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EU LEGISLATION 2006

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Industrial Property

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Patents


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Community Patent

The European Council held in Lisbon in March 2000 called for the creation of a Community patent system to address existing shortcomings in the legal protection for inventions, thus giving an incentive for investments in research and development and contributing to the competitiveness of the economy as a whole. In the wake of the Lisbon European Council, the Commission put forward on 1 August 2000 a proposal for a Council regulation on the Community patent [COM(2000) 412 final].

The effective entry into operation of the Community patent system requires the adoption of this regulation by the Council and of subsequent implementing regulations to be adopted in comitology procedure.

In the framework of the creation of a unitary Community patent, two Commission proposals have also been presented on December 2003 on the establishment of a Community patent jurisdiction.

- 14.05.2004 The proposals before the Council in May 2004 - frequently asked questions
In the light of developments since the Commission issued its proposal in August 2000, these FAQs are being published to show how the proposed system would work and what benefits it would offer innovative industry in the EU.
 [en](#)

- 08.03.2004 Preparation of the meeting of the Council on 11 March 2004: Proposal for a Council Regulation on the Community patent (revised text)
[da](#) [de](#) [el](#) [en](#) [es](#) [fr](#) [it](#) [nl](#) [pt](#) [fi](#) [sv](#)

- 23.12.2003 Commission proposes establishing Community Patent Court
 - [Press release](#)
 - Proposal for a Council Decision conferring jurisdiction on the Court of Justice in disputes relating to the Community patent - [COM\(2003\)827 final](#)
 - Proposal for a Council Decision establishing the Community Patent Court and concerning appeals before the Court of First Instance - [COM\(2003\)828 final](#)




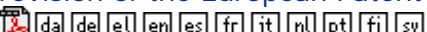
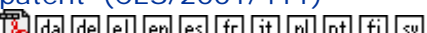
- 21.11.2003 Proposal for a Council Regulation on the Community patent - Text revised by the Secretariat of the Council - Document 15086/03
[es](#) [da](#) [de](#) [el](#) [en](#) [fr](#) [it](#) [nl](#) [pt](#) [fi](#) [sv](#)

- 13.11.2003 Proposal for a Council Regulation on the Community patent - Text revised by the Secretariat of the Council - Document 14233/03
[es](#) [da](#) [de](#) [el](#) [en](#) [fr](#) [it](#) [nl](#) [pt](#) [fi](#) [sv](#)

- 04.09.2003 Proposal for a Council Regulation on the Community patent - Text revised by the Secretariat of the Council - Document 12219/03
[es](#) [da](#) [de](#) [el](#) [en](#) [fr](#) [it](#) [nl](#) [pt](#) [fi](#) [sv](#)

- 23.06.2003 Proposal for a Council Regulation on the Community patent - Text revised by the Secretariat of the Council - Document 10728/03
[es](#) [da](#) [de](#) [el](#) [en](#) [fr](#) [it](#) [nl](#) [pt](#) [fi](#) [sv](#)

- 11.06.2003 Proposal for a Council Regulation on the Community patent - Text revised by the Presidency - Document 10404/03 (PI 53)
[es](#) [da](#) [de](#) [el](#) [en](#) [fr](#) [it](#) [nl](#) [pt](#) [fi](#) [sv](#)

- 16.04.2003 [Proposal for a Council Regulation on the Community patent - Text revised by the Presidency - Document 8539/03](#)

- 14.03.2003 [The 3 March 2003 Agreement on the Community patent reduces translation cost for patents in Europe by more than 50%](#)

- 03.03.2003 [Political Approach adopted by the Council - Document 7159/03](#)

- 30.08.2002 [Commission Working Document on the Planned Community Patent Jurisdiction COM\(2002\) 480 final](#)
- 07.05.2001 [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" - SEC/2001/744 final](#)

- 29.03.2001 [Opinion of the Economic and Social Committee on the 'Proposal for a Council Regulation on the Community patent' \(CES/2001/411\)](#)

- 05.07.2000 [Commission proposes the creation of a Community Patent](#)
- [Press release](#)
 - [Frequently Asked Questions](#)
 - [Full text of the proposal](#)


See also:

- [The Community Patent at the Competitiveness Council: Press Releases and outcome](#)
- [The Community Patent at the European Council meetings: Conclusions of the Presidency](#)

Production of patented medicines for export to countries in need

The European Commission has proposed a Regulation to allow manufacturers of generic pharmaceuticals to produce patented medicines for export to "countries in need" without sufficient capacity to produce them.






- [Commission welcomes changes to EU law to allow export of patented medicine to countries in need \(28.04.2006\)](#)

- [Press release](#) (29.10.2004)
- Text of the proposal  [de](#) [en](#) [fr](#)
[other linguistic versions](#)
- [Read more](#)

Supplementary protection certificate

- 18.07.1996 [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](#)
- 18.06.1992 [Council Regulation \(EEC\) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products](#)

Studies

- 09.05.2005 [Study on patents: "What are patents actually worth? - the value of patents for today's economy and society"](#)
- [Executive Summary Lot 1](#)  [en](#)
 - [Final Report Lot 1](#)  [en](#)
- 12.03.2003 [Study: "The possible introduction of an insurance against costs for litigation in patent cases" by CJA Consultants Ltd, European Policy Advisers, Britain and Brussels](#)
- [Full text](#)  [en](#)
 - [Executive summary](#)  [de](#) [fr](#)
- 14.02.2003 [Study: "The role of national patent Offices, the European patent office as well as Japanese and US patent offices in promoting the patent system" by IBM Business Consulting Services B.V., Almere](#)
- [Full text](#)  [en](#)
 - [Executive summary](#)  [de](#) [fr](#)
 - [Presentation of the study by Anthony Howard, Directorate General Internal Market](#)  [en](#)

Other documents

03.02.2005 The participants of the Exploratory Meeting Concerning the Future of Substantive Patent Law Harmonisation which took place at the United States Patent and Trademark Office, Alexandria, Virginia, February 3-4, 2005 agreed the attached Statement of Intent.



25.04.2000 Conference on patent insurance

- Agenda of the conference
- Presentation of John Horsted, Danish Patent Office
- Presentation of Ernest Kay, LBT Services London

12.02.1999 Communication from the Commission: "Promoting innovation through patents"

- [Press release](#)
- Full text

06.10.1998 Patents: results of audition on 5 October 1998 concerning the period of grace

25.06.1997 Commission approves Green Paper on the Community patent and the patent system in Europe

- [Press release](#)
- Full text
- [How does the European system of patents work?](#)



Last update on 16-05-2006



European Patent Office

Legislative Initiatives in European Patent Law

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- EPC 2000
- Organisational Autonomy of the EPO's Boards of Appeal
- London Agreement on the application of Article 65 EPC
- EPLA - European Patent Litigation Agreement
- **Community Patent**

Community Patent

On 1 August 2000, the Commission proposed the creation of a Community patent by way of an [EC Regulation](#) (PDF, 134 KB).

Discussions in the Council have resulted in a [Common Political Approach](#) dated 3.3.2003 laying down the compromises achieved on four critical issues (jurisdiction, languages and costs, role of national patent offices and distribution of fees).

The latest [Proposal for a Council Regulation on the Community patent](#) is dated 8.3.2004 (document 7119/04).

In addition, on 23.12.2003, the Commission published its proposals for the Community Patent Court:

- [Proposal for a Council Decision conferring jurisdiction on the Court of Justice in disputes relating to the Community patent - COM\(2003\) 827 final](#)
- [Proposal for a Council Decision establishing the Community Patent Court and concerning appeals before the Court of First Instance - COM\(2003\) 828 final](#)

Once the Community Patent Regulation has been adopted, it will be necessary to revise the EPC in order to accommodate the Community patent and enable the European Community to become party to the EPC. The latest [Council Proposal for amendments to the EPC](#) is dated 19.11.2003 (document 15088/03).

In January 2006, the Commission launched a public consultation on how future action in patent policy could best take account of stakeholders' needs. The [Questionnaire on the patent system in Europe](#) published on that occasion by the Commission focuses on three major issues:

- the Community patent,
- how the existing European patent system could be improved in the near future and
- possible areas for harmonisation.

The [EPO's reply to the Questionnaire](#) has been made public.

The consultation process has brought renewed attention to projects which have been suffering from the



▪ [European Patent Office](#)



▪ [Administrative Council](#)

Additional links

- [European Commission --> DC Internal Market](#)

deadlock of the years 2004-2005 as well as new momentum to the arduous endeavour of reforming patent law in Europe. On 12.7.2006, the Commission hosted an open hearing in Brussels. The stated aim of the hearing is to initiate a second phase of the consultation, at the end of which the Commission will present its views on the future patent policy in Europe.

In preparation for the hearing on 12.7.2006, the Commission published its [preliminary findings of the consultation](#). In addition, a short [report](#) on the hearing has been made available together with most [speeches and ppt-presentations](#) given at the hearing, including the [intervention](#) by Professor Pompidou, President of the EPO.

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FUTURE PATENT POLICY IN EUROPE

PUBLIC HEARING – 12 JULY 2006

**European Commission
"Charlemagne" Room S3
Rue de la Loi 170
Brussels**

REPORT

On July 12, DG Internal Market and Services held its public hearing on the future patent policy in Europe.

The hearing encountered the same vivid interest as the preceding written phase of the consultation. Prior to the debate, DG Internal Market published a document containing succinct preliminary results of the 2515 responses it received, which also set out issues to be discussed. The hearing was based on those findings and its structure mirrored that of the questionnaire.



The debate kicked off with a welcome speech by Mr Thierry Stoll, Acting Director General of DG MARKT. Next, Mr Erik Nooteboom, Head of the Industrial Property Unit presented preliminary findings of the Commission's consultation. Next, Mr Giuseppe Gargani, President of the Legal Affairs Committee of the European Parliament, introduced the session on the Community Patent in a much welcomed address where he expressed his support for a Community Patent based on a simple linguistic regime. Professor Michal Du Vall of the Uniwersytet Jagiellonski of Cracow then provided an unorthodox lively introduction to the session on Basic Principles of Patent Law.

The afternoon session kicked off with a speech by Ms Marja-Leena Rinkineva on behalf of the Finnish Presidency, followed by the introduction of the session on EPLA by Mr Vincenzo Scordamaglia, Honorary Director General of the EU Council. He retraced the lengthy saga of the development of a patent jurisdiction in Europe and pleaded for the much awaited adoption of such a jurisdiction.

In total, 39 pre-selected stakeholders spoke on during allocated 5 minute slots and divided among the four sessions of the debate. At the end of the hearing, additional time was devoted to an open debate where 22 participants intervened in 3 minute on any issue of concern.

The afternoon session included a speech made by the President of the European Patent Office, Professor Alain Pompidou, followed by a presentation of the preliminary results of a study commissioned by DG MARKT on the economic and social value of patents.

The hearing ended with a speech by Commissioner McCreevy where he announced the follow-up to this consultation. The speech is available at: <http://europa.eu/rapid/pressReleasesAction.do?reference=SPEECH/06/453&format=HTML&aged=0&language=EN&guiLanguage=en>

The lists of intervening participants and all the speeches and presentations made during the debate are available for download on the DG Markt's website: http://ec.europa.eu/internal_market/indprop/patent/hearing_en.htm.

RESUME

Debate No 1: Basic principles of the patent system: 6 interventions

There was general consensus that the current system should be improved and that a clear IP policy for Europe should be implemented.

The most highlighted issues were: quality of the patents, legal certainty and predictability of the system in order to enhance and maintain the competitiveness of the EU. The importance of access to the patent system was emphasized.

There was general support to maintain the EPO as the centre of the system with the support of national patent offices and the Commission. Duplication of work among the patent offices should be reduced as much as possible.

The representative of a consumer, health care and education association raised some concerns regarding the ethical framework. It was argued, in particular that: patents on life, patents on human bodies "as such" or its parts "as such" should be rejected. The issue of patents for diagnosis was a further topic.

Some proposals on alternative dispute resolution like mediation or arbitration were made and examples of current practices in WIPO were pointed out.

One university representative suggested the introduction of a grace period.

Debate No 2: Harmonisation and mutual recognition: 6 interventions

All participants agreed on the importance of substantive patent law **harmonization** and that it is *de facto* achieved at EU level by the European Patent Convention (EPC). Although some substantive issues were identified as not yet harmonised (computer implemented inventions (CII), trivial patents and ethic-related issues), there is agreement that no Directive on patent harmonization is needed. Also, some mentioned the importance of the Agreement on Trade-related aspects of intellectual property rights Treaty (TRIPS) with respect to harmonisation.

The idea of **mutual recognition** was widely rejected, perceived as a threat for the current "well functioning" grant system and not feasible given significant differences in experience and expertise among national patent offices.

Some stated that the aim of the national patent offices (NPOs) should be to reach the same level of quality as delivered by the EPO (guidelines or soft-law could help harmonise national standards). In this respect, some rejected the idea of an EPO "certificate of quality" since it would increase its current workload. Also, issues of training and of work carried out by patent examiners, as well as education exercise on patents vis-à-vis the general public, were raised.

The importance of a future mutual recognition among trilateral offices (EPO, USPTO and JPO) was highlighted. For that purpose, a Substantive Patent Harmonization Treaty (SPLT) is seen as helpful.

Other proposals: need for quick actions to fulfil the Lisbon agenda; further coordination between the Commission-DG MARKT and EPO, the Commission should start negotiating EPLA and the European Community should accede to the EPC.

Debate No 3: Community Patent

Most participants in the debate supported the concept of a Community patent, however "not at any price".

SME interests claimed that a Community patent in line with the 3d of March 2003 Council compromise was too costly for them. However, it was also suggested to provide for the grant of patents in "the SME's own language" combined with translations of the claims in all other Community languages. Some research institutions proposed to provide for an "English only" language regime.

Various industry and Member States representatives considered that a Community framework for patents is a priority and called for a compromise package. One participant suggested in case that all efforts failed for achieving a package deal to pursue COMPAT by virtue of enhanced co-operation of certain Member States. One speaker, whilst wholeheartedly supporting EPLA, suggested abandoning COMPAT all together.

Consumers' representatives asked for the carrying out of "independent studies" concerning the issues addressed in the consultation and suggested a patent system involving remuneration rights instead of restricted acts.

Other issues of concern in this debate were trivial patents, patent quality and the need for promoting interoperability.

Debate No 4: Jurisdiction

The majority of participants favoured changes to the current patent litigation regime to prevent conflicting interpretations in multi-jurisdictional cases. To succeed, the following features were identified: simple and rapid procedures, simplicity of access (proximity to courts), legal clarity and predictability through a certain level of centralization, reasonable costs, specialised judges and an appropriate language regime.

Some participants pleaded for the development of alternative dispute resolution, such as arbitration and mediation, as providing rapid and less costly solutions that could be helpful, in particular to SMEs.

The majority of participants supported the draft European Patent Litigation Agreement (EPLA). The main reason for the support is the right balance between simple access to courts (regional divisions) and legal certainty through centralization (second instance) that draft EPLA is seen to achieve. Participants also describe the language regime as appropriate and welcome its specialised (technical) judges who would guarantee high quality decisions (high quality patents). The necessity for a uniform set of rules of procedure was stressed. It was stated that an EPLA court was always needed, independently of a COMPAT court, in order to deal with the European bundle patents.

Concerns relating to the draft EPLA centre on costs and the independence of judges. Some participants pointed out that EPLA would force plaintiffs that might otherwise have gone for litigation in only one country, to bear the costs under EPLA, which were two to three times higher than those incurred by litigation in one country (example Germany or France). In practice, only a small percentage of cases actually involve multi-jurisdictional litigation. It was stressed that the higher costs would make it harder for SMEs to enforce their patents and also to defend themselves. A further concern was raised that under EPLA the administration would control the judiciary and that judges would not be independent but taking the same decisions as the EPO (e.g. with regard to software patents). They would be appointed and re-appointed by the same people running the EPO and could hold positions at the EPO at the same time as being judges.

A number of participants stated that an EPLA court and a COMPAT court could function side-by-side, while at least one participant felt that, ultimately, there should be just one patent litigation system in Europe.

At least one intervening participant suggested that a patent litigation system should be modelled on the existing system of Community trade mark courts with national, specialised courts dealing with patent litigation.

Final Open Debate

Many participants stressed the fact that the daily life of SMEs should be better taken into account by the patent system:

- in relation to cost, which can kill innovation;
- in relation to their ability to understand and use the patent system (assistance services).

Other points made: the importance of quality of patents; lack of competitiveness of Europe on the global stage; the need for an easier access for inventors; the need to increase public awareness; the fact that the introduction of exceptions would destroy the economic incentive; the fact that patents are harmful for open standards (need for a clear definition of these standards by the Commission); and the importance of the separation of powers.

Community Patent:

The majority of speakers were in favour of a Community Patent, but opposed to the 2003 common political approach.

Opinions diverged on the language regime: some favoured a one-language (or at least a very limited number of languages) approach, while others considered that such an approach would be discriminatory and would make access to information regarding technology difficult (translations should be put on the web).

Concerning the jurisdictional aspects, several speakers stressed the importance of technically educated judges and of regional chambers at first instance level.

Some speakers supported FICPI's proposal (i.e. COMPAT not necessarily in all MS and a jurisdiction system inspired by the trademark and design system). Several speakers pointed to the fact that COMPAT and EPLA can coexist and that there should be a synergy between them.

EPLA:

The majority of participants were in favour of EPLA (centralisation makes Europe one of the big players on the global stage). Some of them considered that this is THE way forward and that it should be implemented as soon as possible with the involvement of the European Community. Other stakeholders suggested that the EU be part of the EPC and accept the London Protocol and EPLA.

Some pointed to the following features of EPLA: practical and pragmatic agreement, clear procedural rules, optional character, high quality decisions, experienced courts, lower costs than actually foreseen by EPO (States should cover some of the costs).

Harmonisation and Mutual Recognition

While a participant expressed its opposition to both options, another one stressed the need for a harmonisation concerning the breeders' exemption (plant varieties).

Community patent - the proposals before the Council in May 2004 – frequently asked questions

What is the main difference between the compromise text of the Regulation before the Competitiveness Council and the Commission's original proposal?

The Presidency text of the Community patent regulation takes on board the common political approach agreed by the Council in March 2003, in particular the requirement that translations of the claims of the patent be filed in all Community languages for the patent to be valid (unless states renounce the requirement for their official languages). The Commission's original text foresaw that the patent be valid as granted by the European Patent Office in one of the three EPO languages (English, French and German), with translations of the claims in the other two languages published for information.

How will the Community patent relate to existing systems?

The Community patent (Compat) system will exist alongside patents for individual Member States available through the European Patent Office or national patent offices. Applicants will be able to choose what kind of patent they end up with for any particular invention, whether a unitary Community patent covering the whole of the EU, or individual patents for separate EU Member States.

Won't the Compat be compulsory for applicants to the EPO?

Not at all. The European patent application will automatically designate individual states as well as the EU, but the applicant can choose which designations to keep or remove. Any application which still has the EU designated at the time of grant will be a Community patent. If the EU is designated along with its Member States, the unitary EU designation will prevail and the patent will be a Community patent. But after grant the patent holder can still opt for the Community patent to be converted to patents for individual EU Member States under certain conditions.

Won't the Compat system destroy the existing European and national systems?

It will be for applicants to decide which route to patent protection suits them best. There will be different aspects which are advantageous in each case. If one or other route becomes less viable because it does not meet the needs of applicants, then stakeholders will need to decide what action to take.

So what are the differences between a Compat and existing patents?

The main differences relate to the unitary nature of the Community patent, the different translation requirements and maintenance arrangements, with the possibility of corresponding cost savings, and the litigation of disputes before a single Community court instead of in potentially several individual Member States.

What is the significance of the unitary nature of the Compat?

The Compat is a unitary Community-wide intellectual property right (like the Community trade mark or the Community design). It applies with the same effect in the whole territory of the Community, and may only be declared invalid for the whole territory of the Community. Existing patents apply only to individual national territories and can only be invalidated for the state concerned, without directly affecting the equivalent patent in another state. Moreover the Compat will also be managed as a single patent. There will only be one single Community patent register and a Community patent will be annually renewed by paying one single renewal fee, instead of maintaining and paying renewal fees for a number of patents in different MS.

How will costs differ for a Compat?

Costs for the Compat after grant will differ from national patents in relation to translations and maintenance:

- The applicant will be responsible for obtaining translations of the claims of the patent into all EU official languages and filing these at the EPO except for any languages where states have renounced the translation requirement. A simple comparison suggests these costs should be less than the existing translation costs for an average European patent (see http://europa.eu.int/comm/internal_market/en/indprop/patent/docs/2003-03-patent-costs_en.pdf)
- The annual renewal fees for maintenance of the patent will be payable in a single sum to the European Patent Office, rather than to individual national offices as required for national patents. They will amount to not more than the combined annual renewal fees for an average European patent covering say eight states, and could be less. The exact level will have to be decided nearer the time that Community patents will become available.

Taking both these aspects into account, calculations show that the Community patent will cost no more than a European patent covering five states. This would represent a cost saving to around two-thirds (68%) of all applicants for European patents – at least 30000 granted patents each year. For full EU coverage the Community patent would cost only 50% of a European patent for the 25 individual member states – a saving of at least €30000 per patent over 10 years.

On costs, is this a realistic comparison with current practice?

Some companies may prefer to use the system of individual patents so that they can choose in which states to obtain or maintain patent protection. Different firms may protect their inventions in only a few Member States. They may have no need to protect their invention in other Member States if there is no demand or no competition there, or if they have assured market leadership by other means. For them a Community patent may not offer significant cost savings. However if they wanted coverage for more than five states, or access to Community-wide litigation, they could achieve this with a Community patent for little extra cost.

Won't European patents be much cheaper with the London Agreement than the Community patent will be?

The London Agreement¹ is not yet in force. Under the terms of the Agreement, states who become party to it will give up some of their translation requirements for national patents obtained through the European patent system. So if it comes into force it will offer some savings on patents for the states concerned. This could mean that the average European patent for eight states becomes closer in cost to current calculations for the EU-wide Community patent. However the Community patent would still offer cost savings to applicants requiring patent protection for more than around eight states - some 40% of applicants for a European patent – in other words at least 20000 granted patents each year. Even if the London Agreement came into force for all twenty five EU states, the end result would not be any less translation than is required for a Community patent. Under both regimes translations of the claims will be required unless a state renounces that requirement. So while the translation costs might be similar for coverage of 25 states, the maintenance costs would be fixed for the Community patent, leading to a cost saving of some €30000 over patents for all the individual EU MS.

But isn't the Commission preventing application of the London Agreement?

The London Agreement is open to the member states of the European Patent Organisation, and it is for them to decide whether or not to proceed with ratification or accession. But its entry into force is dependent on eight states becoming party including the UK, France and Germany. So far none of the ten original signatory states has ratified, and only one other state has acceded.

So when will we be able to apply for Compats?

Not for a few years yet. That is because among other steps there has to be a Diplomatic Conference to revise the European Patent Convention, under which the EPO would grant Compats. That Diplomatic Conference could take place in 2005. Then a sufficient number of states together with the European Community have to become party to the new version of the Convention to bring it into force. This requires states to pass new national legislation to implement the revised Convention.

What other legislative steps are required?

First of all the Council of the EU needs to adopt the Regulation establishing the Community patent. This has been under discussion since autumn 2000. Once this has been adopted, implementing regulations can then be taken forward, including rules setting out the annual renewal fees for maintenance of the Community patent. A separate series of negotiations will set up the Community patent court (CPC) and the patent appeal chamber at the Court of First Instance on the basis of the proposals adopted by the Commission in December 2003. The Court should be in place by 2010.

Why do we need a Community patent court? Why can't national courts rule?

¹ Agreement on the application of Article 65 of the European Patent Convention, London, 17 October 2000

In fact national courts will deal with some matters relating to the Community patent even after 2010 – particularly questions of ownership, contractual terms or matters relating to the patent as an item of property. But as far as the scope of the patent is concerned, only a single Community jurisdiction can guarantee a consistency of approach and offer legal certainty to right holders and their competitors. So the CPC will rule on infringement and validity questions.

What happens before 2010 when the CPC is to be set up?

During that transition period, MS will designate competent national courts which will have the same jurisdiction as the Community patent court will. However given the steps to be taken before Community patents become available, it is unlikely that many will be subject of litigation before 2010.

How can the Community patent court be as good as the best national courts?

The judges will have to have a high level of legal expertise in patent law, and they will have access to specific technical knowledge provided by the Assistant Rapporteurs. They will be appointed by the Council, on the recommendations of an advisory committee. So it will be up to the Council to ensure that the right team of judges is appointed. And more generally it will be up to the Council to adopt the instruments setting up specific arrangements for the establishment and operation of the court, on the basis of the Commission's proposals adopted last December. The judges will then be responsible for proposing the court's specific rules of procedure for approval by the Council.

Won't it be expensive for litigants to use the Court?

The Court will be funded from the EU budget. The Commission has proposed that parties should contribute a fair share to the costs incurred by their private party litigation. Court fees will need to strike the right balance between the principle of fair access to justice and an adequate contribution by the parties for the services rendered by the Community Patent Court. Legal aid will be provided for parties unable to meet those costs. This means that the Community patent court cannot be expected to be self-financing.

What is the role of patent attorneys before the Community patent jurisdiction?

European Patent Attorneys will enjoy the right to appear before the Community Patent Court and the appeal chamber of the Court of First Instance and speak on behalf of their client. When they appear before the Community patent jurisdiction they shall enjoy the rights and immunities necessary for the independent exercise of their duties. However, the right to represent a party is reserved to the lawyer.

But why can't patent attorneys have the same rights they do at the EPO?

Although patent attorneys have full right of representation before the EPO Boards of Appeal and Boards of Opposition, these specialist bodies are not comparable to national or Community courts. In many national courts patent attorneys do not at

present have full rights of representation. However in order to address this issue the Commission has proposed that European patent attorneys may take part in court proceedings and speak before the Community Patent Court and the appeal chamber of the Court of First Instance.

Why should infringers be able to rely on inaccuracies in translations?

Under the existing system, legislation in most states provides that if the translation of the patent into their official language is narrower in scope than the patent granted by the EPO, then third parties can rely on the translation (Article 70 EPC). This means that they can continue indefinitely to carry out activities which would infringe the granted patent in its original language, if they do not infringe the patent as translated. They do not need authorisation of the owner of the patent, nor are they liable to make any payment. In contrast the Community patent system aims to minimise differences in interpretation of the unitary Community patent while allowing some limited relief for infringers who were genuinely misled by an inaccurate translation.

Won't translation problems make it difficult to obtain injunctions?

There is no question of allowing translation deficiencies to prevent the owner of a patent from asserting his rights. Just as at present in patent cases, an alleged infringer may offer various defences, including the ground that the translation of the patent is not accurate. The court dealing with interim measures would normally be expected to take an initial view of all the arguments put forward and act accordingly. But if the court is not satisfied with the defence then there would be no reason for it to delay the grant of an urgent injunction.

What is the proposed language regime before the Community Patent Court?

The language of proceedings is principally determined by reference to the domicile of the defendant in the EU. The defendant must be able to participate in proceedings in his own language. However the court will have access to translation and interpretation facilities as required to ensure that all parties and the judges can participate in the proceedings. Nothing should prevent the parties, if they so wish, from using a Community language which permits direct communication with the judges.

Does the proposed Community patent regulation really rule out arbitration between parties?

No. The regulation allows parties to choose arbitration as a way to resolve a dispute between them, subject to Member States' national rules on arbitration. What arbitration cannot do is to invalidate or officially declare the patent invalid. Only the European Patent Office (in opposition proceedings) and the Community patent court can rule on the validity of the Community patent.



**COUNCIL OF
THE EUROPEAN UNION**

Brussels, 8 March 2004

7119/04

**Interinstitutional File:
2000/0177 (CNS)**

LIMITE

PI 28

PUBLIC

NOTE

from: Presidency
to: Council (Competitiveness)

No. prev. doc. : 7029/04 PI 26

No. Cion prop. : 10786/00 PI 49

Subject : PREPARATION OF THE MEETING OF THE COUNCIL ON 11 MARCH 2004
- Community patent
= Proposal for a Council Regulation on the Community patent

1. Building on the common political approach of 3 March 2003 (doc. 7159/03) and the further progress achieved thereafter, notably in the context of the meeting of the Competitiveness Council of 26/27 November 2003, the Presidency herewith submits in Annex I to this Note a draft text of the Regulation which reflects the situation following the November Council, with two issues remaining unsolved: the length of the period in Article 24a (3) and the legal effects of the translations of the claims as reflected in Articles 24c and 24d. The changes to the text which was the basis for the deliberations of the November Council (doc. 15086/03) are reflected in the attached Presidency text in the following Articles: **24a (3), 24c, 24d and 62**. These changes are suggested in a continuing effort to find compromise solutions to the remaining outstanding issues regarding the compulsory translations of the Community patent and the effects of incorrect translations.

2. As an alternative approach to solving the issue of the effects of the translations of the claims, the Presidency submits in Annex II to this Note a draft "New concept Article" which, together with suggested new recitals, is meant to replace Articles 24c and 24d as well as Articles 11(3a) and 44(3a) in Annex I. The Presidency considers that this alternative approach offers a pragmatic solution to the issues at stake, fully consistent with the unitary character of the Community patent and the need for legal certainty.

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3. **The Council is invited to consider the two alternative approaches contained in the attached texts with a view to reaching a political agreement on the Regulation on the Community patent to be transmitted to the European Parliament for reconsultation.**

Proposal for a
COUNCIL REGULATION
on the Community patent
(Text with EEA relevance)

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 308 thereof,

Having regard to the proposal from the Commission¹,

Having regard to the opinion of the European Parliament²,

Having regard to the opinion of the European Economic and Social Committee³,

Whereas:

- (1) The activities of the Community include the establishment of an internal market characterised by the abolition of obstacles to the free movement of goods and the creation of a system ensuring that competition in the internal market is not distorted. The creation of the legal conditions enabling undertakings to adapt their activities in manufacturing and distributing products to a Community dimension helps to attain these objectives. A patent to which uniform protection is given and which produces uniform effects throughout the Community should feature amongst the legal instruments which undertakings have at their disposal.
- (2) The Munich Convention on the Grant of European Patents of 5 October 1973 (hereinafter referred to as the "Munich Convention") established the European Patent Office (EPO) and entrusted it with the task of granting European patents. The expertise offered by the European Patent Office should therefore be used in the granting of the Community patent.

¹ OJ C 337E, 28.11.2000, p. 278.

² OJ C 127E, 29.5.2003, p. 519

³ OJ C 155, 29.5.2001, p. 80.

- (2a) The European Patent Office will play a central role in the administration of Community Patents and will alone be responsible for examination of applications and the grant of Community Patents. All national patent offices will have an important role to play, *inter alia* advising potential applicants for Community Patents, receiving applications and forwarding them to the EPO, disseminating patent information and advising SMEs. National Patent Offices will be compensated for these activities.
- (2b) Applications for Community Patents can be filed with the National Patent Office of a Member State in its working language(s). Applicants will remain free to present their patent applications directly to the EPO. They may also request that their applications be fully processed by the EPO. On behalf of the EPO and at the request of the applicant, National Patent Offices of Member States having an official language other than the three official languages of the EPO may carry out any task up to and including novelty searches in their respective language(s). National Patent Offices of Member States having as their official language one of the three EPO languages, which have experience of cooperation with the EPO and which need to maintain a critical mass may, if they so wish, carry out search work on behalf of the EPO. The relationship between National Patent Offices carrying out these tasks and the EPO will be based on partnership agreements, containing *inter alia* common criteria for quality assurance. These criteria (covering documentation, staff training and qualifications and working tools) would aim to guarantee a comparable quality and uniformity of the Community Patent. The implementation of these partnership agreements, i.e. the compliance with these objective quality standards, will be subject to independent periodic review. National patent offices will be compensated for the searches that they carry.
- (2c) The Community Patent system will include a safeguard clause according to which the Council, acting on a proposal from the Commission after consultation with the EPO, can agree to extend the involvement of any National Patent Offices in search activities to meet any severe problems of capacity in delivering Community Patents. Such arrangements must not lead to any reduction of quality of the Community Patent.

- (3) The accession of the Community to the Munich Convention will enable the Community to be included in the Convention system as a territory for which a unitary patent can be granted. The Community can, therefore, limit this Regulation in particular to the creation of the law applicable to the Community patent once granted.
- (3a) The Office should also be entrusted with the task of administering the Community patent, for example, as regards the collection of fees, the distribution of annual fees to national patent offices on the basis of a distribution key to be decided unanimously by the Council and management of the Community Patent Register. It is also appropriate to give the Office a number of other tasks relating to a Community patent, for example, limitation of the patent on application by the holder or recording the surrender or lapse of the patent. In carrying out the tasks of administering the Community patent, the Office will, while respecting Community law, as an organ of the European Patent Organisation apply the provisions of the Munich Convention. The review of decisions taken by the Office will be governed by the Munich Convention.
- (4) Community patent law applicable to the Community patent should not replace the laws of the Member States on patents, nor European patent law as established by the Munich Convention. It would not in fact appear to be justified to require undertakings to apply for registration of their patents as Community patents, since national patents and European patents continue to be necessary for those undertakings which do not want protection of their inventions at Community level. This Regulation should therefore be without prejudice to the right of the Member States to grant national patents.
- (4a) The substantive law applicable to the Community patent, for example as regards patentability, the extent of patent protection, limitation of the effects of the patent and the exhaustion of rights, must follow the same principles as the existing Community legislation with respect to national patents.

- (5) The objective of an affordable Community patent militates in favour of a patent that is valid throughout the Community in the language in which it was granted under the Munich Convention, subject, however, to the obligation on the applicant to submit a translation of all the claims into all the official Community languages. Thus, the language regime for the Community Patent will, up to grant, be the same as the one provided for in the European Patent Convention. This means that the applicant has to present a complete application document in one of the three official languages of the EPO as well as, at the time of grant of the patent, a translation of the claims into the two other EPO languages. However, where the applicant files the application in a non-EPO language and provides a translation into one of the EPO languages, the cost of that translation will be borne by the system ("mutualisation of costs"). For reasons of legal certainty - in particular in connection with actions or claims for damages - non-discrimination and dissemination of patented technology, the applicant must, at the time of grant of the patent, file a translation of all claims into all official Community languages except if a Member State renounces the translation into its official language. The translations will be filed with the EPO and the costs borne by the applicant, who decides on the number and the length of claims to be included in the patent application, thereby having an influence on the cost of translations.
- (5a) The renewal fee for a Community Patent must not exceed the level of the corresponding renewal fees for an average European Patent and will be progressive throughout the life of the Community Patent. The level of procedural fees for processing an application for a Community Patent will be the same regardless of where the application is filed and where the novelty search is carried out (EPO or national patent office). The level of fees will be related to costs for handling the Community Patent and must not lead to any indirect subsidy of national patent offices.
- (5b) Renewal fees for Community Patents will be payable to the European Patent Office, which will keep 50 percent to cover its costs, including the costs of searches carried out by National Patent Offices. The remaining 50 percent will be distributed among the National Patent Offices of the Community Member States in accordance with a distribution key, which will be decided unanimously by the Council.

- (6) Any negative effects of a monopoly created by a Community patent should be prevented through a system of compulsory licences. This is without prejudice to the application of Community competition law by the Commission or national authorities. However, the Community Patent Court should be entrusted with the grant of compulsory licences in situations not falling under Community competition law.
- (7) As Community patents are Community titles the Community jurisdiction should have the power to decide matters affecting their validity. The jurisdictional system of the Community Patent will be based on the principles of a unitary Court for the Community Patent, securing uniformity of the jurisprudence, high quality of working, proximity to the users and potential users and low operating cost. For reasons of legal certainty, all legal actions relating to certain aspects of the Community patent should come under the jurisdiction of one court, and the decisions of that court should be enforceable throughout the Community. Exclusive jurisdiction for a certain category of actions and applications relating to a Community patent, and in particular for actions relating to infringement and validity, should therefore be given to the Court of Justice of the European Communities. Jurisdiction shall reside in the first instance in the Community Patent Court (CPC) created by the decision taken pursuant to Article 225a of the Treaty and, on appeal, in the Court of First Instance. The Court of Justice may make a decision in last resort, subject to the conditions provided for in Article 62 of the Statute of the Court of Justice. This judicial system must be in place and operational by January 2010 at the latest. Until that time, it is necessary to provide for a transitional period during which disputes for which the Community courts are competent shall be heard by the national courts. Once the final judicial system is operational, the Commission shall publish in the Official Journal of the European Union the date on which it shall be applicable. The final system shall apply to actions and applications initiated after that date, whereas individual actions initiated prior to that date before the national courts shall continue to be heard by the national courts.

- (7a) The seat of the Community Patent Court shall be at the Court of First Instance. The judges shall be appointed on the basis of their expertise and taking into account their linguistic skills. The Community Patent Court may hold hearings in Member States other than that in which its seat is located.
- (7b) The judges shall be appointed by a unanimous decision of the Council for a fixed term. The candidates for appointment must have an established high level of legal expertise in patent law. Technical experts will assist the judges throughout the handling of the case.
- (7c) The Community Patent Court will conduct the proceedings in the official language of the Member State where the defendant is domiciled, or in one of them to be chosen by the defendant, where in a Member State there are two or more official languages. At the request of the parties and with the consent of the CPC, any official EU language can be chosen as language of proceedings. The CPC may, in accordance with the rules of procedure, hear parties in person and witnesses in an EU official language other than the language of proceedings. In that case translations and interpretation into the language of the proceedings from another official EU language should be provided.
- (7d) The Community Patent Court shall be established at the latest by 1 January 2010. Until then each Member State shall designate a limited number of national courts to have jurisdiction in the actions and claims related to the Community Patents.

- (8) The court ruling on infringement and validity should also be able to rule on penalties and compensation for damage on the basis of common rules. Those powers are without prejudice to the powers to apply any rules on criminal liability and unfair competition provided for under the Member States' national law.
- (9) In accordance with the principles of subsidiarity and proportionality as set out in Article 5 of the Treaty, the objectives of the proposed action, in particular the creation of a unitary right with effect throughout the Community, can be achieved only by the Community. This Regulation confines itself to the minimum required in order to achieve those objectives and does not go beyond what is necessary for that purpose.
- (10) Since the measures necessary for implementing this Regulation are measures of general scope within the meaning of Article 2 of Council Decision 1999/468/EC of 28 June 1999 laying down the procedures for the exercise of implementing powers conferred on the Commission⁴, they should be adopted in accordance with the regulatory procedure laid down in Article 5 of that Decision,

HAS ADOPTED THIS REGULATION:

⁴ OJ L 184, 17.7.1999, p. 23.

CHAPTER I

GENERAL PROVISIONS

Article 1

Community patent law

This Regulation establishes a Community law on patents. This law shall apply to all patents designating the Community granted by the European Patent Office (hereinafter referred to as "the Office") under the provisions of the European Patent Convention of 5 October 1973 (hereinafter referred to as the "Munich Convention") and to all applications for a European patent in which the Community is designated.

For the purposes of this Regulation, such patents shall be considered to be Community patents and the term "application for a Community patent" shall mean an application for a European patent designating the Community.

Article 2

Community patent

1. The Community patent shall have a unitary character. It shall have equal effect throughout the Community and may only be granted, transferred, declared invalid or lapse in respect of the whole of the Community.

2. The Community patent shall have an autonomous character. It shall be subject only to the provisions of this Regulation and to the general principles of Community law. However, the provisions of this Regulation shall not exclude the application of Community competition law, nor of the law of Member States with regard to criminal liability, unfair competition and mergers, nor of the provisions of the Munich Convention to the extent that they are not covered by this Regulation.

2a. to 4. Deleted.

Article 3

Application to the sea and submarine areas and to space

1. This Regulation shall also apply to the sea and submarine areas adjacent to a Member State's territory in which that Member State exercises sovereign rights or jurisdiction in accordance with international law.
2. This Regulation shall apply to inventions created or used in outer space, including on celestial bodies or on spacecraft, which are under the jurisdiction and control of one or more Member States in accordance with international law.

CHAPTER II

PATENT LAW

SECTION 1

RIGHT TO THE PATENT

Article 4

Right to the Community patent

1. The right to the Community patent shall belong to the inventor or his successor in title.
2. If the inventor is an employee, the right to the Community patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has his place of business to which the employee is attached.

3. If two or more persons have made an invention independently of each other, the right to the Community patent shall belong to the person whose Community patent application has the earliest date of filing or, where applicable, the earliest date of priority. This provision shall apply only if the first Community patent application has been published under Article 93 of the Munich Convention.

Article 5

Claiming the right to the Community patent

1. If the Community patent has been granted to a person who is not entitled to it under Article 4(1) and (2), the person entitled to it under that article may, without prejudice to any other right or remedy which may be open to him, claim to have the patent transferred to him.
2. Where a person is entitled to only part of the Community patent, that person may, in accordance with paragraph 1, claim to be made a joint proprietor.
3. Legal proceedings in respect of the rights referred to in paragraphs 1 and 2 may be instituted only within a period of three years after the date on which the Community Patent Bulletin, referred to in Article 57, publishes the grant of the Community patent. This provision shall not apply if the proprietor of the patent knew, at the time of the grant or of the acquisition of the patent, that he was not entitled to the patent.
4. The fact that legal proceedings have been instituted shall be entered in the Register of Community Patents referred to in Article 56. The final decision in the legal proceedings or any withdrawal thereof shall also be entered.

Article 6

Effect of change of proprietorship of the Community patent

1. Where there is a complete change of proprietorship of a Community patent as a result of legal proceedings referred to in Article 5, licences and other rights shall lapse upon the registration of the person entitled to the patent in the Register of Community Patents referred to in Article 56.

2. If, before the institution of legal proceedings has been registered,
 - (a) the proprietor of the patent has used the invention within the territory of the Community or made effective and serious preparations to do so,
or

 - (b) a licensee of the patent has obtained his licence and has used the invention within the territory of the Community or made effective and serious preparations to do so, he may continue such use provided that he requests a non-exclusive licence of the patent from the new proprietor whose name is entered in the Register of Community Patents. Such request must be made within the period prescribed in the implementing regulations. The licence shall be granted for a reasonable period and upon reasonable terms.

3. Paragraph 2 shall not apply if the proprietor of the patent or the licensee was acting in bad faith at the time when he began to use the invention or to make preparations to do so.

SECTION 2
EFFECTS OF THE COMMUNITY PATENT AND THE COMMUNITY PATENT
APPLICATION

Article 7

Prohibition of direct use of the invention

The Community patent shall confer on its proprietor the right to prevent all third parties not having his consent

- (a) from making, offering, putting on the market or using the product which is the subject-matter of the patent, or importing or stocking the product for these purposes;
- (b) from using the process which is the subject-matter of the patent or, when the third party knows, or it is obvious in the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent, from offering the process for use within the Community;
- (c) from offering, putting on the market or using a product obtained directly by a process which is the subject-matter of the patent, or importing or stocking the product for these purposes.

Article 8

Prohibition of indirect use of the invention

1. In addition to the right conferred pursuant to Article 7, the Community patent shall confer on its proprietor the right to prevent all third parties not having his consent from supplying or offering to supply within the Community to a person, other than one entitled to exploit the patented invention, with means, relating to an essential element of that invention, for putting it into effect therein, when the third party knows, or it is obvious in the circumstances, that these means are suitable and intended for putting that invention into effect.

2. Paragraph 1 shall not apply when the means are staple commercial products, except when the third party induces the person supplied to commit acts prohibited by Article 7.
3. Persons performing the acts referred to in Article 9(a) (b) and (c) shall not be considered to be parties entitled to exploit the invention within the meaning of paragraph 1.

Article 8a

Deleted

Article 9

Limitation of the effects of the Community patent

The rights conferred by the Community patent shall not extend to:

- (a) acts done privately and for non-commercial purposes;
- (b) acts done for experimental purposes relating to the subject-matter of the patented invention;
- (b.1) acts carried out solely for the purpose of conducting tests and trials in accordance with Article 13 of Directive 2001/82/EC or Article 10 of Directive 2001/83/EC in respect of any patent covering the reference product within the meaning of either of the said Directives;
- (c) the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription nor acts concerning the medicine so prepared;

- (d) the use on board vessels of countries other than Member States of the patented invention, in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of Member States, provided that the invention is used there exclusively for the needs of the vessel;
- (e) the use of the patented invention in the construction or operation of aircraft or land vehicles or other means of transport of non-member States, or of accessories to such aircraft or land vehicles, when these temporarily or accidentally enter the territory of Member States;
- (f) the acts specified in Article 27 of the Convention on International Civil Aviation of 7 December 1944, where these acts concern the aircraft of a country other than a Member State;
- (g) the use by a farmer of the product of his crop for propagation or multiplication on his own holding, provided that the reproductive vegetable material was sold or otherwise commercialised by the holder of the patent or with his consent to the farmer, for agricultural purposes. The scope and the detailed methods of this use are laid down in Article 14 of Regulation (EC) No. 2100/94;
- (h) the use by a farmer of protected livestock for farming purposes, on condition that the breeding animals or other animal reproductive material was sold or otherwise commercialised to the farmer by the holder of the patent or with his consent. Such use includes the provision of the animal or other animal reproductive material for the purposes of his agricultural activity, but not the sale as part of or for the purpose of commercial reproductive activity;
- (i) the acts allowed pursuant to Articles 5 and 6 of Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular, by its provisions on decompilation and interoperability;
- (j) the acts allowed pursuant to Article 10 of Directive 98/44/EC on the legal protection of biotechnological inventions.

Article 9a

Government use

Any provision in the law of a Member State allowing non-commercial use of national patents by or for the government may be applied to Community patents, but only to the extent that the use is necessary for essential defence or national security. The patentee should be informed as soon as reasonably possible about the act and be compensated in respect of the act by the government concerned. Any dispute as to whether a Community patent has been used as provided for in this Article or over the amount of compensation shall be decided by the national courts of the Member State concerned.

Article 10

Community exhaustion of the rights conferred by the Community patent

The rights conferred by the Community patent shall not extend to acts concerning the product covered by that patent which are carried out within the territories of the Member States after that product has been put on the market in the Community by the proprietor of the patent or with his consent, unless there are legitimate grounds for the proprietor to oppose further commercialisation of the product.

Article 11

Rights conferred by the Community patent application after publication

1. Compensation reasonable in the circumstances may be claimed from a third party who, in the period between the date of publication of a Community patent application and the date of publication of the mention of the grant of the Community patent, has made any use of the invention which, after that period, would be prohibited by virtue of the Community patent.

2. In determining the reasonable compensation, the courts shall take into account all relevant aspects, such as the economic consequences to the injured party of the use made of the invention, as well as the undeserved profits made by the person using the invention and the behaviour and the good or bad faith of the parties. The compensation shall not be punitive.

3. For the purposes of paragraph 2, a person using the invention who has his residence or principal place of business in a Member State whose official language, which is also an official language of the Community, is not the language in which the patent application was published, is presumed not to have known nor to have had reasonable grounds for knowing that the use made of the invention would be prohibited by virtue of the Community patent after grant. In such a situation, reasonable compensation shall be due only for the period from the time when he is notified of a translation of the patent claims in the official language of the Member State of his residence or principal place of business.

- 3a The applicant for the patent is not entitled to compensation to the extent that, due to an inaccurate translation of the patent claims which has been notified in accordance with paragraph 3, the person using the invention did not know and did not have any reasonable grounds to know that the use would be prohibited by virtue of the Community patent after grant.

4. Where the Member State referred to in paragraph 3 has two or more official languages which are also official languages of the Community, the person using the invention shall be entitled to notification in the official language of his choice.

Article 12

Right based on prior use of the invention

1. A Community patent may not be invoked against a person who, in good faith and for business purposes, had used the invention in the Community or had made effective and serious preparations for such use before the filing date or, where priority has been claimed, the priority date of the application on the basis of which the patent is granted (hereinafter referred to as "the prior user"); the prior user shall have the right, for business purposes, to continue the use in question or to use the invention as planned during the preparations.
2. The right of the prior user may not be transferred either during the user's lifetime or following his death other than with the user's undertaking or that part of the undertaking in which the use or the preparations for use took place.

Article 13

Process patents: burden of proof

1. If the subject-matter of a Community patent is a process for obtaining a new product, the same product when produced without the consent of the proprietor shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process.
2. The reversal of the burden of proof provided for in paragraph 1 shall apply equally where there is a strong likelihood that the same product was obtained by the process and the holder of the Community patent has not been able, despite reasonable efforts, to determine what procedure has actually been used.
3. In adducing proof to the contrary, the legitimate interests of the defendant in protecting his manufacturing and trade secrets shall be taken into account.

SECTION 3
THE COMMUNITY PATENT AS AN OBJECT OF PROPERTY

Article 14

Dealing with the Community patent as a national patent

1. Unless otherwise specified in Articles 15 to 24, the Community patent as an object of property shall be dealt with in its entirety, and for the whole of the Community, as a national patent of the Member State in which, according to the Register of Community Patents provided for by Article 56:
 - (a) the applicant for the patent had his residence or place of business on the date of filing of the Community patent application;
 - (b) where subparagraph (a) does not apply, the applicant had an establishment on that date.
 - (c) Deleted.

In all other cases, the Member State referred to shall be that in which the European Patent Organisation has its seat.

2. If two or more persons are mentioned in the Register of Community Patents as joint applicants, the first subparagraph of paragraph 1 shall apply to the joint applicant first mentioned. If this is not possible, the first subparagraph of paragraph 1 shall apply to the joint applicants next mentioned in order of entry. Where the first subparagraph of paragraph 1 does not apply to any of the joint applicants, the second subparagraph of paragraph 1 shall apply.
3. Deleted.

Article 15

Transfer

1. The transfer of the Community patent shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgement; otherwise it shall be void. The transfer shall be registered in the Register of Community Patents.
2. Subject to Article 6(1), a transfer shall not affect rights acquired by third parties before the date of transfer.
3. A transfer shall, to the extent to which it is verified by the documents set out in the implementing regulations referred to in Article 59, have effect vis-à-vis third parties only after entry in the Register of Community Patents referred to in Article 56. Nevertheless, a transfer, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights after the date of the transfer but who knew of the transfer on the date on which the rights were acquired.

Article 16

Rights *in rem*

1. The Community patent may, independently of the undertaking, be given as security or be the subject of rights *in rem*.
2. At the request of one of the parties, the rights referred to in paragraph 1 shall be entered in the Register of Community Patents referred to in Article 56 and published in the Community Patent Bulletin referred to in Article 57.

Article 17

Levy of execution

1. The Community patent may be levied in execution.
2. At the request of one of the parties, the levy of execution shall be entered in the Register of Community Patents referred to in Article 56 of this Regulation and published in the Community Patent Bulletin referred to in Article 57.

Article 18

Insolvency proceedings

1. The only insolvency proceedings in which a Community patent may be involved shall be those opened in the Member State within the territory of which the centre of a debtor's main interests is situated.
2. In the case of joint proprietorship of a Community patent, paragraph 1 shall apply to the share of the joint proprietor.
3. Where a Community patent is involved in insolvency proceedings, on request of the competent national authority an entry to this effect shall be made in the Register of Community Patents referred to in Article 56 and published in the Community Patent Bulletin referred to in Article 57.

Article 19

Contractual licensing

1. The Community patent may be licensed in whole or in part for the whole or part of the Community. A licence may be exclusive or non-exclusive.
2. The rights conferred by the Community patent may be invoked against a licensee who breaches any restriction in the licensing contract.

3. Article 15(2) and (3) shall apply to the grant or transfer of a licence in respect of a Community patent.

Article 20

Licences of right

1. The proprietor of a Community patent may file a written statement with the Office that he is prepared to allow any person to use the invention as a licensee in return for appropriate compensation. In that case, the renewal fees for the Community patent which fall due after receipt of the statement shall be reduced; the amount of the reduction shall be fixed in the rules relating to fees referred to in Article 60. Where there is a complete change of proprietorship of the patent as a result of legal proceedings under Article 5, the statement shall be deemed withdrawn on the date of entry of the name of the person entitled to the patent in the Register of Community Patents.
2. The statement may be withdrawn at any time by a written communication to this effect to the Office, provided that no-one has yet informed the proprietor of the patent of his intention to use the invention. Such withdrawal shall take effect from the date of receipt of that communication by the Office. The amount by which the renewal fees were reduced shall be paid within one month after withdrawal; Article 25(2) shall apply, but the six-month period shall start upon expiry of the above period.
3. The statement may not be filed while an exclusive licence is recorded in the Register of Community Patents or a request for the recording of such a licence is before the Office.
4. On the basis of the statement, any person shall be entitled to use the invention as a licensee under the conditions laid down in the implementing regulations referred to in Article 59. A licence obtained under the terms of this Article shall, for the purposes of this Regulation, be treated as a contractual licence.

5. On written request by one of the parties, the Community Patent Court shall determine the appropriate compensation referred to in paragraph 1 or review it if circumstances have arisen or become known which render the compensation determined obviously inappropriate.
6. No request for recording an exclusive licence in the Register of Community Patents shall be admissible after the statement has been filed, unless it is withdrawn or deemed withdrawn.
7. The Member States may not grant licences of right in respect of a Community patent.

Article 21

Grant of compulsory licences

1. The Community Patent Court may grant a compulsory licence for lack or insufficiency of exploitation of a Community patent to any person filing an application four years or later after the patent application was filed and three years or later after the patent was granted if the patent proprietor has not exploited the patent in the Community on reasonable terms or has not made effective and serious preparations to do so, unless he provides legitimate reasons to justify his inaction. In determining the lack or insufficiency of exploitation of the patent, no distinction shall be made between products originating within the Community and imported products.
2. On request, the Community Patent Court may grant a compulsory licence in respect of a first patent to the proprietor of a national or Community patent or to the proprietor of a plant variety right who cannot use his patent (second patent) or his national or Community plant variety right without infringing a Community patent (first patent), provided that the invention or new plant variety claimed in the second patent or plant variety right involves an important

technical advance of considerable economic significance in relation to the invention claimed in the first patent. In the case of a compulsory licence in respect of a dependent patent or plant variety right, the owner of the first patent shall be entitled to a cross-licence on reasonable terms to use the patented invention or protected plant variety.

3. Deleted.
- 3a. In times of crisis or in other situations of extreme urgency, including those relating to a public interest of extreme importance, the Community Patent Court may authorise at the request of a Member State the exploitation of a Community patent.
4. In the case of semi-conductor technology, exploitation shall be possible without the authorisation of the right holder only in the situations set out in paragraph 3a.
5. A licence or exploitation set out in paragraphs 1 and 2 may be granted only if the proposed user has made efforts to obtain authorisation from the patent holder on reasonable commercial terms and conditions, and if such efforts have not been successful within a reasonable period of time. However, the authority granting the licence may derogate from this condition in the situations set out in paragraph 3a. In these situations, the right holder shall be informed as soon as reasonably possible.
6. The detailed rules of application and the procedures to be used for applying the principles set out in this Article shall be laid down in the relevant instruments.

Article 22

Conditions applicable to compulsory licences

1. When granting the compulsory licence under Article 21, the Community Patent Court shall specify the type of use covered and the conditions to be met. The following conditions shall apply:
 - (a) the scope and duration of the exploitation shall be limited to the purpose for which it was authorised;
 - (b) the exploitation shall be non-exclusive;
 - (c) the exploitation shall be non-assignable, except with that part of the enterprise or goodwill which enjoys such use;
 - (d) the exploitation shall be authorised predominantly for the supply of the internal market of the Community ;
 - (e) the Community Patent Court may, on reasoned request, decide to cancel the authorisation, subject to adequate protection of the legitimate interests of the persons so authorised, if and when the circumstances which led to it cease to exist and are unlikely to recur;
 - (f) the licence holder shall pay the right holder adequate remuneration, taking into account the economic value of the authorisation ;
 - (g) in the case of a compulsory licence in respect of a dependent patent or a plant variety right, the exploitation authorised in respect of the first patent shall be non-assignable except with the assignment of the second patent or plant variety right.
2. Deleted.

Article 23

Effects vis-à-vis third parties

1. Legal acts referred to in Articles 16 to 22 concerning a Community patent shall have effects vis-à-vis third parties in all the Member States only after entry in the Register of Community Patents. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights concerning the patent after the date of that act but who knew of the act at the date on which the rights were acquired.
2. Paragraph 1 shall not apply in the case of a person who acquires the Community patent or a right concerning the Community patent by way of transfer of the whole of the undertaking or by any other universal succession.

Article 24

The application for a Community patent as an object of property

1. Articles 9a, 14 to 19 and Article 21(3) to (6), and Article 22 shall apply to the application for a Community patent, whereby it is understood that all references to the Community Patent Register include references to the European Patent Register provided for by the Munich Convention.
2. The rights acquired by third parties in respect of a Community patent application referred to in paragraph 1 shall continue to be effective with regard to the Community patent granted upon that application.

CHAPTER IIa
COMPULSORY TRANSLATIONS OF THE COMMUNITY PATENT

Article 24a

Compulsory translations of the Community patent

1. When the patent is granted, the applicant shall file a translation of all the claims into all the official languages of the Community, unless all Member States which have a given language as their official language or one of their official languages agree to dispense with a translation into that language. The translation shall be filed, at the choice of the applicant, either directly with the Office or via the national patent office of a Member State which makes such provision and which has as its official language or one of its official languages the language of the translation.

Where the translation is filed directly with the Office, the Office shall immediately make it available to the national patent offices of the Member States and to the public by publishing it on its Internet database.

Where the translation is filed via a national patent office, that office shall immediately transmit the translation to the Office, which shall make it available to the national patent offices of the other Member States and to the public by publishing it on its Internet database.

2. The decision of one or more Member States referred to in paragraph 1 to dispense with a translation must be communicated to the Commission in a statement, which it shall publish in the *Official Journal of the European Union*.
3. For the purposes of paragraph 1, if the translations into Community languages other than those required for the granting of the patent under the provisions of the Munich Convention are produced and filed at the Office within a maximum of nine months⁵ of the granting of

⁵ The proposals for amendments to the European Patent Convention should also include a proposal to increase the period provided for in Article 99(1) of the Convention for filing notice of opposition from nine months to **twelve months**.

the patent, under conditions specified by the implementing rules, the holder of the patent may exploit the rights conferred by that patent as from the date of publication of the notice of granting of the patent.

4. If the translations provided for in this Article are not filed within the deadline laid down in paragraph 3, the Community patent shall be deemed to be void ab initio.

Article 24b

Conversion into a European patent designating one or more Member States

1. Deleted.
2. The holder of the patent may, by a request filed with the Office within the time limit laid down in Article 24a(3) and under the conditions specified by the provisions of the Munich Convention, opt for the Community Patent to be converted into a European patent designating one or more Member States.

Article 24c

Effects of inaccurate translations

1. Notwithstanding paragraph 3a of Article 44, an alleged infringer, who in good faith is using or has made effective and serious preparations for using the invention the use of which would not constitute infringement of the patent under the translation referred to in Articles 24a or Article 58 but constitutes infringement according to the language in which the patent was granted, may, in the Member State in the official language of which the inaccurate translation is provided, continue, subject to payment of adequate compensation, the use in question for business purposes within the territory of the Member State concerned, for thirty months from the moment at which a corrected translation has either been notified to him or made available to the public in accordance with the said Articles. This right may not be transferred. Article 10 is not applicable.

2. Where the Member State referred to in paragraph 1 has two or more official languages which are also official languages of the Community, paragraph 1 shall apply to the alleged infringer for the official language of his choice.

Article 24d

Status of the translations

The translations referred to in Articles 24a and 58, which have been carried out by a person authorized under the law of a Member State, shall be deemed in the Community to be in conformity with the original, until proved to the contrary. The presumption can at any time be refuted through a presentation of the original text.

CHAPTER III
RENEWAL, LAPSE AND INVALIDITY OF THE COMMUNITY PATENT

SECTION 1
RENEWAL AND LAPSE

Article 25

Renewal fees

1. Annual renewal fees in respect of Community patents shall be paid to the Office in accordance with the implementing regulations referred to in Article 60. These fees shall be due in respect of the years following the year in which the Community Patent Bulletin referred to in Article 57 mentions the grant of the Community patent.
2. When a renewal fee has not been paid on or before the due date, the fee may be validly paid within six months of that date, provided that an additional fee is paid at the same time.
3. Any renewal fee in respect of a Community patent falling due within two months after the publication of the mention of the grant of the Community patent shall be deemed to have been validly paid if it is paid within the period mentioned in paragraph 2. No additional fee shall be charged in this case.

Article 26

Surrender

1. The Community patent may be surrendered only in its entirety.
2. Surrender must be declared in writing to the Office by the proprietor of the patent. It shall not have effect until it is entered in the Register of Community Patents.
3. Surrender shall be entered in the Register of Community Patents only with the agreement of any third party who has a right *in rem* recorded in the Register or in respect of whom there is an entry in the Register pursuant to Article 5(4), first sentence. If a licence is recorded in the Register, surrender shall be entered only if the proprietor of the patent proves that he has previously informed the licensee of his intention to surrender; this entry shall be made on expiry of the period laid down in the implementing regulations referred to in Article 59, and in accordance with the provisions of the Munich Convention.

Article 27

Lapse

1. The Community patent shall lapse:
 - (a) 20 years after the date of filing of the application;
 - (b) if the proprietor of the patent surrenders it in accordance with Article 26;
 - (c) if a renewal fee and any additional fee have not been paid in due time.
2. The lapse of a patent for failure to pay a renewal fee and any additional fee within the due period shall be deemed to have occurred on the date on which the renewal fee was due.

3. The Office shall record the lapse of the Community patent in accordance with the provisions of the Munich Convention.

Article 27a

Restitutio in integrum

1. The holder of a Community patent who, despite being able to demonstrate that he took all due care under the circumstances, was unable to meet an Office deadline, shall, on request, have his rights restored if the failure to meet the deadline directly resulted, by virtue of the provisions of this Regulation, in the loss of a right or of an avenue of appeal to the Office. The processes of restitutio in integrum laid down in the Munich Convention shall apply.
2. Where the holder of a patent has his rights restored, he may not invoke his rights vis-à-vis a third party who, acting in good faith, began to exploit, or to make effective and serious preparations to exploit in the Community an invention covered by a Community patent during the period between the loss of the right referred to in paragraph 1 and the publication of notification of the restoration of that right.

SECTION 2

INVALIDITY AND LIMITATION OF THE COMMUNITY PATENT

Article 28

Grounds for invalidity

1. The Community patent may be declared invalid only on the grounds that:
 - (a) the subject-matter of the patent is not patentable according to Articles 52 to 57 of the Munich Convention;

- (b) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
 - (c) the subject-matter of the patent extends beyond the content of the patent application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 61 of the Munich Convention, beyond the content of the earlier application as filed;
 - (d) the protection conferred by the patent has been extended;
 - (e) the proprietor of the patent is not entitled under Article 4(1) and (2) of this Regulation;
 - (f) the subject-matter of the patent is not new having regard to the content of a national patent application or of a national patent made public in a Member State on the date of filing or later or, where priority has been claimed, the date of priority of the Community patent, but with a filing date or priority date before that date.
2. If the grounds for invalidity affect the patent only partially, invalidity shall be pronounced in the form of a corresponding limitation of the patent. The limitation may be effected in the form of an amendment to the claims.
 3. In the processes before the courts referred to in Article 30 concerning the validity of the Community patent, the holder of the patent shall be entitled to limit the patent by modifying the claims. The limited patent shall then be the basis for the process.

Article 29

Effects of invalidity

1. The Community patent shall be deemed not to have had, from the outset, the effects specified in this Regulation, to the extent that the patent has been declared invalid either in whole or in part.
2. The retroactive effect of the invalidity of the patent shall not affect:
 - (a) any decision on infringement which has acquired the authority of *res judicata* and been enforced prior to the invalidity decision;
 - (b) any contract concluded prior to the invalidity decision, in so far as it has been performed before that decision. However, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract may be claimed on grounds of equity.

Article 29a

Request for limitation

At the request of the holder of a patent, lodged with the Office, the Community patent may be subject to limitation in the form of an amendment to the claims. The provisions of the Munich Convention relating to the request for limitation shall apply.

CHAPTER IV
JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO THE
COMMUNITY PATENT

SECTION 1
ACTIONS CONCERNING THE VALIDITY AND INFRINGEMENT OF THE PATENT
AND THE USE OF THE INVENTION

Article 30

**Actions and claims relating to the Community patent – Exclusive jurisdiction
of the Court of Justice**

1. The Community patent may be the subject of invalidity or of infringement proceedings, of action for a declaration of non-infringement, of proceedings relating to the use of the invention prior to the granting of the patent or to the right based on prior use of the patent, or of a counterclaim for a declaration of invalidity or of a petition for the grant or revocation of a compulsory licence. It may also be the subject of proceedings or claims for damages or provisional or protective measures or requests for the determination of compensation.

2. In accordance with the decision giving the Court of Justice jurisdiction for matters relating to the Community patent, adopted pursuant to Article 229a of the Treaty, the actions and claims referred to in paragraph 1 shall come under the exclusive jurisdiction of the Court of Justice, except in the case of Article 9a. In accordance with the decision taken pursuant to Article 225a of the Treaty, they shall be brought in the first instance before the Community Patent Court and, on appeal, before the Court of First Instance.

Article 31

Invalidation action

1. Invalidation proceedings against a Community patent may be based only on the grounds for invalidity set out in Article 28(1).
2. Any person or the Commission acting in the Community's interest may initiate invalidity proceedings; however, in the case referred to in Article 28(1)(e), the proceedings may be initiated only by a person entitled to be entered in the Register of Community Patents as the sole proprietor of the patent, or by all the persons entitled to be entered as joint proprietors of it in accordance with Article 5 acting jointly.
3. The proceedings may be brought even if opposition may still be filed or if opposition proceedings are pending before the Office.
4. The proceedings may be brought even if the Community patent has lapsed.

Article 32

Counterclaim for invalidity

1. Counterclaims for invalidity against a Community patent may be based only on the grounds for invalidity set out in Article 28(1).
2. If the counterclaim is brought in a legal action to which the proprietor of the patent is not already a party, he shall be informed thereof and may be joined as a party to the action.

Article 33

Infringement action

1. Actions for infringement may be based only on facts referred to in Articles 7, 8 and 19.
2. The proprietor of the patent may bring an action for infringement. Without prejudice to the provisions of the licensing contract, a licensee may bring proceedings for infringement of a Community patent only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the Community patent, after formal notice, does not himself bring infringement proceedings within an appropriate period.
3. The proprietor of the patent shall be entitled to intervene in infringement proceedings brought by the licensee under paragraph 2.
4. A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement proceedings brought by the proprietor under paragraph 2.

Article 34

Action for declaration of non-infringement

1. Any person may bring proceedings against the patent proprietor or the beneficiary of an exclusive licence in order to apply for a decision that the economic activity he is exercising or exercised, or making effective preparations to exercise or envisaging exercising does not affect the rights referred to in Articles 7, 8 and 19.
2. Deleted.

Article 35

Proceedings relating to use of the invention prior to the grant of the patent

1. Proceedings relating to the use of the invention during the period referred to in Article 11(1) may be brought by the applicant for or proprietor of the patent. Without prejudice to the provisions of the licensing contract, a licensee may bring such proceedings only if the applicant for or proprietor of the patent consents thereto. However, the holder of an exclusive licence may bring such proceedings if the applicant for or proprietor of the Community patent, after formal notice, does not himself bring such proceedings within an appropriate period.
2. The Court may not decide on the merits of a case until notification of the granting of the patent has been published.

Article 36

Proceedings relating to a right based on prior use of the invention

Proceedings relating to the right based on prior use of the patent referred to in Article 12(1) may be brought by the prior user or the person to whom he has transferred his right in accordance with paragraph 2 of that Article, with a view to establishing his right to use the invention in question.

Articles 37- 38 – 39- 40

- Deleted -

Article 41

Extent of jurisdiction

In the proceedings referred to in Articles 33 to 36, the Community courts referred to in Article 30 shall have jurisdiction in respect of acts committed and activities undertaken in a part or in the entirety of the territory, zone or space to which this Regulation applies.

Article 42

Provisional or protective measures

The Community courts referred to in Article 30 may adopt any provisional or protective measure, which may be necessary in accordance with their Statutes or Rules of Procedure. These measures may, for example, include measures to prevent acts of infringement of the right granted by the patent and, in particular, to prevent the introduction in the Community's trade channels of allegedly infringing goods, including goods imported immediately after customs clearance, and measures to safeguard evidence of the alleged infringement, as well as measures suitable for guaranteeing compliance with the above measures, including measures of a pecuniary nature.

Article 43

Orders

Where the Community courts referred to in Article 30, in proceedings referred to in Article 33, find that the defendant has infringed a Community patent, they may issue the following orders:

- (a) an order prohibiting the defendant from continuing with the acts which infringed the patent;
- (b) an order to confiscate the products resulting from the infringement;

- (c) an order to confiscate the goods, materials and implements which constitute the means for putting the protected invention into effect and which have been supplied or offered for supply under the conditions set out in Article 8;
- (d) any order imposing other measures adapted to the circumstances and suitable for guaranteeing compliance with the orders referred to in (a), (b) and (c), including measures of a pecuniary nature.

Article 44

Actions or claims for compensation or damages

1. The Community courts referred to in Article 30 shall have the power to order the payment of compensation for damage underlying the actions referred to in Articles 31 to 36.
2. In determining the appropriate damages, the courts shall take into account all relevant aspects, such as the economic consequences to the injured party of the infringement, as well as the undeserved profits made by the infringer and the behaviour and the good or bad faith of the parties. The damages shall not be punitive.
3. For the purposes of paragraph 2, an alleged infringer who has his residence or principal place of business in a Member State whose official language, which is also an official language of the Community, is not the language in which the patent was granted or in which a translation of the patent claims has been made public in accordance with Article 24a or Article 58, is presumed not to have known nor to have had reasonable grounds for knowing that he was infringing the patent. In such a situation, damages for infringement shall be due only for the period from the time when he is notified of a translation of the patent claims in the official language of the Member State of residence or principal place of business of the alleged infringer.

- 3a The patent holder is not entitled to damages to the extent that, due to an inaccurate translation of the patent claims which has been made public in accordance with Article 24a or Article 58, an infringer did not know and did not have any reasonable grounds to know that he was infringing the patent.
4. Where the Member State referred to in paragraph 3 has two or more official languages which are also official languages of the Community, the infringer shall be entitled to notification in the official language of his choice.

Article 45

Period of limitation

Proceedings relating to use, to the right based on prior use, to infringement and to damages referred to in this section shall be barred after five years have elapsed from the date on which the requesting party became aware of facts justifying proceedings or should have become aware of them and in any case after ten years have elapsed from the infringement.

SECTION 2
JURISDICTION AND PROCEDURE IN OTHER ACTIONS RELATING TO THE
COMMUNITY PATENT

Article 46

Jurisdiction of national courts

The national courts of the Member States shall have jurisdiction in actions relating to Community patents which do not come within the exclusive jurisdiction of the Court of Justice under this Regulation on the basis of conferral made by the decision adopted pursuant to Article 229a of the Treaty.

Article 47

Application of provisions on international jurisdiction and enforcement

Unless otherwise specified in this Regulation, Regulation (EC) No 44/2001 or, where applicable, the Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters, signed at Brussels on 27 September 1968⁶, referred to hereafter as "the Convention on Jurisdiction and Enforcement", shall apply to actions brought before the national courts and to decisions given in respect of such actions.

Article 48

Proceedings relating to the right to a patent between an employer and an employee

1. By way of derogation from the provisions applicable under Article 47, the courts of the Member State under whose law the right to a Community patent is determined in accordance with Article 4(2) shall have exclusive jurisdiction in proceedings relating to the right to a patent over which an employer and an employee are in dispute.

⁶ OJ C 27, 26.1.1998, p. 3.

2. Any agreement conferring jurisdiction shall be valid only if it is entered into after the dispute has arisen or if it allows the employee to bring proceedings in courts other than those which would have jurisdiction under paragraph 1.

Article 49

Actions relating to the levy of execution on the Community patent

1. By way of derogation from the provisions applicable under Article 47, the courts and authorities of the Member State determined under Article 14 shall have exclusive jurisdiction in proceedings relating to the levy of execution on a Community patent.
2. and 3. Deleted.

Article 50

Supplementary provisions on jurisdiction

1. Within the Member State whose courts have jurisdiction under Article 47, those courts shall have jurisdiction which would have jurisdiction *ratione loci* and *ratione materiae* in the case of actions relating to national patents granted in that State.
2. Actions relating to the Community patent for which no court has jurisdiction under Articles 47 and 48 and paragraph 1 of this Article may be heard before the courts of the Member State in which the European Patent Organisation has its seat.
3. The provisions of this Section shall apply to actions relating to patent applications, save to the extent that the right to obtain the patent is claimed. In this situation, the Protocol on the jurisdiction, recognition and enforcement of judgments in respect of the right to the grant of a European patent annexed to the Munich Convention shall apply.

Article 51

Obligations of the national court

1. A national court hearing an action or application referred to in Article 30 shall declare of its own motion that it has no jurisdiction, except in the case of Article 9a.
2. A national court hearing an action or claim relating to a Community patent other than the actions referred to in Article 30 shall treat the patent as valid unless it has been declared invalid by the Community Patent Court in a decision which has the authority of res judicata.
3. A national court hearing an action or claim relating to a Community patent other than the actions referred to in Article 30 shall stay the proceedings if it considers a decision on an action or application referred to in Article 30 to be a prior condition for its judgment. Proceedings shall be stayed either by the court of its own motion, after hearing the parties, where an action or application referred to in Article 30 has been brought before the Community Patent Court, or at the request of one of the parties, and after hearing the other parties, where proceedings have not yet been brought before the Community court. In the latter case, the national court shall invite the parties to bring such proceedings within a period prescribed by it. If such proceedings are not brought within the prescribed period, the proceedings before the national court shall continue.

Article 52

Applicable law of procedure

Unless otherwise provided in this Regulation, a national court shall apply the rules of procedure governing the same type of action relating to a national patent in the Member State in which it is situated.

SECTION 3

ARBITRATION

Article 53

Arbitration

The provisions of this Chapter relating to jurisdiction and judicial procedure shall be without prejudice to the national arbitration rules of the Member States. However, a Community patent may not be declared invalid or be invalidated in arbitration proceedings.

SECTION 4

ACTIONS RELATING TO VALIDITY AND INFRINGEMENT OF THE PATENT AND TO THE USE OF THE INVENTION DURING THE TRANSITIONAL PERIOD

Article 53a

Legal jurisdiction during the transitional period

1. Notwithstanding the provisions of Section 1 of this Chapter, and until the system of Community jurisdiction referred to in Article 30 has been put into place, by 1 January 2010 at the latest, competence to hear the legal actions referred to in Section 1 of this Chapter shall be governed by the provisions of this Section.
2. The date on which the Community courts referred to in Article 30 shall commence their activities shall be published by the Commission in the Official Journal of the European Union. Legal actions referred to in Section 1 of this Chapter and begun prior to that date shall be brought before the national courts, in accordance with the provisions of this Section.

3. By derogation from paragraph 2, during the period referred to in paragraph 1 the Commission shall have competence:
 - (a) to determine or review compensation in accordance with Article 20(5);
 - (b) to grant compulsory licences or authorise exploitation in accordance with Article 21.

Article 53b

Jurisdiction during the transitional period

1. Each Member State shall designate the smallest possible number of national courts of first instance and of second instance, which shall be entrusted with the task of performing the functions assigned to them by this Section.
2. Each Member State shall communicate to the Commission, by 31 December 2005 at the latest, a list of the national courts, indicating their names and their territorial jurisdiction.
3. Any change occurring after the communication referred to in paragraph 2 relating to the number, names or territorial jurisdiction of the said courts shall be communicated to the Commission by the Member State concerned without delay.
4. The information referred to in paragraphs 2 and 3 shall be communicated to the Member States by the Commission and shall be published in the Official Journal of the European Union.

5. Until such time as a Member State has communicated the information referred to in paragraph 2, any procedure resulting from an action or application referred to in Article 30 and for which the courts of that Member State have jurisdiction pursuant to Article 53c and 53d, shall be brought before the court of that Member State which would have had territorial jurisdiction and competence to decide on the action or application if the procedure had concerned a national patent of the Member State in question.

Article 53c

**Application of provisions on international jurisdiction and enforcement
during the transitional period**

Save where this Regulation provides otherwise, the provisions of Regulation (EC) No 44/2001 or, where applicable, the Convention on Jurisdiction and Enforcement shall be applicable to actions concerning Community patents, and to decisions handed down on those actions.

Article 53d

International jurisdiction during the transitional period

1. Subject to the provisions of this Regulation and to any provisions of Regulation (EC) No 44/2001 or, where applicable, the provisions of the Convention on Jurisdiction and Enforcement applicable by virtue of Article 53c, proceedings in respect of the actions and claims referred to in Article 30 of this Regulation shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.
2. If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.

3. If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the European Patent Organisation has its seat.
4. Notwithstanding paragraphs 1, 2 and 3:
 - (a) Article 23 of Regulation (EC) 44/2001 or, where applicable, Article 17 of the Convention on Jurisdiction and Enforcement shall apply if the parties agree that a court in a different Member State shall have jurisdiction;
 - (b) Article 24 of Regulation (EC) 44/2001 or, where applicable, Article 18 of the Convention on Jurisdiction and Enforcement shall apply if the defendant enters an appearance before a court of a different Member State.
5. Proceedings in respect of the actions and claims referred to in Article 30 of this Regulation, except actions and claims for a declaration of invalidity, may also be brought in the courts of the Member State in which the act of infringement has been committed.

Article 53e

Extent of jurisdiction during the transitional period

1. A court whose jurisdiction is founded on Article 53d, points a) to e), shall be competent to decide on the facts of an infringement committed in the territory of any Member State.
2. A court whose jurisdiction is founded on Article 53d, point f), shall be competent to decide only on the facts of an infringement committed in the territory of the Member State in which the court is located.

Article 53f

Presumption of validity - defence on the merits

In proceedings resulting from actions against infringement of a Community patent, the courts shall consider the Community patent to be valid. Validity may only be contested by a counterclaim for a declaration of invalidity. Nevertheless, a plea for the invalidity of the Community patent entered other than by a counterclaim shall be admissible to the extent that the defendant can demonstrate the Community patent could be declared invalid on grounds of a national right previously granted to the defendant within the meaning of Article 28(1)(f).

Article 53g

Effects of a decision on invalidity during the transitional period

Where a court decision to the effect that a Community patent is invalid has become enforceable, it shall produce the effects referred to in Article 29 of this Regulation in all the Member States according to the provisions of Regulation (EC) No 44/2001 or, where applicable, the Convention on Jurisdiction and Enforcement.

Article 53h

Applicable law during the transitional period

1. The courts shall apply the provisions of this Regulation.
2. The court shall apply its national laws, including its international private law, to all matters falling outside the scope of this Regulation.
3. Save where this Regulation provides otherwise, the court shall apply the rules of procedure applicable to the same type of procedure relating to national patents in the territory in which that court is located.

Article 53i

Jurisdiction in the second instance – further appeal - during the transitional period

1. Decisions of the courts resulting from the actions and applications referred to in this Section shall be subject to appeal before the courts of second instance.
2. The conditions under which an appeal may be brought before a court of second instance shall be determined by the national law of the Member State in whose territory that court is located.
3. Decisions of the courts of second instance shall be governed by national provisions on further appeals.

CHAPTER V

IMPACT ON NATIONAL LAW

Article 54

Prohibition of simultaneous protection

1. Where a national patent granted in a Member State relates to an invention for which a Community patent has been granted to the same inventor or to his successor in title with the same date of filing, or, if priority has been claimed, with the same date of priority, that national patent shall be ineffective to the extent that it covers the same invention for the same territory as the Community patent, from the date on which:
 - (a) the period for filing an opposition to the decision of the Office to grant a Community patent has expired without any opposition being filed;
 - (b) the opposition proceedings are concluded with a decision to maintain the Community patent;or

- (c) the national patent is granted, where this date is subsequent to the date referred to in point (a) or (b), as the case may be.
2. The subsequent lapse or invalidity of the Community patent shall not affect the provisions of paragraph 1.
 3. Each Member State may prescribe the procedure whereby the effect of the national patent is determined to have been lost in whole or, where appropriate, in part. It may also prescribe that the loss of effect shall apply from the outset.
 4. Simultaneous protection by a Community patent or Community patent application and a national patent or national patent application shall exist prior to the date applicable under paragraph 1.

Article 55

Deleted.

**CHAPTER VI
FINAL PROVISIONS**

Article 56

Register of Community Patents

The Office shall keep a Register of Community Patents, which shall contain those particulars whose registration is provided for by this Regulation. The Register shall be open to public inspection.

Article 57

Community Patent Bulletin

The Office shall periodically publish a Community Patent Bulletin. It shall contain entries made in the Register of Community Patents, as well as other particulars whose publication is prescribed by this Regulation or by the implementing regulation.

Article 58

Optional translations

The proprietor of the patent shall have the option of producing and filing a translation of his patent in several or all of the official languages of the Member States which are official languages of the Community. Such translations may be filed with the Office, or with a National Patent Office of a Member State if that Member State's law so permits. National Patent Offices shall transmit a copy of such translations to the Office. The Register of Community Patents shall contain a mention of the filing of such translations. Those translations shall be made available to the public by the National Patent Offices and the Office by publishing them on their Internet databases.

Article 59

Implementing regulation

1. The rules implementing this Regulation shall be adopted in an implementing regulation.
2. The implementing regulation shall be adopted and amended in accordance with the procedure laid down in Article 61(2).

Article 60

Rules relating to fees

1. The rules relating to fees shall determine the annual renewal fees, including additional fees, the amounts of the fees and the ways in which they are to be paid.
- 1a. Fifty per cent of the income from renewal fees shall be distributed among the central industrial property offices of the Member States in accordance with a distribution key mentioned in the rules relating to fees. The distribution key will be based on a basket of fair, equitable and relevant criteria. Such criteria should reflect patent activities and the size of the market. In addition, considering the role to be played by National Patent Offices, a balancing factor should also be applied where Member States have a disproportionately low level of patent activities. On the basis of these criteria the Member States' share shall be adjusted periodically to current figures.
2. The rules relating to fees shall be adopted and amended in accordance with the procedure referred to in Article 61(2). However, the distribution key referred to in paragraph 1a shall be adopted and amended by the Council of the European Union acting unanimously.

Article 61

Establishment of a committee and procedure for the adoption of the implementing regulations

1. The Commission shall be assisted by a committee, the Committee for issues relating to fees and to the rules for the implementation of the Regulation on the Community patent, composed of representatives of the Member States and chaired by the representative of the Commission.
2. Where reference is made to this paragraph, the regulatory procedure laid down in Article 5 of Decision 1999/468/EC shall apply, in compliance with Article 7 thereof.
3. The period provided for in Article 5(6) of Decision 1999/468/EC shall be three months.

Article 62

Report on the implementation of this Regulation

Not later than five years from the date on which the first patent designating the Community is granted, the Commission shall present to the Council a report on the operation of the Community patent system and where necessary make appropriate proposals for amending this Regulation. The report shall include assessments of quality and consistency, the deadlines required for decisions, the time limit for the filing of translations of claims and the costs incurred by inventors. Subsequent reports on the operation of the Community patent system shall be presented by the Commission every five years.

Article 63

Entry into force

1. This Regulation shall enter into force on the sixtieth day following that of its publication in the *Official Journal of the European Union*.
2. Applications for a Community patent may be filed with the Office from the date laid down in a Commission Decision in accordance with the procedure referred to in Article 61(2).

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels,

For the Council

The President

New concept Article

Effects of translations

- (1) In applying the provisions of Articles 42, 43 and 44 to cases involving an alleged infringer who has his residence or principal place of business in a Member State, the Community courts referred to in Article 30 shall, at the request of the alleged infringer, take into account any discrepancies which arise between the text of the patent as granted and the translation filed in the official language of that Member State or, in the case where that Member State has more than one official language, the official language relied on by the alleged infringer.
- (2) The courts shall take into account, in particular,
 - (a) whether the alleged infringer can prove that he did not know and, having acted in accordance with best business practice, had no reasonable grounds for knowing that any activity he was undertaking or preparing to undertake would infringe an existing patent or patent application, and
 - (b) whether the discrepancies between the translation and the text of the patent as granted had a significant effect on his activity.
- (3) On the basis of their findings, the courts may mitigate the award of compensation or damages and may in addition, allow the alleged infringer to continue use of the invention within the Member State concerned for a period of up to two years on payment of reasonable compensation to the right holder.
- (4) Paragraphs 1 to 3 shall apply *mutatis mutandis* where the Community courts referred to in Article 30 apply the provisions of Article 11.

New recitals

(5aa) (between 5 and 5a)

Some Member States have systems for authorised translators which may offer applicants and patent proprietors greater security against possible inaccuracies in the translation of their patents. However no applicant or proprietor is obliged to use such an authorised translator, and no Member State is required to introduce such a system. Moreover the principles of freedom to provide services and freedom of establishment as enshrined in Articles 43 and 49 of the Treaty should be upheld.

(8a) It is important for the protection of the legitimate interests of third parties that the court ruling on infringement and validity can take into account discrepancies between the translation of a patent and the original text, where these have a significant effect on the activities of an alleged infringer. At the same time, it is expected as a principle of best business practice that commercial operators will have access to the information and assistance available through national patent offices and other sources of advice, and will be encouraged to make informed business decisions by taking account of existing patents and patent applications which may be relevant to their activities. This will lead to an increased awareness of the availability and use of patents, thereby helping to foster investment in innovation and research.

(8b) As the courts ruling on infringement and validity will be able to take into account all the circumstances of the case, including translation discrepancies, they may decide that in a particular case the award of compensation or damages shall be reduced to zero or a nominal amount, and similarly that reasonable compensation due on continued use of an invention may amount to zero or a nominal amount.

(8c) In the case where a court allows an alleged infringer to continue use of the invention, the principle of Community exhaustion cannot apply to goods produced through such use because they will not be products which have been put on the market by the proprietor or with his consent. The goods may therefore not be commercialised outside the Member State in question. Furthermore it is inherent in the court's decision to allow the infringer to continue such use that the permission extends only to the alleged infringer and not to other persons.

The Council of the European Union



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Industrial property: Commission proposes establishing Community Patent Court

Reference: IP/04/137 Date: 02/02/2004

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IP/04/137

Brussels, 2nd February, 2004

Industrial property: Commission proposes establishing Community Patent Court

The European Commission has presented proposals for two Council Decisions establishing a Community Patent jurisdiction, under the aegis of the European Court of Justice, to allow the resolution of disputes within the future Community Patent system, in particular those on infringements and on the validity of Community Patents. Under the proposals, the jurisdiction of the Court of Justice would be exercised by a new Community Patent Court. The new system would mean that judgements over Community Patent rights would be effective throughout the EU, avoiding the expense, inconvenience and confusion that can occur when judgements in several different national courts are required.

Internal Market Commissioner Frits Bolkestein said: "To maximise the benefits of the Community Patent, we need a single Community Patent Court, under the ultimate jurisdiction of the European Court of Justice, so that disputes are judged with EU-wide effect. I am confident the Council will adopt the necessary decisions quickly, as broad agreement in principle was already reached at the March Competitiveness Council. But of course, setting up the jurisdictional arrangements without finalising adoption of the Community Patent Regulation itself is about as useful as a new pair of skis in the desert. So above all I hope the Council will agree on the final points of detail on the Community Patent still at issue and adopt the Regulation. Europe's companies have been crying out for too long for access to pan-European patent protection at reasonable cost with minimum red-tape and maximum legal certainty."

The first proposal presented by the Commission would confer on the Court of Justice formal jurisdiction concerning certain disputes over Community Patents, in particular those concerning alleged infringements of patents and challenges to the validity of patents. The second

proposal would establish the Community Patent Court, whose seven judges would be appointed by the Council of Ministers, to exercise the Court of Justice's jurisdiction on its behalf. It also sets up a specialised chamber within the Court of First Instance to hear appeals against the Community Patent Court's judgements. In exceptional cases, a decision of the Court of First Instance could be subject to review by the Court of Justice.

Disputes on national patents or on European Patents granted by the European Patent Office with effect for individual Member States are decided by the courts of the respective Member States. This means that bringing an action for infringement of a patent or contesting the validity of a patent may require bringing actions in a number of Member States, with all the difficulties and expense that entails. It is also possible that courts in different Member States may interpret patent law differently and reach incompatible verdicts.

To provide a less wasteful and costly system, the Community Patent Court would operate according to a single set of procedural rules, with a uniform case law and with costs affordable for users and in particular for SMEs. Thus, the jurisdiction regime proposed would ensure that disputes over Community Patent rights were judged with EU-wide effect by a single centralised and specialised court. That would provide legal certainty for the protection of inventions throughout the Union.

Background

The legal basis for the establishment of the Community Patent jurisdiction was introduced into the EC Treaty by the Treaty of Nice (Article 229a of the EC Treaty for the conferral of jurisdiction on the Court and Article 225a of the EC Treaty for the establishment of the Community Patent Court).

The creation of the Community Patent system itself aims to make it cheaper and easier to protect new inventions in all EU Member States, with a single procedure. It will thus remove a competitive handicap suffered by Europe's innovators and stimulate investment in research and development. The Commission tabled its proposal for a Regulation setting up the Community Patent in July 2000 (see IP/00/714 and MEMO/00/41). In March 2003, the Council finally reached a broad political agreement on the main thrust of the proposal (see MEMO/03/47). After detailed work by a Council working group, the Competitiveness Council, very close to an agreement on the outstanding issues at its meeting November 2003 meeting (see MEMO/03/245) nevertheless failed to agree on the length of the period under which translations of claims can be filed. The Irish Presidency now intends to bring the matter back before the Council as soon as possible so that the entire Regulation can be finalised.



COMMISSION OF THE EUROPEAN COMMUNITIES

Brussels, 23.12.2003
COM(2003) 827 final

2003/0326 (CNS)

Proposal for a

COUNCIL DECISION

**conferring jurisdiction on the Court of Justice in disputes relating to the Community
patent**

(presented by the Commission)

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EXPLANATORY MEMORANDUM

1. BACKGROUND

In the Community, patent protection has long been provided for in two ways, neither of which is based on a Community instrument: National patents are granted by national patent offices on the basis of legislation of the respective Member State. The protection conferred is limited to the territory of that Member State and in case of dispute the patent right has to be enforced before the competent national courts. European patents are granted by the European Patent Office established by the Convention on the Grant of European Patents (European Patent Convention) of 5 October 1973 providing for substantive patent law and a single procedure of grant. Once granted, the European patent confers protection on the territory of those Contracting States which are designated by the right holder. Whereas the harmonised patent law of the European Patent Convention is essentially limited to the phase up to the grant of the European patent, its effects are determined according to the respective national patent law of each designated Contracting State. In case of dispute, litigation must also take place before the competent national courts. This situation, where the patent right is only granted in or with effect for individual Member States of the European Union including for the right holder the risk to be forced to enter into multiple litigation in a number of Member States on the same patent issue with possibly even variable results has long been criticised as inappropriate and unsuitable for the needs of the European industry operating within the common market. Member States have already in the past undertaken great efforts to redress this situation in a Community context. The Community Patent Convention intending to create a unitary Community patent title was signed on 15 December 1975 in Luxembourg followed by the 15 December 1989 agreement relating to the Community patent including a protocol on the settlement of litigation concerning the infringement and validity of Community patents. However these agreements never entered into force.

2. THE COMMUNITY PATENT

The European Council held in Lisbon in March 2000 launched a general programme to increase the competitiveness of the Union's economy and took up the issue again. As one concrete measure for improvement, the Council called for the creation of a Community patent system to address existing shortcomings in the legal protection for inventions thus giving an incentive for investments in research and development and contributing to the competitiveness of the economy as a whole. In the wake of the Lisbon European Council, the Commission put forward on 1 August 2000 a proposal for a Council regulation on the Community patent [COM(2000) 412 final] containing the relevant provisions applying to Community patents, in particular the provisions for the creation of a unitary Community patent title including the rights conferred by it, the possible actions for the enforcement of these rights, the grounds for invalidity as well as the mechanisms for the administration of granted Community patents such as their yearly renewal. It is foreseen that the grant of Community patents will be carried out by the European Patent Office. For this purpose the Community must accede to the European Patent Convention thereby charging the European Patent Office with the task of granting Community patents. Thus the European Patent Office will grant European and Community patents according to the same standards

of the European Patent Convention ensuring uniformity and legal security of patent law in Europe. At the same time the European Patent Office's high expertise as an examining patent office can be put to use for the Community patent.

3. THE COMMUNITY PATENT JURISDICTION

The establishment of a Community patent jurisdiction is a key element of the Community patent system. The Community patent title covering the territory of all Member States will not only be governed by the uniform provisions of Community law contained in the regulation of the Council on the Community patent. It will, at the latest by 2010, after a transitional period during which national courts will retain jurisdiction for the subject matter, also be enforceable before a Community jurisdiction whose decisions enjoy Community wide effect.

The legal basis to be used for the establishment of a Community patent jurisdiction was introduced into the EC Treaty by Article 2 (26 ff.) of the Treaty of Nice amending the Treaty on European Union, the Treaties establishing the European Communities and certain related acts which entered into force on 1 February 2003, inserting Article 229a and Article 225a into the EC Treaty. It is proposed that the Community patent jurisdiction will be established by two Council decisions based on those Articles.

In order for the Court of Justice to assume jurisdictional responsibilities with regard to the Community patent, that jurisdiction must be conferred on it. Article 229a of the EC Treaty allows the Council to adopt provisions to confer jurisdiction to the extent that it shall determine on the Court of Justice in disputes relating to the application of acts adopted on the basis of the EC Treaty which create Community industrial property rights. The present decision sets out that conferral of jurisdiction with regard to the Community patent and at the same time specifying the extent of the conferral (Articles 1 and 2). As provided for by Article 229a of the EC Treaty the Council shall recommend the provisions conferring jurisdiction on the basis of that Article to the Member States for adoption in accordance with their respective constitutional requirements (Article 3).

The Commission put before the Council a separate proposal for a decision based on Articles 225a, 245 of the EC Treaty proposing the establishment of a judicial panel to be called "Community Patent Court" which would, within the Court of Justice, exercise at first instance the jurisdiction in disputes relating to the Community patent. That decision also contains the necessary provisions with a view to accommodating the new function of the Court of First Instance as appeal instance according to Article 225(2) of the EC Treaty against decisions of the Community Patent Court.

4. TRANSITIONAL PERIOD

As agreed by the Council in its 3 March 2003 common political approach, the Community jurisdiction shall be established at the latest by the year 2010. Until that time national courts of Member States will have jurisdiction. This would be relevant for those Community patents which come into effect before the establishment of the Community patent jurisdiction. The Community patent regulation will contain special provisions governing this transitional period. It is foreseen that each Member

State designates for this purpose a limited number of national courts to exercise the jurisdiction which will at the end of the transitional period be conferred on the Court of Justice. According to Article 2 of the present decision, legal actions of which national courts have been seised at the time when the conferral of jurisdiction on the Court of Justice will take effect will be decided by the competent national courts.

5. NEED FOR A COMMUNITY INTERVENTION

The present decision relating to jurisdictional aspects of the Community patent system intends to redress the existing shortcomings of the current situation of patent protection in the Union. The objective is to establish Community wide patent protection which can be enforced before one single court operating to uniform standards. This objective can only be achieved at a Community level.

6. PROPOSED PROVISIONS

Article 1 – Conferral of jurisdiction on the Court of Justice

This Article contains the subject matter for which exclusive jurisdiction is conferred on the Court of Justice.

Under point (a), the Court of Justice shall have jurisdiction in disputes relating to the infringement and the validity of the Community patent. Which actions relating to those disputes are allowed will be governed by the Community patent regulation. The draft Community patent regulation foresees in this respect an action to stop infringement (Articles 33, 43) as well as an action for the declaration of non-infringement (Article 34). The Court may also order the confiscation of infringing items or other appropriate penalties (Article 43). Concerning the validity of a Community patent, the draft regulation provides for an invalidity action (Article 31) and a counter claim for invalidity (Article 32).

Where a Community supplementary protection certificate extending the period of protection of an invention protected by a Community patent has been granted, disputes relating to its infringement or validity shall also come under the jurisdiction of the Court of Justice. In this regard, the Commission intends to come forward with a proposal for the creation of a Community supplementary protection certificate extending the protection conferred by Community patents in the way as is the case for national patents under Council regulation (EEC) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products [OJ L 182, 2.7.1992, pp. 1-5] and regulation (EC) No 1610/96 of the European Parliament and the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products [OJ L 198, 8.8.1996, pp. 30-35].

Under point (b), jurisdiction is conferred for disputes relating to the use of the invention after the publication of the Community patent application and the right based on prior use of the invention. In that respect, the draft Community patent regulation allows a claim for reasonable compensation against any person who, in the period between the publication of the Community patent application and the grant of the Community patent, has made such use of the invention that would be prohibited by virtue of the granted Community patent (Articles 11, 35). Furthermore the draft

Community patent regulation provides for a right based on the prior use of the invention (Articles 12, 36). Where the invention was used before the filing date of a Community patent, the prior user has the right to continue use of the invention for his business purposes and may invoke this right against the Community patent or a Community supplementary protection certificate.

Under point (c), jurisdiction is also conferred with regard to interim measures in the subject matter conferred. To the extent that the Court of Justice has jurisdiction relating to the Community patent, circumstances may require appropriate interim measures to be ordered under Article 243 of the EC Treaty before a decision in main proceedings can be made. The conferral of jurisdiction for interim measures is not limited to orders of interim measures in pending cases making such orders possible even before main proceedings are brought. Also, the Court of Justice shall have jurisdiction for evidence-protection measures which will be provided for in the context of the Commission proposal for a Council decision establishing the Community Patent Court and concerning appeals before the Court of First Instance.

Under point (d), jurisdiction is conferred to award damages or compensation in the situations for which jurisdiction is conferred under number one to three of this Article. Claims falling into this category are granted in Article 44 of the draft Community patent regulation awarding e.g. claims for damages of the holder of the Community patent in particular in the case of an infringement of a Community patent but also claims of third parties against the right holder where the latter has unduly exercised his rights and caused prejudice to those parties. Finally, in the context of the Commission proposal for a Council decision establishing the Community Patent Court and concerning appeals before the Court of First Instance, a claim for compensation for injuries caused by provisional or evidence-protection measures is foreseen.

Under point (e), jurisdiction is conferred for orders of a penalty payment in case of non-compliance with a decision or order of the Community Patent Court constituting an obligation to act or to abstain from an act. The Community Patent Court itself should be able to order such a penalty payment for non-compliance with its decisions or orders. If for example the Community Patent Court orders a defendant to stop infringement, it should at the same time be able to make an order whereby the non-compliance would be sanctioned by an obligation to pay a certain sum of money. If such an order necessitated a separate application to the courts of Member States, valuable time could be lost in ensuring that the decision of the Community Patent Court is respected.

In so far as this decision does not confer jurisdiction on the Court of Justice, national courts retain their jurisdiction. Article 46 of the draft Community patent regulation clarifies in this regard that national courts remain competent for any action for which exclusive jurisdiction is not conferred on the Court of Justice which for example is the case in disputes concerning the ownership of a Community patent.

Article 2 – Transitional provision

Article 2 contains a transitional provision relating to the extent of the conferral of jurisdiction. The Community jurisdiction will only be established after a transitional period in which national court shall have jurisdiction. The question arises to what extent the conferral of jurisdiction on the Court of Justice will apply with regard to

disputes already existing at the time when the conferral takes effect. Article 2 provides for a clear cut rule that those disputes of which a national court has been seised prior to the conferral of jurisdiction on the Court of Justice will not be affected by the conferral. Consequently they will be decided by the respective national court before which the case is already pending.

Article 3 – Adoption by Member States

In Article 3, the Council recommends the provisions conferring jurisdiction as contained in Articles 1 and 2 of this decision to Member States for adoption in accordance with their respective constitutional requirements as foreseen in Article 229a of the EC Treaty. For reasons of transparency and in order for the Council to monitor developments, Member States shall notify the Council as soon as possible of necessary measures to be taken and of their adoption.

Article 4 – Entry into force

This Article governs the entry into force of this decision and with it the conferral of jurisdiction on the Court of Justice as laid down by it. The entry into force is made dependent on two events. The first condition is the notification by Member States of their acceptance of the conferral after adoption in accordance with their respective constitutional requirements as foreseen in Article 229a of the EC Treaty and Article 3 of the present decision. However, once Member States have effected that notification, the decision cannot automatically enter into force conferring the jurisdiction from Member States on the Court of Justice. The Council has agreed in its 3 March 2003 common political approach that national courts shall have jurisdiction in a transitional period where Community patents will already be granted but where the Community jurisdiction to be established at the latest by 2010 has not yet been created. In order to avoid a situation where there are granted Community patents but no competent jurisdiction before which rights can be enforced, the conferral of jurisdiction must not happen at a point in time where the Community jurisdiction is not yet operational. Hence, the entry into force of the present decision should secondly depend on a ruling published by the President of the Court of Justice in the Official Journal of the European Communities that the Community Patent Court and the patent appeal chamber within the Court of First Instance have been constituted in accordance with law.

Proposal for a

COUNCIL DECISION

conferring jurisdiction on the Court of Justice in disputes relating to the Community patent

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 229a thereof,

Having regard to the proposal from the Commission¹,

Having regard to the opinion of the European Parliament²,

Having regard to the opinion of the European Economic and Social Committee³,

Whereas:

- (1) The European Council held in Lisbon in March 2000 called for the necessary steps to be taken to increase the competitiveness of the European Union in a modern knowledge based economy underlining the importance of effective Community-wide patent protection.
- (2) The system of patent protection has been characterised by patents granted either by a national patent office in a Member State or by the European Patent Office with effect in a Member State, and by enforcement of those patents before the national courts of the Member State concerned.
- (3) Innovative European industry relies on effective Community-wide legal protection for its inventions. The creation of a Community patent system comprising a unitary Community patent title and the possibility of enforcing such a right before a Community jurisdiction to be established at the latest by 2010 after a transitional period in which national courts retain competence will provide the missing elements for the system of patent protection in the Union.
- (4) Council Regulation (EC) No .../2003 of ... 2003 on the Community patent⁴ creates a Community patent title. Holders of such a title enjoy Community-wide protection of an invention according to the uniform standards of that Regulation.

¹ OJ C
² OJ C
³ OJ C
⁴ OJ L

- (5) The Court of Justice should be vested with jurisdiction in certain disputes relating to Community patents.
- (6) The jurisdiction conferred on the Court of Justice is to be exercised by the Community Patent Court by virtue of Council Decision No .../2003⁵, adopted on the basis of Articles 225a and 245 of the Treaty. Those Articles allow for the establishment of judicial panels attached to the Court of First Instance to hear and determine at first instance certain classes of action brought in specific areas.
- (7) By virtue of Article 225(2) of the Treaty, the Court of First Instance has jurisdiction to hear and determine actions and proceedings brought against decisions of the judicial panels set up under Article 225a of the Treaty. Decisions given by the Court of First Instance on appeal against decisions of the Community Patent Court may, exceptionally, pursuant to Article 225(2) of the Treaty, be subject to review by the Court of Justice, where there is a serious risk to the unity or consistency of Community law,

HAS DECIDED AS FOLLOWS:

Article 1

Conferral of jurisdiction on the Court of Justice

The Court of Justice shall have exclusive jurisdiction over the following:

- (a) infringement or validity of a Community patent and a Community supplementary protection certificate;
- (b) the use of the invention after the publication of the Community patent application or the right based on prior use of the invention;
- (c) interim and evidence-protection measures in connection with the subject matters conferred;
- (d) damages or compensation in the circumstances set out in points (a), (b), and (c);
- (e) the ordering of a penalty payment in case of non-compliance with a decision or order constituting an obligation to act or to abstain from an act.

Article 2

Transitional provision

The Court of Justice shall not have jurisdiction over those disputes of which a national court is already seised on the date at which this Decision enters into force.

⁵ OJL

Article 3

Adoption by Member States

The Council recommends the provision contained in Articles 1 and 2 of this Decision to the Member States for adoption in accordance with their respective constitutional requirements. Member States shall notify the Council as soon as possible of the measures to be taken and their adoption.

Article 4

Entry into force

This Decision shall enter into force after the notification to the Council by the last Member State of its acceptance of this Decision on the date of the publication in the *Official Journal of the European Union* of the ruling by the President of the Court of Justice that the Community Patent Court and the patent appeal chamber within the Court of First Instance have been constituted in accordance with law.

Done at Brussels, [...]

For the Council
The President
[...]

LEGISLATIVE FINANCIAL STATEMENT

Policy area(s): Industrial property

Activity: Creation of the Community patent jurisdiction

TITLE OF ACTION: PROPOSAL FOR A COUNCIL DECISION CONFERRING JURISDICTION ON THE COURT OF JUSTICE IN DISPUTES RELATING TO THE COMMUNITY PATENT

1. BUDGET LINE(S) + HEADING(S)

The Community patent jurisdiction is created by two Council decisions. The present decision, based on Article 229a of the EC Treaty, confers jurisdiction relating to the Community patent on the Court of Justice. The second decision, based on Articles 225a, 245 of the EC Treaty and for which the Commission tables a separate proposal, will contain the necessary provisions establishing the Community Patent Court and concerning appeals before the Court of First Instance. The budgetary consequences will follow from that second decision causing human resources and other administrative expenditures. Judges, the registrar, assistant rapporteurs and other staff have to be appointed, court rooms, office space and equipment must be provided for. The present proposal, however, exclusively deals with the conferral of jurisdiction on the Court of Justice and does not itself engage the budget of the Community. It will only enter into force once the court system has been set up, i.e. on the date of the publication of the ruling of the President of the Court of Justice that the Community Patent Court and the patent appeal chamber of the Court of First Instance have been constituted in accordance with law.

Consequently, the present proposal does not contain any figures on the financial implications of the Community patent jurisdiction. These detailed figures are contained in the legislative financial statement in the annex to the Commission proposal for a Council decision establishing the Community Patent Court and concerning appeals before the Court of First Instance.

2. OVERALL FIGURES

Not applicable (see no 1).

3. BUDGET CHARACTERISTICS

Not applicable (See no 1).

4. LEGAL BASIS

Article 229a of the EC Treaty.

5. DESCRIPTION AND GROUNDS

5.1. Need for Community intervention

5.1.1. Objectives pursued

The proposed Council Decision is part of the overall project to establish the Community patent system. By way of a revision of the European Patent Convention and an accession of the Community to it, the European Patent Office shall be empowered to grant Community patents which will confer rights on their holders according to the Regulation of the Council on the Community patent. Disputes concerning in particular the infringement and the validity of these rights shall, after a transitional period, be brought before a Community jurisdiction. These measures shall reform the system of patent protection in Europe which has been characterised by national patent titles to be enforced before national courts and make the necessary adaptations for the needs of the European industry which increasingly operates trans-nationally within the common market. The measures are designed to increase the competitiveness of the Union's innovative industries by creating a Community-wide uniform patent protection which can be enforced before a single Community jurisdiction rendering decisions with Community-wide effect.

Within this overall project, the Community patent jurisdiction shall be created by two Council decisions. The Commission presented a separate proposal for the establishment of a Community Patent Court and concerning appeals before the Court of First Instance. The objective of the present proposal is to confer jurisdiction relating to the Community patent on the Court of Justice which then will be exercised at first instance by the newly established Community Patent Court and by the Court of First Instance on appeal.

5.1.2. Measures taken in connection with ex ante evaluation

The necessity to create a patent system covering the Community as a whole has been recognised for decades. The first initiative to create such a system resulted in the European Patent Convention of 5 October 1973 which harmonised the grant of the European patent by the European Patent Office but did neither include provisions on the rights conferred by such a patent nor create a single jurisdiction to deal with disputes. This was still left to national legislation and national jurisdiction of the Contracting States. In a second initiative, EC Member States tried to create a Community patent on the basis of an international agreement including an integrated jurisdiction. The Community Patent Convention was signed on 15 December 1975 in Luxembourg followed by the 15 December 1989 agreement relating to the Community patent which included a protocol on the settlement of litigation concerning the infringement and validity of Community patents. The Convention, however, never entered into force. In the context of the Amsterdam European Council of June 1997 (action plan for the single market), the Commission published a Green Paper on the promotion of innovation by patents. The consultations on the Green Paper including the comments made in the hearing on 25 and 26 November 1997 showed a clear support for the creation of a Community patent system. Finally, the Lisbon European Council in March 2000 took up the issue and called for the creation of a Community patent system. The Council in its 3 March 2003 common political approach reached agreement on a number of key issues of the Community

patent system including the jurisdictional aspects calling for the establishment of the Community Patent Court on the basis of Article 225a of the EC Treaty.

5.2. Action envisaged and budget intervention arrangements

Not applicable (see no 1).

5.3. Methods of implementation

Not applicable (see no 1).

6. FINANCIAL IMPACT

Not applicable (see no 1).

7. IMPACT ON STAFF AND ADMINISTRATIVE EXPENDITURE

Not applicable (see no 1).

8. FOLLOW-UP AND EVALUATION

8.1. Follow-up arrangements

The Council in its 3 March 2003 common political approach (point 5) foresees a review mechanism of the Community patent system including the jurisdictional arrangements. Regarding the present Decision, the jurisdiction conferred on the Court of Justice would have to be reviewed as to the subject matter in the light of experience gathered. The Commission will need to consult the Court of Justice and interested circles to collect data on the functioning of the Community patent jurisdiction and will have to evaluate the collected data and, where appropriate, suggest changes to the current decision.

8.2. Arrangements and schedule for the planned evaluation

On the basis of the common political approach adopted by the Council on 3 March 2003, the Commission will present a report on the functioning of all aspects of the Community patent including the jurisdictional arrangements five years after the grant of the first Community patent. Further reviews will be made periodically.

9. ANTI-FRAUD MEASURES

This does not apply. The proposal deals with the conferral of jurisdiction on the Court of Justice relating to the Community patent and does not cover a policy area with a risk of fraud.

IMPACT ASSESSMENT FORM

THE IMPACT OF THE PROPOSAL ON BUSINESS WITH SPECIAL REFERENCE TO SMALL AND MEDIUM-SIZED ENTERPRISES(SMEs)

TITLE OF PROPOSAL

Proposal for a Council decision conferring jurisdiction on the Court of Justice relating to the Community patent.

DOCUMENT REFERENCE NUMBER

[...]

THE PROPOSAL

1. Taking account of the principle of subsidiarity, why is Community legislation necessary in this area and what are its main aims?

The object of the Community patent system is to provide a Community wide patent protection which can be enforced before one single court operating to uniform standards and whose decisions enjoy Community wide effect. This objective can only be achieved at a Community level.

THE IMPACT ON BUSINESS

2. Who will be affected by the proposal?

– which sectors of business

All sectors of business that deal with technical inventions which can be subject to patent protection are concerned by the Community patent system. They can in case of conflict be party to litigation before the Community Patent Court and on appeal before the Court of First Instance to the extent that jurisdiction is conferred on the Court of Justice.

– which sizes of business (what is the concentration of small and medium-sized firms)

Potentially every size of business can be a party to Community patent litigation before the Community patent jurisdiction. For example, the holder of a Community patent may, as a plaintiff, wish to enforce his rights flowing from the Community patent title before the Community Patent Court. A third person may as a plaintiff wish to attack the validity of such a Community patent granting exclusive rights to its holder that he considers to be invalid. As defendant the right holder may wish to defend the validity of his patent or as a third person defend himself against an alleged infringement of a Community patent.

The Community patent system intends to make patenting of inventions more attractive especially for SMEs which will particularly increase the significance for this group. So far patenting is done in or with effect for individual Member States and the enforcement must take place before the national courts of the respective Member States their national patent law and their national legislation on the court procedure which is particularly cumbersome for SMEs. The Community patent jurisdiction will allow to enforce a unitary patent right valid in the entire Community in one single court procedure operating to common standards.

3. What will business have to do to comply with the proposal?

The effect for businesses will be felt only in cases of litigation over a Community patent. In that case they have to familiarise themselves with the proceedings before the Community patent jurisdiction.

4. What economic effects is the proposal likely to have?

The proposal will only have an economic effect in combination with the other legal instruments creating a Community patent system. The Community patent system as a whole will have a positive economic impact. In particular:

- on investment and the creation of new businesses

The Community patent system will have a positive impact on investments due to a better Community wide legal protection of inventions. The return on investments in innovative technologies will be more secure serving as an incentive for more investment. Moreover, since better legal protection will be rendered less costly, businesses will be able to make more efficient use of their existing budget for research and development which will lead to more inventions which in turn will stimulate investments to economically exploit these inventions. Since effective patent protection often serves as the legal basis for an economically successfully operating business, a more comprehensive, easier and less costly patent protection will promote the creation of new businesses.

- on the competitiveness of businesses

The Community patent system will make patent protection more effective, easier and less costly not only for those businesses that already make use of patent protection but also make patenting more easily accessible for other businesses and in particular for SMEs. The possibility to protect an invention and with it the associated investment into it with Community wide effect will increase the ability of all businesses that make use of this possibility to compete in the common market. Moreover, the competitiveness of European industry will be increased on a global scale compared to the major trading partners and competitors. Today patent protection for example in the United States or Japan is considerably less costly than in Europe under the national and the European patent system. Consequently US and Japan based companies can develop patented products at a considerably lower price which later are marketed world wide. The Community patent system intends to eliminate this obstacle for the competitiveness of the European industry.

- on employment

An increased investment in inventive technologies and a strengthened competitiveness of the European industry will lead to the creation of new jobs. The creation of new jobs can be expected across the full range of technical fields and their related industries. In particular the modern, innovative technologies which are playing a steadily increasing role in a knowledge based global economy will benefit.

5. Does the proposal contain measures to take account of the specific situation of small and medium-sized firms (reduced or different requirements etc)?

This does not apply. No distinction according to the size of companies can be made with regard the subject matter of jurisdiction conferred on the Court of Justice.

CONSULTATION

6. List the organisations which have been consulted about the proposal and outline their main views:

The necessity to create a patent system covering the Community as a whole has been recognised for decades. The first initiative to create such a system resulted in the European Patent Convention of 5 October 1973 which harmonised the grant of the European patent by the European Patent Office but did neither include provisions on the rights conferred by such a patent nor create a single jurisdiction to deal with disputes. This was still left to national legislation and national jurisdiction of the Contracting States. In a second initiative, EC Member States tried to create a Community patent on the basis of an international agreement including an integrated jurisdiction. The Community Patent Convention was signed on 15 December 1975 in Luxembourg followed by the 15 December 1989 agreement relating to the Community patent which included a protocol on the settlement of litigation concerning the infringement and validity of Community patents. The Convention however never entered into force. In the context of the Amsterdam European Council of June 1997 (action plan for the single market), the Commission published a green paper on the promotion of innovation by patents. The consultations on the green paper including the comments made in the hearing on 25 and 26 November 1997 showed a clear support for the creation of a Community patent system. Finally, the Lisbon European Council in March 2000 took up the issue and called for the creation of a Community patent system. The Council in its 3 March 2003 common political approach reached agreement on a number of key issues of the Community patent system including the jurisdictional aspects calling for the establishment of the Community Patent Court on the basis of Article 225a of the EC Treaty.



COMMISSION OF THE EUROPEAN COMMUNITIES

Brussels, 23.12.2003
COM(2003) 828 final

2003/0324 (CNS)

Proposal for a

COUNCIL DECISION

**establishing the Community Patent Court
and concerning appeals before the Court of First Instance**

(presented by the Commission)

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EXPLANATORY MEMORANDUM

1. BACKGROUND

In the Community, patent protection has long been provided for in two ways, neither of which is based on a Community instrument: National patents are granted by national patent offices on the basis of legislation of the respective Member State. The protection conferred is limited to the territory of that Member State and in case of dispute the patent right has to be enforced before the competent national courts. European patents are granted by the European Patent Office established by the Convention on the Grant of European Patents (European Patent Convention) of 5 October 1973 providing for substantive patent law and a single procedure of grant. Once granted, the European patent confers protection on the territory of those Contracting States which are designated by the right holder. Whereas the harmonised patent law of the European Patent Convention is essentially limited to the phase up to the grant of the European patent, its effects are determined according to the respective national patent law of each designated Contracting State. In case of dispute, litigation must also take place before the competent national courts. This situation, where the patent right is only granted in or with effect for individual Member States of the European Union entails for the right holder the risk of being forced to enter into multiple litigation in a number of Member States on the same patent issue with possibly variable results has long been criticised as inappropriate and unsuitable for the needs of European industry operating within the common market. Member States have already in the past undertaken great efforts to redress this situation in a Community context. The Community Patent Convention intending to create a unitary Community patent title was signed on 15 December 1975 in Luxembourg followed by the 15 December 1989 agreement relating to the Community patent including a protocol on the settlement of litigation concerning the infringement and validity of Community patents. However these agreements never entered into force.

2. THE COMMUNITY PATENT

The European Council held in Lisbon in March 2000 launched a general programme to increase the competitiveness of the Union's economy and took up the issue again. As one concrete measure for improvement, the Council called for the creation of a Community patent system to address existing shortcomings in the legal protection for inventions thus giving an incentive for investments in research and development and contributing to the competitiveness of the economy as a whole. In the wake of the Lisbon European Council, the Commission put forward on 1 August 2000 a proposal for a Council regulation on the Community patent [COM(2000) 412 final] containing the relevant provisions applying to Community patents, in particular the provisions for the creation of a unitary Community patent title including the rights conferred by it, the possible actions for the enforcement of these rights, the grounds for invalidity as well as the mechanisms for the administration of granted Community patents such as their yearly renewal. It is foreseen that the grant of Community patents will be carried out by the European Patent Office. For this purpose the Community must accede to the European Patent Convention thereby charging the European Patent Office with the task of granting Community patents. Thus the European Patent Office will grant European and Community patents according to the same standards

of the European Patent Convention ensuring uniformity and legal security of patent law in Europe. At the same time the European Patent Office's high expertise as an examining patent office can be put to use for the Community patent.

3. THE COMMUNITY PATENT JURISDICTION

The establishment of a Community patent jurisdiction is a key element of the Community patent system. The Community patent title covering the territory of all Member States will not only be governed by the uniform provisions of Community law contained in the regulation of the Council on the Community patent. It will, at the latest by 2010, after a transitional period during which national courts will retain jurisdiction for the subject matter, also be enforceable before a Community jurisdiction whose decisions enjoy Community wide effect.

The legal basis to be used for the establishment of a Community patent jurisdiction was introduced into the EC Treaty by Article 2 (26 ff.) of the Treaty of Nice amending the Treaty on European Union, the Treaties establishing the European Communities and certain related acts which entered into force on 1 February 2003, inserting Article 229a and Article 225a into the EC Treaty. It is proposed that the Community patent jurisdiction will be established by two Council Decisions based on those Articles.

In order for the Court of Justice to assume jurisdictional responsibilities with regard to the Community patent, that jurisdiction must be conferred on it. Article 229a of the EC Treaty allows the Council to adopt provisions to confer jurisdiction to the extent that it shall determine on the Court of Justice in disputes relating to the application of acts adopted on the basis of the Treaty which create Community industrial property rights. To that effect, the Commission put before the Council a separate proposal for a Council Decision containing such a conferral of jurisdiction with regard to the Community patent. The Court of Justice should have jurisdiction in disputes relating to the infringement or the validity of a Community patent and a Community supplementary protection certificate, the use of the invention after the publication of the Community patent application, the right based on prior use of the invention, provisional and evidence-protection measures in the subject matter conferred, damages or compensation in the situations referred to above and orders of a penalty payment in case of non-compliance with a decision or order constituting an obligation to act or to abstain from an act.

The present Commission proposal for a Council Decision based on Articles 225a, 245 of the EC Treaty proposes the establishment of a judicial panel to be called "Community Patent Court" which would within the Court of Justice exercise at first instance the jurisdiction in disputes relating to the Community patent. The Decision also contains necessary provisions with a view to accommodating the new function of the Court of First Instance as appeal instance according to Article 225(2) of the EC Treaty against decisions of the Community Patent Court.

4. THE COMMUNITY PATENT COURT

Article 225a of the EC Treaty provides for the possibility to create judicial panels to hear and determine at first instance certain classes of action or proceeding brought in

specific areas. It is proposed that the Community Patent Court is established as a judicial panel in the sense of Article 225a of the EC Treaty. It would be competent for first instance litigation relating to the Community patent for which jurisdiction is conferred on the Court of Justice by the Decision of the Council based on Article 229a of the EC Treaty.

The EC Treaty itself already contains a number of provisions relevant to judicial panels. Judicial panels are according to Article 220(2) of the EC Treaty attached to the Court of First Instance. Article 225a(4) of the EC Treaty sets out the required qualifications for the judges of judicial panels and the appointment procedure. Judges shall be chosen from persons whose independence is beyond doubt and who possess the ability required for appointment to judicial office. Unlike the judges of the Court of Justice and the Court First Instance who are appointed by common accord of the governments of the Member States, the judges of a judicial panel are appointed by a unanimous decision of the Council. Article 225a(5) of the EC Treaty provides that the Rules of Procedure of a judicial panel are established by the panel itself in agreement with the Court of Justice and subject to the approval by the Council acting by a qualified majority. The EC Treaty provisions relating to the Court of Justice and the provisions of the Statute of the Court of Justice apply according to Article 225a(6) of the EC Treaty also to judicial panels unless the decision establishing a judicial panel provides otherwise. Appeals against decisions of the Community Patent Court will, according to Articles 225(2), 225a(3) of the EC Treaty be heard by the Court of First Instance. That appeal is limited to points of law unless otherwise provided for in the decision establishing the judicial panel.

With regard to the structure of the Community Patent Court, the proposal contains a centralised and specialised Community jurisdiction which will best ensure legal certainty regarding the unitary Community patent. The Community patent title covering the territory of all EU Member States should not only be granted according to the uniform standards of the European Patent Convention and after grant be governed by the uniform provisions of Community law contained in the Community patent regulation. It should also be effectively enforceable before a Community jurisdiction guaranteeing high quality decisions in a quick, inexpensive and uniform procedure. The Community Patent Court with its judges coming from different legal backgrounds within the Community would from its establishment develop a common Community patent case law ensuring legal certainty throughout the Community. These arguments in favour of a completely centralised Community jurisdiction have after a long and thorough discussion found the unanimous support of the Council as expressed in the common political approach of 3 March 2003. The judges of the Community Patent Court as a specialised Community jurisdiction should be sufficiently experienced in the field of patents. This has been expressly recognised by the Council who agreed in its common political approach that candidates for appointment must have an established high level of legal expertise in patent law and that judges shall be appointed on the basis of their expertise.

It is proposed that the Community Patent Court will consist of seven judges including the president. With the normal composition of the bench being three judges, six judges would allow to form two chambers within the Community Patent Court. The seventh member would appear necessary for the reinforcement of a chamber where needed, e.g. due to illness of a judge or for the chamber presided over by the president of the Community Patent Court who also has to assume tasks related to the administration and the representation of the Community Patent Court.

In special circumstances provided for in the Rules of Procedure, the Community Patent Court could sit in an enlarged composition, for example in cases where fundamental questions of patent law are concerned or in a reduced composition which could be the case for interim measures or simple cases in main proceedings.

The judges should be assisted in their work throughout the handling of the case by technical experts as agreed upon by the Council in its 3 March 2003 common political approach. For that purpose, use of “assistant rapporteurs” as foreseen in Article 13 of the Protocol on Statute of the Court of Justice shall be made. Such assistant rapporteurs, specialised in different technical fields, should actively participate in the preparation, the hearing and the deliberation of a case. However, they would not have a right to vote on the decision to take. Their input would be important in helping the judges to focus from the start of proceedings on the essential technical questions involved. Their role would not be to make the use of experts entirely superfluous but to enable the court as a whole to understand the technical aspects of the case quickly and accurately which is relevant for an efficient handling of a case and for a legally sound decision.

The Community Patent Court, though attached to the Court of First Instance should have its own registrar. With a view to an entirely different type of litigation and the case load of the Community Patent Court, a separate registrar would appear to be necessary to ensure swift and efficient proceedings before the Community Patent Court.

With a view to the first instance proceedings before the Community Patent Court, Article 4 of the Decision creates Annex II to the Protocol on the Statute of the Court of Justice including a number of provisions adapting the provisions of the Statute of the Court of Justice which are applied to judicial panels according to Article 225a(6) of the EC Treaty. With a view to the special nature of litigation before the Community Patent Court, i.e. private party patent litigation, some provisions of the Statute of the Court of Justice cannot apply e.g. those concerning the review of the legality of Community acts, others need amendments e.g. those concerning the procedure, the production of evidence or the revision of a judgment and finally some provisions need to be added e.g. those concerning the enforcement of decisions of the Community Patent Court or court fees.

Any official EU language can, depending on the circumstance, become the language of proceedings before the Community Patent Court. The principle that will decide on the language of proceedings in a particular case centres on the place of domicile of the defendant in the Community. The Community Patent Court conducts the proceedings in the official EU language of the Member State where the defendant is domiciled, or in one of them to be chosen by the defendant, where in a Member State there are two or more official languages. However, at the request of the parties and with the consent of the Community Patent Court, any official EU language can be chosen as language of proceedings. Where the defendant is not domiciled in a Member State, the language of proceedings would be determined by the official EU language in which the Community Patent was granted.

The proposal provides that the proceedings before the Community Patent Court will not be free of charge. The Community Patent Court will hear litigation in which parties seek to enforce their private rights against competitors and who should therefore adequately contribute to the incurred court cost. In that respect, the

principle contained in Article 72 of the Rules of Procedure of the Court of Justice and Article 90 of the Rules of Procedure of the Court of First Instance that proceedings are free of charge will not be upheld for Community patent litigation. However, provisions on legal aid will have to be provided for in the Rules of Procedure of the Community Patent Court where a party is unable to meet the cost of proceedings as is the case in the Rules of Procedure in Articles 76 for the Court of Justice and 94. ff for the Court of First Instance.

5. THE APPEAL TO THE COURT OF FIRST INSTANCE

With the establishment of a Community Patent Court as a judicial panel in the sense of Article 225a of the EC Treaty which is attached to the Court of First Instance according to Article 220(2) of the EC Treaty, the latter will under Article 225(2) of the EC Treaty have jurisdiction to hear and determine appeals against decisions of the Community Patent Court.

For that purpose it is suggested to set up a special patent appeal chamber within the Court of First Instance with three judges having a high level of legal expertise in patent law providing the legal experience required for the highly specialised field of patent litigation. This appears to be necessary not only in first instance on the level of the Community Patent Court but also on appeal ensuring swift and efficient proceedings resulting in high quality decisions that merit the trust of the users from the very beginning of the system. The judges hearing the appeal will also be assisted by technical experts throughout the handling of the case. These "assistant rapporteurs" will be required to participate in the preparation, the hearing and the deliberation of the case.

The Community Patent Court in first instance and the patent appeal chamber of the Court of First Instance in patent appeal proceedings must, as the two stages of a uniform procedure, work to the same set of procedural rules. Therefore, those special Statute provisions that are necessary with a view to the specific nature of patent litigation which deviate from the Statute provisions of the Court of Justice as they would apply the Community Patent Court according to Article 225a(6) of the EC Treaty are also made applicable for the appeal proceedings before the Court of First Instance.

In principle Community patent disputes are heard by the Court of First Instance in second and last resort. A further appeal of a case to the Court of Justice is not foreseen. However, in exceptional cases, the decision of the Court of First Instance can be reviewed by the Court of Justice at the request of the First Advocate General according to Article 225(2) of the EC Treaty, Article 62 of the Statute of the Court of Justice where there is a serious risk of the unity or consistency of Community law being affected. The Court of Justice is expected to come forward with a request to change its Statute introducing further details for such a review procedure as called for in Declaration No 13 adopted by the Nice conference.

With a view to the enabling provision of Article 225(3) of the EC Treaty allowing, by way of Statute provision, to entrust the Court of First Instance in specific areas with jurisdiction to hear and determine questions referred for a preliminary ruling under Article 234 of the EC Treaty, the present proposal does not foresee any such competence for Community patent law provisions. While this question has been

considered and held to yield important potential synergies with a view to the Court of First Instance deciding on parallel material issues either as an appeal instance in Community patent litigation or at the request of national courts for a preliminary ruling, it was felt that for the time being this competence should remain with the Court of Justice. The establishment of the Community Patent Court dealing with a new kind of litigation on a Community level constitutes itself a major innovation for the Community legal order such that it would appear appropriate to gather sufficient practical experience in the operation of the new jurisdictional arrangements before taking further steps.

6. TRANSITIONAL PERIOD

As agreed by the Council in its 3 March 2003 common political approach, the Community Patent Court shall be established at the latest by the year 2010. Until that time national courts of Member States will have jurisdiction. This would be relevant for those Community patents which come into effect before the establishment of the Community patent jurisdiction. The Community patent regulation will contain special provisions governing this transitional period. It is foreseen that each Member State will designate for this purpose a limited number of national courts to exercise the jurisdiction which will at the end of the transitional period be conferred on the Court of Justice. With regard to legal remedies against a decision of a national court in first instance, the legal remedies allowed in the respective Member State are applicable. Except where the jurisdiction of a national court is based on the place where an infringement was committed, in which case the jurisdiction is limited to the acts committed in that Member State, the national courts will have Community wide jurisdiction. Before the national courts, the Community patent will enjoy a comprehensive presumption of validity excluding the simple plea for invalidity as a defence against an infringement action. According to Article 2 of the Commission proposal for a Council Decision conferring jurisdiction on the Court of Justice relating to the Community patent, legal actions of which national courts have been seised at the time when the conferral of jurisdiction on the Court of Justice will take effect will be decided by the competent national courts.

7. NEED FOR A COMMUNITY INTERVENTION

The present Decision relating to jurisdictional aspects of the Community patent system intends to redress the existing shortcomings of the current situation of patent protection in the Union. The objective is to establish Community wide patent protection which can be enforced before one single court operating to uniform standards. This objective can only be achieved at a Community level.

8. PROPOSED PROVISIONS

With regard to its structure, the present Decision contains three chapters relating to the Community Patent Court (Chapter I), the appeal proceedings against decisions of the Community Patent Court before the Court First Instance (Chapter II) and final provisions (Chapter III).

Chapter I - The Community Patent Court

Chapter I on the Community Patent Court contains two major elements. Articles 1 to 3 of the Decision contain provisions which set up the Community Patent Court, determine the EC Treaty provisions to be applied to the Community Patent Court and provide a legal basis for an annex to the Protocol on the Statute of the Court of Justice containing the Statute provisions as applied by the Community Patent Court. Article 4 contains the special provisions relating to the Community Patent Court which are to be annexed to the Protocol on the Statute of the Court of Justice (hereinafter "Statute").

Article 1 - Establishment of the Community Patent Court

Article 1 establishes a judicial panel to be called "Community Patent Court" for first instance Community patent litigation. The establishment of the Community Patent Court is based on Article 225a of the EC Treaty which allows for the creation of judicial panels to hear and determine at first instance certain classes of action or proceeding brought in specific areas. Pursuant to Article 220(2) of the EC Treaty, the Community Patent Court is attached to the Court of First Instance. The structure of the Community Patent Court had been subject to intensive debate in the Council as to the proper degree of centralisation. The Council, in its common political approach adopted on 3 March 2003 unanimously agreed on a fully centralised first instance. The proposal for the establishment of a Community Patent Court is built on this approach. Consequently, the Community Patent Court should have its seat at the Court of First Instance without any of the possibilities that had been under discussion in the Council allowing for the establishment of permanent regional divisions of the Community Patent Court in Member States.

Article 2 – Application of EC Treaty provisions

In accordance with Article 225a(6) of the EC Treaty, the provisions of the EC Treaty relating to the Court of Justice and the provisions of the Statute of the Court of Justice will apply to the Community Patent Court unless the Decision establishing the Community Patent Court provides otherwise. Article 2 contains a list of Articles chosen from the EC Treaty provisions relating to the Court of Justice that are applicable to the Community Patent Court subject to the subsequent provisions of Chapter I of this Decision. The same approach had been employed by Article 4 of Council Decision 88/591/ECSC, EEC, Euratom of 24 October 1988 establishing the Court of First Instance.

The EC Treaty provisions relating to the Court of Justice do not seem in their entirety to be suitable for the special litigation to be handled by the Community Patent Court. Not applicable of course are the provisions relating to the Court of Justice and the Court of First Instance themselves, or to special proceedings before them. Moreover, among those provisions of a more general nature, a number of Articles referring to acts of the Communities and in particular their nullification, such as Articles 231, 233, 242 of the EC Treaty, are not applicable to the Community Patent Court handling private party litigation not involving the annulment of Community acts.

Articles 241, 243, 244 and 256 of the EC Treaty will apply to the Community Patent Court. Article 241 of the EC Treaty allows private parties to plead for the non-application of a regulation on the grounds stated by Article 230(2) of the

EC Treaty. The EC Treaty in allowing this plea for non-application ensures the protection against the application of illegal regulation provisions, a safeguard that should also apply in patent litigation. Parties should be allowed to attack indirectly the validity of relevant patent provisions. Article 243 of the EC Treaty states the principle that the Court can order any necessary interim measures. Such provision is also valid for private party litigation and should thus apply to the Community Patent Court. Articles 244 and 256 of the EC Treaty concern the enforcement of a judgment which is governed by the law of the Member State in which enforcement is sought. This provision should also apply to the judgments of the Community Patent Court.

With regard to interim measures (Article 14 of Annex II to the Statute) and the enforcement of decisions of the Community Patent Court (Article 22 of Annex II to the Statute) the Decision takes particular account of the special nature of Community patent litigation. The order of interim measures provided for in Article 243 of the EC Treaty should not be conditional upon main proceedings having already been instituted before the Community Patent Court; also, interim measures that have been found unjustified may give rise to a claim for adequate compensation for the injury thereby caused. Furthermore, the enforcement mechanism provided for in Article 256 of the EC Treaty does not seem to be entirely suitable for the enforcement of decisions of the Community Patent Court, and in particular for interim measures, in that it requires an order of enforcement to be appended to the decision by the national authority designated for this purpose by the Member State in which the enforcement takes place. Although the national authority would only verify the authenticity of the decision to be enforced, this would still result in unjustified delays. Consequently the order of enforcement should be appended directly to the decision by the Community Patent Court. Furthermore, decisions of the Community Patent Court should also be enforceable against Member States as they should be treated on an equal basis with other parties where they own or infringe a Community patent. Finally, the Community Patent Court should have the power to ensure the enforcement of certain decisions by an order of a penalty payment.

Article 3 – Statute provisions for judicial panels

This Article contains a provision inserting a new Title VI "Judicial Panels" into the Statute of the Court of Justice with a new Article 65 creating a legal basis to annex provisions to the Statute of the Court Justice relating to judicial panels created under Article 225a of the EC Treaty. This provision of a general character and applies equally to any future judicial panel to be established. According to Article 225a(6) of the EC Treaty, unless otherwise provided for in the decisions establishing them, judicial panels apply the provisions of the Statute of the Court of Justice. While the majority of the provisions of the Statute of the Court of Justice will also be suitable to apply to judicial panels, some special provisions are necessary in order to take the individual circumstances of the judicial panel concerned into consideration, e.g. concerning the organisation and composition of the panel and special procedural elements. Therefore, for each judicial panel established in the future, a corresponding annex will be created to deal with the Statute provisions to be applied by the judicial panel concerned. Consequently the new Article 65 of the Statute of the Court of Justice consequently lays down that the provisions relating to the jurisdiction, the composition, and the organisation of judicial panels, and the procedure before them are to be set out in an annex to the Statute of the Court of Justice.

Article 4 – Annex to the Protocol on the Statute of the Court of Justice

On the basis of the new Article 65 of the Statute of the Court of Justice which will be inserted by virtue of Article 3 of the present Decision as explained above, Article 4 creates an Annex II to the Statute of the Court of Justice entitled "The Community Patent Court" with the following elements:

Article 1 of Annex II lays down the jurisdiction of the Community Patent Court. Articles 2 and 3 of Annex II concern the appointment of judges, Article 4 the election of the president of the Community Patent Court.

Article 5 of Annex II identifies the provisions from Title I and II of the Statute which apply to the Community Patent Court followed by special provisions relating to the organisation of the Community Patent Court (Articles 6 to 9 of Annex II). Article 10 of Annex II prescribes that the procedure before the Community Patent Court shall be governed by Title III of the Statute followed by a number of special provisions that are necessary in view of particular requirements of the special type of litigation before it (Articles 11 to 25 of Annex II). Articles 47 ff and 53 ff. of Title IV of the Statute of the Court of Justice contain a parallel structure with regard to the Court of First Instance.

Finally, Annex II contains special provisions on the appeal to the Court of First Instance (Articles 26 to 28) and a legal basis to lay down in the Rules of Procedure necessary provisions for applying and, where required, supplementing it.

Article 1 of Annex II to the Statute – Jurisdiction

Pursuant to Article 229a of the EC Treaty, exclusive jurisdiction relating to the Community patent is conferred on the Court of Justice by a separate Council Decision allowing the Court of Justice to assume jurisdictional responsibilities in this field.

The present Article attributes within the Court of Justice the exclusive jurisdiction for these disputes relating to the application of Council regulation (EC) No.../... of ... on the Community patent and Council regulation (EC) No.../... of ... on the Community supplementary protection certificate to be exercised at first instance by the Community Patent Court. The jurisdiction of the Community Patent Court is determined by way of reference to the Council Decision conferring jurisdiction on the Court of Justice relating to the Community patent for which the Commission has put forward a separate proposal for a Council Decision. The Community Patent Court would thus have jurisdiction for the subject matter laid down in Article 1 of the Commission proposal for such a Council Decision, namely for disputes relating to the infringement or the validity of a Community patent and a Community supplementary protection certificate, the use of the invention after the publication of the Community patent application, the right based on prior use of the invention, interim and evidence-protection measures in the subject matters conferred, damages and compensation incurred in the situations referred to above and orders of a penalty payment in case of non-compliance with a decision or order constituting an obligation to act or to abstain from an act.

In a transitional period before the conferral of jurisdiction on the Court Justice takes effect, disputes will be decided by national courts in accordance with the provisions

of the Community patent regulation. As provided for in Article 2 of the proposed Council Decision conferring jurisdiction on the Court of Justice relating to the Community patent, the Community Patent Court will not have jurisdiction for those disputes of which national courts have already been seised during that transitional period, since the conferral of jurisdiction does not extend to those disputes.

Article 2 of Annex II to the Statute – Number, appointment and term of office of judges of the Community Patent Court

Article 2 contains provisions relating to the judges of the Community Patent Court.

Paragraph 1 lays down the number of members of the Community Patent Court and their term of office. As to the size of the Community Patent Court, a total of seven judges including the president is proposed. The Community Patent Court will, according to Article 8 of Annex II to the Statute of the Court of Justice normally sit in chambers with three judges. Six judges would allow formation of two chambers. The seventh member would seem appropriate to give special support to the chamber presided over by the president of the Community Patent Court who will also have to perform other tasks relating for example to the administration and representation of the Community Patent Court. In addition, a complement of seven judges would enable all to sit and issue decisions together in accordance with Article 17(1) of the Statute of the Court of Justice which provides that only an uneven number of judges may sit. This number would also guarantee a smoothly operating jurisdiction in case of leave or sickness of judges and in general seems to be the number appropriate to the tasks to be carried out and the workload to be expected in the initial phase of the Community Patent Court. The judges will, according to Article 225a(5) of the EC Treaty, have to establish the Rules of Procedure of the Community Patent Court; a common practice under the adopted Rules of Procedure will have to be developed, and necessary adaptations in the light of experience be considered. The expected caseload in the initial phase is estimated for the first three consecutive years at around 50, 100 and 150 newly lodged cases which would mean a case load of 25, 50 and 75 new cases per year per chamber. This assumption is based on an expected number of 100 000 patents granted by the European Patent office per year of which around 50 000 would designate the Community and an annual litigation rate of 1 in 1 000 patents in force. When assessing the caseload that can reasonably be handled it must also be borne in mind that the Community Patent Court will have to develop a common jurisprudence necessitating in particular in the initial phase a number of fundamental decisions with corresponding need for intensive discussions.

As a term of office, a six year term with the possibility of renewal as is the case for the Court of Justice in Article 223(1) and (4) of the EC Treaty and for the Court of First Instance in Article 224(2) of the EC Treaty also seems appropriate for the Community Patent Court. The membership will be partially renewed every three years as foreseen for the Court of First Instance in Article 224(2) of the EC Treaty. Such a partial renewal of membership will ensure that the expertise built up by the court can be passed on from experienced judges to newly appointed judges and thus contribute to a stable jurisprudence and legal certainty. In order to establish this cycle where the Community Patent Court is only partially re-staffed at any one time, some members will need to have a shorter initial term of office. To that end, the present decision contains in its Article 7(2) a transitory provision whereby the president of the Council is to proceed to choose by lot the judges whose terms of office are to expire at the end of the first three years.

Paragraph 2 provides that judges are appointed from candidates presented by the Member States, and addresses the particular qualifications of members of the Community Patent Court. The EC Treaty itself prescribes in Article 225a(4) that eligible members of the judicial panels are "persons whose independence is beyond doubt and who possess the ability required for appointment to judicial office". Paragraph 2 specifies this general provision which is meant to address all the different kinds of possible panels by laying down specific requirements relating to the necessary professional profile of possible candidates for judges of the Community Patent Court. As agreed by the Council in its common political approach of 3 March 2003, the members must be appointed on the basis of their expertise from candidates having an established high level of legal expertise in patent law. This is particularly important because the special nature of patent law requires much experience. The experience of the judges in this field will be crucial for the acceptance of the system by users by guaranteeing efficient proceedings and high quality decisions. The judges will be appointed after consultation of a committee to be set up in accordance with Article 3.

Article 3 of Annex II to the Statute – Advisory committee

Paragraph 1 provides that the judges will be appointed following consultation of an advisory committee to be set up for this purpose which is to give an opinion on the adequateness of the profile of candidates for membership of the Community Patent Court. The Council will be aided by the Committee's opinion in the appointment process in finding the best suited candidates for membership of the Community Patent Court. In the light of the specific requirements to be observed, the advisory committee may also provide a list of those candidates who possess the most appropriate high level of legal experience. In such a case the list must include twice the number of candidates as the number of judges to be appointed, in order to guard against any risk of a predetermination of the decision of the Council by the committee's opinion.

Paragraph 2 determines that the advisory committee shall be composed of seven members chosen from among former members of the Court of Justice, the Court of First Instance, the Community Patent Court or lawyers of recognised competence. The appointment of members of the committee and its operating rules shall be decided by the Council, acting by a qualified majority, on a proposal from the president of the Court of Justice.

Article 4 of Annex II to the Statute - President of the Community Patent Court

This Article concerns the president of the Community Patent Court who is to be elected by the judges from among their number for a term of three years with the possibility of re-election. The same principles are applied to the Court of First Instance in Article 224(3) of the EC Treaty. However, the transitory provision contained in Article 7(1) of the present Decision provides that the first president of the Community Patent Court exceptionally appointed in the same manner as its members, unless the Council decides that also the first president shall be elected by the judges. This approach had also been followed for the Court of First Instance in Article 11(1) of Council Decision 88/591/ECSC, EEC, Euratom of 24 October 1988 establishing the Court of First Instance.

Article 5 of Annex II to the Statute – Applicability of provisions from Titles I and II of the Statute to the Community Patent Court and its judges

In the first sentence, this Article contains a reference to those Statute provisions from Titles I and II of the Statute that shall also apply to the Community Patent Court. A corresponding provision for the Court of First Instance is contained in Article 47(1) of the Statute.

For the Community Patent Court are declared applicable from Title I of the Statute: Article 2 (oath), Article 3 (immunity), Article 4 (other occupation), Article 5 (resignation), Article 6 (deprivation of office) and Article 7 (term of office in case of replacement). The present Article does not contain a reference to Article 8 of the Statute relating to the Advocate General since a participation of the Advocate General in proceedings before the Community Patent Court is not foreseen.

From Title II are declared applicable: Article 13 (assistant rapporteur), Article 14 (requirement of residence), Article 15 (judicial vacations), the first, second and fifth paragraphs of Article 17 (composition and quorum) and Article 18 (challenge for bias). The present Article does not contain a reference to Article 9 (number of judges to be replaced), Article 12 (staff attached to the Court of Justice), Article 16 (chambers of the Court of Justice), the third and fourth paragraphs of Article 17 (quorum for grand chamber and full Court). These provisions relate to specificities of the Court of Justice and should not apply to the Community Patent Court.

In the second sentence, the present Article specifies that also in relation to the Community Patent Court the oath of the judges is taken before the Court of Justice who is also attributed the competence to take decisions concerning the immunity and other occupations of judges and their deprivation of office.

Article 6 of Annex II to the Statute – Registrar

The first sentence provides for a registrar of the Community Patent Court. Although the Community Patent Court is attached to the Court of First Instance, a separate registrar seems appropriate since the Community Patent Court will deal with an entirely different type of litigation and also the expected caseload will justify such a measure. A legal basis for the appointment of the registrar and the rules governing his service would seem necessary in the Statute. Unlike for the Court of Justice (Article 223(5) of the EC Treaty) and the Court of First Instance (Article 224(4) of the EC Treaty) no such provision is included in the EC Treaty for the panels to be created under Article 225a.

The second sentence declares the provisions of the Statute relating to the registrar of the Court of Justice applicable to the registrar of the Community Patent Court as is the case for the registrar of the Court of First Instance in Article 47(2) of the Statute. The provisions concerned are Article 3(4) (immunities), Article 10 (oath and duties of the registrar), Article 11 (replacement of the registrar) and Article 14 (requirement of residence).

Article 7 of Annex II to the Statute – Assistant rapporteurs

This Article deals with the question in which way technical expertise is incorporated on the side of the Community Patent Court. An appropriate incorporation of

technical expertise appears to be of particular importance for the efficiency and quality of the proceedings before the Community Patent Court. The judges of the Community Patent Court are confronted with cases involving highly complicated technologies from a wide range of technical fields. In this context, technical expertise can be considered essential in helping the judges to focus from the start of proceedings on the essential technical questions involved. The objective would not be to make the use of experts entirely superfluous but rather to enable the court as a whole to understand the technical aspects of the case quickly and accurately which is relevant for an efficient handling of a case and for a legally sound decision. The question has been subject to thorough discussions in the Council which reached agreement in its common political approach of 3 March 2003 that technical experts should assist the judges throughout the handling of the case. The present Article builds on this approach.

Paragraph 1 provides for technical experts of the Community Patent Court and specifies the framework within which they assume their function. Technical experts will assist the judges throughout the handling of the case as assistant rapporteurs. Article 13 of the Statute is applied to the assistant rapporteurs of the Community Patent Court. They are consequently appointed by the Council, acting unanimously, on a proposal from the Court of Justice. They shall be chosen from persons whose independence is beyond doubt and who possess the necessary legal qualifications. In this context, a thorough experience in patent law would seem necessary since the assistant rapporteur must have a good understanding of what technical aspects are relevant for a legally sound decision of the Community Patent Court. Assistant rapporteurs shall take an oath before the Court of Justice to perform their duties impartially and conscientiously and to preserve the secrecy of deliberations.

Paragraph 2 adds on to these elements providing that assistant rapporteurs must have a high level of expertise in the relevant technical field. The proposal does not foresee a fixed number of assistant rapporteurs but prefers to leave this question to be solved in the light of experience to be gathered. In order to reach the objective as outlined above, which is to provide the bench with technical expertise of a general kind, a limited number of assistant rapporteurs covering the basic divisions of technology such as one for each of the following seven fields would seem appropriate: inorganic chemistry and materials science, organic and polymer chemistry, biochemistry and biotechnology, general physics, mechanical engineering, information and communication technology, electrical engineering. Assistant rapporteurs shall like the judges be appointed for a term of six years with the possibility of reappointment.

Paragraph 3 contains a provision specifying the functions of the assistant rapporteurs within the Community Patent Court. As they shall assist the judges throughout the handling of the case, their participation is foreseen in the preparation, the hearing and the deliberation of cases. The details concerning their participation shall be laid down in the Rules of Procedure. Assistant rapporteurs shall have the right to ask questions to the parties to clarify relevant technical questions. They shall take part in the deliberation of the judges but do not have a right to vote.

Article 8 of Annex II to the Statute – Composition of the chambers and assignment of cases

Paragraph 1 provides that the Community Patent Court as a rule shall sit in chambers composed of three judges. This number also retained in the Council's common

political approach of 3 March 2003 seems to be most appropriate with a view to litigation to be handled striking the right balance between thoroughness and efficiency of case handling for the average cases.

Paragraph 2 addresses situations where there might be a need to deviate from the standard composition of a chamber of three judges. An enlarged configuration might be appropriate, for instance, in cases that involve fundamental points of law or where chambers take a different view on a legal matter. A reduced configuration might be considered for provisional measures or simple cases. The requirements for such a special composition shall be laid out in the Rules of Procedure to allow for the necessary flexibility including provisions on the quorum since the standard provisions of Article 17(3) (grand chamber) and Article 17(4) (full court) of the Statute do not apply to the Community Patent Court.

Paragraph 3 provides that the president of the Community Patent Court shall always preside *ex officio* over one of the chambers of the Community Patent Court. He shall also preside where the Community Patent Court in accordance with its Rules of Procedure sits in an enlarged composition. The presidents of the remaining chambers shall be elected by the judges from among their number for a term of three years with the possibility of re-election.

Paragraph 4 specifies that the composition of the chambers and the assignment of cases to the chambers is governed by the Rules of Procedure. The composition of the chambers and the assignment of cases will thus be predetermined in the Rules of Procedure but at the same time an appropriate degree of flexibility is left to adapt such rules in the light of efficient case handling. It opens, for example, the possibility of largely attributing the cases to the chambers on the basis of the field of technology concerned enhancing the expertise of the individual chamber by building up experience in the technical fields concerned.

Article 9 of Annex II to the Statute – Agreement on services of support staff

According to Article 12 of the Statute, officials and other servants are attached to the Court of Justice. They are responsible to the registrar of the Court of Justice under the authority of the president of the Court of Justice. The conditions under which these officials and other servants render their services to the Court of First Instance are according to Article 52 of the Statute determined by common accord between the president of the Court of Justice and the president of the Court of First Instance.

The present Article lays down the framework under which officials and other servants attached to the Court of Justice will render services to the Community Patent Court to enable it to function. This will be determined between the President of the Court of Justice or, where appropriate, the President of the Court of First Instance by common accord with the President of the Community Patent Court. As a rule, such an agreement will be reached between the president of the Court of Justice and the president of the Community Patent Court. However, there might also be situations where the common accord between the president of the Court of Justice and the president of the Court of First Instance has already taken account of the needs of the Community Patent Court so that in such a case the president of the Court of First Instance and the president of the Community Patent Court are in a position to agree on appropriate terms for the Community Patent Court. Finally, certain officials and other servants who directly support the president, the judges or

the registrar such as legal secretaries or officials of the registry shall be responsible to the registrar of the Community Patent Court under the authority of the president of the Community Patent Court. There is a corresponding provision for the Court of First Instance in Article 52 of the Statute.

Article 10 of Annex II to the Statute – Applicability of provisions from Title III of the Statute to the procedure before the Community Patent Court

Paragraph 1 of this Article declares Title III of the Statute applicable for the procedure before the Community Patent Court as is the case for the Court of First Instance in Article 47 of the Statute. The majority of procedural provisions contained in Title III of the Statute concerning basic principles of procedure before the Court of Justice can also apply to the Community Patent Court. They can be considered a set of common principles of Community court procedure. However, where necessary with a view to the special type of litigation before the Community Patent Court changes have to be made. The Community Patent Court will hear private party Community patent litigation. It will not be concerned with the review of the legality of Community acts but decide disputes between private parties. As a result, not all of the provisions contained in Title III of the Statute can apply in their present form. Hence, certain provisions of Title III of the Statute which are not relevant to the procedure before the Community Patent Court are disapplied (Articles 21(2), 22, 23, 40(1) and (3), 42, 43 of the Statute). Where the special nature of litigation before the Community Patent Court makes adaptations to the existing provisions of Title III of the Statute necessary, this has been done in Articles 11 to 25 of Annex II to the Statute.

The provisions from Title III of the Statute apply to the Community Patent Court as follows:

Article 19 of the Statute on legal representation is applied to the Community Patent Court with the amendments relating to the role of European patent attorneys which are proposed in Article 11 of Annex II to the Statute and who should have a right to speak before the Community Patent Court.

Article 20 of the Statute laying down the principal structure of the procedure consisting of two parts, a written and an oral part, its provisions on communications to the parties and the contents of the oral procedure are applied to the Community Patent Court with the proposed amendments contained in an Article 12 of Annex II to the Statute providing e.g. for exceptional cases to dispense with the oral procedure and allowing for proceedings to be conducted in electronic form.

Article 21(1) of the Statute concerns the necessary elements of written applications. Article 21(2) of the Statute concerns the annulment of measures issued by a Community institution. The Community Patent Court, however, will not be concerned with the review of the legality of Community acts and it is therefore not necessary for this power to apply to the Community Patent Court.

Articles 22 and 23 of the Statute concern appeals against EAEC arbitration awards and preliminary rulings. Since neither of these situations can arise before the Community Patent Court, these provisions should not apply to the Community Patent Court.

Paragraph 1 of Article 24 of the Statute places an obligation of the parties to produce documents and supply information considered desirable by the Court. This obligation seems too wide for private party litigation and consequently should apply to the Community Patent Court in a narrower sense as proposed in Article 13 of Annex II to the Statute. Paragraph 2 of Article 24 of the Statute places a general obligation on Member States and the institutions to provide necessary information.

Articles 25 to 30 of the Statute relate to the taking of evidence by witnesses and expert opinions, and should apply to the Community Patent Court: Article 25 (court's choice of expert), Article 26 (hearing of witnesses), Article 27 (powers with respect to defaulting witnesses), Article 28 (oath of witnesses and experts), Article 29 (hearing of witness or expert by judicial authority of residence), Article 30 (violation of oath).

The elements of the procedure contained in Articles 31 to 38 of the Statute can also apply to the Community Patent Court: Article 31 (principle of public hearings), Article 32 (examination of experts, witnesses and parties), Article 33 (minutes of hearings), Article 34 (establishment of case list), Article 35 (secrecy of deliberations), Article 36 (contents of judgments), Article 37 (signing of judgments and reading of judgment in open court) and Article 38 (adjudication upon costs).

Article 39 of the Statute concerns the order of interim measures in a special summary procedure. This Article should apply to the Community Patent Court with the adjustments specified in Article 15 of Annex II to the Statute proposing that Article 39 would extend to evidence-protection measures and that the Rules of Procedure shall determine who is competent to make orders.

Article 40 of the Statute deals with the intervention of third parties in proceedings supporting the form and order sought by one of the parties. Such intervention should also be possible before the Community Patent Court. However, Article 40(1), (3) of the Statute confers a special right of intervention for the institutions of the Communities, the Member States and other States which are parties to the Agreement on the European Economic Area and the EFTA Surveillance Authority to intervene in proceedings without the general requirement of the establishment of an interest in the result of the case as laid in Article 40(2) of the Statute. This unconditional right of intervention is inappropriately broad to apply to litigation before the Community Patent Court which concerns day to day disputes relating to rights of private parties.

Article 41 of the Statute contains provisions on a judgment by default and should apply to the Community Patent Court together with further specifications laid down in Article 16 of Annex II to the Statute.

Article 42 of the Statute provides for the possibility of third parties to contest a judgment prejudicial to their rights where they had not been heard. Such a provision is incompatible with the principle of legal certainty in private party litigation and should thus not apply to the Community Patent Court. Once a judgment of the Community Patent Court becomes final and can no longer be subject to appeal, there should be no further possibility to reopen the case except in the very limited situation of a revision under Article 44 of the Statute and Article 17 of its Annex II in case of a fundamental procedural defect or a criminal offence. In all other cases parties must be able to rely on the terms of a final judgment. Moreover, a situation envisaged by

Article 42 hardly arises in private party litigation where judgments only produce their effects upon the parties of the case which are bound by the judgment. Situations where third parties might be indirectly affected only arise where there are rights concerned with a patent which has been declared invalid. For these cases, the Rules of Procedure will need to make appropriate provisions ensuring that, where necessary, interests of third parties are already taken into account during the proceedings leading up to the judgment. These could provide, for example, that in case of an exclusive licence, both the right holder and the licensee would need to be sued together whereas in the case of a simple contractual licence the consequences of a declaration of invalidity pronounced in proceedings against the right holder might be left to the legal relationship between right holder and licensee.

Article 43 of the Statute providing for special proceedings in which the scope of a judgment can be subject to interpretation does not seem to be appropriate for private patent litigation and should consequently not apply to the Community Patent Court. The claims granted by the Community Patent Court must be clear and of such nature that they are directly enforceable without the need of further interpretation by the Community Patent Court. Moreover, the provision could be misunderstood as reserving any kind of interpretation of the judgment to the Community Patent Court. However, in the enforcement stage which is according to Articles 244, 256 of the EC Treaty provided for by national law, the competent authority will need to apply the terms of the judgment and decide on the question if a particular embodiment of an invention falls within the scope of an injunction not to infringe a patent. Finally, if systematically used by the defendant in the course of enforcement measures, this provision applied to the Community Patent Court would carry the risk of paralysis of Community patent litigation.

Article 44 of the Statute allowing for a revision of a judgment on the grounds of discovery of new facts, which were unknown at the time judgment was given, seems incompatible with the principle of legal security in private party litigation. Consequently, adaptations to this provision are proposed in Article 17 of Annex II to the Statute limiting a revision to cases of a fundamental procedural defect or a criminal offence in the proceedings that led to the judgment.

Finally, Article 45 of the Statute on time limits and Article 46 of the Statute on a liability bar against the Communities shall apply before the Community Patent Court.

Paragraph 2 of the present Article provides in its first sentence that further and more detailed provisions on the procedure before the Community Patent Court shall be laid down in the Rules of Procedure which, according to Article 225a(5) of the EC Treaty, are established by the Community Patent Court in agreement with the Court of Justice and subject to approval by the Council. The second sentence allows the Rules of Procedure to derogate from Article 40 of the Statute on intervention in order to take account of the special features of private party Community patent litigation. A corresponding provision is contained for the Court of First Instance in Article 53(2) of the Statute.

Article 11 of Annex II to the Statute – European Patent Attorney

This Article contains adaptations to Article 19 of the Statute on legal representation before the Court for the purpose of proceedings before the Community Patent Court.

In patent litigation, questions of technology play an important part in order to reach a legally sound decision. Technical expertise is required not only on the side of the Community Patent Court contributed by assistant rapporteurs but also on the side of the parties.

The first and second paragraphs recognise this important role of technical expertise for the parties giving European Patent Attorneys the right of audience before the Community Patent Court. A reference to the list maintained by the European Patent Office for the purpose of legal representation before it will ensure appropriate and uniform standards for qualifying persons which must be met for efficient proceedings.

The third paragraph applies Article 19(5) and (6) of the Statute to European Patent Attorneys. Where a European Patent Attorney appears before the Community Patent Court, he will enjoy the necessary rights and immunities and the Community Patent Court will have the powers normally accorded to courts of law under the conditions laid down in the Rules of Procedure.

Article 12 of Annex II to the Statute - Oral and written procedure

This Article adapts Article 20 of the Statute concerning the written and oral part of the procedure to proceedings before the Community Patent Court.

It is proposed to rephrase Article 20(4) relating to the conduct of the oral hearing. The obligation of the "reading of a report" by the judge rapporteur seems too rigid for daily trial court proceedings and should be replaced by a more flexible wording referring to the "presentation of the main features of the case". Since the wording of Article 20(4) of the Statute does not allow the hearing of a European Patent Attorney as foreseen before the Community Patent Court by the proposed Article 11 of Annex II to the Statute, the concerned wording should be replaced by the more general wording "hearing of the parties". The question of who actually addresses the court does not have to be enumerated as is currently done in Article 20(4) of the Statute but would be a question of proper legal representation. Finally the hearing of witnesses and experts is replaced by the more general wording of "examination of evidence".

Article 20(5) of the Statute which deals with the Advocate General should not apply to the Community Patent Court as the Advocate General will not participate in proceedings. Instead a provision is proposed that would allow in appropriate cases to pass to a written procedure. Article 20(1) of the Statute lays down the important principle that cases are only decided upon after an oral hearing. For certain cases, an oral hearing might not be appropriate e.g. in simple cases with uncontested facts or where the defendant accepts the plaintiff's claims. For such cases there should be the possibility to deviate from the principle of an oral hearing and exceptionally decide a case in a written procedure. Therefore, the Community Patent Court should have the possibility to dispense with the oral procedure after having heard the parties and in accordance with the Rules of Procedure.

Finally an enabling clause should be introduced which allows for the employment of technical means in the written and oral procedure before the Community Patent Court. This could, for example, apply to the submission of documents in the written procedure or video conferencing at the oral stage. The specification of the parts of

the procedure which can be conducted by electronic means and the conditions for so doing should be left to the Rules of Procedure. Practice will show where, to what extent and under what conditions electronic means should be employed. Moreover technology is constantly developing and the Rules of Procedure would be best suited to keep track of the widening technological possibilities by introducing necessary changes into the procedure.

Article 13 of Annex II to the Statute – Production of evidence

Paragraph 1 of Article 24 of the Statute contains an obligation of the parties to produce documents and supply information considered desirable by the Court. This obligation seems too wide for private party litigation and consequently should apply to the Community Patent Court in a narrower sense. In principle it is the obligation of each party in private party litigation to bring forward the necessary evidence to prove its contested claim. However, under special circumstance it would seem justified to oblige the opposing party to produce evidence in favour of the other party. A reasonable balance between the interests of parties would seem to be struck as recognised by Article 43(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) of 15 April 1994 where a party has presented reasonably available evidence to support its claims, and has, in substantiating those claims cited evidence under the control of the opposing party. In such a case the Community Patent Court may order that evidence be produced by the opposing party, subject to the protection of confidential information.

Article 14 of Annex II to the Statute – Interim and evidence-protection measures

This Article contains special provisions on interim and evidence protection measures.

Paragraph 1 concerns the order of interim measures. Article 243 of the EC Treaty provides that the Court may in cases before it prescribe any necessary interim measures. This provision which is also applied to the Community Patent Court by Article 2 of this Decision does not foresee the ordering of interim measures before main proceedings are pending. However, a need for such a possibility exists in patent litigation where for example a preliminary injunction to stop an infringement is necessary even before the main proceedings have commenced. Also Article 50(6) of the TRIPS Agreement presupposes the possibility to prescribe interim measures in cases where main proceedings have not yet been brought. Consequently the present Article makes use of the possibility foreseen in Article 225a(6) of the EC Treaty to derogate for judicial panels from the EC Treaty provisions relating to the Court of Justice. It is proposed that interim measures shall not be conditional upon main proceedings having already been instituted before the Community Patent Court.

Paragraph 2 provides for evidence-protection measures allowing an order to authorize a detailed description or the physical seizure of infringing goods and related documents in the event of actual or imminent infringement. The measure also known in patent law as *saisie-contrefaçon* supplements the obligation of the parties to produce evidence as laid down in Article 13 of Annex II to the Statute and has proven to be a valuable instrument for the enforcement of intellectual property rights and has therefore also been taken up in Article 8 of the Commission proposal for a directive on measures and procedures to ensure the enforcement of intellectual property rights of 30 January 2003 [COM (2003) 46 final].

Paragraph 3 provides for a claim for adequate compensation in case of interim measures or evidence-protection measures where measures are revoked. Interim measures and evidence protection measures can have a significant economic impact on the party against whom they are ordered. It must also be born in mind that such orders are made in a summary procedure under Article 39 of the Statute, Article 15 of its Annex II at a stage where the judge does not yet have all the necessary elements of fact and evidence to give final judgment. Therefore an appropriate balance between the parties' legitimate interests requires that the applicant obtaining an interim or evidence-protection measure would have the obligation to compensate the opposing party for any injury caused where a measure is not upheld. Such a claim is also provided for in Article 50(7) of the TRIPS Agreement in relation to interim measures and in Articles 8(3) and 10(5) of the Commission proposal for a directive on measures and procedures to ensure the enforcement of intellectual property rights of 30 January 2003 for both measures concerned.

Article 15 of Annex II to the Statute – Special orders

This Article contains adjustments to Article 39 of the Statute on interim measures and measures relating to the suspension of enforcement. Article 39 of the Statute provides a basis for a summary procedure for these cases to be laid down in the Rules of Procedure which may differ from the rules laid down in the Statute. This provision takes account of the special situation and urgency of the measures concerned justifying, where appropriate, deviating from the rules governing main proceedings. For the purpose of proceedings before the Community Patent Court, evidence-protection measures, provided for under Article 14 of Annex II to the Statute should, with a view to their nature and in particular their urgency, qualify for those special measures to be ordered in a summary procedure.

A second amendment for the purpose of proceedings before the Community Patent Court is made with a view to the person entitled to make the orders concerned. Article 39 of the Statute attributes this competence to the president of the Court. This approach does not seem to leave the appropriate degree of flexibility for patent litigation before the Community Patent Court. The question whether the enforcement of a judgment should be suspended is closely linked to the individual case and might consequently be handled more efficiently by the chamber that made the judgment or one of its judges. Interim and evidence-protection measures will also be quite a common procedure in patent litigation and might therefore be better handled by the chamber which is competent for main proceedings or one of its judges. To refer the question who is competent to make orders in a summary procedure to the Rules of Procedure leaves the necessary flexibility to provide for the most suitable solution.

Article 16 of Annex II to the Statute – Judgment by default

This Article makes amendments to Article 41 of the Statute on a judgment by default.

Article 41 of the Statute foresees the possibility for a judgment by default where a defending party, after having been duly summoned, fails to file written submissions in defence. For private party patent litigation this should not be the only situation in which the Community Patent Court should be able to decide the case by a judgment by default. A judgment by default should also be possible where the defendant filed submission in the written part of the procedure but later, after having duly been

summoned, fails to appear at the oral hearing to defend himself. In this situation the Community Patent Court should be able to make a judgment by default which would end the case unless the defendant according to the second sentence of Article 41 of the Statute lodges an objection against the judgment within one month of its notification. Finally, a judgment by default should also be possibly against the plaintiff who, after having been duly summoned, fails to appear at the oral hearing.

Article 17 of Annex II to the Statute – Revision of a judgment

Article 44(1) of the Statute contains a provisions on the revision of a judgment unsuitable for private party litigation before the Community Patent Court. Article 44 allows the revision of a final judgment on the grounds that a decisive factor was unknown at the time the judgment was given. With a view to legal certainty, such grounds are insufficient to reopen a case in private party litigation. Parties must be able to rely on a judgment of the Community Patent Court where that judgment is no longer subject to an appeal even in a case where a decisive fact was unknown at the time of judgment. The reopening of cases must remain very exceptional and should be limited to the discovery of a decisive factor which was unknown to the party claiming the revision and only on the grounds of a fundamental procedural defect or an act which was held by a final court decision to constitute a criminal offence. Only in these very exceptional cases is it justified that a final judgment may legitimately be challenged.

Article 18 of Annex II to the Statute – Settlement

A dispute between the parties may not only be resolved by a final decision of the Community Patent Court in a judgment but also by a settlement between the parties before the Community Patent Court. The present Article lays out the legal basis for an in court settlement which can be concluded by the parties at any time in the course of proceedings. Such a settlement which is confirmed by the Community Patent Court has two important effects: it will terminate the proceedings before the Community Patent Court and it serves as an enforceable title under Articles 244, 256 of the EC Treaty in case a party does not comply with the terms of the settlement. The second sentence clarifies that a settlement cannot affect the validity of a Community patent which is exclusively governed by law and not subject to party autonomy. Of course, parties remain free to conclude a settlement including an agreement to surrender or voluntarily limit the patent.

Article 19 of Annex II to the Statute – Wrongly addressed Community court

Article 54(1) of the Statute concerns the obligation of the registrars of the Court of Justice and the Court of First Instance to forward documents addressed to one of them but accidentally lodged with the other. Article 54(2) of the Statute governs the situation that either the Court of Justice or the Court of First Instance is seised whereas the other court is the competent court. In this case the seised court can refer the action with binding effect. Both provisions shall apply *mutatis mutandis* also in relation to the Community Patent Court.

Article 54(3) of the Statute providing for the possibility to stay proceedings and wait for the ruling of the Court of Justice necessitates some changes and is separately treated in the following Article 20 of Annex II to the Statute.

Article 20 of Annex II to the Statute – Stay of proceedings

This Article contains rules on the stay of proceedings.

Paragraph 1 covers like Article 54(3) of the Statute for the Court of First Instance, the situations in which the Community Patent Court may, after hearing the parties, stay proceedings in order to wait for a decision of another Community court. The Community Patent Court should have the possibility to stay proceedings where there is a sufficient link between the questions at issue before it and those raised in a case before the Court of Justice or the Court of First Instance. A stay of proceedings can be considered where the Court of Justice is seised of a case raising the same issue of interpretation either by way of a preliminary ruling or in the context of a review in accordance with Article 225(2) of the EC Treaty. A stay of proceedings could further be considered where the Court of First Instance has to decide on the validity of the same Community patent that is also subject to proceedings before the Community Patent Court. Under these circumstances a stay of proceedings should be considered with a view to a uniformity of jurisprudence and efficient case handling.

Paragraph 2 provides for the possibility of the Community Patent Court to stay proceedings where it is seised of an invalidity action and where opposition proceedings are ongoing before the European Patent Office. No automatic stay of proceedings is foreseen. It is left to the Community Patent Court to decide this question in view of the circumstances of the individual case. The Community Patent Court may, after hearing the parties, stay proceedings until such time as a final decision is issued on the opposition. Such a final decision, i.e. a decision that is no longer subject to further legal remedy before the European Patent Office, can be issued by the Opposition Division or where an appeal is filed by the Board of Appeal of the European Patent Office.

Article 21 of Annex II to the Statute – Communication of decisions

This Article applies Article 55 of the Statute determining the decisions to be notified and their recipients with slight amendments to the Community Patent Court. The registrar shall notify final decision, decisions disposing of substantive issues in part only or disposing of a procedural issue concerning a plea of lack of competence or inadmissibility to all parties. Member States and the institutions of the Communities which have neither intervened nor been a party to the case shall only be informally sent the final decision of the Community Patent Court for information purposes. A formal notification of the full range of decisions seems inadequate.

Article 22 of Annex II to the Statute – Enforcement of decisions of the Community Patent Court

This Article concerns the enforcement of decisions of the Community Patent Court.

Paragraph 1 lays down two principles governing the enforceability of decisions of the Community Patent Court. Decisions of the Community Patent Court should always be enforceable if they are no longer subject to appeal. Enforcement commences where the decision of the Community Patent Court is *res judicata*. Consequently the appeal against a decision of the Community Patent Court preventing the *res judicata* effect should have a suspensory effect for the enforceability of the decision. However, a party that has won a case at first instance

can have a legitimate interest to start enforcing the terms of a decision even where the opposing party appeals the decision. To postpone any type of enforcement until after a decision on the appeal might dramatically reduce the value of proceedings before the Community Patent Court since the effective remedy might only be realised at a point in time where the party can no longer gather the economic benefit that the proceedings were meant to ensure. Moreover, it has to be born in mind that the Community Patent Court will have decided the case after a thorough examination. On the other hand if the enforcement is allowed prior to the decision reaching *res judicata*, safeguards are necessary to adequately protect a party against whom the enforcement is directed from damages if the decision is not finally upheld on appeal. The present Article strikes a balance between these interests of parties involved in allowing the Community Patent Court to declare its decisions enforceable while, if necessary, subjecting enforcement to the provision of security. Where the Community Patent Court subjects the enforcement to the provision of security, the defendant who successfully appeals a first instance decision which was enforced against him can always recover e.g. a paid sum if necessary from the security even where the opposing party in the meantime has fallen into insolvency. The kinds of situations in which a security would not need to be provided must be developed by the Community Patent Court. This could e.g. be the case for a judgment by default where the party against whom the decision is directed, though duly summoned, has not entered an appearance or where a party has accepted a claim.

Paragraph 2 simplifies the mechanism for the enforcement of decisions of the Community Patent Court. According to Article 225a(6) of the EC Treaty, the enforcement of the decisions of the Community Patent Court is governed by Articles 244, 256 of the EC Treaty unless the decision establishing the Community Patent Court provides otherwise. Under Article 256 of the EC Treaty, enforcement is governed by the rules of civil procedure in force in the State in the territory of which it is carried out. In order to be able to start such enforcement procedures, the national authority designated for this purpose by the Member State needs to append to the decision an order for its enforcement. For doing so, the national authority is entitled only to verify the authenticity of the decision. Even though the role of the national authority in this context is already limited to a formality check of the authenticity of the decision to be enforced, this would seem to be neither necessary nor suitable for the enforcement of decisions of the Community Patent Court. The Community Patent Court would itself be best placed to certify the authenticity of the enforceable decision. A special procedure to obtain an order of enforcement from a national authority would unduly prolong enforcement and would in particular present problems for the enforcement of interim measures which by nature require rapid actions, sometimes within hours. It is therefore proposed that the Community Patent Court itself would append the order of enforcement to its decision which a party could then directly enforce according to the national civil procedure law concerned. Paragraph 2 also allows the enforcement of decisions against Member States. Member States may, like any other person or legal entity, be a party to proceedings before the Community Patent Court. They may obtain a Community patent and they may be subject to infringement proceedings brought by other right holders. Consequently decisions of the Community Patent Court must be enforceable against them.

Paragraph 3 contains a further specificity concerning the enforcement of decisions of the Community Patent Court. Decisions ordering the defendant to act in a certain way or to abstain from certain acts are enforceable through an order of a penalty payment in case of non-compliance with the terms of a decision. The Community Patent Court itself should be able to order such a penalty payment for non-compliance with its decisions or orders. If for example the Community Patent Court orders a defendant to stop infringement, it should at the same time be able to make an order whereby the non-compliance would be sanctioned by an obligation to pay a certain sum of money. If such an order necessitated a separate application to the courts of Member States, valuable time could be lost in ensuring that the decision of the Community Patent Court is respected. The Community Patent Court may order a single amount to be paid in case of non-compliance with the court decision. It may also order the payment of a recurrent fine where the fines are dependant on circumstances to be specified by the court such as e.g. each case of non-compliance with the court decision or the non compliance within a certain time span. The individual fine must be proportionate with a view to the importance of the order to be enforced and may in any case not exceed an amount of EUR 50 000.

Article 23 of Annex II to the Statute – Court fees

This Article introduces Court fees for proceedings before the Community Patent Court.

Paragraph 1 contains the principle that appropriate court fees will be charged for proceedings before the Community Patent Court. While proceedings before the Court of Justice and the Court of First Instance are free of charge, it seems appropriate for Community patent litigation that parties adequately contribute to the costs incurred by the Community Patent Court. Before the Community Patent Court, the parties will litigate disputes about their subjective private rights. The costs of such a dispute between private parties should not entirely be left to be paid for by the public.

Paragraph 2 concerns the adoption of a schedule of fees which would provide for the individual fees as well as the amount to be charged. The schedule of fees should be adopted by the Council by qualified majority on a proposal from the Commission and after consulting the European Parliament and the Court of Justice or at the request of the Court of Justice and after consulting the European Parliament and the Commission. The amount to be charged would need to strike the right balance between the principle of fair access to justice and an adequate contribution of the parties for the services rendered by the Community Patent Court. This means on the one hand that fees must not be of a kind that they create a prohibiting effect rendering the enforcement of Community patents unduly costly. Also for defendants, in particular SMEs, the risk of being sued before the Community Patent Court must not present a financial threat inducing them to rather give up a position than having a dispute decided. On the other hand, parties should shoulder a fair share of the costs that their litigation creates. In addition to a balanced schedule of fees, the Rules of Procedure would need to provide for legal aid for parties unable to meet the costs as is the case in Article 76 of the Rules of Procedure of the Court of Justice and Articles 94 ff. of the Rules of Procedure of the Court of First Instance.

Paragraph 3 specifies that fees shall be paid in advance and that a party which has not paid a prescribed court fee may be excluded from further participation in the proceedings. Parties would pay the due amount according to the schedule of fees

before the Community Patent Court takes action. This shall ensure that the Community Patent Court will receive its fees without spending unnecessary resources on the collection of fees including the world wide enforcement against parties that are not paying their fees. The Community Patent Court will adjudicate upon costs in accordance with Article 38 of the Statute and the relevant provisions of the Rules of Procedure which would lay down detailed provisions on which party ultimately has to bear the costs as is the case for the Court of Justice in Articles 69 ff. and the Court of First Instance in Articles 87 ff of their respective Rules of Procedure. A party winning a case which had advanced a fee would thus be able to reclaim the fees from the losing party. Finally, it should be noted that the Community Patent Court "may" exclude parties from further proceedings. This allows the Community Patent Court to develop a practice under which circumstances fees exceptionally need not be paid in advance as may be appropriate in the case of urgent interim measures leaving no time for prior payment of fees.

Article 24 of Annex II to the Statute –Hearings in Member States

This Article clarifies that the Community Patent Court may hold hearings in Member States other than that in which its seat is located as agreed upon by the Council in its common political approach of 3 March 2003. It is for the Community Patent Court to decide in the individual case on the appropriateness of such hearings.

Article 25 of Annex II to the Statute – Language of proceedings

This Article lays down the principles governing the language of proceedings before the Community Patent Court.

Paragraph 1 provides that the Community Patent Court will conduct proceedings in the official EU language of the Member State where the defendant is domiciled or in one of them to be chosen by the defendant, where in a Member State there are two or more official EU languages. This principle which was recognised in the common political approach of the Council of 3 March 2003 shall ensure that an EU domiciled defendant who is confronted with claims of a plaintiff can defend himself in a language he knows or can be expected to know. Since the domicile of the defendant can regularly be determined with no great difficulty, the chosen rule is very clear contributing to legal certainty for the plaintiff. Where, however, the defendant is not domiciled in a Member State, the Community Patent Court shall conduct proceedings in the official EU language in which the patent was granted. This provision contains a clear rule for all other possible situations in which the defendant has his domicile in a third State.

Paragraph 2 provides as agreed upon by the Council in its 3 March 2003 common political approach that at the request of the parties and with the consent of the Community Patent Court, any official EU language can be chosen as language of proceedings to take account of their respective situations. Such an agreement of the parties would be likely e.g. where the defendant though domiciled in a different Member State originates from the same Member State as the plaintiff or where in particular companies communicate in the same international business language which the defendant would prefer to use in preference to the language of his domicile. Under normal circumstances, the Community Patent Court would consent to the joint request of the parties to change from one language of proceedings to another. However, for exceptional cases, the Community Patent Court should have

the power to reject the request e.g. where the request is made untimely causing difficulty to the Community Patent Court such as a corresponding request close to or at an oral hearing for which interpretation cannot be provided.

Paragraph 3 clarifies that the Community Patent Court may hear, in accordance with the Rules of Procedure, the parties in person, witnesses and experts in any language. The Community Patent Court must be allowed, where it considers necessary, to question any such person even where that person does not speak any of the official EU languages. In such a case, the registrar shall provide for interpretation into the language of proceedings and at the request of any party into the language used by that party at the oral hearing in accordance with the Rules of Procedure.

Paragraph 4 finally provides for the possibility of the Community Patent Court to allow the submissions of accompanying documents drawn up in a language other than the language of proceedings avoiding unnecessary and costly translations. However, the Community Patent Court may at any time order that such a translation be produced.

Article 26 of Annex II to the Statute – Appeal against decisions of the Community Patent Court

This Article contains provisions on the possibility to appeal decisions of the Community Patent Court.

Paragraph 1 lays down, that final decisions of the Community Patent Court may be appealed within two month of the notification of the decision. This provision corresponds to Article 56(1) of the Statute governing the appeal against decisions of the Court of First Instance. The additional wording of that Article relating to an appeal against decisions "disposing of substantive issues in part only or disposing of a procedural issue concerning a plea of lack of competence or inadmissibility" has not been retained for the Community Patent Court. A decision disposing of substantive issues in part would be a judgment of the Community Patent Court and could thus be appealed against. The same can be said for a decision declining competence or declaring an action inadmissible.

Paragraph 2 contains a specific provision on the possibility to appeal against interim measures made pursuant to Article 243 of the EC Treaty, orders for the suspension of enforcement made under Article 256(4) of the EC Treaty and evidence protection measures provided for in Article 14 of Annex II to the Statute. An appeal against such orders may be brought within two month from their notification. A corresponding provision for the Court of First Instance is contained in Article 57(2) of the Statute. In the situations referred to by Article 50(2) of the TRIPS Agreement where such an order has been made without the prior hearing of the party adversely affected by the measures, the legal remedy shall not consist of a direct appeal. Instead that party may, within two months of the notification, lodge an objection with the Community Patent Court which then shall, with due consideration of the arguments brought forward by the party adversely affected, review and modify, revoke or confirm the measures. That decision of the Community Patent Court would then be subject to an appeal. This procedure ensures that an appeal is reserved as a legal remedy against a considered decision of the Community Patent Court handed down after an *inter partes* procedure.

Paragraph 3 provides for an appeal against a decision dismissing an application to intervene within two weeks from the notification of the decision dismissing the application (see also for the Court of First Instance Article 57(1) of the Statute).

Paragraph 4 concerns the possibility of an appeal against other decisions taken by the Community Patent Court in the course of proceedings. The possibility to appeal against every decision disposing of procedural issues seems too wide and would risk paralysing the proceedings. Such appeals should only be possible where explicitly allowed in the Rules of Procedure. Unless otherwise provided for in the Rules of Procedure, any mistake in the procedure would have to be dealt with in the framework of the appeal against the judgment itself ensuring swift first instance proceedings while leaving sufficient safeguards for the parties. An isolated appeal against decisions of a procedural nature could be considered where an immediate appeal is justified by the importance of the disputed decision, for example in the case of a decision of the Community Patent Court on a challenge for bias.

Paragraph 5 clarifies that an appeal provided for in paragraphs 1 to 4 of this Article may only be brought by the party which has been unsuccessful, in whole or part, in its submissions (see also for the Court of First Instance Article 56(2) of the Statute). The procedure referred to in paragraphs 2 and 3 shall be conducted under the summary procedure provided for in Article 39 of the Statute (see also for the Court of First Instance Article 57(3) of the Statute).

Article 27 of Annex II to the Statute – Grounds for appeal

This Article contains the grounds for appeal. Article 225a(3) of the EC Treaty restricts the appeal against decision of a panel set up under that Article to points of law unless otherwise provided for in the decision establishing the panel.

Paragraph 1 provides for the Community Patent Court that an appeal may be based on points of law and matters of fact.

Paragraph 2 specifies on what grounds an appeal on points of law may lie. It could lie on the grounds of lack of competence of the Community Patent Court, a breach of procedure which adversely affects the interests of the appellant or the infringement of Community law by the Community Patent Court. This same list is contained in Article 58(1) of the Statute for an appeal on points of law against decisions of the Court of First Instance to the Court of Justice.

Paragraph 3 specifies on what grounds an appeal on matters of fact shall lie. While an appeal in private party litigation should not be restricted to points of law but should also allow parties to raise matters of fact, a full retrial of a case in second instance should be excluded. A full retrial would reduce the value of the first instance proceedings before the Community Patent Court and risk carrying the trial into the appeal instance before the Court of First Instance which would then risk that it would not be able to properly fulfil its function as an appeal instance, namely to concentrate on specific issues singled out by the parties for more detailed review at a higher level. To this end, an appeal on matters of fact may lie on the grounds of a re-evaluation of facts and evidence submitted to the Community Patent Court. On appeal, the Court of First Instance would be free to make its proper evaluation of the facts brought forward by the parties at first instance before the Community Patent Court. Also where there are contested facts, the Court of First Instance could make

its own evaluation of the evidence produced at first instance. However, the possibility for the parties to submit new facts or evidence for the first time during the appeal proceedings would be restricted to those situations where their submission by the party concerned could not reasonably have been expected during the proceedings before the Community Patent Court. This could, for example, be the case if a fact was unknown to a party and could, while applying due diligence, not have been known by that party or if the Community Patent Court took a view of the case that suggested known facts to be irrelevant. It is left to the Court of First Instance to establish through jurisprudence under what circumstances the submission of facts and evidence could not have been reasonably expected at first instance leaving the necessary flexibility to take account of all the possible situations that may occur in practise.

Paragraph 4 provides that no appeal shall lie regarding only the amount of the costs or the party ordered to pay them as does Article 58(2) of the Statute for appeals against decisions of the Court of First Instance.

Article 28 of Annex II to the Statute – Decisions by the Court of First Instance and referral back to the Community Patent Court

This Article concerns the decision by the Court of First Instance and a possible referral of the case back to the Community Patent Court.

Paragraph 1 provides that where the appeal is well founded, the Court of First Instance shall quash the decision of the Community Patent Court and give final judgment. Only in exceptional circumstances may the Court of First Instance refer the case back to the Community Patent Court for judgment. It seems essential for efficient and swift patent proceedings to avoid unnecessary referrals of a case back and forth between instances. Unlike in Article 61 of the Statute, which addresses the appeal against decisions of the Court of First Instance to the Court of Justice on points of law stating that the Court of Justice may give final judgment where the state of proceedings so permits or otherwise refer the case back to the Court of First Instance, the present Article states the rule that the Court of First Instance in patent appeal proceedings shall decide the case. This follows from the nature of patent appeal proceedings which can also take factual elements into consideration. The Court of First Instance can establish those facts that are missing in its view and then give final judgment whereas the Court of Justice can only use the established facts of the first instance which makes it necessary to refer back a case if further facts need to be established.

However, there are cases where a referral back to the Community Court would be appropriate. A referral back would seem appropriate where the case was not heard in substance before the Community Patent Court and a direct decision of the Court of First Instance would take away the entire first instance for the parties. Examples for such a referral back to the Community Patent Court would be cases where an appeal was brought forward against a judgment declining competence or deciding e.g. only on the liability as such but not the amount of damages. Another situation where a referral back could be considered is where the Community Patent Court committed a fundamental procedural mistake that had an effect on the judgment which could be the case e.g. with a violation of the right to be heard. In such a case the first instance proceedings might not be considered to be an effective legal remedy.

Paragraph 2 provides that the Community Patent Court shall be bound by the decision of the Court of First Instance on points of law where a case is referred back to it (see for the Court of First Instance Article 61(2) of the Statute).

Article 29 of Annex II to the Statute – Rules of Procedure

This Article provides that the Rules of Procedure of the Community Patent Court shall contain any provision necessary for applying and, where required, supplementing Annex II to the Statute. A corresponding provision for the Court of Justice and the Court of First Instance is contained on Article 63 of the Statute.

Chapter II – Appeal proceedings before the Court of First Instance

Chapter II contains amendments to the Statute of the Court of Justice with respect to the function of the Court of First Instance as Community Patent Appeal Court providing in particular for a specialised patent appeal chamber within the Court of First Instance and special provisions governing the procedure before it.

Article 5 – Number of Judges of the Court of First Instance

This Article proposes to raise the number of judges of the Court of First Instance by three judges from 15 to 18. Community patent cases would be heard by a specialised appeal chamber which should be set up within the Court of First Instance in accordance with Article 61a of the Statute as amended by Article 6 of this Decision. The three judges forming the patent appeal chamber should be additional judges with a view to the required professional profile of candidates and the increased case load of the Court of First Instance caused by Community patent appeal proceedings.

Article 6 –Community patent appeal proceedings

This Article inserts into the Statute of the Court of Justice an Article 61a containing special provisions concerning Community patent appeal proceedings before the Court of First Instance.

Paragraph 1 of the proposed Article 61a of the Statute as amended provides for a special chamber to be set up within the Court of First Instance for the purpose of hearing appeals against decisions of the Community Patent Court composed of three judges. Such a specialised chamber seems appropriate with a view to the special type of litigation before it. Litigation concerning the Community Patent is private party litigation in a field that requires a particular experience. It would be difficult to build up and maintain the necessary experience if such appeal proceedings were heard by different chambers. Instead, proceedings should be handled by only one chamber, thus concentrating the expertise within the Court of First Instance.

Paragraph 2 of Article 61a of the Statute as amended proposes that the judges sitting in the patent appeal chamber of the Court of First Instance should be judges having a high level of legal expertise in patent law. This provision is in line with the general approach followed in the establishment of a Community patent jurisdiction i.e. to create a specialised court system for litigation on the Community patent. One of the central demands to come forward with a Community patent system has been to provide for an increased legal security in the Union by a centralised and specialised jurisdiction with experienced judges. As this seems vital for the success of the entire

system, judges sitting at first instance as well as those sitting on appeal should have expertise in patent law. The present provision does not alter in any way Article 224 of the EC Treaty relating to the appointment of judges of the Court of First Instance. That Article, of course, also applies to the appointment of the judges meant to form the patent appeal chamber. With the present provision, the Council would only agree to present candidates and appoint judges with a particular professional profile.

The reference to Article 17(5) and Article 50 of the Statute clarifies that the establishment of a patent appeal chamber within the Court of First Instance is not meant to separate this chamber from the rest of the court. It shall merely be ensured that Community patent appeal cases in the standard composition are heard by specialised judges with particular experience in the field of law concerned. However, any Member of the Court of First Instance may sit in the patent appeal chamber where an additional judge needs to sit. This would be the case where the patent appeal chamber sits in accordance with Article 50 of the Statute with more than three judges which could be appropriate e.g. for cases that would reach beyond patent law and concern the unity and consistency of Community law. Also in the event that one judge of the patent appeal chamber is prevented from attending, a judge of another chamber can be called upon to sit in accordance with Article 17(5) of the Statute. Finally nothing should prevent that, where the caseload so permits, the patent appeal chamber is attributed other cases than Community patent cases such as Community trade mark or design cases in accordance with Article 50(2) of the Statute.

Paragraph 3 of Article 61a of the Statute as amended concerns the appeal procedure before the patent chamber of the Court of First Instance. The object of this provision is to ensure that the Statute provisions governing the procedure for Community patent litigation are the same for the complete trial of first and second instance. Where special procedural provisions are necessary in view of the special character of Community patent litigation i.e. private party litigation these should apply in a uniform manner for the Community Patent Court and the Court of First Instance on appeal. Article 53 of the Statute provides for the Court of First Instance that the procedure before it shall be governed by Title III of the Statute. The same will be valid for the Community Patent Court according to Article 10 of Annex II to the Statute. The special provisions amending Title III of the Statute with regard to the procedure at first Instance before the Community Patent Court are also made applicable to the procedure before the patent appeal chamber of the Court of First Instance. The following provisions of Annex II to the Statute are concerned: Assistant rapporteur (Article 7), provisions from Title III of the Statute that do not apply to patent litigation (Article 10), the role of European Patent Attorneys in the representation of parties (Article 11), the oral and written procedure (Article 12), the production of evidence (Article 13), interim and evidence-protection measures (Article 14), special orders in a summary procedure (Article 15), judgment by default (Article 16), the revision of a judgment (Article 17), settlement (Article 18), the obligation of all Community Courts to forward wrongly addressed documents and refer actions to the competent court (Article 19), the stay of proceedings (Article 20), the transmission of decisions (Article 21), the enforcement of decisions (Article 22) and Court fees (Article 23). For details, see the provisions referred to by the present Article.

The second sentence of Paragraph 3 provides that Member States and the institutions of the European Community shall have the right to intervene in Community patent cases before the Court of First Instance in accordance with Article 40(1) of the

Statute. This possibility is excluded by Article 10 of Annex II to the Statute for proceedings at first instance before the Community Patent Court. While such intervention at the first instance seems too broad for the entirety of cases at first instance, such a possibility seems appropriate for the second instance allowing Member States and the institutions of the European Community to contribute to the development of legal questions of Community patent law.

Paragraph 4 of Article 61a of the Statute as amended provides for the language of appeal proceedings which shall be the language of proceedings in which the case was conducted before the Community Patent Court. This ensures a uniform treatment of the entire case, both at first and second instance. Applications, decisions, written contributions, testimonies of witnesses, expert opinions etc. can be directly considered in second instance without further translations. Also parties might have disposed for their representation at first instance with regard to the language of proceedings and might wish that their representative who is familiar with the case also represents them before the Court of First Instance on appeal. A reference to the provision contained in Article 25(1) of Annex II to the Statute providing for the language of the Member State where the defendant is domiciled as language of proceedings before the Community Patent Court could not be made as the plaintiff of first instance might become the defendant in appeal. However, the further principles laid down in Article 25(2) to (4) of Annex II to the Statute concerning an agreement of the parties on the language of proceedings, the hearing of parties in person, witnesses and experts in a language other than the language of proceeding and the possibility to submit accompanying documents in a language other than the language of proceedings shall also apply to the appeal proceedings.

Chapter III – Final provisions

Chapter III contains final provisions concerning transitional provisions and the entry into force of this Decision.

Article 7 – Transitional provisions

Paragraph 1 of this Article concerns the appointment of the president of the Community Patent Court providing that the first president of the Community Patent Court shall be appointed in the same manner as its members unless the Council decides that also the first president shall be elected by the judges according to Article 4 of Annex II to the Statute. A parallel approach had also been taken for the Court of First Instance in Article 11(1) of Council Decision 88/591/ECSC, EEC, Euratom of 24 October 1988 establishing the Court of First Instance.

Paragraph 2 concerns the newly appointed first judges of the Community Patent Court. In order to establish a cycle where the Community Patent Court is only partially re-staffed at any one time, as foreseen by Article 2 of Annex II to the Statute, some members of the Community Patent Court will need to have a shorter initial term of office. The president of the Council shall proceed to choose by lot the judges whose terms of office are to expire at the end of the first three years which had also been foreseen for the Court of First Instance in Article 12 of Council Decision 88/591/ECSC, EEC, Euratom of 24 October 1988 establishing the Court of First Instance.

Article 8 – Entry into force

This Article contains provisions for the entry into force of this Decision. The entry into force should depend on the adoption of the Council Decision taken pursuant to Article 229a of the EC Treaty conferring jurisdiction on the Court of Justice relating to the Community patent and its acceptance by all Member States in accordance with their constitutional requirements. After the corresponding notification by Member States, the necessary preparations for the establishment of the Community Patent Court and the setting up of the patent appeal chamber of the Court of First Instance can commence.

However, Article 1 of Annex II to the Statute containing the provision attributing jurisdiction within the Court of Justice to the Community Patent Court should only enter into force on the date on which the Council Decision conferring jurisdiction on the Court of Justice enters into force which in turn is dependent on the publication of a notice by the president of the Court of Justice that the Community Patent Court and the appeal chamber within the Court of First Instance have been constituted in accordance with law. This ensures that the conferral of jurisdiction on the Court of Justice and the attribution of jurisdiction to the Community Patent Court take effect at the same point in time marking the end of the transitional period and the beginning of the Community jurisdiction.

Proposal for a

COUNCIL DECISION

**establishing the Community Patent Court
and concerning appeals before the Court of First Instance**

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Articles 225a, 245 thereof,

Having regard to the proposal from the Commission¹,

Having regard to the opinion of the European Parliament²,

Having regard to the opinion of the Court of Justice³,

Having regard to the opinion of the European Economic and Social Committee⁴,

Whereas:

- (1) The European Council held in Lisbon in March 2000 called for the necessary steps to increase the competitiveness of the Union in a modern, knowledge-based economy underlining the importance of effective Community-wide patent protection.
- (2) The system of patent protection has been characterised by patents granted either by a national patent office in a Member State or by the European Patent Office with effect in a Member State and by enforcement of those patents before the national courts of the Member State concerned.
- (3) Innovative European industry relies on effective Community-wide legal protection for its inventions. The creation of a Community patent system comprising a unitary Community patent title and the possibility of enforcing such a right before a Community jurisdiction to be established at the latest by 2010 after a transitional period in which national courts retain competence will provide the missing elements completing the system of patent protection in the Union.
- (4) Council Regulation (EC) No .../2003⁵ creates a Community patent title. Holders of such a title will enjoy Community wide protection of an invention according to the uniform standards of the regulation.

¹ OJ C
² OJ C
³ OJ C
⁴ OJ C
⁵ OJ L

- (5) By Decision 2003/.../EC⁶, the Council confers jurisdiction on the Court of Justice in certain disputes relating to the Community patent, recommending those provisions to the Member States for adoption in accordance with their respective constitutional requirements.
- (6) The second paragraph of Article 220 of the Treaty provides that judicial panels may be attached to the Court of First Instance under the conditions laid down in Article 225a thereof, in order to exercise, in certain specific areas, the judicial competence laid down in the Treaty.
- (7) The jurisdiction conferred on the Court of Justice under Article 229a of the Treaty in disputes relating to the Community patent should be exercised at first instance by a judicial panel established on the basis of Article 225a of the Treaty, to be called "Community Patent Court".
- (8) Article 225(2) of the Treaty provides that the Court of First Instance has jurisdiction to hear and determine actions and proceedings brought against decisions of the judicial panels set up under Article 225a of the EC Treaty. For this purpose a specialised patent appeal chamber should be created within the Court of First Instance to hear appeals against decisions of the Community Patent Court. Decisions made by the Court of First Instance on appeal against decisions of the Community Patent Court are according to Article 225(2) of the Treaty, exceptionally, subject to review by the Court of Justice where there is a serious risk to the unity or consistency of Community law.
- (9) In order to take account of the special nature of private-party Community patent litigation and to ensure a uniform procedure at both instances, amendments to the procedural rules contained in the Protocol on the Statute of the Court of Justice are necessary, both for the procedure at first instance before the Community Patent Court and on appeal before the Court of First Instance.
- (10) A centralised and specialised Community court system, holding exclusive jurisdiction for Community patent disputes and composed of a first-instance Community Patent Court and an appeal chamber within the Court of First Instance, should ensure expertise and decisions of the highest quality. It should guarantee efficient patent proceedings for the whole Community, the establishment of a common body of case-law and the uniform application of Community patent law,

⁶ OJ L

HAS DECIDED AS FOLLOWS:

Chapter I

Community Patent Court

Article 1

Establishment

A judicial panel, to be called "Community Patent Court ", shall be attached to the Court of First Instance of the European Communities.

Its seat shall be at the Court of First Instance.

Article 2

Application of Treaty provisions

Save as hereinafter provided for in this Chapter, Articles 241, 243, 244 and 256 of the Treaty shall apply to the Community Patent Court.

Article 3

Statute provisions for judicial panels

The following Title VI is added to the Protocol on the Statute of the Court of Justice:

"Title VI

JUDICIAL PANELS

Article 65

The provisions relating to the jurisdiction, the composition, and the organisation of judicial panels established under Article 225a of the Treaty, and the procedure before them, shall be as laid down in the annexes to this Statute."

Article 4

Annex to the Protocol on the Statute of the Court of Justice

The following Annex [II] is added to the Protocol on the Statute of the Court of Justice:

"Annex [II]

Community Patent Court

Article 1

The Community Patent Court shall have, at first instance, exclusive jurisdiction in disputes relating to the application of Council Regulation (EC) No.../... [of ... on the Community patent] and Council Regulation (EC) No .../... [of ... on the Community supplementary protection certificate] to the extent that jurisdiction is conferred on the Court of Justice pursuant to Article 229a of the EC Treaty.

Article 2

The Community Patent Court shall consist of seven Judges, who shall be appointed for a period of six years. The membership shall be partially renewed every three years, replacing four and three members alternately. Retiring members shall be eligible for reappointment.

The Judges shall be chosen from candidates presented by the Member States having an established high level of legal expertise in patent law. They shall be appointed by the Council on the basis of their expertise after consultation of a committee to be set up in accordance with Article 3.

Article 3

An advisory committee to be set up for this purpose shall, prior to the appointment decision of the Council, give an opinion on the adequacy of the profile of candidates with a view to the function of a Judge at the Community Patent Court. It may attach to its opinion a list of candidates possessing the most appropriate high level of legal experience. Such a list shall comprise a number of candidates twice the number of Judges to be appointed by the Council.

The advisory committee shall be composed of seven members chosen from among former members of the Court of Justice, the Court of First Instance, the Community Patent Court or lawyers of recognised competence. The appointment of members of the advisory committee and its operating rules shall be decided by the Council, acting by a qualified majority, on a proposal from the President of the Court of Justice.

Article 4

The Judges shall elect the President of the Community Patent Court from among their number for a term of three years. He may be re-elected.

Article 5

Articles 2 to 7, Articles 13, 14 and 15, the first, second and fifth paragraphs of Article 17, and Article 18 of the Statute shall apply to the Community Patent Court and its members.

The oath referred to in Article 2 of the Statute shall be taken before the Court of Justice and the decisions referred to in Articles 3, 4 and 6 of the Statute shall be adopted by that Court after hearing the Court of First Instance and the Community Patent Court.

Article 6

The Community Patent Court shall appoint its Registrar and lay down the rules governing his service. The fourth paragraph of Article 3 of the Statute and Articles 10, 11 and 14 thereof shall apply to the Registrar of the Community Patent Court *mutatis mutandis*.

Article 7

Technical experts shall assist the Judges throughout the handling of the case as Assistant Rapporteurs. The fourth paragraph of Article 3 and Article 13 of the Statute shall apply.

Assistant Rapporteurs must have a high level of expertise in the relevant technical field. They shall be appointed for a period of six years on a proposal from the Court of Justice. Retiring Assistant Rapporteurs shall be eligible for reappointment.

Assistant Rapporteurs are required, under the conditions laid down in the Rules of Procedure, to participate in the preparation, the hearing and the deliberation of cases. They shall have the right to put questions to the parties. They shall not have a right to vote.

Article 8

The Community Patent Court shall sit in chambers of three Judges.

In certain cases governed by the Rules of Procedure, the Community Patent Court may sit in an enlarged configuration, or be constituted by a single Judge. They shall contain provisions concerning the quorum.

The President of the Community Patent Court shall preside over one of the chambers of three Judges. In addition, he shall preside where the Community Patent Court sits in an enlarged configuration. The President of the remaining chambers shall be elected by the Judges from among their number for a term of three years. They may be re-elected.

The composition of the chambers and the assignment of cases to them shall be governed by the Rules of Procedure.

Article 9

The President of the Court of Justice or, where appropriate, the President of the Court of First Instance shall, acting by common accord with the President of the Community Patent Court, determine the conditions under which officials and other servants attached to the Court of Justice shall render their services to the Community Patent Court to enable it to function. Certain officials or other servants shall be responsible to the Registrar of the Community Patent Court under the authority of the President of the Community Patent Court.

Article 10

The procedure before the Community Patent Court shall be governed by Title III of the Statute with the exception of the second paragraph of Article 21, Articles 22 and 23, the first and third paragraphs of Article 40, Article 42 and Article 43 thereof. It shall be subject to Articles 11 to 25 of this Annex.

Such further and more detailed provisions as may be necessary shall be laid down in its Rules of Procedure. The Rules of Procedure may derogate from Article 40 of the Statute in order to take account of the specific features of litigation in the field of Community patents.

Article 11

The lawyer referred to in Article 19 of the Statute may be assisted by a European Patent Attorney whose name appears on the list maintained by the European Patent Office for the purpose of legal representation before it and who is a national of a Member State or of another State which is a party to the Agreement on the European Economic Area.

The European Patent Attorney shall be allowed to speak at hearings under the conditions laid down in the Rules of Procedure.

The fifth and sixth paragraphs of Article 19 of the Statute shall apply *mutatis mutandis*.

Article 12

By way of derogation from the fourth, fifth and sixth paragraphs of Article 20 of the Statute the following rules shall apply:

The oral procedure shall consist of the presentation of the main features of the case by the Judge acting as Rapporteur, the hearing by the Community Patent Court of the parties, and the examination of evidence.

The Community Patent Court may, in accordance with the Rules of Procedure and after having heard the parties, dispense with the oral procedure.

The Rules of Procedure may provide that all or part of the procedure may be conducted in electronic form, and the conditions for so doing.

Article 13

By way of derogation from the first sentence of the first paragraph of Article 24 of the Statute the following rule shall apply:

Where a party has presented reasonably accessible evidence sufficient to support its claims, and has, in substantiating those claims, cited evidence which is to be found under the control of the opposing party, the Community Patent Court may order that such evidence be produced by the opposing party, subject to the protection of confidential information.

Article 14

The competence of the Community Patent Court to prescribe any necessary interim measures shall not be conditional upon main proceedings having already been instituted before it.

Where there is a demonstrable risk that evidence may be destroyed even before the commencement of proceedings on the merits of the case, the Community Patent Court may, in the event of an actual or imminent infringement of a Community patent, authorise in any place either the detailed description, with or without the taking of samples, or the physical seizure of the infringing goods, and, in appropriate cases, the documents relating thereto.

Where interim or evidence-protection measures have been revoked the Community Patent Court shall order the applicant, at the request of the defendant, to provide the defendant adequate compensation for any injury caused by these measures.

Article 15

Article 39 of the Statute relating to special orders in a summary procedure shall also apply to evidence-protection measures. The Rules of Procedure shall determine who is competent to make the orders.

Article 16

Without prejudice to Article 41 of the Statute, a judgment by default may be given against the party that, after having been duly summoned, fails to appear at the oral hearing.

Article 17

By way of derogation from the first paragraph of Article 44 of the Statute, the following rule shall apply:

An application for revision of a judgment may exceptionally be made to the Community Patent Court on discovery of a fact which is of such a nature as to be a decisive factor, and which, when the judgment was given, was unknown to the party claiming the revision, and only on the grounds of a fundamental procedural defect or of an act which was held, by a final court decision, to constitute a criminal offence.

Article 18

The parties may, at any time in the course of proceedings, conclude their case by way of settlement confirmed by a decision of the Community Patent Court. The settlement cannot affect the validity of a Community patent.

Article 19

The first and second paragraphs of Article 54 of the Statute shall apply *mutatis mutandis* to the Community Patent Court.

Article 20

Where the Court of Justice is seised of a case in which the same issue of interpretation is raised, or where the Court First Instance is seised of a case in which the validity of the same Community patent is called in question, the Community Patent Court may, after hearing the parties, stay proceedings before it until such time as the Court of Justice or the Court of First Instance shall have delivered judgment.

Where an opposition against the grant of a European patent designating the Community is filed with the European Patent Office, the Community Patent Court, seised of an invalidity action, may, after hearing the parties, stay proceedings until such time as a final decision is issued on the opposition.

Article 21

Article 55 of the Statute shall apply subject to the condition that Member States and institutions of the Communities which have neither intervened nor been a party to the case shall only receive the final decision of the Community Patent Court.

Article 22

Final decisions of the Community Patent Court shall be enforceable if they are no longer subject to appeal. Appeal shall have suspensory effect. However, the Community Patent Court may declare its decisions enforceable while, if necessary, subjecting enforcement to the provision of security.

The order for its enforcement is appended to the decision by the Community Patent Court. Decisions shall be enforceable against Member States.

The Community Patent Court may order that non-compliance with its decisions or orders constituting an obligation to act or to abstain from an act shall be sanctioned by a penalty payment. The penalty payment may consist in a single or a recurrent fine. The individual fine must be proportionate and may not exceed EUR 50 000.

Article 23

Appropriate court fees will be charged for proceedings before the Community Patent Court.

A schedule of fees shall be adopted by the Council, acting by a qualified majority on a proposal from the Commission and after consulting the European Parliament and the Court of Justice or at the request of the Court of Justice and after consulting the European Parliament and the Commission.

Court fees shall be paid in advance. Any party which has not paid the prescribed court fees may be excluded from further participation in the proceedings.

Article 24

The Community Patent Court may hold hearings in Member States other than that in which its seat is located.

Article 25

The Community Patent Court shall conduct proceedings in the official EU language of the Member State where the defendant is domiciled, or in one of them to be chosen by the defendant, where in a Member State there are two or more official EU languages. Where the defendant is not domiciled in a Member State, the Community Patent Court will conduct the proceedings in the official EU language in which the Community Patent was granted.

At the request of the parties, and with the consent of the Community Patent Court, any official EU language can be chosen as language of proceedings.

The Community Patent Court may, in accordance with the Rules of Procedure, hear parties in person, witnesses and experts in a language other than the language of proceedings. In that case the Registrar shall cause everything said during the oral procedure to be translated into the language of proceedings and, at the request of any party, into the language used by that party in accordance with the Rules of Procedure.

The Community Patent Court may, in accordance with the Rules of Procedure, allow the submission of accompanying documents drawn up in a language other than the language of proceedings. It may at any time order that party to produce a translation of such documents into the language of proceedings.

Article 26

An appeal against a final decision of the Community Patent Court may be brought before the Court of First Instance within two months of the notification of the decision appealed against.

An appeal against a decision of the Community Patent Court made pursuant to Article 243 of the Treaty or the fourth paragraph of Article 256 thereof or pursuant to the second paragraph of Article 14 of this Annex may be brought before the Court of First Instance within two months of its notification. However, if the order has been made without a prior hearing of the party adversely affected, that party may, within two months of the notification, lodge an objection with the Community Patent Court, whose decision shall be subject to an appeal to the Court of First Instance.

An appeal against a decision of the Community Patent Court dismissing an application to intervene may be brought before the Court of First Instance within two weeks of its notification.

The Rules of Procedure may determine the situations and conditions under which an appeal may be brought against decisions of a procedural nature taken by the Community Patent Court in the course of proceedings.

An appeal as provided for in paragraphs 1 to 4 may be brought by any party which has been unsuccessful, in whole or in part, in its submissions. The appeals referred to in paragraphs 2 and 3 shall be heard and determined under the procedure referred to in Article 39 of the Statute.

Article 27

The appeal may be based on points of law and matters of fact.

An appeal on points of law shall lie on the grounds of lack of competence of the Community Patent Court, a breach of procedure before it which adversely affects the interests of the appellant, or an infringement of Community law by the Community Patent Court.

An appeal on matters of fact shall lie on the grounds of a re-evaluation of the facts and evidence submitted to the Community Patent Court. New facts and new evidence may only be introduced if their submission by the party concerned could not reasonably have been expected during proceedings at first instance.

No appeal shall lie regarding only the amount of the costs or the party ordered to pay them.

Article 28

If the appeal is well founded, the Court of First Instance shall quash the decision of the Community Patent Court and give final judgment. The Court of First Instance may in exceptional circumstances and in accordance with the Rules of Procedure refer the case back to the Community Patent Court for judgment.

Where a case is referred back to the Community Patent Court, it shall be bound by the decision of the Court of First Instance on points of law.

Article 29

The Rules of Procedure of the Community Patent Court shall contain any provision necessary for applying and, where required, supplementing this Annex."

Chapter II

Appeal proceedings before the Court of First Instance

Article 5

Number of Judges of the Court of First Instance

Article 48 of the Protocol on the Statute of the Court of Justice is replaced by the following:

“Article 48

The Court of First Instance shall consist of 18 Judges.”

Article 6

Community Patent appeal proceedings

The following Article is inserted into the Protocol on the Statute of the Court of Justice:

"Article 61a

A specialised patent chamber of the Court of First Instance with three Judges shall hear appeals against decisions of the Community Patent Court.

Without prejudice to the fifth paragraph of Article 17 and Article 50, the Judges of the patent appeal chamber shall be chosen from candidates having an established high level of legal expertise in patent law and appointed on the basis of their expertise.

Article 7 and Articles 10 to 23 of Annex [II] to the Statute shall apply to the appeal procedure before the patent chamber of the Court of First Instance *mutatis mutandis*. Member States and institutions of the European Community shall have the right to intervene in accordance with the first paragraph of Article 40.

The appeal proceedings shall be conducted in the language of proceedings in which the case was conducted before the Community Patent Court. The second, third and fourth paragraphs of Article 25 of Annex [II] to the Statute apply."

Chapter III

Final provisions

Article 7

Transitional provisions

The first President of the Community Patent Court shall be appointed for a term of three years in the same manner as its members. However, the Council may decide that the procedure laid down in Article 4 of Annex [II] to the Protocol on the Statute of the Court of Justice shall apply.

Immediately after all members of the Community Patent Court have taken oath, the President of the Council shall proceed to choose by lot the Judges whose terms of office are to expire at the end of the first three years.

Article 8

Entry into force

Following its publication in the *Official Journal of the European Union*, this Decision shall enter into force on the day following notification by the last Member State of its acceptance of the provisions of Council Decision 2003/.../EC taken pursuant to Article 229a of the EC Treaty conferring jurisdiction on the Court of Justice relating to the Community Patent.

Article 1 of Annex [II] to the Protocol on the Statute of the Court of Justice shall become applicable on the date on which Council Decision 2003/.../EC conferring jurisdiction on the Court of Justice relating to the Community patent enters into force.

Done at Brussels, [...]

For the Council
The President
[...]

LEGISLATIVE FINANCIAL STATEMENT

Policy area: Industrial Property

Activity: Creation of the Community patent jurisdiction

TITLE OF ACTION: PROPOSAL FOR A COUNCIL DECISION ESTABLISHING THE COMMUNITY PATENT COURT AND CONCERNING APPEALS BEFORE THE COURT OF FIRST INSTANCE

1. BUDGET LINE(S) + HEADING(S)

Section IV - Court of Justice

2. OVERALL FIGURES

The creation of the Community patent jurisdiction has a financial impact on part A of the budget (human resources and other administrative expenditure). Community patent litigation brings a new type of litigation under the jurisdiction of the Court of Justice but also a considerable quantity of new cases in a specialised field which consequently requires new staff to handle cases. With the increasing number of Community patents being granted, the number of new cases before the Community Patent Court will rise sharply. The European Patent Office can be expected to grant each year 50 000 new Community patents which would, in view of a litigation rate of around 1 per 1 000 patents in force, increase the number of new proceedings at first instance by about 50 per year. In about 25% of the cases decided by the Community Patent Court an appeal to the Court of First Instance is likely to be filed. The resources which are considered necessary for the initial phase of the Community patent jurisdiction till 2014 can be brought in gradually according to the type and size of the tasks to be handled. Where additional staff are brought in, the calculation of the financial impact of human resources follows the general practice in this matter, i.e. newly created posts in the year of their creation are only calculated on a six-month basis.

– Necessary resources in the first five years of operation (2010-2014)

At the level of the Community Patent Court seven judges (including the president) have been considered appropriate to fulfil its function in the initial phase. Even before the new jurisdiction can start up its function, the judges will, according to Article 225a(5) of the EC Treaty, need to establish the first codification of a Community civil procedure law which in itself is a major undertaking. In the initial phase, a number of key decisions on fundamental questions will need to be taken by an enlarged bench. Each judge will need to be assisted by one legal secretary and one clerical secretary.

The highly technical Community patent litigation will also have consequences for the Court of First Instance hearing cases on appeal. With a view to the highly specialised and technical subject matter, a patent appeal chamber will need to be set up with three additional specialised judges at the Court of First Instance. Each judge will need to be assisted by at least one legal and one clerical secretary.

In addition, the special nature of patent litigation which deals with a subject matter involving the latest technological developments requires not only lawyers on the bench but also the attendance of technical experts. The Council in its 3 March 2003 common political approach decided that technical experts shall assist the judges throughout the handling of a case. To cover the more than 70 fields of technology, seven such technical experts (assistant rapporteurs) are foreseen for the first instance Community Patent Court in the following sub-divisions (1) inorganic chemistry and materials science, (2) organic and polymer chemistry, (3) biochemistry and biotechnology, (4) general physics, (5) mechanical engineering, (6) information and communication technology and (7) electrical engineering. With a view to the preparation of the technical questions raised by a case during first instance proceedings, the assistance of a reduced number of three technical experts during the appeal proceedings before the Court of First Instance in the more general sub-divisions chemistry, physics and mechanics would seem sufficient.

The Community Patent Court would also need a registrar who would be supported by six officials in the registry. The registry would need to operate in a particularly complex environment. The registry of the Community Patent Court would be responsible not only for keeping the register but also for the correspondence with parties and their legal representatives from all over the world, as cases could even involve e.g. two parties from non EU countries. The registry would need to be able to process incoming private party litigation in all of the official languages of the Community. It would have to respond orally and in writing to requests made by the parties (e.g. request for information on state of the case, scheduling of hearings etc.) or the judges (e.g. request for additional information, missing documents etc.). In order to safeguard the proper functioning of the court, such day to day contact between the parties and the court will not be able to rely on the regular translation or interpretation services but will have to be provided by the registry directly. Moreover, the registry would also be responsible for cooperation with the national authorities enforcing the decisions of the Community Patent Court under Articles 244, 256 of the EC Treaty. The Community Patent Court will only deliver the judgment whereas the terms of the judgment must be enforced by the competent authorities in the Member States. The registry must ensure communication in the official language of the Member State where the decision of the Community Patent Court is enforced.

A lecteur d'arrêt appears to be necessary in order to verify that the judgment, drafted by judges in a language which is not necessarily their mother tongue, is linguistically correct. This is current practice at the Court to safeguard quality standards and must also be provided for with respect to decisions of the new Community Patent Court and the patent chamber of the Court of First Instance. A researcher seems necessary in order to research the legislation and jurisprudence in Member States to provide data for the Community patent jurisdiction that is necessary to establish Community jurisprudence in this field. As jurisdiction in private party patent litigation will be completely new to the Community legal order, the researchers would be indispensable to investigate the existing concepts in Member States in order to allow the court to take them sufficiently into account when considering new cases. An additional legal secretary for the Advocate General seems necessary in view of review procedures under Article 225(2) of the EC Treaty before the Court of Justice against decisions of the Court of First Instance. All the patent decisions of the Court of First Instance would need to be evaluated as to their unity and consistency with

Community law. Where there is a serious risk that Community law might be affected, this person would support the Advocate General in the necessary proceedings before the Court of Justice. Apart from the staff that will be necessary to operate the Community Patent Court as such, the proposals must also provide the necessary reinforcement of the translation service. Finally the establishment of an IP library will be essential for the new jurisdiction. The relevant publications (from all Member States) such as law books, periodicals and collections of court decisions and also publications on all fields of technology as well as access to legal and technical data bases will need to be provided for.

– Phasing in of human resources

The new jurisdiction will necessarily go through a period in which staff may be recruited gradually according to the type and size of the tasks to be handled.

In the year before the estimated start of the Community jurisdiction, which is foreseen for 2010, a reduced number of staff will suffice for the necessary preparations. Only the judges with secretarial support will need to be appointed. It is important that all the judges are present from this moment. They will have to prepare the Rules of Procedure for patent proceedings which according to Articles 224(5), 225a(5) of the EC Treaty are adopted by the judges themselves. At this stage a librarian would also need to begin with the preparations to establish the IP library. Consequently a reduced figure of 14 staff has been introduced for the year 2009 in tables 2.3c), 7.1.

A considerable (but not yet the full) number of staff is only necessary as from the point when the Community patent jurisdiction takes up its function in 2010 (see increased expenditures set out accordingly in tables 2.3(c) and 7.2. A total of 70 personnel seems appropriate at the start of the new jurisdiction in order to fulfil its functions properly. This includes first of all the seven judges of the Community Patent Court. In particular in the initial phase, a number of key decisions on fundamental questions need to be taken by the court in which they establish important case law. Such decisions should be taken by an enlarged bench instead of a chamber of three judges. This number of judges is also necessary in order to guarantee a smoothly operating jurisdiction in case of sickness or leave of a judge. As concerns the three judges of the patent appeal chamber of the Court of First Instance, it is important to note that appeals will be filed from the time when the system becomes operational, in particular concerning interim measures or evidence-protection measures. Furthermore all the technical experts, seven for the Community Patent Court and three for the Court of First Instance, need to be present from the start of the operation. Cases may come from any of the existing fields of technology and as a consequence this number cannot be reduced in this initial phase. The president of the Community Patent Court who will apart from his jurisdictional functions also have to deal with administrative matters and the representation of the first private party Community jurisdiction will need to be assisted in his work by a *chef de cabinet* from the beginning. A *lecteur d'arrêt* for the Community Patent Court and the Court of First Instance will be necessary from the first year of operation since decisions will be delivered right from the start by both courts.

However, five legal secretaries for the Community Patent Court and two for the Court of First Instance, ten clerical secretaries and one researcher will suffice for this initial period of operation of the Community patent jurisdiction. Finally, in view of

the case load of this initial phase, a first (modest) reinforcement of the translation and interpretation capacities of the Court of Justice by ten translators and ten interpreters seems sufficient.

Certain posts can be phased in at a later stage as the case load rises. (see increase of expenditure in tables 2.3(c), 7.3 and 7.4 below). This concerns secretarial support, where eleven further staff are foreseen for 2012. For 2014, three further legal secretaries are foreseen for the judges of the Community Patent Court and the Court of First Instance so that each judge finally will be assisted by one legal secretary. In the same year, one additional legal secretary for the Advocate General for review proceedings seems necessary as the judgments of the Court of First Instance on appeal against decisions of the Community Patent Court will have reached a number where their scrutiny in view of possible review proceedings justifies an additional post. Also a second researcher would only be necessary in 2014 as the case load increases. Finally, the translation and interpretation capacities of the Court of Justice can be expanded in relation to increasing case load on a step-by-step basis, i.e. by another ten staff in 2012 and another eighteen in 2014. The total staff for the Community patent jurisdiction will thus by 2014 amount to 114 posts.

2.1. Total allocation for action (Part B): EUR million for commitment

None

2.2. Period of application:

Start: 2009

Expiry: open ended

2.3. Overall multiannual estimate of expenditure:

(a) Schedule of commitment appropriations/payment appropriations (financial intervention) (*see point 6.1.1*)

Not applicable

(b) Technical and administrative assistance and support expenditure (*see point 6.1.2*)

Not applicable

(c) Overall financial impact of human resources and other administrative expenditure (*see point 7*)

Year (n)	2009	2010	2011	2012	2013	2014
Year of operation	---	I	II	III	IV	V
New cases at first instance	0	50	100	150	200	250
Posts:						
Jurisdiction	13	49	49	60	60	65
Library	1	1	1	1	1	1
Translation	---	20	20	30	30	48
Total	14	70	70	91	91	114

Commitment s/ payments in EUR	3 257 000	7 115 000	10 472 000	11 606 000	12 740 000	13 982 000
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2.4. Compatibility with financial programming and financial perspective

Not applicable

2.5. Financial impact on revenue:

[...] Proposal has no financial implications (involves technical aspects regarding implementation of a measure)

OR

[X] Proposal has financial impact – the effect on revenue is as follows:

The proposal provides that parties will be charged appropriate court fees for Community patent litigation at first and second instance (See Article 23 of Annex II the Statute). However, the amount of revenue cannot be estimated at present. The amount to be charged would need to strike the right balance between the principle of a fair access to justice and an adequate contribution of the parties for the services rendered by the Community patent jurisdiction to solve their private disputes. In any case, the revenues from court fees will only contribute in a modest way to cover the overall incurred costs and could by no means be expected to lead to a self financing system. A schedule of fees laying down the exact fees to be paid will be adopted by the Council, acting by a qualified majority on a proposal from the Commission and after consulting the European Parliament and the Court of Justice or at the request of the Court of Justice and after consulting the European Parliament and the Commission.

3. BUDGET CHARACTERISTICS

Type of expenditure		New	EFTA contribution	Contributions from applicant countries	Heading in financial perspective
Non-comp	Non-diff	YES	NO	NO	No 5

4. LEGAL BASIS

Articles 225a, 245 of the EC Treaty.

5. DESCRIPTION AND GROUNDS

5.1. Need for Community intervention

5.1.1. Objectives pursued

The proposed Council Decision is part of the overall project to establish the Community patent system. By way of revision of the European Patent Convention and accession of the Community to the same, the European Patent Office shall be empowered to grant Community patents which will confer rights on their holders according to the regulation of the Council on the Community patent. Disputes concerning in particular the infringement and validity of these rights shall, after a transitional period, be brought before a Community jurisdiction. These measures shall reform the system of patent protection in Europe, which has been characterised by national patent titles enforceable before national courts, and make the necessary adaptations for the needs of European industry which increasingly operates trans-nationally within the common market. The measures are designed to increase the competitiveness of the Union's innovative industries by creating a Community wide uniform patent protection which can be enforced before a single Community jurisdiction rendering decisions with Community wide effect.

Within this overall project, the objective of the present proposal is to establish a Community Patent Court for first instance Community patent litigation and to provide for the necessary provisions with a view to accommodating the new function of the Court of First Instance as appeal instance against decisions of the Community Patent Court.

5.1.2. Measures taken in connection with ex ante evaluation

The necessity to create a patent system covering the Community as a whole has been recognised for decades. The first initiative to create such a system resulted in the European Patent Convention of 5 October 1973 which harmonised the grant of the European patent by the European Patent Office but neither included provisions on the rights conferred by such a patent nor created a single jurisdiction to deal with disputes. This is still left to national legislation and jurisdiction of the Contracting States. In a second initiative, EC Member States tried to create a Community patent on the basis of an international agreement including an integrated jurisdiction. The Community Patent Convention was signed on 15 December 1975 in Luxembourg followed by the 15 December 1989 agreement relating to the Community patent

which included a protocol on the settlement of litigation concerning the infringement and validity of Community patents. The Convention however never entered into force. In the context of the Amsterdam European Council of June 1997 (action plan for the single market), the Commission published a green paper on the promotion of innovation by patents. The consultations on the green paper including the comments made in the hearing on 25 and 26 November 1997 showed clear support for the creation of a Community patent system. Finally, the Lisbon European Council in March 2000 took up the issue and called for the creation of a Community patent system. The Council in its 3 March 2003 common political approach reached agreement on a number of key issues of the Community patent system including the jurisdictional aspects calling for the establishment of the Community Patent Court on the basis of Article 225a of the EC Treaty.

5.2. Action envisaged and budget intervention arrangements

The proposal constitutes a major element of the envisaged Community patent system. It contains the necessary legal provisions to set up a Community Patent Court which will deal with the Community patent related disputes for which jurisdiction is conferred on the Court of Justice. It also contains necessary provisions with a view to accommodating the new function of the Court of First Instance as appeal instance against decisions of the Community Patent Court. An efficiently functioning Community patent jurisdiction requires adequate resources. Court staff need to be employed (judges, registrar, assistant rapporteurs, legal secretaries, lecturers, researchers, secretaries, translators, interpreters, librarian), court rooms and equipment (office equipment, ICT facilities, library) have to be provided.

5.3. Methods of implementation

The necessary staff identified in 5.2. will be regular staff employed by the Court of Justice.

6. FINANCIAL IMPACT

6.1. Total financial impact on Part B - (over the entire programming period)

Not applicable

6.2. Calculation of costs by measure envisaged in Part B (over the entire programming period)

Not applicable

7. IMPACT ON STAFF AND ADMINISTRATIVE EXPENDITURE

7.1 The year before the Community patent jurisdiction becomes operational (2009)

The following tables show the impact on staff and administrative expenditures in 2009, the year before the Community patent jurisdiction becomes operational.

7.1.1. *Impact on human resources*

Types of post		Staff to be assigned to management of the action using existing and/or additional resources		Total	Description of tasks deriving from the action
		Number of permanent posts	Number of temporary posts		
officials or temporary staff	judges	10		10	CPC: (1 president, 6 judges); CFI: 3 judges
	B	1		1	librarian
	C	3		3	secretaries
total		14		14	

7.1.2. *Overall financial impact of human resources*

Type of human resources	Amount (EUR)	Method of calculation *
judges	2 825 000	CPC: 275 000 EUR X 7 CFI: 300 000 EUR X 3
officials (B, C)	432 000	108 000 EUR X 4
Total	3 257 000	

The amounts are total expenditure for twelve months.

7.1.3. *Other administrative expenditure deriving from action in 2009*

Budget line (number and heading)	Amount EUR	Method of calculation
Overall allocation (Title A7)		
A0701 – Missions		
A07030 – Meetings		
A07031 – Compulsory committees ¹		
A07032 – Non-compulsory committees ¹		
A07040 – Conferences		
A0705 – Studies and consultations		
Other expenditure (specify)		
Information systems (A-5001/A-4300)		
Other expenditure - Part A: Library		
Total	0	

The amounts are total expenditure for twelve months.

¹ Specify the type of committee and the group to which it belongs.

I.	Annual total (7.1.2. + 7.1.3.)	EUR 3 257 000
II.	Duration of action	indefinitely

7.2. First two years of operational Community patent jurisdiction (2010-2011)

The following tables show the impact on staff and administrative expenditures in 2010 -2011, the first two years from the start of the Community patent jurisdiction.

7.2.1. Impact on human resources

Types of post		Staff to be assigned to management of the action using existing and/or additional resources		Total	Description of tasks deriving from the action
		Number of permanent posts	Number of temporary posts		
officials or temporary staff	judges	10		10	CPC: (1 president, 6 judges); CFI: 3 judges
	registrar	1		1	registrar of CPC
	A	10		10	assistant rapporteurs: 7 CPC, 3 CFI
	other A	11		11	CPC 7 (5 legal secretaries, 1 lecteur, 1 chef cab. president) CFI: 3 (2 legal secretaries, 1 lecteur)
	B	6		6	CPC and CFI: 1 researchers registry CPC
	C	10		10	CPC: 7 (secretaries); CFI: 3 (secretaries)
	D	1		1	chauffeur president CPC
subtotal		49		49	
Other human resources for general services of the Court of Justice		1		1	librarian
		10		10	translators
		10		10	interpreters
subtotal		21		21	
total		70		70	

7.2.2. Overall financial impact of human resources

7.2.2.1. Overall financial impact on human resources in 2010

Type of human resources	Amount (EUR)	Method of calculation*
judges CPC and CFI	2 825 000	CPC: 275 000 EUR X 7 CFI: 300 000 EUR X 3
registrar CPC	138 000	275 000 EUR / 2
officials for CPC and CFI (A, B, C, D posts)	324 000	108 000 EUR X 3
	1 890 000	108 000 EUR X 35 / 2
subtotal	5 177 000	
other human resources for general services of the Court of Justice		
librarian	108 000	108 000 X 1
translators / interpreters	1 080 000	108 000 EUR X 20 / 2
total	6 365 000	

The amounts are total expenditure for twelve months. Newly created posts in 2010 are calculated for six months.

7.2.2.2. Overall financial impact on human resources in 2011

Type of human resources	Amount (EUR)	Method of calculation*
judges and registrar	3 100 000	CPC: 275 000 EUR X 8 CFI: 300 000 EUR X 3
officials for CPC and CFI (A, B, C, D posts)	4 104 000	108 000 EUR X 38
subtotal	7 204 000	
other human resources for general services of the Court of Justice (translators, interpreters, librarian)	2 268 000	108 000 EUR X 21
total	9 472 000	

The amounts are total expenditure for twelve months.

7.2.3. Other administrative expenditure deriving from the action

7.2.3.1. Other administrative expenditure deriving from action in 2010

Budget line (number and heading)	Amount EUR	Method of calculation
Overall allocation (Title A7) A0701 – Missions A07030 – Meetings A07031 – Compulsory committees ¹ A07032 – Non-compulsory committees ¹ A07040 – Conferences A0705 – Studies and consultations Other expenditure (specify)	p.m.	
Information systems (A-5001/A-4300)		
Other expenditure - Part A: Library	750 000	
Total	750 000	

The amounts are total expenditure for twelve months.

¹ Specify the type of committee and the group to which it belongs.

7.2.3.2. Other administrative expenditure deriving from action in 2011

Budget line (number and heading)	Amount €	Method of calculation
Overall allocation (Title A7) A0701 – Missions A07030 – Meetings A07031 – Compulsory committees ¹ A07032 – Non-compulsory committees ¹ A07040 – Conferences A0705 – Studies and consultations Other expenditure (specify)	p.m.	
Information systems (A-5001/A-4300)		
Other expenditure - Part A: Library	1 000 000	
Total	1 000 000	

The amounts are total expenditure for twelve months.

¹ Specify the type of committee and the group to which it belongs.

I.	Annual total (7.2.2 + 7.2.3)	
	Annual total in 2010	EUR 7 115 000
	Annual total in 2011	EUR10 472 000
II.	Duration of action	indefinitely

7.3. Third and fourth year of operation of the Community patent jurisdiction (2012 – 2013)

The following tables show the impact on staff and administrative expenditures in 2012 and 2013, the third and fourth year of the operation of the Community patent jurisdiction.

7.3.1. Impact on human resources

Types of post		Staff to be assigned to management of the action using existing and/or additional resources		Total	Description of tasks deriving from the action
		Number of permanent posts	Number of temporary posts		
officials or temporary staff	judges	10		10	CPC: (1 president, 6 judges); CFI: 3 judges
	registrar	1		1	registrar of CPC
	A	10		10	assistant rapporteurs: 7 CPC, 3 CFI
	other A	11		11	CPC 7 (5 legal secretaries, 1 lecteur, 1 chef cab. president) CFI: 3 (2 legal secretaries, 1 lecteur) CPC and CFI: 1 researcher
	B	6		6	6 (registry CPC),
	C	21		21	CPC: 15 (secretaries); CFI: 6 (secretaries)
	D	1		1	chauffeur president CPC
subtotal		60		60	
other human resources for general services of the Court of Justice		1		1	librarian
		15		15	translators
		15		15	interpreters
subtotal		31		31	
total		91		91	

7.3.2. Overall financial impact on human resources

7.3.2.1. Overall financial impact on human resources in 2012

Type of human resources	Amount (EUR)	Method of calculation *
judges and registrar	3 100 000	CPC: 275 000 EUR X 8 CFI: 300 000 EUR X 3
officials for CPC and CFI (A, B, C, D posts)	4 104 000	108 000 EUR X 38
	594 000	108 000 EUR X 11 / 2
subtotal	7 798 000	
other human resources for general services of the Court of Justice (translators, interpreters, librarian)	2 268 000	108 000 EUR X 21
	540 000	108 000 EUR X 10 / 2
Subtotal	2 808 000	
Total	10 606 000	

The amounts are total expenditure for twelve months. Newly created posts in 2012 are calculated for six months.

7.3.2.2. Overall financial impact on human resources in 2013

Type of human resources	Amount (€)	Method of calculation *
judges and registrar	3 100 000	CPC: 275 000 EUR X 8 CFI: 300 000 EUR X 3
officials for CPC and CFI (A, B, C, D posts)	5 292 000	108 000 EUR X 49
subtotal	8 392 000	
other human resources for general services of the Court of Justice (translators, interpreters, librarian)	3 348 000	108 000 EUR X 31
total	11 740 000	

The amounts are total expenditure for twelve months.

7.3.3. *Other administrative expenditure deriving from action in each of the years 2012 and in 2013*

Budget line (number and heading)	Amount EUR	Method of calculation
Overall allocation (Title A7) A0701 – Missions A07030 – Meetings A07031 – Compulsory committees ¹ A07032 – Non-compulsory committees ¹ A07040 – Conferences A0705 – Studies and consultations Other expenditure (specify)	p.m.	
Information systems (A-5001/A-4300)		
Other expenditure - Part A: Library	1 000 000	
Total	1 000 000	

The amounts are total expenditure for twelve months.

¹ Specify the type of committee and the group to which it belongs.

I.	Annual total (7.3.2 + 7.3.3)	
	Annual total in 2012	EUR 11 606 000
	Annual total in 2013	EUR 12 440 000
II.	Duration of action	indefinitely

7.4. End of the initial phase (2014)

The following tables show the impact on staff and administrative expenditure in 2014 marking the end of the initial phase when the staffing of the Community patent jurisdiction will be completed.

7.4.1. *Impact on human resources*

Types of post		Staff to be assigned to management of the action using existing and/or additional resources		Total	Description of tasks deriving from the action
		Number of permanent posts	Number of temporary posts		
officials or temporary staff	judges	10		10	CPC: (1 president, 6 judges); CFI: 3 judges
	registrar	1		1	registrar of CPC
	A	10		10	assistant rapporteurs: 7 CPC, 3 CFI
	other A	16		16	CPC 9 (7 legal secretaries, 1 lecteur, 1 chef cab. president) CFI: 4 (3 legal secretaries, 1 lecteur) CPC and CFI: 2 researchers ECJ: 1 legal secretary for review procedure
	B	6		6	6 (registry CPC),
	C	21		21	CPC: 15 (secretaries); CFI: 6 (secretaries)
	D	1		1	chauffeur president CPC
subtotal		65		65	
Other human resources for general services of the Court of Justice		1		1	librarian
		24		24	translators
		24		24	interpreters
subtotal		49		49	
total		114		114	

7.4.2. Overall financial impact of human resources

Type of human resources	Amount (EUR)	Method of calculation*
judges and registrar	3 100 000	CPC: 275 000 EUR X 8 CFI: 300 000 EUR X 3
officials for CPC and CFI (A, B, C, D posts)	5 292 000	108 000 EUR X 49
	270 000	108 000 EUR X 5 / 2
subtotal	8 662 000	
other human resources for general services of the Court of Justice (translators, interpreters, librarian)	3 348 000	108 000 EUR X 31
	972 000	108 000 EUR X 18 / 2
subtotal	4 320 000	
total	12 982 000	

The amounts are total expenditure for twelve months. Newly created posts in 2014 are calculated for six months.

7.4.3. Other administrative expenditure deriving from the action

Budget line (number and heading)	Amount EUR	Method of calculation
Overall allocation (Title A7)	p.m.	
A0701 – Missions		
A07030 – Meetings		
A07031 – Compulsory committees ¹		
A07032 – Non-compulsory committees ¹		
A07040 – Conferences		
A0705 – Studies and consultations		
Other expenditure (specify)		
Information systems (A-5001/A-4300)		
Other expenditure - Part A: Library	1 000 000	
Total	1 000 000	

The amounts are total expenditure for twelve months.

¹ Specify the type of committee and the group to which it belongs.

I.	Annual total (7.4.2 + 7.4.3)	Eur 13 982 000
II.	Duration of action	indefinitely

8. FOLLOW-UP AND EVALUATION

8.1. Follow-up arrangements

The Council in its 3 March 2003 common political approach (point 5) foresees a review mechanism of the Community patent system including the jurisdictional arrangements. Regarding the contents of the present Decision, the organisation of the Community Patent Court and the provisions of the Statute of the Court of Justice relating to the work of the Community Patent Court at first instance and the Court of First Instance on appeal would have to be reviewed in the light of experience gathered. The Commission will need to consult the Court of Justice and interested circles to collect data on the functioning of the Community patent jurisdiction and will have to evaluate the collected data and where appropriate suggest changes to the current Decision.

8.2. Arrangements and schedule for the planned evaluation

On the basis of the common political approach adopted by the Council on 3 March 2003, the Commission will present a report on the functioning of all aspects of the Community patent including the jurisdictional arrangements five years after the grant of the first Community patent. Further reviews will be made periodically.

9. ANTI-FRAUD MEASURES

This does not apply. The proposal deals with the establishment of a Community Patent Court and the appeal procedure before the Court of First Instance and does not cover a policy area with a risk of fraud.

IMPACT ASSESSMENT FORM

THE IMPACT OF THE PROPOSAL ON BUSINESS WITH SPECIAL REFERENCE TO SMALL AND MEDIUM-SIZED ENTERPRISES(SMEs)

TITLE OF PROPOSAL

Proposal for a Council Decision establishing the Community Patent Court and concerning appeals before the Court of First Instance.

DOCUMENT REFERENCE NUMBER

[...]

THE PROPOSAL

1. Taking account of the principle of subsidiarity, why is Community legislation necessary in this area and what are its main aims?

The object of the Community patent system is to provide a Community wide patent protection which can be enforced before one single court operating to uniform standards and whose decisions enjoy Community wide effect. This objective can only be achieved at a Community level.

THE IMPACT ON BUSINESS

2. Who will be affected by the proposal?

- which sectors of business

All sectors of business that deal with technical inventions which can be subject to patent protection are concerned by the Community patent system. They can in case of conflict be party to litigation before the Community jurisdiction.

- which sizes of business (what is the concentration of small and medium-sized firms)

Potentially every size of business can be a party to Community patent litigation before the Community patent jurisdiction. For example, the holder of a Community patent may as a plaintiff wish to enforce his rights flowing from the Community patent title before the Community Patent Court. A third person may as a plaintiff wish to attack the validity of such a Community patent granting exclusive rights to its holder that he considers to be invalid. As defendant the right holder may wish to defend the validity of his patent or as a third person defend himself against an alleged infringement of a Community patent.

The Community patent system intends to make patenting of inventions more attractive especially for SMEs which will particularly increase the significance for this group. So far patenting is done in or with effect for individual Member States

and the enforcement must take place before the national courts of the respective Member States their national patent law and their national legislation on the court procedure which is particularly cumbersome for SMEs. The Community patent jurisdiction will allow to enforce a unitary patent right valid in the entire Community in one single court procedure operating to common standards.

3. What will business have to do to comply with the proposal?

The effect for businesses will be felt only in cases of litigation over a Community patent. In that case they have to familiarise themselves with the proceedings before the Community patent jurisdiction.

4. What economic effects is the proposal likely to have?

The proposal will only have an economic effect in combination with the other legal instruments creating a Community patent system. The Community patent system as a whole will have a positive economic impact. In particular:

- on investment and the creation of new businesses

The Community patent system will have a positive impact on investments due to a better Community wide legal protection of inventions. The return on investments in innovative technologies will be more secure serving as an incentive for more investment. Moreover, since better legal protection will be rendered less costly, businesses will be able to make more efficient use of their existing budget for research and development which will lead to more inventions which in turn will stimulate investments to economically exploit these inventions. Since effective patent protection often serves as the legal basis for an economically successfully operating business, a more comprehensive, easier and less costly patent protection will promote the creation of new businesses.

- on the competitiveness of businesses

The Community patent system will make patent protection more effective, easier and less costly not only for those businesses that already make use of patent protection but also make patenting more easily accessible for other businesses and in particular for SMEs. The possibility to protect an invention and with it the associated investment into it with Community wide effect will increase the ability of all businesses that make use of this possibility to compete in the common market. Moreover, the competitiveness of European industry will be increased on a global scale compared to the major trading partners and competitors. Today patent protection, for example in the United States or Japan, is considerably less costly than in Europe under the national and the European patent system. Consequently US and Japan based companies can develop patented products at a considerably lower price which later are marketed world wide. The Community patent system intends to eliminate this obstacle for the competitiveness of the European industry.

- on employment

An increased investment in inventive technologies and a strengthened competitiveness of the European industry will lead to the creation of new jobs. The creation of new jobs can be expected across the full range of technical fields and

their related industries. In particular the modern, innovative technologies which are playing a steadily increasing role in a knowledge based global economy will benefit.

5. Does the proposal contain measures to take account of the specific situation of small and medium-sized firms (reduced or different requirements etc)?

This does not apply. No distinction according to the size of companies can be made with regard the establishment, the organisation and the procedure before the Statute the Community Patent Court and the Court of First Instance on appeal.

CONSULTATION

6. List the organisations which have been consulted about the proposal and outline their main views:

The necessity to create a patent system covering the Community as a whole has been recognised for decades. The first initiative to create such a system resulted in the European Patent Convention of 5 October 1973 which harmonised the grant of the European patent by the European Patent Office but neither included provisions on the rights conferred by such a patent nor created a single jurisdiction to deal with disputes. This was still left to national legislation and jurisdiction of the Contracting States. In a second initiative, EC Member States tried to create a Community patent on the basis of an international agreement including an integrated jurisdiction. The Community Patent Convention was signed on 15 December 1975 in Luxembourg followed by the 15 December 1989 agreement relating to the Community patent which included a protocol on the settlement of litigation concerning the infringement and validity of Community patents. The Convention however never entered into force. In the context of the Amsterdam European Council of June 1997 (action plan for the single market), the Commission published a green paper on the promotion of innovation by patents. The consultations on the green paper including the comments made in the hearing on 25 and 26 November 1997 showed clear support for the creation of a Community patent system. Finally, the Lisbon European Council in March 2000 took up the issue and called for the creation of a Community patent system. The Council in its 3 March 2003 common political approach reached agreement on a number of key issues of the Community patent system including the jurisdictional aspects calling for the establishment of the Community Patent Court on the basis of Article 225a of the EC Treaty.

76/76/EEC: Convention for the European patent for the common market (Community Patent Convention)

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CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON MARKET

(COMMUNITY PATENT CONVENTION)

(76/76/EEC)

PREAMBLE

THE HIGH CONTRACTING PARTIES TO THE TREATY ESTABLISHING THE EUROPEAN ECONOMIC COMMUNITY ,

DESIRING TO GIVE UNITARY AND AUTONOMOUS EFFECT TO EUROPEAN PATENTS GRANTED IN RESPECT OF THEIR TERRITORIES UNDER THE CONVENTION ON THE GRANT OF EUROPEAN PATENTS OF 5 OCTOBER 1973 ,

ANXIOUS TO ESTABLISH A COMMUNITY PATENT SYSTEM WHICH CONTRIBUTES TO THE ATTAINMENT OF THE OBJECTIVES OF THE TREATY ESTABLISHING THE EUROPEAN ECONOMIC COMMUNITY , AND IN PARTICULAR TO THE ELIMINATION WITHIN THE COMMUNITY OF THE DISTORTION OF COMPETITION WHICH MAY RESULT FROM THE TERRITORIAL ASPECT OF NATIONAL PROTECTION RIGHTS ,

CONSIDERING THAT ONE OF THE FUNDAMENTAL OBJECTIVES OF THE TREATY ESTABLISHING THE EUROPEAN ECONOMIC COMMUNITY IS THE ABOLITION OF OBSTACLES TO THE FREE MOVEMENT OF GOODS ,

CONSIDERING THAT ONE OF THE MOST SUITABLE MEANS OF ENSURING THAT THIS OBJECTIVE WILL BE ACHIEVED , AS REGARDS THE FREE MOVEMENT OF GOODS PROTECTED BY PATENTS , IS THE CREATION OF A COMMUNITY PATENT SYSTEM ,

CONSIDERING THAT THE CREATION OF SUCH A COMMUNITY PATENT SYSTEM IS THEREFORE INSEPARABLE FROM THE ATTAINMENT OF THE OBJECTIVES OF THE TREATY AND THUS LINKED WITH THE COMMUNITY LEGAL ORDER ,

CONSIDERING THAT IT IS NECESSARY FOR THESE PURPOSES FOR THE HIGH CONTRACTING PARTIES TO CONCLUDE A CONVENTION WHICH CONSTITUTES A SPECIAL AGREEMENT WITHIN THE MEANING OF ARTICLE 142 OF THE CONVENTION ON THE GRANT OF EUROPEAN PATENTS , A REGIONAL PATENT TREATY WITHIN THE MEANING OF ARTICLE 45 (1) OF THE PATENT COOPERATION TREATY OF 19 JUNE 1970 , AND A SPECIAL AGREEMENT WITHIN THE MEANING OF ARTICLE 19 OF THE CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY , SIGNED IN PARIS ON 20 MARCH 1883 AND LAST REVISED ON 14 JULY 1967 ,

CONSIDERING THAT IT IS ESSENTIAL THAT THIS CONVENTION BE INTERPRETED IN A UNIFORM MANNER SO THAT THE RIGHTS AND OBLIGATIONS FLOWING FROM A COMMUNITY PATENT BE IDENTICAL THROUGHOUT THE COMMUNITY AND THAT THEREFORE JURISDICTION BE CONFERRED ON THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES ,

CONVINCED THEREFORE THAT THE CONCLUSION OF THIS CONVENTION IS NECESSARY TO FACILITATE THE ACHIEVEMENT OF THE TASKS OF THE EUROPEAN ECONOMIC COMMUNITY AND THAT THEREFORE IT IS AN APPROPRIATE MEASURE TO BE TAKEN BY THE MEMBER STATES , SUBJECT TO NATIONAL RATIFICATION PROCEDURES , TO ENSURE FULFILMENT OF COMMUNITY OBLIGATIONS ,

HAVE DECIDED TO CONCLUDE THIS CONVENTION AND TO THIS END HAVE DESIGNATED AS THEIR PLENIPOTENTIARIES :

- HIS MAJESTY THE KING OF THE BELGIANS :

MR . J . DESCHAMPS ,

BELGIAN AMBASSADOR TO LUXEMBOURG ;

- HER MAJESTY THE QUEEN OF DENMARK :

MR . K . V. SKJOEDT ,

DIRECTOR , DANISH PATENT OFFICE ;

- THE PRESIDENT OF THE FEDERAL REPUBLIC OF GERMANY :

DR . PETER HERMES ,

STATE SECRETARY , FEDERAL MINISTRY OF FOREIGN AFFAIRS ;

- THE PRESIDENT OF THE FRENCH REPUBLIC :

MR EMILE CAZIMAJOU ,

MINISTER PLENIPOTENTIARY , DEPUTY PERMANENT REPRESENTATIVE ;

- THE PRESIDENT OF IRELAND :

MR JOHN BRUTON ,

PARLIAMENTARY SECRETARY , MINISTRY FOR INDUSTRY AND COMMERCE ;

- THE PRESIDENT OF THE ITALIAN REPUBLIC :

MR F . CATTANEI ,

STATE SECRETARY , MINISTRY OF FOREIGN AFFAIRS ;

- HIS ROYAL HIGHNESS THE GRAND DUKE OF LUXEMBOURG :

MR MARCEL MART ,

MINISTER FOR ECONOMIC AFFAIRS , SMALL FIRMS AND OF TOURISM ;

- HER MAJESTY THE QUEEN OF THE NETHERLANDS :

MR TH . M . HAZEKAMP ,

STATE SECRETARY , MINISTRY OF ECONOMIC AFFAIRS ;

- HER MAJESTY THE QUEEN OF THE UNITED KINGDOM OF GREAT BRITAIN AND NORTHERN IRELAND :

THE RT . HON. LORD GORONWY-ROBERTS ,

MINISTER OF STATE , FOREIGN AND COMMONWEALTH OFFICE , DEPUTY LEADER OF THE HOUSE OF LORDS ;

WHO , MEETING IN THE COUNCIL OF THE EUROPEAN COMMUNITIES , HAVING EXCHANGED THEIR FULL POWERS , FOUND IN GOOD AND DUE FORM ,

HAVE AGREED AS FOLLOWS :

PART I

GENERAL AND INSTITUTIONAL PROVISIONS

CHAPTER I

GENERAL PROVISIONS

ARTICLE 1

COMMON SYSTEM OF LAW FOR PATENTS

1 . A SYSTEM OF LAW , COMMON TO THE CONTRACTING STATES , CONCERNING PATENTS FOR INVENTION IS HEREBY ESTABLISHED.

2 . THE COMMON SYSTEM OF LAW SHALL GOVERN THE EUROPEAN PATENTS GRANTED FOR THE CONTRACTING STATES IN ACCORDANCE WITH THE CONVENTION ON THE GRANT OF EUROPEAN PATENTS , HEREINAFTER REFERRED TO AS " THE EUROPEAN PATENT CONVENTION " , AND THE EUROPEAN PATENT APPLICATIONS IN WHICH SUCH STATES ARE DESIGNATED.

ARTICLE 2

COMMUNITY PATENT

1 . EUROPEAN PATENTS GRANTED FOR THE CONTRACTING STATES SHALL BE CALLED COMMUNITY PATENTS.

2 . COMMUNITY PATENTS SHALL HAVE A UNITARY CHARACTER. THEY SHALL HAVE EQUAL EFFECT THROUGHOUT THE TERRITORIES TO WHICH THIS CONVENTION APPLIES AND MAY ONLY BE GRANTED , TRANSFERRED , REVOKED OR ALLOWED TO LAPSE IN RESPECT OF THE WHOLE OF SUCH TERRITORIES. THE SAME SHALL APPLY MUTATIS MUTANDIS TO APPLICATIONS FOR EUROPEAN PATENTS IN WHICH THE CONTRACTING STATES ARE DESIGNATED.

3 . COMMUNITY PATENTS SHALL HAVE AN AUTONOMOUS CHARACTER. THEY SHALL BE SUBJECT ONLY TO THE PROVISIONS OF THIS CONVENTION AND THOSE PROVISIONS OF THE EUROPEAN PATENT CONVENTION WHICH ARE BINDING UPON EVERY EUROPEAN PATENT AND WHICH SHALL CONSEQUENTLY BE DEEMED TO BE PROVISIONS OF THIS CONVENTION.

ARTICLE 3

JOINT DESIGNATION

DESIGNATION OF THE STATES PARTIES TO THIS CONVENTION IN ACCORDANCE WITH ARTICLE 79 OF THE EUROPEAN PATENT CONVENTION SHALL BE EFFECTED JOINTLY . DESIGNATION OF ONE OR SOME ONLY OF THESE STATES SHALL BE DEEMED TO BE

DESIGNATION OF ALL OF THESE STATES.

ARTICLE 4

SETTING UP OF SPECIAL DEPARTMENTS

FOR IMPLEMENTING THE PROCEDURES LAID DOWN IN THIS CONVENTION , SPECIAL DEPARTMENTS COMMON TO THE CONTRACTING STATES SHALL BE SET UP WITHIN THE EUROPEAN PATENT OFFICE. THE WORK OF THESE DEPARTMENTS SHALL BE SUPERVISED BY A SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANIZATION.

ARTICLE 5

JURISDICTION OF THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES

1 . THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES SHALL IN RESPECT OF THIS CONVENTION HAVE THE JURISDICTION CONFERRED ON IT BY THIS CONVENTION. THE PROTOCOL ON THE STATUTE OF THE COURT OF JUSTICE OF THE EUROPEAN ECONOMIC COMMUNITY AND THE RULES OF PROCEDURE OF THE COURT OF JUSTICE SHALL APPLY.

2 . THE RULES OF PROCEDURE SHALL BE ADAPTED AND SUPPLEMENTED , AS NECESSARY , IN CONFORMITY WITH ARTICLE 188 OF THE TREATY ESTABLISHING THE EUROPEAN ECONOMIC COMMUNITY.

ARTICLE 6

NATIONAL PATENTS

THIS CONVENTION SHALL BE WITHOUT PREJUDICE TO THE RIGHT OF THE CONTRACTING STATES TO GRANT NATIONAL PATENTS.

CHAPTER II

SPECIAL DEPARTMENTS OF EUROPEAN PATENT OFFICE

ARTICLE 7

THE SPECIAL DEPARTMENTS

THE SPECIAL DEPARTMENTS SHALL BE AS FOLLOWS :

- (A) A PATENT ADMINISTRATION DIVISION ;
- (B) ONE OR MORE REVOCATION DIVISIONS ;
- (C) ONE OR MORE REVOCATION BOARDS.

ARTICLE 8

PATENT ADMINISTRATION DIVISION

1 . THE PATENT ADMINISTRATION DIVISION SHALL BE RESPONSIBLE FOR ALL ACTS OF THE EUROPEAN PATENT OFFICE RELATING TO COMMUNITY PATENTS , IN SO FAR AS THESE ACTS ARE NOT THE RESPONSIBILITY OF OTHER DEPARTMENTS OF THE OFFICE. IT SHALL IN PARTICULAR BE RESPONSIBLE FOR DECISIONS IN RESPECT OF ENTRIES IN THE REGISTER OF COMMUNITY PATENTS.

2 . DECISIONS OF THE PATENT ADMINISTRATION DIVISION SHALL BE TAKEN BY ONE LEGALLY QUALIFIED MEMBER.

3 . THE MEMBERS OF THE PATENT ADMINISTRATION DIVISION MAY NOT BE MEMBERS OF THE BOARDS OF APPEAL OR THE ENLARGED BOARD OF APPEAL SET UP UNDER THE EUROPEAN PATENT CONVENTION , NOR OF THE REVOCATION BOARDS.

ARTICLE 9

REVOCATION DIVISIONS

1 . THE REVOCATION DIVISIONS SHALL BE RESPONSIBLE FOR THE EXAMINATION OF REQUESTS FOR THE LIMITATION OF AND APPLICATIONS FOR THE REVOCATION OF COMMUNITY PATENTS , AND FOR DETERMINING COMPENSATION UNDER ARTICLE 44 (5) .

2 . A REVOCATION DIVISION SHALL CONSIST OF ONE LEGALLY QUALIFIED MEMBER WHO SHALL BE THE CHAIRMAN , AND TWO TECHNICALLY QUALIFIED MEMBERS . PRIOR TO THE TAKING OF A FINAL DECISION ON THE REQUEST OR APPLICATION , THE REVOCATION DIVISION MAY ENTRUST THE EXAMINATION OF THE REQUEST OR APPLICATION TO ONE OF ITS MEMBERS. ORAL PROCEEDINGS SHALL BE BEFORE THE REVOCATION DIVISION ITSELF.

ARTICLE 10

REVOCATION BOARDS

1 . THE REVOCATION BOARDS SHALL BE RESPONSIBLE FOR THE EXAMINATION OF APPEALS FROM THE DECISIONS OF THE REVOCATION DIVISIONS AND THE PATENT ADMINISTRATION DIVISION AND FOR EXPRESSING AN OPINION ON THE EXTENT OF PROTECTION OF A COMMUNITY PATENT.

2 . FOR APPEALS FROM A DECISION OF A REVOCATION DIVISION , A REVOCATION BOARD SHALL CONSIST OF TWO LEGALLY QUALIFIED MEMBERS , ONE OF WHOM SHALL BE THE CHAIRMAN , AND THREE TECHNICALLY QUALIFIED MEMBERS .

3 . FOR APPEALS FROM A DECISION OF THE PATENT ADMINISTRATION DIVISION , A REVOCATION BOARD SHALL CONSIST OF THREE LEGALLY QUALIFIED MEMBERS .

4 . FOR THE PURPOSES OF EXPRESSING AN OPINION ON THE EXTENT OF PROTECTION OF A COMMUNITY PATENT , A REVOCATION BOARD SHALL NORMALLY CONSIST OF TWO LEGALLY QUALIFIED MEMBERS , ONE OF WHOM SHALL BE THE CHAIRMAN , AND ONE TECHNICALLY QUALIFIED MEMBER. HOWEVER , IF THE OPINION HAS TO BE EXPRESSED IN CONNECTION WITH AN APPEAL FROM A REVOCATION DIVISION OR IF THE REVOCATION BOARD CONSIDERS THAT THE NATURE OF THE OPINION SO REQUIRES , THE REVOCATION BOARD SHALL BE COMPOSED AS IN PARAGRAPH 2.

ARTICLE 11

APPOINTMENT OF MEMBERS OF THE REVOCATION BOARDS

1 . THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL SHALL APPOINT

(A) THE CHAIRMEN OF THE REVOCATION BOARDS ON A PROPOSAL FROM A MEMBER OF THAT COMMITTEE , AFTER THE PRESIDENT OF THE EUROPEAN PATENT OFFICE HAS BEEN CONSULTED , OR ON HIS PROPOSAL ;

(B) THE OTHER MEMBERS OF THE REVOCATION BOARDS ON A PROPOSAL FROM THE PRESIDENT OF THE EUROPEAN PATENT OFFICE.

2 . THE MEMBERS OF THE BOARDS MAY BE REAPPOINTED BY DECISION OF THE SELECT COMMITTEE AFTER THE PRESIDENT OF THE EUROPEAN PATENT OFFICE HAS BEEN CONSULTED.

3 . SUBJECT TO ARTICLE 12 (1) , THE SELECT COMMITTEE SHALL EXERCISE DISCIPLINARY AUTHORITY OVER THE EMPLOYEES APPOINTED IN ACCORDANCE WITH PARAGRAPH 1 .

ARTICLE 12

INDEPENDENCE OF THE MEMBERS OF THE REVOCATION BOARDS

1 . THE MEMBERS OF THE REVOCATION BOARDS SHALL BE APPOINTED FOR A TERM OF FIVE YEARS AND MAY NOT BE REMOVED FROM OFFICE DURING THIS TERM , UNLESS THERE ARE SERIOUS GROUNDS FOR SUCH REMOVAL AND THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES , BEFORE WHICH THE MATTER SHALL BE BROUGHT BY THE PRESIDENT OF THE EUROPEAN PATENT OFFICE , TAKES A DECISION TO THIS EFFECT.

2 . THE MEMBERS OF THE BOARDS MAY NOT BE MEMBERS OF THE RECEIVING SECTION , EXAMINING DIVISIONS , OPPOSITION DIVISIONS OR LEGAL DIVISION SET UP UNDER THE EUROPEAN PATENT CONVENTION , NOR OF THE PATENT ADMINISTRATION DIVISION OR REVOCATION DIVISIONS.

3 . IN THEIR DECISIONS THE MEMBERS OF THE BOARDS SHALL NOT BE BOUND BY ANY INSTRUCTIONS AND SHALL COMPLY ONLY WITH THE PROVISIONS OF THIS CONVENTION .

4 . THE RULES OF PROCEDURE OF THE REVOCATION BOARDS SHALL BE ADOPTED IN ACCORDANCE WITH THE IMPLEMENTING REGULATIONS. THEY SHALL BE SUBJECT TO

THE APPROVAL OF THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL .

ARTICLE 13

EXCLUSION AND OBJECTION

1 . MEMBERS OF THE REVOCATION DIVISIONS AND THE REVOCATION BOARDS MAY NOT TAKE PART IN ANY PROCEEDINGS IF THEY HAVE ANY PERSONAL INTEREST THEREIN , IF THEY HAVE PREVIOUSLY BEEN INVOLVED AS REPRESENTATIVES OF ONE OF THE PARTIES , OR IF THEY HAVE PARTICIPATED IN THE FINAL DECISION ON THE CASE IN THE PROCEEDINGS FOR GRANT OR OPPOSITION PROCEEDINGS. FURTHERMORE , MEMBERS OF THE REVOCATION BOARDS MAY NOT TAKE PART IN APPEAL PROCEEDINGS IF THEY PARTICIPATED IN THE DECISION UNDER APPEAL.

2 . IF , FOR ONE OF THE REASONS MENTIONED IN PARAGRAPH 1 OR FOR ANY OTHER REASON , A MEMBER OF A REVOCATION DIVISION OR A REVOCATION BOARD CONSIDERS THAT HE SHOULD NOT TAKE PART IN ANY PROCEEDINGS , HE SHALL INFORM THE DIVISION OR BOARD ACCORDINGLY.

3 . MEMBERS OF A REVOCATION DIVISION OR OF A REVOCATION BOARD MAY BE OBJECTED TO BY ANY PARTY FOR ONE OF THE REASONS MENTIONED IN PARAGRAPH 1 , OR IF SUSPECTED OF PARTIALITY. AN OBJECTION SHALL NOT BE ADMISSIBLE IF , WHILE BEING AWARE OF A REASON FOR OBJECTION , THE PARTY HAS TAKEN A PROCEDURAL STEP. NO OBJECTION MAY BE BASED UPON THE NATIONALITY OF MEMBERS.

4 . THE REVOCATION DIVISIONS AND THE REVOCATION BOARDS SHALL DECIDE AS TO THE ACTION TO BE TAKEN IN THE CASES SPECIFIED IN PARAGRAPHS 2 AND 3 WITHOUT THE PARTICIPATION OF THE MEMBER CONCERNED. FOR THE PURPOSES OF TAKING THIS DECISION THE MEMBER OBJECTED TO SHALL BE REPLACED BY HIS ALTERNATE.

ARTICLE 14

LANGUAGES FOR PROCEEDINGS AND PUBLICATIONS

1 . THE OFFICIAL LANGUAGES OF THE EUROPEAN PATENT OFFICE SHALL ALSO BE THE OFFICIAL LANGUAGES OF THE SPECIAL DEPARTMENTS.

2 . THROUGHOUT THE PROCEEDINGS BEFORE THE SPECIAL DEPARTMENTS , A TRANSLATION FILED IN ACCORDANCE WITH THE SECOND SENTENCE OF ARTICLE 14 (2) OF THE EUROPEAN PATENT CONVENTION MAY BE BROUGHT INTO CONFORMITY WITH THE ORIGINAL TEXT OF THE EUROPEAN PATENT APPLICATION.

3 . THE OFFICIAL LANGUAGE OF THE EUROPEAN PATENT OFFICE IN WHICH THE COMMUNITY PATENT IS GRANTED SHALL BE USED AS THE LANGUAGE OF THE PROCEEDINGS IN ALL PROCEEDINGS BEFORE THE SPECIAL DEPARTMENTS CONCERNING THE COMMUNITY PATENT , UNLESS OTHERWISE PROVIDED IN THE IMPLEMENTING REGULATIONS.

4 . HOWEVER , NATURAL OR LEGAL PERSONS HAVING THEIR RESIDENCE OR PRINCIPAL PLACE OF BUSINESS WITHIN THE TERRITORY OF A CONTRACTING STATE HAVING A LANGUAGE OTHER THAN ONE OF THE OFFICIAL LANGUAGES OF THE EUROPEAN PATENT OFFICE AS AN OFFICIAL LANGUAGE , AND NATIONALS OF THAT STATE WHO ARE RESIDENT

ABROAD , MAY FILE DOCUMENTS WHICH HAVE TO BE FILED WITHIN A TIME LIMIT IN AN OFFICIAL LANGUAGE OF THE CONTRACTING STATE CONCERNED. THEY MUST HOWEVER FILE A TRANSLATION IN THE LANGUAGE OF THE PROCEEDINGS WITHIN THE TIME LIMIT PRESCRIBED IN THE IMPLEMENTING REGULATIONS ; IN THE CASES PROVIDED FOR IN THE IMPLEMENTING REGULATIONS , THEY MAY FILE A TRANSLATION IN A DIFFERENT OFFICIAL LANGUAGE OF THE EUROPEAN PATENT OFFICE.

5 . IF ANY DOCUMENT IS NOT FILED IN THE LANGUAGE PRESCRIBED BY THIS CONVENTION , OR IF ANY TRANSLATION REQUIRED BY VIRTUE OF THIS CONVENTION IS NOT FILED IN DUE TIME , THE DOCUMENT SHALL BE DEEMED NOT TO HAVE BEEN RECEIVED.

6 . NEW SPECIFICATIONS OF COMMUNITY PATENTS PUBLISHED FOLLOWING LIMITATION OR REVOCATION PROCEEDINGS SHALL BE PUBLISHED IN THE LANGUAGE OF THE PROCEEDINGS ; THEY SHALL INCLUDE A TRANSLATION OF THE AMENDED CLAIMS IN ONE OF THE OFFICIAL LANGUAGES OF EACH OF THE CONTRACTING STATES WHICH DO NOT HAVE AS AN OFFICIAL LANGUAGE THE LANGUAGE OF THE PROCEEDINGS.

7 . THE COMMUNITY PATENT BULLETIN SHALL BE PUBLISHED IN THE THREE OFFICIAL LANGUAGES OF THE EUROPEAN PATENT OFFICE.

8 . ENTRIES IN THE REGISTER OF COMMUNITY PATENTS SHALL BE MADE IN THE THREE OFFICIAL LANGUAGES OF THE EUROPEAN PATENT OFFICE. IN CASES OF DOUBT , THE ENTRY IN THE LANGUAGE OF THE PROCEEDINGS SHALL BE AUTHENTIC .

9 . NO CONTRACTING STATE MAY AVAIL ITSELF OF THE AUTHORIZATIONS GIVEN IN ARTICLES 65 , 67 (3) AND 70 (3) OF THE EUROPEAN PATENT CONVENTION .

CHAPTER III

THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL

ARTICLE 15

MEMBERSHIP

1 . THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL SHALL BE COMPOSED OF THE REPRESENTATIVES OF THE CONTRACTING STATES , THE REPRESENTATIVE OF THE COMMISSION OF THE EUROPEAN COMMUNITIES AND THEIR ALTERNATE REPRESENTATIVES. EACH CONTRACTING STATE AND THE COMMISSION SHALL BE ENTITLED TO APPOINT ONE REPRESENTATIVE AND ONE ALTERNATE REPRESENTATIVE TO THE SELECT COMMITTEE. THE SAME MEMBERS SHALL REPRESENT THE CONTRACTING STATES ON THE ADMINISTRATIVE COUNCIL AND ON THE SELECT COMMITTEE.

2 . THE MEMBERS OF THE SELECT COMMITTEE MAY , SUBJECT TO THE PROVISIONS OF ITS RULES OF PROCEDURE , BE ASSISTED BY ADVISERS OR EXPERTS .

ARTICLE 16

CHAIRMANSHIP

1 . THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL SHALL ELECT A CHAIRMAN AND A DEPUTY CHAIRMAN FROM AMONG THE REPRESENTATIVES AND ALTERNATE REPRESENTATIVES

OF THE CONTRACTING STATES. THE DEPUTY CHAIRMAN SHALL EX OFFICIO REPLACE THE CHAIRMAN IN THE EVENT OF HIS BEING PREVENTED FROM ATTENDING TO HIS DUTIES.

2 . THE DURATION OF THE TERMS OF OFFICE OF THE CHAIRMAN AND THE DEPUTY CHAIRMAN SHALL BE THREE YEARS. THE TERMS OF OFFICE SHALL BE RENEWABLE .

ARTICLE 17

BOARD

1 . THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL MAY SET UP A BOARD COMPOSED OF FIVE OF ITS MEMBERS.

2 . THE CHAIRMAN AND THE DEPUTY CHAIRMAN OF THE SELECT COMMITTEE SHALL BE MEMBERS OF THE BOARD EX OFFICIO ; THE OTHER THREE MEMBERS SHALL BE ELECTED BY THE SELECT COMMITTEE.

3 . THE TERM OF OFFICE OF THE MEMBERS ELECTED BY THE SELECT COMMITTEE SHALL BE THREE YEARS. THIS TERM OF OFFICE SHALL NOT BE RENEWABLE .

4 . THE BOARD SHALL PERFORM THE DUTIES GIVEN TO IT BY THE SELECT COMMITTEE IN ACCORDANCE WITH THE RULES OF PROCEDURE.

ARTICLE 18

MEETINGS

1 . MEETINGS OF THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL SHALL BE CONVENED BY ITS CHAIRMAN.

2 . THE PRESIDENT OF THE EUROPEAN PATENT OFFICE SHALL TAKE PART IN THE DELIBERATIONS OF THE SELECT COMMITTEE.

3 . THE SELECT COMMITTEE SHALL HOLD AN ORDINARY MEETING ONCE EACH YEAR . IN ADDITION , IT SHALL MEET ON THE INITIATIVE OF ITS CHAIRMAN OR AT THE REQUEST OF ONETHIRD OF THE CONTRACTING STATES.

4 . THE DELIBERATIONS OF THE SELECT COMMITTEE SHALL BE BASED ON AN AGENDA , AND SHALL BE HELD IN ACCORDANCE WITH ITS RULES OF PROCEDURE.

5 . THE PROVISIONAL AGENDA SHALL CONTAIN ANY QUESTION WHOSE INCLUSION IS REQUESTED BY ANY CONTRACTING STATE IN ACCORDANCE WITH THE RULES OF PROCEDURE.

ARTICLE 19

LANGUAGES OF THE SELECT COMMITTEE

1 . THE LANGUAGES IN USE IN THE DELIBERATIONS OF THE SELECT COMMITTEE OF

THE ADMINISTRATIVE COUNCIL SHALL BE ENGLISH , FRENCH AND GERMAN .

2 . DOCUMENTS SUBMITTED TO THE SELECT COMMITTEE , AND THE MINUTES OF ITS DELIBERATIONS , SHALL BE DRAWN UP IN THE THREE LANGUAGES MENTIONED IN PARAGRAPH 1.

ARTICLE 20

COMPETENCE OF THE SELECT COMMITTEE IN CERTAIN CASES

1 . THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL SHALL BE COMPETENT TO AMEND THE FOLLOWING PROVISIONS OF THIS CONVENTION :

(A) THE TIME LIMITS LAID DOWN IN THIS CONVENTION WHICH ARE TO BE OBSERVED VIS-A-VIS THE EUROPEAN PATENT OFFICE ;

(B) THE IMPLEMENTING REGULATIONS.

2 . THE SELECT COMMITTEE SHALL BE COMPETENT , IN CONFORMITY WITH THIS CONVENTION , TO ADOPT OR AMEND THE FOLLOWING PROVISIONS :

(A) THE FINANCIAL REGULATIONS ;

(B) THE RULES RELATING TO FEES ;

(C) ITS RULES OF PROCEDURE.

ARTICLE 21

VOTING RIGHTS

1 . THE RIGHT TO VOTE IN THE SELECT COMMITTEE OF 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 23.

ARTICLE 22

VOTING RULES

1 . THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL SHALL TAKE ITS DECISIONS OTHER THAN THOSE REFERRED TO IN PARAGRAPH 2 BY A SIMPLE MAJORITY OF THE CONTRACTING STATES REPRESENTED AND VOTING.

2 . A MAJORITY OF THREE-QUARTERS OF THE VOTES OF THE CONTRACTING STATES REPRESENTED AND VOTING SHALL BE REQUIRED FOR THE DECISIONS WHICH THE SELECT COMMITTEE IS EMPOWERED TO TAKE UNDER ARTICLES 20 AND 25 (A) .

3 . ABSTENTIONS SHALL NOT BE CONSIDERED AS VOTES.

ARTICLE 23

WEIGHTING OF VOTES

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 APPROVAL REFERRED TO IN ARTICLE 25 (A) , VOTING SHALL BE CONDUCTED ACCORDING TO ARTICLE 36 OF THE EUROPEAN PATENT CONVENTION. THE TERM " CONTRACTING STATES " IN THAT ARTICLE SHALL BE UNDERSTOOD AS MEANING THE STATES PARTIES TO THIS CONVENTION .

CHAPTER IV

FINANCIAL PROVISIONS

ARTICLE 24

FINANCIAL OBLIGATIONS AND BENEFITS

1 . THE AMOUNT PAYABLE BY THE STATES PARTIES TO THIS CONVENTION PURSUANT TO ARTICLE 146 OF THE EUROPEAN PATENT CONVENTION SHALL BE COVERED BY FINANCIAL CONTRIBUTIONS DETERMINED IN RESPECT OF EACH STATE IN ACCORDANCE WITH THE SCALE LAID DOWN IN ARTICLE 40 (3) OF THAT CONVENTION .

2 . BOTH THE REVENUE DERIVED FROM FEES PAID IN ACCORDANCE WITH THE RULES RELATING TO FEES , LESS THE PAYMENTS TO THE EUROPEAN PATENT ORGANIZATION PURSUANT TO ARTICLES 39 AND 147 OF THE EUROPEAN PATENT CONVENTION , AND ALL OTHER RECEIPTS OF THE EUROPEAN PATENT ORGANIZATION OBTAINED IN IMPLEMENTATION OF THIS CONVENTION SHALL BE DISTRIBUTED AMONG THE STATES PARTIES TO THIS CONVENTION IN ACCORDANCE WITH THE SCALE MENTIONED IN PARAGRAPH 1.

3 . UPON ENTRY INTO FORCE OF THIS CONVENTION THE NECESSARY WORK SHALL BE COMMENCED IN ORDER TO EXAMINE UNDER WHAT CONDITIONS AND AT WHAT DATE THE SYSTEM OF FINANCING PROVIDED FOR IN PARAGRAPHS 1 AND 2 MAY BE REPLACED BY ANOTHER SYSTEM BASED , HAVING REGARD TO DEVELOPMENTS IN THE EUROPEAN COMMUNITIES , ON COMMUNITY FINANCING. THIS SYSTEM MAY INCLUDE THE AMOUNTS PAYABLE BY THE STATES PARTIES TO THIS CONVENTION PURSUANT TO THE EUROPEAN PATENT CONVENTION AND THE AMOUNTS ACCRUING TO THESE STATES PURSUANT TO THAT CONVENTION. WHEN THIS WORK HAS BEEN CONCLUDED , THIS ARTICLE AND , IF APPROPRIATE , ARTICLE 23 MAY BE AMENDED BY A DECISION OF THE COUNCIL OF THE EUROPEAN COMMUNITIES ACTING UNANIMOUSLY ON A PROPOSAL FROM THE COMMISSION.

ARTICLE 25

POWERS OF THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL IN BUDGETARY MATTERS

THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL SHALL :

- (A) APPROVE ANNUALLY THE FORECASTS OF EXPENDITURE AND REVENUE RELATING TO THE IMPLEMENTATION OF THIS CONVENTION AND ANY AMENDMENTS OR ADDITIONS MADE TO THESE FORECASTS , SUBMITTED TO IT BY THE PRESIDENT OF THE EUROPEAN PATENT OFFICE , AND SUPERVISE THE IMPLEMENTATION THEREOF ;
- (B) GRANT THE AUTHORIZATION PROVIDED FOR IN ARTICLE 47 (2) OF THE EUROPEAN PATENT CONVENTION , IN SO FAR AS THE EXPENDITURE INVOLVED RELATES TO THE IMPLEMENTATION OF THIS CONVENTION ;
- (C) APPROVE THE ANNUAL ACCOUNTS OF THE EUROPEAN PATENT ORGANIZATION WHICH RELATE TO THE IMPLEMENTATION OF THIS CONVENTION AND THAT PART OF THE REPORT OF THE AUDITORS APPOINTED UNDER ARTICLE 49 (1) OF THE EUROPEAN PATENT CONVENTION WHICH RELATES TO THESE ACCOUNTS , AND GIVE THE PRESIDENT OF THE EUROPEAN PATENT OFFICE A DISCHARGE.

ARTICLE 26

RULES RELATING TO FEES

THE RULES RELATING TO FEES SHALL DETERMINE IN PARTICULAR THE AMOUNTS OF THE FEES AND THE WAYS IN WHICH THEY ARE TO BE PAID.

PART II

SUBSTANTIVE PATENT LAW

CHAPTER I

RIGHT TO THE COMMUNITY PATENT

ARTICLE 27

CLAIMING THE RIGHT TO THE COMMUNITY PATENT

1 . IF A COMMUNITY PATENT HAS BEEN GRANTED TO A PERSON WHO IS NOT ENTITLED TO IT UNDER ARTICLE 60 (1) OF THE EUROPEAN PATENT CONVENTION , THE PERSON ENTITLED TO IT UNDER THAT PROVISION MAY , WITHOUT PREJUDICE TO ANY OTHER REMEDY WHICH MAY BE OPEN TO HIM , CLAIM TO HAVE THE PATENT TRANSFERRED TO HIM.

2 . WHERE A PERSON IS ENTITLED TO ONLY PART OF THE COMMUNITY PATENT , THAT PERSON MAY , IN ACCORDANCE WITH PARAGRAPH 1 , CLAIM TO BE MADE A JOINT PROPRIETOR.

3 . LEGAL PROCEEDINGS IN RESPECT OF THE RIGHTS SPECIFIED IN PARAGRAPHS 1 AND 2 MAY BE INSTITUTED ONLY WITHIN A PERIOD OF NOT MORE THAN TWO YEARS AFTER THE DATE ON WHICH THE EUROPEAN PATENT BULLETIN MENTIONS THE GRANT OF THE EUROPEAN PATENT. THIS PROVISION SHALL NOT APPLY IF THE PROPRIETOR OF THE PATENT KNEW , AT THE TIME WHEN THE PATENT WAS GRANTED OR TRANSFERRED

TO HIM , THAT HE WAS NOT ENTITLED TO THE PATENT .

4 . THE FACT THAT LEGAL PROCEEDINGS HAVE BEEN INSTITUTED SHALL BE ENTERED IN THE REGISTER OF COMMUNITY PATENTS. ENTRY SHALL ALSO BE MADE OF THE FINAL DECISION IN , OR OF ANY OTHER TERMINATION OF , THE PROCEEDINGS .

ARTICLE 28

EFFECT OF CHANGE OF PROPRIETORSHIP

1 . WHERE THERE IS A COMPLETE CHANGE OF PROPRIETORSHIP OF A COMMUNITY PATENT AS A RESULT OF LEGAL PROCEEDINGS UNDER ARTICLE 27 , LICENCES AND OTHER RIGHTS SHALL LAPSE UPON THE REGISTRATION OF THE PERSON ENTITLED TO THE PATENT IN THE REGISTER OF COMMUNITY PATENTS.

2 . IF , BEFORE THE INSTITUTION OF LEGAL PROCEEDINGS HAS BEEN REGISTERED ,

(A) THE PROPRIETOR OF THE PATENT HAS USED THE INVENTION WITHIN THE TERRITORY OF ANY OF THE CONTRACTING STATES OR MADE EFFECTIVE AND SERIOUS PREPARATIONS TO DO SO , OR

(B) A LICENSEE OF THE PATENT HAS OBTAINED HIS LICENCE AND HAS USED THE INVENTION WITHIN THE TERRITORY OF ANY OF THE CONTRACTING STATES OR MADE EFFECTIVE AND SERIOUS PREPARATIONS TO DO SO ,

HE MAY CONTINUE SUCH USE PROVIDED THAT HE REQUESTS A NON-EXCLUSIVE LICENCE OF THE PATENT FROM THE NEW PROPRIETOR WHOSE NAME IS ENTERED IN THE REGISTER OF COMMUNITY PATENTS. SUCH REQUEST MUST BE MADE WITHIN THE PERIOD PRESCRIBED IN THE IMPLEMENTING REGULATIONS. THE LICENCE SHALL BE GRANTED FOR A REASONABLE PERIOD AND UPON REASONABLE TERMS.

3 . PARAGRAPH 2 SHALL NOT APPLY IF THE PROPRIETOR OF THE PATENT OR THE LICENSEE , AS THE CASE MAY BE , WAS ACTING IN BAD FAITH AT THE TIME WHEN HE BEGAN TO USE THE INVENTION OR TO MAKE PREPARATIONS TO DO SO .

CHAPTER II

EFFECTS OF THE COMMUNITY PATENT AND THE EUROPEAN PATENT APPLICATION

ARTICLE 29

PROHIBITION OF DIRECT USE OF THE INVENTION

A COMMUNITY PATENT SHALL CONFER ON ITS PROPRIETOR THE RIGHT TO PREVENT ALL THIRD PARTIES NOT HAVING HIS CONSENT :

(A) FROM MAKING , OFFERING , PUTTING ON THE MARKET OR USING A PRODUCT WHICH IS THE SUBJECT-MATTER OF THE PATENT , OR IMPORTING OR STOCKING THE PRODUCT FOR THESE PURPOSES ;

(B) FROM USING A PROCESS WHICH IS THE SUBJECT-MATTER OF THE PATENT OR , WHEN THE THIRD PARTY KNOWS , OR IT IS OBVIOUS IN THE CIRCUMSTANCES

, THAT THE USE OF THE PROCESS IS PROHIBITED WITHOUT THE CONSENT OF THE PROPRIETOR OF THE PATENT , FROM OFFERING THE PROCESS FOR USE WITHIN THE TERRITORIES OF THE CONTRACTING STATES ;

(C) FROM OFFERING , PUTTING ON THE MARKET , USING , OR IMPORTING OR STOCKING FOR THESE PURPOSES THE PRODUCT OBTAINED DIRECTLY BY A PROCESS WHICH IS THE SUBJECT-MATTER OF THE PATENT.

ARTICLE 30

PROHIBITION OF INDIRECT USE OF THE INVENTION

1 . A COMMUNITY PATENT SHALL ALSO CONFER ON ITS PROPRIETOR THE RIGHT TO PREVENT ALL THIRD PARTIES NOT HAVING HIS CONSENT FROM SUPPLYING OR OFFERING TO SUPPLY WITHIN THE TERRITORIES OF THE CONTRACTING STATES A PERSON , OTHER THAN A PARTY ENTITLED TO EXPLOIT THE PATENTED INVENTION , WITH MEANS , RELATING TO AN ESSENTIAL ELEMENT OF THAT INVENTION , FOR PUTTING IT INTO EFFECT THEREIN , WHEN THE THIRD PARTY KNOWS , OR IT IS OBVIOUS IN THE CIRCUMSTANCES , THAT THESE MEANS ARE SUITABLE AND INTENDED FOR PUTTING THAT INVENTION INTO EFFECT.

2 . PARAGRAPH 1 SHALL NOT APPLY WHEN THE MEANS ARE STAPLE COMMERCIAL PRODUCTS , EXCEPT WHEN THE THIRD PARTY INDUCES THE PERSON SUPPLIED TO COMMIT ACTS PROHIBITED BY ARTICLE 29.

3 . PERSONS PERFORMING THE ACTS REFERRED TO IN ARTICLE 31 (A) TO (C) SHALL NOT BE CONSIDERED TO BE PARTIES ENTITLED TO EXPLOIT THE INVENTION WITHIN THE MEANING OF PARAGRAPH 1.

ARTICLE 31

LIMITATION OF THE EFFECTS OF THE COMMUNITY PATENT

THE RIGHTS CONFERRED BY A COMMUNITY PATENT SHALL NOT EXTEND TO :

- (A) ACTS DONE PRIVATELY AND FOR NON-COMMERCIAL PURPOSES ;
- (B) ACTS DONE FOR EXPERIMENTAL PURPOSES RELATING TO THE SUBJECT-MATTER OF THE PATENTED INVENTION ;
- (C) THE EXTEMPORANEOUS PREPARATION FOR INDIVIDUAL CASES IN A PHARMACY OF A MEDICINE IN ACCORDANCE WITH A MEDICAL PRESCRIPTION OR ACTS CONCERNING THE MEDICINE SO PREPARED ;
- (D) THE USE ON BOARD VESSELS OF THE COUNTRIES OF THE UNION OF PARIS FOR THE PROTECTION OF INDUSTRIAL PROPERTY , OTHER THAN THE CONTRACTING STATES , OF THE PATENTED INVENTION , IN THE BODY OF THE VESSEL , IN THE MACHINERY , TACKLE , GEAR AND OTHER ACCESSORIES , WHEN SUCH VESSELS TEMPORARILY OR ACCIDENTALLY ENTER THE WATERS OF CONTRACTING STATES , PROVIDED THAT THE INVENTION IS USED THERE EXCLUSIVELY FOR THE NEEDS OF THE VESSEL ;

- (E) THE USE OF THE PATENTED INVENTION IN THE CONSTRUCTION OR OPERATION OF AIRCRAFT OR LAND VEHICLES OF COUNTRIES OF THE UNION OF PARIS FOR THE PROTECTION OF INDUSTRIAL PROPERTY , OTHER THAN THE CONTRACTING STATES , OR OF ACCESSORIES TO SUCH AIRCRAFT OR LAND VEHICLES , WHEN THESE TEMPORARILY OR ACCIDENTALLY ENTER THE TERRITORY OF CONTRACTING STATES ;
- (F) THE ACTS SPECIFIED IN ARTICLE 27 OF THE CONVENTION ON INTERNATIONAL CIVIL AVIATION OF 7 DECEMBER 1944 , WHERE THESE ACTS CONCERN THE AIRCRAFT OF A STATE , OTHER THAN THE CONTRACTING STATES , BENEFITING FROM THE PROVISIONS OF THAT ARTICLE.

ARTICLE 32

EXHAUSTION OF THE RIGHTS CONFERRED BY THE COMMUNITY PATENT

THE RIGHTS CONFERRED BY A COMMUNITY PATENT SHALL NOT EXTEND TO ACTS CONCERNING A PRODUCT COVERED BY THAT PATENT WHICH ARE DONE WITHIN THE TERRITORIES OF THE CONTRACTING STATES AFTER THAT PRODUCT HAS BEEN PUT ON THE MARKET IN ONE OF THESE STATES BY THE PROPRIETOR OF THE PATENT OR WITH HIS EXPRESS CONSENT , UNLESS THERE ARE GROUNDS WHICH , UNDER COMMUNITY LAW , WOULD JUSTIFY THE EXTENSION TO SUCH ACTS OF THE RIGHTS CONFERRED BY THE PATENT.

ARTICLE 33

TRANSLATION OF THE CLAIMS IN EXAMINATION OR OPPOSITION PROCEEDINGS

- 1 . THE APPLICANT SHALL FILE WITH THE EUROPEAN PATENT OFFICE WITHIN THE TIME LIMIT PRESCRIBED IN THE IMPLEMENTING REGULATIONS A TRANSLATION OF THE CLAIMS ON WHICH THE GRANT OF THE EUROPEAN PATENT IS TO BE BASED IN ONE OF THE OFFICIAL LANGUAGES OF EACH OF THE CONTRACTING STATES WHICH DOES NOT HAVE ENGLISH , FRENCH OR GERMAN AS AN OFFICIAL LANGUAGE.
- 2 . PARAGRAPH 1 SHALL APPLY MUTATIS MUTANDIS IN RESPECT OF CLAIMS WHICH ARE AMENDED DURING OPPOSITION PROCEEDINGS.
- 3 . THE TRANSLATIONS OF THE CLAIMS SHALL BE PUBLISHED BY THE EUROPEAN PATENT OFFICE.
- 4 . THE APPLICANT FOR OR PROPRIETOR OF THE PATENT SHALL PAY THE FEE FOR THE PUBLICATION OF THE TRANSLATIONS OF THE CLAIMS WITHIN THE TIME LIMITS PRESCRIBED IN THE IMPLEMENTING REGULATIONS.
- 5 . IF THE TRANSLATIONS PRESCRIBED IN PARAGRAPHS 1 AND 2 ARE NOT FILED IN DUE TIME OR IF THE FEE FOR THE PUBLICATION OF THE TRANSLATIONS OF THE CLAIMS IS NOT PAID IN DUE TIME , THE COMMUNITY PATENT SHALL BE DEEMED TO BE VOID AB INITIO , UNLESS THESE ACTS ARE DONE AND THE ADDITIONAL FEE IS PAID WITHIN A FURTHER PERIOD AS PRESCRIBED IN THE IMPLEMENTING REGULATIONS.

ARTICLE 34

RIGHTS CONFERRED BY A EUROPEAN PATENT APPLICATION AFTER PUBLICATION

1 . COMPENSATION REASONABLE IN THE CIRCUMSTANCES MAY BE CLAIMED FROM A THIRD PARTY WHO , IN THE PERIOD BETWEEN THE DATE OF PUBLICATION OF A EUROPEAN PATENT APPLICATION IN WHICH THE CONTRACTING STATES ARE DESIGNATED AND THE DATE OF PUBLICATION OF THE MENTION OF THE GRANT OF THE EUROPEAN PATENT , HAS MADE ANY USE OF THE INVENTION WHICH , AFTER THAT PERIOD , WOULD BE PROHIBITED BY VIRTUE OF THE COMMUNITY PATENT.

2 . ANY CONTRACTING STATE WHICH DOES NOT HAVE AS AN OFFICIAL LANGUAGE THE LANGUAGE OF THE PROCEEDINGS OF A EUROPEAN PATENT APPLICATION IN WHICH THE CONTRACTING STATES ARE DESIGNATED , MAY PRESCRIBE THAT SUCH APPLICATION SHALL NOT CONFER , IN RESPECT OF USE OF THE INVENTION WITHIN ITS TERRITORY , THE RIGHT REFERRED TO IN PARAGRAPH 1 UNTIL SUCH TIME AS THE APPLICANT , AT HIS OPTION , HAS :

- (A) SUPPLIED A TRANSLATION OF THE CLAIMS IN ONE OF ITS OFFICIAL LANGUAGES TO THE COMPETENT AUTHORITY OF THAT STATE AND THE TRANSLATION HAS BEEN PUBLISHED , OR
- (B) COMMUNICATED SUCH A TRANSLATION TO THE PERSON USING THE INVENTION WITHIN THAT STATE.

ARTICLE 35

EFFECT OF REVOCATION OF THE COMMUNITY PATENT

1 . A EUROPEAN PATENT APPLICATION IN WHICH THE CONTRACTING STATES ARE DESIGNATED AND THE RESULTING COMMUNITY PATENT SHALL BE DEEMED NOT TO HAVE HAD , AS FROM THE OUTSET , THE EFFECTS SPECIFIED IN THIS CHAPTER , TO THE EXTENT THAT THE PATENT HAS BEEN REVOKED.

2 . SUBJECT TO THE NATIONAL PROVISIONS RELATING EITHER TO CLAIMS FOR COMPENSATION FOR DAMAGE CAUSED BY NEGLIGENCE OR LACK OF GOOD FAITH ON THE PART OF THE PROPRIETOR OF THE PATENT , OR TO UNJUST ENRICHMENT , THE RETROACTIVE EFFECT OF THE REVOCATION OF THE PATENT AS A RESULT OF OPPOSITION OR REVOCATION PROCEEDINGS SHALL NOT AFFECT :

- (A) ANY DECISION ON INFRINGEMENT WHICH HAS ACQUIRED THE AUTHORITY OF A FINAL DECISION AND BEEN ENFORCED PRIOR TO THE REVOCATION DECISION
- (B) ANY CONTRACT CONCLUDED PRIOR TO THE REVOCATION DECISION , IN SO FAR AS IT HAS BEEN PERFORMED BEFORE THAT DECISION ; HOWEVER , REPAYMENT , TO AN EXTENT JUSTIFIED BY THE CIRCUMSTANCES , OF SUMS PAID UNDER THE RELEVANT CONTRACT , MAY BE CLAIMED ON GROUNDS OF EQUITY.

ARTICLE 36

COMPLEMENTARY APPLICATION OF NATIONAL LAW REGARDING INFRINGEMENT

1 . THE EFFECTS OF A COMMUNITY PATENT SHALL BE GOVERNED SOLELY BY THE PROVISIONS OF THIS CONVENTION. IN OTHER RESPECTS , INFRINGEMENT OF A COMMUNITY PATENT SHALL BE GOVERNED BY THE NATIONAL LAW RELATING TO INFRINGEMENT OF A NATIONAL PATENT IN THE CONTRACTING STATE WHERE THE COURT HEARING THE ACTION IS LOCATED , IN SO FAR AS THE PRIVATE INTERNATIONAL LAW OF THAT STATE DOES NOT REQUIRE APPLICATION OF THE NATIONAL LAW OF ANOTHER CONTRACTING STATE.

2 . THE RULES OF PROCEDURE APPLICABLE ARE THOSE SPECIFIED IN ARTICLE 74 .

3 . PARAGRAPHS 1 AND 2 SHALL APPLY MUTATIS MUTANDIS TO A EUROPEAN PATENT APPLICATION IN WHICH THE CONTRACTING STATES ARE DESIGNATED.

CHAPTER III

NATIONAL RIGHTS

ARTICLE 37

NATIONAL PRIOR RIGHT

1 . WITH REGARD TO A COMMUNITY PATENT HAVING A DATE OF FILING OR , WHERE PRIORITY HAS BEEN CLAIMED , A DATE OF PRIORITY LATER THAN THAT OF A NATIONAL PATENT APPLICATION OR NATIONAL PATENT MADE PUBLIC IN A CONTRACTING STATE ON OR AFTER THAT DATE , THE NATIONAL PATENT APPLICATION OR PATENT SHALL , FOR THAT CONTRACTING STATE , HAVE THE SAME PRIOR RIGHT EFFECT AS A PUBLISHED EUROPEAN PATENT APPLICATION DESIGNATING THAT CONTRACTING STATE.

2 . IF , IN A CONTRACTING STATE , A NATIONAL PATENT APPLICATION OR PATENT , WHICH IS UNPUBLISHED BY REASON OF THE NATIONAL LAW OF THAT STATE CONCERNING THE SECRECY OF INVENTIONS , HAS A PRIOR RIGHT EFFECT WITH REGARD TO A NATIONAL PATENT IN THAT STATE HAVING A LATER DATE OF FILING , OR WHERE PRIORITY HAS BEEN CLAIMED A LATER DATE OF PRIORITY , THE SAME SHALL APPLY IN THAT STATE WITH REGARD TO A COMMUNITY PATENT.

ARTICLE 38

RIGHT BASED ON PRIOR USE AND RIGHT OF PERSONAL POSSESSION

1 . ANY PERSON WHO , IF A NATIONAL PATENT HAD BEEN GRANTED IN RESPECT OF AN INVENTION , WOULD HAVE HAD , IN ONE OF THE CONTRACTING STATES , A RIGHT BASED ON PRIOR USE OF THAT INVENTION OR A RIGHT OF PERSONAL POSSESSION OF THAT INVENTION , SHALL ENJOY , IN THAT STATE , THE SAME RIGHTS IN RESPECT OF A COMMUNITY PATENT FOR THE SAME INVENTION .

2 . THE RIGHTS CONFERRED BY A COMMUNITY PATENT SHALL NOT EXTEND TO ACTS CONCERNING A PRODUCT COVERED BY THAT PATENT WHICH ARE DONE WITHIN THE TERRITORY OF THE STATE CONCERNED AFTER THAT PRODUCT HAS BEEN PUT ON THE MARKET IN THAT STATE BY THE PERSON REFERRED TO IN PARAGRAPH 1 , IN SO FAR

AS THE NATIONAL LAW OF THAT STATE MAKES PROVISION TO THE SAME EFFECT IN RESPECT OF NATIONAL PATENTS.

CHAPTER IV

THE COMMUNITY PATENT AS AN OBJECT OF PROPERTY

ARTICLE 39

DEALING WITH THE COMMUNITY PATENT AS A NATIONAL PATENT

1 . UNLESS OTHERWISE SPECIFIED IN THIS CONVENTION , A COMMUNITY PATENT AS AN OBJECT OF PROPERTY SHALL BE DEALT WITH IN ITS ENTIRETY , AND FOR THE WHOLE OF THE TERRITORIES IN WHICH IT IS EFFECTIVE , AS A NATIONAL PATENT OF THE CONTRACTING STATE IN WHICH , ACCORDING TO THE REGISTER OF EUROPEAN PATENTS PROVIDED FOR IN THE EUROPEAN PATENT CONVENTION :

- (A) THE APPLICANT FOR THE PATENT HAD HIS RESIDENCE OR PRINCIPAL PLACE OF BUSINESS ON THE DATE OF FILING OF THE EUROPEAN PATENT APPLICATION ,
- (B) WHERE SUBPARAGRAPH (A) DOES NOT APPLY , THE APPLICANT HAD A PLACE OF BUSINESS ON THAT DATE , OR
- (C) WHERE NEITHER SUBPARAGRAPH (A) NOR SUBPARAGRAPH (B) APPLIES , THE APPLICANT'S REPRESENTATIVE WHOSE NAME IS ENTERED FIRST IN THE REGISTER OF EUROPEAN PATENTS HAD HIS PLACE OF BUSINESS ON THE DATE OF THAT ENTRY .

2 . WHERE SUBPARAGRAPHS (A) , (B) AND (C) OF PARAGRAPH 1 DO NOT APPLY , THE CONTRACTING STATE REFERRED TO IN THAT PARAGRAPH SHALL BE THE FEDERAL REPUBLIC OF GERMANY.

3 . IF TWO OR MORE PERSONS ARE MENTIONED IN THE REGISTER OF EUROPEAN PATENTS AS JOINT APPLICANTS , PARAGRAPH 1 SHALL APPLY TO THE JOINT APPLICANT FIRST MENTIONED ; IF THIS IS NOT POSSIBLE , IT SHALL APPLY TO THE JOINT APPLICANT NEXT MENTIONED IN RESPECT OF WHOM IT IS APPLICABLE . WHERE PARAGRAPH 1 DOES NOT APPLY TO ANY OF THE JOINT APPLICANTS , PARAGRAPH 2 SHALL APPLY.

4 . IF IN A CONTRACTING STATE AS DETERMINED BY THE PRECEDING PARAGRAPHS A RIGHT IN RESPECT OF A NATIONAL PATENT IS EFFECTIVE ONLY AFTER ENTRY IN THE NATIONAL PATENT REGISTER , SUCH A RIGHT IN RESPECT OF A COMMUNITY PATENT SHALL BE EFFECTIVE ONLY AFTER ENTRY IN THE REGISTER OF COMMUNITY PATENTS.

ARTICLE 40

TRANSFER

1 . AN ASSIGNMENT OF A COMMUNITY PATENT SHALL BE MADE IN WRITING AND SHALL REQUIRE THE SIGNATURE OF THE PARTIES TO THE CONTRACT , EXCEPT WHEN IT IS A RESULT OF A JUDGMENT.

2 . SUBJECT TO ARTICLE 28 (1) , A TRANSFER SHALL NOT AFFECT RIGHTS ACQUIRED BY THIRD PARTIES BEFORE THE DATE OF TRANSFER.

3 . A TRANSFER SHALL , TO THE EXTENT TO WHICH IT IS VERIFIED BY THE PAPERS REFERRED TO IN THE IMPLEMENTING REGULATIONS , ONLY HAVE EFFECT VIS-A-VIS THIRD PARTIES AFTER ENTRY IN THE REGISTER OF COMMUNITY PATENTS . NEVERTHELESS , A TRANSFER , BEFORE IT IS SO ENTERED , SHALL HAVE EFFECT VIS-A-VIS THIRD PARTIES WHO HAVE ACQUIRED RIGHTS AFTER THE DATE OF THE TRANSFER BUT WHO KNEW OF THE TRANSFER AT THE DATE ON WHICH THE RIGHTS WERE ACQUIRED.

ARTICLE 41

ENFORCEMENT PROCEEDINGS

THE COURTS AND OTHER AUTHORITIES OF THE CONTRACTING STATE DETERMINED IN ACCORDANCE WITH ARTICLE 39 SHALL HAVE EXCLUSIVE JURISDICTION IN RESPECT OF PROCEEDINGS RELATING TO JUDGMENTS OR OTHER OFFICIAL ACTS IN SO FAR AS THEY ARE BEING ENFORCED AGAINST COMMUNITY PATENTS.

ARTICLE 42

BANKRUPTCY OR LIKE PROCEEDINGS

1 . UNTIL SUCH TIME AS COMMON RULES FOR THE CONTRACTING STATES IN THIS FIELD ENTER INTO FORCE , THE ONLY CONTRACTING STATE IN WHICH A COMMUNITY PATENT MAY BE INVOLVED IN BANKRUPTCY OR LIKE PROCEEDINGS SHALL BE THAT IN WHICH SUCH PROCEEDINGS ARE OPENED FIRST.

2 . PARAGRAPH 1 SHALL APPLY MUTATIS MUTANDIS IN THE CASE OF JOINT PROPRIETORSHIP OF A COMMUNITY PATENT TO THE SHARE OF THE JOINT PROPRIETOR .

ARTICLE 43

CONTRACTUAL LICENSING

1 . A COMMUNITY PATENT MAY BE LICENSED IN WHOLE OR IN PART FOR THE WHOLE OR PART OF THE TERRITORIES IN WHICH IT IS EFFECTIVE. A LICENCE MAY BE EXCLUSIVE OR NON-EXCLUSIVE.

2 . THE RIGHTS CONFERRED BY THE COMMUNITY PATENT MAY BE INVOKED AGAINST A LICENSEE WHO CONTRAVENES ANY RESTRICTION IN HIS LICENCE WHICH IS COVERED BY PARAGRAPH 1.

3 . ARTICLE 40 (2) AND (3) SHALL APPLY MUTATIS MUTANDIS TO THE GRANT OR TRANSFER OF A LICENCE IN RESPECT OF A COMMUNITY PATENT.

ARTICLE 44

LICENCES OF RIGHT

1 . WHERE THE PROPRIETOR OF A COMMUNITY PATENT FILES A WRITTEN STATEMENT WITH THE EUROPEAN PATENT OFFICE THAT HE IS PREPARED TO ALLOW ANY PERSON TO USE THE INVENTION AS A LICENSEE IN RETURN FOR APPROPRIATE COMPENSATION , THE RENEWAL FEES FOR THE COMMUNITY PATENT WHICH FALL DUE AFTER RECEIPT OF THE STATEMENT SHALL BE REDUCED ; THE AMOUNT OF THE REDUCTION SHALL BE FIXED IN THE RULES RELATING TO FEES. WHERE THERE IS A COMPLETE CHANGE OF PROPRIETORSHIP OF THE PATENT AS A RESULT OF LEGAL PROCEEDINGS UNDER ARTICLE 27 , THE STATEMENT SHALL BE DEEMED WITHDRAWN UPON THE ENTRY OF THE NAME OF THE PERSON ENTITLED TO THE PATENT IN THE REGISTER OF COMMUNITY PATENTS.

2 . THE STATEMENT MAY BE WITHDRAWN AT ANY TIME UPON WRITTEN NOTIFICATION TO THIS EFFECT TO THE EUROPEAN PATENT OFFICE , PROVIDED THAT NO ONE HAS INFORMED THE PROPRIETOR OF THE PATENT OF HIS INTENTION TO USE THE INVENTION. SUCH WITHDRAWAL SHALL TAKE EFFECT FROM THE DATE OF ITS NOTIFICATION. THE AMOUNT BY WHICH THE RENEWAL FEES WERE REDUCED SHALL BE PAID WITHIN ONE MONTH AFTER WITHDRAWAL ; ARTICLE 49 (2) SHALL APPLY , BUT THE SIX-MONTH PERIOD SHALL START UPON EXPIRY OF THE ABOVE PERIOD.

3 . THE STATEMENT MAY NOT BE FILED WHILE AN EXCLUSIVE LICENCE IS RECORDED IN THE REGISTER OF COMMUNITY PATENTS OR A REQUEST FOR THE RECORDING OF SUCH A LICENCE IS BEFORE THE EUROPEAN PATENT OFFICE.

4 . ON THE BASIS OF THE STATEMENT , ANY PERSON SHALL BE ENTITLED TO USE THE INVENTION AS A LICENSEE UNDER THE CONDITIONS LAID DOWN IN THE IMPLEMENTING REGULATIONS. A LICENCE SO OBTAINED SHALL , FOR THE PURPOSES OF THIS CONVENTION , BE TREATED AS A CONTRACTUAL LICENCE.

5 . ON WRITTEN REQUEST BY ONE OF THE PARTIES , A REVOCATION DIVISION SHALL DETERMINE THE APPROPRIATE COMPENSATION OR REVIEW IT IF CIRCUMSTANCES HAVE ARISEN OR BECOME KNOWN WHICH RENDER THE COMPENSATION DETERMINED OBVIOUSLY INAPPROPRIATE. THE PROVISIONS GOVERNING REVOCATION PROCEEDINGS SHALL APPLY MUTATIS MUTANDIS , UNLESS THEY ARE INAPPLICABLE AS A RESULT OF THE PARTICULAR NATURE OF REVOCATION PROCEEDINGS. THE REQUEST SHALL NOT BE DEEMED TO HAVE BEEN MADE UNTIL SUCH TIME AS AN ADMINISTRATIVE FEE HAS BEEN PAID.

6 . NO REQUEST FOR RECORDING AN EXCLUSIVE LICENCE IN THE REGISTER OF COMMUNITY PATENTS SHALL BE ADMISSIBLE AFTER THE STATEMENT HAS BEEN FILED , UNLESS IT IS WITHDRAWN OR DEEMED WITHDRAWN.

ARTICLE 45

THE EUROPEAN PATENT APPLICATION AS AN OBJECT OF PROPERTY

1 . ARTICLES 39 TO 43 SHALL APPLY MUTATIS MUTANDIS TO A EUROPEAN PATENT APPLICATION IN WHICH THE CONTRACTING STATES ARE DESIGNATED , THE REFERENCES TO THE REGISTER OF COMMUNITY PATENTS BEING UNDERSTOOD AS REFERRING TO THE REGISTER OF EUROPEAN PATENTS PROVIDED FOR IN THE EUROPEAN PATENT CONVENTION.

2 . THE RIGHTS ACQUIRED BY THIRD PARTIES IN RESPECT OF A EUROPEAN PATENT APPLICATION REFERRED TO IN PARAGRAPH 1 SHALL CONTINUE TO BE EFFECTIVE WITH REGARD TO THE COMMUNITY PATENT GRANTED UPON THAT APPLICATION .

CHAPTER V

COMPULSORY LICENCES IN RESPECT OF A COMMUNITY PATENT

ARTICLE 46

COMPULSORY LICENCES

1 . ANY PROVISION IN THE LAW OF A CONTRACTING STATE FOR THE GRANT OF COMPULSORY LICENCES IN RESPECT OF NATIONAL PATENTS SHALL BE APPLICABLE TO COMMUNITY PATENTS. THE EXTENT AND EFFECT OF COMPULSORY LICENCES GRANTED IN RESPECT OF COMMUNITY PATENTS SHALL BE RESTRICTED TO THE TERRITORY OF THE STATE CONCERNED. ARTICLE 32 SHALL NOT APPLY.

2 . EACH CONTRACTING STATE SHALL , AT LEAST IN RESPECT OF COMPENSATION UNDER A COMPULSORY LICENCE , PROVIDE FOR A FINAL APPEAL TO A COURT OF LAW.

3 . AS FAR AS PRACTICABLE NATIONAL AUTHORITIES SHALL NOTIFY THE EUROPEAN PATENT OFFICE OF THE GRANT OF ANY COMPULSORY LICENCE IN RESPECT OF A COMMUNITY PATENT.

4 . FOR THE PURPOSES OF THIS CONVENTION , THE TERM " COMPULSORY LICENCES " SHALL BE CONSTRUED AS INCLUDING OFFICIAL LICENCES AND ANY RIGHT TO USE PATENTED INVENTIONS IN THE PUBLIC INTEREST.

ARTICLE 47

COMPULSORY LICENCES FOR LACK OR INSUFFICIENCY OF EXPLOITATION

A COMPULSORY LICENCE MAY NOT BE GRANTED IN RESPECT OF A COMMUNITY PATENT ON THE GROUND OF LACK OR INSUFFICIENCY OF EXPLOITATION IF THE PRODUCT COVERED BY THE PATENT , WHICH IS MANUFACTURED IN A CONTRACTING STATE , IS PUT ON THE MARKET IN THE TERRITORY OF ANY OTHER CONTRACTING STATE , FOR WHICH SUCH A LICENCE HAS BEEN REQUESTED , IN SUFFICIENT QUANTITY TO SATISFY NEEDS IN THE TERRITORY OF THAT OTHER CONTRACTING STATE . THIS PROVISION SHALL NOT APPLY TO COMPULSORY LICENCES GRANTED IN THE PUBLIC INTEREST.

ARTICLE 48

COMPULSORY LICENCES IN RESPECT OF DEPENDENT PATENTS

ANY PROVISION IN THE LAW OF A CONTRACTING STATE FOR THE GRANT OF COMPULSORY LICENCES IN RESPECT OF EARLIER PATENTS IN FAVOUR OF SUBSEQUENT DEPENDENT PATENTS SHALL BE APPLICABLE TO THE RELATIONSHIP BETWEEN COMMUNITY PATENTS

AND NATIONAL PATENTS AND TO THE RELATIONSHIP BETWEEN COMMUNITY PATENTS THEMSELVES.

PART III

RENEWAL , LAPSE , LIMITATION AND REVOCATION OF THE COMMUNITY PATENT

CHAPTER I

RENEWAL AND LAPSE

ARTICLE 49

RENEWAL FEES

1 . RENEWAL FEES IN RESPECT OF COMMUNITY PATENTS SHALL BE PAID TO THE EUROPEAN PATENT OFFICE IN ACCORDANCE WITH THE IMPLEMENTING REGULATIONS . THESE FEES SHALL BE DUE IN RESPECT OF THE YEARS FOLLOWING THE YEAR REFERRED TO IN ARTICLE 86 (4) OF THE EUROPEAN PATENT CONVENTION , PROVIDED THAT NO RENEWAL FEES SHALL BE DUE IN RESPECT OF THE FIRST TWO YEARS , CALCULATED FROM THE DATE OF FILING OF THE APPLICATION.

2 . WHEN A RENEWAL FEE HAS NOT BEEN PAID ON OR BEFORE THE DUE DATE , THE FEE MAY BE VALIDLY PAID WITHIN SIX MONTHS OF THAT DATE , PROVIDED THAT THE ADDITIONAL FEE IS PAID AT THE SAME TIME.

3 . ANY RENEWAL FEE IN RESPECT OF A COMMUNITY PATENT FALLING DUE WITHIN TWO MONTHS AFTER THE PUBLICATION OF THE MENTION OF THE GRANT OF THE EUROPEAN PATENT SHALL BE DEEMED TO HAVE BEEN VALIDLY PAID IF IT IS PAID WITHIN THAT PERIOD. NO ADDITIONAL FEE SHALL BE CHARGED.

ARTICLE 50

SURRENDER

1 . A COMMUNITY PATENT MAY BE SURRENDERED ONLY IN ITS ENTIRETY.

2 . THE SURRENDER MUST BE DECLARED IN WRITING TO THE EUROPEAN PATENT OFFICE BY THE PROPRIETOR OF THE PATENT. IT SHALL NOT HAVE EFFECT UNTIL IT IS ENTERED IN THE REGISTER OF COMMUNITY PATENTS.

3 . SURRENDER WILL BE ENTERED IN THE REGISTER OF COMMUNITY PATENTS ONLY WITH THE AGREEMENT OF ANY THIRD PARTY WHO HAS A RIGHT IN REM RECORDED IN THE REGISTER OR IN RESPECT OF WHOM THERE IS AN ENTRY IN THE REGISTER PURSUANT TO THE FIRST SENTENCE OF ARTICLE 27 (4) . IF A LICENCE IS RECORDED IN THE REGISTER , SURRENDER WILL BE ENTERED ONLY IF THE PROPRIETOR OF THE PATENT PROVES THAT HE HAS PREVIOUSLY INFORMED THE LICENSEE OF HIS INTENTION TO SURRENDER ; THIS ENTRY WILL BE MADE ON EXPIRY OF THE PERIOD LAID DOWN IN THE IMPLEMENTING REGULATIONS.

ARTICLE 51

LAPSE

1 . A COMMUNITY PATENT SHALL LAPSE :

- (A) AT THE END OF THE TERM LAID DOWN IN ARTICLE 63 OF THE EUROPEAN PATENT CONVENTION ;
- (B) IF THE PROPRIETOR OF THE PATENT SURRENDERS IT IN ACCORDANCE WITH ARTICLE 50 ;
- (C) IF A RENEWAL FEE AND ANY ADDITIONAL FEE HAVE NOT BEEN PAID IN DUE TIME .

2 . THE COMMUNITY PATENT SHALL LAPSE ON THE DATE MENTIONED IN ARTICLE 54 (4) TO THE EXTENT THAT IT IS NOT MAINTAINED.

3 . THE LAPSE OF A PATENT FOR FAILURE TO PAY A RENEWAL FEE AND ANY ADDITIONAL FEE WITHIN THE DUE PERIOD SHALL BE DEEMED TO HAVE OCCURRED ON THE DATE ON WHICH THE RENEWAL FEE WAS DUE.

4 . THE LAPSE OF A COMMUNITY PATENT SHALL , IF NECESSARY , BE DECIDED BY THE PATENT ADMINISTRATION DIVISION OR , IF PROCEEDINGS IN RESPECT OF THAT PATENT ARE PENDING BEFORE IT , A REVOCATION DIVISION OR A REVOCATION BOARD.

CHAPTER II

LIMITATION PROCEDURE

ARTICLE 52

REQUEST FOR LIMITATION

1 . AT THE REQUEST OF THE PROPRIETOR , A COMMUNITY PATENT MAY BE LIMITED IN THE FORM OF AN AMENDMENT TO THE CLAIMS , THE DESCRIPTION OR THE DRAWINGS. LIMITATION IN RESPECT OF ONE OR SOME OF THE CONTRACTING STATES MAY BE REQUESTED ONLY WHERE ARTICLE 37 (1) APPLIES.

2 . THE REQUEST MAY NOT BE FILED DURING THE PERIOD WITHIN WHICH AN OPPOSITION MAY BE FILED OR WHILE OPPOSITION PROCEEDINGS OR REVOCATION PROCEEDINGS ARE PENDING.

3 . THE REQUEST SHALL BE FILED IN WRITING WITH THE EUROPEAN PATENT OFFICE . IT SHALL NOT BE DEEMED TO HAVE BEEN FILED UNTIL THE FEE FOR LIMITATION HAS BEEN PAID.

4 . ARTICLE 50 (3) SHALL APPLY MUTATIS MUTANDIS TO THE FILING OF THE REQUEST .

5 . WHERE AN APPLICATION FOR REVOCATION OF THE COMMUNITY PATENT IS FILED DURING LIMITATION PROCEEDINGS , THE REVOCATION DIVISION SHALL STAY THE LIMITATION PROCEEDINGS UNTIL A FINAL DECISION IS GIVEN IN RESPECT OF THE APPLICATION FOR REVOCATION.

ARTICLE 53

EXAMINATION OF THE REQUEST

1 . THE REVOCATION DIVISION SHALL EXAMINE WHETHER THE GROUNDS FOR REVOCATION MENTIONED IN ARTICLE 57 (1) (A) TO (D) , WOULD PREJUDICE THE MAINTENANCE OF THE COMMUNITY PATENT AS AMENDED.

2 . IN THE EXAMINATION OF THE REQUEST , WHICH SHALL BE CONDUCTED IN ACCORDANCE WITH THE IMPLEMENTING REGULATIONS , THE REVOCATION DIVISION SHALL INVITE THE PROPRIETOR OF THE PATENT , AS OFTEN AS NECESSARY , TO FILE OBSERVATIONS , WITHIN A PERIOD TO BE FIXED BY THE REVOCATION DIVISION , ON COMMUNICATIONS ISSUED BY ITSELF.

3 . IF THE PROPRIETOR OF THE PATENT FAILS TO REPLY IN DUE TIME TO ANY INVITATION UNDER PARAGRAPH 2 , THE REQUEST SHALL BE DEEMED TO BE WITHDRAWN .

ARTICLE 54

REJECTION OF THE REQUEST OR LIMITATION OF THE COMMUNITY PATENT

1 . IF , FOLLOWING THE EXAMINATION PROVIDED FOR IN ARTICLE 53 , THE REVOCATION DIVISION IS OF THE OPINION THAT THE AMENDMENTS ARE NOT ACCEPTABLE , IT SHALL REJECT THE REQUEST.

2 . IF THE REVOCATION DIVISION IS OF THE OPINION THAT , TAKING INTO CONSIDERATION THE AMENDMENTS MADE BY THE PROPRIETOR OF THE PATENT DURING THE LIMITATION PROCEEDINGS , THE GROUNDS FOR REVOCATION MENTIONED IN ARTICLE 57 DO NOT PREJUDICE THE MAINTENANCE OF THE COMMUNITY PATENT , IT SHALL DECIDE TO LIMIT THE PATENT ACCORDINGLY , PROVIDED THAT :

- (A) IT IS ESTABLISHED , IN ACCORDANCE WITH THE IMPLEMENTING REGULATIONS , THAT THE PROPRIETOR OF THE PATENT APPROVES THE TEXT IN WHICH THE REVOCATION DIVISION INTENDS TO LIMIT THE PATENT ;
- (B) A TRANSLATION OF ANY AMENDED CLAIMS IN ONE OF THE OFFICIAL LANGUAGES OF EACH OF THE CONTRACTING STATES WHICH DO NOT HAVE AS AN OFFICIAL LANGUAGE THE LANGUAGE OF THE PROCEEDINGS IS FILED WITHIN THE TIME LIMIT PRESCRIBED IN THE IMPLEMENTING REGULATIONS ;
- (C) THE FEE FOR THE PRINTING OF A NEW SPECIFICATION IS PAID WITHIN THE TIME LIMIT PRESCRIBED IN THE IMPLEMENTING REGULATIONS.

3 . IF A TRANSLATION IS NOT FILED IN DUE TIME OR IF THE FEE FOR THE PRINTING OF A NEW SPECIFICATION IS NOT PAID IN DUE TIME , THE REQUEST SHALL BE DEEMED TO BE WITHDRAWN , UNLESS THESE ACTS ARE DONE AND THE ADDITIONAL FEE IS PAID WITHIN A FURTHER PERIOD AS PRESCRIBED IN THE IMPLEMENTING REGULATIONS.

4 . THE DECISION TO LIMIT A COMMUNITY PATENT SHALL NOT TAKE EFFECT UNTIL THE DATE ON WHICH THE COMMUNITY PATENT BULLETIN MENTIONS THE LIMITATION .

ARTICLE 55

PUBLICATION OF A NEW SPECIFICATION FOLLOWING LIMITATION PROCEEDINGS

IF A COMMUNITY PATENT IS LIMITED UNDER ARTICLE 54 (2) , THE EUROPEAN PATENT OFFICE SHALL , AT THE SAME TIME AS IT PUBLISHES THE MENTION OF THE DECISION TO LIMIT , PUBLISH A NEW SPECIFICATION OF THE COMMUNITY PATENT CONTAINING THE DESCRIPTION , THE CLAIMS AND ANY DRAWINGS , IN THE AMENDED FORM.

CHAPTER III

REVOCATION PROCEDURE

ARTICLE 56

APPLICATION FOR REVOCATION

1 . ANY PERSON MAY FILE WITH THE EUROPEAN PATENT OFFICE AN APPLICATION FOR REVOCATION OF A COMMUNITY PATENT ; HOWEVER , IN THE CASE SPECIFIED IN ARTICLE 57 (1) (E) , THE APPLICATION MAY BE FILED ONLY BY A PERSON ENTITLED TO BE ENTERED IN THE REGISTER OF COMMUNITY PATENTS AS THE SOLE PROPRIETOR OF THE PATENT OR BY ALL THE PERSONS ENTITLED TO BE ENTERED AS JOINT PROPRIETORS OF IT IN ACCORDANCE WITH ARTICLE 27 ACTING JOINTLY.

2 . THE APPLICATION MAY NOT BE FILED IN THE CASES SPECIFIED IN ARTICLE 57 (1) (A) TO (D) DURING THE PERIOD WITHIN WHICH AN OPPOSITION MAY BE FILED OR WHILE OPPOSITION PROCEEDINGS ARE PENDING.

3 . AN APPLICATION MAY BE FILED EVEN IF THE COMMUNITY PATENT HAS LAPSED .

4 . THE APPLICATION SHALL BE FILED IN A WRITTEN REASONED STATEMENT. IT SHALL NOT BE DEEMED TO HAVE BEEN FILED UNTIL THE REVOCATION FEE HAS BEEN PAID .

5 . APPLICANTS SHALL BE PARTIES TO THE REVOCATION PROCEEDINGS AS WELL AS THE PROPRIETOR OF THE PATENT.

6 . IF THE APPLICANT HAS NEITHER HIS RESIDENCE NOR HIS PRINCIPAL PLACE OF BUSINESS WITHIN THE TERRITORY OF ONE OF THE CONTRACTING STATES , HE SHALL , AT THE REQUEST OF THE PROPRIETOR OF THE PATENT , FURNISH SECURITY FOR THE COSTS OF THE PROCEEDINGS. THE REVOCATION DIVISION SHALL FIX AT A REASONABLE FIGURE THE AMOUNT OF THE SECURITY AND THE PERIOD WITHIN WHICH IT MUST BE DEPOSITED. IF THE SECURITY IS NOT DEPOSITED WITHIN THE PERIOD SPECIFIED , THE APPLICATION SHALL BE DEEMED TO BE WITHDRAWN.

ARTICLE 57

GROUNDS FOR REVOCATION

1 . AN APPLICATION FOR REVOCATION OF A COMMUNITY PATENT MAY BE FILED ONLY ON THE GROUNDS THAT :

- (A) THE SUBJECT-MATTER OF THE PATENT IS NOT PATENTABLE WITHIN THE TERMS OF ARTICLES 52 TO 57 OF THE EUROPEAN PATENT CONVENTION ;
- (B) THE PATENT DOES NOT DISCLOSE THE INVENTION IN A MANNER SUFFICIENTLY CLEAR AND COMPLETE FOR IT TO BE CARRIED OUT BY A PERSON SKILLED IN THE ART ;
- (C) THE SUBJECT-MATTER OF THE PATENT EXTENDS BEYOND THE CONTENT OF THE EUROPEAN PATENT APPLICATION AS FILED , OR IF THE PATENT WAS GRANTED ON A EUROPEAN DIVISIONAL APPLICATION OR ON A NEW EUROPEAN APPLICATION FILED IN ACCORDANCE WITH ARTICLE 61 OF THE EUROPEAN PATENT CONVENTION , BEYOND THE CONTENT OF THE EARLIER APPLICATION AS FILED ;
- (D) THE PROTECTION CONFERRED BY THE PATENT HAS BEEN EXTENDED ;
- (E) THE PROPRIETOR OF THE PATENT IS NOT , HAVING REGARD TO A DECISION WHICH HAS TO BE RECOGNIZED IN ALL THE CONTRACTING STATES , ENTITLED UNDER ARTICLE 60 (1) OF THE EUROPEAN PATENT CONVENTION ;
- (F) THE SUBJECT-MATTER OF THE PATENT IS NOT PATENTABLE WITHIN THE TERMS OF ARTICLE 37 (1) .

2 . IF THE GROUNDS FOR REVOCATION AFFECT THE PATENT ONLY PARTIALLY , REVOCATION SHALL BE PRONOUNCED IN THE FORM OF A CORRESPONDING LIMITATION OF THE PATENT. THE LIMITATION MAY BE EFFECTED IN THE FORM OF AN AMENDMENT TO THE CLAIMS , THE DESCRIPTION OR THE DRAWINGS.

3 . IN THE CASE SPECIFIED IN PARAGRAPH 1 (F) , REVOCATION SHALL BE PRONOUNCED ONLY IN RESPECT OF THE CONTRACTING STATE IN WHICH THE NATIONAL PATENT APPLICATION OR NATIONAL PATENT HAS BEEN MADE PUBLIC.

ARTICLE 58

EXAMINATION OF THE APPLICATION

1 . IF THE APPLICATION FOR REVOCATION OF THE COMMUNITY PATENT IS ADMISSIBLE , THE REVOCATION DIVISION SHALL EXAMINE WHETHER THE GROUNDS FOR REVOCATION MENTIONED IN ARTICLE 57 PREJUDICE THE MAINTENANCE OF THE PATENT .

2 . IN THE EXAMINATION OF THE APPLICATION , WHICH SHALL BE CONDUCTED IN ACCORDANCE WITH THE IMPLEMENTING REGULATIONS , THE REVOCATION DIVISION SHALL INVITE THE PARTIES , AS OFTEN AS NECESSARY , TO FILE OBSERVATIONS , WITHIN A PERIOD TO BE FIXED BY THE REVOCATION DIVISION , ON COMMUNICATIONS FROM ANOTHER PARTY OR ISSUED BY ITSELF.

ARTICLE 59

REVOCATION OR MAINTENANCE OF THE COMMUNITY PATENT

1 . IF THE REVOCATION DIVISION IS OF THE OPINION THAT THE GROUNDS FOR REVOCATION MENTIONED IN ARTICLE 57 PREJUDICE THE MAINTENANCE OF THE COMMUNITY PATENT , IT SHALL REVOKE THE PATENT.

2 . IF THE REVOCATION DIVISION IS OF THE OPINION THAT THE GROUNDS FOR REVOCATION MENTIONED IN ARTICLE 57 DO NOT PREJUDICE THE MAINTENANCE OF THE PATENT UNAMENDED , IT SHALL REJECT THE APPLICATION

3 . IF THE REVOCATION DIVISION IS OF THE OPINION THAT , TAKING INTO CONSIDERATION THE AMENDMENTS MADE BY THE PROPRIETOR OF THE PATENT DURING THE REVOCATION PROCEEDINGS , THE GROUNDS FOR REVOCATION MENTIONED IN ARTICLE 57 DO NOT PREJUDICE THE MAINTENANCE OF THE PATENT , IT SHALL DECIDE TO MAINTAIN THE PATENT AS AMENDED , PROVIDED THAT :

- (A) IT IS ESTABLISHED , IN ACCORDANCE WITH THE IMPLEMENTING REGULATIONS , THAT THE PROPRIETOR OF THE PATENT APPROVES THE TEXT IN WHICH THE REVOCATION DIVISION INTENDS TO MAINTAIN THE PATENT ;
- (B) A TRANSLATION OF ANY AMENDED CLAIMS IN ONE OF THE OFFICIAL LANGUAGES OF EACH OF THE CONTRACTING STATES WHICH DO NOT HAVE AS AN OFFICIAL LANGUAGE THE LANGUAGE OF THE PROCEEDINGS IS FILED WITHIN THE TIME LIMIT PRESCRIBED IN THE IMPLEMENTING REGULATIONS ;
- (C) THE FEE FOR THE PRINTING OF A NEW SPECIFICATION IS PAID WITHIN THE TIME LIMIT PRESCRIBED IN THE IMPLEMENTING REGULATIONS.

4 . IF A TRANSLATION IS NOT FILED IN DUE TIME OR IF THE FEE FOR THE PRINTING OF A NEW SPECIFICATION IS NOT PAID IN DUE TIME , THE PATENT SHALL BE REVOKED , UNLESS THESE ACTS ARE DONE AND THE ADDITIONAL FEE IS PAID WITHIN A FURTHER PERIOD AS PRESCRIBED IN THE IMPLEMENTING REGULATIONS .

ARTICLE 60

PUBLICATION OF A NEW SPECIFICATION FOLLOWING REVOCATION PROCEEDINGS

IF A COMMUNITY PATENT IS AMENDED UNDER ARTICLE 59 (3) , THE EUROPEAN PATENT OFFICE SHALL , AT THE SAME TIME AS IT PUBLISHES THE MENTION OF THE DECISION ON THE APPLICATION FOR REVOCATION , PUBLISH A NEW SPECIFICATION OF THE COMMUNITY PATENT CONTAINING THE DESCRIPTION , THE CLAIMS AND ANY DRAWINGS , IN THE AMENDED FORM.

ARTICLE 61

COSTS

1 . EACH PARTY TO REVOCATION PROCEEDINGS SHALL MEET THE COSTS HE HAS INCURRED UNLESS A DECISION OF A REVOCATION DIVISION OR REVOCATION BOARD , FOR REASONS OF EQUITY , ORDERS , IN ACCORDANCE WITH THE IMPLEMENTING REGULATIONS , A DIFFERENT APPORTIONMENT OF COSTS INCURRED DURING TAKING OF EVIDENCE OR IN ORAL PROCEEDINGS. A DECISION ON THE APPORTIONMENT OF THE COSTS MAY ALSO BE TAKEN ON REQUEST WHEN THE APPLICATION FOR REVOCATION IS WITHDRAWN

OR WHEN THE COMMUNITY PATENT LAPSES .

2 . ON REQUEST , THE REGISTRY OF THE REVOCATION DIVISION SHALL FIX THE AMOUNT OF THE COSTS TO BE PAID UNDER A DECISION APPORTIONING THEM . THE FIXING OF THE COSTS BY THE REGISTRY MAY BE REVIEWED BY A DECISION OF THE REVOCATION DIVISION ON A REQUEST FILED WITHIN THE PERIOD LAID DOWN IN THE IMPLEMENTING REGULATIONS.

3 . ARTICLE 104 (3) OF THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS.

PART IV

APPEALS PROCEDURE

ARTICLE 62

APPEAL

1 . AN APPEAL SHALL LIE FROM DECISIONS OF THE REVOCATION DIVISIONS AND THE PATENT ADMINISTRATION DIVISION.

2 . ARTICLES 106 TO 111 OF THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS TO THIS APPEALS PROCEDURE.

ARTICLE 63

FURTHER APPEAL

1 . A FURTHER APPEAL TO THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES SHALL LIE FROM DECISIONS OF THE REVOCATION BOARDS ON APPEALS . SUCH FURTHER APPEAL SHALL HAVE SUSPENSIVE EFFECT.

2 . THE FURTHER APPEAL MAY BE LODGED ON GROUNDS OF INFRINGEMENT OF AN ESSENTIAL PROCEDURAL REQUIREMENT AND OF INFRINGEMENT OF THIS CONVENTION OR ANY RULE OF LAW RELATING TO ITS APPLICATION , IN SO FAR AS THAT RULE OF LAW IS NOT A NATIONAL PROVISION. THE COURT OF JUSTICE SHALL NOT EXAMINE THE FACTS AS DETERMINED IN THE DECISION OF THE REVOCATION BOARD.

3 . THE FURTHER APPEAL SHALL BE OPEN TO ANY PARTY TO PROCEEDINGS BEFORE A REVOCATION BOARD ADVERSELY AFFECTED BY ITS DECISION.

4 . THE FURTHER APPEAL SHALL BE LODGED WITH THE COURT OF JUSTICE WITHIN TWO MONTHS OF THE DATE OF NOTIFICATION OF THE DECISION OF THE REVOCATION BOARD.

5 . THE FURTHER APPEAL MAY BE MADE EVEN IF THE COMMUNITY PATENT HAS LAPSED .

6 . IF THE COURT OF JUSTICE REMITS THE CASE FOR FURTHER PROSECUTION TO

THE REVOCATION BOARD , THAT DEPARTMENT SHALL BE BOUND BY THE RATIO DECIDENDI OF THE COURT OF JUSTICE , IN SO FAR AS THE FACTS ARE THE SAME .

PART V

COMMON PROVISIONS

ARTICLE 64

COMMON PROVISIONS GOVERNING PROCEDURE AND REPRESENTATION

1 . THE PROVISIONS OF PART VII , CHAPTERS I AND III , OF THE EUROPEAN PATENT CONVENTION , OTHER THAN ARTICLES 121 AND 124 , SHALL APPLY MUTATIS MUTANDIS TO THIS CONVENTION , SUBJECT TO THE FOLLOWING :

- (A) ARTICLE 114 (1) SHALL APPLY ONLY TO THE REVOCATION DIVISIONS AND THE REVOCATION BOARDS ;
- (B) ARTICLE 116 (2) AND (3) SHALL APPLY ONLY TO THE PATENT ADMINISTRATION DIVISION , AND PARAGRAPH 4 SHALL APPLY ONLY TO THE REVOCATION DIVISIONS AND THE REVOCATION BOARDS ;
- (C) ARTICLE 122 SHALL ALSO APPLY TO ALL OTHER PARTIES TO PROCEEDINGS BEFORE THE SPECIAL DEPARTMENTS ;
- (D) ARTICLE 123 (3) SHALL APPLY TO LIMITATION AND REVOCATION PROCEEDINGS ;
- (E) THE TERM " CONTRACTING STATES " SHALL BE UNDERSTOOD AS MEANING THE STATES PARTIES TO THIS CONVENTION.

2 . NOTWITHSTANDING PARAGRAPH 1 (E) , A PERSON WHOSE NAME APPEARS ON THE LIST OF PROFESSIONAL REPRESENTATIVES MAINTAINED BY THE EUROPEAN PATENT OFFICE WHO IS NOT A NATIONAL OF ONE OF THE STATES PARTIES TO THIS CONVENTION OR DOES NOT HAVE HIS PLACE OF BUSINESS OR EMPLOYMENT WITHIN THE TERRITORY OF ONE OF THESE STATES , SHALL BE ENTITLED TO ACT AS A PROFESSIONAL REPRESENTATIVE FOR A PARTY TO PROCEEDINGS RELATING TO A COMMUNITY PATENT BEFORE THE SPECIAL DEPARTMENTS , PROVIDED THAT :

- (A) HE WAS , ACCORDING TO THE REGISTER OF EUROPEAN PATENTS , THE PERSON LAST AUTHORIZED TO ACT AS THE PROFESSIONAL REPRESENTATIVE FOR THE SAME PARTY OR HIS PREDECESSOR IN TITLE IN PROCEEDINGS PURSUANT TO THE EUROPEAN PATENT CONVENTION WHICH RELATE TO THIS COMMUNITY PATENT OR TO THE EUROPEAN PATENT APPLICATION ON WHICH IT IS BASED ; AND
- (B) THE STATE OF WHICH HE IS A NATIONAL OR WITHIN THE TERRITORY OF WHICH HE HAS HIS PLACE OF BUSINESS OR EMPLOYMENT APPLIES RULES , AS REGARDS REPRESENTATION BEFORE THE CENTRAL INDUSTRIAL PROPERTY OFFICE OF THE STATE CONCERNED , WHICH COMPLY , IN RESPECT OF RECIPROCITY , WITH SUCH CONDITIONS AS THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL MAY PRESCRIBE.

ARTICLE 65

REGISTER OF COMMUNITY PATENTS

THE EUROPEAN PATENT OFFICE SHALL KEEP A REGISTER , TO BE KNOWN AS THE REGISTER OF COMMUNITY PATENTS , WHICH SHALL CONTAIN THOSE PARTICULARS THE REGISTRATION OF WHICH IS PROVIDED FOR BY THIS CONVENTION . THE REGISTER SHALL BE OPEN TO PUBLIC INSPECTION.

ARTICLE 66

COMMUNITY PATENT BULLETIN

THE EUROPEAN PATENT OFFICE SHALL PERIODICALLY PUBLISH A COMMUNITY PATENT BULLETIN CONTAINING ENTRIES MADE IN THE REGISTER OF COMMUNITY PATENTS , AS WELL AS OTHER PARTICULARS , THE PUBLICATION OF WHICH IS PRESCRIBED BY THIS CONVENTION.

ARTICLE 67

INFORMATION TO THE PUBLIC OR OFFICIAL AUTHORITIES

ARTICLES 128 (4) AND 130 TO 132 OF THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS , THE TERM " CONTRACTING STATES " BEING UNDERSTOOD AS MEANING THE STATES PARTIES TO THIS CONVENTION.

PART VI

JURISDICTION AND PROCEDURE IN ACTIONS RELATING TO COMMUNITY PATENTS

CHAPTER I

JURISDICTION AND ENFORCEMENT

ARTICLE 68

GENERAL PROVISIONS

UNLESS OTHERWISE SPECIFIED IN THIS CONVENTION , THE CONVENTION ON JURISDICTION AND ENFORCEMENT OF JUDGMENTS IN CIVIL AND COMMERCIAL MATTERS , SIGNED AT BRUSSELS ON 27 SEPTEMBER 1968 , HEREINAFTER REFERRED TO AS " THE CONVENTION ON JURISDICTION AND ENFORCEMENT " , SHALL APPLY TO ACTIONS RELATING TO COMMUNITY PATENTS AND TO DECISIONS GIVEN IN RESPECT OF SUCH ACTIONS.

ARTICLE 69

JURISDICTION OF NATIONAL COURTS CONCERNING ACTIONS RELATING TO COMMUNITY PATENTS

1 . ACTIONS FOR INFRINGEMENT OF A COMMUNITY PATENT MAY BE HEARD BEFORE THE COURTS OF THE CONTRACTING STATE IN WHICH THE DEFENDANT HAS HIS RESIDENCE OR , IF HE IS NOT SO RESIDENT , AN ESTABLISHMENT. IF THE DEFENDANT HAS NEITHER HIS RESIDENCE NOR AN ESTABLISHMENT IN ONE OF THE CONTRACTING STATES , SUCH ACTIONS MAY , BY WAY OF DEROGATION FROM ARTICLE 4 OF THE CONVENTION ON JURISDICTION AND ENFORCEMENT , BE HEARD BEFORE THE COURTS OF THE CONTRACTING STATE IN WHICH THE PLAINTIFF HAS HIS RESIDENCE OR , IF HE IS NOT SO RESIDENT , AN ESTABLISHMENT. IF NEITHER THE DEFENDANT NOR THE PLAINTIFF IS SO RESIDENT OR HAS SUCH AN ESTABLISHMENT , SUCH ACTIONS MAY BE BROUGHT BEFORE THE COURTS OF THE FEDERAL REPUBLIC OF GERMANY. THE COURT HEARING THE ACTION SHALL HAVE JURISDICTION IN RESPECT OF ACTS OF INFRINGEMENT COMMITTED WITHIN THE TERRITORY OF ANY OF THE CONTRACTING STATES.

2 . ACTIONS FOR INFRINGEMENT OF A COMMUNITY PATENT MAY ALSO BE HEARD BEFORE THE COURTS OF THE CONTRACTING STATE IN WHICH AN ACT OF INFRINGEMENT WAS COMMITTED. THE COURT HEARING THE ACTION SHALL HAVE JURISDICTION ONLY IN RESPECT OF ACTS OF INFRINGEMENT COMMITTED WITHIN THE TERRITORY OF THAT STATE.

3 . ARTICLE 5 (3) AND (4) OF THE CONVENTION ON JURISDICTION AND ENFORCEMENT SHALL NOT APPLY TO ACTIONS FOR INFRINGEMENT OF A COMMUNITY PATENT .

4 . THE FOLLOWING COURTS SHALL HAVE EXCLUSIVE JURISDICTION , REGARDLESS OF RESIDENCE :

(A) IN ACTIONS RELATING TO COMPULSORY LICENCES IN RESPECT OF A COMMUNITY PATENT , THE COURTS OF THE CONTRACTING STATE THE NATIONAL LAW OF WHICH IS APPLICABLE TO THE LICENCE ;

(B) IN ACTIONS RELATING TO THE RIGHT TO A PATENT IN WHICH AN EMPLOYER AND AN EMPLOYEE ARE IN DISPUTE , THE COURTS OF THE CONTRACTING STATE UNDER WHOSE LAW THE RIGHT TO A EUROPEAN PATENT IS DETERMINED IN ACCORDANCE WITH THE SECOND SENTENCE OF ARTICLE 60 (1) OF THE EUROPEAN PATENT CONVENTION. ANY AGREEMENT CONFERRING JURISDICTION SHALL BE VALID ONLY IN SO FAR AS THE NATIONAL LAW GOVERNING THE CONTRACT OF EMPLOYMENT ALLOWS THE AGREEMENT IN QUESTION

5 . FOR THE PURPOSES OF THIS ARTICLE , THE RESIDENCE OF A PARTY SHALL BE DETERMINED BY APPLYING ARTICLES 52 AND 53 OF THE CONVENTION ON JURISDICTION AND ENFORCEMENT.

ARTICLE 70

SUPPLEMENTARY PROVISIONS ON JURISDICTION

1 . WITHIN THE CONTRACTING STATE WHOSE COURTS HAVE JURISDICTION UNDER ARTICLES 68 AND 69 , THOSE COURTS SHALL HAVE JURISDICTION WHICH WOULD HAVE JURISDICTION RATIONE LOCI AND RATIONE MATERIAE IN THE CASE OF ACTIONS RELATING TO A NATIONAL PATENT GRANTED IN THAT STATE.

2 . ARTICLES 68 AND 69 SHALL APPLY TO ACTIONS RELATING TO A EUROPEAN PATENT APPLICATION IN WHICH THE CONTRACTING STATES ARE DESIGNATED , EXCEPT IN SO FAR AS THE RIGHT TO THE GRANT OF A EUROPEAN PATENT IS CLAIMED .

3 . ACTIONS RELATING TO A COMMUNITY PATENT FOR WHICH NO COURT HAS JURISDICTION UNDER ARTICLES 68 AND 69 (1) AND (2) MAY BE HEARD BEFORE THE COURTS OF THE FEDERAL REPUBLIC OF GERMANY.

ARTICLE 71

SUPPLEMENTARY PROVISIONS ON RECOGNITION AND ENFORCEMENT

1 . ARTICLE 27 (3) AND (4) OF THE CONVENTION ON JURISDICTION AND ENFORCEMENT SHALL NOT APPLY TO DECISIONS RELATING TO THE RIGHT TO THE COMMUNITY PATENT.

2 . IN THE CASE OF IRRECONCILABLE DECISIONS RELATING TO THE RIGHT TO A COMMUNITY PATENT GIVEN IN PROCEEDINGS BETWEEN THE SAME PARTIES , ONLY THE DECISION OF THE COURT FIRST SEISED OF THE MATTER SHALL BE RECOGNIZED . NEITHER PARTY MAY INVOKE ANY OTHER DECISION EVEN IN THE CONTRACTING STATE IN WHICH IT WAS GIVEN.

ARTICLE 72

NATIONAL AUTHORITIES

FOR ACTIONS RELATING TO THE RIGHT TO A COMMUNITY PATENT OR TO COMPULSORY LICENCES IN RESPECT OF A COMMUNITY PATENT THE TERM " COURTS " IN THIS CONVENTION AND THE CONVENTION ON JURISDICTION AND ENFORCEMENT SHALL INCLUDE AUTHORITIES WHICH , UNDER THE NATIONAL LAW OF A CONTRACTING STATE , HAVE JURISDICTION TO DECIDE SUCH ACTIONS RELATING TO A NATIONAL PATENT GRANTED IN THAT STATE. ANY CONTRACTING STATE SHALL NOTIFY THE EUROPEAN PATENT OFFICE OF ANY AUTHORITY ON WHICH SUCH JURISDICTION IS CONFERRED AND THE EUROPEAN PATENT OFFICE SHALL INFORM THE OTHER CONTRACTING STATES ACCORDINGLY.

ARTICLE 73

PRELIMINARY RULING BY THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES

1 . IN PROCEEDINGS RELATING TO A COMMUNITY PATENT WHICH ARE BROUGHT BEFORE A NATIONAL COURT OR TRIBUNAL , THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES SHALL HAVE JURISDICTION TO GIVE PRELIMINARY RULINGS CONCERNING :

(A) THE INTERPRETATION OF THIS CONVENTION AND OF THE PROVISIONS OF THE EUROPEAN PATENT CONVENTION WHICH ARE BINDING UPON EVERY COMMUNITY PATENT

IN ACCORDANCE WITH ARTICLE 2 (3) ;

(B) THE VALIDITY AND INTERPRETATION OF PROVISIONS ENACTED IN IMPLEMENTATION OF THIS CONVENTION , TO THE EXTENT TO WHICH THEY ARE NOT NATIONAL PROVISIONS.

2 . WHERE SUCH A QUESTION IS RAISED BEFORE A NATIONAL COURT OR TRIBUNAL , THAT COURT OR TRIBUNAL MAY , IF IT CONSIDERS THAT A DECISION ON THE QUESTION IS NECESSARY TO ENABLE IT TO GIVE JUDGMENT , REQUEST THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES TO GIVE A RULING THEREON.

3 . WHERE ANY SUCH QUESTION IS RAISED IN A CASE PENDING BEFORE A NATIONAL COURT OR TRIBUNAL , AGAINST WHOSE DECISIONS THERE IS NO JUDICIAL REMEDY UNDER NATIONAL LAW , THAT COURT OR TRIBUNAL SHALL BRING THE MATTER BEFORE THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES .

CHAPTER II

PROCEDURE

ARTICLE 74

RULES OF PROCEDURE

UNLESS OTHERWISE SPECIFIED IN THIS CONVENTION , THE ACTIONS REFERRED TO IN ARTICLES 68 TO 70 SHALL BE SUBJECT TO THE NATIONAL RULES OF PROCEDURE GOVERNING THE SAME TYPE OF ACTION RELATING TO A NATIONAL PATENT .

ARTICLE 75

BURDEN OF PROOF

1 . IF THE SUBJECT-MATTER OF A COMMUNITY PATENT IS A PROCESS FOR OBTAINING A NEW PRODUCT , THE SAME PRODUCT WHEN PRODUCED BY ANY OTHER PARTY SHALL , IN THE ABSENCE OF PROOF TO THE CONTRARY , BE DEEMED TO HAVE BEEN OBTAINED BY THE PATENTED PROCESS.

2 . IN THE ADDUCTION OF PROOF TO THE CONTRARY , THE LEGITIMATE INTERESTS OF THE DEFENDANT IN PROTECTING HIS MANUFACTURING AND BUSINESS SECRETS SHALL BE TAKEN INTO ACCOUNT.

ARTICLE 76

OBLIGATION OF THE NATIONAL COURT

A NATIONAL COURT WHICH IS DEALING WITH AN ACTION RELATING TO A COMMUNITY PATENT SHALL TREAT THE PATENT AS VALID.

ARTICLE 77

STAY OF PROCEEDINGS

1 . IF THE DECISION IN AN ACTION BEFORE A NATIONAL COURT RELATING TO A EUROPEAN PATENT APPLICATION IN WHICH THE CONTRACTING STATES ARE DESIGNATED DEPENDS UPON THE PATENTABILITY OF THE INVENTION , THAT DECISION MAY BE GIVEN ONLY AFTER THE EUROPEAN PATENT OFFICE HAS GRANTED A EUROPEAN PATENT OR REFUSED THE EUROPEAN PATENT APPLICATION. PARAGRAPH 2 SHALL APPLY AFTER THE GRANT OF THE EUROPEAN PATENT.

2 . WHERE AN OPPOSITION HAS BEEN FILED , OR A REQUEST FOR THE LIMITATION OR AN APPLICATION FOR THE REVOCATION OF A COMMUNITY PATENT AS BEEN MADE , THE NATIONAL COURT MAY , AT THE REQUEST OF ONE OF THE PARTIES AND AFTER HEARING THE OTHER PARTIES , STAY PROCEEDINGS RELATING TO THE COMMUNITY PATENT , IN SO FAR AS ITS DECISION DEPENDS UPON VALIDITY. AT THE REQUEST OF ONE OF THE PARTIES THE COURT SHALL INSTRUCT THAT THE DOCUMENTARY EVIDENCE OF THE OPPOSITION , LIMITATION OR REVOCATION PROCEEDINGS BE COMMUNICATED TO IT , IN ORDER TO GIVE A RULING ON THE REQUEST FOR A STAY OF PROCEEDINGS.

ARTICLE 78

OPINION ON THE EXTENT OF PROTECTION

1 . WHEN INFRINGEMENT PROCEEDINGS ARE STAYED IN ACCORDANCE WITH ARTICLE 77 (2) BY A NATIONAL COURT WHICH HAS JURISDICTION TO DETERMINE THE EXTENT OF PROTECTION CONFERRED BY THE COMMUNITY PATENT IN RELATION TO THE ALLEGED INFRINGEMENT , THE EUROPEAN PATENT OFFICE SHALL , IF IT HAS DECIDED TO MAINTAIN THE PATENT , EXPRESS AN OPINION ON THE EXTENT OF PROTECTION CONFERRED BY THE PATENT.

2 . IN CASES WHERE ARTICLE 77 (2) DOES NOT APPLY , A NATIONAL COURT BEFORE WHICH PROCEEDINGS FOR INFRINGEMENT OF A COMMUNITY PATENT ARE BROUGHT MAY , OF ITS OWN MOTION OR AT THE REQUEST OF ONE OF THE PARTIES AND AFTER HEARING THE OTHER PARTIES , OBTAIN AN OPINION FROM THE EUROPEAN PATENT OFFICE ON THE EXTENT OF PROTECTION CONFERRED BY THE PATENT BEFORE GIVING A DECISION CONCERNING THE INFRINGEMENT.

3 . THE OPINION SHALL BE GIVEN BY A REVOCATION BOARD AGAINST PAYMENT OF AN APPROPRIATE FEE AND SHALL TAKE INTO ACCOUNT THE PRODUCT OR PROCESS WHICH , IN ACCORDANCE WITH THE FINDINGS OF THE NATIONAL COURT , IS ALLEGED TO INFRINGE. THIS OPINION SHALL NOT BIND THE NATIONAL COURT . ARTICLE 116 (1) OF THE EUROPEAN PATENT CONVENTION SHALL APPLY

4 . FOR THE PURPOSES OF OBTAINING THE OPINION THE NATIONAL COURT SHALL TRANSMIT TO THE EUROPEAN PATENT OFFICE , IN ONE OF THE THREE OFFICIAL LANGUAGES OF THE EUROPEAN PATENT OFFICE , THE FINDINGS AND QUESTIONS OF THE COURT AS WELL AS ANY OTHER DOCUMENTS CONSIDERED USEFUL BY IT.

ARTICLE 79

PENAL SANCTIONS FOR INFRINGEMENT



THE NATIONAL PENAL PROVISIONS IN THE MATTER OF INFRINGEMENT SHALL BE APPLICABLE IN THE CASE OF INFRINGEMENT OF A COMMUNITY PATENT , TO THE EXTENT THAT LIKE ACTS OF INFRINGEMENT WOULD BE PUNISHABLE IF THEY SIMILARLY AFFECTED A NATIONAL PATENT.

PART VII

IMPACT ON NATIONAL LAW

ARTICLE 80

PROHIBITION OF SIMULTANEOUS PROTECTION

1 . WHERE A NATIONAL PATENT GRANTED IN A CONTRACTING STATE RELATES TO AN INVENTION FOR WHICH A COMMUNITY PATENT HAS BEEN GRANTED TO THE SAME INVENTOR OR TO HIS SUCCESSOR IN TITLE WITH THE SAME DATE OF FILING , OR , IF PRIORITY HAS BEEN CLAIMED , WITH THE SAME DATE OF PRIORITY , THAT NATIONAL PATENT SHALL BE INEFFECTIVE TO THE EXTENT THAT IT COVERS THE SAME INVENTION AS THE COMMUNITY PATENT , FROM THE DATE ON WHICH :

- (A) THE PERIOD FOR FILING AN OPPOSITION TO THE COMMUNITY PATENT HAS EXPIRED WITHOUT ANY OPPOSITION BEING FILED ;
- (B) THE OPPOSITION PROCEEDINGS ARE CONCLUDED WITH A DECISION TO MAINTAIN THE COMMUNITY PATENT ; OR
- (C) THE NATIONAL PATENT IS GRANTED , WHERE THIS DATE IS SUBSEQUENT TO THE DATE REFERRED TO IN SUBPARAGRAPH (A) OR (B) , AS THE CASE MAY BE .

2 . THE SUBSEQUENT LAPSE OR REVOCATION OF THE COMMUNITY PATENT SHALL NOT AFFECT THE PROVISIONS OF PARAGRAPH 1.

3 . EACH CONTRACTING STATE MAY PRESCRIBE THE PROCEDURE WHEREBY THE LOSS OF EFFECT OF THE NATIONAL PATENT IS DETERMINED AND , WHERE APPROPRIATE , THE EXTENT OF THAT LOSS. IT MAY ALSO PRESCRIBE THAT THE LOSS OF EFFECT SHALL APPLY AS FROM THE OUTSET.

4 . PRIOR TO THE DATE APPLICABLE UNDER PARAGRAPH 1 , SIMULTANEOUS PROTECTION BY A COMMUNITY PATENT OR A EUROPEAN PATENT APPLICATION AND A NATIONAL PATENT OR A NATIONAL PATENT APPLICATION SHALL EXIST UNLESS ANY CONTRACTING STATE PROVIDES OTHERWISE.

ARTICLE 81

EXHAUSTION OF THE RIGHTS CONFERRED BY A NATIONAL PATENT

1 . THE RIGHTS CONFERRED BY A NATIONAL PATENT IN A CONTRACTING STATE SHALL NOT EXTEND TO ACTS CONCERNING A PRODUCT COVERED BY THAT PATENT WHICH ARE DONE WITHIN THE TERRITORY OF THAT CONTRACTING STATE AFTER THAT PRODUCT HAS BEEN PUT ON THE MARKET IN ANY CONTRACTING STATE BY THE PROPRIETOR OF THE PATENT OR WITH HIS EXPRESS CONSENT , UNLESS THERE ARE GROUNDS WHICH , UNDER COMMUNITY LAW , WOULD JUSTIFY THE EXTENSION TO SUCH ACTS OF THE RIGHTS CONFERRED BY THE PATENT.

2 . PARAGRAPH 1 SHALL ALSO APPLY WITH REGARD TO A PRODUCT PUT ON THE MARKET BY THE PROPRIETOR OF A NATIONAL PATENT , GRANTED FOR THE SAME INVENTION IN ANOTHER CONTRACTING STATE , WHO HAS ECONOMIC CONNECTIONS WITH THE PROPRIETOR OF THE PATENT REFERRED TO IN PARAGRAPH 1. FOR THE PURPOSE OF THIS PARAGRAPH , TWO PERSONS SHALL BE DEEMED TO HAVE ECONOMIC CONNECTIONS WHERE ONE OF THEM IS IN A POSITION TO EXERT A DECISIVE INFLUENCE ON THE OTHER , DIRECTLY OR INDIRECTLY , WITH REGARD TO THE EXPLOITATION OF A PATENT , OR WHERE A THIRD PARTY IS IN A POSITION TO EXERCISE SUCH AN INFLUENCE ON BOTH PERSONS.

3 . THE PRECEDING PARAGRAPHS SHALL NOT APPLY IN THE CASE OF A PRODUCT PUT ON THE MARKET UNDER A COMPULSORY LICENCE.

ARTICLE 82

COMPULSORY LICENCES IN RESPECT OF NATIONAL PATENTS

ARTICLE 47 SHALL APPLY MUTATIS MUTANDIS TO THE GRANT OF COMPULSORY LICENCES FOR LACK OR INSUFFICIENCY OF EXPLOITATION OF A NATIONAL PATENT .

ARTICLE 83

EFFECT OF UNPUBLISHED NATIONAL APPLICATIONS OR PATENTS

1 . WHERE ARTICLE 37 (2) APPLIES , THE COMMUNITY PATENT SHALL BE INEFFECTIVE IN THE CONTRACTING STATE CONCERNED TO THE EXTENT THAT IT COVERS THE SAME INVENTION AS THE NATIONAL PATENT APPLICATION OR PATENT

2 . THE PROCEDURE CONFIRMING THAT , PURSUANT TO PARAGRAPH 1 , THE COMMUNITY PATENT IS INEFFECTIVE IN THE CONTRACTING STATE SHALL , IN THAT STATE , BE THAT ACCORDING TO WHICH , IF THE COMMUNITY PATENT HAD BEEN A NATIONAL PATENT , IT COULD HAVE BEEN REVOKED OR MADE INEFFECTIVE .

ARTICLE 84

NATIONAL UTILITY MODELS AND UTILITY CERTIFICATES

1 . ARTICLES 37 , 80 AND 81 SHALL APPLY TO UTILITY MODELS AND UTILITY CERTIFICATES AND TO APPLICATIONS FOR UTILITY MODELS AND UTILITY CERTIFICATES IN THE CONTRACTING STATES WHOSE LAWS MAKE PROVISION FOR SUCH MODELS OR CERTIFICATES.

2 . IF A CONTRACTING STATE PROVIDES IN ITS LAW THAT A PERSON MAY NOT EXERCISE THE RIGHTS CONFERRED BY A PATENT SO LONG AS THERE EXISTS A UTILITY MODEL HAVING AN EARLIER DATE OF FILING OR , WHERE PRIORITY HAS BEEN CLAIMED , AN EARLIER DATE OF PRIORITY , THE SAME SHALL , NOTWITHSTANDING PARAGRAPH 1 , APPLY ALSO TO THE COMMUNITY PATENT IN THAT STATE .

PART VIII

TRANSITIONAL PROVISIONS

ARTICLE 85

APPLICATION OF THE CONVENTION ON JURISDICTION AND ENFORCEMENT

THE PROVISIONS OF THE CONVENTION ON JURISDICTION AND ENFORCEMENT RENDERED APPLICABLE BY THE PRECEDING ARTICLES SHALL NOT HAVE EFFECT IN RESPECT OF ANY CONTRACTING STATE FOR WHICH THAT CONVENTION HAS NOT YET ENTERED INTO FORCE UNTIL SUCH ENTRY INTO FORCE.

ARTICLE 86

OPTION BETWEEN A COMMUNITY PATENT AND A EUROPEAN PATENT

1 . THIS CONVENTION SHALL , SUBJECT TO PARAGRAPH 3 , NOT APPLY TO A EUROPEAN PATENT APPLICATION FILED DURING A TRANSITIONAL PERIOD NOR TO ANY RESULTING EUROPEAN PATENT , PROVIDED THAT THE REQUEST FOR GRANT CONTAINS A STATEMENT THAT THE APPLICANT DOES NOT WISH TO OBTAIN A COMMUNITY PATENT. THIS STATEMENT MAY NOT BE WITHDRAWN.

2 . ARTICLE 54 (3) AND (4) OF THE EUROPEAN PATENT CONVENTION SHALL APPLY WHERE A EUROPEAN PATENT APPLICATION IN WHICH THE CONTRACTING STATES ARE DESIGNATED OR A COMMUNITY PATENT HAS A DATE OF FILING OR , WHERE PRIORITY HAS BEEN CLAIMED , A DATE OF PRIORITY LATER THAN THAT OF A EUROPEAN PATENT APPLICATION IN WHICH ONE OR SOME OF THE CONTRACTING STATES ARE DESIGNATED. IN THE EVENT OF LIMITATION OR REVOCATION OF THE COMMUNITY PATENT ON THIS GROUND , LIMITATION OR REVOCATION SHALL BE PRONOUNCED ONLY IN RESPECT OF THE CONTRACTING STATES DESIGNATED IN THE EARLIER EUROPEAN PATENT APPLICATION AS PUBLISHED .

3 . ARTICLES 80 TO 82 AND 84 SHALL APPLY TO A EUROPEAN PATENT AS REFERRED TO IN PARAGRAPH 1 , THE REFERENCES IN ARTICLES 80 AND 84 TO A COMMUNITY PATENT AND THE REFERENCES IN ARTICLES 81 AND 82 TO A NATIONAL PATENT BEING UNDERSTOOD AS REFERENCES TO SUCH A EUROPEAN PATENT .

4 . THE TRANSITIONAL PERIOD REFERRED TO IN PARAGRAPH 1 MAY BE TERMINATED BY DECISION OF THE COUNCIL OF THE EUROPEAN COMMUNITIES , ACTING ON A PROPOSAL FROM THE COMMISSION OF THE EUROPEAN COMMUNITIES OR FROM A CONTRACTING STATE.

5 . THE DECISION REFERRED TO IN PARAGRAPH 4 SHALL REQUIRE :

- (A) UNANIMITY DURING THE FIRST 10 YEARS FROM THE DATE OF ENTRY INTO FORCE OF THIS CONVENTION ;
- (B) A QUALIFIED MAJORITY AFTER EXPIRY OF THAT PERIOD. THIS MAJORITY SHALL BE THAT SPECIFIED IN THE SECOND INDENT OF THE SECOND SUBPARAGRAPH OF ARTICLE 148 (2) OF THE TREATY ESTABLISHING THE EUROPEAN ECONOMIC COMMUNITY.

ARTICLE 87

SUBSEQUENT CHOICE OF A COMMUNITY PATENT

THIS CONVENTION SHALL APPLY TO A EUROPEAN PATENT GRANTED IN RESPECT OF A EUROPEAN PATENT APPLICATION IN WHICH ALL THE CONTRACTING STATES ARE DESIGNATED AND WHICH IS FILED PRIOR TO THE ENTRY INTO FORCE OF THIS CONVENTION , PROVIDED THAT PRIOR TO THE EXPIRY OF THE TIME LIMIT MENTIONED IN ARTICLE 97 (2) (B) OF THE EUROPEAN PATENT CONVENTION , THE APPLICANT FILES WITH THE EUROPEAN PATENT OFFICE A WRITTEN STATEMENT THAT HE WISHES TO OBTAIN A COMMUNITY PATENT.

ARTICLE 88

RESERVATION CONCERNING THE TRANSLATION OF THE SPECIFICATION OF A COMMUNITY PATENT

1 . NOTWITHSTANDING ARTICLE 14 (9) , ANY CONTRACTING STATE MAY , AT THE TIME OF SIGNATURE OR WHEN DEPOSITING ITS INSTRUMENT OF RATIFICATION , DECLARE THAT IT RESERVES THE RIGHT TO PROVIDE THAT , IF THE SPECIFICATION OF A COMMUNITY PATENT HAS BEEN PUBLISHED IN A LANGUAGE WHICH IS NOT ONE OF THE OFFICIAL LANGUAGES OF THAT STATE , THE PROPRIETOR OF THE PATENT MAY , SUBJECT TO THE FOLLOWING PARAGRAPHS , AVAIL HIMSELF , IN THAT STATE , OF THE RIGHTS CONFERRED BY THAT PATENT , ONLY UNDER THE CONDITION THAT HE FILES WITH THE EUROPEAN PATENT OFFICE A TRANSLATION OF THE SPECIFICATION , EXCEPT FOR THE CLAIMS , IN ONE OF THE OFFICIAL LANGUAGES OF THAT STATE.

2 . IF THE TRANSLATION IS FILED WITHIN THREE MONTHS OF THE DATE OF PUBLICATION OF THE MENTION OF THE GRANT OF THE PATENT , THE PROPRIETOR OF THE PATENT MAY AVAIL HIMSELF FROM THAT DATE OF THE RIGHTS CONFERRED BY THE PATENT.

3 . IF THE TRANSLATION IS FILED AFTER THE PERIOD REFERRED TO IN PARAGRAPH 2 , THE PROPRIETOR OF THE PATENT MAY AVAIL HIMSELF OF THE RIGHTS CONFERRED BY THE PATENT FROM THE DATE OF FILING OF THE TRANSLATION . IN RESPECT OF USE OF THE INVENTION WITHOUT HIS CONSENT IN THE PERIOD BETWEEN THE DATE OF THE PUBLICATION OF THE MENTION OF THE GRANT OF THE PATENT AND THE DATE

OF FILING OF THE TRANSLATION , THE PROPRIETOR MAY AVAIL HIMSELF OF THE RIGHTS CONFERRED BY THE PATENT ONLY TO THE EXTENT THAT HE MAY , AFTER THE FILING OF THE TRANSLATION , CLAIM REASONABLE COMPENSATION.

4 . IF THE TRANSLATION IS FILED MORE THAN THREE YEARS AFTER THE EXPIRY OF THE PERIOD MENTIONED IN ARTICLE 99 (1) OF THE EUROPEAN PATENT CONVENTION , ANY PERSON WHO HAS USED OR MADE EFFECTIVE AND SERIOUS PREPARATIONS FOR USING THE INVENTION , WITHIN THE PERIOD MENTIONED IN THE SECOND SENTENCE OF PARAGRAPH 3 , MAY CONTINUE USE OF THE INVENTION UPON REASONABLE TERMS.

5 . ANY RESERVATION MADE BY A CONTRACTING STATE UNDER PARAGRAPH 1 SHALL CEASE TO APPLY WHEN THE COUNCIL OF THE EUROPEAN COMMUNITIES , ACTING UNANIMOUSLY ON A PROPOSAL FROM THE COMMISSION OF THE EUROPEAN COMMUNITIES OR FROM A CONTRACTING STATE , DECIDES TO TERMINATE IT.

6 . ANY CONTRACTING STATE THAT HAS MADE A RESERVATION UNDER PARAGRAPH 1 MAY WITHDRAW IT AT ANY TIME. SUCH WITHDRAWAL SHALL BE MADE BY NOTIFICATION ADDRESSED TO THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES AND SHALL TAKE EFFECT ONE MONTH FROM THE DATE OF RECEIPT OF SUCH NOTIFICATION.

7 . TERMINATION OF THE EFFECT OF THE RESERVATION SHALL NOT APPLY TO COMMUNITY PATENTS GRANTED BEFORE THE DATE ON WHICH THE RESERVATION CEASED TO HAVE EFFECT.

ARTICLE 89

RESERVATION IN RESPECT OF COMPULSORY LICENCES

1 . ANY CONTRACTING STATE MAY , AT THE TIME OF SIGNATURE OR WHEN DEPOSITING ITS INSTRUMENT OF RATIFICATION , DECLARE THAT IT RESERVES THE RIGHT TO PROVIDE THAT ARTICLES 47 AND 82 SHALL NOT APPLY WITHIN ITS TERRITORY TO COMMUNITY PATENTS OR TO EUROPEAN PATENTS GRANTED FOR , OR TO NATIONAL PATENTS GRANTED BY , THAT STATE.

2 . ANY RESERVATION MADE BY A CONTRACTING STATE UNDER PARAGRAPH 1 SHALL HAVE EFFECT FOR A PERIOD OF NOT MORE THAN 10 YEARS FROM THE ENTRY INTO FORCE OF THIS CONVENTION. HOWEVER , THE COUNCIL OF THE EUROPEAN COMMUNITIES MAY , ACTING BY A QUALIFIED MAJORITY ON A PROPOSAL FROM A CONTRACTING STATE , EXTEND THE PERIOD IN RESPECT OF A CONTRACTING STATE MAKING SUCH A RESERVATION BY NOT MORE THAN FIVE YEARS . THIS MAJORITY SHALL BE THAT SPECIFIED IN ARTICLE 86 (5) (B)

3 . ANY RESERVATION MADE UNDER PARAGRAPH 1 SHALL CEASE TO APPLY WHEN COMMON RULES ON THE GRANTING OF COMPULSORY LICENCES IN RESPECT OF COMMUNITY PATENTS HAVE BECOME OPERATIVE.

4 . ANY CONTRACTING STATE THAT HAS MADE A RESERVATION UNDER PARAGRAPH 1 MAY WITHDRAW IT AT ANY TIME. SUCH WITHDRAWAL SHALL BE MADE BY NOTIFICATION ADDRESSED TO THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES AND SHALL TAKE EFFECT ONE MONTH FROM THE DATE OF RECEIPT OF SUCH NOTIFICATION.

5 . TERMINATION OF THE EFFECT OF THE RESERVATION SHALL NOT AFFECT COMPULSORY LICENCES GRANTED BEFORE THE DATE ON WHICH THE RESERVATION CEASED TO HAVE

EFFECT.

ARTICLE 90

RESERVATION IN RESPECT OF INFRINGEMENT PROCEEDINGS

1 . NOTWITHSTANDING ARTICLE 76 , ANY CONTRACTING STATE WHOSE NATIONAL LAW MAKES PROVISION FOR A DECISION TO BE TAKEN IN INFRINGEMENT PROCEEDINGS AS TO THE VALIDITY OF NATIONAL PATENTS MAY , AT THE TIME OF SIGNATURE OR WHEN DEPOSITING ITS INSTRUMENT OF RATIFICATION , DECLARE THAT IT RESERVES THE RIGHT TO PROVIDE THAT ITS COURTS DEALING WITH INFRINGEMENT RELATING TO A COMMUNITY PATENT MAY , WITH THE AGREEMENT OF THE PARTIES , DECIDE UPON THE EFFECT OF THE COMMUNITY PATENT IN THE TERRITORY OF THE STATE IN WHICH THE COURT IS LOCATED . HOWEVER :

(A) THE COURT SHALL , IN SO FAR AS THE FACTS ARE THE SAME , BE BOUND BY A PRIOR DECISION OF THE EUROPEAN PATENT OFFICE CONCERNING THE VALIDITY OF THE COMMUNITY PATENT ;

(B) THE COURT SHALL BE LIMITED TO THE GROUNDS FOR REVOCATION SPECIFIED IN ARTICLE 57 AND BE GOVERNED BY THE OTHER PROVISIONS OF THIS CONVENTION.

2 . THE COMMUNITY PATENT SHALL NOT HAVE EFFECT IN THE TERRITORY OF A CONTRACTING STATE WHICH HAS MADE A RESERVATION PURSUANT TO PARAGRAPH 1 , TO THE EXTENT TO WHICH A COURT IN THAT STATE HAS DECIDED THAT THE PATENT IS INEFFECTIVE.

3 . THE PROCEDURE FOR DETERMINING THE EFFECT OF THE COMMUNITY PATENT IN A CONTRACTING STATE WHICH HAS MADE A RESERVATION PURSUANT TO PARAGRAPH 1 SHALL BE THAT WHICH WOULD HAVE BEEN IMPLEMENTED IF THE COMMUNITY PATENT HAD BEEN A NATIONAL PATENT.

4 . ANY RESERVATION MADE BY A CONTRACTING STATE UNDER PARAGRAPH 1 SHALL HAVE EFFECT FOR A PERIOD OF NOT MORE THAN 10 YEARS FROM THE ENTRY INTO FORCE OF THIS CONVENTION. HOWEVER , THE COUNCIL OF THE EUROPEAN COMMUNITIES MAY , ACTING BY A QUALIFIED MAJORITY ON A PROPOSAL FROM A CONTRACTING STATE , EXTEND THE PERIOD IN RESPECT OF A CONTRACTING STATE MAKING SUCH A RESERVATION BY NOT MORE THAN FIVE YEARS . THIS MAJORITY SHALL BE THAT SPECIFIED IN ARTICLE 86 (5) (B)

5 . ANY RESERVATION MADE UNDER PARAGRAPH 1 SHALL CEASE TO APPLY WHEN SPECIAL ARRANGEMENTS FOR LITIGATION OF COMMUNITY PATENTS HAVE BECOME OPERATIVE .

6 . ANY CONTRACTING STATE THAT HAS MADE A RESERVATION UNDER PARAGRAPH 1 MAY WITHDRAW IT AT ANY TIME. SUCH WITHDRAWAL SHALL BE MADE BY NOTIFICATION ADDRESSED TO THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES AND SHALL TAKE EFFECT ONE MONTH FROM THE DATE OF RECEIPT OF SUCH NOTIFICATION.

7 . A COURT EXERCISING JURISDICTION UNDER THIS ARTICLE SHALL HAVE JURISDICTION ONLY IN RESPECT OF ACTS OF INFRINGEMENT COMMITTED WITHIN THE TERRITORY OF THE CONTRACTING STATE IN WHICH IT IS SITUATED. ARTICLES 21 TO 23 OF THE CONVENTION ON JURISDICTION AND ENFORCEMENT SHALL NOT APPLY.

ARTICLE 91

OTHER TRANSITIONAL PROVISIONS

1 . ARTICLES 159 , 160 (2) , 161 AND 163 OF THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS SUBJECT TO THE FOLLOWING :

(A) THE FIRST MEETING OF THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL SHALL BE ON THE INVITATION OF THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES ;

(B) THE TERM " CONTRACTING STATES " SHALL BE UNDERSTOOD AS MEANING THE STATES PARTIES TO THIS CONVENTION.

2 . NOTWITHSTANDING PARAGRAPH 1 (B) , ARTICLE 64 (2) SHALL APPLY.

PART IX

FINAL PROVISIONS

ARTICLE 92

IMPLEMENTING REGULATIONS

1 . THE IMPLEMENTING REGULATIONS SHALL BE AN INTEGRAL PART OF THIS CONVENTION .

2 . IN THE CASE OF CONFLICT BETWEEN THE PROVISIONS OF THIS CONVENTION AND THOSE OF THE IMPLEMENTING REGULATIONS , THE PROVISIONS OF THIS CONVENTION SHALL PREVAIL.

ARTICLE 93

PRECEDENCE OF THE PROVISIONS OF THE TREATY ESTABLISHING THE EUROPEAN ECONOMIC COMMUNITY

NO PROVISION OF THIS CONVENTION MAY BE INVOKED AGAINST THE APPLICATION OF ANY PROVISION OF THE TREATY ESTABLISHING THE EUROPEAN ECONOMIC COMMUNITY.

ARTICLE 94

RATIFICATION

THIS CONVENTION SHALL BE SUBJECT TO RATIFICATION BY THE SIGNATORY STATES ; INSTRUMENTS OF RATIFICATION SHALL BE DEPOSITED WITH THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES.

ARTICLE 95

ACCESSION

1 . THIS CONVENTION SHALL BE OPEN TO ACCESSION BY STATES BECOMING MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY.

2 . INSTRUMENTS OF ACCESSION TO THIS CONVENTION SHALL BE DEPOSITED WITH THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES . ACCESSION SHALL TAKE EFFECT ON THE FIRST DAY OF THE THIRD MONTH FOLLOWING THE DEPOSIT OF THE INSTRUMENT OF ACCESSION , PROVIDED THAT THE RATIFICATION BY THE STATE CONCERNED OF THE EUROPEAN PATENT CONVENTION OR ITS ACCESSION THERETO HAS BECOME EFFECTIVE.

3 . THE CONTRACTING STATES HEREBY RECOGNIZE THAT ANY STATE WHICH BECOMES A MEMBER OF THE EUROPEAN ECONOMIC COMMUNITY MUST ACCEDE TO THIS CONVENTION.

4 . A SPECIAL AGREEMENT MAY BE CONCLUDED BETWEEN THE CONTRACTING STATES AND THE ACCEDING STATE , TO DETERMINE THE DETAILS OF APPLICATION OF THIS CONVENTION NECESSITATED BY THE ACCESSION OF THAT STATE .

ARTICLE 96

PARTICIPATION OF THIRD STATES

THE COUNCIL OF THE EUROPEAN COMMUNITIES MAY , ACTING BY A UNANIMOUS DECISION , INVITE A STATE PARTY TO THE EUROPEAN PATENT CONVENTION WHICH FORMS A CUSTOMS UNION OR A FREE TRADE AREA WITH THE EUROPEAN ECONOMIC COMMUNITY TO ENTER INTO NEGOTIATIONS WITH A VIEW TO ENABLING THAT THIRD STATE TO PARTICIPATE IN THIS CONVENTION ON THE BASIS OF A SPECIAL AGREEMENT , TO BE CONCLUDED BETWEEN THE STATES PARTIES TO THIS CONVENTION AND THE THIRD STATE CONCERNED , DETERMINING THE CONDITIONS AND DETAILS FOR APPLYING THIS CONVENTION TO THAT STATE.

ARTICLE 97

TERRITORIAL FIELD OF APPLICATION

1 . THIS CONVENTION SHALL APPLY TO THE KINGDOM OF BELGIUM , THE KINGDOM OF DENMARK , THE FEDERAL REPUBLIC OF GERMANY , THE FRENCH REPUBLIC INCLUDING ITS OVERSEAS DEPARTMENTS AND TERRITORIES , IRELAND , THE ITALIAN REPUBLIC , THE GRAND DUCHY OF LUXEMBOURG , THE EUROPEAN TERRITORY OF THE KINGDOM OF THE NETHERLANDS AND TO THE UNITED KINGDOM OF GREAT BRITAIN AND NORTHERN IRELAND.

2 . FOR THE PURPOSES OF PARAGRAPH 1 , THE UNITED KINGDOM OF GREAT BRITAIN AND NORTHERN IRELAND MEANS ENGLAND AND WALES , SCOTLAND AND NORTHERN IRELAND.

3 . THIS CONVENTION SHALL NOT APPLY TO THE FAROE ISLANDS. THE KINGDOM OF

DENMARK MAY AT ANY TIME DECLARE BY NOTIFICATION ADDRESSED TO THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES THAT THIS CONVENTION SHALL BE APPLICABLE TO THE FAROE ISLANDS.

4 . THE KINGDOM OF THE NETHERLANDS MAY DECLARE IN ITS INSTRUMENT OF RATIFICATION OR BY NOTIFICATION ADDRESSED TO THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES AT ANY LATER TIME THAT THIS CONVENTION SHALL BE APPLICABLE TO THE NETHERLANDS ANTILLES.

5 . THE UNITED KINGDOM OF GREAT BRITAIN AND NORTHERN IRELAND MAY DECLARE IN ITS INSTRUMENT OF RATIFICATION OR BY NOTIFICATION ADDRESSED TO THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES AT ANY LATER TIME THAT THIS CONVENTION SHALL BE APPLICABLE TO ONE OR MORE OF THE EUROPEAN TERRITORIES FOR THE EXTERNAL RELATIONS OF WHICH IT IS RESPONSIBLE .

6 . IF A DECLARATION REFERRED TO IN PARAGRAPH 3 , 4 OR 5 IS CONTAINED IN THE INSTRUMENT OF RATIFICATION , IT SHALL TAKE EFFECT ON THE SAME DATE AS THE RATIFICATION ; IF THE DECLARATION IS MADE IN A NOTIFICATION AFTER THE DEPOSIT OF THE INSTRUMENT OF RATIFICATION , IT SHALL TAKE EFFECT SIX MONTHS AFTER THE DATE OF RECEIPT BY THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES.

7 . THE STATES REFERRED TO IN PARAGRAPHS 4 AND 5 MAY , AT ANY TIME , DECLARE THAT THE CONVENTION SHALL CEASE TO APPLY TO ONE OR MORE OF THE TERRITORIES IN RESPECT OF WHICH THEY HAVE MADE A DECLARATION PURSUANT TO PARAGRAPH 4 OR 5. SUCH DECLARATIONS OF TERMINATION SHALL TAKE EFFECT ONE YEAR AFTER THE DATE ON WHICH THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES RECEIVED NOTIFICATION THEREOF.

8 . FOR THE PURPOSES OF IMPLEMENTING THIS CONVENTION , THAT PART OF THE CONTINENTAL SHELF ADJACENT TO A TERRITORY REFERRED TO IN PARAGRAPH 1 , 3 , 4 OR 5 SHALL BE DEEMED TO BE INCLUDED IN THIS TERRITORY , WITHIN THE LIMITS OF THE SOVEREIGN RIGHTS OF COASTAL STATES AS LAID DOWN IN THE GENEVA CONVENTION ON THE CONTINENTAL SHELF OF 29 APRIL 1958 , OR ANY OTHER CONVENTION AMENDING OR REPLACING THAT CONVENTION FOR THE CONTRACTING STATES.

ARTICLE 98

ENTRY INTO FORCE

THIS CONVENTION SHALL ENTER INTO FORCE THREE MONTHS AFTER THE DEPOSIT OF THE INSTRUMENT OF RATIFICATION BY THE LAST SIGNATORY STATE TO TAKE THIS STEP ; HOWEVER , IF THE EUROPEAN PATENT CONVENTION ENTERS INTO FORCE WITH RESPECT TO THE STATES SIGNATORIES TO THIS CONVENTION AT A LATER DATE , THIS CONVENTION SHALL ENTER INTO FORCE ON THE LATTER DATE .

ARTICLE 99

DURATION OF THE CONVENTION

THIS CONVENTION IS CONCLUDED FOR AN UNLIMITED PERIOD.

ARTICLE 100

REVISION

IF A MAJORITY OF THE CONTRACTING STATES REQUESTS THE REVISION OF THIS CONVENTION , A REVISION CONFERENCE SHALL BE CONVENED BY THE PRESIDENT OF THE COUNCIL OF THE EUROPEAN COMMUNITIES. THE CONFERENCE SHALL BE PREPARED BY THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL .

ARTICLE 101

DISPUTES BETWEEN CONTRACTING STATES

1 . ANY DISPUTE BETWEEN CONTRACTING STATES CONCERNING THE INTERPRETATION OR APPLICATION OF THIS CONVENTION WHICH IS NOT SETTLED BY NEGOTIATION SHALL BE SUBMITTED , AT THE REQUEST OF ONE OF THE STATES CONCERNED , TO THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL , WHICH SHALL ENDEAVOUR TO BRING ABOUT AGREEMENT BETWEEN THE STATES CONCERNED.

2 . IF AGREEMENT IS NOT REACHED WITHIN SIX MONTHS FROM THE DATE WHEN THE SELECT COMMITTEE WAS SEISED OF THE DISPUTE , ANY ONE OF THE STATES CONCERNED MAY SUBMIT THE DISPUTE TO THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES.

3 . IF THE COURT OF JUSTICE FINDS THAT A CONTRACTING STATE HAS FAILED TO FULFIL AN OBLIGATION UNDER THIS CONVENTION , THAT STATE SHALL BE REQUIRED TO TAKE THE NECESSARY MEASURES TO COMPLY WITH THE JUDGMENT OF THE COURT OF JUSTICE.

ARTICLE 102

ORIGINAL OF THE CONVENTION

THIS CONVENTION , DRAWN UP IN A SINGLE ORIGINAL IN THE DANISH , DUTCH , ENGLISH , FRENCH , GERMAN , IRISH AND ITALIAN LANGUAGES , ALL SEVEN EXTS BEING EQUALLY AUTHENTIC , SHALL BE DEPOSITED IN THE ARCHIVES OF THE SECRETARIAT OF THE COUNCIL OF THE EUROPEAN COMMUNITIES . THE SECRETARY-GENERAL SHALL TRANSMIT A CERTIFIED COPY TO THE GOVERNMENT OF EACH SIGNATORY STATE.

ARTICLE 103

NOTIFICATION

THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES SHALL NOTIFY THE SIGNATORY STATES OF :

(A) THE DEPOSIT OF EACH INSTRUMENT OF RATIFICATION AND ACCESSION ;

(B) ANY RESERVATION OR WITHDRAWAL OF RESERVATION PURSUANT TO ARTICLE 88 , 89 OR 90 ;

(C) THE DATE OF ENTRY INTO FORCE OF THIS CONVENTION ;

(D) ANY DECLARATION OR NOTIFICATION RECEIVED PURSUANT TO ARTICLE 97

TIL BEKRAEFTELSE HERAF HAR UNDERTEGNEDE BEFULDMAEGTIGEDE UNDESKREVET DENNE KONVENTION.

ZU URKUND DESSEN HABEN DIE UNTERZEICHNETEN BEVOLLMAECHTIGTEN IHRE UNTERSCHRIFTEN UNTER DIESES UEBEREINKOMMEN GESETZT.

IN WITNESS WHEREOF , THE UNDERSIGNED PLENIPOTENTIARIES HAVE AFFIXED THEIR SIGNATURES BELOW THIS CONVENTION.

EN FOI DE QUOI , LES PLENIPOTENTIAIRES SOUSSIGNES ONT APOSE LEURS SIGNATURES AU BAS DE LA PRESENTE CONVENTION.

DA FHIANU SIN , CHUIR NA LANCHUMHACHTAIGH THIOS-SINITHE A LAMH LEIS AN GCOINBHINSIUN SEO.

IN FEDE DI CHE , I PLENIPOTENZIARI SOTTOSCRITTI HANNO APPOSTO LE LORO FIRME IN CALCE ALLA PRESENTE CONVENZIONE.

TEN BLIJKE WAARVAN DE ONDERGETEKENDE GEVOLMACHTIGDEN HUN HANDTEKENING ONDER DIT VERDRAG HEBBEN GESTELD.

UDFAERDIGET I LUXEMBOURG , DEN FEMTENDE DECEMBER NITTEN HUNDREDE OG FEMOGHALVFJERDS.

GESCHEHEN ZU LUXEMBURG AM FUENFZEHNTE DEZEMBER NEUNZEHNHUNDERTFUENFUNDSTUEBZIG.

DONE AT LUXEMBOURG ON THE FIFTEENTH DAY OF DECEMBER IN THE YEAR ONE THOUSAND NINE HUNDRED AND SEVENTY-FIVE.

FAIT A LUXEMBOURG , LE QUINZE DECEMBRE MIL NEUF CENT SOIXANTE-QUINZE

ARNA DHEANAMH I LUCSAMBURG , AN CUIGIU LA DEAG DE MHI NA NOLLAG , MILE NAOI GCEAD SEACHTO A CUIG.

FATTO A LUSSEMBURGO , ADDI QUINDICI DICEMBRE MILLENOVECENTOSETTANTACINQUE.

GEDAAN TE LUXEMBURG , DE VIJFTIENDE DECEMBER NEGENTIENHONDERD VIJFENZEVENTIG.

POUR SA MAJESTE LE ROI DES BELGES

VOOR ZIJNE MAJESTEIT DE KONING DER BELGEN

FOR HENDES MAJESTAET DRONNINGEN AF DANMARK

FUER DEN PRAESIDENTEN DER BUNDESREPUBLIK DEUTSCHLAND

POUR LE PRESIDENT DE LA REPUBLIQUE FRANCAISE

THAR CEANN UACHTARAN NA HEIREANN

PER IL PRESIDENTE DELLA REPUBBLICA ITALIANA

POUR SON ALTESSE ROYALE LE GRAND-DUC DE LUXEMBOURG

VOOR HARE MAJESTEIT DE KONINGIN DER NEDERLANDEN

FOR HER MAJESTY THE QUEEN OF THE UNITED KINGDOM OF GREAT BRITAIN AND NORTHERN IRELAND

IMPLEMENTING REGULATIONS TO THE CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON MARKET

PART I

IMPLEMENTING REGULATIONS TO PART I OF THE CONVENTION

CHAPTER I

ORGANIZATION OF THE SPECIAL DEPARTMENTS

RULE 1

ALLOCATION OF DUTIES TO THE DEPARTMENTS OF THE FIRST INSTANCE

1 . THE PRESIDENT OF THE EUROPEAN PATENT OFFICE SHALL DETERMINE THE NUMBER OF REVOCATION DIVISIONS. HE SHALL ALLOCATE DUTIES TO THESE DEPARTMENTS BY REFERENCE TO THE INTERNATIONAL CLASSIFICATION.

2 . THE PRESIDENT OF THE EUROPEAN PATENT OFFICE SHALL , WITH THE AGREEMENT OF THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL , DETERMINE IN DETAIL THE DUTIES FOR WHICH THE PATENT ADMINISTRATION DIVISION IS RESPONSIBLE PURSUANT TO ARTICLE 8.

3 . IN ADDITION TO THE RESPONSIBILITIES VESTED IN THEM UNDER THE CONVENTION , THE PRESIDENT OF THE EUROPEAN PATENT OFFICE MAY ALLOCATE FURTHER DUTIES TO THE PATENT ADMINISTRATION DIVISION AND THE REVOCATION DIVISIONS.

4 . THE PRESIDENT OF THE EUROPEAN PATENT OFFICE MAY ENTRUST TO EMPLOYEES WHO ARE NOT TECHNICALLY OR LEGALLY QUALIFIED MEMBERS THE EXECUTION OF INDIVIDUAL DUTIES FALLING TO THE PATENT ADMINISTRATION DIVISION OR THE REVOCATION DIVISIONS , AND INVOLVING NO TECHNICAL OR LEGAL DIFFICULTIES.

RULE 2

ALLOCATION OF DUTIES TO THE DEPARTMENTS OF THE SECOND INSTANCE AND DESIGNATION OF THEIR MEMBERS

1 . DUTIES SHALL BE ALLOCATED TO THE REVOCATION BOARDS AND THE REGULAR AND ALTERNATE MEMBERS OF THE VARIOUS REVOCATION BOARDS SHALL BE DESIGNATED BEFORE THE BEGINNING OF EACH WORKING YEAR. ANY MEMBER OF A REVOCATION BOARD MAY BE DESIGNATED AS A MEMBER OF MORE THAN ONE REVOCATION BOARD. THESE MEASURES MAY , WHERE NECESSARY , BE AMENDED DURING THE COURSE OF THE WORKING YEAR IN QUESTION.

2 . THE MEASURES REFERRED TO IN PARAGRAPH 1 SHALL BE TAKEN BY AN AUTHORITY CONSISTING OF THE PRESIDENT OF THE EUROPEAN PATENT OFFICE , WHO SHALL ACT AS CHAIRMAN , THE VICE-PRESIDENT RESPONSIBLE FOR REVOCATION BOARDS , THE CHAIRMEN OF THE REVOCATION BOARDS , AND ONE OTHER MEMBER OF THE REVOCATION BOARDS , THE LATTER BEING ELECTED BY THE FULL MEMBERSHIP OF THESE BOARDS FOR THE WORKING YEAR IN QUESTION. THIS AUTHORITY MAY ONLY TAKE A DECISION IF AT LEAST THREE OF ITS MEMBERS ARE PRESENT ; THESE MUST INCLUDE THE PRESIDENT

OR A VICE-PRESIDENT OF THE EUROPEAN PATENT OFFICE AND THE CHAIRMAN OF A REVOCATION BOARD. DECISIONS SHALL BE TAKEN BY A MAJORITY VOTE ; IN THE EVENT OF PARITY OF VOTES , THE VOTE OF THE CHAIRMAN SHALL BE DECISIVE .

3 . THE AUTHORITY REFERRED TO IN PARAGRAPH 2 SHALL DECIDE ON CONFLICTS REGARDING THE ALLOCATION OF DUTIES BETWEEN TWO OR MORE REVOCATION BOARDS.

RULE 3

RULES OF PROCEDURE OF THE REVOCATION BOARDS

THE AUTHORITY REFERRED TO IN RULE 2 (2) SHALL ADOPT THE RULES OF PROCEDURE OF THE REVOCATION BOARDS.

RULE 4

ADMINISTRATIVE STRUCTURE OF THE SPECIAL DEPARTMENTS

1 . THE REVOCATION DIVISIONS MAY BE GROUPED TOGETHER ADMINISTRATIVELY WITH THE EXAMINING DIVISIONS AND OPPOSITION DIVISIONS SO AS TO FORM DIRECTORATES , OR MAY FORM A DIRECTORATE TOGETHER WITH THE PATENT ADMINISTRATION DIVISION.

2 . THE SPECIAL DEPARTMENTS MAY BE GROUPED TOGETHER ADMINISTRATIVELY WITH OTHER DEPARTMENTS OF THE EUROPEAN PATENT OFFICE SO AS TO FORM DIRECTORATES-GENERAL OR MAY FORM A SEPARATE DIRECTORATE-GENERAL ; IN THE LATTER CASE , RULE 12 (3) OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION SHALL APPLY , BUT THE APPOINTMENT OF A VICE-PRESIDENT TO THE DIRECTORATE-GENERAL SHALL BE DECIDED UPON BY THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL.

CHAPTER II

LANGUAGES OF THE SPECIAL DEPARTMENTS

RULE 5

LANGUAGE OF THE PROCEEDINGS

1 . RULES 1 TO 3 , 5 , 6 (2) AND 7 OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS TO PROCEEDINGS BEFORE THE SPECIAL DEPARTMENTS.

2 . A REDUCTION IN THE LIMITATION FEE , REVOCATION FEE OR APPEAL FEE SHALL BE ALLOWED THE PROPRIETOR OF A PATENT OR AN APPLICANT FOR REVOCATION WHO AVAILS HIMSELF OF THE OPTIONS PROVIDED FOR IN ARTICLE 14 (4) . THE REDUCTION SHALL BE FIXED IN THE RULES RELATING TO FEES AT A PERCENTAGE OF THE TOTAL OF THE FEES.

PART II

IMPLEMENTING REGULATIONS TO PART II OF THE CONVENTION

RULE 6

SUSPENSION OF PROCEEDINGS

RULE 13 OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS TO LIMITATION PROCEEDINGS AND REVOCATION

PROCEEDINGS.

RULE 7

ENTRIES REGARDING CLAIMS TO THE RIGHT TO COMMUNITY PATENTS

THE ENTRIES REFERRED TO IN ARTICLE 27 (4) SHALL BE MADE :

- (A) AT THE REQUEST OF THE REGISTRAR OF THE COURT BEFORE WHICH THE PROCEEDINGS ARE INSTITUTED ;
- (B) AT THE REQUEST OF THE CLAIMANT OR ANY OTHER INTERESTED PERSON.

RULE 8

REQUEST TO FILE TRANSLATIONS OF THE CLAIMS IN EXAMINATION OR OPPOSITION PROCEEDINGS

1 . THE EUROPEAN PATENT OFFICE SHALL REQUEST THE APPLICANT FOR OR PROPRIETOR OF THE PATENT TO FILE , WITHIN THREE MONTHS , THE TRANSLATIONS PRESCRIBED IN ARTICLE 33 (1) AND (2) , AND TO PAY THE FEE FOR THE PUBLICATION OF THE TRANSLATIONS OF THE CLAIMS WITHIN THE SAME PERIOD .

2 . THE REQUEST SHALL BE SENT AT THE SAME TIME AS :

- (A) IN THE CASE OF EXAMINATION PROCEEDINGS , THE REQUEST REFERRED TO IN RULE 51 (4) OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION ;
- (B) IN THE CASE OF OPPOSITION PROCEEDINGS , THE REQUEST REFERRED TO IN RULE 58 (5) OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION .

3 . THE FURTHER PERIOD REFERRED TO IN ARTICLE 33 (5) SHALL BE TWO MONTHS .

RULE 9

CORRECTION OF THE TRANSLATION

1 . WHERE ARTICLE 33 (1) AND (2) APPLY , THE APPLICANT FOR OR PROPRIETOR OF THE PATENT MAY FILE AT THE EUROPEAN PATENT OFFICE A CORRECTED TRANSLATION FOR THE PURPOSES OF PUBLICATION. THE CORRECTED TRANSLATION SHALL NOT BE DEEMED TO HAVE BEEN FILED UNTIL THE FEE FOR ITS PUBLICATION HAS BEEN PAID.

2 . WHERE A CONTRACTING STATE HAS ADOPTED A PROVISION PURSUANT TO ARTICLE 34 (2) , THE APPLICANT WHOSE TRANSLATION OF THE CLAIMS HAS BEEN PUBLISHED , MAY FILE WITH THE COMPETENT AUTHORITY OF THAT STATE A CORRECTED TRANSLATION FOR THE PURPOSES OF PUBLICATION.

RULE 10

REGISTERING TRANSFERS , LICENCES AND OTHER RIGHTS

1 . RULES 20 TO 22 OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS TO ENTRIES MADE IN THE REGISTER OF COMMUNITY PATENTS.

2 . THE REQUEST PROVIDED FOR IN ARTICLE 28 (2) MUST , IN THE CASE OF SUBPARAGRAPH

(A) , BE MADE WITHIN TWO MONTHS , OR IN THE CASE OF SUBPARAGRAPH (B) , WITHIN FOUR MONTHS , OF RECEIPT OF NOTIFICATION FROM THE EUROPEAN PATENT OFFICE THAT THE NAME OF A NEW PROPRIETOR HAS BEEN ENTERED IN THE REGISTER OF COMMUNITY PATENTS.

3 . WHERE A COMMUNITY PATENT IS INVOLVED IN BANKRUPTCY OR LIKE PROCEEDINGS , AN ENTRY TO THIS EFFECT SHALL BE MADE IN THE REGISTER OF COMMUNITY PATENTS ON REQUEST OF THE COMPETENT NATIONAL AUTHORITY. THE ENTRY SHALL NOT INCUR A FEE.

4 . THE ENTRY REFERRED TO IN PARAGRAPH 3 SHALL BE DELETED AT THE REQUEST OF THE COMPETENT NATIONAL AUTHORITY. THE REQUEST SHALL NOT INCUR A FEE .

5 . WHERE A EUROPEAN PATENT APPLICATION IN WHICH THE CONTRACTING STATES ARE DESIGNATED IS INVOLVED IN BANKRUPTCY OR LIKE PROCEEDINGS , PARAGRAPHS 3 AND 4 SHALL APPLY MUTATIS MUTANDIS BUT THE REFERENCE TO THE REGISTER OF COMMUNITY PATENTS SHALL BE UNDERSTOOD AS BEING A REFERENCE TO THE REGISTER OF EUROPEAN PATENTS PROVIDED FOR IN THE EUROPEAN PATENT CONVENTION.

RULE 11

LICENCES OF RIGHT

1 . ANY PERSON WHO WISHES TO USE THE INVENTION AFTER A STATEMENT PROVIDED FOR IN ARTICLE 44 (1) HAS BEEN FILED SHALL DECLARE HIS INTENTION TO THE PROPRIETOR OF THE PATENT BY REGISTERED LETTER. THE DECLARATION SHALL BE DEEMED TO HAVE BEEN MADE ONE WEEK AFTER POSTING OF THE REGISTERED LETTER. A COPY OF THIS DECLARATION , STATING THE DATE UPON WHICH THE DECLARATION WAS POSTED , SHALL BE SENT TO THE EUROPEAN PATENT OFFICE. FAILING THIS , THE EUROPEAN PATENT OFFICE SHALL , IN THE EVENT OF WITHDRAWAL OF THE STATEMENT , CONSIDER THE DECLARATION NOT TO HAVE BEEN MADE.

2 . THE DECLARATION SHALL STATE HOW THE INVENTION IS TO BE USED. AFTER THE DECLARATION HAS BEEN MADE , THE PERSON MAKING IT SHALL BE ENTITLED TO USE THE INVENTION IN THE WAY HE HAS STATED.

3 . THE LICENSEE SHALL BE OBLIGED AT THE END OF EVERY QUARTER OF A CALENDAR YEAR TO REPORT TO THE PROPRIETOR OF THE PATENT ON THE USE MADE THEREOF AND TO PAY THE COMPENSATION THEREFOR. IF THIS OBLIGATION IS NOT COMPLIED WITH , THE PROPRIETOR OF THE PATENT MAY LAY DOWN A FURTHER SUITABLE TIME LIMIT FOR THIS PURPOSE. IF THE TIME LIMIT IS NOT COMPLIED WITH THE LICENCE SHALL EXPIRE.

4 . A REQUEST FOR REVIEW OF THE COMPENSATION DETERMINED BY THE REVOCATION DIVISION MAY BE MADE ONLY AFTER THE EXPIRY OF ONE YEAR FROM THE LAST DETERMINATION OF COMPENSATION.

PART III

IMPLEMENTING REGULATIONS TO PART III OF THE CONVENTION

CHAPTER I

RENEWAL FEES

RULE 12

PAYMENT OF RENEWAL FEES

1 . RULE 37 (1) AND (2) OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION SHALL APPLY TO THE PAYMENT OF RENEWAL FEES FOR COMMUNITY PATENTS.

2 . AN ADDITIONAL FEE SHALL BE DEEMED TO HAVE BEEN PAID AT THE SAME TIME AS THE RENEWAL FEE WITHIN THE MEANING OF ARTICLE 49 (2) IF IT IS PAID WITHIN THE PERIOD LAID DOWN IN THAT PROVISION.

RULE 13

PERIOD FOR THE ENTRY OF SURRENDER

THE PERIOD REFERRED TO IN ARTICLE 50 (3) SHALL BE THREE MONTHS FROM THE DATE ON WHICH THE PROPRIETOR OF THE PATENT HAS PROVED TO THE EUROPEAN PATENT OFFICE THAT HE HAS INFORMED THE LICENSEE OF HIS INTENTION TO SURRENDER. IF BEFORE EXPIRY OF THE PERIOD , THE PROPRIETOR OF THE PATENT PROVES TO THE EUROPEAN PATENT OFFICE THAT THE LICENSEE AGREES TO THE SURRENDER , IT MAY BE ENTERED IMMEDIATELY.

CHAPTER II

LIMITATION PROCEDURE

RULE 14

PERIOD FOR THE FILING OF THE REQUEST FOR LIMITATION

RULE 13 SHALL APPLY MUTATIS MUTANDIS TO THE FILING OF THE REQUEST FOR LIMITATION OF THE COMMUNITY PATENT.

RULE 15

CONTENT OF THE REQUEST FOR LIMITATION

THE REQUEST FOR LIMITATION OF A COMMUNITY PATENT SHALL CONTAIN :

- (A) THE NUMBER OF THE COMMUNITY PATENT WHICH IT IS SOUGHT TO LIMIT , THE NAME OF THE PROPRIETOR AND THE TITLE OF THE INVENTION ;
- (B) THE AMENDMENTS SOUGHT ;
- (C) IF THE PROPRIETOR OF THE PATENT HAS APPOINTED A REPRESENTATIVE , HIS NAME AND THE ADDRESS OF HIS PLACE OF BUSINESS IN ACCORDANCE WITH RULE 26 (2) (C) OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION.

RULE 16

REJECTION OF THE REQUEST FOR LIMITATION AS INADMISSIBLE

IF THE REVOCATION DIVISION NOTES THAT THE REQUEST FOR LIMITATION OF A COMMUNITY PATENT DOES NOT COMPLY WITH ARTICLE 52 (1) AND (3) , AND RULE 15 , IT SHALL COMMUNICATE THIS TO THE PROPRIETOR OF THE PATENT AND SHALL INVITE HIM TO REMEDY THE DEFICIENCIES NOTED WITHIN SUCH A PERIOD AS IT MAY SPECIFY. IF THE REQUEST FOR LIMITATION IS NOT CORRECTED IN GOOD TIME , THE REVOCATION DIVISION SHALL REJECT IT AS INADMISSIBLE.

RULE 17

EXAMINATION OF THE REQUEST FOR LIMITATION

1 . IF THE REQUEST FOR LIMITATION OF THE COMMUNITY PATENT IS ADMISSIBLE , THE PROPRIETOR OF THE PATENT SHALL , IN ANY COMMUNICATION PURSUANT TO ARTICLE 53 (2) , WHERE APPROPRIATE , BE INVITED TO FILE THE DESCRIPTION , CLAIMS AND DRAWINGS IN AMENDED FORM.

2 . WHERE NECESSARY , ANY COMMUNICATION PURSUANT TO ARTICLE 53 (2) SHALL CONTAIN A REASONED STATEMENT. WHERE APPROPRIATE , THIS STATEMENT SHALL COVER ALL THE GROUNDS AGAINST THE LIMITATION OF THE PATENT .

3 . BEFORE THE REVOCATION DIVISION DECIDES ON THE LIMITATION OF THE PATENT , IT SHALL INFORM THE PROPRIETOR OF THE EXTENT TO WHICH IT INTENDS TO LIMIT THE PATENT , AND SHALL REQUEST HIM TO PAY WITHIN THREE MONTHS THE FEE FOR PRINTING A NEW PATENT SPECIFICATION AND TO FILE THE TRANSLATIONS PRESCRIBED IN ARTICLE 54 (2) (B) WITHIN THE SAME PERIOD . IF WITHIN THAT PERIOD THE PROPRIETOR HAS COMMUNICATED HIS DISAPPROVAL OF THE PATENT BEING LIMITED TO THIS EXTENT , THE COMMUNICATION OF THE REVOCATION DIVISION SHALL BE DEEMED NOT TO HAVE BEEN MADE , AND THE LIMITATION PROCEEDINGS SHALL BE RESUMED.

4 . THE FURTHER PERIOD REFERRED TO IN ARTICLE 54 (3) SHALL BE TWO MONTHS .

5 . THE DECISION TO LIMIT THE PATENT SHALL STATE THE TEXT OF THE PATENT AS LIMITED.

RULE 18

RESUMPTION OF LIMITATION PROCEEDINGS

WHERE LIMITATION PROCEEDINGS HAVE BEEN STAYED BECAUSE OF REVOCATION PROCEEDINGS WHICH RESULT IN A DECISION UNDER ARTICLE 59 (2) OR (3) , THE REVOCATION DIVISION , AFTER THE PUBLICATION OF THE MENTION OF SUCH DECISION , SHALL COMMUNICATE TO THE PROPRIETOR OF THE PATENT THAT THE PROCEEDINGS WILL BE RESUMED AFTER NOTIFICATION OF THIS COMMUNICATION TO THE PROPRIETOR. RULE 13 (5) OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS.

RULE 19

DIFFERENT CLAIMS , DESCRIPTION AND DRAWINGS IN THE CASE OF LIMITATION

WHERE IT IS DECIDED TO LIMIT A COMMUNITY PATENT IN RESPECT OF ONE OR SOME OF THE CONTRACTING STATES , THE COMMUNITY PATENT MAY , WHERE APPROPRIATE , CONTAIN , FOR THAT STATE OR STATES , CLAIMS AND , IF THE REVOCATION DIVISION CONSIDERS IT NECESSARY , A DESCRIPTION AND DRAWINGS WHICH ARE DIFFERENT FROM THOSE FOR THE OTHER CONTRACTING STATES .

RULE 20

FORM OF THE NEW SPECIFICATION FOLLOWING LIMITATION PROCEEDINGS

THE PRESIDENT OF THE EUROPEAN PATENT OFFICE SHALL PRESCRIBE THE FORM OF THE PUBLICATION OF THE NEW SPECIFICATION OF THE COMMUNITY PATENT AND THE DATA WHICH ARE TO BE INCLUDED.

CHAPTER III

REVOCATION PROCEDURE

RULE 21

CONTENT OF THE APPLICATION FOR REVOCATION

AN APPLICATION FOR REVOCATION OF A COMMUNITY PATENT SHALL CONTAIN :

- (A) THE NAME AND ADDRESS OF THE APPLICANT FOR REVOCATION AND THE STATE IN WHICH HIS RESIDENCE OR PRINCIPAL PLACE OF BUSINESS IS LOCATED , IN ACCORDANCE WITH RULE 26 (2) (C) OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION ;
- (B) THE NUMBER OF THE PATENT IN RESPECT OF WHICH REVOCATION IS APPLIED FOR , THE NAME OF THE PROPRIETOR AND THE TITLE OF THE INVENTION ;
- (C) A STATEMENT OF THE EXTENT TO WHICH REVOCATION IS APPLIED FOR AND OF THE GROUNDS ON WHICH THE APPLICATION IS BASED AS WELL AS AN INDICATION OF THE FACTS , EVIDENCE AND ARGUMENTS PRESENTED IN SUPPORT OF THESE GROUNDS ;
- (D) IF THE APPLICANT HAS APPOINTED A REPRESENTATIVE , HIS NAME AND THE ADDRESS OF HIS PLACE OF BUSINESS , IN ACCORDANCE WITH RULE 26 (2) (C) OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION

RULE 22

SECURITY FOR THE COSTS OF PROCEEDINGS

THE SECURITY FOR THE COSTS OF THE PROCEEDINGS SHALL BE DEPOSITED IN A CURRENCY IN WHICH FEES MAY BE PAID. IT MUST BE DEPOSITED WITH A FINANCIAL OR BANKING ESTABLISHMENT INCLUDED IN THE LIST DRAWN UP BY THE PRESIDENT OF THE EUROPEAN PATENT OFFICE. THE NATIONAL LAW OF THE CONTRACTING STATE IN WHICH THE ESTABLISHMENT HAS ITS PLACE OF BUSINESS SHALL APPLY TO ANY SUCH SECURITY.

RULE 23

REJECTION OF THE APPLICATION FOR REVOCATION AS INADMISSIBLE

1 . THE REVOCATION DIVISION SHALL COMMUNICATE THE APPLICATION FOR REVOCATION TO THE PROPRIETOR OF THE PATENT WHO MAY COMMENT ON ITS ADMISSIBILITY WITHIN ONE MONTH.

2 . IF THE REVOCATION DIVISION NOTES THAT THE APPLICATION FOR REVOCATION DOES NOT COMPLY WITH ARTICLE 56 (1) AND (4) , RULES 21 AND 5 OF THESE IMPLEMENTING REGULATIONS IN CONJUNCTION WITH RULE 1 (1) OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION , IT SHALL COMMUNICATE THIS TO THE PROPRIETOR AND TO THE APPLICANT AND SHALL INVITE THE APPLICANT TO REMEDY THE DEFICIENCIES NOTED WITHIN SUCH PERIOD AS IT MAY SPECIFY. IF THE APPLICATION FOR REVOCATION IS NOT CORRECTED IN GOOD TIME , THE REVOCATION DIVISION SHALL REJECT IT AS INADMISSIBLE.

3 . ANY DECISION TO REJECT AN APPLICATION FOR REVOCATION AS INADMISSIBLE SHALL BE COMMUNICATED TO THE PROPRIETOR OF THE PATENT.

RULE 24

PREPARATION OF THE EXAMINATION OF THE APPLICATION FOR REVOCATION

1 . IF THE APPLICATION FOR REVOCATION IS ADMISSIBLE , THE REVOCATION DIVISION SHALL INVITE THE PROPRIETOR OF THE PATENT TO FILE HIS OBSERVATIONS AND TO FILE AMENDMENTS , WHERE APPROPRIATE , TO THE DESCRIPTION , CLAIMS AND DRAWINGS WITHIN A PERIOD TO BE FIXED BY THE REVOCATION DIVISION.

2 . THE OBSERVATIONS AND ANY AMENDMENTS FILED BY THE PROPRIETOR OF THE PATENT SHALL BE COMMUNICATED TO THE APPLICANT WHO SHALL BE INVITED BY THE REVOCATION DIVISION , IF IT CONSIDERS IT EXPEDIENT , TO REPLY WITHIN A PERIOD TO BE FIXED BY THE REVOCATION DIVISION.

RULE 25

EXAMINATION OF THE APPLICATION FOR REVOCATION

1 . ALL COMMUNICATIONS ISSUED PURSUANT TO ARTICLE 58 (2) AND ALL REPLIES THERETO SHALL BE COMMUNICATED TO ALL PARTIES.

2 . IN ANY COMMUNICATION FROM THE REVOCATION DIVISION TO THE PROPRIETOR OF THE PATENT PURSUANT TO ARTICLE 58 (2) , HE SHALL , WHERE APPROPRIATE , BE INVITED TO FILE THE DESCRIPTION , CLAIMS AND DRAWINGS IN AMENDED FORM.

3 . WHERE NECESSARY , ANY COMMUNICATION FROM THE REVOCATION DIVISION TO THE PROPRIETOR OF THE PATENT PURSUANT TO ARTICLE 58 (2) SHALL CONTAIN A REASONED STATEMENT. WHERE APPROPRIATE , THIS STATEMENT SHALL COVER ALL THE GROUNDS AGAINST THE MAINTENANCE OF THE COMMUNITY PATENT .

4 . BEFORE THE REVOCATION DIVISION DECIDES ON THE MAINTENANCE OF THE PATENT IN THE AMENDED FORM , IT SHALL INFORM THE PARTIES THAT IT INTENDS TO MAINTAIN THE PATENT AS AMENDED AND SHALL INVITE THEM TO STATE THEIR OBSERVATIONS WITHIN A PERIOD OF ONE MONTH IF THEY DISAPPROVE OF THE TEXT IN WHICH IT IS INTENDED TO MAINTAIN THE PATENT

5 . IF DISAPPROVAL OF THE TEXT COMMUNICATED BY THE REVOCATION DIVISION IS EXPRESSED , EXAMINATION OF THE REVOCATION MAY BE CONTINUED ; OTHERWISE , THE REVOCATION DIVISION SHALL , ON EXPIRY OF THE PERIOD REFERRED TO IN PARAGRAPH 4 , REQUEST THE PROPRIETOR OF THE PATENT TO PAY WITHIN THREE MONTHS THE FEE FOR THE PRINTING OF A NEW SPECIFICATION AND , IF THE CLAIMS ARE AMENDED , TO FILE THE TRANSLATIONS PRESCRIBED IN ARTICLE 59 (3) (B) WITHIN THE SAME PERIOD

6 . THE FURTHER PERIOD REFERRED TO IN ARTICLE 59 (4) SHALL BE TWO MONTHS .

7 . THE DECISION TO MAINTAIN THE PATENT AS AMENDED SHALL STATE WHICH TEXT OF THE PATENT FORMS THE BASIS FOR THE MAINTENANCE THEREOF.

RULE 26

JOINT PROCESSING OF APPLICATIONS FOR REVOCATION

1 . THE REVOCATION DIVISION MAY ORDER THAT TWO OR MORE APPLICATIONS FOR REVOCATION PENDING BEFORE IT AND RELATING TO THE SAME COMMUNITY PATENT , BE DEALT WITH JOINTLY IN ORDER TO CARRY OUT A JOINT INVESTIGATION AND TAKE A JOINT DECISION.

2 . THE REVOCATION DIVISION MAY RESCIND AN ORDER GIVEN PURSUANT TO PARAGRAPH

1 .

RULE 27

DIFFERENT CLAIMS , DESCRIPTION AND DRAWINGS IN THE CASE OF REVOCATION WHERE REVOCATION OF A COMMUNITY PATENT IS PRONOUNCED IN RESPECT OF ONE OR SOME OF THE CONTRACTING STATES , RULE 19 SHALL APPLY MUTATIS MUTANDIS .

RULE 28

FORM OF THE NEW SPECIFICATION FOLLOWING REVOCATION PROCEEDINGS

RULE 20 SHALL APPLY TO THE NEW SPECIFICATION OF THE COMMUNITY PATENT REFERRED TO IN ARTICLE 60.

RULE 29

OTHER PROVISIONS APPLICABLE TO REVOCATION PROCEEDINGS

RULES 59 , 60 AND 63 OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS TO REQUESTS FOR DOCUMENTS , CONTINUATION OF REVOCATION PROCEEDINGS BY THE EUROPEAN PATENT OFFICE OF ITS OWN MOTION AND COSTS IN REVOCATION PROCEEDINGS.

PART IV

IMPLEMENTING REGULATIONS TO PART IV OF THE CONVENTION

RULE 30

APPEAL PROCEEDINGS

RULES 64 TO 67 OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS TO APPEAL PROCEEDINGS.

PART V

IMPLEMENTING REGULATIONS TO PART V OF THE CONVENTION

RULE 31

ENTRIES IN THE REGISTER OF COMMUNITY PATENTS

1 . RULE 92 (1) (A) TO (L) , (O) , (Q) TO (U) AND (W) , (2) AND (3) OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS TO THE REGISTER OF COMMUNITY PATENTS .

2 . THE REGISTER OF COMMUNITY PATENTS SHALL ALSO CONTAIN THE FOLLOWING ENTRIES :

(A) DATE OF LAPSE OF THE COMMUNITY PATENT IN THE CASES PROVIDED FOR IN ARTICLE 51 (1) (B) AND (C) ;

(B) DATE OF FILING OF THE STATEMENT PROVIDED FOR IN ARTICLE 44 ;

- (C) DATE OF RECEIPT OF A REQUEST FOR LIMITATION OF THE COMMUNITY PATENT ;
- (D) DATE AND PURPORT OF THE DECISION ON THE REQUEST FOR LIMITATION OF THE COMMUNITY PATENT ;
- (E) DATE OF RECEIPT OF AN APPLICATION FOR REVOCATION OF THE COMMUNITY PATENT ;
- (F) DATE AND PURPORT OF THE DECISION ON THE APPLICATION FOR REVOCATION OF THE COMMUNITY PATENT ;
- (G) PARTICULARS OF MATTERS REFERRED TO IN ARTICLE 27 (4).

RULE 32

ADDITIONAL PUBLICATIONS BY THE EUROPEAN PATENT OFFICE

THE PRESIDENT OF THE EUROPEAN PATENT OFFICE SHALL DETERMINE IN WHAT FORM THE TRANSLATIONS OF CLAIMS FILED PURSUANT TO THE CONVENTION BY THE APPLICANT FOR OR PROPRIETOR OF A PATENT AND , WHERE APPROPRIATE , CORRECTED TRANSLATIONS , SHALL BE PUBLISHED AND WHETHER PARTICULARS OF SUCH TRANSLATIONS AND CORRECTED TRANSLATIONS SHOULD BE ENTERED IN THE COMMUNITY PATENT BULLETIN.

RULE 33

OTHER COMMON PROVISIONS

RULES 36 AND 106 AND THE PROVISIONS OF PART VII OF THE IMPLEMENTING REGULATIONS TO THE EUROPEAN PATENT CONVENTION , WITH THE EXCEPTION OF RULES 85 (3) , 86 , 87 , 92 AND 96 SHALL APPLY MUTATIS MUTANDIS SUBJECT TO THE FOLLOWING :

- (A) RULE 69 SHALL NOT APPLY TO DECISIONS ON REQUESTS FOR LIMITATION OR ON APPLICATIONS FOR REVOCATION OF THE COMMUNITY PATENT ;
- (B) THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL SHALL DETERMINE THE DETAILS OF THE APPLICATION OF RULE 74 (2) AND (3) ;
- (C) THE TERM " CONTRACTING STATES " SHALL BE UNDERSTOOD AS MEANING THE STATES PARTIES TO THIS CONVENTION.

PART VI

IMPLEMENTING REGULATIONS TO PART VIII OF THE CONVENTION

RULE 34

FORWARDING OF TRANSLATIONS

THE EUROPEAN PATENT OFFICE SHALL ENTER IN THE REGISTER OF COMMUNITY PATENTS THE DATE ON WHICH A TRANSLATION PURSUANT TO ARTICLE 88 IS FILED AND SHALL , AS SOON AS POSSIBLE , FORWARD A COPY OF THE TRANSLATION TO THE CENTRAL INDUSTRIAL PROPERTY OFFICE OF THE CONTRACTING STATE CONCERNED.

FINAL ACT

THE PLENIPOTENTIARIES OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY

ASSEMBLED AT LUXEMBOURG ON THE FIFTEENTH DAY OF DECEMBER IN THE YEAR ONE THOUSAND NINE HUNDRED AND SEVENTY-FIVE ON THE OCCASION OF THE LUXEMBOURG CONFERENCE ON THE COMMUNITY PATENT ,

HAVE PLACED ON RECORD THE FACT THAT THE FOLLOWING TEXT HAS BEEN DRAWN UP AND ADOPTED FOR SIGNATURE BY THE PLENIPOTENTIARIES OF THE MEMBER STATES MEETING WITHIN THE COUNCIL OF THE EUROPEAN COMMUNITIES :

CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON MARKET.

THE PLENIPOTENTIARIES HAVE ADOPTED THE RESOLUTION , DECLARATIONS AND DECISION LISTED BELOW AND ANNEXED TO THIS FINAL ACT :

RESOLUTION ON THE APPOINTMENT OF THE CHAIRMEN OF THE REVOCATION BOARDS

RESOLUTION CONCERNING PRIOR USE OR POSSESSION

RESOLUTION ON COMMON RULES ON THE GRANTING OF COMPULSORY LICENCES IN RESPECT OF COMMUNITY PATENTS

RESOLUTION ON THE CENTRALIZATION IN EACH CONTRACTING STATE OF JURISDICTION IN ACTIONS FOR INFRINGEMENT OF COMMUNITY PATENTS

RESOLUTION ON LITIGATION OF COMMUNITY PATENTS

RESOLUTION ON THE ADJUSTMENT OF NATIONAL PATENT LAW

DECLARATION ON THE RATIFICATION OF THE PATENT COOPERATION TREATY

DECLARATION ON THE RATIFICATION OF THE COMMUNITY PATENT CONVENTION

DECISION ON PREPARATIONS FOR THE COMMENCEMENT OF THE ACTIVITIES OF THE SPECIAL DEPARTMENTS OF THE EUROPEAN PATENT OFFICE.

THE PLENIPOTENTIARIES HAVE ALSO DRAWN UP AND ADOPTED FOR SIGNATURE THE FOLLOWING :

SUPPLEMENTARY PROTOCOL TO THE PROTOCOL OF 13 APRIL 1962 ON THE SETTING-UP OF EUROPEAN SCHOOLS ;

PROTOCOL OF PROVISIONAL APPLICATION OF THE SUPPLEMENTARY PROTOCOL TO THE PROTOCOL OF 13 APRIL 1962 ON THE SETTING-UP OF EUROPEAN SCHOOLS.

TIL BEKRAEFTELSE AF DETTE HAR DE UNDERTEGNEDE BEFULDMAEGTIGEDE UNDSKRIVET DENNE SLUTAKT.

ZU URKUND DESSEN HABEN DIE UNTERZEICHNETEN BEVOLLMAECHTIGTEN IHRE UNTERSCHRIFTEN UNTER DIESE SCHLUSSAKTE GESETZT.

IN WITNESS WHEREOF , THE UNDERSIGNED PLENIPOTENTIARIES HAVE AFFIXED THEIR SIGNATURES BELOW THIS FINAL ACT.

EN FOI DE QUOI , LES PLENIPOTENTIAIRES SOUSSIGNES ONT APOSE LEURS SIGNATURES AU BAS DU PRESENT ACTE FINAL.

DA FHIANU SIN , CHUIR NA LANCHUMHACHTAIGH THIOS-SINITHE A LAMH LEIS AN IONSTRAIM CHRIOCHNAITHEACH SEO.

IN FEDE DI CHE , I PLENIPOTENZIARI SOTTOSCRITTI HANNO APPOSTO LE LORO FIRME IN CALCE AL PRESENTE ATTO FINALE.

TEN BLIJKE WAARVAN DE ONDERGETEKENDE GEVOLMACHTIGDEN HUN HANDTEKENING ONDER DEZE SLOTAKTE HEBBEN GESTELD.

UDFAERDIGET I LUXEMBOURG , DEN FEMTENDE DECEMBER NITTEN HUNDREDE OG FEMOGHALVFJERDS.

GESCHEHEN ZU LUXEMBURG AM FUENFZEHTEN DEZEMBER NEUNZEHNHUNDERFUENFUNDSEBZIG.

DONE AT LUXEMBOURG ON THE FIFTEENTH DAY OF DECEMBER IN THE YEAR ONE THOUSAND NINE HUNDRED AND SEVENTY-FIVE.

FAIT A LUXEMBOURG , LE QUINZE DECEMBRE MIL NEUF CENT SOIXANTE-QUINZE

ARNA DHEANAMH I LUCSAMBURG , AN CUIGIU LA DEAG DE MHI NA NOLLAG , MILE NAOI GCEAD SEACHTO A CUIG.

FATTO A LUSSEMBURGO , ADDI QUINDICI DICEMBRE MILLENOVECENTOSETTANTACINQUE.

GEDAAN TE LUXEMBURG , DE VIJFTIENDE DECEMBER NEGENTIENHONDERD VIJFENZEVENTIG.

POUR LE GOUVERNEMENT DU ROYAUME DE BELGIQUE

VOOR DE REGERING VAN HET KONINKRIJK BELGIE

FOR REGERINGEN FOR KONGERIGET DANMARK

FUER DIE REGIERUNG DER BUNDESREPUBLIK DEUTSCHLAND

POUR LE GOUVERNEMENT DE LA REPUBLIQUE FRANCAISE

THAR CEANN RIALTAS NA HEIREANN

PER IL GOVERNO DELLA REPUBBLICA ITALIANA

POUR LE GOUVERNEMENT DU GRAND-DUCHE DE LUXEMBOURG

VOOR DE REGERING VAN HET KONINKRIJK DER NEDERLANDEN

FOR THE GOVERNMENT OF THE UNITED KINGDOM OF GREAT BRITAIN AND NORTHERN IRELAND

ANNEX

RESOLUTION

ON THE APPOINTMENT OF THE CHAIRMEN OF THE REVOCATION BOARDS REVOCATION BOARDS

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY

,

UPON SIGNATURE OF THE COMMUNITY PATENT CONVENTION ,

DECLARE THAT , AS A GENERAL RULE , A PERSON APPOINTED AS CHAIRMAN OF A REVOCATION BOARD AS PROVIDED FOR IN ARTICLE 11 OF THE CONVENTION , SHOULD BE A PERSON POSSESSING SEVERAL YEARS' EXPERIENCE IN INDUSTRIAL PROPERTY , FOR EXAMPLE AS A MEMBER OF AN ORDINARY COURT OR TRIBUNAL OR OF A COURT SPECIALIZED IN THIS FIELD IN A CONTRACTING STATE , OR AS A MEMBER OF ANY NATIONAL PATENT OFFICE OF A CONTRACTING STATE WHO IS EMPOWERED TO DECIDE IN REVOCATION OR APPEAL PROCEEDINGS , OR AS A MEMBER OF A REVOCATION BOARD

OR A BOARD OF APPEAL OF THE EUROPEAN PATENT OFFICE.

RESOLUTION

CONCERNING PRIOR USE OR POSSESSION

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY

,
UPON SIGNATURE OF THE COMMUNITY PATENT CONVENTION ,

DESIRING TO ENABLE THOSE WHO HAVE USED OR POSSESSED AN INVENTION THE SUBJECT-MATTER OF A COMMUNITY PATENT BEFORE THE DATE OF FILING OR , WHERE PRIORITY HAS BEEN CLAIMED , THE DATE OF PRIORITY OF THAT PATENT TO AVAIL THEMSELVES UNDER UNIFORM CONDITIONS OF A RIGHT , BASED ON SUCH USE OR POSSESSION , THROUGHOUT THE TERRITORIES OF THE CONTRACTING STATES ,

RECOGNIZING THAT FULFILMENT OF THIS AIM WILL REQUIRE A REVISION OF ARTICLE 38 OF THE CONVENTION ,

HAVE DECIDED TO COMMENCE IN GOOD TIME THE PROCEDURE FOR REVISING THIS CONVENTION IN ORDER TO CREATE A RIGHT , BASED ON PRIOR USE OR POSSESSION OF AN INVENTION THE SUBJECT-MATTER OF A COMMUNITY PATENT , WHICH SHALL HAVE UNIFORM EFFECT THROUGHOUT THE TERRITORIES OF THE CONTRACTING STATES.

RESOLUTION

ON COMMON RULES ON THE GRANTING OF COMPULSORY LICENCES IN RESPECT OF COMMUNITY PATENTS

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY

,
UPON SIGNATURE OF THE COMMUNITY PATENT CONVENTION ,

DESIRING TO REINFORCE THE UNITARY CHARACTER OF COMMUNITY PATENTS BY RULES PROVIDING THAT COMPULSORY LICENCES IN RESPECT OF THOSE PATENTS ARE TO BE GRANTED BY COMMON AUTHORITIES ON THE BASIS OF CRITERIA LAID DOWN IN THOSE RULES ,

RECOGNIZING NEVERTHELESS THAT IT IS NECESSARY FOR THE CONTRACTING STATES TO BE ABLE TO GRANT COMPULSORY LICENCES IN RESPECT OF COMMUNITY PATENTS WITHIN THE MEANING OF ARTICLE 46 (4) OF THE CONVENTION , IN THE PUBLIC INTEREST , FOR EXAMPLE IN THE INTEREST OF NATIONAL DEFENCE

WHEREAS , WITH THIS PROVISIO , THE RETENTION OF POWERS OF THE NATIONAL AUTHORITIES TO GRANT COMPULSORY LICENCES IN RESPECT OF COMMUNITY PATENTS CAN ONLY BE ENVISAGED FOR A SHORT TRANSITIONAL PERIOD BECAUSE OF FUNDAMENTAL LEGISLATIVE DIFFERENCES AFFECTING THE FREE MOVEMENT OF GOODS PROTECTED BY PATENTS AND THE ELIMINATION OF THE DISTORTION OF COMPETITION ,

HAVE DECIDED TO COMMENCE THE WORK , AS SOON AS THE CONVENTION ENTERS INTO FORCE , TO ENABLE THE CONVENTION TO BE SUPPLEMENTED BY COMMON RULES ON THE GRANTING OF COMPULSORY LICENCES IN RESPECT OF COMMUNITY PATENTS .

RESOLUTION

ON THE CENTRALIZATION IN EACH CONTRACTING STATE OF JURISDICTION IN ACTIONS FOR INFRINGEMENT OF COMMUNITY PATENTS

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

UPON SIGNATURE OF THE COMMUNITY PATENT CONVENTION ,

DESIRING TO PROMOTE , AS FAR AS POSSIBLE , UNIFORMITY OF JUDICIAL PRACTICE IN EACH CONTRACTING STATE IN RESPECT OF ACTIONS FOR INFRINGEMENT OF COMMUNITY PATENTS ,

RECOGNIZING THAT THERE IS A NEED FOR JUDGES EXPERIENCED IN SUCH ACTIONS IN ALL THE CONTRACTING STATES ,

HAVE DECIDED TO TAKE THE NECESSARY MEASURES AT THE EARLIEST OPPORTUNITY TO ARRIVE , SO FAR AS POSSIBLE , AT THE CENTRALIZATION IN THEIR RESPECTIVE TERRITORIES OF FIRST INSTANCE JURISDICTION IN RESPECT OF THE INFRINGEMENT OF COMMUNITY PATENTS SO AS THEREBY TO GUARANTEE THAT SUCH ACTIONS WILL BE DEALT WITH BY JUDGES EXPERIENCED IN THIS FIELD .

RESOLUTION

ON LITIGATION OF COMMUNITY PATENTS

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

UPON SIGNATURE OF THE COMMUNITY PATENT CONVENTION ,

CONSCIOUS OF THE PROBLEM OF DEALING EFFECTIVELY WITH ACTIONS RELATING TO COMMUNITY PATENTS ,

CONSCIOUS ALSO OF THE PROBLEMS ARISING FROM A SEPARATION OF JURISDICTION IN RESPECT OF INFRINGEMENT AND VALIDITY OF COMMUNITY PATENTS ,

HAVING REGARD TO ARTICLE 90 (5) OF THE CONVENTION ,

HAVE DECIDED TO COMMENCE , AS SOON AS POSSIBLE AFTER SIGNATURE OF THE CONVENTION , THE NECESSARY WORK TO PROVIDE A SOLUTION TO THE ABOVE PROBLEMS , SUCH A SOLUTION TO BE EMBODIED IF POSSIBLE IN A PROTOCOL WHICH SHOULD BE CONCLUDED BEFORE ANY LITIGATION ON COMMUNITY PATENTS TAKES PLACE AND AT THE LATEST WITHIN 10 YEARS FROM THE DATE OF SIGNING OF THE CONVENTION ,

HAVE DECIDED FURTHER THAT , WITH A VIEW TO IMPLEMENTING THAT DECISION , A WORKING PARTY SHALL BE ESTABLISHED BY THE SIGNATORY STATES WITHOUT DELAY AFTER SIGNATURE OF THIS CONVENTION.

RESOLUTION

ON THE ADJUSTMENT OF NATIONAL PATENT LAW

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

UPON SIGNATURE OF THE COMMUNITY PATENT CONVENTION ,

NOTING WITH SATISFACTION THAT THE ENTRY INTO FORCE OF THE CONVENTION WILL RESULT IN A DESIRABLE UNIFICATION OF PATENT LAW THROUGHOUT THE TERRITORIES OF THE CONTRACTING STATES ,

RECOGNIZING NEVERTHELESS THAT THE DIFFERENCES BETWEEN THE LAWS IN THE

CONTRACTING STATES RELATING TO NATIONAL PATENTS AND THE PROVISIONS OF THE CONVENTION COULD ENTAIL A DUALITY OF STANDARDS IN PATENT LAW IN THOSE STATES ,

HAVE DECIDED TO COMMENCE THE WORK , AS SOON AS THE CONVENTION HAS BEEN SIGNED , TO ADJUST THEIR LAWS RELATING TO NATIONAL PATENTS AS SOON AS POSSIBLE SO AS TO PERMIT RATIFICATION OF THE STRASBOURG CONVENTION ON THE UNIFICATION OF CERTAIN POINTS OF SUBSTANTIVE LAW ON PATENTS FOR INVENTION , AND SO AS TO BRING THEIR LAWS INTO CONFORMITY , AS FAR AS PRACTICABLE , WITH CORRESPONDING PROVISIONS OF THE EUROPEAN PATENT CONVENTION , COMMUNITY PATENT CONVENTION AND THE PATENT COOPERATION TREATY.

DECLARATION

ON THE RATIFICATION OF THE PATENT COOPERATION TREATY

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

UPON SIGNATURE OF THE COMMUNITY PATENT CONVENTION ,

DESIRING TO PROMOTE THE INITIAL ENTRY INTO FORCE OF THE PATENT COOPERATION TREATY AT AN EARLY DATE AND PREFERABLY AT THE SAME TIME AS THAT OF THE EUROPEAN PATENT CONVENTION ,

DECLARE THAT EACH INTENDS TO DEPOSIT ITS INSTRUMENT OF RATIFICATION OF THE PATENT COOPERATION TREATY AT THE SAME TIME AS ITS INSTRUMENT OF RATIFICATION OF THE EUROPEAN PATENT CONVENTION OR AS SOON AS POSSIBLE THEREAFTER ,

DECLARE FURTHER THAT THEY INTEND TO CONSULT , AS NECESSARY , WITH EACH OTHER IN THIS MATTER , IN PARTICULAR ON THE CONTENT OF ANY DECLARATIONS TO BE MADE BY THEM UNDER ARTICLE 64 OF THE PATENT COOPERATION TREATY.

DECLARATION

ON THE RATIFICATION OF THE COMMUNITY PATENT CONVENTION

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

UPON SIGNATURE OF THE COMMUNITY PATENT CONVENTION ,

DECLARE THAT THEY INTEND TO SEEK RATIFICATION OF THE CONVENTION AS SOON AS POSSIBLE SO AS TO MINIMIZE THE INTERVAL BETWEEN ENTRY INTO FORCE OF THE CONVENTION AND OF THE EUROPEAN PATENT CONVENTION.

DECISION

ON PREPARATIONS FOR THE COMMENCEMENT OF THE ACTIVITIES OF THE SPECIAL DEPARTMENTS OF THE EUROPEAN PATENT OFFICE

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

UPON SIGNATURE OF THE COMMUNITY PATENT CONVENTION ,

DESIRING TO TAKE ALL APPROPRIATE MEASURES TO ENABLE THE SPECIAL DEPARTMENTS OF THE EUROPEAN PATENT OFFICE , IN THE INTERESTS OF THE ESTABLISHMENT OF A COMMUNITY PATENT SYSTEM , TO BEGIN THEIR ACTIVITIES IN DUE TIME ,

HAVE ADOPTED THE FOLLOWING DECISION :

1 . AFTER THE CONCLUSION OF THIS CONFERENCE A COMMUNITY PATENT INTERIM COMMITTEE , COMPRISING REPRESENTATIVES OF ALL THE MEMBER STATES AND OF THE COMMISSION OF THE EUROPEAN COMMUNITIES , SHALL BE SET UP ; ARTICLES 15 , 16 , 19 , 21 AND 22 (1) AND (3) OF THE COMMUNITY PATENT CONVENTION SHALL APPLY MUTATIS MUTANDIS TO THIS INTERIM COMMITTEE. THE INTERIM COMMITTEE MAY DRAW UP RULES OF PROCEDURE TO SUPPLEMENT THESE PROVISIONS. THE INTERIM COMMITTEE SHALL BE DISBANDED WHEN THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL MEETS PURSUANT TO ARTICLE 91 (1) (A) OF THE CONVENTION.

2 . IT SHALL BE THE DUTY OF THE INTERIM COMMITTEE TO TAKE ALL PREPARATORY MEASURES TO ENABLE THE SPECIAL DEPARTMENTS OF THE EUROPEAN PATENT OFFICE TO BEGIN THEIR ACTIVITIES IN DUE TIME.

3 . THE PREPARATIONS FOR THE COMMENCEMENT OF THE ACTIVITIES OF THE SPECIAL DEPARTMENTS OF THE EUROPEAN PATENT OFFICE MAY BE CARRIED OUT BY WORKING PARTIES.

4 . THE INTERIM COMMITTEE MAY INVITE INTER-GOVERNMENTAL AND INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS TO ATTEND ITS MEETINGS AND THOSE OF THE WORKING PARTIES AS OBSERVERS.

5 . THE SECRETARY-GENERAL OF THE COUNCIL OF THE EUROPEAN COMMUNITIES SHALL ISSUE THE INVITATIONS TO THE INAUGURAL MEETING OF THE INTERIM COMMITTEE .

COUNCIL RESOLUTION

OF 15 DECEMBER 1975

ON THE CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON MARKET

THE COUNCIL OF THE EUROPEAN COMMUNITIES ,

HAVING REGARD TO THE TREATY ESTABLISHING THE EUROPEAN ECONOMIC COMMUNITY ,

WHEREAS THE REPRESENTATIVES OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY HAVE THIS DAY SIGNED A CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON MARKET ;

WHEREAS THE COUNCIL IS OF THE OPINION AND THE REPRESENTATIVES OF THE MEMBER STATES HAVE DECLARED IN THE PREAMBLE TO THE CONVENTION THAT THE CONCLUSION OF THE CONVENTION IS NECESSARY TO FACILITATE THE ACHIEVEMENT OF THE TASKS OF THE EUROPEAN ECONOMIC COMMUNITY AND THAT THEREFORE IT IS AN APPROPRIATE MEASURE TO BE TAKEN BY THE MEMBER STATES , SUBJECT TO NATIONAL RATIFICATION PROCEDURES , TO ENSURE FULFILMENT OF COMMUNITY OBLIGATIONS ,

RESOLVES THAT THE MEMBER STATES SHOULD BECOME PARTIES TO THE CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON MARKET AND TAKE ALL SUCH MEASURES AS MAY BE NECESSARY TO ENSURE ITS IMPLEMENTATION .Decision on preparations for the commencement of the activities of the special departments of the European Patent Office.

The Plenipotentiaries have also drawn up and adopted for signature the following :

Supplementary Protocol to the Protocol of 13 April 1962 on the setting-up of European schools ;

Protocol of provisional application of the Supplementary Protocol to the Protocol of 13 April 1962 on the setting-up of European schools .

ANNEX

RESOLUTION

ON THE APPOINTMENT OF THE CHAIRMEN OF THE REVOCATION BOARDS

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

Upon signature of the Community Patent Convention ,

DECLARE that , as a general rule , a person appointed as chairman of a Revocation Board as provided for in Article 11 of the Convention , should be a person possessing several years' experience in industrial property , for example as a member of an ordinary court or tribunal or of a court specialized in this field in a Contracting State , or as a member of any national patent office of a Contracting State who is empowered to decide in revocation or appeal proceedings , or as a member of a Revocation Board or a Board of Appeal of the European Patent Office.

RESOLUTION

CONCERNING PRIOR USE OR POSSESSION

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

Upon signature of the Community Patent Convention ,

Desiring to enable those who have used or possessed an invention the subject-matter of a Community patent before the date of filing or , where priority has been claimed , the date of priority of that patent to avail themselves under uniform conditions of a right , based on such use or possession , throughout the territories of the Contracting States ,

Recognizing that fulfilment of this aim will require a revision of Article 38 of the Convention ,

HAVE DECIDED to commence in good time the procedure for revising this Convention in order to create a right , based on prior use or possession of an invention the subject-matter of a Community patent , which shall have uniform effect throughout the territories of the Contracting States.

RESOLUTION

ON COMMON RULES ON THE GRANTING OF COMPULSORY LICENCES IN RESPECT OF COMMUNITY PATENTS

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

Upon signature of the Community Patent Convention ,

Desiring to reinforce the unitary character of Community patents by rules providing that compulsory licences in respect of those patents are to be granted by common authorities on the basis of criteria laid down in those rules ,

Recognizing nevertheless that it is necessary for the Contracting States to be able to grant compulsory licences in respect of Community patents within the meaning of Article 46 (4) of the Convention, in the public interest, for example in the interest of national defence,

Whereas, with this proviso, the retention of powers of the national authorities to grant compulsory licences in respect of Community patents can only be envisaged for a short transitional period because of fundamental legislative differences affecting the free movement of goods protected by patents and the elimination of the distortion of competition,

HAVE DECIDED to commence the work, as soon as the Convention enters into force, to enable the Convention to be supplemented by common rules on the granting of compulsory licences in respect of Community patents.

RESOLUTION

ON THE CENTRALIZATION IN EACH CONTRACTING STATE OF JURISDICTION IN ACTIONS FOR INFRINGEMENT OF COMMUNITY PATENTS

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY,

Upon signature of the Community Patent Convention,

Desiring to promote, as far as possible, uniformity of judicial practice in each Contracting State in respect of actions for infringement of Community patents,

Recognizing that there is a need for judges experienced in such actions in all the Contracting States,

HAVE DECIDED to take the necessary measures at the earliest opportunity to arrive, so far as possible, at the centralization in their respective territories of first instance jurisdiction in respect of the infringement of Community patents so as thereby to guarantee that such actions will be dealt with by judges experienced in this field.

RESOLUTION

ON LITIGATION OF COMMUNITY PATENTS

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY,

Upon signature of the Community Patent Convention,

Conscious of the problem of dealing effectively with actions relating to Community patents,

Conscious also of the problems arising from a separation of jurisdiction in respect of infringement and validity of Community patents,

Having regard to Article 90 (5) of the Convention,

HAVE DECIDED to commence, as soon as possible after signature of the Convention, the necessary work to provide a solution to the above problems, such a solution to be embodied if possible in a Protocol which should be concluded before any litigation on Community patents takes place and at the latest within 10 years from the date of signing of the Convention,

HAVE DECIDED further that, with a view to implementing that decision, a Working Party shall be established by the signatory States without delay after signature of this Convention.

RESOLUTION

ON THE ADJUSTMENT OF NATIONAL PATENT LAW

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

Upon signature of the Community Patent Convention ,

Noting with satisfaction that the entry into force of the Convention will result in a desirable unification of patent law throughout the territories of the Contracting States ,

Recognizing nevertheless that the differences between the laws in the Contracting States relating to national patents and the provisions of the Convention could entail a duality of standards in patent law in those States ,

HAVE DECIDED to commence the work , as soon as the Convention has been signed , to adjust their laws relating to national patents as soon as possible so as to permit ratification of the Strasbourg Convention on the unification of certain points of substantive law on patents for invention , and so as to bring their laws into conformity , as far as practicable , with corresponding provisions of the European Patent Convention , Community Patent Convention and the Patent Cooperation Treaty.

DECLARATION

ON THE RATIFICATION OF THE PATENT COOPERATION TREATY

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

Upon signature of the Community Patent Convention ,

Desiring to promote the initial entry into force of the Patent Cooperation Treaty at an early date and preferably at the same time as that of the European Patent Convention ,

DECLARE that each intends to deposit its instrument of ratification of the Patent Cooperation Treaty at the same time as its instrument of ratification of the European Patent Convention or as soon as possible thereafter ,

DECLARE further that they intend to consult , as necessary , with each other in this matter , in particular on the content of any declarations to be made by them under Article 64 of the Patent Cooperation Treaty.

DECLARATION

ON THE RATIFICATION OF THE COMMUNITY PATENT CONVENTION

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY ,

Upon signature of the Community Patent Convention ,

DECLARE that they intend to seek ratification of the Convention as soon as possible so as to minimize the interval between entry into force of the Convention and of the European Patent Convention.

DECISION

ON PREPARATIONS FOR THE COMMENCEMENT OF THE ACTIVITIES OF THE SPECIAL DEPARTMENTS OF THE EUROPEAN PATENT OFFICE

THE GOVERNMENTS OF THE MEMBER STATES OF THE EUROPEAN ECONOMIC COMMUNITY

Upon signature of the Community Patent Convention ,

Desiring to take all appropriate measures to enable the special departments of the European Patent Office , in the interests of the establishment of a Community patent system , to begin their activities in due time ,

HAVE ADOPTED THE FOLLOWING DECISION :

1 . After the conclusion of this conference a Community Patent Interim Committee , comprising representatives of all the Member States and of the Commission of the European Communities , shall be set up ; Articles 15 , 16 , 19 , 21 and 22 (1) and (3) of the Community Patent Convention shall apply mutatis mutandis to this Interim Committee. The Interim Committee may draw up Rules of Procedure to supplement these provisions. The Interim Committee shall be disbanded when the Select Committee of the Administrative Council meets pursuant to Article 91 (1) (a) of the Convention.

2 . It shall be the duty of the Interim Committee to take all preparatory measures to enable the special departments of the European Patent Office to begin their activities in due time.

3 . The preparations for the commencement of the activities of the special departments of the European Patent Office may be carried out by Working Parties.

4 . The Interim Committee may invite inter-governmental and international non-governmental organizations to attend its meetings and those of the Working Parties as observers.

5 . The Secretary-General of the Council of the European Communities shall issue the invitations to the inaugural meeting of the Interim Committee.

DOCNUM	41975A3490
AUTHOR	REPRESENTATIVES OF THE MEMBER STATES MEETING IN THE COUNCIL
FORM	CONVENTION
TYPDOC	4 ; SUPPLEMENTARY LEGAL ACTS ; 1975 ; A
PUBREF	Official Journal L 017 , 26/01/1976 p. 0001 - 0043 Spanish special edition...: Chapter 1 Volume 6 p. 10 Portuguese special edition Chapter 1 Volume 6 p. 10
DESCRIPT	European patent ; inter-company agreement ; patent law ; patents licence ; administrative organization
PUB	1976/01/26
DOC	1975/12/15
ENDVAL	1989/12/15

SIGNED 1975/12/15=LUXEMBOURG

MODIFIED CORRECTED-BY.. 41975A3490R(01).....
REPLACED-BY... 41989A0695(01).....

SUB INDUSTRIAL AND COMMERCIAL PROPERTY ; EXTERNAL RELATIONS

REGISTER 17200000

DATES OF DOCUMENT.....: 15/12/1975
OF SIGNATURE.....: 15/12/1975; LUXEMBOURG
OF END OF VALIDITY: 15/12/1989; REPLACED BY 41989A0695(01)

Implementing Regulations to the Convention for the European patent for the common market
IMPLEMENTING REGULATIONS
TO THE CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON
MARKET

PART I

IMPLEMENTING REGULATIONS TO PART I OF THE CONVENTION

CHAPTER I

ORGANIZATION OF THE SPECIAL DEPARTMENTS

Rule 1

Allocation of duties to the departments of the first instance

1. The President of the European Patent Office shall determine the number of Revocation Divisions. He shall allocate duties to these departments by reference to the international classification.
2. The President of the European Patent Office shall, with the agreement of the Select Committee of the Administrative Council, determine in detail the duties for which the Patent Administration Division is responsible pursuant to Article 7.
3. In addition to the responsibilities vested in them under the Convention, the President of the European Patent Office may allocate further duties to the Patent Administration Division and the Revocation Divisions.
4. The President of the European Patent Office may entrust to employees who are not technically or legally qualified members the execution of individual duties falling to the Patent Administration Division or the Revocation Divisions, and involving no technical or legal difficulties.

Rule 2

Administrative structure of the special departments

1. The Revocation Divisions may be grouped together administratively with the Examining Divisions and Opposition Divisions so as to form directorates, or may form a directorate together with the Patent Administration Division.
2. The special departments may be grouped together administratively with other departments of the European Patent Office so as to form Directorates-General or may form a separate Directorate-General; in the latter case, Rule 12 (3) of the Implementing Regulations to the European Patent Convention shall apply, but the appointment of a vice-president to the Directorate-General shall be decided upon by the Select Committee of the Administrative Council.

CHAPTER II

LANGUAGES OF THE SPECIAL DEPARTMENTS

Rule 3

Language of the proceedings

1. Rules 1 to 3, 5, 6 (2) and 7 of the Implementing Regulations to the European Patent Convention shall apply *mutatis mutandis* to proceedings before the special departments.

2. A reduction in the limitation fee, revocation fee or appeal fee shall be allowed the proprietor of a patent or an applicant for revocation who avails himself of the options provided for in Article 10 (4). The reduction shall be fixed in the Rules relating to Fees at a percentage of the total of the fees.

PART II

IMPLEMENTING REGULATIONS TO PART II OF THE CONVENTION

Rule 4

Suspension of proceedings

Rule 13 of the Implementing Regulations to the European Patent Convention shall apply *mutatis mutandis* to limitation proceedings and revocation proceedings.

Rule 5

Entries regarding claims to the right to Community patents

The entries referred to in Article 23 (4) shall be made:

- (a) at the request of the registrar of the court before which the proceedings are instituted;
- (b) at the request of the claimant or any other interested person.

Rule 6

Filing of translations and payment of fees in examination or opposition proceedings

1. When sending the invitation referred to in Rule 51 (6) of the Implementing Regulations to the European Patent Convention, the European Patent Office shall also invite the applicant for the patent to file, within the period set by it, the translations prescribed in Article 29 (1) and to pay, within the same period, the fee for the publication of the translations of the claims.

2. When sending the invitation referred to in Rule 58 (5) of the Implementing Regulations to the European Patent Convention, the European Patent Office shall also invite the proprietor of the patent to file, within the period referred to in the said paragraph, the translations prescribed in Article 29 (2) and to pay the fee for the publication of the translations of the claims.

3. The period for filing the translations prescribed in Article 30 (1) and (2) shall be three months from the date of publication in the Community Patent Bulletin of the mention of the grant of the Community patent or, as the case may be, of the decision on the maintenance of the Community patent in amended form.

4. If the acts required by paragraph 2 are not performed in due time they may still be validly performed within two months of notification of the communication pointing out the failure to observe the time limit, provided that within this two-month period an additional fee in accordance with the Rules relating to Fees is paid.

Rule 7

Forwarding of translations

The European Patent Office shall enter in the Register of Community Patents the date on which the translations prescribed in Article 30 are filed. Copies of the translations shall be forwarded to the central industrial property offices

of the Contracting States concerned by post within the three days following the expiry of the period laid down in Rule 6 (3).

Rule 8

Revision of the translation

The corrected translation provided for in Article 29 (6) shall not have any legal effect until the fee for its publication has been paid.

Rule 9

Registering transfers, licences and other rights

1. Rules 20 to 22 of the Implementing Regulations to the European Patent Convention shall apply mutatis mutandis to entries made in the Register of Community Patents.

2. The request provided for in Article 24 (2) must, in the case of subparagraph (a), be made within two months, or in the case of subparagraph (b), within four months, of receipt of notification from the European Patent Office that the name of a new proprietor has been entered in the Register of Community Patents.

3. Where a Community patent is involved in bankruptcy or like proceedings, an entry to this effect shall be made in the Register of Community Patents on request of the competent national authority. The entry shall not incur a fee.

4. The entry referred to in paragraph 3 shall be deleted at the request of the competent national authority. The request shall not incur a fee.

5. Where a European patent application in which the Contracting States are designated is involved in bankruptcy or like proceedings, paragraphs 3 and 4 shall apply mutatis mutandis but the reference to the Register of Community Patents shall be understood as being a reference to the Register of European Patents provided for in the European Patent Convention.

Rule 10

Licences of right

1. Any person who wishes to use the invention after a statement provided for in Article 43 (1) has been filed, shall declare his intention to the proprietor of the patent by registered letter. The declaration shall be deemed to have been made one week after posting of the registered letter. A copy of this declaration, stating the date upon which the declaration was posted, shall be sent to the European Patent Office. Failing this, the European Patent Office shall, in the event of withdrawal of the statement, consider the declaration not to have been made.

2. The declaration shall state how the invention is to be used. After the declaration has been made, the person making it shall be entitled to use the invention in the way he has stated.

3. The licensee shall be obliged at the end of every quarter of a calendar year to report to the proprietor of the patent on the use made thereof and to pay the compensation therefor. If this obligation is not complied with, the proprietor of the patent may lay down a further suitable time

limit for this purpose. If the time limit is not complied with the licence shall expire.

4. A request for review of the compensation determined by the Revocation Division may be made only after the expiry of one year from the last determination of compensation.

PART III

IMPLEMENTING REGULATIONS TO PART III OF THE CONVENTION

CHAPTER I

RENEWAL FEES

Rule 11

Payment of renewal fees

1. Rule 37 (1) and (2) of the Implementing Regulations to the European Patent Convention shall apply to the payment of renewal fees for Community patents.

2. An additional fee shall be deemed to have been paid at the same time as the renewal fee within the meaning of Article 48 (2) if it is paid within the period laid down in that provision.

Rule 12

Period for the entry of surrender

The period referred to in Article 49 (3) shall be three months from the date on which the proprietor of the patent has proved to the European Patent Office that he has informed the licensee of his intention to surrender. If, before expiry of the period, the proprietor of the patent proves to the European Patent Office that the licensee agrees to the surrender, it may be entered immediately.

CHAPTER II

LIMITATION PROCEDURE

Rule 13

Period for the filing of the request for limitation

Rule 12 shall apply *mutatis mutandis* to the filing of the request for limitation of the Community patent.

Rule 14

Content of the request for limitation

The request for limitation of a Community patent shall contain:

- (a) the number of the Community patent which it is sought to limit, the name of the proprietor and the title of the invention;
- (b) the amendments sought;
- (c) if the proprietor of the patent has appointed a representative, his name and the address of his place of business in accordance with Rule 26 (2) (c) of the Implementing Regulations to the European Patent Convention.

Rule 15

Rejection of the request for limitation as inadmissible

If the Revocation Division notes that the request for limitation of a Community patent does not comply with Article 51 (1) and (3) and Rule 14, it shall communicate this to the proprietor of the patent and shall invite him to remedy the deficiencies noted within such a period as it may specify. If the request for limitation is not corrected in good time, the Revocation Division shall reject it as inadmissible.

Rule 16

Examination of the request for limitation

1. If the request for limitation of the Community patent is admissible, the proprietor of the patent shall, in any communication pursuant to Article 52 (2), where appropriate, be invited to file the description, claims and drawings in amended form.
2. Where necessary, any communication pursuant to Article 52 (2) shall contain a reasoned statement. Where appropriate, this statement shall cover all the grounds against the limitation of the patent.
3. Before the Revocation Division decides on the limitation of the patent, it shall inform the proprietor of the extent to which it intends to limit the patent, and shall request him to pay within three months the fee for printing a new patent specification and to file the translation prescribed in Article 53 (2) (b) within the same period. If within that period the proprietor has communicated his disapproval of the patent being limited to this extent, the communication of the Revocation Division shall be deemed not to have been made, and the limitation proceedings shall be resumed.
4. The further period referred to in Article 53 (3) shall be two months.
5. The decision to limit the patent shall state the text of the patent as limited.

Rule 17

Resumption of limitation proceedings

Where limitation proceedings have been stayed because of revocation proceedings which result in a decision under Article 58 (2) or (3), the Revocation Division, after the publication of the mention of such decision, shall communicate to the proprietor of the patent that the proceedings will be resumed after notification of this

communication to the proprietor. Rule 13 (5) of the Implementing Regulations to the European Patent Convention shall apply *mutatis mutandis*.

Rule 18

Different claims, description and drawings in the case of limitation

Where it is decided to limit a Community patent in respect of one or some of the Contracting States, the Community patent may, where appropriate, contain, for that State or States, claims and, if the Revocation Division considers it necessary, a description and drawings which are different from those for the other Contracting States.

Rule 19

Form of the new specification following limitation proceedings

The President of the European Patent Office shall prescribe the form of the publication of the new specification of the Community patent and the data which are to be included.

CHAPTER III

REVOCATION PROCEDURE

Rule 20

Content of the application for revocation

An application for revocation of a Community patent shall contain:

- (a) the name and address of the applicant for revocation and the State in which his residence or principal place of business is located, in accordance with Rule 26 (2) (c) of the Implementing Regulations to the European Patent Convention;
- (b) the number of the patent in respect of which revocation is applied for, the name of the proprietor and the title of the invention;
- (c) a statement of the extent to which revocation is applied for and of the grounds on which the application is based as well as an indication of the facts, evidence and arguments presented in support of these grounds;
- (d) if the applicant has appointed a representative, his name and the address of his place of business, in accordance with Rule 26 (2) (c) of the Implementing Regulations to the European Patent Convention.

Rule 21

Security for the costs of proceedings

The security for the costs of the proceedings shall be deposited in a currency in which fees may be paid. It must be deposited with a financial or banking establishment included

in the list drawn up by the President of the European Patent Office. The national law of the Contracting State in which the establishment has its place of business shall apply to any such security.

Rule 22

Rejection of the application for revocation as inadmissible

1. The Revocation Division shall communicate the application for revocation to the proprietor of the patent who may comment on its admissibility within one month.

2. If the Revocation Division notes that the application for revocation does not comply with Article 55 (1) and (4) and Rule 20, as well as Rule 3 of these Implementing Regulations in conjunction with Rule 1 (1) of

the Implementing Regulations to the European Patent Convention, it shall communicate this to the proprietor and to the applicant and shall invite the applicant to remedy the deficiencies noted within such period as it may specify. If the application for revocation is not corrected in good time, the Revocation Division shall reject it as inadmissible.

3. Any decision to reject an application for revocation as inadmissible shall be communicated to the proprietor of the patent.

Rule 23

Preparation of the examination of the application for revocation

1. If the application for revocation is admissible, the Revocation Division shall invite the proprietor of the patent to file his observations and to file amendments, where appropriate, to

the description, claims and drawings within a period to be fixed by the Revocation Division.

2. The observations and any amendments filed by the proprietor of the patent shall be communicated to the applicant who shall be invited by the Revocation Division, if it considers it expedient, to reply within a period to be fixed by the Revocation Division.

Rule 24

Examination of the application for revocation

1. All communications issued pursuant to Article 57 (2) and all replies thereto shall be communicated to all parties.

2. In any communication from the Revocation Division to the proprietor of the patent pursuant to Article 57 (2), he shall, where appropriate, be invited to file the description, claims and drawings in amended form.

3. Where necessary, any communication from the Revocation Division to the proprietor of the patent pursuant

to Article 57 (2) shall contain a reasoned statement. Where appropriate, this statement shall cover all the grounds against the maintenance of the Community patent.

4. Before the Revocation Division decides on the maintenance of the patent in the amended form, it shall inform the parties that it intends to maintain the patent as amended and shall invite them to state their observations within a period of one month if they disapprove of the text in which it is intended to maintain the patent.

5. If disapproval of the text communicated by the Revocation Division is expressed, examination of the revocation may be continued; otherwise, the Revocation Division shall, on expiry of the period referred to in paragraph 4, request the proprietor of the patent to pay within three months the fee for the printing of a new specification and to file the translations prescribed in Article 58 (3) (b) within the same period.

6. The further period referred to in Article 58 (4) shall be two months.

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

Rule 25

Joint processing of applications for revocation

1. The Revocation Division may order that two or more applications for revocation pending before it and relating to

the same Community patent be dealt with jointly in order to carry out a joint investigation and take a joint decision.

2. The Revocation Division may rescind an order given pursuant to paragraph 1.

Rule 26

Different claims, description and drawings in the case of revocation

Where revocation of a Community patent is pronounced in respect of one or more of the Contracting States, Rule 18 shall apply *mutatis mutandis*.

Rule 27

Form of the new specification following revocation proceedings

Rule 19 shall apply to the new specification of the Community patent referred to in Article 59.

Rule 28

Other provisions applicable to revocation proceedings

Rules 59, 60 and 63 of the Implementing Regulations to the European Patent Convention shall apply mutatis mutandis to requests for documents, continuation of revocation proceedings by the European Patent Office of its own motion and costs in revocation proceedings.

PART IV

IMPLEMENTING REGULATIONS TO PART V OF THE CONVENTION

Rule 29

Entries in the Register of Community Patents

1. Rule 92 (1) (a) to (l), (o), (q) to (u) and (w), (2) and

(3) of the Implementing Regulations to the European Patent Convention shall apply mutatis mutandis to the Register of Community Patents.

2. The Register of Community Patents shall also contain the following entries:

(a) date of lapse of the Community patent in the cases provided for in Article 50 (1) (b) and (c);

(b) date of filing of the statement provided for in Article 43;

(c) date of receipt of a request for limitation of the Community patent;

(d) date and purport of the decision on the request for limitation of the Community patent;

(e) date of receipt of an application for revocation of the Community patent;

(f)

date and purport of the decision on the application for revocation of the Community patent;

(g)

particulars of matters referred to in Article 23 (4);

(h)

a record of the information communicated to the European Patent Office concerning proceedings under the Protocol on Litigation.

Rule 30

Additional publications by the European Patent Office

The President of the European Patent Office shall determine in what form the translations filed pursuant to the

Convention by the applicant for or proprietor of a patent and, where appropriate, corrected translations, shall be published and whether particulars of such translations and corrected translations should

be entered in the Community Patent Bulletin.

Rule 31

Other common provisions

Rules 36 and 106 and the provisions of Part VII of the Implementing Regulations to the European Patent

Convention, with the exception of Rules 85 (3), 86, 87, 92 and 96, shall apply mutatis mutandis subject to the following:

- (a) Rule 69 shall not apply to decisions on requests for limitation or on applications for revocation of the Community patent;
- (b) the Select Committee of the Administrative Council shall determine the details of the application of Rule 74 (2) and (3);
- (c) the term 'Contracting States' shall be understood as meaning the States parties to this Convention.

PART V

IMPLEMENTING REGULATIONS TO PART VIII OF THE CONVENTION

Rule 32

Option between a Community patent and a European patent

1. The statement referred to in Article 81 (1) must be filed, and the fees paid, before or when the applicant approves, in accordance with Rule 51 (4) of the Implementing Regulations to the European Patent Convention, the text in which the patent is to be granted.

2. The prescribed fees referred to in Article 81 (1) shall consist of:

- (a) an additional fee in accordance with the Rules relating to Fees; and
- (b) if the designation of more than three Contracting States is to be maintained, the currently prescribed designation fee for each additional Contracting State over and above the first three.

DOCNUM	41989A0695(02)
AUTHOR	REPRESENTATIVES OF THE MEMBER STATES MEETING IN THE COUNCIL ; COUNCIL
FORM	VARIOUS ACTS
TYPDOC	4 ; SUPPLEMENTARY LEGAL ACTS ; 1989 ; A
PUBREF	Official Journal L 401 , 30/12/1989 p. 0028 - 0033
DESCRIPT	European patent ; EPO ; European convention ; administrative organization

; patents licence ; industrial property

PUB 1989/12/30

DOC 1989/12/15

ENDVAL 9999/99/99

MODIFIES 41989A0695(01).....LINKAGE.....

SUB INDUSTRIAL AND COMMERCIAL PROPERTY ; EXTERNAL RELATIONS

REGISTER 17200000

AUTLANG GERMAN ; ENGLISH ; DANISH ; SPANISH ; FRENCH ; GREEK ;
GAELIC ; ITALIAN ; DUTCH ; PORTUGUESE

DATES OF DOCUMENT.....: 15/12/1989
OF END OF VALIDITY: 99/99/9999

**Council Resolution
of 15 December 1975
on the Convention for the European patent for the Common Market**

COUNCIL RESOLUTION of 15 December 1975 on the Convention for the European patent for the common market

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community,

Whereas the representatives of the Member States of the European Economic Community have this day signed a Convention for the European patent for the common market;

Whereas the Council is of the opinion and the representatives of the Member States have declared in the preamble to the Convention that the conclusion of the Convention is necessary to facilitate the achievement of the tasks of the European Economic Community and that therefore it is an appropriate measure to be taken by the Member States, subject to national ratification procedures, to ensure fulfilment of Community obligations,

RESOLVES that the Member States should become parties to the Convention for the European patent for the common market and take all such measures as may be necessary to ensure its implementation.

DOCNUM	31976G0126
AUTHOR	Council
FORM	Resolution
TREATY	European Economic Community
TYPDOC	3 ; secondary legislation ; 1976 SEC_3_TYP_G
PUBREF	Official Journal L 017 , 26/01/1976 P. 0043 - 0043
DESCRIPT	common market ; European patent ; European convention
PUB	1976/01/26
DOC	1975/12/15
INFORCE	1975/12/15=EV
ENDVAL	9999/99/99
LEGBASE	11957E.....
LEGCIT	41975A3490.....
SUB	Competition ; Free movement of goods

REGISTER

17200000

DATES

of document: 15/12/1975

of effect: 15/12/1975; Entry into force Date of document

end of validity: 99/99/9999

**75/597/EEC: Commission Opinion
of 26 September 1975
on the draft Convention for the European Patent for the common market**

COMMISSION OPINION of 26 September 1975 on the draft Convention for the European Patent for the common market (75/597/EEC)

1. In its Opinion of 4 April 1974 the Commission made known its general views on the draft Convention for the European patent for the Common Market (Community patent) and stated that the "Protocol on the deferred Application of the Provisions on the Exhaustion of Rights attached to Community Patents and National Patents" was basically incompatible with Community law. The Opinion was delivered with a view to the intergovernmental Conference due to take place between 6 and 28 May 1974 and in the course of which the draft Convention was to be finally adopted. This Conference was adjourned at the request of the United Kingdom government. It will now take place in Luxembourg from 17 November to 15 December 1975.

The Commission, noting that a proposal for amendment of the rules forbidding partitioning of the Common Market by means of patents (Arts. 32 and 78) is to be submitted to the Luxembourg Conference (1), and no decision has yet been taken concerning the abovementioned Protocol, would now take this opportunity to deliver a new Opinion.

I

The Working Party on Community Patent has proposed two important amendments to the draft Convention on the European Patent.

2. In its previous version, the draft provided that designation of a Member State of the Community in an application for a European patent results automatically in the grant of a Community patent with effect throughout the Member States.

The new Article 84a of the draft provides that, during a transitional period of ten years, an applicant for a patent will have a choice between a Community patent and a European patent. The applicant may state that he wants a patent only in one or more Member States. If, for example, he makes such a statement and designates Germany and France in the application, he obtains a European patent for these two countries which has the effect of a national patent only.

The Commission regrets this amendment. It still considers it essential that the procedure for the grant of a European patent in which a Member State is designated should lead only to the grant of a Community patent whose scope extends to all the Member States and which is subject to the uniform law created by the Convention for a Community patent.

The Commission considers that there is no convincing reason for allowing the holder of a patent to have such a choice as mentioned above and that it derogates from an important principle of the Convention.

3. The second amendment also entails the abandonment of an important principle.

In the previous draft it was provided that the European Patent Office has sole jurisdiction to cancel the Community patent with effect for all the Member States. The new Article 84b of the draft provides, however, that national courts before which an infringement action has been taken may also decide on the (1) c. f. preparatory document No 17 for the Luxembourg Conference (Doc. R 416/74) p. 2. validity of a Community patent. Such a decision has effect only in the territory of the State over which the court has jurisdiction.

By virtue of this new provision national courts can decide on the validity of the patent, with the result that the Community patent may be considered valid in one Member State and void in another. The principle laid down in Article 2 of the draft, whereby the Community patent is to have the

same effect in all the Member States, is thus contravened. Furthermore, abandonment of the unitary character of the Community patent creates obstacles to the free movement of patented goods and to the creation of equal conditions of competition and also is at variance with the principle of the "free movement" of judgments under the Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters.

The Commission is not unaware of the difficulties which may result from the division of jurisdiction concerning infringement and validity actions. However, in accordance with a draft resolution submitted to the Luxembourg Conference, the work necessary for the resolution of these difficulties is to be undertaken after signature of the Convention.

The Commission considers that it is in the context of that work that a solution should be found which will ensure the unitary character of the European patent.

II

4. The provisions of Articles 32 and 78 are designed to ensure that a patent product put on the market in any Member State by the holder of a Community patent or by the holder of one or more parallel national patents may move freely throughout the territory of the Community. The partitioning of the common market into nine national markets is thus forbidden.

5. Under a proposal submitted to the Luxembourg Conference, the scope of these two Articles is to be limited. This proposal provides that a patentee may prohibit the import of goods which have been put on the market by himself or with his consent in a Member State in which the Community patent has no effect (on account of the existence of a prior national patent opposed to it) or in which a parallel national patent does not exist. In order to justify this proposal it is suggested that a patentee who puts his products on the market in a country where they are not protected by a patent would have to take account of the prices charged by his competitors in that country, and would thus be deprived of the profit due to his creativity.

6. It is true that in certain cases the patentee may be forced to sell his products more cheaply in a country where he has no patent if a third party is able to market the subject of the invention in that country at a lower price.

As a result, if goods put on the market by a patentee in a country where there is no protection are imported into those countries where that patentee holds parallel patents, his profit may be reduced. It is not however the purpose of the law of patents to guarantee to the patentee a higher profit than that which can be derived from the market price. A patentee is only granted, for a certain period, the exclusive right to forbid anybody to make and market the subject of his invention. This exclusive right is the counterpart of the fact that application for a patent makes the invention accessible to the public. The opportunity for the patentee to obtain an additional profit in selling his product depends in particular on his market position and on the existence of substitute products. On patent law grounds alone, the proposal concerning Article 78 should be rejected.

7. Furthermore, this proposal is incompatible with the EEC Treaty, as it envisages free movement of patented goods only where parallel national patents exist in all the Member States. In practice this would never happen or would happen only very rarely. According to forecasts of the number of applications for European patents which will be made every year a firm will apply for a European patent when it holds national patents in two or more Member States of the EEC ; thus as a general rule national patents will exist only in one or two Member States.

It is therefore clear that the proposed amendment would in the ordinary course of events lead to a partitioning of the market as regards products put on the market by the patentee or by a third party with his consent in a part of the Community where those products are not protected.

Such a partitioning of the market could be of advantage to a patentee, particularly where his productive capacity is sufficient to cover the needs of the common market as a whole, and in the Member States in which he has no national patent he has no serious competition for technical or economic reasons. In such cases the amendment of Article 78 which is proposed would enable the patentee to maintain different price levels in two separate areas of the common market by putting a part of his production on the market directly in the territory in which no protection exists. The patentee could then, by means of an infringement action, prevent the importation of those products into that part of the common market in which they are patented.

The result of the abovementioned proposal is incompatible with one of the fundamental aims of the EEC Treaty, namely the creation of conditions in regard to free movement of goods within the Community which are identical to those which exist in a domestic market. It is therefore essential to maintain the present solution, which prevents a patentee from dividing common market into two separate areas through his choice of the place in which he puts his products on the market.

8. In its Opinion No 74/209/EEC (1) of 4 April 1974, paragraph 11, last subparagraph addressed to the Member States, the Commission declared that Community law forbade the holder of a patent to exercise his exclusive right to oppose importation of a protected product into a Member State when that product has already been put on the market by himself or with his consent in another Member State.

9. In its decision of 8 June 1971, in the *Deutsche Grammophongesellschaft (DGG) case (Recueil) XVII, 487*, the Court of Justice of the European Communities has already stated (p. 500):

"If a protection right analogous to copyright is used in order to prohibit in one Member State the marketing of goods that have been brought into the market by the holder of the right or with his consent in the territory of another Member State solely because this marketing has not occurred in the domestic market, such a prohibition maintaining the isolation of the national markets conflicts with the essential aim of the Treaty, the integration of the national markets into one uniform market. This aim could not be achieved if by virtue of the various legal systems of the Member States private persons were able to divide the market and cause arbitrary discriminations or disguised restrictions in trade between the Member States.

Accordingly, it would conflict with the provisions regarding the free movement of goods in the common market if manufacturer of recordings exercised the exclusive right granted to him by the legislation of a Member State to market the protected articles in order to prohibit the marketings in that Member State of products that had been sold by him himself or with his consent in another Member State solely because this marketing had not occurred in the territory of the first Member State."

The phrase "in order to prohibit the marketing in that Member State of products that had been sold by him himself or with his consent in another Member State", shows clearly that it matters little whether, when the goods were put on the market for the first time, it was in a State in which a parallel patent existed or not. In the DGG case the manufacturer of records did not have an exclusive parallel right in the State in which the goods were first put on the market (France).

10. The decision of the Court of Justice in *Centrafarm v. Sterling Drug case 15/74 of 31 October 1974*, confirms the interpretation by the Commission of the DGG decision, namely that the principles enunciated in the latter case apply also to patents. In regard to the question raised here the Court of Justice declared in the *Sterling Drug case (ECR 1974-6 p. 1147)*, p. 1163:

"In fact, if a patentee could prevent the import of protected products marketed by him or with his consent in another Member State, he would be able to partition off national markets and thereby restrict trade between Member States, in a situation where no such restriction was necessary

to guarantee the essence of the exclusive right flowing from the parallel patents.

The question referred should therefore be answered to the effect that the exercise, by a patentee, of the right which he enjoys under the legislation of a Member State to prohibit the sale, in that State, of a product protected by the patent which has been marketed in another Member State by the patentee or with his consent is incompatible with the rules of the EEC Treaty concerning the free movement of goods within the common market".

11. The proposal for amendment cannot be defended on the ground that the Sterling Drug case was concerned with products imported from a Member State in which a parallel patent existed. In fact the reasons given for this decision, like those in the DGG decision (a case in which a parallel exclusive right did not exist), are based solely on the fact that the putting of the goods on the market took place in another Member State independently of the existence or absence of parallel protection.

The Sterling Drug decision contains furthermore a statement which dispels all doubt. In discussing the conditions in which a patentee may prohibit imports under Article 36 of the EEC Treaty, the Court of Justice takes the view that the patentee may, by means of an infringement action, oppose importation of "a product coming from a Member State where it is not patentable and has been manufactured by third parties without the consent of the patentee". It follows that the patentee cannot forbid importation of products from a Member State in which the product cannot be patented but where it has been put on the market by a third party with his consent. This is also the case if the patentee himself puts the product on the market in a Member State in which parallel protection does not exist.

12. The same considerations apply to the proposed amendment to Article 32 : free circulation of goods must also be guaranteed when the holder of a Community patent puts the patented goods on the market in a Member State in which his patent has no effect.

(1) JO No L 109, 23.4.1974, p. 34. 13. Consequently a limitation of the scope of Articles 32 and 78 of the draft Convention would be contrary to the provisions of the EEC Treaty.

The Commission is also of the opinion that the scope of Article 78 should be extended. Under Article 78 (2) the free circulation of goods is also ensured where two or more persons who have economic connections with each other hold different national patents for the same invention. This rule includes those cases in which legally independent subsidiaries and their parent company are holders of different national patents for the same invention.

14. However, Article 78 does not cover the case where the holder of two or more parallel national patents assigns one of these to a third party with which he has no "economic connection". Article 78 in its present form thus permits partitioning of the common market through the assignment of a national patent to a third party who is economically independent of the assignor. This procedure may be used to circumvent the rules which guarantee the free movement of patented goods.

So far, the Court of Justice has not had to declare itself in such a case. In the *Centrafarm v. Sterling Drug* case it nevertheless gave a clear indication of what the solution to this problem might be. The Court of Justice declared that Article 36 of the Treaty allows derogations to be made to the principle of free circulation of goods "in cases where there exist patents, the original proprietors of which are legally and economically independent". By original proprietors is meant persons who have made an invention independently of each other and who have obtained a patent for that invention.

In the case in question here the person to whom a patent has been assigned is not the original proprietor of a patent. He is only the holder of a derived right which he has acquired as a result

of the assignment. Thus an exception to the principle of free circulation of goods cannot be justified where there is an assignment of a national patent.

There is no obvious justification for treating someone who acquired a national patent as a result of an assignment differently from the holder of an exclusive licence, which from a commercial point of view is very close to an assignment. It is to be feared that, where until now an exclusive licence was granted, assignment will be used. This could have the effect of effectively partitioning national markets.

Such a result is incompatible with the principle of free circulation of goods. For this reason the Commission takes the view, for which it finds support in the decisions of the Court of Justice, that assignment of a licence to a third party economically independent of the assignor cannot be allowed to lead to partitioning of the market. Similar provisions should apply to any case where an invention which has not yet been patented is assigned to a third party who applies under his own name for a patent in respect of that invention.

The Commission therefore proposes that Article 78 (2) be amended to read as follows:

The provisions of paragraph 1 shall apply also in respect of a product put on the market by the proprietor of a national patent, granted for the same invention in another Contracting State, to whom the right to the patent or the patent itself has been assigned by the proprietor of the patent referred to in paragraph 1. (The second sentence is deleted).

III

15. The Commission reiterates the view expressed in its first Opinion, that the "Protocol on the deferred Application of the Provisions on the Exhaustion of Rights attached to Community Patents and National Patents" is contrary to Community law. This Protocol provides that the provisions of Article 32 and 78, which forbid the partitioning of markets, will not be applicable during a transitional period of five to ten years, maximum.

The adoption of this Protocol would allow a patentee to control the marketing of his products within the common market. By taking an infringement action against the importers of products which he himself or his licensee has put on the market in another Member State he can protect national markets and charge different prices in each Member State.

In accordance with the interpretation given by the Court of Justice of the European Communities in the *Deutsche Grammophon* and *Sterling Drug* cases, Community law forbids a patent holder to exercise his exclusive right to oppose importation into a Member State of a patented product when that product was put on the market by him or with his consent in another Member State.

IV

16. The Commission, acting on the considerations hereinbefore set out and in pursuance of its powers under Article 155 of the EEC Treaty, hereby expresses itself in favour of signature by the Member States of the European Communities of the Convention for the European Patent for the common market, but at the same time declares that it is not in favour of the adoption of the Protocol, annexed to the said Convention, on the deferred Application of the Provisions on the Exhaustion of Rights attached to Community Patents and National Patents, and furthermore that it is not in favour of the proposal to limit the scope of Articles 32 and 78. On the contrary it considers that the scope of Article 78 should be extended as proposed in the foregoing paragraphs.

Should the proposals in regard to which the Commission has expressed an unfavourable view in the foregoing paragraph be adopted, the Commission reserves its right to institute proceedings under Article 169 for failure to observe the obligations of the EEC Treaty.

17. This Opinion is addressed to the Member States.

Done at Brussels, 26 September 1975.

For the Commission

F.O. GUNDELACH

Member of the Commission

COMMISSION OPINION of 26 September 1975 on the draft Convention for the European Patent for the common market (75/597/EEC)

1. In its Opinion of 4 April 1974 the Commission made known its general views on the draft Convention for the European patent for the Common Market (Community patent) and stated that the "Protocol on the deferred Application of the Provisions on the Exhaustion of Rights attached to Community Patents and National Patents" was basically incompatible with Community law. The Opinion was delivered with a view to the intergovernmental Conference due to take place between 6 and 28 May 1974 and in the course of which the draft Convention was to be finally adopted. This Conference was adjourned at the request of the United Kingdom government. It will now take place in Luxembourg from 17 November to 15 December 1975.

The Commission, noting that a proposal for amendment of the rules forbidding partitioning of the Common Market by means of patents (Arts. 32 and 78) is to be submitted to the Luxembourg Conference (1), and no decision has yet been taken concerning the abovementioned Protocol, would now take this opportunity to deliver a new Opinion.

I

The Working Party on Community Patent has proposed two important amendments to the draft Convention on the European Patent.

2. In its previous version, the draft provided that designation of a Member State of the Community in an application for a European patent results automatically in the grant of a Community patent with effect throughout the Member States.

The new Article 84a of the draft provides that, during a transitional period of ten years, an applicant for a patent will have a choice between a Community patent and a European patent. The applicant may state that he wants a patent only in one or more Member States. If, for example, he makes such a statement and designates Germany and France in the application, he obtains a European patent for these two countries which has the effect of a national patent only.

The Commission regrets this amendment. It still considers it essential that the procedure for the grant of a European patent in which a Member State is designated should lead only to the grant of a Community patent whose scope extends to all the Member States and which is subject to the uniform law created by the Convention for a Community patent.

The Commission considers that there is no convincing reason for allowing the holder of a patent to have such a choice as mentioned above and that it derogates from an important principle of the Convention.

3. The second amendment also entails the abandonment of an important principle.

In the previous draft it was provided that the European Patent Office has sole jurisdiction to cancel the Community patent with effect for all the Member States. The new Article 84b of the draft provides, however, that national courts before which an infringement action has been taken may also decide on the (1) c. f. preparatory document No 17 for the Luxembourg Conference (Doc. R 416/74) p. 2. validity of a Community patent. Such a decision has effect only in the territory

of the State over which the court has jurisdiction.

By virtue of this new provision national courts can decide on the validity of the patent, with the result that the Community patent may be considered valid in one Member State and void in another. The principle laid down in Article 2 of the draft, whereby the Community patent is to have the same effect in all the Member States, is thus contravened. Furthermore, abandonment of the unitary character of the Community patent creates obstacles to the free movement of patented goods and to the creation of equal conditions of competition and also is at variance with the principle of the "free movement" of judgments under the Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters.

The Commission is not unaware of the difficulties which may result from the division of jurisdiction concerning infringement and validity actions. However, in accordance with a draft resolution submitted to the Luxembourg Conference, the work necessary for the resolution of these difficulties is to be undertaken after signature of the Convention.

The Commission considers that it is in the context of that work that a solution should be found which will ensure the unitary character of the European patent.

II

4. The provisions of Articles 32 and 78 are designed to ensure that a patent product put on the market in any Member State by the holder of a Community patent or by the holder of one or more parallel national patents may move freely throughout the territory of the Community. The partitioning of the common market into nine national markets is thus forbidden.

5. Under a proposal submitted to the Luxembourg Conference, the scope of these two Articles is to be limited. This proposal provides that a patentee may prohibit the import of goods which have been put on the market by himself or with his consent in a Member State in which the Community patent has no effect (on account of the existence of a prior national patent opposed to it) or in which a parallel national patent does not exist. In order to justify this proposal it is suggested that a patentee who puts his products on the market in a country where they are not protected by a patent would have to take account of the prices charged by his competitors in that country, and would thus be deprived of the profit due to his creativity.

6. It is true that in certain cases the patentee may be forced to sell his products more cheaply in a country where he has no patent if a third party is able to market the subject of the invention in that country at a lower price.

As a result, if goods put on the market by a patentee in a country where there is no protection are imported into those countries where that patentee holds parallel patents, his profit may be reduced. It is not however the purpose of the law of patents to guarantee to the patentee a higher profit than that which can be derived from the market price. A patentee is only granted, for a certain period, the exclusive right to forbid anybody to make and market the subject of his invention. This exclusive right is the counterpart of the fact that application for a patent makes the invention accessible to the public. The opportunity for the patentee to obtain an additional profit in selling his product depends in particular on his market position and on the existence of substitute products. On patent law grounds alone, the proposal concerning Article 78 should be rejected.

7. Furthermore, this proposal is incompatible with the EEC Treaty, as it envisages free movement of patented goods only where parallel national patents exist in all the Member States. In practice this would never happen or would happen only very rarely. According to forecasts of the number of applications for European patents which will be made every year a firm will apply for a European patent when it holds national patents in two or more Member States of the EEC ; thus as a general

rule national patents will exist only in one or two Member States.

It is therefore clear that the proposed amendment would in the ordinary course of events lead to a partitioning of the market as regards products put on the market by the patentee or by a third party with his consent in a part of the Community where those products are not protected.

Such a partitioning of the market could be of advantage to a patentee, particularly where his productive capacity is sufficient to cover the needs of the common market as a whole, and in the Member States in which he has no national patent he has no serious competition for technical or economic reasons. In such cases the amendment of Article 78 which is proposed would enable the patentee to maintain different price levels in two separate areas of the common market by putting a part of his production on the market directly in the territory in which no protection exists. The patentee could then, by means of an infringement action, prevent the importation of those products into that part of the common market in which they are patented.

The result of the abovementioned proposal is incompatible with one of the fundamental aims of the EEC Treaty, namely the creation of conditions in regard to free movement of goods within the Community which are identical to those which exist in a domestic market. It is therefore essential to maintain the present solution, which prevents a patentee from dividing common market into two separate areas through his choice of the place in which he puts his products on the market.

8. In its Opinion No 74/209/EEC (1) of 4 April 1974, paragraph 11, last subparagraph addressed to the Member States, the Commission declared that Community law forbade the holder of a patent to exercise his exclusive right to oppose importation of a protected product into a Member State when that product has already been put on the market by himself or with his consent in another Member State.

9. In its decision of 8 June 1971, in the *Deutsche Grammophongesellschaft (DGG) case (Recueil) XVII, 487*, the Court of Justice of the European Communities has already stated (p. 500):

"If a protection right analogous to copyright is used in order to prohibit in one Member State the marketing of goods that have been brought into the market by the holder of the right or with his consent in the territory of another Member State solely because this marketing has not occurred in the domestic market, such a prohibition maintaining the isolation of the national markets conflicts with the essential aim of the Treaty, the integration of the national markets into one uniform market. This aim could not be achieved if by virtue of the various legal systems of the Member States private persons were able to divide the market and cause arbitrary discriminations or disguised restrictions in trade between the Member States.

Accordingly, it would conflict with the provisions regarding the free movement of goods in the common market if manufacturer of recordings exercised the exclusive right granted to him by the legislation of a Member State to market the protected articles in order to prohibit the marketings in that Member State of products that had been sold by him himself or with his consent in another Member State solely because this marketing had not occurred in the territory of the first Member State."

The phrase "in order to prohibit the marketing in that Member State of products that had been sold by him himself or with his consent in another Member State", shows clearly that it matters little whether, when the goods were put on the market for the first time, it was in a State in which a parallel patent existed or not. In the DGG case the manufacturer of records did not have an exclusive parallel right in the State in which the goods were first put on the market (France).

10. The decision of the Court of Justice in *Centrafarm v. Sterling Drug case 15/74* of 31 October 1974, confirms the interpretation by the Commission of the DGG decision, namely that the principles

enunciated in the latter case apply also to patents. In regard to the question raised here the Court of Justice declared in the Sterling Drug case (ECR 1974-6 p. 1147), p. 1163:

"In fact, if a patentee could prevent the import of protected products marketed by him or with his consent in another Member State, he would be able to partition off national markets and thereby restrict trade between Member States, in a situation where no such restriction was necessary to guarantee the essence of the exclusive right flowing from the parallel patents.

The question referred should therefore be answered to the effect that the exercise, by a patentee, of the right which he enjoys under the legislation of a Member State to prohibit the sale, in that State, of a product protected by the patent which has been marketed in another Member State by the patentee or with his consent is incompatible with the rules of the EEC Treaty concerning the free movement of goods within the common market".

11. The proposal for amendment cannot be defended on the ground that the Sterling Drug case was concerned with products imported from a Member State in which a parallel patent existed. In fact the reasons given for this decision, like those in the DGG decision (a case in which a parallel exclusive right did not exist), are based solely on the fact that the putting of the goods on the market took place in another Member State independently of the existence or absence of parallel protection.

The Sterling Drug decision contains furthermore a statement which dispels all doubt. In discussing the conditions in which a patentee may prohibit imports under Article 36 of the EEC Treaty, the Court of Justice takes the view that the patentee may, by means of an infringement action, oppose importation of "a product coming from a Member State where it is not patentable and has been manufactured by third parties without the consent of the patentee". It follows that the patentee cannot forbid importation of products from a Member State in which the product cannot be patented but where it has been put on the market by a third party with his consent. This is also the case if the patentee himself puts the product on the market in a Member State in which parallel protection does not exist.

12. The same considerations apply to the proposed amendment to Article 32 : free circulation of goods must also be guaranteed when the holder of a Community patent puts the patented goods on the market in a Member State in which his patent has no effect.

(1) JO No L 109, 23.4.1974, p. 34. 13. Consequently a limitation of the scope of Articles 32 and 78 of the draft Convention would be contrary to the provisions of the EEC Treaty.

The Commission is also of the opinion that the scope of Article 78 should be extended. Under Article 78 (2) the free circulation of goods is also ensured where two or more persons who have economic connections with each other hold different national patents for the same invention. This rule includes those cases in which legally independent subsidiaries and their parent company are holders of different national patents for the same invention.

14. However, Article 78 does not cover the case where the holder of two or more parallel national patents assigns one of these to a third party with which he has no "economic connection". Article 78 in its present form thus permits partitioning of the common market through the assignment of a national patent to a third party who is economically independent of the assignor. This procedure may be used to circumvent the rules which guarantee the free movement of patented goods.

So far, the Court of Justice has not had to declare itself in such a case. In the *Centrafarm v. Sterling Drug* case it nevertheless gave a clear indication of what the solution to this problem might be. The Court of Justice declared that Article 36 of the Treaty allows derogations to be made to the principle of free circulation of goods "in cases where there exist patents, the original

proprietors of which are legally and economically independent". By original proprietors is meant persons who have made an invention independently of each other and who have obtained a patent for that invention.

In the case in question here the person to whom a patent has been assigned is not the original proprietor of a patent. He is only the holder of a derived right which he has acquired as a result of the assignment. Thus an exception to the principle of free circulation of goods cannot be justified where there is an assignment of a national patent.

There is no obvious justification for treating someone who acquired a national patent as a result of an assignment differently from the holder of an exclusive licence, which from a commercial point of view is very close to an assignment. It is to be feared that, where until now an exclusive licence was granted, assignment will be used. This could have the effect of effectively partitioning national markets.

Such a result is incompatible with the principle of free circulation of goods. For this reason the Commission takes the view, for which it finds support in the decisions of the Court of Justice, that assignment of a licence to a third party economically independent of the assignor cannot be allowed to lead to partitioning of the market. Similar provisions should apply to any case where an invention which has not yet been patented is assigned to a third party who applies under his own name for a patent in respect of that invention.

The Commission therefore proposes that Article 78 (2) be amended to read as follows:

The provisions of paragraph 1 shall apply also in respect of a product put on the market by the proprietor of a national patent, granted for the same invention in another Contracting State, to whom the right to the patent or the patent itself has been assigned by the proprietor of the patent referred to in paragraph 1. (The second sentence is deleted).

III

15. The Commission reiterates the view expressed in its first Opinion, that the "Protocol on the deferred Application of the Provisions on the Exhaustion of Rights attached to Community Patents and National Patents" is contrary to Community law. This Protocol provides that the provisions of Article 32 and 78, which forbid the partitioning of markets, will not be applicable during a transitional period of five to ten years, maximum.

The adoption of this Protocol would allow a patentee to control the marketing of his products within the common market. By taking an infringement action against the importers of products which he himself or his licensee has put on the market in another Member State he can protect national markets and charge different prices in each Member State.

In accordance with the interpretation given by the Court of Justice of the European Communities in the *Deutsche Grammophon* and *Sterling Drug* cases, Community law forbids a patent holder to exercise his exclusive right to oppose importation into a Member State of a patented product when that product was put on the market by him or with his consent in another Member State.

IV

16. The Commission, acting on the considerations hereinbefore set out and in pursuance of its powers under Article 155 of the EEC Treaty, hereby expresses itself in favour of signature by the Member States of the European Communities of the Convention for the European Patent for the common market, but at the same time declares that it is not in favour of the adoption of the Protocol, annexed to the said Convention, on the deferred Application of the Provisions on the Exhaustion of Rights attached to Community Patents and National Patents, and furthermore that it is not in favour of the proposal to limit the scope of Articles 32 and 78. On the contrary it considers that the scope of Article 78 should be extended as proposed in the foregoing paragraphs.

Should the proposals in regard to which the Commission has expressed an unfavourable view in the foregoing paragraph be adopted, the Commission reserves its right to institute proceedings under Article 169 for failure to observe the obligations of the EEC Treaty.

17. This Opinion is addressed to the Member States.

Done at Brussels, 26 September 1975.

For the Commission

F.O. GUNDELACH

Member of the Commission

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**74/209/EEC: Commission Opinion
of 4 April 1974**

concerning the draft Convention for the European Patent for the Common Market and the Protocol annexed thereto relating to the deferred application of the provisions on the exhaustion of rights attached to Community Patents and National Patents

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COMMISSION OPINION

OF 4 APRIL 1974

CONCERNING THE DRAFT CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON MARKET AND THE PROTOCOL ANNEXED THERETO RELATING TO THE DEFERRED APPLICATION OF THE PROVISIONS ON THE EXHAUSTION OF RIGHTS ATTACHED TO COMMUNITY PATENTS AND NATIONAL PATENTS

(74/209/EEC)

THE FUTURE EUROPEAN PATENT WILL BE GOVERNED BY TWO CONVENTIONS. THE FIRST CONVENTION (1) SHALL REGULATE THE PROCEDURE FOR THE GRANT OF PATENTS . THIS CONVENTION WAS SIGNED IN MUNICH ON 5 OCTOBER 1973 , BY THE PLENIPOTENTIARIES OF THE NINE MEMBER STATES OF THE EUROPEAN COMMUNITIES AND SEVERAL OTHER EUROPEAN STATES. THE EFFECTS OF A PATENT THUS GRANTED WILL BE DEFINED IN A SECOND CONVENTION WHICH WILL BE APPLICABLE ONLY IN THE COMMON MARKET AS A WHOLE. THE DRAFT OF THIS SECOND CONVENTION (2) WILL BE SUBMITTED TO AN INTER-GOVERNMENTAL CONFERENCE WHICH WILL BE HELD IN LUXEMBOURG FROM 6 TO 28 MAY 1974. IT WILL BE INITIALED DURING THIS CONFERENCE AND THE DRAFT WILL THEN BE SIGNED DURING THE COURSE OF A CONFERENCE OF GOVERNMENT REPRESENTATIVES OF THE MEMBER STATES MEETING IN THE COUNCIL. THE TEXT OF THE DRAFT HAS BEEN SUBMITTED TO THE MEMBER STATES AND TO THE COMMISSION SO THAT THEY MAY GIVE THEIR OPINIONS ON IT.

I

1 . THE EUROPEAN PATENT MAY BE GRANTED IN RESPECT OF STATES WHICH ARE PARTIES TO THE FIRST CONVENTION , AND NOT IN RESPECT OF OTHERS , ACCORDING TO THE WISH OF THE APPLICANT , AND THIS PATENT WILL HAVE SIMILAR EFFECTS IN EACH STATE TO THOSE OF A NATIONAL PATENT. AN IMPORTANT EXCEPTION HAS BEEN PROVIDED IN REGARD TO THIS PRINCIPLE , CONCERNING THE MEMBER STATES OF THE EUROPEAN COMMUNITIES : THE PATENT CAN ONLY BE GRANTED IN RESPECT OF ALL THE STATES TOGETHER AND NOT FOR SOME OF THEM ONLY. THE COMMUNITY PATENT WILL HAVE THE SAME EFFECT IN THE TERRITORIES OF ALL THE MEMBER STATES AS IT WILL BE GOVERNED BY A UNIFIED AND INDEPENDENT LAW , WHICH IS THE OBJECT OF THE DRAFT CONVENTION TO BE SUBMITTED TO THE INTER-GOVERNMENTAL CONFERENCE IN LUXEMBOURG . NATIONAL PATENTS WILL CONTINUE TO BE GRANTED IN THE MEMBER STATES OF THE COMMUNITY. COMMUNITY LEGISLATION WILL CO-EXIST WITH NATIONAL LEGISLATION ON THE SUBJECT.

2 . THE PREAMBLE TO THE DRAFT DRAWS ATTENTION TO THE MEMBER STATES' WISH TO ESTABLISH A PATENT REGIME WHICH SHALL CONTRIBUTE TO A REALIZATION OF THE OBJECTIVES OF THE TREATY SETTING UP THE EUROPEAN ECONOMIC COMMUNITY. THE AIM OF THE DRAFT , IN FACT , IS TO BRING ABOUT FREE MOVEMENT OF PATENTED GOODS IN THE COMMON MARKET AND ALSO TO BRING ABOUT EQUALIZATION OF COMPETITIVE CONDITIONS IN THAT SECTOR. THESE TWIN PURPOSES SHALL BE ACHIEVED BY ELIMINATING THE RESTRICTIONS RESULTING FROM TERRITORIALITY OF NATIONAL RIGHTS OF

PROTECTION.

3 . IN THIS CONNECTION ARTICLE 32 OF THE DRAFT FORBIDS DIVISION OF THE COMMON MARKET INTO NINE NATIONAL MARKETS BY MEANS OF THE RIGHTS ATTACHED TO THE COMMUNITY PATENT. PROTECTED PRODUCTS MUST BE ABLE TO MOVE FREELY AFTER THE OWNER OF THE PATENT HAS PUT THEM ON THE MARKET IN ANY PART OF THE COMMUNITY. THIS RULE APPLIES ALSO TO PRODUCTS MARKETED BY THE HOLDER OF A CONTRACTUAL LICENCE OR A LICENCE OF RIGHT

4 . FURTHERMORE , IN ORDER TO ENSURE FREE MOVEMENT OF PATENTED GOODS , ARTICLE 78 APPLIES THE SAME PRINCIPLE IN CASES WHERE THE RIGHT TO PROTECTION DOES NOT ARISE FROM A COMMUNITY PATENT BUT FROM ONE OR SEVERAL NATIONAL PATENTS BELONGING TO ONE OWNER OR PERSONS WHO ARE TIED TO HIM ECONOMICALLY. UNDER THIS ARTICLE , MARKETING A PATENTED PRODUCT IN ONE OF THE MEMBER STATES HAS THE CONSEQUENCE OF EXHAUSTING THE RIGHTS ATTACHED TO NATIONAL PATENTS GRANTED IN OTHER MEMBER STATES . THE OWNER OF TWO NATIONAL PATENTS PROTECTING ONE INVENTION IN GERMANY AND IN FRANCE , FOR EXAMPLE , MAY NOT PREVENT IMPORTATION OF PROTECTED PRODUCTS WHICH HAVE BEEN MARKETED IN FRANCE , BY HIMSELF OR BY A THIRD PARTY WITH HIS CONSENT , IN ORDER TO PROTECT HIS GERMAN PATENT . THE CONTENT OF THIS ARTICLE IN ANY CASE ONLY RESTATES THE PRESENT LEGAL SITUATION AS SET OUT UNDER III BELOW.

5 . THUS , THE EUROPEAN LAW AS SET OUT IN THE CONVENTION WILL ESTABLISH IN THE COMMON MARKET CONDITIONS SIMILAR TO THOSE WHICH EXIST IN A NATIONAL MARKET IN REGARD TO THE ACQUISITION AND EXPLOITATION OF PATENTS . INDUSTRY WILL BE ABLE TO ADOPT A PRODUCTION AND SALES POLICY FOR THE COMMUNITY AS A WHOLE. INTRA-COMMUNITY COMMERCE WILL BE FACILITATED AND EXPANDED DUE TO THE FREE MOVEMENT OF PATENTED PRODUCTS OR PROCESSES AND EQUAL CONDITIONS OF COMPETITION.

II

6 . THIS FAVOURABLE SITUATION WOULD BE PUT AT RISK BY ADOPTION OF THE DRAFT " PROTOCOL ON THE DEFERRED APPLICATION OF THE PROVISIONS ON THE EXHAUSTION OF RIGHTS ATTACHED TO COMMUNITY PATENTS AND NATIONAL PATENTS " . THIS PROTOCOL , WHICH IS ANNEXED TO THE CONVENTION AND WHICH IS TO BE AN INTEGRAL PART THEREOF , PROVIDES THAT ARTICLES 32 AND 78 FORBIDDING DIVISION OF MARKETS SHALL NOT BE APPLICABLE DURING A TRANSITIONAL PERIOD OF FIVE TO 10 YEARS MAXIMUM.

7 . ADOPTION OF THIS PROTOCOL WILL ALLOW THE HOLDER OF THE EUROPEAN PATENT DURING A TRANSITIONAL PERIOD TO FORBID IMPORTATION OF PRODUCTS PUT ON THE MARKET IN ANOTHER MEMBER STATE BY HIMSELF OR HIS LICENSEE. IN THIS WAY , HE WOULD BE ABLE TO CONTROL THE MARKETING OF HIS PRODUCTS INSIDE THE COMMON MARKET , AND BY BRINGING AN ACTION FOR BREACH OF PATENT RIGHTS , SEPARATE NATIONAL MARKETS ONE FROM THE OTHER AND MAINTAIN DIFFERENT PRICES IN EACH MEMBER STATE.

8 . TAKING INTO ACCOUNT THE FACT THAT THE CONVENTION FOR THE EUROPEAN COMMUNITY PATENT WILL NOT COME INTO FORCE UNTIL 1976 AT THE EARLIEST - GIVEN THE TIME NEEDED FOR PARLIAMENTARY RATIFICATION - THE PROTOCOL COULD DELAY UNTIL 1981 , OR EVEN 1986 , APPLICATION OF THE PROVISIONS FORBIDDING DIVISION OF THE COMMON MARKET.

III

9 . SUCH A LIMITATION OF THE PRINCIPLE OF FREE MOVEMENT OF GOODS APPLIED TO PATENTED PRODUCTS IS CONTRARY TO THE PROVISIONS OF THE TREATY OF ROME. IT IS CLEAR FROM ARTICLES 2 , 3 , 30 TO 37 , 85 AND 86 , THAT ONE OF THE ESSENTIAL AIMS OF THE COMMUNITY CONSISTS OF CREATING A COMMON MARKET IN WHICH PRODUCTS MOVE FREELY AND COMPETITION IS NOT DISTORTED. FREE MOVEMENT OF GOODS IS SUCH A FUNDAMENTAL PART OF THE REALIZATION OF THE COMMON MARKET THAT IT CAN BE MODIFIED ONLY IN THE EXCEPTIONAL CIRCUMSTANCES DEFINED VERY STRICTLY BY THE TREATY. THE PROTOCOL , HOWEVER , INTRODUCES SUCH AN EXCEPTION FOR A PERIOD OF TIME WHICH MAY COME TO AN END APPROXIMATELY 30 YEARS AFTER THE EEC TREATY HAS COME INTO FORCE AND SOME 15 YEARS AFTER THE EXPIRATION OF THE TRANSITIONAL PERIOD LAID DOWN BY THE TREATY FOR THE CREATION OF THE CUSTOMS UNION.

10 . THE COMMISSION'S OPINION IS SUPPORTED BY THE DECISIONS OF THE COURT OF JUSTICE OF THE EUROPEAN COMMUNITIES , IN PARTICULAR BY THE DECISION OF 8 JULY 1971 , IN THE CASE OF DEUTSCHE GRAMMOPHON V. METRO (CASE 78/70) (3). IN THIS DECISION THE COURT IN PARTICULAR STATES

" ARTICLE 36 MENTIONS AMONG THE PROHIBITIONS OR RESTRICTIONS ON THE FREE MOVEMENT OF GOODS PERMITTED BY IT THOSE THAT ARE JUSTIFIED FOR THE PROTECTION OF INDUSTRIAL AND COMMERCIAL PROPERTY. IF IT BE ASSUMED THAT A RIGHT ANALOGOUS TO COPYRIGHT CAN BE COVERED BY THESE PROVISIONS IT FOLLOWS , HOWEVER , FROM THIS ARTICLE THAT ALTHOUGH THE TREATY DOES NOT AFFECT THE EXISTENCE OF THE INDUSTRIAL PROPERTY RIGHTS CONFERRED BY THE NATIONAL LEGISLATION OF A MEMBER STATE , THE EXERCISE OF THESE RIGHTS MAY COME WITHIN THE PROHIBITIONS OF THE TREATY. ALTHOUGH ARTICLE 36 PERMITS PROHIBITIONS OR RESTRICTIONS ON THE FREE MOVEMENT OF GOODS THAT ARE JUSTIFIED FOR THE PROTECTION OF INDUSTRIAL AND COMMERCIAL PROPERTY , IT ONLY ALLOWS SUCH RESTRICTIONS ON THE FREEDOM OF TRADE TO THE EXTENT THAT THEY ARE JUSTIFIED FOR THE PROTECTION OF THE RIGHTS THAT FORM THE SPECIFIC OBJECT OF THIS PROPERTY .

IF A PROTECTION RIGHT ANALOGOUS TO COPYRIGHT IS USED IN ORDER TO PROHIBIT IN ONE MEMBER STATE THE MARKETING OF GOODS THAT HAVE BEEN BROUGHT INTO THE MARKET BY THE HOLDER OF THE RIGHT OR WITH HIS CONSENT IN THE TERRITORY OF ANOTHER MEMBER STATE SOLELY BECAUSE THIS MARKETING HAS NOT OCCURRED IN THE DOMESTIC MARKET , SUCH A PROHIBITION MAINTAINING THE ISOLATION OF THE NATIONAL MARKETS CONFLICTS WITH THE ESSENTIAL AIM OF THE TREATY , THE INTEGRATION OF THE NATIONAL MARKETS INTO ONE UNIFORM MARKET. THIS AIM COULD NOT BE ACHIEVED IF BY VIRTUE OF THE VARIOUS LEGAL SYSTEMS OF THE MEMBER STATES PRIVATE PERSONS WERE ABLE TO DIVIDE THE MARKET AND CAUSE ARBITRARY DISCRIMINATIONS OR DISGUISED RESTRICTIONS IN TRADE BETWEEN THE MEMBER STATES.

ACCORDINGLY , IT WOULD CONFLICT WITH THE PROVISIONS REGARDING THE FREE MOVEMENT OF GOODS IN THE COMMON MARKET IF A MANUFACTURER OF RECORDINGS EXERCISED THE EXCLUSIVE RIGHT GRANTED TO HIM BY THE LEGISLATION OF A MEMBER STATE TO MARKET THE PROTECTED ARTICLES IN ORDER TO PROHIBIT THE MARKETING IN THAT MEMBER STATE OF PRODUCTS THAT HAD BEEN SOLD BY HIM HIMSELF OR WITH HIS CONSENT IN ANOTHER MEMBER STATE SOLELY BECAUSE THIS MARKETING

HAD NOT OCCURRED IN THE TERRITORY OF THE FIRST MEMBER STATE " .

11 . THE DECISION IN QUESTION IS CONCERNED WITH , (THIS IS NOT IN DOUBT) OVER AND ABOVE THE EXCLUSIVE RIGHT OF A PRODUCER OF RECORDINGS WHICH WAS THE BASIS OF THE LITIGATION , ALL EXCLUSIVE RIGHTS ATTACHED TO PROTECTION OF INDUSTRIAL AND COMMERCIAL PROPERTY.

THE DECISION APPEARS TO ARGUE THAT SUCH A RIGHT (THE RIGHT ACCRUING TO A PRODUCER OF RECORDINGS) , ANALOGOUS TO AUTHOR'S COPYRIGHT , COULD NOT COME WITHIN THE EXCEPTION IN ARTICLE 36 UNLESS IT COULD BE CONSIDERED TO BE A RIGHT OF INDUSTRIAL OR COMMERCIAL PROPERTY (WHICH IT WASN'T) . THE COURT POINTED OUT , HOWEVER , THAT THIS RIGHT COULD NOT , IN ANY CASE , BE EXERCISED IN SUCH A WAY AS TO DIVIDE UP THE COMMON MARKET WITHOUT BEING IN BREACH OF THE RULES ON FREE MOVEMENT OF GOODS .

IT CLEARLY FOLLOWS , THAT THE COURT , IN THE CASE SUBMITTED TO IT , WISHED TO ENLARGE THE SCOPE OF THE LITIGATION AND INTERPRET ART. 36 IN A WAY THAT WAS VALID NOT ONLY FOR RIGHTS ANALOGOUS TO AUTHOR'S COPYRIGHT BUT ALSO FOR ALL RIGHTS OF INDUSTRIAL AND COMMERCIAL PROPERTY .

THE COMMISSION CONCLUDES THAT THE INTERPRETATION GIVEN BY THE COURT DEFINITELY APPLIES TO PATENT RIGHTS , WITHOUT HAVING TO ASK ITSELF IF A PATENTEE'S RIGHTS ARE OF THE SAME NATURE OR NOT AS THOSE BELONGING TO A PRODUCER OF RECORDINGS.

ON THIS INTERPRETATION OF THE DECISION IN THE DEUTSCHE GRAMMOPHON CASE , COMMUNITY LAW FORBIDS A PATENTEE TO EXERCISE HIS EXCLUSIVE RIGHT TO OPPOSE IMPORTATION OF A PROTECTED PRODUCT INTO A MEMBER STATE WHEN THAT PRODUCT HAS ALREADY BEEN SOLD , BY HIM OR WITH HIS CONSENT , IN ANOTHER MEMBER STATE.

12 . HAVING REGARD TO THAT , SIGNATURE OF THE PROTOCOL ON EXHAUSTION OF RIGHTS , A PROTOCOL WHICH ATTEMPTS TO LEGITIMATE , IF ONLY TEMPORARILY , EXERCISE OF THE RIGHTS OF INDUSTRIAL PROPERTY IN A MANNER CONTRARY TO COMMUNITY LAW , AS AUTHORITATIVELY INTERPRETED BY THE COURT OF JUSTICE , WOULD OBVIOUSLY NOT BE COMPATIBLE WITH THE FUNDAMENTAL OBLIGATION OF MEMBER STATES CONTAINED IN ARTICLE 5 OF THE TREATY , TO ABSTAIN FROM " ANY MEASURE WHICH COULD JEOPARDIZE THE ATTAINMENT OF THE OBJECTIVES OF THIS TREATY " , AND WOULD , CONSEQUENTLY , BE A BREACH OF THIS PROVISION.

13 . A PROTOCOL OF THIS SORT WOULD THEREFORE SET OUT TO AMEND THE TREATY , AN AMENDMENT HOWEVER , WHOSE EFFECT WOULD BE TO RESTRICT FREEDOM OF MOVEMENT OF GOODS AS LAID DOWN AT PRESENT BY COMMUNITY LAW , COULD NOT BE CARRIED OUT BY A CONVENTION BETWEEN MEMBER STATES OUTSIDE THE PROCEDURES EXPRESSLY LAID DOWN BY THE TREATY (ARTICLE 236) . THE LEGAL VALIDITY OF THE PROTOCOL ITSELF WOULD , FOR THE SAME REASON , BE IN SERIOUS DOUBT , AND THE COMMISSION BELIEVES THAT THE TRANSITIONAL ARRANGEMENT IT CONTAINS CANNOT PREVAIL OVER COMMUNITY LAW IN CASE OF CONFLICT.

IV

14 . FINALLY , THE COMMISSION , IN ACCORDANCE WITH THE VIEWS SET OUT ABOVE AND RELYING ON ARTICLE 155 OF THE EEC TREATY , IS ON THE ONE HAND IN FAVOUR OF SIGNATURE OF THE CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON

MARKET BY THE MEMBER STATES AND ON THE OTHER HAND IS AGAINST ADOPTION OF THE PROTOCOL , ANNEXED TO THE SAID CONVENTION , CONCERNING THE DEFERRED APPLICATION OF THE PROVISIONS ON THE EXHAUSTION OF RIGHTS ATTACHED TO COMMUNITY PATENTS AND NATIONAL PATENTS .

15 . THIS OPINION IS ADDRESSED TO ALL MEMBER STATES.

DONE AT BRUSSELS , 4 APRIL 1974.

FOR THE COMMISSION

THE PRESIDENT

FRANCOIS-XAVIER ORTOLI

- (1) CONVENTION ON THE GRANT OF EUROPEAN PATENTS AND ANNEXED DOCUMENTS PUBLISHED BY THE GOVERNMENT OF THE FEDERAL REPUBLIC OF GERMANY , MUENCHEN , WILA VERLAG , 1973 , 343 P.
- (2) DRAFT CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON MARKET PUBLISHED BY THE COUNCIL OF THE EUROPEAN COMMUNITIES , LUXEMBOURG , OFFICIAL PUBLICATIONS OFFICE OF THE EUROPEAN COMMUNITIES , 1973 , 303 P .
- (3) REPORTS OF THE EUROPEAN COURT OF JUSTICE , VOLUME XVII , P. 487 ET SEQUITUR.

THIS TEXT IS AN UNOFFICIAL TRANSLATION INTO ENGLISH OF THE REPORT OF THE COURT OF JUSTICE.

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**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

COUNCIL of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 100a thereof,

Having regard to the proposal from the Commission (1),

Having regard to the opinion of the Economic and Social Committee (2),

Acting in accordance with the procedure referred to in Article 189b of the Treaty (3),

- (1) Whereas research into plant protection products contributes to the continuing improvement in the production and procurement of plentiful food of good quality at affordable prices;
- (2) Whereas plant protection research contributes to the continuing improvement in crop production;
- (3) Whereas plant protection products, especially those that are the result of long, costly research, will continue to be developed in the Community and in Europe if they are covered by favourable rules that provide for sufficient protection to encourage such research;
- (4) Whereas the competitiveness of the plant protection sector, by the very nature of the industry, requires a level of protection for innovation which is equivalent to that granted to medicinal products by Council Regulation (EEC) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products (4);
- (5) Whereas, at the moment, the period that elapses between the filing of an application for a patent for a new plant protection product and authorization to place the said plant protection product on the market makes the period of effective protection under the patent insufficient to cover the investment put into the research and to generate the resources needed to maintain a high level of research;
- (6) Whereas this situation leads to a lack of protection which penalizes plant protection research and the competitiveness of the sector;
- (7) Whereas one of the main objectives of the supplementary protection certificate is to place European industry on the same competitive footing as its North American and Japanese counterparts;
- (8) Whereas, in its Resolution of 1 February 1993 (5) on a Community programme of policy and action in relation to the environment and sustainable development, the Council adopted the general approach and strategy of the programme presented by the Commission, which stressed the interdependence of economic growth and environmental quality; whereas improving protection of the environment means maintaining the economic competitiveness of industry; whereas, accordingly, the issue of a supplementary protection certificate can be regarded as a positive measure in favour of environmental protection;
- (9) Whereas a uniform solution at Community level should be provided for, thereby preventing the heterogeneous development of national laws leading to further disparities which would be likely to hinder the free movement of plant protection products within the Community and thus directly affect the functioning of the internal market; whereas this is in accordance with the principle of subsidiarity as defined by Article 3b of the Treaty;
- (10) Whereas, therefore, there is a need to create a supplementary protection certificate granted,

under the same conditions, by each of the Member States at the request of the holder of a national or European patent relating to a plant protection product for which marketing authorization has been granted is necessary; whereas a Regulation is therefore the most appropriate legal instrument;

- (11) Whereas the duration of the protection granted by the certificate should be such as to provide adequate, effective protection; whereas, for this purpose, the holder of both a patent and a certificate should be able to enjoy an overall maximum of fifteen years of exclusivity from the time the plant protection product in question first obtains authorization to be placed on the market in the Community;
- (12) Whereas all the interests at stake in a sector as complex and sensitive as plant protection must nevertheless be taken into account; whereas, for this purpose, the certificate cannot be granted for a period exceeding five years;
- (13) Whereas the certificate confers the same rights as those conferred by the basic patent; whereas, consequently, where the basic patent covers an active substance and its various derivatives (salts and esters), the certificate confers the same protection;
- (14) Whereas the issue of a certificate for a product consisting of an active substance does not prejudice the issue of other certificates for derivatives (salts and esters) of the substance, provided that the derivatives are the subject of patents specifically covering them;
- (15) Whereas a fair balance should also be struck with regard to the determination of the transitional arrangements; whereas such arrangements should enable the Community plant protection industry to catch up to some extent with its main competitors, while making sure that the arrangements do not compromise the achievement of other legitimate objectives concerning the agricultural policy and environment protection policy pursued at both national and Community level;
- (16) Whereas only action at Community level will enable the objective, which consists in ensuring adequate protection for innovation in the field of plant protection, while guaranteeing the proper functioning of the internal market for plant protection products, to be attained effectively;
- (17) Whereas the detailed rules in recitals 12, 13 and 14 and in Articles 3 (2), 4, 8 (1) (c) and 17 (2) of this Regulation are also valid, *mutatis mutandis*, for the interpretation in particular of recital 9 and Articles 3, 4, 8 (1) (c) and 17 of Council Regulation (EEC) No 1768/92,

HAVE ADOPTED THIS REGULATION:

Article 1

Definitions

For the purposes of this Regulation, the following definitions shall apply:

1. 'plant protection products': active substances and preparations containing one or more active substances, put up in the form in which they are supplied to the user, intended to:
 - (a) protect plants or plant products against all harmful organisms or prevent the action of such organisms, in so far as such substances or preparations are not otherwise defined below;
 - (b) influence the life processes of plants, other than as a nutrient (e.g. plant growth regulators);
 - (c) preserve plant products, in so far as such substances or products are not subject to special Council or Commission provisions on preservatives;
 - (d) destroy undesirable plants; or

- (e) destroy parts of plants, check or prevent undesirable growth of plants;
2. 'substances': chemical elements and their compounds, as they occur naturally or by manufacture, including any impurity inevitably resulting from the manufacturing process;
3. 'active substances': substances or micro-organisms including viruses, having general or specific action:
- (a) against harmful organisms; or
- (b) on plants, parts of plants or plant products;
4. 'preparations': mixtures or solutions composed of two or more substances, of which at least one is an active substance, intended for use as plant protection products;
5. 'plants': live plants and live parts of plants, including fresh fruit and seeds;
6. 'plant products': products in the unprocessed state or having undergone only simple preparation such as milling, drying or pressing, derived from plants, but excluding plants themselves as defined in point 5;
7. 'harmful organisms': pests of plants or plant products belonging to the animal or plant kingdom, and also viruses, bacteria and mycoplasmas and other pathogens;
8. 'product': the active substance as defined in point 3 or combination of active substances of a plant protection product;
9. 'basic patent': a patent which protects a product as defined in point 8 as such, a preparation as defined in point 4, a process to obtain a product or an application of a product, and which is designated by its holder for the purpose of the procedure for grant of a certificate;
10. 'certificate': the supplementary protection certificate.

Article 2

Scope

Any product protected by a patent in the territory of a Member State and subject, prior to being placed on the market as a plant protection product, to an administrative authorization procedure as laid down in Article 4 of Directive 91/414/EEC (6), or pursuant to an equivalent provision of national law if it is a plant protection product in respect of which the application for authorization was lodged before Directive 91/414/EEC was implemented by the Member State concerned, may, under the terms and conditions provided for in this Regulation, be the subject of a certificate.

Article 3

Conditions for obtaining a certificate

1. A certificate shall be granted if, in the Member State in which the application referred to in Article 7 is submitted, at the date of that application:
- (a) the product is protected by a basic patent in force;
- (b) a valid authorization to place the product on the market as a plant protection product has been granted in accordance with Article 4 of Directive 91/414/EEC or an equivalent provision of

national law;

(c) the product has not already been the subject of a certificate;

(d) the authorization referred to in (b) is the first authorization to place the product on the market as a plant protection product.

2. The holder of more than one patent for the same product shall not be granted more than one certificate for that product. However, where two or more applications concerning the same product and emanating from two or more holders of different patents are pending, one certificate for this product may be issued to each of these holders.

Article 4

Subject-matter of protection

Within the limits of the protection conferred by the basic patent, the protection conferred by a certificate shall extend only to the product covered by the authorizations to place the corresponding plant protection product on the market and for any use of the product as a plant protection product that has been authorized before the expiry of the certificate.

Article 5

Effects of the certificate

Subject to Article 4, the certificate shall confer the same rights as conferred by the basic patent and shall be subject to the same limitations and the same obligations.

Article 6

Entitlement to the certificate

The certificate shall be granted to the holder of the basic patent or his successor in title.

Article 7

Application for a certificate

1. The application for a certificate shall be lodged within six months of the date on which the authorization referred to in Article 3 (1) (b) to place the product on the market as a plant protection product was granted.

2. Notwithstanding paragraph 1, where the authorization to place the product on the market is granted before the basic patent is granted, the application for a certificate shall be lodged within six months of the date on which the patent is granted.

Article 8

Content of the application for a certificate

1. The application for a certificate shall contain:

(a) a request for the grant of a certificate, stating in particular:

(i) the name and address of the applicant;

(ii) the name and address of the representative, if any;

(iii) the number of the basic patent and the title of the invention;

(iv) the number and date of the first authorization to place the product on the market, as referred to in Article 3 (1) (b) and, if this authorization is not the first authorization to place the product on the market in the Community, the number and date of that authorization;

(b) a copy of the authorization to place the product on the market, as referred to in Article 3 (1) (b), in which the product is identified, containing in particular the number and date of the authorization and the summary of the product characteristics listed in Part A.I (points 1-7) or B.I (points 1-7) of Annex II to Directive 91/414/EEC or in equivalent national laws of the Member State in which the application was lodged;

(c) if the authorization referred to in (b) is not the first authorization to place the product on the market as a plant protection product in the Community, information regarding the identity of the product thus authorized and the legal provision under which the authorization procedure took place, together with a copy of the notice publishing the authorization in the appropriate official publication or, failing such a notice, any other document proving that the authorization has been issued, the date on which it was issued and the identity of the product authorized.

2. Member States may require a fee to be payable upon application for a certificate.

Article 9

Lodging of an application for a certificate

1. The application for a certificate shall be lodged with the competent industrial property office of the Member State which granted the basic patent or on whose behalf it was granted and in which the authorization referred to in Article 3 (1) (b) to place the product on the market was obtained, unless the member State designates another authority for the purpose.

2. Notification of the application for a certificate shall be published by the authority referred to in paragraph 1. The notification shall contain at least the following information:

(a) the name and address of the applicant;

(b) the number of the basic patent;

(c) the title of the invention;

(d) the number and date of the authorization to place the product on the market, referred to in Article 3 (1) (b), and the product identified in that authorization;

(e) where relevant, the number and date of the first authorization to place the product on the market

in the Community.

Article 10

Grant of the certificate or rejection of the application

1. Where the application for a certificate and the product to which it relates meet the conditions laid down in this Regulation, the authority referred to in Article 9 (1) shall grant the certificate.
2. The authority referred to in Article 9 (1) shall, subject to paragraph 3, reject the application for a certificate if the application or the product to which it relates does not meet the conditions laid down in this Regulation.
3. Where the application for a certificate does not meet the conditions laid down in Article 8, the authority referred to in Article 9 (1) shall ask the applicant to rectify the irregularity, or to settle the fee, within a stated time.
4. If the irregularity is not rectified or the fee is not settled under paragraph 3 within the stated time, the application shall be rejected.
5. Member States may provide that the authority referred to in Article 9 (1) is to grant certificates without verifying that the conditions laid down in Article 3 (1) (c) and (d) are met.

Article 11

Publication

1. Notification of the fact that a certificate has been granted shall be published by the authority referred to in Article 9 (1). The notification shall contain at least the following information:
 - (a) the name and address of the holder of the certificate;
 - (b) the number of the basic patent;
 - (c) the title of the invention;
 - (d) the number and date of the authorization to place the product on the market referred to in Article 3 (1) (b) and the product identified in that authorization;
 - (e) where relevant, the number and date of the first authorization to place the product on the market in the Community;
 - (f) the duration of the certificate.
2. Notification of the fact that the application for a certificate has been rejected shall be published by the authority referred to in Article 9 (1). The notification shall contain at least the information listed in Article 9 (2).

Article 12

Annual fees

Member States may require the certificate to be subject to the payment of annual fees.

Article 13

Duration of the certificate

1. The certificate shall take effect at the end of the lawful term of the basic patent for a period equal to the period which elapsed between the date on which the application for a basic patent was lodged and the date of the first authorization to place the product on the market in the Community, reduced by a period of five years.
2. Notwithstanding paragraph 1, the duration of the certificate may not exceed five years from the date on which it takes effect.
3. For the purposes of calculating the duration of the certificate, account shall be taken of a provisional first marketing authorization only if it is directly followed by a definitive authorization concerning the same product.

Article 14

Expiry of the certificate

The certificate shall lapse:

- (a) at the end of the period provided for in Article 13;
- (b) if the certificate-holder surrenders it;
- (c) if the annual fee laid down in accordance with Article 12 is not paid in time;
- (d) if and as long as the product covered by the certificate may no longer be placed on the market following the withdrawal of the appropriate authorization or authorizations to place it on the market in accordance with Article 4 of Directive 91/414/EEC or equivalent provisions of national law. The authority referred to in Article 9 (1) may decide on the lapse of the certificate either on its own initiative or at the request of a third party.

Article 15

Invalidity of the certificate

1. The certificate shall be invalid if:

- (a) it was granted contrary to the provisions of Article 3;
- (b) the basic patent has lapsed before its lawful term expires;
- (c) the basic patent is revoked or limited to the extent that the product for which the certificate was granted would no longer be protected by the claims of the basic patent or, after the basic patent has expired, grounds for revocation exist which would have justified such revocation or limitation.

2. Any person may submit an application or bring an action for a declaration of invalidity of the certificate before the body responsible under national law for the revocation of the corresponding basic patent.

Article 16

Notification of lapse or invalidity

If the certificate lapses in accordance with Article 14 (b), (c) or (d) or is invalid in accordance with Article 15, notification thereof shall be published by the authority referred to in Article 9 (1).

Article 17

Appeals

1. The decisions of the authority referred to in Article 9 (1) or of the body referred to in Article 15 (2) taken under this Regulation shall be open to the same appeals as those provided for in national law against similar decisions taken in respect of national patents.

2. The decision to grant the certificate shall be open to an appeal aimed at rectifying the duration of the certificate where the date of the first authorization to place the product on the market in the Community, contained in the application for a certificate as provided for in Article 8, is incorrect.

Article 18

Procedure

1. In the absence of procedural provisions in this Regulation, the procedural provisions applicable under national law to the corresponding basic patent and, where appropriate, the procedural provisions applicable to the certificates referred to in Regulation (EEC) No 1768/92, shall apply to the certificate, unless national law lays down special procedural provisions for certificates as referred to in this Regulation.

2. Notwithstanding paragraph 1, the procedure for opposition to the granting of a certificate shall be excluded.

TRANSITIONAL PROVISIONS

Article 19

1. Any product which, on the date on which this Regulation enters into force, is protected by a valid basic patent and for which the first authorization to place it on the market as a plant protection product in the Community was obtained after 1 January 1985 under Article 4 of Directive 91/414/EEC or an equivalent national provision may be granted a certificate.

2. An application made under paragraph 1 for a certificate shall be submitted within six months of the date on which this Regulation enters into force.

Article 20

In those Member States whose national law did not, on 1 January 1990, provide for the patentability of plant protection products, this Regulation shall apply from 2 January 1998.

Article 19 shall not apply in those Member States.

FINAL PROVISION

Article 21

Entry into force

This Regulation shall enter into force six months after its publication in the Official Journal of the European Communities.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 23 July 1996.

For the European Parliament

The President

K. HÆNSCH

For the Council

The President

M. LOWRY

- (1) OJ C 390, 31. 12. 1994, p. 21 and OJ C 335, 13. 12. 1995, p. 15.
- (2) OJ No C 155, 21. 6. 1995, p. 14.
- (3) Opinion of the European Parliament of 15 June 1995 (OJ C 166, 3. 7. 1995, p. 89), common position of the Council of 27 November 1995 (OJ C 353, 30. 12. 1995, p. 36) and decision of the European Parliament of 12 March 1996 (OJ C 96, 1. 4. 1996, p. 30).
- (4) OJ No L 182, 2. 7. 1992, p. 1.
- (5) OJ No C 138, 17. 5. 1993, p. 1.
- (6) OJ L 230, 19. 8. 1991, p. 1. Directive as last amended by Directive 95/36/EC (OJ L 172, 22. 7. 1995, p. 8).

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**Council Regulation (EEC) No 1768/92
of 18 June 1992
concerning the creation of a supplementary protection certificate for medicinal products**

COUNCIL REGULATION (EEC) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community, and in particular Article 100a thereof,

Having regard to the proposal from the Commission (1),

In cooperation with the European Parliament (2),

Having regard to the opinion of the Economic and Social Committee (3),

Whereas pharmaceutical research plays a decisive role in the continuing improvement in public health;

Whereas medicinal products, especially those that are the result of long, costly research will not continue to be developed in the Community and in Europe unless they are covered by favourable rules that provide for sufficient protection to encourage such research;

Whereas at the moment the period that elapses between the filing of an application for a patent for a new medicinal product and authorization to place the medicinal product on the market makes the period of effective protection under the patent insufficient to cover the investment put into the research;

Whereas this situation leads to a lack of protection which penalizes pharmaceutical research;

Whereas the current situation is creating the risk of research centres situated in the Member States relocating to countries that already offer greater protection;

Whereas a uniform solution at Community level should be provided for, thereby preventing the heterogeneous development of national laws leading to further disparities which would be likely to create obstacles to the free movement of medicinal products within the Community and thus directly affect the establishment and the functioning of the internal market;

Whereas, therefore, the creation of a supplementary protection certificate granted, under the same conditions, by each of the Member States at the request of the holder of a national or European patent relating to a medicinal product for which marketing authorization has been granted is necessary; whereas a Regulation is therefore the most appropriate legal instrument;

Whereas the duration of the protection granted by the certificate should be such as to provide adequate effective protection; whereas, for this purpose, the holder of both a patent and a certificate should be able to enjoy an overall maximum of fifteen years of exclusivity from the time the medicinal product in question first obtains authorization to be placed on the market in the Community;

Whereas all the interests at stake, including those of public health, in a sector as complex and sensitive as the pharmaceutical sector must nevertheless be taken into account; whereas, for this purpose, the certificate cannot be granted for a period exceeding five years; whereas the protection granted should furthermore be strictly confined to the product which obtained authorization to be placed on the market as a medicinal product;

Whereas a fair balance should also be struck with regard to the determination of the transitional arrangements; whereas such arrangements should enable the Community pharmaceutical industry to catch up to some extent with its main competitors who, for a number of years, have been covered by laws guaranteeing them more adequate protection, while making sure that the arrangements do not

compromise the achievement of other legitimate objectives concerning the health policies pursued both at national and Community level;

Whereas the transitional arrangements applicable to applications for certificates filed and to certificates granted under national legislation prior to the entry into force of this Regulation should be defined;

Whereas special arrangements should be allowed in Member States whose laws introduced the patentability of pharmaceutical products only very recently;

Whereas provision should be made for appropriate limitation of the duration of the certificate in the special case where a patent term has already been extended under a specific national law,

HAS ADOPTED THIS REGULATION:

Article 1

Definitions For the purposes of this Regulation:

- (a) 'medicinal product' means any substance or combination of substances presented for treating or preventing disease in human beings or animals and any substance or combination of substances which may be administered to human beings or animals with a view to making a medical diagnosis or to restoring, correcting or modifying physiological functions in humans or in animals;
- (b) 'product' means the active ingredient or combination of active ingredients of a medicinal product;
- (c) 'basic patent' means a patent which protects a product as defined in (b) as such, a process to obtain a product or an application of a product, and which is designated by its holder for the purpose of the procedure for grant of a certificate;
- (d) 'certificate' means the supplementary protection certificate.

Article 2

Scope Any product protected by a patent in the territory of a Member State and subject, prior to being placed on the market as a medicinal product, to an administrative authorization procedure as laid down in Council Directive 65/65/EEC (4) or Directive 81/851/EEC (5) may, under the terms and conditions provided for in this Regulation, be the subject of a certificate.

Article 3

Conditions for obtaining a certificate A certificate shall be granted if, in the Member State in which the application referred to in Article 7 is submitted and at the date of that application:

- (a) the product is protected by a basic patent in force;
- (b) a valid authorization to place the product on the market as a medicinal product has been granted in accordance with Directive 65/65/EEC or Directive 81/851/EEC, as appropriate;
- (c) the product has not already been the subject of a certificate;

- (d) the authorization referred to in (b) is the first authorization to place the product on the market as a medicinal product.

Article 4

Subject-matter of protection Within the limits of the protection conferred by the basic patent, the protection conferred by a certificate shall extend only to the product covered by the authorization to place the corresponding medicinal product on the market and for any use of the product as a medicinal product that has been authorized before the expiry of the certificate.

Article 5

Effects of the certificate Subject to the provisions of Article 4, the certificate shall confer the same rights as conferred by the basic patent and shall be subject to the same limitations and the same obligations.

Article 6

Entitlement to the certificate The certificate shall be granted to the holder of the basic patent or his successor in title.

Article 7

Application for a certificate 1. The application for a certificate shall be lodged within six months of the date on which the authorization referred to in Article 3 (b) to place the product on the market as a medicinal product was granted.

2. Notwithstanding paragraph 1, where the authorization to place the product on the market is granted before the basic patent is granted, the application for a certificate shall be lodged within six months of the date on which the patent is granted.

Article 8

Content of the application for a certificate 1. The application for a certificate shall contain:

- (a) a request for the grant of a certificate, stating in particular:
- (i) the name and address of the applicant;
 - (ii) if he has appointed a representative, the name and address of the representative;
 - (iii) the number of the basic patent and the title of the invention;
 - (iv) the number and date of the first authorization to place the product on the market, as referred to in Article 3 (b) and, if this authorization is not the first authorization for placing the

product on the market in the Community, the number and date of that authorization;

- (b) a copy of the authorization to place the product on the market, as referred to in Article 3 (b), in which the product is identified, containing in particular the number and date of the authorization and the summary of the product characteristics listed in Article 4a of Directive 65/65/EEC or Article 5a of Directive 81/851/EEC;
 - (c) if the authorization referred to in (b) is not the first authorization for placing the product on the market as a medicinal product in the Community, information regarding the identity of the product thus authorized and the legal provision under which the authorization procedure took place, together with a copy of the notice publishing the authorization in the appropriate official publication.
2. Member States may provide that a fee is to be payable upon application for a certificate.

Article 9

Lodging of an application for a certificate

1. The application for a certificate shall be lodged with the competent industrial property office of the Member State which granted the basic patent or on whose behalf it was granted and in which the authorization referred to in Article 3 (b) to place the product on the market was obtained, unless the Member State designates another authority for the purpose.
2. Notification of the application for a certificate shall be published by the authority referred to in paragraph 1. The notification shall contain at least the following information:
 - (a) the name and address of the applicant;
 - (b) the number of the basic patent;
 - (c) the title of the invention;
 - (d) the number and date of the authorization to place the product on the market, referred to in Article 3 (b), and the product identified in that authorization;
 - (e) where relevant, the number and date of the first authorization to place the product on the market in the Community.

Article 10

Grant of the certificate or rejection of the application 1. Where the application for a certificate and the product to which it relates meet the conditions laid down in this Regulation, the authority referred to in Article 9 (1) shall grant the certificate.

2. The authority referred to in Article 9 (1) shall, subject to paragraph 3, reject the application for a certificate if the application or the product to which it relates does not meet the conditions laid down in this Regulation.

3. Where the application for a certificate does not meet the conditions laid down in Article 8, the authority referred to in Article 9 (1) shall ask the applicant to rectify the irregularity, or to settle the fee, within a stated time.

4. If the irregularity is not rectified or the fee is not settled under paragraph 3 within the

stated time, the authority shall reject the application.

5. Member States may provide that the authority referred to in Article 9 (1) is to grant certificates without verifying that the conditions laid down in Article 3 (c) and (d) are met.

Article 11

Publication 1. Notification of the fact that a certificate has been granted shall be published by the authority referred to in Article 9 (1). The notification shall contain at least the following information:

- (a) the name and address of the holder of the certificate;
- (b) the number of the basic patent;
- (c) the title of the invention;
- (d) the number and date of the authorization to place the product on the market referred to in Article 3 (b) and the product identified in that authorization;
- (e) where relevant, the number and date of the first authorization to place the product on the market in the Community;
- (f) the duration of the certificate.

2. Notification of the fact that the application for a certificate has been rejected shall be published by the authority referred to in Article 9 (1). The notification shall contain at least the information listed in Article 9 (2).

Article 12

Annual fees Member States may require that the certificate be subject to the payment of annual fees.

Article 13

Duration of the certificate 1. The certificate shall take effect at the end of the lawful term of the basic patent for a period equal to the period which elapsed between the date on which the application for a basic patent was lodged and the date of the first authorization to place the product on the market in the Community reduced by a period of five years.

2. Notwithstanding paragraph 1, the duration of the certificate may not exceed five years from the date on which it takes effect.

Article 14

Expiry of the certificate The certificate shall lapse:

- (a) at the end of the period provided for in Article 13;

- (b) if the certificate-holder surrenders it;
- (c) if the annual fee laid down in accordance with Article 12 is not paid in time;
- (d) if and as long as the product covered by the certificate may no longer be placed on the market following the withdrawal of the appropriate authorization or authorizations to place on the market in accordance with Directive 65/65/EEC or Directive 81/851/EEC. The authority referred to in Article 9 (1) may decide on the lapse of the certificate either of its own motion or at the request of a third party.

Article 15

Invalidity of the certificate 1. The certificate shall be invalid if:

- (a) it was granted contrary to the provisions of Article 3;
- (b) the basic patent has lapsed before its lawful term expires;
- (c) the basic patent is revoked or limited to the extent that the product for which the certificate was granted would no longer be protected by the claims of the basic patent or, after the basic patent has expired, grounds for revocation exist which would have justified such revocation or limitation.

2. Any person may submit an application or bring an action for a declaration of invalidity of the certificate before the body responsible under national law for the renovation of the corresponding basic patent.

Article 16

Notification of lapse or invalidity If the certificate lapses in accordance with Article 14 (b), (c) or (d) or is invalid in accordance with Article 15, notification thereof shall be published by the authority referred to in Article 9 (1).

Article 17

Appeals The decisions of the authority referred to in Article 9 (1) or of the body referred to in Article 15 (2) taken under this Regulation shall be open to the same appeals as those provided for in national law against similar decisions taken in respect of national patents.

Article 18

Procedure 1. In the absence of procedural provisions in this Regulation, the procedural provisions applicable under national law to the corresponding basic patent shall apply to the certificate, unless that law lays down special procedural provisions for certificates.

2. Notwithstanding paragraph 1, the procedure for opposition to the granting of a certificate shall be excluded.

Article 19

Transitional provisions 1. Any product which, on the date on which this Regulation enters into force, is protected by a valid basic patent and for which the first authorization to place it on the market as a medicinal product in the Community was obtained after 1 January 1985 may be granted a certificate.

In the case of certificates to be granted in Denmark and in Germany, the date of 1 January 1985 shall be replaced by that of 1 January 1988.

In the case of certificates to be granted in Belgium and in Italy, the date of 1 January 1985 shall be replaced by that of 1 January 1982.

2. An application for a certificate as referred to in paragraph 1 shall be submitted within six months of the date on which this Regulation enters into force.

Article 20

This Regulation shall not apply to certificates granted in accordance with the national legislation of a Member State before the date on which this Regulation enters into force or to applications for a certificate filed in accordance with that legislation before the date of publication of this Regulation in the Official Journal of the European Communities.

Article 21

In those Member States whose national law did not on 1 January 1990 provide for the patentability of pharmaceutical products, this Regulation shall apply five years after the entry into force of this Regulation.

Article 19

shall not apply in those Member States.

Article 22

Where a certificate is granted for a product protected by a patent which, before the date on which this Regulation enters into force, has had its term extended or for which such extension was applied for, under national patent law, the term of protection to be afforded under this certificate shall be reduced by the number of years by which the term of the patent exceeds 20 years.

FINAL PROVISION

Article 23

Entry into force This Regulation shall enter into force six months after its publication in the Official Journal of the European Communities. This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Luxembourg, 18 June 1992. For the Council

The President

Vitor MARTINS

- (1) OJ No C 114, 8. 5. 1990, p. 10. (2) OJ No C 19, 28. 1. 1991, p. 94 and OJ No C 150, 15. 6. 1992. (3) OJ No C 69, 18. 3. 1991, p. 22. (4) OJ No L 22, 9. 12. 1965, p. 369. Last amended by Directive 89/341/EEC (OJ No L 142, 25. 5. 1989, p. 11). (5) OJ No L 317, 6. 11. 1981, p. 1. Amended by Directive 90/676/EEC (OJ No L 373, 31. 12. 1990, p. 15).

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**Directive 98/44/EC of the European Parliament and of the Council
the Council the Council July 1998 on the legal protection of biotechnological inventions**

July 1998 on the legal protection of biotechnological inventions

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 100a thereof,

Having regard to the proposal from the Commission (1),

Having regard to the opinion of the Economic and Social Committee (2),

Acting in accordance with the procedure laid down in Article 189b of the Treaty (3),

- (1) Whereas biotechnology and genetic engineering are playing an increasingly important role in a broad range of industries and the protection of biotechnological inventions will certainly be of fundamental importance for the Community's industrial development;
- (2) Whereas, in particular in the field of genetic engineering, research and development require a considerable amount of high-risk investment and therefore only adequate legal protection can make them profitable;
- (3) Whereas effective and harmonised protection throughout the Member States is essential in order to maintain and encourage investment in the field of biotechnology;
- (4) Whereas following the European Parliament's rejection of the joint text, approved by the Conciliation Committee, for a European Parliament and Council Directive on the legal protection of biotechnological inventions (4), the European Parliament and the Council have determined that the legal protection of biotechnological inventions requires clarification;
- (5) Whereas differences exist in the legal protection of biotechnological inventions offered by the laws and practices of the different Member States; whereas such differences could create barriers to trade and hence impede the proper functioning of the internal market;
- (6) Whereas such differences could well become greater as Member States adopt new and different legislation and administrative practices, or whereas national case-law interpreting such legislation develops differently;
- (7) Whereas uncoordinated development of national laws on the legal protection of biotechnological inventions in the Community could lead to further disincentives to trade, to the detriment of the industrial development of such inventions and of the smooth operation of the internal market;
- (8) Whereas legal protection of biotechnological inventions does not necessitate the creation of a separate body of law in place of the rules of national patent law; whereas the rules of national patent law remain the essential basis for the legal protection of biotechnological inventions given that they must be adapted or added to in certain specific respects in order to take adequate account of technological developments involving biological material which also fulfil the requirements for patentability;
- (9) Whereas in certain cases, such as the exclusion from patentability of plant and animal varieties and of essentially biological processes for the production of plants and animals, certain concepts in national laws based upon international patent and plant variety conventions have created uncertainty regarding the protection of biotechnological and certain microbiological inventions; whereas harmonisation is necessary to clarify the said uncertainty;
- (10) Whereas regard should be had to the potential of the development of biotechnology for the environment and in particular the utility of this technology for the development of methods of

cultivation which are less polluting and more economical in their use of ground; whereas the patent system should be used to encourage research into, and the application of, such processes;

- (11) Whereas the development of biotechnology is important to developing countries, both in the field of health and combating major epidemics and endemic diseases and in that of combating hunger in the world; whereas the patent system should likewise be used to encourage research in these fields; whereas international procedures for the dissemination of such technology in the Third World and to the benefit of the population groups concerned should be promoted;
- (12) Whereas the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) (5) signed by the European Community and the Member States, has entered into force and provides that patent protection must be guaranteed for products and processes in all areas of technology;
- (13) Whereas the Community's legal framework for the protection of biotechnological inventions can be limited to laying down certain principles as they apply to the patentability of biological material as such, such principles being intended in particular to determine the difference between inventions and discoveries with regard to the patentability of certain elements of human origin, to the scope of protection conferred by a patent on a biotechnological invention, to the right to use a deposit mechanism in addition to written descriptions and lastly to the option of obtaining non-exclusive compulsory licences in respect of interdependence between plant varieties and inventions, and conversely;
- (14) Whereas a patent for invention does not authorise the holder to implement that invention, but merely entitles him to prohibit third parties from exploiting it for industrial and commercial purposes; whereas, consequently, substantive patent law cannot serve to replace or render superfluous national, European or international law which may impose restrictions or prohibitions or which concerns the monitoring of research and of the use or commercialisation of its results, notably from the point of view of the requirements of public health, safety, environmental protection, animal welfare, the preservation of genetic diversity and compliance with certain ethical standards;
- (15) Whereas no prohibition or exclusion exists in national or European patent law (Munich Convention) which precludes a priori the patentability of biological matter;
- (16) Whereas patent law must be applied so as to respect the fundamental principles safeguarding the dignity and integrity of the person; whereas it is important to assert the principle that the human body, at any stage in its formation or development, including germ cells, and the simple discovery of one of its elements or one of its products, including the sequence or partial sequence of a human gene, cannot be patented; whereas these principles are in line with the criteria of patentability proper to patent law, whereby a mere discovery cannot be patented;
- (17) Whereas significant progress in the treatment of diseases has already been made thanks to the existence of medicinal products derived from elements isolated from the human body and/or otherwise produced, such medicinal products resulting from technical processes aimed at obtaining elements similar in structure to those existing naturally in the human body and whereas, consequently, research aimed at obtaining and isolating such elements valuable to medicinal production should be encouraged by means of the patent system;
- (18) Whereas, since the patent system provides insufficient incentive for encouraging research into and production of biotechnological medicines which are needed to combat rare or 'orphan' diseases, the Community and the Member States have a duty to respond adequately to this problem;
- (19) Whereas account has been taken of Opinion No 8 of the Group of Advisers on the Ethical Implications of Biotechnology to the European Commission;
- (20) Whereas, therefore, it should be made clear that an invention based on an element isolated

from the human body or otherwise produced by means of a technical process, which is susceptible of industrial application, is not excluded from patentability, even where the structure of that element is identical to that of a natural element, given that the rights conferred by the patent do not extend to the human body and its elements in their natural environment;

- (21) Whereas such an element isolated from the human body or otherwise produced is not excluded from patentability since it is, for example, the result of technical processes used to identify, purify and classify it and to reproduce it outside the human body, techniques which human beings alone are capable of putting into practice and which nature is incapable of accomplishing by itself;
- (22) Whereas the discussion on the patentability of sequences or partial sequences of genes is controversial; whereas, according to this Directive, the granting of a patent for inventions which concern such sequences or partial sequences should be subject to the same criteria of patentability as in all other areas of technology: novelty, inventive step and industrial application; whereas the industrial application of a sequence or partial sequence must be disclosed in the patent application as filed;
- (23) Whereas a mere DNA sequence without indication of a function does not contain any technical information and is therefore not a patentable invention;
- (24) Whereas, in order to comply with the industrial application criterion it is necessary in cases where a sequence or partial sequence of a gene is used to produce a protein or part of a protein, to specify which protein or part of a protein is produced or what function it performs;
- (25) Whereas, for the purposes of interpreting rights conferred by a patent, when sequences overlap only in parts which are not essential to the invention, each sequence will be considered as an independent sequence in patent law terms;
- (26) Whereas if an invention is based on biological material of human origin or if it uses such material, where a patent application is filed, the person from whose body the material is taken must have had an opportunity of expressing free and informed consent thereto, in accordance with national law;
- (27) Whereas if an invention is based on biological material of plant or animal origin or if it uses such material, the patent application should, where appropriate, include information on the geographical origin of such material, if known; whereas this is without prejudice to the processing of patent applications or the validity of rights arising from granted patents;
- (28) Whereas this Directive does not in any way affect the basis of current patent law, according to which a patent may be granted for any new application of a patented product;
- (29) Whereas this Directive is without prejudice to the exclusion of plant and animal varieties from patentability; whereas on the other hand inventions which concern plants or animals are patentable provided that the application of the invention is not technically confined to a single plant or animal variety;
- (30) Whereas the concept 'plant variety' is defined by the legislation protecting new varieties, pursuant to which a variety is defined by its whole genome and therefore possesses individuality and is clearly distinguishable from other varieties;
- (31) Whereas a plant grouping which is characterised by a particular gene (and not its whole genome) is not covered by the protection of new varieties and is therefore not excluded from patentability even if it comprises new varieties of plants;
- (32) Whereas, however, if an invention consists only in genetically modifying a particular plant

- variety, and if a new plant variety is bred, it will still be excluded from patentability even if the genetic modification is the result not of an essentially biological process but of a biotechnological process;
- (33) Whereas it is necessary to define for the purposes of this Directive when a process for the breeding of plants and animals is essentially biological;
- (34) Whereas this Directive shall be without prejudice to concepts of invention and discovery, as developed by national, European or international patent law;
- (35) Whereas this Directive shall be without prejudice to the provisions of national patent law whereby processes for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body are excluded from patentability;
- (36) Whereas the TRIPs Agreement provides for the possibility that members of the World Trade Organisation may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect ordre public or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law;
- (37) Whereas the principle whereby inventions must be excluded from patentability where their commercial exploitation offends against ordre public or morality must also be stressed in this Directive;
- (38) Whereas the operative part of this Directive should also include an illustrative list of inventions excluded from patentability so as to provide national courts and patent offices with a general guide to interpreting the reference to ordre public and morality; whereas this list obviously cannot presume to be exhaustive; whereas processes, the use of which offend against human dignity, such as processes to produce chimeras from germ cells or totipotent cells of humans and animals, are obviously also excluded from patentability;
- (39) Whereas ordre public and morality correspond in particular to ethical or moral principles recognised in a Member State, respect for which is particularly important in the field of biotechnology in view of the potential scope of inventions in this field and their inherent relationship to living matter; whereas such ethical or moral principles supplement the standard legal examinations under patent law regardless of the technical field of the invention;
- (40) Whereas there is a consensus within the Community that interventions in the human germ line and the cloning of human beings offends against ordre public and morality; whereas it is therefore important to exclude unequivocally from patentability processes for modifying the germ line genetic identity of human beings and processes for cloning human beings;
- (41) Whereas a process for cloning human beings may be defined as any process, including techniques of embryo splitting, designed to create a human being with the same nuclear genetic information as another living or deceased human being;
- (42) Whereas, moreover, uses of human embryos for industrial or commercial purposes must also be excluded from patentability; whereas in any case such exclusion does not affect inventions for therapeutic or diagnostic purposes which are applied to the human embryo and are useful to it;
- (43) Whereas pursuant to Article F(2) of the Treaty on European Union, the Union is to respect fundamental rights, as guaranteed by the European Convention for the Protection of Human Rights and Fundamental Freedoms signed in Rome on 4 November 1950 and as they result from the constitutional traditions common to the Member States, as general principles of Community law;
- (44) Whereas the Commission's European Group on Ethics in Science and New Technologies evaluates

all ethical aspects of biotechnology; whereas it should be pointed out in this connection that that Group may be consulted only where biotechnology is to be evaluated at the level of basic ethical principles, including where it is consulted on patent law;

- (45) Whereas processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit in terms of research, prevention, diagnosis or therapy to man or animal, and also animals resulting from such processes, must be excluded from patentability;
- (46) Whereas, in view of the fact that the function of a patent is to reward the inventor for his creative efforts by granting an exclusive but time-bound right, and thereby encourage inventive activities, the holder of the patent should be entitled to prohibit the use of patented self-reproducing material in situations analogous to those where it would be permitted to prohibit the use of patented, non-self-reproducing products, that is to say the production of the patented product itself;
- (47) Whereas it is necessary to provide for a first derogation from the rights of the holder of the patent when the propagating material incorporating the protected invention is sold to a farmer for farming purposes by the holder of the patent or with his consent; whereas that initial derogation must authorise the farmer to use the product of his harvest for further multiplication or propagation on his own farm; whereas the extent and the conditions of that derogation must be limited in accordance with the extent and conditions set out in Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights (6);
- (48) Whereas only the fee envisaged under Community law relating to plant variety rights as a condition for applying the derogation from Community plant variety rights can be required of the farmer;
- (49) Whereas, however, the holder of the patent may defend his rights against a farmer abusing the derogation or against a breeder who has developed a plant variety incorporating the protected invention if the latter fails to adhere to his commitments;
- (50) Whereas a second derogation from the rights of the holder of the patent must authorise the farmer to use protected livestock for agricultural purposes;
- (51) Whereas the extent and the conditions of that second derogation must be determined by national laws, regulations and practices, since there is no Community legislation on animal variety rights;
- (52) Whereas, in the field of exploitation of new plant characteristics resulting from genetic engineering, guaranteed access must, on payment of a fee, be granted in the form of a compulsory licence where, in relation to the genus or species concerned, the plant variety represents significant technical progress of considerable economic interest compared to the invention claimed in the patent;
- (53) Whereas, in the field of the use of new plant characteristics resulting from new plant varieties in genetic engineering, guaranteed access must, on payment of a fee, be granted in the form of a compulsory licence where the invention represents significant technical progress of considerable economic interest;
- (54) Whereas Article 34 of the TRIPs Agreement contains detailed provisions on the burden of proof which is binding on all Member States; whereas, therefore, a provision in this Directive is not necessary;
- (55) Whereas following Decision 93/626/EEC (7) the Community is party to the Convention on Biological Diversity of 5 June 1992; whereas, in this regard, Member States must give particular weight to Article 3 and Article 8(j), the second sentence of Article 16(2) and Article 16(5) of the Convention when bringing into force the laws, regulations and administrative provisions necessary

to comply with this Directive;

- (56) Whereas the Third Conference of the Parties to the Biodiversity Convention, which took place in November 1996, noted in Decision III/17 that 'further work is required to help develop a common appreciation of the relationship between intellectual property rights and the relevant provisions of the TRIPs Agreement and the Convention on Biological Diversity, in particular on issues relating to technology transfer and conservation and sustainable use of biological diversity and the fair and equitable sharing of benefits arising out of the use of genetic resources, including the protection of knowledge, innovations and practices of indigenous and local communities embodying traditional lifestyles relevant for the conservation and sustainable use of biological diversity`,

HAVE ADOPTED THIS DIRECTIVE:

CHAPTER I Patentability

Article 1

1. Member States shall protect biotechnological inventions under national patent law. They shall, if necessary, adjust their national patent law to take account of the provisions of this Directive.
2. This Directive shall be without prejudice to the obligations of the Member States pursuant to international agreements, and in particular the TRIPs Agreement and the Convention on Biological Diversity.

Article 2

1. For the purposes of this Directive,
 - (a) 'biological material` means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system;
 - (b) 'microbiological process` means any process involving or performed upon or resulting in microbiological material.
2. A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection.
3. The concept of 'plant variety` is defined by Article 5 of Regulation (EC) No 2100/94.

Article 3

1. For the purposes of this Directive, inventions which are new, which involve an inventive step and which are susceptible of industrial application shall be patentable even if they concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used.
2. Biological material which is isolated from its natural environment or produced by means of a technical process may be the subject of an invention even if it previously occurred in nature.

Article 4

1. The following shall not be patentable:

- (a) plant and animal varieties;
- (b) essentially biological processes for the production of plants or animals.

2. Inventions which concern plants or animals shall be patentable if the technical feasibility of the invention is not confined to a particular plant or animal variety.

3. Paragraph 1(b) shall be without prejudice to the patentability of inventions which concern a microbiological or other technical process or a product obtained by means of such a process.

Article 5

1. The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.

2. An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.

3. The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.

Article 6

1. Inventions shall be considered unpatentable where their commercial exploitation would be contrary to ordre public or morality; however, exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation.

2. On the basis of paragraph 1, the following, in particular, shall be considered unpatentable:

- (a) processes for cloning human beings;
- (b) processes for modifying the germ line genetic identity of human beings;
- (c) uses of human embryos for industrial or commercial purposes;
- (d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

Article 7

The Commission's European Group on Ethics in Science and New Technologies evaluates all ethical aspects of biotechnology.

CHAPTER II Scope of protection

Article 8

1. The protection conferred by a patent on a biological material possessing specific characteristics as a result of the invention shall extend to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.
2. The protection conferred by a patent on a process that enables a biological material to be produced possessing specific characteristics as a result of the invention shall extend to biological material directly obtained through that process and to any other biological material derived from the directly obtained biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

Article 9

The protection conferred by a patent on a product containing or consisting of genetic information shall extend to all material, save as provided in Article 5(1), in which the product is incorporated and in which the genetic information is contained and performs its function.

Article 10

The protection referred to in Articles 8 and 9 shall not extend to biological material obtained from the propagation or multiplication of biological material placed on the market in the territory of a Member State by the holder of the patent or with his consent, where the multiplication or propagation necessarily results from the application for which the biological material was marketed, provided that the material obtained is not subsequently used for other propagation or multiplication.

Article 11

1. By way of derogation from Articles 8 and 9, the sale or other form of commercialisation of plant propagating material to a farmer by the holder of the patent or with his consent for agricultural use implies authorisation for the farmer to use the product of his harvest for propagation or multiplication by him on his own farm, the extent and conditions of this derogation corresponding to those under Article 14 of Regulation (EC) No 2100/94.
2. By way of derogation from Articles 8 and 9, the sale or any other form of commercialisation of breeding stock or other animal reproductive material to a farmer by the holder of the patent or with his consent implies authorisation for the farmer to use the protected livestock for an agricultural purpose. This includes making the animal or other animal reproductive material available for the purposes of pursuing his agricultural activity but not sale within the framework or for the purpose of a commercial reproduction activity.
3. The extent and the conditions of the derogation provided for in paragraph 2 shall be determined

by national laws, regulations and practices.

CHAPTER III Compulsory cross-licensing

Article 12

1. Where a breeder cannot acquire or exploit a plant variety right without infringing a prior patent, he may apply for a compulsory licence for non-exclusive use of the invention protected by the patent inasmuch as the licence is necessary for the exploitation of the plant variety to be protected, subject to payment of an appropriate royalty. Member States shall provide that, where such a licence is granted, the holder of the patent will be entitled to a cross-licence on reasonable terms to use the protected variety.

2. Where the holder of a patent concerning a biotechnological invention cannot exploit it without infringing a prior plant variety right, he may apply for a compulsory licence for non-exclusive use of the plant variety protected by that right, subject to payment of an appropriate royalty. Member States shall provide that, where such a licence is granted, the holder of the variety right will be entitled to a cross-licence on reasonable terms to use the protected invention.

3. Applicants for the licences referred to in paragraphs 1 and 2 must demonstrate that:

- (a) they have applied unsuccessfully to the holder of the patent or of the plant variety right to obtain a contractual licence;
- (b) the plant variety or the invention constitutes significant technical progress of considerable economic interest compared with the invention claimed in the patent or the protected plant variety.

4. Each Member State shall designate the authority or authorities responsible for granting the licence. Where a licence for a plant variety can be granted only by the Community Plant Variety Office, Article 29 of Regulation (EC) No 2100/94 shall apply.

CHAPTER IV Deposit, access and re-deposit of a biological material

Article 13

1. Where an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in a patent application in such a manner as to enable the invention to be reproduced by a person skilled in the art, the description shall be considered inadequate for the purposes of patent law unless:

- (a) the biological material has been deposited no later than the date on which the patent application was filed with a recognised depositary institution. At least the international depositary authorities which acquired this status by virtue of Article 7 of the Budapest Treaty of 28 April 1977 on the international recognition of the deposit of micro-organisms for the purposes of patent procedure, hereinafter referred to as the 'Budapest Treaty', shall be recognised;
- (b) the application as filed contains such relevant information as is available to the applicant on the characteristics of the biological material deposited;
- (c) the patent application states the name of the depositary institution and the accession number.

2. Access to the deposited biological material shall be provided through the supply of a sample:

-
- (a) up to the first publication of the patent application, only to those persons who are authorised under national patent law;
- (b) between the first publication of the application and the granting of the patent, to anyone requesting it or, if the applicant so requests, only to an independent expert;
- (c) after the patent has been granted, and notwithstanding revocation or cancellation of the patent, to anyone requesting it.
3. The sample shall be supplied only if the person requesting it undertakes, for the term during which the patent is in force:
- (a) not to make it or any material derived from it available to third parties; and
- (b) not to use it or any material derived from it except for experimental purposes, unless the applicant for or proprietor of the patent, as applicable, expressly waives such an undertaking.
4. At the applicant's request, where an application is refused or withdrawn, access to the deposited material shall be limited to an independent expert for 20 years from the date on which the patent application was filed. In that case, paragraph 3 shall apply.
5. The applicant's requests referred to in point (b) of paragraph 2 and in paragraph 4 may only be made up to the date on which the technical preparations for publishing the patent application are deemed to have been completed.

Article 14

1. If the biological material deposited in accordance with Article 13 ceases to be available from the recognised depositary institution, a new deposit of the material shall be permitted on the same terms as those laid down in the Budapest Treaty.
2. Any new deposit shall be accompanied by a statement signed by the depositor certifying that the newly deposited biological material is the same as that originally deposited.

CHAPTER V Final provisions

Article 15

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive not later than 30 July 2000. They shall forthwith inform the Commission thereof.

When Member States adopt these measures, they shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such reference shall be laid down by Member States.

2. Member States shall communicate to the Commission the text of the provisions of national law which they adopt in the field covered by this Directive.

Article 16

The Commission shall send the European Parliament and the Council:

- (a) every five years as from the date specified in Article 15(1) a report on any problems encountered with regard to the relationship between this Directive and international agreements on the protection of human rights to which the Member States have acceded;
- (b) within two years of entry into force of this Directive, a report assessing the implications for basic genetic engineering research of failure to publish, or late publication of, papers on subjects which could be patentable;
- (c) annually as from the date specified in Article 15(1), a report on the development and implications of patent law in the field of biotechnology and genetic engineering.

Article 17

This Directive shall enter into force on the day of its publication in the Official Journal of the European Communities.

Article 18

This Directive is addressed to the Member States.

Done at Brussels, 6 July 1998.

For the European Parliament

The President

J. M. GIL-ROBLES

For the Council

The President

R. EDLINGER

- (1) OJ C 296, 8.10.1996, p. 4 and OJ C 311, 11.10.1997, p. 12.
- (2) OJ C 295, 7.10.1996, p. 11.
- (3) Opinion of the European Parliament of 16 July 1997 (OJ C 286, 22.9.1997, p. 87). Council Common Position of 26 February 1998 (OJ C 110, 8.4.1998, p. 17) and Decision of the European Parliament of 12 May 1998 (OJ C 167, 1.6.1998). Council Decision of 16 June 1998.
- (4) OJ C 68, 20.3.1995, p. 26.
- (5) OJ L 336, 23.12.1994, p. 213.
- (6) OJ L 227, 1.9.1994, p. 1. Regulation as amended by Regulation (EC) No 2506/95 (OJ L 258, 28.10.1995, p. 3).
- (7) OJ L 309, 31.12.1993, p. 1.

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BELPROV

1. - Loi du 28 avril 2005 modifiant la loi du 28 mars 1984 sur les brevets d'invention, en ce qui concerne la brevetabilité des inventions biotechnologique.
2. - Loi du 28 avril 2005 modifiant la loi du 28 mars 1984 sur les brevets d'invention, en ce qui concerne la brevetabilité des inventions biotechnologique.

DEUPROV

1. - Gesetz zur Umsetzung der Richtlinie über den rechtlichen Schutz biotechnologischer Erfindungen; Verordnung über die Hinterlegung von biologischem Material in Patent- und Gebrauchsmusterverfahren
2. - Gesetz

DNKPROV

1. - Lov nr 412 af 31 maj 2000
2. - Bekendtgørelse om ændring af bekendtgørelse om patenter og supplerende beskyttelsescertifikater. ref: Bekendtgørelse nr. 1086 af 11/2000

ESPPROV

1. - Ley 10/2002, de 29 de abril, por la que se modifica la Ley 11/1986, de 20 de marzo, de Patentes, para la incorporacion al Derecho español de la Directiva 98/44/CE, del Parlamento Europeo y del Consejo, de 6 de julio, relativa a la proteccion juridica de las invenciones biotecnologicas BOE n° 103 de 30/04/2002, page 15691

FRAPROV

1. - Loi n° 2004-800 du 6/8/2004 relative à la bioéthique.
2. - Loi n° 2004-1338 du 8/12/2004 relative à la protection des inventions biotechnologiques.

GRCPROV

NO REFERENCE AVAILABLE

IRLPROV

NO REFERENCE AVAILABLE

ITAPROV

NO REFERENCE AVAILABLE

LUXPROV

NO REFERENCE AVAILABLE

NLDPROV

1. - Rijkswet van 10 november 2004 tot wijziging van de rijkswet, houdende wijziging van de Rijksoctrooiwet, de Rijksoctrooiwet 1995 en de Zaaizaad- en Plantgoedwet ten behoeve van de rechtsbescherming van biotechnologische uitvindingen
2. - Besluit van 10 november 2004 tot vaststelling van het tijdstip van inwerkingtreding van de rijkswet houdende wijziging van de Rijksoctrooiwet, de Rijksoctrooiwet 1995 en de Zaaizaad- en Plantgoedwet ten behoeve van de rechtsbescherming van biotechnologische uitvindingen

3. - Rijkswet van 10 november 2004 houdende wijziging van de Rijksoctrooiwet, de Rijksoctrooiwet 1995 en de Zaaizaad- en Plantgoedwet ten behoeve van de rechtsbescherming van biotechnologische uitvindingen
4. - Besluit van 10 november 2004 tot wijziging van het Uitvoeringsbesluit Rijksoctrooiwet 1995 in verband met het depot van ander biologisch materiaal dan micro-organismen

PRTPROV

1. - Decreto-Lei n° 36/2003 de 05/03/2003 Diario da Republica I Serie A n° 54 du 05/03/2003 p. 1501

GBRPROV

1. - The Patents and Plant Variety Rights (Compulsory Licensing) Regulations 2002 S.I. n° 247 of 2002, coming into force 01/03/2002

Implementing SIs

['*' indicates information added by Justis Publishing]

- *The Patents Regulations 2000, SI 2000/2037
- *The Patents and Plant Variety Rights (Compulsory Licensing) Regulations 2002, SI 2002/247

AUTPROV

1. - Biotechnologie-Richtlinie - Umsetzungsnovelle Bundesgesetz, mit dem das Patentgesetz 1970, das Patentverträge-Einführungsgesetz, das Gebrauchsmustergesetz, das Halbleiterschutzgesetz und das Sortenschutzgesetz 2001 geändert werden

SVEPROV

NO REFERENCE AVAILABLE

FINPROV

NO REFERENCE AVAILABLE

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1. - Zakon o ochrane biotechnologickuch vynalezu a o zmene zakona c. 132/1989 Sb., o ochane prav k novum odrudam rostlin a plemenum zvírat, ve znení zakona c. 93/1996 Sb.

2. - Zakon o uvadní do obhu osiva a sadby pstovanuch rostlin a o zmn nkteruch zakon (zakon o obhu osiva a sadby)

3. - Zakon o vynalezech, prmyslovuch vzorech a zlepovacích navrzích

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1. - Patendiseadus

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1. - () 2002

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1. - Patentu likums

2. - entisks izptes krtba

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1. - Lietuvos Respublikos patent statymas Nr. I-372

2. - Lietuvos Respublikos patent statymo 7, 8, 22 straipsni pakeitimo ir papildymo statymas Nr. VIII-590

3. - Lietuvos Respublikos Patent statymo 26, 39, 40 straipsni pakeitimo ir papildymo bei 38 straipsnio pripainimo netekusiu galios statymas Nr. VIII-1738

4. - Lietuvos Respublikos patent statymo papildymo 41(1) straipsniu statymas Nr. IX-118

5. - Lietuvos Respublikos Patent statymo 2, 6, 26, 31, 41 straipsni pakeitimo ir statymo papildymo 27(1) straipsniu statymas Nr. IX-568

6. - Lietuvos Respublikos patent statymo preambuls, 2, 4, 10, 11, 13, 19, 21, 24, 26, 39, 40, 48, 50 straipsni pakeitimo bei papildymo ir statymo papildymo 28(1), 38 straipsniais, X(1) skirsniu ir priedu statymas Nr. X-287

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1. - 2002. évi XXXIX. törvénya talalmanyok szabadalmi oltalmarol szolo 1995. évi XXXIII. törvény modositasarol

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1. - CHAPTER 417 PATENTS AND DESIGNS ACT

:

1. - Ustawa z dnia 30 czerwca 2000 r. - Prawo wasnoci przemysowej

:

1. - Zakon. 435/2001 Z. z. o patentoch, dodatkovuch ochrannuch osvedeniach a o zmene a doplnení niektoruch zakonov (patentovu zakon)

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1. - Zakon o industrijski lastnini - uradno preieno besedilo, (Ur.l. RS, t. 7/2003)

2. - Uredba o pravnem varstvu biotehnolokih izumov, (Ur.l. RS, t. 81/2003)

3. - Pravilnik o vsebini patentne prijave in postopku z deljenimi patenti, (Ur.l. RS, t. 102/2001)

4. - Zakon o varstvu novih sort rastlin, (Ur.l. RS, t. 86/1998)

5. - Pravilnik o pogojih za uporabo pridelka zavarovane sorte za nadaljnjo setev in o kriterijih za male kmete, (Ur.l. RS, t. 82/1999)

6. - Zakon o industrijski lastnini

7. - Zakon o industrijski lastnini - uradno preieno besedilo

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Legal protection of biotechnological inventions Frequently Asked Questions on scope and objectives of the EU Directive (98/44)

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Brussels, 3 July 2000

Legal protection of biotechnological inventions Frequently Asked Questions on scope and objectives of the EU Directive (98/44)

A number of questions have been raised recently concerning the Directive (98/44) of the EU's Council of Ministers and the European Parliament on the legal protection of biotechnological inventions, the so-called 'biotech patents Directive'. For example, there have been questions raised as to how the Directive affects access to the human genome data and possible restrictions on the research and applications for which this data could be used. The following set of answers to a number of Frequently Asked Questions (FAQ) is intended to clarify and explain the provisions of the Directive and to allay any concerns.

Why are patents necessary in the area of biotechnology?

Patents provide an incentive to innovation. Without the safeguard provided by patents, industry and other inventors would be unwilling to invest their time and money in research and development. This applies to biotechnology as well as any other area of technology. Indeed given the considerable amount of high risk investment that is often required in the area of biotechnology, particularly in the field of genetic engineering, adequate patent protection is even more essential to encourage the investment required to create jobs and maintain the European Union's competitiveness in this crucial field. Indeed, the key role of adequate patent protection in the creation of a dynamic; knowledge based economy was explicitly underlined by the March 2000 Lisbon Summit conclusions.

This is why Directive 98/44 on the legal protection of biotechnological inventions was proposed and, after lengthy and thorough discussions within the European Parliament and among Member States, adopted.

Much consideration was given during those discussions to the ethical aspects of biotechnological inventions. The resulting Directive both addresses these ethical aspects and provides the necessary incentives to encourage the research and development.

Can the discovery of DNA or the human genome be patented under the Biotech Patents Directive?

No. Neither DNA nor the human genome can be patented under the Biotech Patents Directive because they are not inventions but discoveries i.e. they existed already, they extend knowledge but that knowledge has thereafter to be applied to be technically useful.

The Directive states explicitly that discoveries cannot be patented. Yet, it also states that the patentability of an industrial process or a product received as a result of such a process is not prevented by the mere fact that during this industrial application DNA is used. In fact, in this case it is not the DNA as such that is patented but the industrial application or isolation process using DNA.

Surely all biotechnological inventions which deal with human, vegetable, or animal genes involve materials which already occur in nature and can therefore under no circumstances be invented, but only discovered?

Discoveries, which do not extend human ability, but only human knowledge, are by their very nature not patentable. This is certainly the case with the mere sequencing of a genome which belongs to the area of discovery and for that reason alone cannot be the subject of patent protection. The Directive confirms and reinforces this position.

It is different however if a DNA sequence is released from its natural surroundings by means of a technical procedure and is made available for the first time to a commercial application. Here there is a step taken from knowing to being able. Such a gene is new in the patent sense and therefore patentable, if it was not previously accessible to the public as such, and thus technically was not available.

The position that was agreed by both the European Parliament and the Council of Ministers after much discussion was that patents for inventions comprising of, or based on, gene sequences should be allowed. This position took account of the Opinion of the Group of Advisers on the Ethical Implications of Biotechnology to the European Commission. Indeed the Group of Advisers fully recognised the stimulus provided by patents for medical research.

The Directive therefore provides that inventions based, on or comprising of, gene sequences or partial gene sequences can be patented provided that they satisfy the normal criteria for any invention namely that they are novel, involve an inventive step and are capable of industrial application. In this last respect, the Directive took account of some of the controversy surrounding some of the earlier patent applications for gene sequences that were filed and indeed granted before the Directive was agreed. In particular the Directive makes clear that patents should not be granted where the application does not include specific reference to the industrial application of the gene sequence.

But isn't the Directive unclear on whether gene-based inventions can be patented?

The relevant provision in the Directive relating to this issue is Article 5. Concerns have been expressed is that there is a contradiction between the first two paragraphs of this article. The first paragraph provides that the human body, at the various stages of its formation

and development, and the simple **discovery** of one of its elements, including the sequence or partial sequence of a gene cannot constitute patentable inventions (emphasis added). This paragraph is clearly in line with the basic principle that discoveries are not patentable.

The second paragraph of Article 5 states however that an element **isolated** from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element. As noted above, the invention arises from the isolation of a particular gene from its natural surroundings by means of a technical process. Of course to be patentable, that invention would still need to satisfy the criteria of novelty, inventiveness and industrial applicability.

Paragraphs 1 and 2 are therefore consistent with each other.

Let us take a hypothetical example. Since the human genome provides information related to growth and repair, it may be possible to take a DNA sequence and to isolate from it a particular gene that relates to hair loss. Company A wants to develop a shampoo for baldness. It successfully develops a way to isolate the gene responsible for baldness from the DNA sequence. The underlying genetic material remains free - other researchers can do work on growth and repair. But the **technique** developed to isolate the gene is hugely complex, involving identification, purification and classification techniques which are costly to develop. Without human intervention, it would have been impossible to isolate the gene. The isolation process cannot therefore be said to occur in nature and the product the isolated gene - can be patented. It is a "new" in terms of patent law, involves an inventive step and has industrial applications. By taking out a patent, Company A has protected the considerable investment made in its invention.

But aren't the techniques for isolating and even determining the function of particular genes now becoming more routine?

The rapid advancement of the technology and our understanding in this area has indeed made the isolation and manufacture of genes more straightforward. It may also be possible now to deduce the function of a gene from a computer based comparison with other genes. These advances in technology are taken into account when a patent is examined in particular in respect of whether the invention in the patent application possesses an inventive step. If it is decided by either the patent offices or the national courts that there is no inventive step then the patent will either be refused or revoked.

But patents for gene based inventions will surely inhibit research in the area of gene technology and restrict access and use of the data on the human genome?

The raw fundamental data on the human genome that has been, and is still being, produced by the Human Genome Project (HUGO) and private sector companies is not patentable. Therefore access to that data will not be restricted or encumbered by patents. Intellectual property protection for gene based inventions will however play an important role in stimulating investment into using this raw data on the human genome to develop important new products, for example in the area of health care.

Moreover all patent systems in Europe include exceptions to the rights provided by a patent so as to allow for research and experimentation on the subject matter covered by a patent. In addition, safeguards such as compulsory licences are provided to ensure that patent holders do not abuse their rights for example by charging unreasonable fees for the use of their inventions.

Finally, the requirement to fully disclose the invention in the patent application brings into the public domain for use by other researchers information that might otherwise be kept secret.

Does the Directive allow for methods of cloning human beings to be patented?

No. Article 6 of the Directive clearly states that the following are not patentable on the basis that their commercial exploitation would be contrary to the public order or morality:

- Processes for cloning human beings;
- Processes for modifying the germ line genetic identity of human beings;
- Uses of human embryos for industrial and commercial purposes;
- Processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

This is precisely why European Patent EP 69 53 51 on transgenic stem cells granted by the European Patent Office to the University of Edinburgh in December 1999 would have been illegal under the terms of Article 6 of the Directive.

Does the Directive override national laws governing for example research activities?

No. The biotech patents Directive determines only what, in terms of patent law, can and cannot be patented. A patent does not give any positive right to use an invention. The use of any invention, and indeed the research and development leading up to that invention, are still governed by general national and European laws.

For example, take the case of genetically-modified organisms (GMOs). The biotech patents Directive makes it possible to patent both the process for genetically modifying plants and also the resulting plants, although not a particular variety of plant. However, if a Member State legislates against the planting of GMO crops, then the patent holder still cannot grow that crop in that Member State.

When must the Directive be implemented by the Member States?

The Directive must be implemented by the 30th July 2000. The Commission is working with the Member States to help them to implement the Directive correctly and on time and has already started to receive notifications of implementing regulations from the Member States.

As the Netherlands has already challenged the legality of this Directive, what incentive is there for Member States to implement it by the 30th July deadline?

The Biotech Patents Directive was approved by a majority of Member States and by the European Parliament in 1998 after lengthy discussions. It is hence existing Community law. EU rules provide that any Member State may challenge EU legislation, for example regarding the underlying legal base. However, until such time that the European Court of Justice has ruled on the issue (and the timing of that is up to the Court), all Member States are bound by the existing law. In this case the ECJ has not yet set a date for a hearing and so all Member States must implement the Directive by 30th July.

Does the Commission plan any further initiatives in the area of patents and biotechnology?

No. That said, as with all legislation, the Commission will monitor the Directive to ensure that its scope of protection remains relevant to the rapid technological developments that are likely in this field and also that it remains in line with the public's attitude to this area of technology. As required by the Directive, the Commission will make reports to the European Parliament and to the Council on a regular basis on the development and implications of patent law in the field of biotechnology and genetic engineering.

Useful Links

Text of Directive EC 98/44 on the legal protection of biotechnological inventions

http://europa.eu.int/eur-lex/en/lif/dat/1998/en_398L0044.html

Opinion No. 8 of the Group of Advisors on the Ethical Implications of biotechnology to the European Commission

http://europa.eu.int/comm/secretariat_general/sgc/ethics/oldversion/en/opinion8.pdf

Further information on the Directive

http://www.ipr-helpdesk.org/t_en/i/i_410_en.asp?adt_id=817&ads=0

STATE OF PLAY OF THE IMPLEMENTATION OF DIRECTIVE 98/44/EC
(Last revision 9-06-2006)

COUNTRY		STATE OF PLAY OF THE IMPLEMENTATION GENERAL REMARKS	IMPLEMENTATION DATE
MEMBER STATES (25)			
AT	AUSTRIA	<p><u>16-5-2000:</u> Bill submitted to Parliament. However, due to the election and the Parliament's dissolution (autumn 2002) the AT authorities are obliged to re-submit a new bill to Parliament.</p> <p><u>8-10-2003:</u> Inquiry of the Parliament relating to the directive.</p> <p><u>14-9-2004:</u> New Bill approved by Ministers and submitted to Parliament.</p> <p><u>12-5-2005:</u> The first reading has been completed by Nationalrat.</p> <p>Law BGBl. I Nr. 42/2005 - Publication on <u>09-06-2005</u></p>	<u>09 June 2005</u>
BE	BELGIUM	<p><u>14-6-2001:</u> Bill adopted by Government. Bill submitted to Parliament before the Summer break 2002. Due to the election which took place on <u>18-05-2003</u>, the BE authorities were obliged to re-submit a new bill to the Parliament. An urgent advice of the "Raad van State" (Council of the State) has been requested on this proposed text and then this proposal is to go to the Parliament. A text was being discussed in Parliament in November 2004</p> <p>The Bill was approved at the Chamber of Representatives on <u>10-03-2005</u> and the Senate on <u>14-04-2005</u>.</p> <p>Law of <u>28-04-2005</u>, publication on <u>13-05-2005</u></p>	<u>28 April 2005</u>
CY	CYPRUS	Law N.163(I)/2002, the Patents (Amendment) Law of 2002 as from <u>9-08-2002</u> .	<u>Implemented 2002</u>
CZ	CZECH REPUBLIC	Act No. 206/2000 Coll. L of <u>21-06-2000</u>	Entry into force: <u>01.10.2000</u>
DK	DENMARK	The Danish Parliament (Folketinget) passed the implementing legislation on <u>26-05-2000</u> .	<u>26 May 2000</u>
EE	ESTONIA	Amendments of 1994 Patents Act dated <u>27-10-1999</u>	Entry into force: <u>01.01.2000</u>
DE	GERMANY	<p>A new bill has been unanimously adopted by the Government on <u>25-06-2003</u>. This bill should be discussed in the course of the first semester 2004. Debates were ongoing in Parliament. The first reading has been completed by the Bundesrat by <u>11-03-2004</u>. Due to the general election (September 2002), DE authorities were obliged to re-submit a new bill to Parliament (the former one was dated from 18-10-2000).</p> <p>The Bundestag passed a bill on <u>3-12-2004</u>.</p>	<u>28 February 2005</u>

COUNTRY		STATE OF PLAY OF THE IMPLEMENTATION GENERAL REMARKS	IMPLEMENTATION DATE
		Publication on 28-01-2005 in the Bundesgesetzblatt to be in force on 28-02-2005	
FIN	FINLAND	The Finnish Parliament (Riksdagen) passed the implementing legislation on 30-05-2000 .	<u>30 June 2000</u>
FR	FRANCE	<p>Bill adopted by the Government on 31-10-2001. This bill has never been discussed by the Parliament. However, the main provisions of the directive (art. 5 and 6) have been involved in the revision of the bioethics laws. Other provisions of the directive should be discussed after the adoption of the new laws on bioethics.</p> <ul style="list-style-type: none"> • January 2002: 1st lecture in National Assembly • January 2003: 1st lecture in the Senate • December 2003: 2nd lecture in the N.A. • 6-08-2004: bill adopted in 2nd lecture in the Senate (Law n° 2004-800 published on 7/8/2004). • 29-11-2004: Remaining implementing measures adopted (Law n° 2004-1338 published on 8-12-2004). 	<p><u>7 August 2004</u>: <i>Implementation of Articles 5 and 6</i></p> <p><u>8 December 2004</u>: <i>Remaining implementation achieved</i></p>
GR	GREECE	Presidential Decree no. 321/2001 (OJ 218, A, <u>1-10-2001</u>).	<u>22 October 2001</u>
HU	HUNGARY	Act. XXXIX of 2002	Entry into force: <u>01.01.2003</u>
IRL	IRELAND	European Communities (Legal Protection of Biotechnological Inventions) Regulations, 2000 (S.I. No. 247 of 2000)	<u>30 July 2000</u> : Regulations
IT	ITALY	<p>19-10-1999: Bill submitted to Parliament</p> <p>26-9-2002: Adoption of the bill by the Lower Chamber with amendments.</p> <p>02-04-2003: Adoption by Senate with amendments</p> <p>26-06-2003: Adoption by Lower Chamber with further amendments therefore requires final approval by Senate.</p> <p>2004: Awaiting final approval by the Senate after the amendments made in the last reading by the Lower Chamber. After this, the text should be ready for transposition into law (for which the administration has 6 months from the final approval).</p> <p>29-12-2005: Decree-Law adopted by the Government (Decreto-Legge n.3 del 10 gennaio 2006, published on <u>11-01-2006</u>).</p> <p>Conversion in Law definitively adopted (Legge n.78 del 22 febbraio 2006) published on <u>10-03-2006</u>.</p>	<u>11 March 2006</u>

COUNTRY		STATE OF PLAY OF THE IMPLEMENTATION GENERAL REMARKS	IMPLEMENTATION DATE
LV	LATVIA	<ul style="list-style-type: none"> Modification of the Law relating to Plant Variety Rights (Grozījumi Augu šķirņu aizsardzības likumā), adopted on <u>17-11-2005</u> Modification of the Law relating to Patents (Grozījumi Patentu likumā), adopted on <u>8-12-2005</u> 	<u>29 December 2005</u>
LU	LUXEMBOURG	The bill No 4673 was submitted to Parliament in <u>June 2000</u> . Parliamentary Committee on Ethics in charge of the file expressed its opposition against the bill of law. However, the Government re-submitted the bill to the Parliamentary Committee on Economy in <u>March 2005</u> which made amendments. On <u>11-10-2005</u> the State Council has delivered two opinions on these amendments and the final report from the Committee was adopted on 19-01-2006. Law adopted in plenary on 15-02-2006. Law of <u>7-04-2006</u> published on <u>19-04-2006</u> .	<u>23 April 2006</u>
LT	LITHUANIA	Law of <u>30-06-2005</u> on the Amendments and Supplements of the Preamble, Articles 2, 4, 10, 11, 13, 19, 21, 24, 26, 39, 40, 48, 50 of the Patent Law and Amendments of the Law by Articles 28(1), 38, Section X(1) and an Annex (No X-287). Official Gazette "Valstybes žinios" 2005 No 85-3135	Entry into force: <u>14.07.2005</u>
MT	MALTA	Patents and Designs Act 2002 (Chapter 417 of the Laws of Malta)	Entry into force: <u>01.01.2004</u>
NL	NETHERLANDS	Laws passed <u>10-11-2004</u>	<u>November 2004</u>
PL	POLAND	Ustawa z dnia 30 czerwca 2000 r. - Prawo własności przemysłowej adopted <u>30-06-2000</u>	Entry into force: <u>18.10.2002</u>
PT	PORTUGAL	Bill has been adopted by Parliament. The Minister Council has been definitively adopted on <u>November 2002</u> . The law is entered into force 7 months after this adoption.	<u>1st July 2003</u>
SK	SLOVAK REPUBLIC	Act. No. 435/2001 Coll. Patent Act	Entry into force: <u>01.11.2001</u>
SV	SLOVENIA	Decree n° 3873 published on <u>18-08-2003</u>	Entry into force: <u>02.09.2003</u>
ES	SPAIN	The Directive has been implemented by the law 10/2002, dated 29 April and published in the Official Bulletin on <u>30-04-2002</u> .	<u>30 April 2002</u>
SE	SWEDEN	<u>12-12-2003</u> : A bill of a law adopted. <u>1-04-2004</u> : Bill passed by Parliament without amendment.	<u>1st May 2004</u>
GB	UNITED KINGDOM	<ul style="list-style-type: none"> Implementation of Art 1-11. Entered into force on <u>28-07-2000</u> Implementation of Art. 13 and 14 on 	<u>28 July 2000</u> : Implementation of Articles 1-11

COUNTRY		STATE OF PLAY OF THE IMPLEMENTATION GENERAL REMARKS	IMPLEMENTATION DATE
		<p><u>6-07-2001</u></p> <ul style="list-style-type: none"> Implementation of Art 12. Entered into force on <u>1-03-2002</u> 	<p><u>6 July 2001:</u> <i>Implementation of Articles 13-14</i></p> <p><u>1 March 2002:</u> <i>Implementation of Article 12</i></p>

ACCEDING COUNTRIES

<i>BG</i>	<i>BULGARIA</i>	Draft law expected to be adopted soon.	
<i>RO</i>	<i>ROMANIA</i>	Patent Law No. 64/1991, as amended and completed by Law No. 203/2002 of 19 April 2002 (OJ Nr. 212/1991, Nr. 340/2002) approved by Government Decision No.499/2003 of 18 April 2003 (OJ Nr. 348 of 22 May 2003)	<i>Entry into force: <u>22.05.2003</u></i>

CANDIDATE COUNTRIES


<i>HR</i>	<i>CROATIA</i>	Patent Act of <u>8-11-2003</u>	<i>Entry into force: <u>01.01.2004</u></i>
<i>TR</i>	<i>TURKEY</i>	EPC member state. Technical Studies in preparation.	
	<i>FYROM</i>	No information	

EAA COUNTRIES

<i>IC</i>	<i>ICELAND</i>	Iceland has enacted legislation implementing the biotech Directive (Act of <u>15-03-2004</u> , entry into force after publication)	<i>Entry into force: <u>11.05. 2004</u></i>
<i>LI</i>	<i>LIECHTENSTEIN</i>	EPC member state. No information	
<i>NO</i>	<i>NORWAY</i>	Adapted by Parliament by <u>2003</u>	<i>Entry into force: <u>01.02.2004</u></i>

NON EU BUT EPC COUNTRIES

<i>CH</i>	<i>SWITZERLAND</i>	<ul style="list-style-type: none"> <u>07-12-2001:</u> The Swiss Justice- and Police department has opened the notification procedure (Vernehmlassungsverfahren). One of the issues is the adjustment of the Swiss Regulations on the Patenting of biotechnological inventions to the EU provisions. <u>29-11-2002:</u> The Federal Council (Bundesrat) has taken notice of the Report of the results of the notification procedure <u>11-03-2005:</u> The Federal Council authorized the Federal Department of Justice and Police to complete the draft of the revised patent law at its March 11, 2005 session. The draft is supposed to be presented to Parliament in the current year. The draft focuses on appropriate patent protection for Biotech inventions. 	Delayed
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Commission welcomes changes to EU law to allow export of patented medicine to countries in need

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IP/06/550

Brussels, 28 April 2006

Commission welcomes changes to EU law to allow export of patented medicine to countries in need

The European Commission today welcomes the adoption by the European Council of a regulation allowing companies to produce copies of patented medicines under license for export to "countries in need" without sufficient capacity to produce them. The regulation implements within the EU the necessary conditions to meet a WTO Agreement of December 2005, under which national authorities can grant compulsory licences for such production if certain conditions are fulfilled. Yesterday, the European Commission formally recommended that Member States approve EU ratification of the historic changes to WTO law. Today's move is a clear signal of their intention to do so. The compulsory licensing regulation represents a crucial measure for some of the poorest countries in the world, which will gain improved access to affordable medicines which are safe and effective.

Internal Market and Services Commissioner Charlie McCreevy said: "This regulation is a key element in ensuring access to affordable medicines for poor countries. Its rapid adoption highlights the EU's commitment to the implementation of the WTO Decision. Countries in need will acquire affordable medicines which are safe and effective and at the same time the patent system will continue to support investment in the research and development of new medicines".

Trade Commissioner Peter Mandelson said: "This is an important EU contribution to the fight against killer diseases in developing countries. It shows that the EU is committed to the WTO process, and to ensuring that the WTO system can respond to the public health concerns of poor countries in need of affordable medicines."

What was agreed in the WTO in December 2005?

On 6 December 2005, the WTO Members agreed to amend the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). This amendment would make permanent a provisional decision on compulsory licensing originally adopted on 30 August 2003. The WTO General Council has submitted the proposed amendment to the WTO Members for acceptance. Once accepted and in force, this amendment will complete a process that began in 2001 with the Doha Declaration on the TRIPS Agreement and Public Health. The EU strongly supported these changes at every stage.

The existing rules on intellectual property provide that compulsory licences can only be authorised predominantly for the supply of the domestic market. The amendment will allow any WTO Member to export pharmaceutical products made under compulsory licence for the purpose of supplying developing countries with no or insufficient manufacturing capacities in the pharmaceutical sector. The new rules will be formally incorporated into the TRIPS Agreement.

The amendment will take effect for the Members that have accepted it when two thirds of the WTO Members accept the amendment. WTO Members have set themselves until 1 December 2007 to do this. The waiver decision remains in force for each Member until the amendment becomes effective for that Member.

What is being changed at the European level?

The regulation creates a mechanism in line with the WTO General Council Decision of August 2003 so that companies in the EU can apply for a licence to manufacture, without the authorisation of the patent holder, pharmaceutical products for export to countries in need of medicines and facing public health problems. There is no specific restriction on the pharmaceutical products covered, although there is acknowledgement that they are required to address public health problems since that is the context of the Decision.

It represents an instrument that will allow the compulsory licensing procedure of the WTO decision to fit within the context of Member States' national patent law and their compulsory licensing procedures. This is to give transparency and clarity for those companies operating within the EU's internal market and wishing to apply for compulsory licences for export to countries in need.

Provided countries in need notify to the WTO the medicines they need, it would be up to generic companies to decide to apply for licences to manufacture them.

Once export takes place, all parties have an interest in seeing that medicines are not diverted from those who need them. The regulation prohibits re-importation into the EU and provides for customs authorities to take action against goods being re-imported. The patent holder can use existing national procedures to enforce its rights against re-imported goods if they do enter the EU, and the licence can be terminated.

The regulation also foresees a role for non-governmental and international organisations as being potentially involved in any purchasing procedures and able to make requests on behalf of an importing country with that country's approval.

Safety and efficacy of medicines for export can be certified through the EU's scientific opinion procedure, or equivalent national procedures. The EU felt this was a necessary complement to the licensing mechanism in order to assist importing countries.



COMMISSION OF THE EUROPEAN COMMUNITIES

Brussels, 29.10.2004
COM(2004) 737 final

2004/0258 (COD)

Proposal for a

REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL

on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems

(presented by the Commission)

{SEC(2004) 1348}

EXPLANATORY MEMORANDUM

1. BACKGROUND

This proposal aims to implement at Community level the WTO General Council Decision of 30 August 2003 on the Implementation of Paragraph 6 of the Declaration on the TRIPs Agreement and Public Health (WT/L/540 of 2 September 2003).

By waiving WTO Members' obligations under Article 31(f) of the WTO Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs Agreement), this Decision allows WTO Members to grant compulsory licences for the production and sale of patented pharmaceutical products intended for export to third countries with insufficient or no manufacturing capacity in the pharmaceutical sector. It includes substantial safeguards against trade diversion and rules to ensure transparency, and provides for future replacement of the Decision by an amendment to the TRIPs Agreement.

2. NEED FOR A COMMUNITY INTERVENTION

Given the active role played by the European Communities and their Member States in the adoption of the Decision, their commitment made at the WTO to fully contribute to the implementation of the Decision and their appeal to all WTO Members to ensure that the right conditions are put in place to allow the system set up by the Decision to operate efficiently, it is important for the Community to contribute to the system set up by the Decision through implementation in the Community legal order.

Within the Community uniform implementation of the Decision is needed to ensure that the conditions for the granting of compulsory licences for export are the same in all EU Member States, to avoid distortion of competition for operators in the EU single market and to apply uniform rules to prevent re-importation into the territory of the European Union of pharmaceutical products manufactured under compulsory licences.

In view also of the very specific nature of the provisions of the Decision, the fact that national arrangements for compulsory licensing already exist, and the need for urgent action to allow for the export of medicines to countries with public health problems, the Commission proposes implementation by way of a Regulation based on Articles 95 and 133 of the Treaty.

3. PROPOSED PROVISIONS

Article 1

The Regulation sets out a procedure and conditions for the grant of compulsory licences in line with the Decision. While supplementary protection certificates are not mentioned in the Decision, within the EU they entail the same effects as patents and so are included.

Article 2

The definition of the term "pharmaceutical product" is taken from the Decision, with text to reflect the definition of medicinal product in Directive 2001/83/EC.

Article 3

The competent authorities for granting compulsory licences pursuant to the Regulation will be those notified by the Member States.

Article 4

Eligibility is based on notifications and declarations to the WTO.

Article 5

This includes key elements of information required under the Decision and the TRIPs Agreement. The requirement to provide evidence of a specific request to the applicant by the importing country or from its authorised representatives should help ensure effective control of the amount of product supplied under compulsory licences.

Article 6

Competent authorities should verify whether basic conditions to trigger the system set out in the Decision have been met.

Article 7

Paragraph 1 reflects Article 31(b) of the TRIPs Agreement. While the TRIPs Agreement allows this requirement to be waived in the case of a national emergency or other circumstances of extreme urgency, here it is retained (paragraph 2) in view of the speed of modern communications and the desirability of voluntary agreements.

Article 8

This provision takes over the conditions set out in paragraph 2(b) of the Decision. In addition it reflects conditions usually found in licensing agreements.

Article 9

This specifies under which conditions a competent authority can refuse an application.

Article 10

Paragraph 2(c) of the Decision requires the exporting Member to notify the WTO Council for TRIPS about the grant of any licence. As the Commission is the usual interlocutor before the WTO for matters falling under the Common Commercial Policy, such notifications should be made via the Commission.

Articles 11 – 13

These are based on equivalent provisions in Council Regulation (EC) No 953/2003 on trade diversion.

Article 14

Termination of the licence is provided for if (a) the licence conditions are not respected, or (b) the circumstances which led to grant of the licence cease to exist (Article 31(g) of the TRIPs Agreement).

Article 15

Article 31(i) and 31(j)) of the TRIPs Agreement require provision to be made for review of decisions.

Article 16

As the licensee will not necessarily hold a medicinal products marketing authorisation within the EU for the product manufactured under a compulsory licence for export, the Regulation provides for licensees to ask for a scientific opinion from the European or national regulatory authorities if they should need this for export to the country concerned. Derogations from data protection and caducity rules are provided.

Article 17

This provides for review three years after entry into force of the Regulation.

Proposal for a

REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL

on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Articles 95 and 133 thereof,

Having regard to the proposal from the Commission¹,

Having regard to the opinion of the European Economic and Social Committee²,

Acting in accordance with the procedure laid down in Article 251 of the Treaty³,

Whereas:

- (1) On 14 November 2001 the Fourth Ministerial Conference of the World Trade Organisation (WTO) adopted the Doha Declaration on the TRIPS Agreement and Public Health. The Declaration recognises that each WTO Member has the right to grant compulsory licences and the freedom to determine the grounds upon which such licences are granted. It also recognises that WTO Members with insufficient or no manufacturing capacities in the pharmaceutical sector could face difficulties in making effective use of compulsory licensing.
- (2) On 30 August 2003 the General Council of the WTO adopted the Decision on the implementation of Paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health, hereinafter “the Decision”. Subject to conditions, the Decision waives certain obligations concerning the issue of compulsory licences set out in the TRIPS Agreement, to address the needs of WTO Members with insufficient manufacturing capacity.
- (3) Given the Community’s active role in the adoption of the Decision, its commitment made at the WTO to fully contribute to the implementation of the Decision and its appeal to all WTO Members to ensure that conditions are put in place which will allow the system set up by the Decision to operate efficiently, it is important for the Community to implement the Decision in its legal order.

¹ OJ C [...] [...], p.[...]

² OJ C [...] [...], p.[...]

³ OJ C [...] [...], p.[...]

- (4) Uniform implementation of the Decision is needed to ensure that the conditions for the granting of compulsory licences for export are the same in all Member States and to avoid distortion of competition for operators in the single market. Uniform rules should also be applied to prevent re-importation into the territory of the Community of pharmaceutical products manufactured pursuant to this Regulation.
- (5) This Regulation is intended to be part of the wider European and international action to address public health problems faced by least developed countries and other developing countries, and in particular to improve access to affordable medicines.
- (6) As the compulsory licensing system set up by this Regulation is intended to address public health problems, it should be used in good faith. It should not be used with the primary purpose of addressing other objectives, and in particular objectives of a purely commercial nature.
- (7) Products manufactured pursuant to this Regulation should reach those who need them and should not be diverted from those for whom they were intended. Compulsory licences issued under this Regulation should therefore impose clear conditions upon the licensee as regards the acts covered by the licence, the identification of the pharmaceutical products manufactured under the licence and the countries to which these products will be exported.
- (8) Provision should be made for customs action at external borders to deal with products manufactured and sold for export under a compulsory licence and which a person attempts to re-import into the territory of the Community.
- (9) To avoid facilitating overproduction and possible diversion of products, competent authorities should take into account existing compulsory licences for the same products and countries, as well as parallel applications indicated by the applicant,
- (10) Since the objectives of the action to be taken, in particular the establishment of harmonised procedures for the granting of compulsory licences which contribute to the effective implementation of the system set up by the Decision, cannot be sufficiently achieved by the Member States because of the options available to exporting countries under the Decision and can therefore, by reason of the potential effects on operators in the internal market, be better achieved at Community level, the Community may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty. In accordance with the principle of proportionality, as set out in that Article, this Regulation does not go beyond what is necessary in order to achieve those objectives.

HAVE ADOPTED THIS REGULATION:

Article 1

This Regulation establishes a procedure for the grant of compulsory licences in relation to patents and supplementary protection certificates concerning the manufacture and sale of pharmaceutical products, when such products are intended for export to eligible WTO members affected by public health problems.

Member States shall grant a compulsory licence to any person making an application in accordance with Article 5 and subject to the conditions set out in Articles 5 – 8.

Article 2

For the purposes of this Regulation, the following definitions shall apply:

- (1) “pharmaceutical product” means any product of the pharmaceutical sector, including medicinal products as defined in Article 1(2) of Directive 2001/83/EC of the European Parliament and of the Council⁴, active ingredients and diagnostic kits;
- (2) “right holder” means the holder of any patent or SPC in relation to which a compulsory licence has been applied for under this Regulation; in cases where more than one right holder is involved, for the purposes of this Regulation the singular term should be read as plural;
- (3) “importing WTO member” means the name of the WTO member to which the pharmaceutical product is to be exported;

Article 3

The competent authorities in the Member States for granting compulsory licences under this Regulation shall be those which have competence for the granting of compulsory licences under national patent law, unless the Member State concerned determines otherwise.

Member States shall notify the Commission of the competent authorities designated for the purposes of this Regulation.

Notifications shall be published in the *Official Journal of the European Union*.

Article 4

The following are eligible importing WTO members:

- (a) any least-developed country member of WTO
- (b) any other member of WTO that has made a notification to the Council for TRIPs of its intention to use the system as an importer, including whether it will use the system in whole or in a limited way.

However, any WTO member that has made a declaration to the WTO that it will not use the system as an importing WTO member is not an eligible importing WTO member.

⁴ OJ L 311, 28.11.2001, p. 67

Article 5

1. Any person may submit an application for a compulsory licence under this Regulation to a competent authority in the Member State or States where patents or supplementary protection certificates have effect and cover his intended activities of manufacture and sale for export.
2. If the person applying for a compulsory licence is submitting applications to competent authorities in more than one Member State for the same product, he shall indicate that in each application, together with details of the quantities and importing WTO members concerned.
3. The application pursuant to paragraph 1 shall set out the following:
 - (a) the name and contact details of the applicant and of any agent or representative the applicant has appointed to act for him before the competent authority;
 - (b) the name of the pharmaceutical product or products the applicant intends to manufacture and sell for export under the compulsory licence, including any additional information needed to ensure the precise identification of the product or products in question;
 - (c) identification of the patent(s) and/or supplementary protection certificate(s) in respect of which a compulsory licence is sought;
 - (d) the amount of pharmaceutical product which the applicant seeks to produce under the compulsory licence;
 - (e) the importing WTO member or members;
 - (f) evidence of prior negotiation with the right holder pursuant to Article 7;
 - (g) evidence of a specific request to the applicant from authorised representatives of the importing WTO member and indicating quantity of product required.
4. The competent authority may prescribe additional formal or administrative requirements for efficient processing of the application.

Article 6

1. The competent authority shall verify that each importing WTO member cited in the application has made a notification to the WTO pursuant to the Decision of 30 August 2003 of the General Council of the WTO on the implementation of Paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health, hereinafter “the Decision” in respect of each of the products covered by the application that:
 - (a) specifies the names and expected quantities of the product(s) needed;
 - (b) unless the importing WTO member is a least-developed country, confirms that the importing WTO member has established that it either has no manufacturing capacities in the pharmaceutical sector or has examined its manufacturing

capacity in that sector and found that, excluding any capacity owned or controlled by the right holder, it is currently insufficient for meeting its needs;

- (c) confirms that where a pharmaceutical product is patented in the territory of the importing WTO member, that WTO member has granted or intends to grant a compulsory licence for import of the product concerned in accordance with Article 31 of the TRIPS Agreement and the provisions of the Decision.
2. The competent authority shall verify that the quantity of product cited in the application does not exceed that notified to the WTO by the importing WTO member(s), and that, taking into account other compulsory licences ordered in the Community, the total amount of product authorised to be produced for any importing WTO member does not significantly exceed the amount notified to the WTO by that member.

Article 7

The applicant shall provide evidence to satisfy the competent authority that he has made efforts to obtain authorisation from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time.

The determination of a reasonable period of time shall take into account whether the importing WTO member has declared a situation of national emergency or other circumstances of extreme urgency.

Article 8

1. The licence granted shall be non-exclusive and non-assignable. It shall contain the specific conditions set out in paragraphs 2 to 8 to be fulfilled by the licensee.
2. The amount of patented product(s) manufactured under the licence shall not exceed what is necessary to meet the needs of the importing WTO member or members cited in the application.
3. The licence shall be strictly limited to the acts of manufacturing the product in question and selling for export to the WTO member or members cited in the application. No product made under the compulsory licence shall be offered for sale or put on the market in any country other than the WTO member(s) cited in the application.
4. Products made under the licence shall be clearly identified, through specific labelling or marking, as being produced pursuant to this Regulation. The products shall be distinguished from those made by the right holder through special packaging. The packaging and any associated literature shall bear an indication that the product is subject of a compulsory licence under this Regulation, giving the name of the competent authority and any identifying reference number, and specifying clearly that the product is exclusively for export to and sale in the importing WTO member or members concerned. Unless the applicant proves that such distinction is not feasible or has a significant impact on price, special colouring or shaping of the products themselves shall also be required.

5. Before shipment to the importing WTO member or members cited in the application, the licensee shall post on a website the following information:
 - (a) the quantities being supplied under the licence and the WTO members to which they are supplied
 - (b) the distinguishing features of the product or products concerned.The website address shall be communicated to the competent authority.
6. If the product(s) covered by the compulsory licence are patented in the importing WTO members cited in the application, the product(s) shall only be exported if those countries have issued a compulsory licence for the import and sale of the products.
7. The licensee shall keep complete and accurate books and records of all quantities of product manufactured and of all dealings therein. The licensee shall make these books and records available on request to an independent person agreed by the parties, or otherwise appointed by the competent authority, for the sole purpose of checking whether the terms of the licence, and in particular those relating to the final destination of the products, have been met.
8. The licensee shall be required to provide proof of exportation of the product, through a declaration of exportation certified by the customs authority concerned, and proof of importation or putting on the market certified by an authority of the importing WTO member, and shall retain such records for at least three years. Upon request these proofs must be supplied to the competent authority.
9. The licensee shall be responsible for the payment of adequate remuneration to the right holder as determined by the competent authority taking into account the economic value of the use that has been authorised under the licence to the importing WTO member(s) concerned.

Article 9

The competent authority shall refuse an application if any of the conditions set out in Article 5 (3) and (4) and Articles 6, 7 and 8 is not met. Before refusing an application, the competent authority shall give the applicant an opportunity to rectify the situation and to be heard.

Article 10

1. When a compulsory licence has been granted the competent authority shall notify the Commission of the grant of the licence, and of the specific conditions attached to it.

The information provided shall include the following details of the licence:

 - (a) the name and address of the licensee;
 - (b) the product or products concerned;
 - (c) the quantity to be supplied;

- (d) the country or countries to which the product or products are to be exported;
 - (e) the duration of the licence;
 - (f) the address of the website referred to in Article 8 (5).
2. The Commission shall forward the information referred to in paragraph 1 to the Council for TRIPS.

Article 11

1. It is prohibited to import into the Community products subject of a compulsory licence under this Regulation for the purposes of release for free circulation, re-export, placing under suspensive procedures or placing in a free zone or free warehouse.
2. Paragraph 1 shall not apply in the case of re-export to the importing WTO member cited in the application and identified in the packaging and documentation associated with the product, or placing under a transit or customs warehouse procedure or in a free zone or free warehouse for the purpose of re-export to that importing WTO member.

Article 12

1. Where there is reason to suspect that, contrary to Article 11(1), products subject of a compulsory licence under this Regulation are being imported into the Community, customs authorities shall suspend the release of, or detain, the products concerned for the time necessary to obtain a decision of the relevant national authority on the character of the merchandise. The period of suspension or detention shall not exceed 10 working days unless special circumstances apply, in which case the period may be extended by a maximum of 10 working days. Upon expiry of that period, the products shall be released, provided that all customs formalities have been complied with.
2. The relevant national authority and the manufacturer or exporter of the products concerned shall be informed without delay of the suspended release or detention of the products and shall receive all information available with respect to the products concerned. Due account shall be taken of national provisions on the protection of personal data, commercial and industrial secrecy and professional and administrative confidentiality. The importer, and where appropriate, the exporter, shall be given ample opportunity to supply the relevant national authority with the information which it deems appropriate regarding the products.
3. The procedure of suspension or detention of the goods is carried out at the expense of the importer. If it is not possible to recover those expenses from the importer, they may, in accordance with national legislation, be recovered from any other person responsible for the attempted illicit importation.
4. If the relevant national authority finds that products suspended for release or detained by customs authorities were intended for import into the Community contrary to the

prohibition in Article 11 (1), that authority shall ensure that these products are seized and disposed of in accordance with national legislation. These procedures are carried out at the expense of the importer. If it is not possible to recover these expenses from the importer, they may, in accordance with national legislation, be recovered from any other person responsible for the attempted illicit importation.

5. Where products suspended for release or detained by customs authorities subsequent to further control by the relevant national authority are found not to violate the prohibition in Article 11(1), the customs authority shall release the products to the consignee, provided that all customs formalities have been complied with.
6. The relevant national authority shall inform the Commission of any decisions on seizure or destruction which are adopted pursuant to this Regulation.

Article 13

Articles 11 and 12 shall not apply to goods of a non-commercial nature contained in travellers' personal luggage for personal use within the limits laid down in respect of relief from customs duty.

Article 14

1. Subject to adequate protection of the legitimate interests of the licensee, a compulsory licence granted pursuant to this Regulation may be terminated by a decision of the competent authority or by one of the bodies referred to under Article 16 in either of the following cases:
 - (a) if the conditions of the licence are not respected by the licensee;
 - (b) if and when the circumstances which led to the grant of the licence cease to exist and are unlikely to recur.

The competent authority shall have the authority to review, on its own initiative or upon reasoned request by the right holder or the licensee, whether either of those situations applies.

- (2) Termination of a licence granted under this Regulation shall be notified to the Commission who shall inform the WTO.
- (3) Within a reasonable time following termination of the licence the licensee shall arrange for any product in his possession, custody, power or control to be redirected at his expense to countries in need or otherwise as prescribed by the competent authority in consultation with the right holder.

Article 15

Appeals against any decision of the competent authority, and disputes concerning compliance with the conditions of the licence, shall be heard by the appropriate body responsible under national law.

Article 16

1. Where the application for a compulsory licence concerns a medicinal product authorised in accordance with Article 6 of Directive 2001/83/EC, the provisions of Article 24(4) and (5) and of Article 14(4) and (5) of Regulation (EC) No 726/2004 of the European Parliament and the Council⁵ shall not apply.

For the purpose of the application of this paragraph, and by way of derogation from Article 10(1) of Directive 2001/83/EC, the applicant shall not be required to provide the results of pre-clinical tests and of clinical trials if he can demonstrate that the product concerned is a generic of a reference medicinal product which is or has been authorised under Article 6 of that Directive or under Article 3 of Regulation (EC) No 726/2004.

2. Where the application for a compulsory licence concerns a medicinal product and the applicant for the compulsory licence is not the holder of a marketing authorisation valid within the Community for the product concerned, he may avail himself of the scientific opinion procedure provided for under Article 58 of Regulation (EC) No 726/2004 or any similar procedure provided under national law.
3. For the purposes of obtaining a scientific opinion under paragraph (2) and by way of derogation from Article 10(1) of Directive 2001/83/EC, the applicant shall not be required to provide the results of pre-clinical tests and of clinical trials if he can demonstrate that the product concerned is a generic of a reference medicinal product which is or has been authorised under Article 6 of that Directive or Article 3 of Regulation (EC) No 726/2004.

Article 17

Three years after the entry into force of this Regulation, the Commission shall present a report to the European Parliament, the Council, and the European Economic and Social Committee on the operation of this Regulation and the contribution it has made to the implementation of the system established by the Decision.

Article 18

This Regulation shall enter into force on the twentieth day following that of its publication in the *Official Journal of the European Union*.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

⁵ OJ L 136, 30.4.2004, p. 1.

Done at Brussels,

For the European Parliament
The President

For the Council
The President

LEGISLATIVE FINANCIAL STATEMENT

Policy area(s): Internal Market for Goods and Services

Activit(y/ies): Formulate community law in the area of biotechnology, plant protection and pharmaceuticals

TITLE OF ACTION: PROPOSAL FOR A REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL ON COMPULSORY LICENSING OF PATENTS RELATING TO THE MANUFACTURE OF PHARMACEUTICAL PRODUCTS FOR EXPORT TO COUNTRIES WITH PUBLIC HEALTH PROBLEMS

1. BUDGET LINE(S) + HEADING(S)

2. OVERALL FIGURES

2.1. Total allocation for action (Part B): € million for commitment

Not applicable

2.2. Period of application:

(start and expiry years)

Start: Date of entry into force

Expiry: Indefinite

2.3. Overall multiannual estimate of expenditure:

(a) Schedule of commitment appropriations/payment appropriations (financial intervention) *(see point 6.1.1)*

None

(b) Technical and administrative assistance and support expenditure *(see point 6.1.2)*

None

(c) Overall financial impact of human resources and other administrative expenditure *(see points 7.2 and 7.3)*

	2005	2006	2007	2008	2009	2010	Total
Commitments/ payments	0.108	0.108	0.108	0.108	0.108	0.108	0.648

TOTAL a+b+c							
Commitments	0.108	0.108	0.108	0.108	0.108	0.108	0.648
Payments	0.108	0.108	0.108	0.108	0.108	0.108	0.648

2.4. Compatibility with financial programming and financial perspective

Proposal is compatible with existing financial programming.

Proposal will entail reprogramming of the relevant heading in the financial perspective.

Proposal may require application of the provisions of the Interinstitutional Agreement.

2.5. Financial impact on revenue:⁶

Proposal has no financial implications (involves technical aspects regarding implementation of a measure)

OR

Proposal has financial impact – the effect on revenue is as follows:

Not applicable

3. BUDGET CHARACTERISTICS

Type of expenditure		New	EFTA contribution	Contributions from applicant countries	Heading in financial perspective
Non-comp	Diff/	<u>NO</u>	<u>NO</u>	<u>NO</u>	5

4. LEGAL BASIS

Articles 95 and 133 of the EC Treaty.

⁶ For further information, see separate explanatory note.

5. DESCRIPTION AND GROUNDS

5.1. Need for Community intervention ⁷

5.1.1. Objectives pursued

The proposal implements at EU level the WTO General Council Decision of 30 August 2003 which sets out a mechanism in national patent law to allow the manufacture and export of pharmaceutical products to countries in need without the authorisation of the patent holder. At present exports without such authorisation may not take place. The aim of this mechanism is to facilitate access to affordable medicines for people in developing countries which do not have sufficient manufacturing capacity themselves. Intervention at Community level is required in view of the Community's involvement in external negotiations and the need to avoid differences in application and distortions of competition affecting operators within the Internal Market.

5.1.2. Measures taken in connection with ex ante evaluation

The WTO General Council Decision is the result of several years' negotiation on the basis of EU positions coordinated in the Article 133 Committee.

5.1.3. Measures taken following ex post evaluation

Not applicable

5.2. Action envisaged and budget intervention arrangements

The proposed mechanism is a voluntary one both for the countries in need who seek to obtain affordable medicines and the companies who intend to supply them. Once the legislation comes into force, compulsory licences will be granted by national authorities on the basis of applications from companies and notifications by developing countries that they require particular pharmaceutical products. No financial assistance is involved.

5.3. Methods of implementation

After adoption of the draft legislation by the Council and European Parliament, it will be MS national authorities who grant compulsory licences.

6. FINANCIAL IMPACT

6.1. Total financial impact on Part B - (over the entire programming period)

Not applicable

⁷ For further information, see separate explanatory note.

6.2. Calculation of costs by measure envisaged in Part B (over the entire programming period)⁸

Not applicable

7. IMPACT ON STAFF AND ADMINISTRATIVE EXPENDITURE

Human and administrative resource requirements will be covered from within the budget allocated to the managing DG in the framework of the annual allocation procedure.

7.1. Impact on human resources

Types of post		Staff to be assigned to management of the action using existing resources		Total	Description of tasks deriving from the action
		Number of permanent posts	Number of temporary posts		
Officials or temporary staff	A	1		1	<p><i>If necessary, a fuller description of the tasks may be annexed.</i></p> <p>Preparing for and attending meetings of Council and Parliament to negotiate the proposal through to adoption. Monitoring application and impact of system set up by this legislation, in liaison with stakeholders including EU MS, companies, third countries and international organisations.</p>
	B				
	C				
Other human resources		0	0	0	
Total		1	0	1	

7.2. Overall financial impact of human resources

Type of human resources	Amount (€)	Method of calculation *
Officials	108.000	Annual costs per official: 108.000 €
Temporary staff		
Other human resources (specify budget line)		
Total	108.000 €	

The amounts are total expenditure for twelve months.

7.3. Other administrative expenditure deriving from the action

Not applicable

⁸ For further information, see separate explanatory note.

The amounts are total expenditure for twelve months.

¹ Specify the type of committee and the group to which it belongs.

I.	Annual total (7.2 + 7.3)	108.000 €
II.	Duration of action	2005 - 2010
III.	Total cost of action (I x II)	€648.000

8. FOLLOW-UP AND EVALUATION

8.1. Follow-up arrangements

8.2. Arrangements and schedule for the planned evaluation

Use of the mechanism envisaged by the proposal is optional for business; on-going evaluation will be possible through analysis of the notifications made to the WTO and the Commission for every compulsory licence granted under the Regulation. Report and review is proposed in the Regulation itself five years after entry into force.

9. ANTI-FRAUD MEASURES

No financial assistance is involved.

Proposal for a Council Decision accepting, on behalf of the European Community, of the Protocol amending the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), done at Geneva on 6 December 2005

[pic] | COMMISSION OF THE EUROPEAN COMMUNITIES |

Brussels, 27.4.2006

COM(2006) 175 final

2006/0060 (AVC)

Proposal for a

COUNCIL DECISION

accepting, on behalf of the European Community, of the Protocol amending the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), done at Geneva on 6 December 2005

(presented by the Commission)

EXPLANATORY MEMORANDUM

Objective of this proposal This proposal for a Council Decision aims at accepting, on behalf of the European Community, the Protocol amending the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as the TRIPS Agreement), done at Geneva on 6 December 2005. On 6 December 2005, the General Council of the World Trade Organization (hereinafter referred to as the WTO) submitted a proposed amendment to the TRIPS Agreement to the WTO Members for acceptance. This amendment would make permanent a waiver decision on compulsory licences originally adopted in 2003. Once accepted and in force, this amendment will complete a process that began with the Declaration on the TRIPS Agreement and Public Health that ministers made at the Doha Ministerial Conference in November 2001. This is the first time that a core WTO agreement is amended. The Doha Declaration on TRIPS and Public Health On 14 November 2001 at Doha, the Fourth Session of the WTO Ministerial Conference adopted the Declaration on the TRIPS Agreement and Public Health. The Doha Declaration clarifies the relationship between the TRIPS Agreement and public health policies of WTO Members, confirming the right of Members to issue compulsory licences on patents for reasons of public health. As to WTO Members with no manufacturing capacity in the pharmaceutical sector, which could not import medicines they needed, Paragraph 6 of the Doha Declaration instructed the Council for TRIPS to find an expeditious solution to this problem. The waiver decision of 30 August 2003 On 30 August 2003, the WTO General Council adopted the decision on the implementation of Paragraph 6 of the Doha Declaration on the TRIPs Agreement and Public Health. This decision allows WTO Members to [export patented medicines](#) to third countries with no manufacturing capacity in the pharmaceutical sector, by making use of compulsory licences. It includes substantial safeguards against trade diversion and rules to ensure transparency. The decision was accompanied by a statement by the chair of the General Council, describing Members' shared understanding on how the decision is interpreted and implemented. It says the decision will be used in good faith in order to deal with public health problems and not for industrial or commercial policy objectives. It stipulates that issues such as preventing the medicines getting into the wrong hands are important. In order to make sure that the system would be aimed at relieving the neediest, developed country Members of the WTO (among which all EU Member States¹) have taken the commitment not to use the system as importers. High income developing country members have made a statement that they would not use the system except in exceptional circumstances. All WTO Members have the right to act as exporters. The 30 August 2003 decision takes the form of a provisional waiver in the meaning of Article IX:3 of the Marrakech Agreement Establishing the World Trade Organization (hereinafter referred to as the WTO Agreement) and provides for its replacement

by an amendment to the TRIPS Agreement, on which work was to be completed by mid 2004. Following the waiver, the Commission has proposed to the European Parliament and the Council the adoption of a Regulation on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems², the adoption of which is imminent. The decision of 6 December 2005 The decision of 6 December 2005 is intended to transform the 30 August 2003 waiver decision into a permanent amendment of the TRIPS Agreement. The amendment will allow any WTO Member to export pharmaceutical products made under a compulsory licence for the purpose of supplying developing countries with insufficient manufacturing capacities. It will ensure a legally secure, predictable, effective and sustainable solution for those countries which want to use the system to get affordable medicines they need. The new rules will be formally incorporated into the TRIPS Agreement. In accordance with Paragraph 3 of Article X of the WTO Agreement, the amendment takes effect for the Members that have accepted it when two thirds of the WTO Members accept the amendment and thereafter for each other Member upon acceptance by it. WTO Members have set themselves until 1 December 2007 to do this. The waiver remains in force for each Member until the amendment becomes effective for that Member. The amendment is designed to match the 30 August 2003 decision as closely as possible. Other procedures used in 2003 are also matched, including the statement by the chair of the WTO General Council. In order to achieve this, the 6 December 2005 decision ensures that the legal meaning and weight, and the relationship between the statement and the new rules, are preserved as exactly as possible. This reflects the approach that the EC had defended in the WTO. A group of developed countries, including the European Community, is listed as announcing that they will not use the system to import. A number of other countries announced separately that if they use the system as importers it would only be for emergencies or extremely urgent situations. Contents of the amendment The amendment itself is composed of three parts: Five paragraphs come under Article 31bis (i.e. an additional article after Article 31). The first allows pharmaceutical products made under compulsory licences to be exported to countries lacking production capacity. Other paragraphs deal with avoiding double remuneration to the patent owner, regional trade agreements involving least-developed countries, non-violation and situation complaints, and retaining all existing flexibilities under the TRIPS Agreement. A further seven paragraphs are in a new annex to the TRIPS Agreement. These set out terms for using the system, and cover such issues as definitions, notification and transparency, avoiding the pharmaceuticals being diverted to the wrong markets, developing regional systems to allow economies of scale, and annual review in the Council for TRIPS. An appendix to the annex deals with assessing lack of manufacturing capability in the importing country. This was originally an annex to the 2003 decision. The new Article 31bis and annex of the TRIPS Agreement are attached to the Protocol of amendment. This is attached to a WTO General Council decision, which adopts the Protocol and opens it for Members to accept it by 1 December 2007. |

Conclusion of the Protocol The European Commission participated, on behalf of the European Community, in the negotiation of the Protocol. In accordance with paragraph 5 of Article 133 of the EC Treaty, the European Community is competent to conclude agreements in the field of commercial aspects of intellectual property. Therefore, the Protocol should be accepted on behalf of the European Community. Following the adoption of the Regulation of the European Parliament and the Council on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems, the Community will have an exclusive competence over this matter. Member States should therefore not accept the Protocol. The President of the Council shall be authorised to designate the person empowered to deposit the instrument of acceptance of the Protocol with the WTO Director-General. In its instrument of acceptance, the European Community shall also confirm, in accordance with Article 300 paragraph 7 of the EC Treaty, that the Protocol will be binding on its Member States. For these reasons, the Commission proposes to the Council

to adopt the attached decision. |

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2006/0060 (AVC)

Proposal for a

COUNCIL DECISION

accepting, on behalf of the European Community, of the Protocol amending the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), done at Geneva on 6 December 2005

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular paragraph 5 of Article 133 in conjunction with the first sentence of the first subparagraph of paragraph 2 and the second subparagraph of paragraph 3 of Article 300 thereof,

Having regard to the proposal from the Commission[1],

Having regard to the assent of the European Parliament[2],

Whereas:

- (1) On 14 November 2001 at Doha, the Fourth Session of the Ministerial Conference of the World Trade Organisation (hereinafter referred to as the WTO) adopted the Declaration on the TRIPS Agreement and Public Health (WT/MIN(01)/DEC/2).
- (2) Paragraph 6 of this Declaration instructed the Council for TRIPS to find an expeditious solution to the problem of the difficulties that WTO Members with insufficient or no manufacturing capacities in the pharmaceutical sector could face in making effective use of compulsory licensing under the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as the TRIPS Agreement).
- (3) On 30 August 2003, the WTO General Council adopted a temporary decision implementing paragraph 6 of the Declaration on the TRIPS Agreement and Public Health.
- (4) Paragraph 11 of the 30 August 2003 decision provides that this decision, including the waivers granted in it, shall terminate for each Member on the date on which an amendment to the TRIPS Agreement replacing its provisions takes effect for that Member.
- (5) On 6 December 2005, in order to transform the 30 August 2003 decision into an amendment of the TRIPS Agreement, the WTO General Council adopted a Protocol amending the TRIPS Agreement and submitted it to the Members of the WTO for acceptance.
- (6) Paragraph 3 of the Protocol provides that this Protocol shall be open for acceptance by Members until 1 December 2007 or such later date as may be decided by the Ministerial Conference.
- (7) The European Commission participated, on behalf of the European Community, in the negotiation of the Protocol.
- (8) In accordance with paragraph 5 of Article 133 of the EC Treaty, the European Community is competent to conclude agreements in the field of commercial aspects of intellectual property.
- (9) The Protocol should be accepted on behalf of the European Community.
- (10) In its instrument of acceptance, the European Community shall also confirm, in accordance with Article 300 paragraph 7 of the EC Treaty, that the Protocol will be binding on its Member States,

HAS DECIDED AS FOLLOWS:

Article 1

The Protocol amending the Agreement on Trade-Related Aspects of Intellectual Property Rights, done at Geneva on 6 December 2005, is hereby accepted on behalf of the European Community.

The text of the Protocol is attached to this Decision.

Article 2

The President of the Council is hereby authorised to designate the person empowered to deposit the instrument of acceptance of the Protocol with the Director-General of the World Trade Organization.

Article 3

In its instrument of acceptance, the European Community shall confirm, in accordance with Article 300 paragraph 7 of the EC Treaty, that the Protocol will be binding on its Member States.

Done at Brussels,

For the Council

The President

ANNEX PROTOCOL AMENDING THE TRIPS AGREEMENT

Members of the World Trade Organization;

Having regard to the Decision of the General Council in document WT/L/641, adopted pursuant to paragraph 1 of Article X of the Marrakesh Agreement Establishing the World Trade Organization ("the WTO Agreement");

Hereby agree as follows:

1. The Agreement on Trade-Related Aspects of Intellectual Property Rights (the "TRIPS Agreement") shall, upon the entry into force of the Protocol pursuant to paragraph 4, be amended as set out in the Annex to this Protocol, by inserting Article 31 bis after Article 31 and by inserting the Annex to the TRIPS Agreement after Article 73.
2. Reservations may not be entered in respect of any of the provisions of this Protocol without the consent of the other Members.
3. This Protocol shall be open for acceptance by Members until 1 December 2007 or such later date as may be decided by the Ministerial Conference.
4. This Protocol shall enter into force in accordance with paragraph 3 of Article X of the WTO Agreement.
5. This Protocol shall be deposited with the Director-General of the World Trade Organization who shall promptly furnish to each Member a certified copy thereof and a notification of each acceptance thereof pursuant to paragraph 3.

6. This Protocol shall be registered in accordance with the provisions of Article 102 of the Charter of the United Nations.

Done at Geneva this sixth day of December two thousand and five, in a single copy in the English, French and Spanish languages, each text being authentic.

ANNEX TO THE PROTOCOL AMENDING THE TRIPS AGREEMENT

Article 31bis

1. The obligations of an exporting Member under Article 31(f) shall not apply with respect to the grant by it of a compulsory licence to the extent necessary for the purposes of production of a pharmaceutical product(s) and its export to an eligible importing Member(s) in accordance with the terms set out in paragraph 2 of the Annex to this Agreement.

2. Where a compulsory licence is granted by an exporting Member under the system set out in this Article and the Annex to this Agreement, adequate remuneration pursuant to Article 31(h) shall be paid in that Member taking into account the economic value to the importing Member of the use that has been authorized in the exporting Member. Where a compulsory licence is granted for the same products in the eligible importing Member, the obligation of that Member under Article 31(h) shall not apply in respect of those products for which remuneration in accordance with the first sentence of this paragraph is paid in the exporting Member.

3. With a view to harnessing economies of scale for the purposes of enhancing purchasing power for, and facilitating the local production of, pharmaceutical products: where a developing or least-developed country WTO Member is a party to a regional trade agreement within the meaning of Article XXIV of the GATT 1994 and the Decision of 28 November 1979 on Differential and More Favourable Treatment Reciprocity and Fuller Participation of Developing Countries (L/4903), at least half of the current membership of which is made up of countries presently on the United Nations list of least-developed countries, the obligation of that Member under Article 31(f) shall not apply to the extent necessary to enable a pharmaceutical product produced or imported under a compulsory licence in that Member to be exported to the markets of those other developing or least-developed country parties to the regional trade agreement that share the health problem in question. It is understood that this will not prejudice the territorial nature of the patent rights in question.

4. Members shall not challenge any measures taken in conformity with the provisions of this Article and the Annex to this Agreement under subparagraphs 1(b) and 1(c) of Article XXIII of GATT 1994.

5. This Article and the Annex to this Agreement are without prejudice to the rights, obligations and flexibilities that Members have under the provisions of this Agreement other than paragraphs (f) and (h) of Article 31, including those reaffirmed by the Declaration on the TRIPS Agreement and Public Health (WT/MIN(01)/DEC/2), and to their interpretation. They are also without prejudice to the extent to which pharmaceutical products produced under a compulsory licence can be exported under the provisions of Article 31(f).

ANNEX TO THE TRIPS AGREEMENT

1. For the purposes of Article 31 bis and this Annex:

- (a) "pharmaceutical product" means any patented product, or product manufactured through a patented process, of the pharmaceutical sector needed to address the public health problems as recognized in paragraph 1 of the Declaration on the TRIPS Agreement and Public Health (WT/MIN(01)/DEC/2).

It is understood that active ingredients necessary for its manufacture and diagnostic kits needed for its use would be included[3];

(b) "eligible importing Member" means any least-developed country Member, and any other Member that has made a notification[4] to the Council for TRIPS of its intention to use the system set out in Article 31 bis and this Annex ("system") as an importer, it being understood that a Member may notify at any time that it will use the system in whole or in a limited way, for example only in the case of a national emergency or other circumstances of extreme urgency or in cases of public non-commercial use. It is noted that some Members will not use the system as importing Members[5] and that some other Members have stated that, if they use the system, it would be in no more than situations of national emergency or other circumstances of extreme urgency;

(c) "exporting Member" means a Member using the system to produce pharmaceutical products for, and export them to, an eligible importing Member.

2. The terms referred to in paragraph 1 of Article 31 bis are that:

(a) the eligible importing Member(s)[6] has made a notification² to the Council for TRIPS, that:

(i) specifies the names and expected quantities of the product(s) needed[7];

(ii) confirms that the eligible importing Member in question, other than a least-developed country Member, has established that it has insufficient or no manufacturing capacities in the pharmaceutical sector for the product(s) in question in one of the ways set out in the Appendix to this Annex; and

(iii) confirms that, where a pharmaceutical product is patented in its territory, it has granted or intends to grant a compulsory licence in accordance with Articles 31 and 31 bis of this Agreement and the provisions of this Annex[8];

(b) the compulsory licence issued by the exporting Member under the system shall contain the following conditions:

(i) only the amount necessary to meet the needs of the eligible importing Member(s) may be manufactured under the licence and the entirety of this production shall be exported to the Member(s) which has notified its needs to the Council for TRIPS;

(ii) products produced under the licence shall be clearly identified as being produced under the system through specific labelling or marking. Suppliers should distinguish such products through special packaging and/or special colouring/shaping of the products themselves, provided that such distinction is feasible and does not have a significant impact on price; and

(iii) before shipment begins, the licensee shall post on a website[9] the following information:

- the quantities being supplied to each destination as referred to in indent (i) above; and

- the distinguishing features of the product(s) referred to in indent (ii) above;

(c) the exporting Member shall notify[10] the Council for TRIPS of the grant of the licence, including the conditions attached to it.[11] The information provided shall include the name and address of the licensee, the product(s) for which the licence has been granted, the quantity(ies) for which it has been granted, the country(ies) to which the product(s) is (are) to be supplied and the duration of the licence. The notification shall also indicate the address of the website referred to in subparagraph (b)(iii) above.

3. In order to ensure that the products imported under the system are used for the public health purposes underlying their importation, eligible importing Members shall take reasonable measures

within their means, proportionate to their administrative capacities and to the risk of trade diversion to prevent re-exportation of the products that have actually been imported into their territories under the system. In the event that an eligible importing Member that is a developing country Member or a least-developed country Member experiences difficulty in implementing this provision, developed country Members shall provide, on request and on mutually agreed terms and conditions, technical and financial cooperation in order to facilitate its implementation.

4. Members shall ensure the availability of effective legal means to prevent the importation into, and sale in, their territories of products produced under the system and diverted to their markets inconsistently with its provisions, using the means already required to be available under this Agreement. If any Member considers that such measures are proving insufficient for this purpose, the matter may be reviewed in the Council for TRIPS at the request of that Member.

5. With a view to harnessing economies of scale for the purposes of enhancing purchasing power for, and facilitating the local production of, pharmaceutical products, it is recognized that the development of systems providing for the grant of regional patents to be applicable in the Members described in paragraph 3 of Article 31 bis should be promoted. To this end, developed country Members undertake to provide technical cooperation in accordance with Article 67 of this Agreement, including in conjunction with other relevant intergovernmental organizations.

6. Members recognize the desirability of promoting the transfer of technology and capacity building in the pharmaceutical sector in order to overcome the problem faced by Members with insufficient or no manufacturing capacities in the pharmaceutical sector. To this end, eligible importing Members and exporting Members are encouraged to use the system in a way which would promote this objective. Members undertake to cooperate in paying special attention to the transfer of technology and capacity building in the pharmaceutical sector in the work to be undertaken pursuant to Article 66.2 of this Agreement, paragraph 7 of the Declaration on the TRIPS Agreement and Public Health and any other relevant work of the Council for TRIPS.

7. The Council for TRIPS shall review annually the functioning of the system with a view to ensuring its effective operation and shall annually report on its operation to the General Council.

APPENDIX TO THE ANNEX TO THE TRIPS AGREEMENT

Assessment of Manufacturing Capacities in the Pharmaceutical Sector

Least-developed country Members are deemed to have insufficient or no manufacturing capacities in the pharmaceutical sector.

For other eligible importing Members insufficient or no manufacturing capacities for the product(s) in question may be established in either of the following ways:

- (i) the Member in question has established that it has no manufacturing capacity in the pharmaceutical sector;
- or
- (ii) where the Member has some manufacturing capacity in this sector, it has examined this capacity and found that, excluding any capacity owned or controlled by the patent owner, it is currently insufficient for the purposes of meeting its needs. When it is established that such capacity has become sufficient to meet the Member's needs, the system shall no longer apply.

1 Before accession to the EU, the then ten accession countries made a statement that they would not use the system except in exceptional circumstances. Upon accession to the EU, their commitment is not to use the system as importers at all.

2 COM(2004) 737 final of 29.10.2004.

[1] OJ C , p.

[2] OJ C , p.

[3] This subparagraph is without prejudice to subparagraph 1(b).

[4] It is understood that this notification does not need to be approved by a WTO body in order to use the system.

[5] Australia, Canada, the European Communities with, for the purposes of Article 31 bis and this Annex, its member States, Iceland, Japan, New Zealand, Norway, Switzerland, and the United States.

[6] Joint notifications providing the information required under this subparagraph may be made by the regional organizations referred to in paragraph 3 of Article 31 bis on behalf of eligible importing Members using the system that are parties to them, with the agreement of those parties.

[7] The notification will be made available publicly by the WTO Secretariat through a page on the WTO website dedicated to the system.

[8] This subparagraph is without prejudice to Article 66.1 of this Agreement.

[9] The licensee may use for this purpose its own website or, with the assistance of the WTO Secretariat, the page on the WTO website dedicated to the system.

[10] It is understood that this notification does not need to be approved by a WTO body in order to use the system.

[11] The notification will be made available publicly by the WTO Secretariat through a page on the WTO website dedicated to the system.

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[IMPORTANT LEGAL NOTICES](#)

de en fr



↔ [Industrial Property](#) ↔ Patentability of computer-implemented inventions

Patentability of computer-implemented inventions

06.07.2005 European Parliament rejects Council common position and legislative procedure is closed

- [Commissioner's statement](#)
- Consult [legislative history](#) in PreLex

08.03.2005 [Statement to the European Parliament](#) on Computer Implemented Inventions

18.05.2004 Commission welcomes [Council agreement](#) on Directive on computer-implemented inventions

20.02.2002 Commission proposes rules for inventions using software

- [Press release](#)
- [Full text](#) of the proposal
- [Frequently asked questions](#)

24.07.2001 [Analyses of replies](#) to the Consultation papers on the patentability of computer-implemented inventions

19.10.2000 Study "The Economic Impact of Patentability of Computer Programs"

- Full text  
- [Summary](#)



[Index](#) [Full text](#)

Debates

Wednesday 6 July 2005 - Strasbourg

OJ edition

▶ Patentability of computer-implemented inventions

▶ **Benita Ferrero-Waldner**, *Member of the Commission*. Mr President, the rejection of the Council common position is the democratic right of Parliament as co-legislator with the Council. Many speakers during the debate yesterday mentioned the voice of the people and the role of democracy.

Without this directive, patents for computer-implemented inventions will continue to be issued by national patent offices and the European Patent Office under existing law. There will be no harmonisation at EU level.

(Applause)

This means that different interpretations as to what is patentable or not will continue without any judicial control by the European Court of Justice.

Since the adoption of the common position, the Commission has maintained the view that, should Parliament decide to reject the common position, the Commission would respect this and would not present a new proposal but, if Parliament invites us to do so, we will speak with the various parliamentary committees and then consider the next procedures.

Various Members have expressed the view that the Commission should present a non-sector-specific instrument and that it should seek the adoption of the Community patent.

A large amount of national patent law is already aligned with the European Patent Convention and the Community Patent Convention of 1989. Again, Commissioner McCreevy will be happy to debate these matters with you. You have already said you would invite us to the relevant committee meetings and also to the plenary sittings if you wish to do this.

On the future of the Community patent, the key to agreement on this lies in the hands of the Council. Many options have already been explored formally and informally.

Last updated: 19 September 2005

[Legal notice](#)

Common Position (EC) No 20/2005 of 7 March 2005 adopted by the Council, acting in accordance with the procedure referred to in Article 251 of the Treaty establishing the European Community, with a view to adopting a Directive of the European Parliament and of the Council on the patentability of computer-implemented inventions

Common Position (EC) No 20/2005

adopted by the Council on 7 March 2005

with a view to adopting Directive 2005/.../EC of the European Parliament and of the Council of... on the patentability of computer-implemented inventions

(2005/C 144 E/02)

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 95 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Economic and Social Committee [1],

Acting in accordance with the procedure laid down in Article 251 of the Treaty [2],

Whereas:

- (1) The realisation of the internal market implies the elimination of restrictions to free circulation and of distortions in competition, while creating an environment which is favourable to innovation and investment. In this context the protection of inventions by means of patents is an essential element for the success of the internal market. Effective, transparent and harmonised protection of computer-implemented inventions throughout the Member States is essential in order to maintain and encourage investment in this field.
- (2) Differences exist in the protection of computer-implemented inventions offered by the administrative practices and the case law of the different Member States. Such differences could create barriers to trade and hence impede the proper functioning of the internal market.
- (3) Such differences could become greater as Member States adopt new and different administrative practices, or where national case law interpreting the current legislation evolves differently.
- (4) The steady increase in the distribution and use of computer programs in all fields of technology and in their worldwide distribution via the Internet is a critical factor in technological innovation. It is therefore necessary to ensure that an optimum environment exists for developers and users of computer programs in the Community.
- (5) Therefore, the legal rules governing the patentability of computer-implemented inventions should be harmonised so as to ensure that the resulting legal certainty and the level of requirements demanded for patentability enable innovative enterprises to derive the maximum advantage from their inventive process and provide an incentive for investment and innovation. Legal certainty will also be secured by the fact that, in case of doubt as to the interpretation of this Directive, national courts may, and national courts of last instance must, seek a ruling from the Court of Justice.
- (6) The Community and its Member States are bound by the Agreement on trade-related aspects of intellectual property rights (TRIPS), approved by Council Decision 94/800/EC of 22 December 1994 concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986

to 1994) [3]. Article 27(1) of TRIPS provides that patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application. Moreover, according to that Article, patent rights should be available and patent rights enjoyable without discrimination as to the field of technology. These principles should accordingly apply to computer-implemented inventions.

- (7) Under the Convention on the Grant of European Patents signed in Munich on 5 October 1973 (European Patent Convention) and the patent laws of the Member States, programs for computers together with discoveries, scientific theories, mathematical methods, aesthetic creations, schemes, rules and methods for performing mental acts, playing games or doing business, and presentations of information are expressly not regarded as inventions and are therefore excluded from patentability. This exception, however, applies and is justified only to the extent that a patent application or patent relates to the above subject-matter or activities as such, because the said subject-matter and activities as such do not belong to a field of technology.
- (8) The aim of this Directive is to prevent different interpretations of the provisions of the European Patent Convention concerning the limits to patentability. The consequent legal certainty should help to foster a climate conducive to investment and innovation in the field of software.
- (9) Patent protection allows innovators to benefit from their creativity. Patent rights protect innovation in the interests of society as a whole and should not be used in a manner which is anti-competitive.
- (10) In accordance with Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs [4], the expression in any form of an original computer program is protected by copyright as a literary work. However, ideas and principles which underlie any element of a computer program are not protected by copyright.
- (11) In order for any invention to be considered as patentable it should have a technical character, and thus belong to a field of technology.
- (12) It is a condition for inventions in general that, in order to involve an inventive step, they should make a technical contribution to the state of the art.
- (13) Accordingly, although a computer-implemented invention belongs to a field of technology, where it does not make a technical contribution to the state of the art, as would be the case, for example, where its specific contribution lacks a technical character, it will lack an inventive step and thus will not be patentable.
- (14) The mere implementation of an otherwise unpatentable method on an apparatus such as a computer is not in itself sufficient to warrant a finding that a technical contribution is present. Accordingly, a computer-implemented business method, data processing method or other method, in which the only contribution to the state of the art is non-technical, cannot constitute a patentable invention.
- (15) If the contribution to the state of the art relates solely to unpatentable matter, there can be no patentable invention irrespective of how the matter is presented in the claims. For example, the requirement for technical contribution cannot be circumvented merely by specifying technical means in the patent claims.
- (16) Furthermore, an algorithm is inherently non-technical and therefore cannot constitute a technical invention. Nonetheless, a method involving the use of an algorithm might be patentable provided that the method is used to solve a technical problem. However, any patent granted for such a method should not monopolise the algorithm itself or its use in contexts not foreseen in the patent.
- (17) The scope of the exclusive rights conferred by any patent is defined by the claims, as interpreted

with reference to the description and any drawings. Computer-implemented inventions should be claimed at least with reference to either a product such as a programmed apparatus, or to a process carried out in such an apparatus. Accordingly, where individual elements of software are used in contexts which do not involve the realisation of any validly claimed product or process, such use will not constitute patent infringement.

- (18) The legal protection of computer-implemented inventions does not necessitate the creation of a separate body of law in place of the rules of national patent law. The rules of national patent law remain the essential basis for the legal protection of computer-implemented inventions. This Directive simply clarifies the present legal position with a view to securing legal certainty, transparency, and clarity of the law and avoiding any drift towards the patentability of unpatentable methods such as obvious or non-technical procedures and business methods.
- (19) This Directive should be limited to laying down certain principles as they apply to the patentability of such inventions, such principles being intended in particular to ensure that inventions which belong to a field of technology and make a technical contribution are susceptible of protection, and conversely to ensure that those inventions which do not make a technical contribution are not susceptible of protection.
- (20) The competitive position of Community industry in relation to its major trading partners will be improved if the current differences in the legal protection of computer-implemented inventions are eliminated and the legal situation is transparent. With the present trend for traditional manufacturing industry to shift their operations to low-cost economies outside the Community, the importance of intellectual property protection and in particular patent protection is self-evident.
- (21) This Directive should be without prejudice to the application of Articles 81 and 82 of the Treaty, in particular where a dominant supplier refuses to allow the use of a patented technique which is needed for the sole purpose of ensuring conversion of the conventions used in two different computer systems or networks so as to allow communication and exchange of data content between them.
- (22) The rights conferred by patents granted for inventions within the scope of this Directive should not affect acts permitted under Articles 5 and 6 of Directive 91/250/EEC, in particular under the provisions thereof in respect of decompilation and interoperability. In particular, acts which, under Articles 5 and 6 of Directive 91/250/EEC, do not require authorisation of the rightholder with respect to the rightholder's copyrights in or pertaining to a computer program, and which, but for those Articles, would require such authorisation, should not require authorisation of the rightholder with respect to the rightholder's patent rights in or pertaining to the computer program.
- (23) Since the objective of this Directive, namely to harmonise national rules on the [patentability of computer-implemented inventions](#), cannot be sufficiently achieved by the Member States and can therefore be better achieved at Community level, the Community may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty. In accordance with the principle of proportionality, as set out in that Article, this Directive does not go beyond what is necessary to achieve that objective,

HAVE ADOPTED THIS DIRECTIVE:

Article 1

Scope

This Directive lays down rules for the [patentability](#) of [computer-implemented inventions](#).

Article 2

Definitions

For the purposes of this Directive the following definitions shall apply:

- (a) "computer-implemented invention" means any invention the performance of which involves the use of a computer, computer network or other programmable apparatus, the invention having one or more features which are realised wholly or partly by means of a computer program or computer programs;
- (b) "technical contribution" means a contribution to the state of the art in a field of technology which is new and not obvious to a person skilled in the art. The technical contribution shall be assessed by consideration of the difference between the state of the art and the scope of the patent claim considered as a whole, which must comprise technical features, irrespective of whether or not these are accompanied by non-technical features.

Article 3

Conditions for patentability

In order to be patentable, a computer-implemented invention must be susceptible to industrial application and new and must involve an inventive step. In order to involve an inventive step, a computer-implemented invention must make a technical contribution.

Article 4

Exclusions from patentability

1. A computer program as such cannot constitute a patentable invention.
2. A computer-implemented invention shall not be regarded as making a technical contribution merely because it involves the use of a computer, network or other programmable apparatus. Accordingly, inventions involving computer programs, whether expressed as source code, as object code or in any other form, which implement business, mathematical or other methods and do not produce any technical effects beyond the normal physical interactions between a program and the computer, network or other programmable apparatus in which it is run shall not be patentable.

Article 5

Form of claims

1. Member States shall ensure that a computer-implemented invention may be claimed as a product, that is as a programmed computer, a programmed computer network or other programmed apparatus, or as a process carried out by such a computer, computer network or apparatus through the execution

of software.

2. A claim to a computer program, either on its own or on a carrier, shall not be allowed unless that program would, when loaded and executed in a programmable computer, programmable computer network or other programmable apparatus, put into force a product or process claimed in the same patent application in accordance with paragraph 1.

Article 6

Relationship with Directive 91/250/EEC

The rights conferred by patents granted for inventions within the scope of this Directive shall not affect acts permitted under Articles 5 and 6 of Directive 91/250/EEC, in particular under the provisions thereof in respect of decompilation and interoperability.

Article 7

Monitoring

The Commission shall monitor the impact of computer-implemented inventions on innovation and competition, both within Europe and internationally, on Community businesses, especially small and medium-sized enterprises, on the open-source community and on electronic commerce.

Article 8

Report on the effects of the Directive

The Commission shall report to the European Parliament and the Council by ... [5] on:

- (a) the impact of patents for computer-implemented inventions on the factors referred to in Article 7;
- (b) whether the rules governing the term of the patent and the determination of the patentability requirements, and more specifically novelty, inventive step and the proper scope of claims, are adequate, and whether it would be desirable and legally possible having regard to the Community's international obligations to make modifications to such rules;
- (c) whether difficulties have been experienced in respect of Member States where the requirements of novelty and inventive step are not examined prior to issuance of a patent, and if so, whether any measures are desirable to address such difficulties;
- (d) whether difficulties have been experienced in respect of the relationship between the protection by patent of computer-implemented inventions and the protection by copyright of computer programs as provided for in Directive 91/250/EEC and whether any abuse of the patent system has occurred in relation to computer-implemented inventions;
- (e) how the requirements of this Directive have been taken into account in the practice of the European Patent Office and in its examination guidelines;
- (f) the aspects in respect of which it may be necessary to prepare for a diplomatic conference to

revise the European Patent Convention;

- (g) the impact of patents for computer-implemented inventions on the development and commercialisation of interoperable computer programs and systems.

Article 9

Impact review

In the light of the monitoring carried out pursuant to Article 7 and the report to be drawn up pursuant to Article 8, the Commission shall review the impact of this Directive and, where necessary, submit amending proposals to the European Parliament and the Council.

Article 10

Implementation

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive by ... [6]. They shall forthwith inform the Commission thereof.

When Member States adopt those measures, they shall contain a reference to this Directive or shall be accompanied by such a reference on the occasion of their official publication. The methods of making such reference shall be laid down by Member States.

2. Member States shall communicate to the Commission the text of the provisions of national law which they adopt in the field governed by this Directive.

Article 11

Entry into force

This Directive shall enter into force on the twentieth day following its publication in the Official Journal of the European Union.

Article 12

Addressees

This Directive is addressed to the Member States.

Done at Brussels,

For the European Parliament

The President

...

For the Council

The President

...

[1] OJ C 61, 14.3.2003, p. 154.

[2] Opinion of the European Parliament of 24 September 2003 (OJ C 77 E, 26.3.2004, p. 230), Council Common Position of 7 March 2005 and Position of the European parliament of... (not yet published in the Official Journal).

[3] OJ L 336, 23.12.1994, p. 1.

[4] OJ L 122, 17.5.1991 p. 42. Directive as amended by Directive 93/98/EEC (OJ L 290, 24.11.1993, p. 9).

[5] Five years after the date of entry into force of this Directive.

[6] Two years from the date of entry into force of this Directive.

STATEMENT OF THE COUNCIL'S REASONS

I. INTRODUCTION

1. On 20 February 2002, the Commission submitted a proposal for a European Parliament and Council Directive on the [patentability](#) of [computer-implemented inventions](#) [1], based on Article 95 of the EC Treaty.

2. The Economic and Social Committee delivered its opinion on 19 September 2002 [2].

3. The European Parliament delivered its opinion at first reading on 24 September 2003 [3].

4. The Commission has not submitted an amended proposal.

5. The Council adopted its common position according to Article 251 of the EC Treaty on 7 March 2005.

II. AIM

6. The proposed Directive aims at harmonising national patent laws with respect to the [patentability](#) of [computer-implemented inventions](#) and at making the conditions of such patentability more transparent.

III. COMMON POSITION

Recitals

7. The Council has amended or merged a number of recitals appearing in the Commission's proposal and has adopted a few additional ones. In so doing, the Council has taken on board in full or in part, or following reformulation, the European Parliament's amendments 1, 2, 88, 3, 34, 115, 85, 7, 8, 9, 86, 11, 12 and 13. Reference to the main changes in the recitals is made below under the relevant Articles.

Articles

Article 1 (Scope)

8. Article 1 was accepted as in the Commission's proposal. The European Parliament has not suggested any amendments to this Article either.

Article 2 (Definitions)

9. On point (a), the Council has partly followed the European Parliament's amendments 36, 42 and 117 by deleting the words "one or more *prima facie* novel" from the definition of "computer-implemented invention", on the grounds that these are redundant and risk creating confusion as regards their relationship with the novelty test, which applies at the stage of the examination of the patentability of any invention.

10. On point (b), the Council:

- replaced "technical field" with "field of technology", which is the term commonly used in international agreements on patent law, such as the TRIPS Agreement;
- inserted the words "new and", in order to clarify the criteria for "technical contribution";
- added a second sentence, which is basically the provision of Article 4(3) of the Commission proposal slightly amended in order to clarify that even if non-technical features may be taken into consideration when assessing the technical contribution of a given computer-implemented invention, it is indispensable that any patent claim comprises technical features as well. This idea concurs with part of the European Parliament's amendments 16, 100, 57, 99, 110 and 70.

Article 3 of the Commission proposal (Computer-implemented inventions as a field of technology)

11. This Article imposed on Member States the obligation of ensuring in their national law that computer-implemented inventions are considered to belong to a field of technology. In accordance with the European Parliament's amendment 15, the Council has decided to delete Article 3, considering that a general obligation of this nature would be difficult to transpose into national law. In exchange, the Council has decided to reinforce in recital 13 the relevant statement contained in recital 11 of the Commission proposal.

Article 3 (Article 4 of the Commission proposal) (Conditions for patentability)

12. The Council merged the first two paragraphs of Article 4 of the Commission proposal into a single paragraph, while introducing minor drafting amendments with a view to improving the clarity of the text. The new text follows word by word the wording of Article 4(1) as proposed in the European Parliament's amendment 16.

13. As already mentioned, paragraph 3 of Article 4 of the Commission proposal has been incorporated in the definition of 'technical contribution' under Article 2(b), as it was felt that this belongs to the definitions rather than in an Article entitled 'Conditions for patentability'.

Article 4 (Exclusions from patentability)

14. In order to avoid any misunderstanding, the Council has included in paragraph 1 of this Article a clear statement to the effect that a computer program as such cannot constitute a patentable invention.

15. Paragraph 2, which corresponds to amendment 17 of the European Parliament, aims at clarifying the limits of what can be patentable under the present Directive and has to be read in conjunction with recitals 14 to 16, which correspond to the European Parliament's amendments 85, 7 and 8. The Council has however inserted the terms "whether expressed as source code, as object code or in any other form" in order to clarify better what is meant by "invention involving computer programs".

Article 5 (Form of claims)

16. Paragraph 1 was accepted as in the Commission's proposal.

17. Paragraph 2 was added in order to clarify that in certain circumstances and under strict conditions a patent can cover a claim to a computer program, be it on its own or on a carrier. The Council

considers that this would align the Directive on standard current practice both at the European Patent Office and in Member States.

Article 6 (Relationship with Directive 91/250/EEC)

18. The Council has taken on board the European Parliament's amendment 19, considering that this is clearer than the text of the Commission's proposal. It has removed references to provisions concerning semiconductor topographies or trade marks as these were considered as irrelevant in this context.

19. The Council did not take on board the European Parliament's amendment 76, considering that this was too open-ended and would be contrary to the TRIPS Agreement. The Council considered that the interoperability issue is already sufficiently covered by Article 6, as well as by the application of general competition rules. This is clearly explained in recitals 21 and 22 of the Council's common position.

Article 7 (Monitoring)

20. The Council has taken on board the European Parliament's amendment 71.

Article 8 (Report on the effects of the Directive)

21. The Council has maintained the text of the Commission proposal and has inserted the following additional elements:

- point (b): the words "the term of the patent and" have been added, as suggested by the European Parliament in amendment 92; furthermore, bearing in mind the European Parliament's amendment 25, the Council has introduced language relating to the Community's international obligations;
- point (d): the Council has taken on board the European Parliament's amendment 23;
- point (e): the Council has taken on board the European Parliament's amendment 26;
- point (f): the Council has taken on board the European Parliament's amendment 25, but has removed the reference to the Community patent, on the grounds that such a reference would be irrelevant in this context;
- point (g): the Council has taken on board the substance of the European Parliament's amendment 89, while opting for a clearer wording.

Article 9 of the Council common position (Impact assessment)

22. The Council took on board European Parliament's amendment 27.

Article 10 (Article 9 of the Commission proposal) (Implementation)

23. Unlike the European Parliament, which has opted for an implementation period of 18 months (amendment 28), the Council has opted for an implementation period of 24 months.

Articles 11 (Entry into force) and 12 (Addressees) (Articles 10 and 11 of the Commission proposal)

24. The Council has taken on board the text of the Commission's proposal.

IV. EUROPEAN PARLIAMENT AMENDMENTS NOT TAKEN ON BOARD

25. After having given them full consideration, the Council has not been able to take on board European Parliament amendments 88 (first sentence), 31, 32, 112, 95, 84, 114, 125, 75, 36, 42, 117, 107, 69, 55/rev, 97, 108, 38, 44, 118, 45, 16, 100, 57, 99, 110, 70 (partly), 60, 102, 111, 72, 103, 119, 104, 120, 76, 24, 81, 93, 94 and 28.

26. The Council considered that some of these amendments were superfluous (amendments 88 (first

sentence), 31, 75, 94), unclear and potentially confusing (amendments 36, 42, 117, 72, 104, 120), had no direct link with the issues at stake (amendments 95, 24, 81), did not reflect established practice (amendments 32, 112, 16, 100, 57, 99, 110, 70, 102, 111), or would be contrary to the international obligations of the European Community and its Member States under the TRIPS Agreement as well as to the general principles of patent law (84, 114, 125, 107, 69, 55/rev, 97, 108, 38, 44, 118, 45, 60, 103, 119, 76, 93).

V. CONCLUSIONS

27. In its common position, the Council has taken over a considerable number of amendments proposed by the European Parliament. Throughout the common position, the Council has sought to strike a reasonable and workable balance between the interests of rightholders and those of other parties concerned. The overall balance of the Council's common position has been acknowledged by the Commission, which has accepted it as a satisfactory compromise package.

[1] OJ C 151 E, 25.6.2002, p. 129.

[2] OJ C 61, 14.3.2003, p. 154.

[3] OJ C 77 E, 26.3.2004, p. 230.

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Communication from the Commission to the European Parliament pursuant to the second subparagraph of Article 251 (2) of the EC Treaty concerning the common position of the Council on the adoption of a directive of the European Parliament and Council on the [patentability of computer-implemented inventions](#)

Brussels, 09.03.2005

COM(2005) 83 final

2002/0047 (COD)

COMMUNICATION FROM THE COMMISSION TO THE EUROPEAN PARLIAMENT pursuant to the second subparagraph of Article 251 (2) of the EC Treaty concerning the

common position of the Council on the adoption of a directive of the European Parliament and Council on the [patentability of computer-implemented inventions](#)

2002/0047 (COD)

COMMUNICATION FROM THE COMMISSION TO THE EUROPEAN PARLIAMENT pursuant to the second subparagraph of Article 251 (2) of the EC Treaty concerning the

common position of the Council on the adoption of a directive of the European Parliament and Council on the [patentability of computer-implemented inventions](#)

1- BACKGROUND

Date of transmission of the proposal to the EP and the Council (document COM(2002)[92] final - [2002/[0047]COD)[1]: | 20 February 2002 |

Date of the opinion of the European Economic and Social Committee[2]: | 19 September 2002 |

Date of the opinion of the European Parliament, first reading[3]: | 24 September 2002 |

Date of adoption of the common position[4]: | 7 March 2005 |

2- OBJECTIVE OF THE COMMISSION PROPOSAL

The proposal for a Directive on the [patentability of computer-implemented inventions](#) aims at harmonising the provisions of national patent law dealing with inventions which rely on computers for their performance. The Directive will bring under the supervision of the European Court of Justice the rules applicable by national courts and patent offices charged with assessing the validity of patents and applications in this field. Given that many patents in this field are granted by the European Patent Office, the Administrative Council of the European Patent Organisation could be invited to consider adapting the Implementing Regulations of the European Patent Convention.

3- COMMENTS ON THE COMMON POSITION

3.1 General remarks

The Council, acting by qualified majority, has adopted a common position which incorporates the substance of some 25 of Parliament's amendments at first reading. The Commission has indicated that it accepts the common position, even though this differs from the Commission's original proposal in certain respects. In general, the Commission believes that the common position strikes an acceptable balance between the interests of right holders and those of competitors and consumers (including in the open source community). This balance is further safeguarded by the new requirements in Article 7 for the Commission to monitor the impact of computer-implemented inventions in particular on small and medium-sized enterprises and on the open source community.

As far as the Commission is concerned, the directive continues to address the key objective stated in the explanatory memorandum of the Commission's proposal, namely the harmonisation of patent law between the Member States and the resolution of legal uncertainty in this field. It is crucial to note that there is to date no Community legislative instrument which affects general patent law either in a horizontal manner or specifically relating to computer-implemented inventions. The adoption of this directive would therefore have the effect of bringing patent law in this field, for the very first time, explicitly within Community jurisdiction.

A failure to adopt a directive would prevent Community institutions from exercising control in this strategic area of the European economy, which would thus remain within the remit only of national patent offices and courts and the European Patent Office in Munich.

3.1.1 Computer program product claims

Although the Commission's proposal did not explicitly permit claims on computer programs on their own or on carriers, the Commission has accepted Article 5(2) of the common position as this has to be understood as relating to the enforceability of (existing) patent rights and not to extending the scope of patentability. This is reinforced by the explicit link with Article 5 (1) as mentioned below. To the extent that the relationship between Article 5(2) and the exclusion of computer programs as such (as is explicitly laid out in Article 4(1)) is open to differing interpretations, the text may need further clarification.

Acts relating to computer programs on their own or on carriers could be subject to proceedings for contributory infringement even without provisions equivalent to Article 5(2). The effect of Article 5(2) is thus to facilitate enforcement of legitimate rights by ensuring that such acts may constitute direct, rather than just contributory, infringements. This is particularly important in cases of infringements across national boundaries as Member States' courts do not have jurisdiction over contributory infringements occurring outside their national territory.

In any case, the final part of Article 5(2) makes clear that the claim on the computer program on its own or on a carrier has to put in force a patentable product or process claimed in the same patent application (and falling within the scope of Article 5(1)). This ensures that Article 5(2) cannot constitute protection equivalent to the patentability of computer programs as such, a reading which is furthermore confirmed by the more explicit language of the common position, in particular of Article 4 paragraphs 1 and 2.

3.1.2. Interoperability

The Commission is strongly committed to the promotion of interoperability as a means of fostering innovation and competition. This is consistent with the objectives of the Commission's proposal to help safeguard investment in inventions which are new, inventive and industrially applicable. It is important to note that the requirement for sufficient disclosure of a patented invention may facilitate access to information useful in achieving interoperability of computer-implemented inventions.

The Commission affirmed its commitment to the policy objective of promoting interoperability and fostering innovation by explicitly preserving in Article 6 existing interoperability exceptions under copyright law

The Commission believes that the Council common position remains consistent with these objectives. Equivalent conditions for patentability have been maintained in new Articles 3 and 4 (read in conjunction with Article 2). As expressed in a statement by the Commission to be entered in the minutes of the Council adopting the common position (see below), the Commission considers that Article 6, read in conjunction with Recital 22, permits any acts as described by Articles 5 and 6 of Directive

91/250/EEC on the legal protection of computer programs by copyright, including any acts necessary to ensure interoperability, without the need for authorisation from the patent's right holder.

The Commission furthermore welcomes the fact that safeguards for interoperability have been strengthened in Article 8(d) and (g) in terms of the requirements on the Commission to report on how the situation regarding interoperability has been affected by the passage of the directive.

In the light of the Community objective of promoting interoperability, the Commission intends to facilitate the approximation of the Council and Parliament positions drawing on amendments put forward by both institutions in first reading.

Furthermore, Recital 21 recalls that a dominant supplier who refuses to allow the use of a patented technique to achieve interoperability is subject to the application of competition rules and in particular Articles 81 and 82 of the Treaty. The application of these Articles therefore contributes to achieving the objectives laid out above, although it is of course important to note that competition law on its own cannot solve all potential problems in this area.

. 3.2 Response to Parliament's amendments at first reading

Amendments accepted in full: 1, 2, 3, 34 (=115), 7, 8, 11, 12, 13, 15, 16, 71, 92, 23, 26, 27.

Amendments accepted with minor modification: 85, 9, 86, 17, 19, 25.

Amendments 88 and 89 have been accepted but in a revised form.

Part of amendment 107 (=69) was accepted (the idea that the technical contribution must be new) and some of the text of amendment 76 has been used in recital 17 to deal with the issue that this amendment sought to address.

3.3 Amendments introduced during the discussions within the Council

Recital 1

Council accepted Parliament's amendment 1.

Recital 5

Council accepted Parliament's amendment 2.

Recital 8

Council has incorporated Parliament's amendment 3 and the second half of amendment 88 into this new Recital. It was felt that amendment 3 was an equivalent but clearer restatement of the first part of amendment 88.

Recitals 12 and 13

Council has moved the first part of recital 11 of the Commission's proposal to recital 12 of the Commission's proposal.

Recital 13 of the Commission's proposal (deleted)

Council accepted Parliament's amendment 34 (=115).

Recital 14

Council accepted Parliament's amendment 85.

Recital 15

Council accepted Parliament's amendment 7.

Recital 16

Council accepted Parliament's amendment 8.

Recital 17

Council accepted Parliament's amendment 9.

Recital 18

Council accepted Parliament's amendment 86 with a slight modification to maintain conformity with the Articles and standard patent terminology (obvious or non-technical replaces trivial).

Recital 20

Council accepted Parliament's amendment 11.

Recital 21

This recital has been modified by Council, taking inspiration from the text of Parliament's amendment 76, to address the issue of interoperability.

Recital 22

Council accepted Parliament's amendment 13.

Article 2

The Council deleted the Commission's reference to 'prima facie novel' features in Article 2(a). In Article 2(b), the Council added an element of Amendment 107 (=69) which defines a technical contribution as being new and added a new sentence, transferred from Article 4(3) of the Commission's proposal, to define how the technical contribution is assessed.

Article 3 of the Commission's proposal (deleted)

Council accepted Parliament's amendment 15.

Article 3

Council restated and condensed Article 4 paragraphs (1) and (2) of the Commission's proposal into a single paragraph according to Parliament's amendment 16 and transferred the substance of Article 4(3) of the Commission's proposal to Article 2(b) as noted above.

Article 4

Council introduced a new Article 4. Article 4 (1) reiterates the principle that a computer program as such cannot constitute a patentable invention. Article 4 (2) is Parliament's amendment 17 with some additional wording to make clear that all forms of an excluded program (e.g. source or object code) are not patentable.

Article 5

Council added Article 5(2) disallowing claims to computer programs, alone or on carriers, unless the claimed program puts into force a product or process claimed in accordance with Article 5(1) in the same patent.

Article 6

The Council modified Article 6 in line with Parliament's amendment 19 while also specifying the relevant Articles of Directive 91/250/EEC which are applicable in this context.

Article 7

Council accepted Parliament's amendment 71.

Article 8

Council accepted Parliament's amendments 92, 23, 25, 26 and the spirit of amendment 89. In Article 8(b), it also added a reference to the Community's international obligations. This is understood as primarily a reference to the TRIPS Agreement. In paragraph (f), introduced by amendment 25, the reference to the Community Patent was deleted as this is beyond the scope of the current Directive. New paragraph (g) is a restatement of the intentions behind amendment 89 which Council felt was clearer.

Article 9

Council accepted Parliament's amendment 27.

Article 10

The Council stipulated a transposition period of twenty four months (not defined in the Commission's proposal). Parliament envisaged eighteen months.

3.4 Commission position on the Council's common position

Overall the Commission supports the Council's common position because it retains the balance set out in the original proposal while clarifying certain aspects which were shown to be of concern to the Parliament. Most of the changes introduced by Council are based on Parliament's amendments which the Commission had already indicated that it could support. The remaining differences between the Council's common position and the Commission's original proposal are set out below.

Recital 13 of the Commission's proposal (deleted)

The Commission can accept this deletion because the substance is broadly restated in Recital 16 as introduced by Parliament's amendment 8.

Recital 21

The Commission supports the new wording as it reconfirms that an appropriate way to deal with potential competition issues between enterprises is through the established competition rules. The application of Articles 81 and 82 therefore contributes to achieving objectives underlying the present directive. This Recital usefully gives an example of a potential competition problem involving interoperability, specifically where a dominant supplier refuses to allow the use of a patented technique which is needed for the sole purpose of ensuring conversion of the conventions used in two different computer systems or networks so as to allow communication and exchange of data content between them.

Article 2

The insertion of the requirement that the technical contribution be new is acceptable.

Article 4

The new paragraph 1 of this Article states the existing law and, as the Commission set out to clarify and not change the current legal situation, this is an acceptable addition.

The Commission can also accept the clarification in paragraph 2.

Article 5

The Commission can support the addition of paragraph 2 in the context of the overall package as it provides useful clarification as to the conditions under which particular forms of claim can and cannot be granted and is balanced by other provisions.

Article 6

It is logical to refer to the relevant interoperability provisions precisely so the Commission is in favour of this clarifying addition.

Article 10

Although the Commission would have preferred the swifter transposition envisaged by Parliament, it can accept twenty four months as the deadline for implementation.

4- CONCLUSION

The Commission considers that Council's common position maintains the balance aimed for in the original proposal and it can, therefore, accept it. In particular, the current wording provides for sufficient incentives to innovation in this field and maintains the freedom to commercialise new products while allowing right holders to enforce their rights in an effective yet proportionate way against infringers. The fact of harmonisation at a Community level ensures that the enforcement of these rights is consistent across the European Union and therefore facilitates the efficient

functioning of the Single Market.

The Commission invites the Parliament to engage constructively in further inter-institutional dialogue so as to ensure adoption of a directive which meets these objectives and is ready to engage further with both Parliament and Council on key issues concerning the directive, notably in the light of the Commission's commitments to the promotion of interoperability

5- COMMISSION STATEMENT

The following statement is entered in the minutes of the Council adopting the common position

The Commission considers that Article 6, read in conjunction with Recital 22, permits any acts as described by Articles 5 and 6 of Directive 91/250/EEC on the legal protection of computer programs by copyright, including any acts necessary to ensure interoperability, without the need for authorisation from the patent's right holder.

[1] OJ No C 151, 25.6.2002, p.129 COM (2002) 92 final

[2] OJ No C 61 , 14.3.2003, p.154

[3] 11503/03 CODEC 995 PI 70

[4] insert reference

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P5_TA(2003)0402

Patentability of computer-implemented inventions *I**

European Parliament legislative resolution on the proposal for a directive of the European Parliament and of the Council on the patentability of computer-implemented inventions (COM(2002) 92 – C5-0082/2002 – 2002/0047(COD))

(Codecision procedure: first reading)

The European Parliament,

- having regard to the Commission proposal to the European Parliament and the Council (COM(2002) 92)¹,
 - having regard to Article 251(2) and Article 95 of the EC Treaty, pursuant to which the Commission submitted the proposal to Parliament (C5-0082/2002),
 - having regard to the opinion of the European Economic and Social Committee²,
 - having regard to Rule 67 of its Rules of Procedure,
 - having regard to the report of the Committee on Legal Affairs and the Internal Market and the opinions of the Committee on Industry, External Trade, Research and Energy and the Committee on Culture, Youth, Education, the Media and Sport (A5-0238/2003),
1. Approves the Commission proposal as amended;
 2. Calls on the Commission to refer the matter to Parliament again if it intends to amend the proposal substantially or replace it with another text;
 3. Instructs its President to forward its position to the Council and Commission.

¹ OJ C 151 E, 25.6.2002, p 129.

² OJ C 61, 14.3.2003, p. 154.

Position of the European Parliament adopted at first reading on 24 September 2003 with a view to the adoption of Directive 2003/.../EC of the European Parliament and of the Council on the patentability of computer-implemented inventions

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 95 thereof,

Having regard to the proposal from the Commission¹,

Having regard to the opinion of the *European Economic and Social Committee*²,

Acting in accordance with the procedure laid down in Article 251 of the Treaty³,

Whereas:

- (1) The realisation of the internal market implies the elimination of restrictions *on free movement* and of distortions in competition, while creating an environment which is favourable to innovation and investment. In this context the protection of inventions by means of patents is an essential element for the success of the internal market. *Effective, transparent* and harmonised protection of computer-implemented inventions throughout the Member States is essential in order to maintain and encourage investment in this field.
- (2) Differences exist in the protection of computer-implemented inventions offered by the administrative practices and the case law of the different Member States. Such differences could create barriers to trade and hence impede the proper functioning of the internal market.

¹ OJ C 151 E, 25.6.2002, p. 129.

² OJ C 61, 14.3.2003, p. 154.

³ *Position of the European Parliament of 24 September 2003.*

- (3) Such differences have developed and could become greater as Member States adopt new and different administrative practices, or where national case law interpreting the current legislation evolves differently.
- (4) The steady increase in the distribution and use of computer programs in all fields of technology and in their world-wide distribution via the Internet is a critical factor in technological innovation. It is therefore necessary to ensure that an optimum environment exists for developers and users of computer programs in the Community.
- (5) Therefore, the legal rules ***governing the patentability of computer-implemented inventions*** should be harmonised ***so as to ensure that*** the resulting legal certainty ***and the level of requirements demanded for patentability*** enable innovative enterprises to derive the maximum advantage from ***their inventive process*** and provide an incentive for investment and innovation. ***Legal certainty will also be secured by the fact that, in case of doubt as to the interpretation of this Directive, national courts may, and national courts of last instance must, seek a ruling from the Court of Justice of the European Communities.***
- (6) ***The rules of the Convention on the Grant of European Patents signed in Munich on 5 October 1973, and in particular Article 52 thereof concerning the limits to patentability, should be confirmed and clarified. The consequent legal certainty should help to foster a climate conducive to investment and innovation in the field of software.***
- (7) ***Under the Convention and the patent laws of the Member States, programs for computers together with discoveries, scientific theories, mathematical methods, aesthetic creations, schemes, rules and methods for performing mental acts, playing games or doing business, and presentations of information are expressly not regarded as inventions and are therefore excluded from patentability. This exception applies because such subject-matter and activities do not belong to a field of technology.***

- (8) *The aim of this Directive is not to amend the aforementioned Convention, but to prevent different interpretations of its provisions.*
- (9) *In its Resolution of 30 March 2000 on the decision by the European Patent Office with regard to patent No EP 695 351 granted on 8 December 1999¹, the European Parliament once again called for a review of the Office's operating rules to ensure that it was publicly accountable in the exercise of its functions. In this connection it would be particularly desirable to reconsider the practice whereby the Office sees fit to obtain payment for the patents that it grants, as this practice harms the public nature of the institution.*
- (10) Patent protection allows innovators to benefit from their creativity. Patent rights protect innovation in the interests of society as a whole, *and* should not be used in a manner which is anti-competitive.
- (11) In accordance with Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs², the expression in any form of an original computer program is protected by copyright as a literary work. However, ideas and principles which underlie any element of a computer program are not protected by copyright.

¹ *OJ C 378, 29.12.2000, p. 95.*

² OJ L 122 , 17.5.1991, p. 42. Directive amended by Directive 93/98/EEC (OJ L 290, 24.11.1993, p. 9).

- (12) In order for any invention to be considered as patentable it should have a technical character, and thus belong to a field of technology.
- (13) *In order to be patentable, inventions in general and computer-implemented inventions in particular must be susceptible of industrial application, new and involve an inventive step. In order to involve an inventive step, computer-implemented inventions must in addition make a new technical contribution to the state of the art, in order to distinguish them from pure software.*
- (14) *Accordingly, an innovation that does not make a technical contribution to the state of the art is not an invention within the meaning of patent law.*
- (15) *However, the mere implementation of an otherwise unpatentable method on an apparatus such as a computer is not in itself sufficient to warrant a finding that a technical contribution is present. Accordingly, a computer-implemented business method, data processing method or other method in which the only contribution to the state of the art is non-technical cannot constitute a patentable invention.*
- (16) *If the contribution to the state of the art relates solely to unpatentable matter, there can be no patentable invention irrespective of how the matter is presented in the claims. For example, the requirement of technical contribution cannot be circumvented merely by specifying technical means in the patent claims.*
- (17) *Furthermore, an algorithm is inherently non-technical and therefore cannot constitute a technical invention. Nonetheless, a method involving the use of an algorithm might be patentable provided that the method is used to solve a technical problem. However, any patent granted for such a method should not monopolise the algorithm itself or its use in contexts not foreseen in the patent.*

- (18) *The scope of the exclusive rights conferred by any patent are defined by the claims. Computer-implemented inventions must be claimed with reference to either a product such as a programmed apparatus, or to a process carried out in such an apparatus. Accordingly, where individual elements of software are used in contexts which do not involve the realisation of any validly claimed product or process, such use will not constitute patent infringement.*
- (19) The legal protection of computer-implemented inventions *does* not necessitate the creation of a separate body of law in place of the rules of national patent law. The rules of national patent *law remain* the essential basis for the legal protection of computer-implemented inventions. *This Directive simply clarifies the current legal position with a view to securing legal certainty, transparency, and clarity of the law and avoiding any drift towards the patentability of unpatentable methods such as trivial procedures and business methods.*
- (20) This Directive should be limited to laying down certain principles as they apply to the patentability of such inventions, such principles being intended in particular to ensure that inventions which belong to a field of technology and make a technical contribution are susceptible of protection, and conversely to ensure that those inventions which do not make a technical contribution are not so susceptible.
- (21) The competitive position of European industry in relation to its major trading partners *will* be improved if the current differences in the legal protection of computer-implemented inventions *are* eliminated and the legal situation *is* transparent. *With the current trend for traditional manufacturing industry to shift their operations to low-cost economies outside the European Union, the importance of intellectual property protection and in particular patent protection is self-evident.*

- (22) This Directive *should* be without prejudice to the application of the competition rules, in particular Articles 81 and 82 of the Treaty.
- (23) *The rights conferred by patents granted for inventions within the scope of this Directive should not affect acts permitted under Articles 5 and 6 of Directive 91/250/EEC, in particular under the provisions thereof in respect of decompilation and interoperability. In particular, acts which, under Articles 5 and 6 of that Directive, do not require authorisation of the rightholder with respect to the rightholder's copyrights in or pertaining to a computer program, and which, but for those Articles, would require such authorisation, should not require authorisation of the rightholder with respect to the rightholder's patent rights in or pertaining to the computer program.*
- (24) *At all events, the legislation of the Member States must ensure that patents contain innovations and involve an inventive step, so as to prevent inventions already in the public domain from being appropriated simply by being incorporated into a computer program.*
- (25) Since the objectives of the proposed action, namely to harmonise national rules on computer-implemented inventions, cannot be sufficiently achieved by the Member States and can therefore, by reason of the scale or effects of the action, be better achieved at Community level, the Community may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty. In accordance with the principle of proportionality, as set out in that Article, this Directive does not go beyond what is necessary to achieve those *objectives*,

HAVE ADOPTED THIS DIRECTIVE:

Article 1

Scope

This Directive lays down rules for the patentability of computer-implemented inventions.

Article 2

Definitions

For the purposes of this Directive the following definitions shall apply:

- (a) “computer-implemented invention” means any invention *within the meaning of the European Patent Convention* the performance of which involves the use of a computer, computer network or other programmable apparatus and having *in its implementations* one or more *non-technical* features which are realised wholly or partly *by a* computer program or computer programs, *besides the technical features that any invention must contribute;*
- (b) “technical contribution”, *also called “invention”*, means a contribution to the state of the art in *a field of technology*. *The technical character of the contribution is one of the four requirements for patentability. Additionally, to deserve a patent, the technical contribution has to be new, non-obvious, and susceptible of industrial application. The use of natural forces to control physical effects beyond the digital representation of information belongs to a field of technology. The processing, handling, and presentation of information do not belong to a field of technology, even where technical devices are employed for such purposes;*

- (c) ***“field of technology” means an industrial application domain requiring the use of controllable forces of nature to achieve predictable results. “Technical” means “belonging to a field of technology”;***
- (d) ***“industry” within the meaning of patent law means the automated production of material goods.***

Article 3

Data-processing and patent law

Member States shall ensure that data processing is not considered to be a field of technology within the meaning of patent law, and that innovations in the field of data processing are not considered to be inventions within the meaning of patent law.

Article 4

Conditions for patentability

- 1. In order to be patentable, a computer-implemented invention must be susceptible of industrial application, new and involve an inventive step. In order to involve an inventive step, a computer-implemented invention must make a technical contribution.***
- 2. Member States shall ensure that a computer-implemented invention making a technical contribution constitutes a necessary condition of involving an inventive step.***
- 3. The significant extent of the technical contribution shall be assessed by consideration of the difference between all of the technical features included in the scope of the patent claim considered as a whole and the state of the art, irrespective of whether or not such features are accompanied by non-technical features.***

4. In determining whether a given computer-implemented invention makes a technical contribution, the following test shall be used: whether it constitutes a new teaching on cause-effect relations in the use of controllable forces of nature and has an industrial application in the strict sense of the expression, in terms of both method and result.

Article 5

Exclusions from patentability

A computer-implemented invention shall not be regarded as making a technical contribution merely because it involves the use of a computer, network or other programmable apparatus. Accordingly, inventions involving computer programs which implement business, mathematical or other methods and do not produce any technical effects beyond the normal physical interactions between a program and the computer, network or other programmable apparatus in which it is run shall not be patentable.

Article 6

Patentability of solutions to technical problems

Member States shall ensure that computer-implemented solutions to technical problems are not considered to be patentable inventions merely because they improve efficiency in the use of resources within the data processing system.

Article 7

Form of claims

1. Member States shall ensure that a computer-implemented invention may be claimed *only* as a product, that is as a programmed *device*, or as a *technical production process*.

2. Member States shall ensure that patent claims granted in respect of computer-implemented inventions include only the technical contribution which justifies the patent claim. A patent claim to a computer program, either on its own or on a carrier, shall not be allowed.

3. Member States shall ensure that the production, handling, processing, distribution and publication of information, in whatever form, can never constitute direct or indirect infringement of a patent, even when a technical apparatus is used for that purpose.

4. Member States shall ensure that the use of a computer program for purposes that do not belong to the scope of the patent cannot constitute a direct or indirect patent infringement.

5. Member States shall ensure that whenever a patent claim names features that imply the use of a computer program, a well-functioning and well documented reference implementation of such a program shall be published as a part of description without any restricting licensing terms.

Article 8

Relationship with Directive 91/250/EEC

The rights conferred by patents granted for inventions within the scope of this Directive shall not affect acts permitted under Articles 5 and 6 of Directive 91/250/EEC, in particular under the provisions thereof in respect of decompilation and interoperability.

Article 9

Use of patented techniques

Member States shall ensure that, wherever the use of a patented technique is needed for a significant purpose, such as ensuring conversion of the conventions used in two different computer systems or networks so as to allow communication and exchange of data content between them, such use is not considered to be a patent infringement.

Article 10

Monitoring

The Commission shall monitor the impact of computer-implemented inventions on innovation and competition, both within Europe and internationally, and on European businesses, ***especially small and medium-sized enterprises and the open source community, and*** electronic commerce.

Article 11

Report on the effects of the Directive

The Commission shall report to the European Parliament and the Council, *not later than ...**, on

- (a) the impact of patents for computer-implemented inventions on the factors referred to in *Article 10*;
- (b) whether the rules governing ***the term of the patent and*** the determination of the patentability requirements, and more specifically novelty, inventive step and the proper scope of claims, are ***adequate***;

* 54 months after the entry into force of the Directive.

- (c) whether difficulties have been experienced in respect of Member States where the requirements of novelty and inventive step are not examined prior to issuance of a patent, and if so, whether any steps are desirable to address such difficulties;
- (d) *whether difficulties have been experienced in respect of the relationship between the protection by patent of computer-implemented inventions and the protection by copyright of computer programs as provided for in Directive 91/250/EEC, and whether any abuse of the patent system has occurred in relation to computer-implemented inventions;*
- (e) *whether it would be desirable and legally possible having regard to the Community's international obligations to introduce a "grace period" in respect of elements of a patent application for any type of invention disclosed prior to the date of the application;*
- (f) *the aspects in respect of which it may be necessary to prepare for a diplomatic conference to revise the Convention on the Grant of European Patents, also in the light of the advent of the Community patent;*
- (g) *how the requirements of this Directive have been taken into account in the practice of the European Patent Office and in its examination guidelines;*
- (h) *whether the powers delegated to the Office are compatible with the need to harmonise Community legislation, and with the principles of transparency and accountability;*
- (i) *the impact on the conversion of the conventions used in two different computer systems to allow communication and exchange of data; and*
- (j) *whether the option outlined in the Directive concerning the use of a patented invention for the sole purpose of ensuring interoperability between two systems is adequate.*

In this report the Commission shall justify why it believes an amendment of the Directive necessary or not and, if required, will list the points to which it intends to propose an amendment.

Article 12

Impact assessment

In the light of the monitoring carried out pursuant to Article 10 and the report to be drawn up pursuant to Article 11, the Commission shall assess the impact of this Directive and, where necessary, submit proposals for amending legislation to the European Parliament and the Council.

Article 13

Implementation

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive not later than ...*. They shall forthwith inform the Commission thereof.

When Member States adopt those provisions, they shall contain a reference to this Directive or shall be accompanied by such a reference on the occasion of their official publication. Member States shall determine how such reference is to be made.

2. Member States shall communicate to the Commission the text of the provisions of national law which they adopt in the field covered by this Directive.

Article 14

Entry into force

This Directive shall enter into force on the twentieth day following that of its publication in the Official Journal of the European *Union*.

* *Eighteen months after the entry into force of the Directive.*

Article 15

Addressees

This Directive is addressed to the Member States.

Done at ,

For the European Parliament
The President

For the Council
The President


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Law and practice at the European Patent Office

- Patentability requirements under the EPC
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Law and practice at the European Patent Office (EPO)

1. Definition of computer-implemented inventions

According to a generally accepted and widely used definition, a “computer-implemented invention” (CII) is an invention whose implementation involves the use of a computer, computer network or other programmable apparatus, the invention having one or more features which are realised wholly or partly by means of a computer program.

2. Legal framework

- The EPO is bound by European patent law as laid down in the European Patent Convention (EPC), which has been adopted by the 31 member states of the European Patent Organisation, and as interpreted by the independent EPO boards of appeal, the judiciary of the Organisation.
- All the 31 [member states of the European Patent Organisation](#) have national patent laws whose basic provisions, in particular the patentability requirements, have been harmonised with the EPC.

3. Patentability requirements under the EPC

As with all inventions, computer-implemented inventions are only patentable if they

- have technical character and solve a technical problem,
- are new and
- provide an inventive technical contribution to the prior art.

4. Computer programs as such and computer-implemented business methods claimed as computer programs

The European Patent Office (EPO) does not grant patents for computer programs or computer-implemented business methods that make no technical contribution. In this respect the granting practice of the EPO differs significantly from that of the United States Patent and Trademark Office (USPTO).

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Directive on the patentability of computer-implemented inventions

From Wikipedia, the free encyclopedia

(Redirected from EU Directive on the Patentability of Computer-Implemented Inventions)

The European Union (EU) **Directive on the patentability of computer-implemented inventions (2002/0047/COD)** was a proposal for an EU law which aimed to harmonise EU national patent laws and practices, which involved the granting of patents for computer-implemented inventions provided they meet certain criteria.



The proposal became a major focus for conflict between those who regarded the directive as a way to codify the case law of the Boards of Appeal of the European Patent Office in the sphere of computing, and those who asserted that the directive is an extension of the patentability sphere, not just a harmonisation, that ideas are not patentable and that the expression of those ideas is already adequately protected by the law of copyright.

Following several years of debate, the proposal finally fell when the European Parliament rejected it by an overwhelming majority (648 to 14) in a vote on 6 July 2005.

This failure to reform the exclusion of software followed the failed attempt to delete programs for computers from the list of exclusions from patentability in Article 52(2)(c) (<http://www.european-patent-office.org/legal/epc/e/ar52.html>) EPC of the convention in 2000 at the diplomatic conference in Munich (http://patlaw-reform.european-patent-office.org/epc2000/documents/mr/_pdf/em00015.pdf). At the time the reform was explicitly derogated in order to await the outcome of the consultation process for this EU Directive.

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History

Original draft directive

On February 20, 2002, the European Commission initiated a proposal (http://europa.eu.int/eur-lex/lex/LexUriServ/site/en/com/2002/com2002_0092en01.pdf) for a directive to codify and "harmonise" the different EU national patent laws and cement the practice of the European Patent Office of granting patents for computer-implemented inventions provided they meet certain criteria (cf. software patents under the European Patent Convention). The directive also took on the role of excluding "business methods" from patentability (in contrast with the situation under United States law), because business methods as such are not patentable under the different European national patent laws or under the European Patent Convention.

Opponents of the original directive claimed that it was a thinly disguised attempt to make all software patentable. Supporters, however, argued that this was not the case since the proposal (http://europa.eu.int/eur-lex/lex/LexUriServ/site/en/com/2002/com2002_0092en01.pdf) explained in several locations (pages 11, 14, 24, 25) that there should be no extension to the existing scope of patentability for computer programs and that pure business methods implemented in software would not be patentable. Only computer programs which provided a "technical contribution" would be patentable.

This reliance on the word "technical" was an important weakness in the directive, since it is not a word that has a well-defined meaning, and a "technical contribution" was only defined as being "a contribution to the state of the art in a technical field which is not obvious to a person skilled in the art." (See Article 2 of the proposal (http://europa.eu.int/eur-lex/lex/LexUriServ/site/en/com/2002/com2002_0092en01.pdf)). Nevertheless, the term has been used as a benchmark for what is and is not patentable by the EPO and by individual national Patent Offices and courts in Europe (particularly the United Kingdom and Germany) since the early 1980s and a general understanding of its meaning can be gleaned from studying the resulting case law. The subsequent failure of the European Parliament to develop an acceptable definition of what was meant by the word technical illustrates the difficulty inherent in attempting to do so.

Transformation by the European Parliament

On September 24, 2003, the European Parliament passed the directive in a heavily amended form ^[1], which placed significant limits on the patentability of software. The most significant changes included:

- a definition of the "technicity" requirement for patentability which distinguishes between abstract information-processing processes and specific kinds of physical processes (only the latter are "technical");
- a blanket rule that patents cannot be used to prevent interoperability between computer systems.

Patent attorney Axel H. Horns, however, voiced concern that Parliament's wording might extend the ban on software patents to inventions potentially implementable in software, such as signal processing equipment ^[2].

Politically, these amendments were supported almost unanimously by small parties on both the right and left, while the larger groupings (socialists, liberals and conservatives) were all split, with the balance of socialists leaning in favour of amendment and the balance of conservatives leaning against.

Parliament's amendments were a major defeat for the directive's original proponents. Rather than confirming the practice of granting patents for computer programs which provide a technical contribution, the revised directive placed substantial limits on patentability.

Reversion by the Council of Ministers

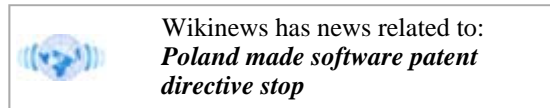
Under the codecision procedure, both the European Parliament and the Council of Ministers (representing national Governments) must approve a text in identical terms in order for a proposal to become law. On 18 May 2004, the Council agreed in an advisory vote to resubmit to Parliament what was described as a "compromise version" of the proposal. The agreed version permitted patenting of computer-implemented inventions (providing the inventions have a "technical character") and overturned most of Parliament's amendments. Critics of the Directive argued that the "technical character" requirement was open to too much

interpretation and could lead to almost unlimited patentability of software. Proponents, also, felt that the amended version contained too many ambiguities to be capable of meeting the original purpose of the Directive, which was to harmonise the law across Europe. Nevertheless, the Council formally approved this resolution on March 7, 2005 ^[3]. The revised proposal was resubmitted to Parliament.

Developments between first Parliament decision and Council decision

Subsequently, in an unprecedented move, the Dutch national parliament passed a motion requesting that the nation's ministerial representative on the Council, Laurens Jan Brinkhorst, change his vote on the Council's version of the directive, from "in favour" to abstention. Brinkhorst stated that he would not do this. ^[4] The Council's confirmation (or otherwise) of its President's "compromise" had also been delayed ^[5].

The Polish government announced on November 16, 2004, that it could not "support the text that was agreed upon by Council on 18 May 2004" ^[6]. A joint press release by the FFII, the Internet Society Poland, and



NoSoftwarePatents.com, supported the concerns of opponents of the Council directive, stating:

"at a meeting hosted by the Polish government on the 5th of this month, everyone including representatives of the Polish Patent Office, SUN, Novell, Hewlett-Packard and Microsoft, as well as various patent lawyers, confirmed that the present proposal of the EU Council does make all software potentially patentable." ^[7]

On 7 December 2004, the Belgian Minister of Economic Affairs, Marc Verwilghen, stated that no Council decision would be taken until 2005 "for the reason that the qualified majority does not exist anymore". However, amid rumours of a change in the Polish position, the 13-15 December meeting of the Council's Committee of Permanent Representatives determined that a qualified majority appeared to exist, and that the Council's revised version of the directive would be scheduled for formal adoption by the Council, without further debate, probably at the Agriculture and Fisheries Council meeting on the 21st and 22 December 2004. ^[8]

Statements expressing reservations were attached to this Common Position by Belgium (which abstained), France (which hoped for further changes to the directive), the Netherlands (where the parliament requested their representative vote against), Poland (which was opposed until recent diplomatic pressure), Hungary and Latvia. Germany was ambivalent, saying that the text of the directive could benefit from improvements.

Due to the expressed reservations and especially to opposition from Poland, whose Minister of Science and Information Technology made a special journey to Brussels to demand that the directive be dropped from the agenda. The Council's vote was postponed "indefinitely".

Meanwhile, a group of 61 MEPs from 13 countries tabled a "motion for a resolution" to restart the entire legislative process. On 2 February 2005, JURI, the Legal Affairs Committee of the European Parliament, voted 19-1 in favour of asking the Commission to withdraw the directive and restart the process.

The next day, Nicolas Schmit, deputy foreign minister of Luxembourg (which at that time chaired the Council), said that he would instead ask the Council to formally adopt the draft directive at a meeting on 17 February. Although Poland stated it would only oppose this if other countries raised an objection, reports of opposition from Denmark, the Netherlands and Spain ensured that the common position was not on the agenda for that meeting of the Commission.

On 17 February, Parliament's Conference of Presidents (the President of the Parliament and the leaders of the political groups) approved JURI's request to restart the process, and agreed to pass the request to the European Commission. On 24 February, a plenary session of the European Parliament reinforced this message, inviting the Commission to reconsider, but on 28 February the Commission refused the parliament's request.

The "common position" reappeared on the agenda of the Council's 7 March meeting as an "A-item" for

adoption without discussion. At the Competitiveness meeting of the Council, Denmark requested that this be removed. The President of the Council, seemingly in breach of the Council's procedures, opposed this, "for administrative reasons" and because it would defeat the logic of the directive. The Danish representative accepted this at face value, declined to object formally, and entered Denmark's objections into the record. The common position was thus adopted without debate, and referred to the European Parliament for a second reading, with dissenting statements and caveats from a number of countries. In the event, only Spain had actually voted against: Austria, Belgium and Italy abstained (which has the same effect as voting against, given the way Qualified Majority Voting works).

Second reading in Parliament

In June 2005, the legal affairs committee of the European Parliament discussed the directive and rejected plans for a complete overhaul of the directive ^[9]. The vote by the committee took place on 21 June 2005, and narrowly decided not to substantially amend the Council version of the directive. According to the Financial Times, this "vote marks a turning point in the protracted battle over the law, which has split the software industry and sparked severe recriminations." ^[10]

On 5 July 2005, the committee's report passed to a plenary session of Parliament for debate by all MEPs. On 6 July 2005, Parliament rejected the proposal by a very large majority (648 in favour of rejection, 14 against and 18 registered abstentions out of 729 total MEPS) without considering any of the other 175 proposed amendments. Under the codecision procedure, the legislative process ended with this rejection and the proposed directive did not become law in any form. This was the first and as of 2005 the only time a directive was ever rejected by Parliament at second reading. ^[11]



Wikinews has news related to:
European Parliament rejects computer-implemented inventions directive

The vote was the result of a compromise between the different parties: those in favour of software patents feared a text that would heavily limit its scope, while those against rejected the whole principle. Heavy defeat was the "least worst option" to both sides. In addition, some saw the defeat as an expression of Parliament's indignation about the handling of the proposal by the Council of the European Union and the European Commission as well as its concerns about the content of the proposal itself.

Consequences of the rejection

Parliament's decision to strike down the final draft has the effect that national laws will not be harmonised. National legislatures may continue to enact laws allowing patents on computer-implemented inventions, should they wish to do so, and national courts may enforce such laws. The European Patent Office, which is not legally bound by any EU directive but generally adapts its regulations to new EU law, has no reason or incentive to adapt its practice of granting patents on computer-implemented inventions under certain conditions, according to its interpretation of the European Patent Convention and its Implementing Regulations.

Reactions

Supporters of the proposal

Supporters of the proposed directive included Microsoft, IBM, Hewlett-Packard and the European Patent Office.

The European Information and Communication Technology Association (EICTA) warned that "thousands of jobs and inventions were at risk because of opposition from the European parliament to a draft EU directive giving patent protection to scores of new products" ^[1] (<http://www.guardian.co.uk/business/story/0,3604,1351216,00.html>). EICTA's position was in turn been

characterised by opponents of software patents as "dominated by patent lawyers from the patent arms of large corporate members" [2] (<http://swpat.ffii.org/players/eicta/index.en.html>), "most of which qualifying as non European companies" [3] (<http://wiki.ael.be/index.php/AgoriaRepresentativity>) and "with a patent policy (...) tailored to the special interests of a few large corporations (...)" [4] (<http://www.nosoftwarepatents.com/en/m/politics/organizations.html>).

Opponents of the proposal

The proposal catalyzed a campaign by diverse opponents of software patents, who took the opportunity afforded by the introduction of the proposal to argue that software patents are neither economically desirable nor mandated by international law. The FFII and the EuroLinux Alliance played key roles in coordinating this lobbying campaign, which drew support from some free software and open source programmers, some academics, some small business groups, and some commercial software developers. Many of these organisations expressed concern over what they saw as abuses of the software patent system in the USA, and argued that although some software patents might be beneficial, the net effect of the Commission's proposals would be to suppress innovation and dampen legitimate competition. The campaign in its turn was characterised by advocates of software patents as "a small but highly organised and vocal lobby" ([5] (<http://www.out-law.com/page-4814>) and [6] (<http://www.out-law.com/page-4835>) for an answer by an opponent), although the opposition to the Directive expressed by the parliaments of a number of member states suggested that opposition was more widespread.

Figures who have supported the campaign against software patents in Europe include Tim Berners-Lee, developer of the World Wide Web, and Linus Torvalds, developer of Linux. Politicians opposed to the directive included Michel Rocard. Political opposition was founded both on opposition to software patents and on hostility towards what was seen as heavy-handed management by the Commission.

On 16 February 2005, the European Parliament's Directorate General for Economic and Scientific Policy issued a briefing paper (<http://www.ffii.org/~jmaebe/epescosci0502/SoftwarePatent.pdf>) (and summary (<http://www.ffii.org/~jmaebe/epescosci0502/SoftwareHandout.pdf>)) which concluded that a directive is needed both to harmonise the laws of the member states and to enable Europe to compete, but which also stated that "if we adopt the current proposal, it will create the same broad and ambiguous system that is in place in USA".

Concerns about the balance of power

Apart from the issue itself, the legislative process for this directive generated concerns about the balance of power between the European Commission and the European Parliament. It also raised concern about the balance between the Council (of member state governments) and Parliament (of elected members from member states). When the Commission rejected Parliament's request to restart discussion on the directive, this led to debates over how much power the Commission should have compared to Parliament and member states. Some MEPs saw the affair as part of a power struggle between the two bodies. Others believed that the real debate was more about whether Council should be able to overrule Parliament, or vice versa.

Software patents and international law

Main articles: Software patents under TRIPs Agreement, Software patents under the European Patent Convention.

Whether international law mandates software patents is a controversial question. The World Trade Organisation's TRIPs Agreement includes a requirement that:

"(...) patents shall be available for any inventions, whether products or processes, in all fields of technology, provided they are new, involve an inventive step and are capable of industrial application" (Art. 27(1)).

The only avenue open for completely avoiding a requirement that algorithms be patentable is to define them as not being "inventions" [7] (<http://www.jenkins-ip.com/patlaw/pa77.htm#s1>); and/or to define them as being non-technical and thus not in a "field of technology". This distinction is arbitrary but also self-consistent, in that it makes perfect sense to distinguish between "technical" processes and devices (i.e., those tied to the physical world) and informational or mathematical processes which have no necessary connection to physics. Because the "field of technology" requirement in TRIPs had its origins in European patent laws, Europe is, in legal terms, free to take steps to define the concept in either a broad or narrow way.

In fact, some people argue that the principle of software patents breaches those very international treaties which impose them according to others. [8] (<http://beauprez.net/softpat/summary.html>)

See also

- Community Patent
- Strasbourg Convention (1963)
- Directive on the patentability of biotechnological inventions
- Directive on the enforcement of intellectual property rights
- Institutions of the European Union
- Software patent

Notes

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2. ^ "The Protection of Software and the Crisis of the Patent System" (<http://216.92.57.242/patentepi/data/040901SoftPat-10-FINAL.pdf>), Axel H. Horns, p8,15.
3. ^ "EU ministers endorse patent law" (<http://news.bbc.co.uk/1/hi/technology/4325215.stm>), *BBC News*.
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5. ^ "EU software patents directive delayed" (<http://europa.eu.int/idabc/en/document/3378>), *iDABC eGovernment News*.
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- "Software patents law up in the air after Poland pull out" (<http://www.euractiv.com/Article?tcaturi=tcm:29-132419-16&type=News>) (November 19, 2004). *EuroActiv.com*.

External links

- European Commission's page on the Patentability of computer-implemented inventions (http://europa.eu.int/comm/internal_market/en/indprop/comp/index.htm)
- News story about defeat of CII directive, 6th July 2005 (<http://www.linuxformat.co.uk/modules.php?op=modload&name=News&file=article&sid=56&mode=thread&order=0&thold=0>)
- Interview with Mark Webbink, Red Hat's deputy General Counsel (<http://www.linuxformat.co.uk/modules.php?op=modload&name=News&file=article&sid=57&mode=thread&order=0&thold=0>)
- FAQ about the directive (<http://www.patent.gov.uk/about/ippd/faq/softpat.htm>) and Summary of the issues (<http://www.patent.gov.uk/about/ippd/issues/cii.htm>), on the UK Patent Office site
- Top reasons why there should be no software patents (<http://wiki.ael.be/index.php/TopReasonsWhyNoEpatents>)
- History of the Directive proposal from FSF Europe Chapter Italy (<http://www.italy.fsf-europe.org/projects/swpat/swpat.en.html>)
- opposes software patents (<http://www.softwarepatents.co.uk/>)
- opposes software patents (<http://www.nosoftwarepatents.com/>)
- The Proper Balance of Competition and Patent Law and Policy (PDF) (<http://www.ftc.gov/os/2003/10/innovationrpt.pdf>), (Federal Trade Commission)
- A Study of Copyright and patent law interactions (<http://www.codeliberty.org/defence.html>)

- The EU and the software patent directive (<http://newsbyte.blogspot.com/2005/07/software-patents-manifesto.html>)

Studies and working papers

- The patentability of computer programmes: Discussion of European-level legislation in the field of patents for software (PDF) (<http://www.europarl.eu.int/meetdocs/committees/juri/20020619/SoftwarePatent.pub.pdf>), working paper of the European Parliament's Directorate-General for Research
- Enforcing small firms' patent rights (PDF) (ftp://ftp.cordis.lu/pub/innovation-policy/studies/studies_enforcing_firms_patent_rights.pdf) A study funded by the European Commission, Enterprise Directorate-General

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Categories: European patent law | Computer law | European Union laws

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Patentability requirements under the European Patent Convention

1. Starting point

- The starting point for defining the legal framework within the European patent grant procedure for assessing the patentability of computer-implemented inventions is [Article 52](#) of the European Patent Convention (EPC).
- The EPC contains the fundamental provisions that a patent may be granted in respect of any invention as long as it meets the requirements for patentability ([Article 52\(1\)](#) EPC) and is not expressly excluded from patent protection.

2. Definition of the term "invention"

Whilst the EPC sets out the patentability requirements of novelty, inventive step and industrial application in some detail ([Article 54](#), [Article 56](#) and [Article 57](#) EPC), it does not contain a legal definition of the term "invention". It has, however, been part of the European legal tradition since the early days of the patent system that patent protection should be reserved for technical creations. The subject-matter of a patentable invention must therefore have a "technical character" or, to be more precise, involve a "technical teaching", that is an instruction addressed to a skilled person as to how to solve a particular technical problem using particular technical means.

3. Non-patentable inventions

- Although the EPC does not define the term "invention", it does contain a list of subject-matter and activities that are specifically excluded from patent protection on the grounds that they are not considered as having a technical character. The subject-matter and activities are listed in [Article 52\(2\)](#) EPC, which stipulates that they are not to be regarded as "inventions" within the meaning of European patent law. The list is not exhaustive but enumerates the major exclusions, including "methods for doing business" and "programs for computers".
- It should be emphasised that, under [Article 52\(3\)](#) EPC, these exceptions have to be interpreted narrowly. The subject-matter and activities on the list are only non-patentable if the European patent application or European patent relates to them *as such*. Therefore, inventions having a technical character which are or may be implemented by computer programs may well be patentable.



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- The granting practice of the EPO and the case law of the boards of appeal (an independent body which reviews the decisions of the EPO in grant and opposition proceedings - see [Article 106 EPC](#)) are based on this interpretation of the term "invention".

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Board of appeal decisions

1. The role of the boards of appeal

- The boards of appeal are completely independent in reaching their decisions, in that they are not bound by any instructions but are obliged to comply only with the provisions of the EPC. They are responsible for reviewing the decisions of the EPO in grant and opposition proceedings. In doing so they interpret the EPC in cases where disputes arise. In the field of computer-implemented inventions the boards of appeal have developed the interpretation of the EPC provisions relating to the term "invention" in a number of decisions, providing clear guidance on what is patentable and what is not.
- The EPC as interpreted by the boards of appeal enables and obliges the EPO to grant patents for many inventions in which software makes a technical contribution.

2. The patentability or non-patentability of computer-implemented inventions

According to the established granting practice of the EPO and the case law of the boards of appeal, computer-implemented inventions:

- can be patented if they provide an inventive technical contribution to the prior art;
- are not patentable if there is no technical contribution to the prior art or, if there is such contribution, where that contribution is not new or inventive.

3. Patentability may not be denied merely on the grounds that a computer program is involved

The decision of the technical board of appeal in [case T 208/84 "VICOM"](#) held that a claim directed to subject-matter for controlling or carrying out a technical process is patentable irrespective of whether it is implemented by hardware or software. The decision as to whether a process is carried out by means of special circuits or by means of a computer program depends on economic and technological factors. Patentability may not be denied merely on the grounds that a computer program is involved. This was confirmed by the decision in [case T 26/86 "KOCH & STERZEL"](#) concerning X-ray equipment designed for radiological imaging using a computer program.

4. Patentability is allowed only if there is a further technical effect


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A special case arises in connection with claims to computer program products, such as computer programs stored on a data carrier. **These constitute patentable subject-matter only if there is a "further technical effect"**, that is one going beyond the normal physical effects (for example, the flow of electrical current) which occur when any program is executed. Such further technical effect might be, for instance,

- the more secure operation of the brakes of a car or train
- faster communication between two mobile phones with improved quality of voice transmission.

However, such claims are only allowed by the EPO if they relate to a new and inventive technical process which may be carried out by a computer program (see Guidelines for Examination in the EPO, [C-IV, 2.3](#)).

This practice is consistent with the case law of the EPO boards of appeal (decisions [T 1173/97 "IBM"](#) and [T 935/97 "IBM"](#)).

5. Business methods as such are excluded from patentability

Nevertheless, if the claimed subject-matter specifies an apparatus or technical process for carrying out at least some part of the business method, that business method and the apparatus or technical process have to be examined as a whole (**decisions [T 931/95 "PBS"](#) and [T 641/00 "COMVIK"](#) and Guidelines for Examination in the EPO, [C-IV, 2.3](#)**). In particular, if the claim specifies computers, computer networks or other conventional programmable apparatus, or a program therefor, for carrying out at least some steps of a business method, it is to be examined as a computer-implemented invention (**decisions [T 1173/97 "IBM"](#) and [T 935/97 "IBM"](#)**).

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Other relevant aspects

1. Source codes

- **There is no legal basis in the EPC for requesting a program source code from the applicant**, nor is it the policy of the EPO to require or examine source codes or to publish them as annexes to patent application documents (which consist of the request for grant, the claims, the description, the drawings and the abstract). The source code is neither necessary nor appropriate for sufficient disclosure of a computer-implemented invention. For examination and publication purposes the inventive concept must be disclosed in the application in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. This does not require disclosure of a source code.
- Moreover, given the length and complexity of source code listings, which can often stretch to hundreds of pages, it would be quite impossible to examine them.

2. “No search” declarations

- **Business methods**, even if they involve the use of a computer, are not themselves patentable in Europe if their technical implementation is straightforward. Such methods are, however, often patented in the USA.
- **Claims to business methods and their commonplace technological implementation in patent applications are not searched by the EPO because a meaningful search into the state of the art is not possible.** In such cases a declaration is issued that no search report will be established or, where appropriate, a partial search report only will be established. This practice also enables the EPO to indicate to the applicant at a very early stage that the claims of the application contain subject-matter that is not patentable.

3. Patents for “trivial” inventions

- The expression “trivial patent” is ambiguous and subjective. If a “trivial” patent is one that has been granted but, in the opinion of a third party, should not have been because it lacks novelty or inventive step, then mechanisms exist by which such patents may be challenged.
- Furthermore, with hindsight many patented inventions may appear to be trivial or obvious, though at


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the priority date of the application they were not. Finally, in cases where the scope of protection is small or has become small, perhaps because the examiner has in the light of the prior art imposed additional restrictions to the claims, such that it might appear to be "trivial" in the opinion of third parties, then such a patent may be of doubtful value to its owner and unlikely to block any further technical innovation.

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Diplomatic conference to revise the EPC

- In June 1999 the member states of the European Patent Organisation gathered in Paris at an intergovernmental conference on the reform of the patent system in Europe. The [mandate](#) adopted by the Conference stated that "it is desirable to eliminate any ambiguity regarding the patentability of inventions involving software" and requested the Organisation to "prepare a revision conference to be convened in the year 2000 with a view to adopting a revised text relating in particular to [Article 52\(2\) EPC](#)" Article 52(2) EPC excludes computer programs as such from patentability.
- The Diplomatic Conference to revise the EPC took place in November 2000. The patentability of computer programs was one of many revision points submitted to the Conference. It was proposed that programs for computers be deleted from the list in [Article 52\(2\)](#) (see the "Basic proposal for the revision of the EPC" [MR/2/00](#), pages 43-44).
- The Conference however decided to leave Article 52(2) EPC unchanged. In a [conference resolution](#) adopted on 29 November 2000, the signatory states "agreed to maintain for the present the EPC's current provisions on software".
- Furthermore, in a press conference held at the end of the conference, chairman Roland Grossenbacher said : "The Conference agreed not to delete computer programs from the list of non-patentable inventions. For the meantime, the existing legal position therefore remains unchanged. The Conference's decision took account of the process of consultation on the future of legal protection in this field, and in no way challenges the existing practice of the Office and its boards of appeal, or that of national patent authorities and courts. As before, computer-implemented inventions can be patented if they involve a new and inventive technical contribution to the state of the art. Technical solutions for use in data processing or for carrying out methods of doing business therefore remain patentable" (see [Statement by the chairman of the Diplomatic Conference](#)).

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Proposed EU directive on the patentability of computer-implemented inventions

- On 20 February 2002 the European Commission presented a [proposal for a directive](#) on the patentability of computer-implemented inventions.
- The recitals accompanying the proposal explain the background to the Commission's initiative:
 - (1) ... "Effective, transparent and harmonised protection of computer-implemented inventions throughout the Member States is essential to maintain and encourage investment in this field.
 - (2) Differences exist in the protection of computer-implemented inventions offered by the administrative practices and the case law of the Member States. Such differences could create barriers to trade and hence impede the proper functioning of the internal market.
 - (3) Such differences have developed and could become greater as Member States adopt new and different administrative practices, or where national case law interpreting the current legislation evolves differently
 - (5) ... the legal rules as interpreted by Member States' courts should be harmonised and the law governing the patentability of computer-implemented inventions should be made transparent."
- The [first reading](#) in the European Parliament took place on 23 -24 September 2003.
- On 7 March 2005, the Council agreed on a [common position](#).
- On 6 July 2005, the European Parliament, in the second reading, [rejected](#) the proposed directive by 648 votes to 14 with 18 abstentions. This **terminates the legislative procedure**. The Commission has indicated that, for the time being, it does not intend to present a new proposal for legislation in this field.

See EPO [press release](#) dated 6 July 2005.

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European Patent Office continues to advocate harmonisation in the field of CII patents

Munich/Strasbourg, 6 July 2005 - The European Patent Office (EPO) has followed with interest the vote of the European Parliament today and has taken note of the decision of the European Parliament not to accept the Directive on the patentability of computer-implemented inventions (CII) according to the Common Position of the Council. The proposed Directive is therefore deemed not to have been adopted. "The objective of the directive would have been to harmonize the understanding of what constitutes a patentable invention in the field of CII", explained the President of the EPO, Professor Alain Pompidou.

The EPO carries out a centralised patent granting procedure for the 31 [member states](#) of the European Patent Organisation. "Our Organisation was founded by almost the same countries as those which founded the European Union, and in the same spirit. The purpose behind the creation of the EPO was to make the patenting process in Europe more efficient by applying a single procedure on the basis of the [European Patent Convention](#) (EPC). In its practice, the EPO follows strictly the provisions of the Convention, which has been ratified by all member states of the Organisation", President Pompidou explained.

Under the EPC a well-defined practice on granting patents in the field of CII has been established: "The EPC provides the general legal basis for the grant of European patents, whereas the objective of the directive would have been to harmonise the EU member states' rules on CII and the relevant provisions of the EPC. The EPC also governs our work in the field of CII, together with the case law of our judiciary, the Boards of Appeal of the EPO," Mr Pompidou said.

As with all inventions, CII are only patentable if they have technical character, are new and involve an inventive technical contribution to the prior art. Moreover, the EPO does not grant "software patents": computer programs claimed as such, algorithms or computer-implemented business methods that make no technical contribution are not considered patentable inventions under the EPC. In this respect, the practice of the EPO differs significantly from that of the United States Patent & Trademark Office.

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Appeal procedure before the European Patent Office

From Wikipedia, the free encyclopedia

Decisions of the first instances of the European Patent Office (EPO) can be appealed, i.e. challenged, before the **Boards of Appeal of the EPO**, in a judicial procedure (proper to an administrative court), as opposed to an administrative procedure. These boards act as the final instances in the granting and opposition procedures before the EPO.

In addition to the Boards of Appeal, the European Patent Office includes an **Enlarged Board of Appeal**. This board does not constitute an additional level of jurisdiction in the classical sense. This instance takes decisions only when the case law of the Boards of Appeal becomes inconsistent or when an important point of law arises. Its purpose is "to ensure uniform application of the law" ^[1] and to clarify or interpret important points of law in relation to the European Patent Convention.

Only the Boards of Appeal themselves and the President of the EPO can refer a question to the Enlarged Board of Appeal. In the first case, the Enlarged Board issues a decision, while in the latter case it issues an opinion.

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Appointment and independence

The members of the Boards of Appeal and of the Enlarged Board of Appeal are appointed by the Administrative Council of the EPO on a proposal from the President of the EPO, ^[2] and are employed of the European Patent Organisation. In contrast, members of the search divisions and of the examining divisions of the EPO are employed by the European Patent Office.

Members of the Boards are only bound by the European Patent Convention. They are not bound by any instructions, such as the "Guidelines for Examination in the European Patent Office". They have a duty of independence. ^[3]

However, since "the [appeal] boards' administrative and organisational attachment to the EPO which is an administrative authority obscures their judicial nature and is not fully commensurate with their function as a judicial body" ^[4], there have been calls for creating, within the European Patent Organisation, a third judicial body alongside the Administrative Council and the European Patent Office. This third judicial body would replace the present Boards of Appeal and could be called the "*Court of Appeals of the European Patent Organisation*" ^[5] or the "*European Court of Patent Appeals*". ^[4] This third body would have his own budget, would have its seat in Munich, Germany and would be supervised "without prejudice to its judicial independence" by the Administrative Council of the EPO. ^[4] The EPO has also proposed that the members of the Boards of Appeal should be appointed for lifetime, "with grounds for termination exhaustively regulated in the EPC". ^[4] These change would however need to be approved by a new Diplomatic Conference.

Decisions and opinions

Binding character

The legal system established under the EPC differs from a common law legal system in that "[it] does not treat (...) established jurisprudence as binding." ^[6] Indeed, a decision of a Board of Appeal is only binding on to the department whose decision was appealed, in so far as the facts are the same (if the case is remitted to the first instance of course) ^[7] However, "[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." ^[8]

A decision of the Enlarged Board of Appeal (pursuant to Article 112(1)(a) (<http://www.european-patent-office.org/legal/epc/e/ar112.html>) EPC) is only binding on the Board of Appeal in respect of the appeal in question, i.e. on the Board of Appeal which referred the question to the Enlarged Board of Appeal. In practice however, the Boards of Appeal rarely diverge from the case law established by the Enlarged Board of Appeal.

If "a Board [of Appeal] considers it necessary to deviate from an interpretation or explanation of the [EPC] given in an earlier decision of any Board [of Appeal], the grounds for this deviation shall be given, unless such grounds are in accordance with an earlier opinion or decision of the Enlarged Board of Appeal. The President of the European Patent Office shall be informed of the Board's decision." ^[9]

References

Each decision issued by the Boards of Appeal or by the Enlarged Board of Appeal, as well as each opinion of the Enlarged Board of Appeal, has an alphanumeric reference, such as decision *T 285/93*. The first letter of the reference gives an indication of the type of board which took the decision:

- *G* - Enlarged Board of Appeal
- *T* - Technical Board of Appeal
- *J* - Legal Board of Appeal
- *D* - Disciplinary Board of Appeal
- *W* - Decision concerning PCT reserves

The last two digits give the year during which the appeal was lodged. Note that the letter "*L*" does not refer to a decision of a Board of Appeal but to a Legal Advice of the EPO ^[10], and that the letter "*V*" refers to decisions of Examination and Opposition Divisions. ^[11]

In addition to their alphanumeric reference, decisions are sometimes referred to and identified by their date. This enables to distinguish between decisions bearing the same alphanumeric reference but issued at a different date (e.g. *T 843/91* of March 17, 1993 ^[1] (<http://legal.european-patent-office.org/dg3/biblio/t910843ex1.htm>) and *T 843/91* of August 5, 1993 ^[2] (<http://legal.european-patent-office.org/dg3/biblio/t910843ex2.htm>), *T 59/87* of April 26, 1988 ^[3] (<http://legal.european-patent-office.org/dg3/biblio/t870059eu1.htm>) and *T 59/87* of August 14, 1990 ^[4] (<http://legal.european-patent-office.org/dg3/biblio/t870059ep2.htm>) or *T 261/88* of March 28, 1991 ^[5] (<http://legal.european-patent-office.org/dg3/biblio/t880261ep1.htm>) and *T 261/88* of February 16, 1993 ^[6] (<http://legal.european-patent-office.org/dg3/biblio/t880261eu2.htm>)). These cases are relatively rare however.

References

1. ^ Article 112(1) (<http://www.european-patent-office.org/legal/epc/e/ar112.html>) EPC
2. ^ Article 11(3) (<http://www.european-patent-office.org/legal/epc/e/ar11.html>) EPC
3. ^ Article 23(1) (<http://www.european-patent-office.org/legal/epc/e/ar23.html>) EPC
4. ^ *a b c d* EPO web site, Legislative Initiatives in European patent law, Organisational Autonomy of the EPO's Boards of Appeal (http://patlaw-reform.european-patent-office.org/boards_appeal/). Retrieved on August 30, 2006.

5. ^ Standing Advisory Committee Before the European Patent Office (SACEPO) *Organisational autonomy of the Boards of Appeal of the European Patent Office within the European Patent Organisation* (<http://www.ficpi.org/library/singaporeCET/CET-1404annex.pdf>) June 6, 2003 (pdf)
6. ^ T 740/98 (<http://legal.european-patent-office.org/dg3/pdf/t980740eu1.pdf>), Reasons 2.3
7. ^ Article 111(2)(first sentence) (<http://www.european-patent-office.org/legal/epc/e/ar111.html>) EPC
8. ^ Article 111(2)(second sentence) (<http://www.european-patent-office.org/legal/epc/e/ar111.html>) EPC
9. ^ Article 15(1) Rules of Procedure of the Boards of Appeal (http://www.european-patent-office.org/legal/anc_reg/en/ap_i_a23_4_2003_89.htm#OJ_2003_89)
10. ^ EPO web site, VI. Legal Advice from the EPO (http://www.european-patent-office.org/legal/anc_reg/en/ancreg_toc_vi.htm#ANCREG_TOC_VI). Retrieved on August 30, 2006.
11. ^ EPO web site, EPO boards of appeal decisions - help section. (<http://legal.european-patent-office.org/dg3/help/coverage.htm>) Retrieved on August 30, 2006.

See also

- List of decisions and opinions of the Enlarged Board of Appeal of the European Patent Office
- Board of Patent Appeals and Interferences (BPAI), US appeal court
- European Court of Justice, the appeal court of the European Union, but which is not involved in the appeal procedure before the EPO
- Peter Messerli, Vice-President of the European Patent Office, head of the DG 3 (Appeals)
- *Reformatio in peius*
- *Restitutio in integrum* in patent law

External links

- Search interface for the Decisions of the EPO Boards of Appeal (http://www.european-patent-office.org/dg3/search_dg3.htm)
- Case Law of the Boards of Appeal (http://www.european-patent-office.org/legal/case_law/e/index.htm)
- Administrative Council of the EPO (<http://ac.european-patent-office.org/index.en.php>)
- Rules of procedure of the Boards of appeal (http://www.european-patent-office.org/legal/anc_reg/en/ap_i_a23_4_2003_89.htm#OJ_2003_89) (RPBA) (consolidated version)
- Rules of procedure of the Enlarged Board of appeal (http://www.european-patent-office.org/legal/anc_reg/en/ap_i_a23_4_2003_58.htm#OJ_2003_58) (RPEBA) (consolidated version)

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VORWORT

Die vorliegende 12., durchgesehene Auflage der Textausgabe des Europäischen Patentübereinkommens enthält die Texte des Übereinkommens über die Erteilung europäischer Patente (Fassung vom 1. Januar 2006) und seiner Ausführungsordnung (**Fassung vom 1. Juli 2005**), des Zentralisierungsprotokolls vom 5. Oktober 1973, des Anerkennungsprotokolls vom 5. Oktober 1973, des Protokolls über Vorrechte und Immunitäten vom 5. Oktober 1973 und der Gebührenordnung (**Fassung vom 1. April 2006**). Von der Diplomatischen Konferenz 2000 (siehe ABl. EPA 2001, Sonderausgabe Nr. 4) wurden am 29.11.2000 zahlreiche Änderungen des EPÜ angenommen. Vorläufig anwendbar und damit unmittelbar wirksam sind die Änderungen der Artikel 16, 17, 18, 37, 38, 42 und 50 EPÜ, des Zentralisierungsprotokolls und das Personalstandsprotokoll. Diese neuen Vorschriften wurden zusätzlich zu den bestehenden Texten aufgenommen. Die Textausgabe enthält außerdem ein Verzeichnis der veröffentlichten Entscheidungen/Stellungnahmen der Großen Beschwerdekammer (Anhang I), eine Übersicht über die Rechtsauskünfte des EPA (Anhang II) und ein alphabetisches Sachregister.

In der 12. Auflage sind folgende Beschlüsse des Verwaltungsrats erstmals berücksichtigt: Beschluss vom 7. Juni 2002 zur Änderung der Vorschriften über die Errichtung eines Instituts der beim Europäischen Patentamt zugelassenen Vertreter (ABl. EPA 2002, 429); Beschluss vom 24. Oktober 2002 zur Änderung der Vorschriften über die europäische Eignungsprüfung für zugelassene Vertreter (ABl. EPA 2002, 565); Beschluss vom 12. Dezember 2002 zur Genehmigung von Änderungen der Verfahrensordnung der Großen Beschwerdekammer des Europäischen Patentamts (ABl. EPA 2003, 58); Beschluss vom 12. Dezember 2002 zur Genehmigung von Änderungen der Verfahrensordnung der Beschwerdekammern des Europäischen Patentamts (ABl. EPA 2003, 61); Beschluss vom 5. Juni 2003 zur Einsetzung eines Präsidiums des Verwaltungsrats (ABl. EPA 2003, 333); Beschluss vom 30. Oktober 2003 zur Änderung der Gebührenordnung - Artikel 2 Nummer 2 - (ABl. EPA 2003, 531 f.); Beschluss vom 30. Oktober 2003 betreffend die Einsetzung des Präsidiums des Verwaltungsrats (ABl. EPA 2003, 579); Beschluss vom 4. Dezember 2003 zur Änderung der Gebührenordnung - Artikel 2 Nummer 1 - (ABl. EPA 2004, 3 f.); Beschluss vom 17. Juni 2004 zur Änderung der Vorschriften über die Errichtung eines Instituts der beim Europäischen Patentamt zugelassenen Vertreter (ABl. EPA 2004, 361); Beschluss vom 29. Oktober 2004 zur Genehmigung einer Änderung der Verfahrensordnung der Beschwerdekammern des Europäischen Patentamts (ABl. EPA 2004, 541); Beschluss vom 9. Dezember 2004 zur Änderung der Ausführungsordnung - Regel 44a - und der Gebührenordnung - Artikel 2 Nummern 2 und 6, Artikel 10 - (ABl. EPA 2005, 5 ff.); Beschluss vom 9. Dezember 2004 zur Änderung der Ausführungsordnung - Regel 51 (4) - (ABl. EPA 2005, 8 f.); Beschluss vom 9. Dezember 2004 zur Änderung der

PREFACE

This 12th, revised edition of the European Patent Convention contains the texts of the Convention on the Grant of European Patents (version as of 1 January 2006) and its Implementing Regulations (**version as of 1 July 2005**), the Protocol on Centralisation of 5 October 1973, the Protocol on Recognition of 5 October 1973, the Protocol on Privileges and Immunities of 5 October 1973 and the Rules relating to Fees (**version as of 1 April 2006**). On 29.11.2000, the Diplomatic Conference 2000 (see OJ EPO 2001, Special edition No. 4) adopted numerous amendments to the EPC. The amendments to Articles 16, 17, 18, 37, 38, 42, and 50 EPC, to the Protocol on Centralisation and the Protocol on the Staff Complement are provisionally applicable, and thus already in effect. These new provisions have been inserted in addition to the existing texts. Moreover, the revised edition encompasses an index of published decisions/opinions of the Enlarged Board of Appeal (Annex I), Legal Advice from the EPO in brief (Annex II) and an alphabetical keyword index.

This 12th edition takes account for the first time of the following decisions of the Administrative Council: decision of 7 June 2002 amending the Regulation on the establishment of an Institute of professional representatives before the European Patent Office (OJ EPO 2002, 429); decision of 24 October 2002 amending the Regulation on the European qualifying examination for professional representatives (OJ EPO 2002, 565); decision of 12 December 2002 approving amendments to the Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office (OJ EPO 2003, 58); decision of 12 December 2002 approving amendments to the Rules of Procedure of the Boards of Appeal of the European Patent Office (OJ EPO 2003, 61); decision of 5 June 2003 setting up a Board of the Administrative Council (OJ EPO 2003, 333); decision of 30 October 2003 amending the Rules relating to Fees - Article 2 item 2 - (OJ EPO 2003, 531 f); decision of 30 October 2003 concerning the operation of the Board of the Administrative Council (OJ EPO 2003, 579); decision of 4 December 2003 amending the Rules relating to Fees - Article 2 item 1 - (OJ EPO 2004, 3 f); decision of 17 June 2004 amending the Regulation on the establishment of an institute of professional representatives before the European Patent Office (OJ EPO 2004, 361); decision of 29 October 2004 approving an amendment to the Rules of Procedure of the Boards of Appeal of the European Patent Office (OJ EPO 2004, 541); decision of 9 December 2004 amending the Implementing Regulations - Rule 44a - and the Rules relating to Fees - Article 2 items 2 and 6, Article 10 - (OJ EPO 2005, 5 ff); decision of 9 December 2004 amending the Implementing Regulations - Rule 51(4) - (OJ EPO 2005, 8 f); decision of 9 December 2004 amending the Rules relating to Fees - Article 2 items 12 and 13 - (OJ EPO 2005, 10); decision of 9 December 2004 amending the Implementing Regulations - Rules 54 and 108 - and the Rules relating to Fees - Article 2 item 3c - (OJ EPO 2005, 11 f); decision of 10 June 2005

INTRODUCTION

La douzième édition révisée de la Convention sur le brevet européen comprend les textes mis à jour de la Convention sur la délivrance de brevets européens (rédaction du 1^{er} janvier 2006) avec son règlement d'exécution (**rédaction du 1^{er} juillet 2005**), du protocole sur la centralisation du 5 octobre 1973, du protocole sur la reconnaissance du 5 octobre 1973, du protocole sur les privilèges et immunités du 5 octobre 1973 et du règlement relatif aux taxes (**rédaction du 1^{er} avril 2006**). Le 29.11.2000, la Conférence diplomatique 2000 (cf. JO OEB 2001, édition spéciale n°4) a adopté de nombreuses modifications à la CBE. Les articles 16, 17, 18, 37, 38, 42 et 50 CBE et le Protocole sur la centralisation tels qu'amendés et le Protocole sur les effectifs s'appliquent à titre provisoire et prennent donc immédiatement effet. Ces nouvelles dispositions ont été insérées en sus des textes existants. L'édition révisée contient en outre une liste des décisions/avis publiés de la Grande Chambre de recours (Annexe I), un tableau récapitulatif des renseignements juridiques communiqués par l'OEB (Annexe II) et un index alphabétique.

La douzième édition tient compte pour la première fois des décisions suivantes du Conseil d'administration : décision du 7 juin 2002 modifiant le Règlement relatif à la création d'un Institut des mandataires agréés près l'Office européen des brevets (JO OEB 2002, 429) ; décision du 24 octobre 2002 modifiant le règlement relatif à l'examen européen de qualification des mandataires agréés (JO OEB 2002, 565) ; décision du 12 décembre 2002 approuvant les modifications du règlement de procédure de la Grande Chambre de recours de l'Office européen des brevets (JO OEB 2003, 58) ; décision du 12 décembre 2002 approuvant les modifications du règlement de procédure des chambres de recours de l'Office européen des brevets (JO OEB 2003, 61) ; décision du 5 juin 2003 instituant un Bureau du Conseil d'administration (JO OEB 2003, 333) ; décision du 30 octobre 2003 modifiant le règlement relatif aux taxes - article 2, point 2 - (JO OEB 2003, 531 s.) ; décision du 30 octobre 2003 relative à la mise en œuvre du Bureau du Conseil d'administration (JO OEB 2003, 579) ; décision du 4 décembre 2003 modifiant le règlement relatif aux taxes - article 2, point 1 - (JO OEB 2004, 3 s.) ; décision du 17 juin 2004 modifiant le Règlement relatif à la création d'un Institut des mandataires agréés près l'Office européen des brevets (JO OEB 2004, 361) ; décision du 29 octobre 2004 approuvant une modification du règlement de procédure des chambres de recours de l'Office européen des brevets (JO OEB 2004, 541) ; décision du 9 décembre 2004 modifiant le règlement d'exécution - règle 44bis - et le règlement relatif aux taxes - article 2, points 2 et 6, article 10 - (JO OEB 2005, 5 s.) ; décision du 9 décembre 2004 modifiant le règlement d'exécution - règle 51(4) - (JO OEB 2005, 8 s.) ; décision du 9 décembre 2004 modifiant le règlement relatif aux taxes - article 2, points 12 et 13 - (JO OEB 2005, 10) ; décision du 9 décembre 2004 modifiant le règlement d'exécution - règles 54 et 108 - et le

Gebührenordnung - Artikel 2 Nummern 12 und 13 - (ABl. EPA 2005, 10); Beschluss vom 9. Dezember 2004 zur Änderung der Ausführungsordnung - Regeln 54 und 108 - und der Gebührenordnung - Artikel 2 Nummer 3c - (ABl. EPA 2005, 11 f.); Beschluss vom 10. Juni 2005 zur Herabsetzung der Gebühr für die ergänzende europäische Recherche (ABl. EPA 2005, 422); Beschluss vom 27. Oktober 2005 zur Änderung des EPÜ - Artikel 97 (4) und (5) - (ABl. EPA 2005, 545 f.); Beschlüsse vom 27. Oktober 2005 zur Herabsetzung der Gebühr für die ergänzende europäische Recherche (ABl. EPA 2005, 546, 548); Beschlüsse vom 15. Dezember 2005 zur Änderung der Gebührenordnung - Artikel 2 - und zur Herabsetzung der Gebühr für die ergänzende europäische Recherche (ABl. EPA 2006, 8 ff., 13 f.).

Die vom Verwaltungsrat der Europäischen Patentorganisation seit dem Inkrafttreten des Übereinkommens am 7. Oktober 1977 beschlossenen Änderungen des Übereinkommens, der Ausführungsordnung und der Gebührenordnung sind in Fußnoten zu den betroffenen Bestimmungen kenntlich gemacht. Sie weisen das Datum des entsprechenden Verwaltungsratsbeschlusses, den Zeitpunkt seines Inkrafttretens und die Fundstelle seiner Veröffentlichung im Amtsblatt des Europäischen Patentamts (ABl. EPA) aus.

Bei einigen wenigen Vorschriften, deren redaktionelle Fassung zu Zweifeln Anlass geben könnte, erschien es nützlich, durch Randvermerke darauf hinzuweisen.

Neben den Texten des Übereinkommens und der Ausführungsordnung erscheinen Verweisungen auf einschlägige Artikel und Regeln. In den einzelnen Vorschriften selbst bereits zitierte Artikel und Regeln werden jedoch nicht nochmals angeführt. Es wird ausdrücklich darauf hingewiesen, dass diese Verweisungen nicht Bestandteil der offiziellen Texte des Übereinkommens sind, sondern, ohne Anspruch auf Vollständigkeit zu erheben, die praktische Handhabung der Textausgabe erleichtern sollen.

Hierzu dienen auch die o.g. Anhänge I und II sowie das alphabetische Sachregister. Hinweise auf die Aktenzeichen der Entscheidungen/Stellungnahmen der Großen Beschwerdekammer und auf die Nummern der Rechtsauskünfte sind bei den betroffenen Artikeln und Regeln als Fußnoten abgedruckt.

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reducing the fee for the supplementary European search (OJ EPO 2005, 422); decision of 27 October 2005 amending the EPC - Article 97(4) and (5) - (OJ EPO 2005, 545 f); decisions of 27 October 2005 reducing the fee for the supplementary European search (OJ EPO 2005, 546, 548); decisions of 15 December 2005 amending the Rules relating to Fees - Article 2 - and reducing the fee for the supplementary European search (OJ EPO 2006, 8 ff, 13 f).

The amendments made to the Convention, the Implementing Regulations and the Rules relating to Fees by decisions of the Administrative Council of the European Patent Organisation since the Convention entered into force on 7 October 1977 are indicated in footnotes to the provisions in question. These footnotes give the date of the Administrative Council decision concerned, the date on which it entered into force and the reference to the Official Journal of the European Patent Office (OJ EPO) in which it was published.

It has been thought useful to indicate, by way of marginal notes, some provisions the drafting of which might give rise to misinterpretation.

References to pertinent Articles and Rules appear on the right-hand side of the text of the Convention and its Implementing Regulations. However, Articles and Rules already quoted in the provisions themselves are not again indicated. It is expressly pointed out that these references do not form part of the official text. They are simply intended to facilitate its use, and do not claim to be exhaustive.

Annexes I, II and the alphabetical keyword index as mentioned above are designed to serve the same purpose. The reference numbers of the decisions/opinions of the Enlarged Board of Appeal and the Legal Advice numbers are indicated in a footnote to the Articles and Rules in question.

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règlement relatif aux taxes - article 2, point 3c - (JO OEB 2005, 11 s.) ; décision du 10 juin 2005 réduisant la taxe due pour la recherche européenne complémentaire (JO OEB 2005, 422) ; décision du 27 octobre 2005 modifiant la CBE - article 97(4) et (5) - (JO OEB 2005, 545 s.) ; décisions du 27 octobre 2005 réduisant la taxe due pour la recherche européenne complémentaire (JO OEB 2005, 546, 548) ; décisions du 15 décembre 2005 modifiant le règlement relatif aux taxes - article 2 - et réduisant la taxe due pour la recherche européenne complémentaire (JO OEB 2006, 8 s., 13 s.).

Les modifications apportées à la Convention, au règlement d'exécution et au règlement relatif aux taxes par le Conseil d'administration de l'Organisation européenne des brevets depuis l'entrée en vigueur de la Convention le 7 octobre 1977 sont indiquées dans les notes en bas de page correspondant aux dispositions en cause. Ces notes indiquent la date à laquelle la décision du Conseil d'administration est intervenue, la date de l'entrée en vigueur et la référence de la publication de la décision au Journal officiel de l'Office européen des brevets (JO OEB).

Dans les quelques cas où la rédaction de certaines dispositions pourrait susciter des doutes, il nous a paru opportun de l'indiquer en marge.

La présente édition de la Convention sur le brevet européen et de son règlement d'exécution comporte en marge, à droite du texte des dispositions de la Convention et du règlement d'exécution, des renvois aux articles et aux règles pertinents. Toutefois, les articles et règles cités dans le texte de ces dispositions ne sont pas repris en marge. Il convient de souligner que ces renvois ne font pas partie intégrante des textes officiels de la Convention, mais que, sans toutefois prétendre à l'exhaustivité, ils sont destinés à en faciliter la consultation.

C'est aussi à cette fin qu'ont été joints les annexes I, II susmentionnées et l'index alphabétique. Les renvois aux numéros de référence des décisions/avis publiés de la Grande Chambre de recours et aux numéros des renseignements juridiques figurent sous forme de notes en bas de page sous les articles et règles concernés.

Décembre 2005 Office européen des brevets

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und der Beschlüsse des Verwaltungsrats der Europäischen Patentorganisation
vom 21. Dezember 1978, vom 13. Dezember 1994, vom 20. Oktober 1995,
vom 5. Dezember 1996, vom 10. Dezember 1998 und vom 27. Oktober 2005 sowie mit den vorläufig
anwendbaren Bestimmungen der Akte zur Revision des EPÜ vom 29. November 2000

CONVENTION
ON THE GRANT OF EUROPEAN PATENTS
(EUROPEAN PATENT CONVENTION)

of 5 October 1973

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CONVENTION
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du 5 octobre 1973

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PRÄAMBEL

Die Vertragsstaaten -

in dem Bestreben, die Zusammenarbeit zwischen den europäischen Staaten auf dem Gebiet des Schutzes der Erfindungen zu verstärken,

in dem Bestreben, einen solchen Schutz in diesen Staaten durch ein einheitliches Patenterteilungsverfahren und durch die Schaffung bestimmter einheitlicher Vorschriften für die nach diesem Verfahren erteilten Patente zu erreichen,

in dem Bestreben, zu diesen Zwecken ein Übereinkommen zu schließen, durch das eine Europäische Patentorganisation geschaffen wird und das ein Sonderabkommen im Sinn des Artikels 19 der am 20. März 1883 in Paris unterzeichneten und zuletzt am 14. Juli 1967 revidierten Verbandsübereinkunft zum Schutz des gewerblichen Eigentums und einen regionalen Patentvertrag im Sinn des Artikels 45 Absatz 1 des Vertrags über die internationale Zusammenarbeit auf dem Gebiet des Patentwesens vom 19. Juni 1970 darstellt -

sind wie folgt übereingekommen:

PREAMBLE

The Contracting States,

DESIRING to strengthen co-operation between the States of Europe in respect of the protection of inventions,

DESIRING that such protection may be obtained in those States by a single procedure for the grant of patents and by the establishment of certain standard rules governing patents so granted,

DESIRING, for this purpose, to conclude a Convention which establishes a European Patent Organisation and which constitutes a special agreement within the meaning of Article 19 of the Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883 and last revised on 14 July 1967, and a regional patent treaty within the meaning of Article 45, paragraph 1, of the Patent Cooperation Treaty of 19 June 1970,

HAVE AGREED on the following provisions:

PRÉAMBULE

Les Etats contractants,

Désireux de renforcer la coopération entre les Etats européens dans le domaine de la protection des inventions,

Désireux qu'une telle protection puisse être obtenue dans ces Etats par une procédure unique de délivrance de brevets et par l'établissement de certaines règles uniformes régissant les brevets ainsi délivrés,

Désireux, à ces fins, de conclure une convention qui institue une Organisation européenne des brevets et constitue un arrangement particulier au sens de l'article 19 de la Convention pour la protection de la propriété industrielle signée à Paris le 20 mars 1883 et révisée en dernier lieu le 14 juillet 1967 et un traité de brevet régional au sens de l'article 45, paragraphe 1, du Traité de Coopération en matière de brevets du 19 juin 1970,

sont convenus des dispositions suivantes :

ERSTER TEIL

ALLGEMEINE UND INSTITUTIONELLE VORSCHRIFTEN

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Allgemeine Vorschriften

Artikel 1

Europäisches Recht für die Erteilung von Patenten

Durch dieses Übereinkommen wird ein den Vertragsstaaten¹ gemeinsames Recht für die Erteilung von Erfindungspatenten geschaffen.

Artikel 2

Europäisches Patent

(1) Die nach diesem Übereinkommen erteilten Patente werden als europäische Patente bezeichnet.

(2) Das europäische Patent hat in jedem Vertragsstaat, für den es erteilt worden ist, dieselbe Wirkung und unterliegt denselben Vorschriften wie ein in diesem Staat erteiltes nationales Patent, soweit sich aus diesem Übereinkommen nichts anderes ergibt.

Artikel 3

Territoriale Wirkung

Die Erteilung des europäischen Patents kann für einen, mehrere oder alle Vertragsstaaten beantragt werden.

Artikel 4²

Europäische Patentorganisation

(1) Durch dieses Übereinkommen wird eine Europäische Patentorganisation gegründet, die nachstehend Organisation genannt wird. Sie ist mit verwaltungsmäßiger und finanzieller Selbständigkeit ausgestattet.

(2) Die Organe der Organisation sind:

- a) das Europäische Patentamt;
- b) der Verwaltungsrat.

(3) Die Organisation hat die Aufgabe, die europäischen Patente zu erteilen. Diese Aufgabe wird vom Europäischen Patentamt durchgeführt, dessen Tätigkeit vom Verwaltungsrat überwacht wird.

PART I

GENERAL AND INSTITUTIONAL PROVISIONS

Chapter I

General provisions

Article 1

European law for the grant of patents

A system of law, common to the Contracting States¹, for the grant of patents for invention is hereby established.

Article 2

European patent

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

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

Article 3

Territorial effect

The grant of a European patent may be requested for one or more of the Contracting States.

Article 4²

European Patent Organisation

(1) A European Patent Organisation, hereinafter referred to as the Organisation, is established by this Convention. It shall have administrative and financial autonomy.

(2) The organs of the Organisation shall be:

- (a) a European Patent Office;
- (b) an Administrative Council.

(3) The task of the Organisation shall be to grant European patents. This shall be carried out by the European Patent Office supervised by the Administrative Council.

¹ Die derzeit 31 Vertragsstaaten sind: AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HU, IE, IS, IT, LI, LT, LU, LV, MC, NL, PL, PT, RO, SE, SI, SK, TR.

² Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 5/88, G 7/88, G 8/88 (Anhang I).

¹ Currently the 31 Contracting States are: AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HU, IE, IS, IT, LI, LT, LU, LV, MC, NL, PL, PT, RO, SE, SI, SK, TR.

² See decisions of the Enlarged Board of Appeal G 5/88, G 7/88, G 8/88 (Annex I).

PREMIÈRE PARTIE

Verweisungen / References / Références

DISPOSITIONS GÉNÉRALES ET INSTITUTIONNELLES

Chapitre I

Dispositions générales

Article premier

Droit européen de délivrance de brevets

Il est institué par la présente convention un droit commun aux Etats contractants¹ en matière de délivrance de brevets d'invention.

Article 2

Brevet européen

*Art. 63-65, 68, 69, 70, 99-105, 142
R. 61*

(1) Les brevets délivrés en vertu de la présente convention sont dénommés brevets européens.

(2) Dans chacun des Etats contractants pour lesquels il est délivré, le brevet européen a les mêmes effets et est soumis au même régime qu'un brevet national délivré dans cet Etat, pour autant que la présente convention n'en dispose pas autrement.

Article 3

Portée territoriale

Art. 79, 149

La délivrance d'un brevet européen peut être demandée pour tous les Etats contractants, pour plusieurs ou pour l'un d'entre eux seulement.

*Article 4*²

Organisation européenne des brevets

Art. 10-36

(1) Il est institué par la présente convention une Organisation européenne des brevets, ci-après dénommée l'Organisation. Elle est dotée de l'autonomie administrative et financière.

(2) Les organes de l'Organisation sont :

- a) l'Office européen des brevets ;
- b) le Conseil d'administration.

(3) L'Organisation a pour tâche de délivrer les brevets européens. Cette tâche est exécutée par l'Office européen des brevets sous le contrôle du Conseil d'administration.

¹ Les Etats contractants, actuellement au nombre de 31, sont : AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HU, IE, IS, IT, LI, LT, LU, LV, MC, NL, PL, PT, RO, SE, SI, SK, TR.

² Cf. les décisions de la Grande Chambre de recours G 5/88, G 7/88, G 8/88 (Annexe I).

Die Europäische Patentorganisation*Artikel 5*³

Rechtsstellung

- (1) Die Organisation besitzt Rechtspersönlichkeit.
- (2) Die Organisation besitzt in jedem Vertragsstaat die weitestgehende Rechts- und Geschäftsfähigkeit, die juristischen Personen nach dessen Rechtsvorschriften zuerkannt ist; sie kann insbesondere bewegliches und unbewegliches Vermögen erwerben und veräußern sowie vor Gericht stehen.
- (3) Der Präsident des Europäischen Patentamts vertritt die Organisation.

*Artikel 6*⁴

Sitz

- (1) Die Organisation hat ihren Sitz in München.
- (2) Das Europäische Patentamt wird in München errichtet. Es hat eine Zweigstelle in Den Haag.

*Artikel 7*⁵

Dienststellen des Europäischen Patentamts

In den Vertragsstaaten und bei zwischenstaatlichen Organisationen auf dem Gebiet des gewerblichen Rechtsschutzes können, soweit erforderlich und vorbehaltlich der Zustimmung des betreffenden Vertragsstaats oder der betreffenden Organisation, durch Beschluss des Verwaltungsrats Dienststellen des Europäischen Patentamts zu Informations- oder Verbindungszwecken geschaffen werden.

Artikel 8

Vorrechte und Immunitäten

Die Organisation, die Mitglieder des Verwaltungsrats, die Bediensteten des Europäischen Patentamts und die sonstigen Personen, die in dem diesem Übereinkommen beigefügten Protokoll über Vorrechte und Immunitäten bezeichnet sind und an der Arbeit der Organisation teilnehmen, genießen in den Hoheitsgebieten der Vertragsstaaten die zur Durchführung ihrer Aufgaben erforderlichen Vorrechte und Immunitäten nach Maßgabe dieses Protokolls.

The European Patent Organisation*Article 5*³

Legal status

- (1) The Organisation shall have legal personality.
- (2) In each of the Contracting States, the Organisation shall enjoy the most extensive legal capacity accorded to legal persons under the national law of that State; it may in particular acquire or dispose of movable and immovable property and may be a party to legal proceedings.
- (3) The President of the European Patent Office shall represent the Organisation.

*Article 6*⁴

Seat

- (1) The Organisation shall have its seat at Munich.
- (2) The European Patent Office shall be set up at Munich. It shall have a branch at The Hague.

*Article 7*⁵

Sub-offices of the European Patent Office

By decision of the Administrative Council, sub-offices of the European Patent Office may be created if need be, for the purpose of information and liaison, in the Contracting States and with inter-governmental organisations in the field of industrial property, subject to the approval of the Contracting State or organisation concerned.

Article 8

Privileges and immunities

The Protocol on Privileges and Immunities annexed to this Convention shall define the conditions under which the Organisation, the members of the Administrative Council, the employees of the European Patent Office and such other persons specified in that Protocol as take part in the work of the Organisation, shall enjoy, in the territory of each Contracting State, the privileges and immunities necessary for the performance of their duties.

³ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 5/88, G 7/88, G 8/88 (Anhang I).

⁴ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 5/88, G 7/88, G 8/88 (Anhang I).

⁵ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 5/88, G 7/88, G 8/88 (Anhang I).

³ See decisions of the Enlarged Board of Appeal G 5/88, G 7/88, G 8/88 (Annex I).

⁴ See decisions of the Enlarged Board of Appeal G 5/88, G 7/88, G 8/88 (Annex I).

⁵ See decisions of the Enlarged Board of Appeal G 5/88, G 7/88, G 8/88 (Annex I).

L'Organisation européenne des brevets*Article 5*³

Statut juridique

- (1) L'Organisation a la personnalité juridique.
- (2) Dans chacun des Etats contractants, l'Organisation possède la capacité juridique la plus large reconnue aux personnes morales par la législation nationale ; elle peut notamment acquérir ou aliéner des biens immobiliers et mobiliers et ester en justice.
- (3) Le Président de l'Office européen des brevets représente l'Organisation.

*Article 6*⁴

Siège

- (1) L'Organisation a son siège à Munich.
- (2) L'Office européen des brevets est situé à Munich. Il a un département à La Haye.

*Article 7*⁵

Agences de l'Office européen des brevets

Art. 35

Par décision du Conseil d'administration, des agences de l'Office européen des brevets peuvent être créées, en tant que de besoin, dans un but d'information ou de liaison, dans les Etats contractants ou auprès d'organisations intergouvernementales compétentes en matière de propriété industrielle, sous réserve du consentement de l'Etat contractant ou de l'organisation intéressée.

Article 8

Privilèges et immunités

Le protocole sur les privilèges et immunités annexé à la présente convention définit les conditions dans lesquelles l'Organisation, les membres du Conseil d'administration, les agents de l'Office européen des brevets et toutes autres personnes mentionnées dans ce protocole qui participent aux activités de l'Organisation, jouissent, sur le territoire des Etats contractants, des privilèges et immunités nécessaires à l'accomplissement de leur mission.

³ Cf. les décisions de la Grande Chambre de recours G 5/88, G 7/88, G 8/88 (Annexe I).

⁴ Cf. les décisions de la Grande Chambre de recours G 5/88, G 7/88, G 8/88 (Annexe I).

⁵ Cf. les décisions de la Grande Chambre de recours G 5/88, G 7/88, G 8/88 (Annexe I).

Artikel 9

Haftung

(1) Die vertragliche Haftung der Organisation bestimmt sich nach dem Recht, das auf den betreffenden Vertrag anzuwenden ist.

(2) Die außervertragliche Haftung der Organisation für Schäden, die durch sie oder die Bediensteten des Europäischen Patentamts in Ausübung ihrer Amtstätigkeit verursacht worden sind, bestimmt sich nach dem in der Bundesrepublik Deutschland geltenden Recht. Ist der Schaden durch die Zweigstelle in Den Haag oder eine Dienststelle oder durch Bedienstete, die einer dieser Stellen angehören, verursacht worden, so ist das Recht des Vertragsstaats anzuwenden, in dem sich die betreffende Stelle befindet.

(3) Die persönliche Haftung der Bediensteten des Europäischen Patentamts gegenüber der Organisation bestimmt sich nach den Vorschriften ihres Statuts oder der für sie geltenden Beschäftigungsbedingungen.

(4) Für die Regelung der Streitigkeiten nach den Absätzen 1 und 2 sind folgende Gerichte zuständig:

a) bei einer Streitigkeit nach Absatz 1 das zuständige Gericht der Bundesrepublik Deutschland, sofern in dem von den Parteien geschlossenen Vertrag nicht ein Gericht eines anderen Staats bestimmt worden ist;

b) bei einer Streitigkeit nach Absatz 2, je nach Lage des Falls, entweder das in der Bundesrepublik Deutschland zuständige Gericht oder das zuständige Gericht des Staats, in dem sich die Zweigstelle oder die Dienststelle befindet.

Kapitel III

Das Europäische Patentamt

Artikel 10⁶

Leitung

(1) Die Leitung des Europäischen Patentamts obliegt dem Präsidenten, der dem Verwaltungsrat gegenüber für die Tätigkeit des Amts verantwortlich ist.

(2) Zu diesem Zweck hat der Präsident insbesondere folgende Aufgaben und Befugnisse:

a) er trifft alle für die Tätigkeit des Europäischen Patentamts zweckmäßigen Maßnahmen, einschließlich des Erlasses interner Verwaltungsvorschriften und der Veröffentlichung von Mitteilungen an die Öffentlichkeit;

Article 9

Liability

(1) The contractual liability of the Organisation shall be governed by the law applicable to the relevant contract.

(2) The non-contractual liability of the Organisation in respect of any damage caused by it or by the employees of the European Patent Office in the performance of their duties shall be governed by the provisions of the law of the Federal Republic of Germany. Where the damage is caused by the branch at The Hague or a sub-office or employees attached thereto, the provisions of the law of the Contracting State in which such branch or sub-office is located shall apply.

(3) The personal liability of the employees of the European Patent Office towards the Organisation shall be laid down in their Service Regulations or conditions of employment.

(4) The courts with jurisdiction to settle disputes under paragraphs 1 and 2 shall be:

(a) for disputes under paragraph 1, the courts of competent jurisdiction in the Federal Republic of Germany, unless the contract concluded between the parties designates the courts of another State;

(b) for disputes under paragraph 2, either the courts of competent jurisdiction in the Federal Republic of Germany, or the courts of competent jurisdiction in the State in which the branch or sub-office is located.

Chapter III

The European Patent Office

Article 10⁶

Direction

(1) The European Patent Office shall be directed by the President who shall be responsible for its activities to the Administrative Council.

(2) To this end, the President shall have in particular the following functions and powers:

(a) he shall take all necessary steps, including the adoption of internal administrative instructions and the publication of guidance for the public, to ensure the functioning of the European Patent Office;

⁶ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 5/88, G 7/88, G 8/88, G 1/02 (Anhang I).

⁶ See decisions/opinions of the Enlarged Board of Appeal G 5/88, G 7/88, G 8/88, G 1/02 (Annex I).

Responsabilité

(1) La responsabilité contractuelle de l'Organisation est régie par la loi applicable au contrat en cause.

(2) La responsabilité non contractuelle de l'Organisation en ce qui concerne les dommages causés par elle et par les agents de l'Office européen des brevets dans l'exercice de leurs fonctions est réglementée conformément aux dispositions de la loi en vigueur en République fédérale d'Allemagne. Si les dommages ont été causés par le département de La Haye ou par une agence, ou par des agents relevant du département ou de cette agence, la loi applicable est celle de l'Etat contractant dans lequel le département ou l'agence est situé.

(3) La responsabilité personnelle des agents de l'Office européen des brevets envers l'Organisation est réglée dans les dispositions fixant leur statut ou le régime qui leur est applicable.

(4) Les juridictions compétentes pour régler les litiges visés aux paragraphes 1 et 2 sont :

a) en ce qui concerne les litiges visés au paragraphe 1, les juridictions compétentes de la République fédérale d'Allemagne, à défaut de la désignation de la juridiction d'un autre Etat dans le contrat conclu entre les parties ;

b) en ce qui concerne les litiges visés au paragraphe 2, selon le cas, soit les juridictions compétentes de la République fédérale d'Allemagne, soit les juridictions compétentes de l'Etat dans lequel le département ou l'agence est situé.

Chapitre III

L'Office européen des brevets

Article 10⁶

Direction

R. 9, 12

(1) La direction de l'Office européen des brevets est assurée par le Président, qui est responsable de l'activité de l'Office devant le Conseil d'administration.

(2) A cet effet, le Président a notamment les compétences ci-après :

a) il prend toutes mesures utiles, notamment l'adoption d'instructions administratives internes et la publication d'indications pour le public, en vue d'assurer le fonctionnement de l'Office européen des brevets ;

⁶ Cf. les décisions/avis de la Grande Chambre de recours G 5/88, G 7/88, G 8/88, G 1/02 (Annexe I).

b) er bestimmt, soweit in diesem Übereinkommen hierüber nichts vorgesehen ist, welche Handlungen beim Europäischen Patentamt in München und welche Handlungen bei seiner Zweigstelle in Den Haag vorzunehmen sind;

c) er kann dem Verwaltungsrat Vorschläge für eine Änderung dieses Übereinkommens sowie Entwürfe für allgemeine Durchführungsbestimmungen und Beschlüsse vorlegen, die zur Zuständigkeit des Verwaltungsrats gehören;

d) er bereitet den Haushaltsplan und etwaige Berichtigungs- und Nachtragshaushaltspläne vor und führt sie aus;

e) er legt dem Verwaltungsrat jedes Jahr einen Tätigkeitsbericht vor;

f) er übt das Weisungsrecht und die Aufsicht über das Personal aus;

g) vorbehaltlich Artikel 11 ernennt er die Bediensteten und entscheidet über ihre Beförderung;

h) er übt die Disziplinargewalt über die nicht in Artikel 11 genannten Bediensteten aus und kann dem Verwaltungsrat Disziplinarmaßnahmen gegenüber den in Artikel 11 Absätze 2 und 3 genannten Bediensteten vorschlagen;

i) er kann seine Aufgaben und Befugnisse übertragen.

(3)⁷ Der Präsident wird von mehreren Vizepräsidenten unterstützt. Ist der Präsident abwesend oder verhindert, so wird er nach dem vom Verwaltungsrat festgelegten Verfahren von einem der Vizepräsidenten vertreten.

Artikel 11

Ernennung hoher Beamter

(1) Der Präsident des Europäischen Patentamts wird vom Verwaltungsrat ernannt.

(2) Die Vizepräsidenten werden nach Anhörung des Präsidenten vom Verwaltungsrat ernannt.

(3) Die Mitglieder der Beschwerdekammern und der Großen Beschwerdekammer einschließlich der Vorsitzenden werden auf Vorschlag des Präsidenten des Europäischen Patentamts vom Verwaltungsrat ernannt. Sie können vom Verwaltungsrat nach Anhörung des Präsidenten des Europäischen Patentamts wieder ernannt werden.

(4) Der Verwaltungsrat übt die Disziplinargewalt über die in den Absätzen 1 bis 3 genannten Bediensteten aus.

(b) in so far as this Convention contains no provisions in this respect, he shall prescribe which transactions are to be carried out at the European Patent Office at Munich and its branch at The Hague respectively;

(c) he may place before the Administrative Council any proposal for amending this Convention and any proposal for general regulations or decisions which come within the competence of the Administrative Council;

(d) he shall prepare and implement the budget and any amending or supplementary budget;

(e) he shall submit a management report to the Administrative Council each year;

(f) he shall exercise supervisory authority over the personnel;

(g) subject to the provisions of Article 11, he shall appoint and promote the employees;

(h) he shall exercise disciplinary authority over the employees other than those referred to in Article 11, and may propose disciplinary action to the Administrative Council with regard to employees referred to in Article 11, paragraphs 2 and 3;

(i) he may delegate his functions and powers.

(3)⁷ The President shall be assisted by a number of Vice-Presidents. If the President is absent or indisposed, one of the Vice-Presidents shall take his place in accordance with the procedure laid down by the Administrative Council.

Article 11

Appointment of senior employees

(1) The President of the European Patent Office shall be appointed by decision of the Administrative Council.

(2) The Vice-Presidents shall be appointed by decision of the Administrative Council after the President has been consulted.

(3) The members, including the Chairmen, of the Boards of Appeal and of the Enlarged Board of Appeal shall be appointed by decision of the Administrative Council, taken on a proposal from the President of the European Patent Office. They may be re-appointed by decision of the Administrative Council after the President of the European Patent Office has been consulted.

(4) The Administrative Council shall exercise disciplinary authority over the employees referred to in paragraphs 1 to 3.

⁷ Siehe hierzu den Beschluss des Verwaltungsrats vom 06.07.1978 betreffend die Vertretung des Präsidenten des EPA (ABl. EPA 1978, 326).

⁷ See the decision of the Administrative Council of 06.07.1978 on substitution for the President of the EPO (OJ EPO 1978, 326).

- b) il détermine, dans la mesure où la présente convention ne comporte aucune disposition à cet égard, les formalités qui doivent être accomplies respectivement auprès de l'Office européen des brevets à Munich ou de son département à la Haye ;
 - c) il peut soumettre au Conseil d'administration tout projet de modification de la présente convention, ainsi que tout projet de réglementation générale ou de décision qui relève de la compétence du Conseil d'administration ;
 - d) il prépare et exécute le budget ainsi que tout budget modificatif ou additionnel ;
 - e) il soumet annuellement au Conseil d'administration un rapport d'activité ;
 - f) il exerce l'autorité hiérarchique sur le personnel ;
 - g) sous réserve des dispositions de l'article 11, il nomme les agents et statue sur leur avancement ;
 - h) il exerce le pouvoir disciplinaire sur les agents autres que ceux visés à l'article 11 et peut proposer au Conseil d'administration des sanctions disciplinaires à l'encontre des agents visés à l'article 11, paragraphes 2 et 3 ;
 - i) il peut déléguer ses pouvoirs.
- (3)⁷ Le Président est assisté de plusieurs Vice-Présidents. En cas d'absence ou d'empêchement du Président, un des Vice-Présidents assume ses fonctions suivant la procédure fixée par le Conseil d'administration.

Article 11

Nomination du personnel supérieur

Art. 21, 22, 35

- (1) Le Président de l'Office européen des brevets est nommé par décision du Conseil d'administration.
- (2) Les Vice-Présidents sont nommés par décision du Conseil d'administration, le Président entendu.
- (3) Les membres des chambres de recours et de la Grande Chambre de recours, y compris leurs présidents, sont nommés par décision du Conseil d'administration, prise sur proposition du Président de l'Office européen des brevets. Ils peuvent être reconduits dans leurs fonctions par le Conseil d'administration, le Président de l'Office européen des brevets entendu.
- (4) Le Conseil d'administration exerce le pouvoir disciplinaire sur les agents visés aux paragraphes 1 à 3 du présent article.

⁷ Cf. la décision du Conseil d'administration du 06.07.1978 concernant la suppléance du Président de l'OEB (JO OEB 1978, 326).

Artikel 12

Amtspflichten

Die Bediensteten des Europäischen Patentamts sind verpflichtet, auch nach Beendigung ihrer Amtstätigkeit Kenntnisse, die ihrem Wesen nach unter das Berufsgeheimnis fallen, weder preiszugeben noch zu verwenden.

Artikel 13

Streitsachen zwischen der Organisation und den Bediensteten des Europäischen Patentamts

(1) Die Bediensteten oder ehemaligen Bediensteten des Europäischen Patentamts oder ihre Rechtsnachfolger haben das Recht, in Streitsachen zwischen ihnen und der Europäischen Patentorganisation das Verwaltungsgericht der Internationalen Arbeitsorganisation nach der Satzung dieses Gerichts und innerhalb der Grenzen und nach Maßgabe der Bedingungen anzurufen, die im Statut der Beamten oder in der Versorgungsordnung festgelegt sind oder sich aus den Beschäftigungsbedingungen für die sonstigen Bediensteten ergeben.

(2) Eine Beschwerde ist nur zulässig, wenn der Betreffende alle Beschwerdemöglichkeiten ausgeschöpft hat, die ihm das Statut der Beamten, die Versorgungsordnung oder die Beschäftigungsbedingungen für die sonstigen Bediensteten eröffnen.

Artikel 14⁸

Sprachen des Europäischen Patentamts

(1) Die Amtssprachen des Europäischen Patentamts sind Deutsch, Englisch und Französisch. Europäische Patentanmeldungen sind in einer dieser Sprachen einzureichen.

(2) Natürliche oder juristische Personen mit Wohnsitz oder Sitz im Hoheitsgebiet eines Vertragsstaats, in dem eine andere Sprache als Deutsch, Englisch oder Französisch Amtssprache ist, und die Angehörigen dieses Staats mit Wohnsitz im Ausland können europäische Patentanmeldungen in einer Amtssprache dieses Staats einreichen. Sie müssen jedoch eine Übersetzung in einer der Amtssprachen des Europäischen Patentamts innerhalb einer in der Ausführungsordnung vorgeschriebenen Frist einreichen; diese Übersetzung kann während des gesamten Verfahrens vor dem Europäischen Patentamt mit der Anmeldung in der ursprünglich eingereichten Fassung in Übereinstimmung gebracht werden.

(3) Die Amtssprache des Europäischen Patentamts, in der die europäische Patentanmeldung eingereicht oder in die sie im Fall des Absatzes 2 übersetzt worden ist, ist in allen Verfahren vor dem Europäischen Patentamt, die diese Anmeldung oder das darauf erteilte Patent betreffen, als Verfahrenssprache zu verwenden, soweit in der Ausführungsordnung nichts anderes bestimmt ist.

Article 12

Duties of office

The employees of the European Patent Office shall be bound, even after the termination of their employment, neither to disclose nor to make use of information which by its nature is a professional secret.

Article 13

Disputes between the Organisation and the employees of the European Patent Office

(1) Employees and former employees of the European Patent Office or their successors in title may apply to the Administrative Tribunal of the International Labour Organisation in the case of disputes with the European Patent Organisation in accordance with the Statute of the Tribunal and within the limits and subject to the conditions laid down in the Service Regulations for permanent employees or the Pension Scheme Regulations or arising from the conditions of employment of other employees.

(2) An appeal shall only be admissible if the person concerned has exhausted such other means of appeal as are available to him under the Service Regulations, the Pension Scheme Regulations or the conditions of employment, as the case may be.

Article 14⁸

Languages of the European Patent Office

(1) The official languages of the European Patent Office shall be English, French and German. European patent applications must be filed in one of these languages.

(2) However, natural or legal persons having their residence or principal place of business within the territory of a Contracting State having a language other than English, French or German as an official language, and nationals of that State who are resident abroad, may file European patent applications in an official language of that State. Nevertheless, a translation in one of the official languages of the European Patent Office must be filed within the time limit prescribed in the Implementing Regulations; throughout the proceedings before the European Patent Office, such translation may be brought into conformity with the original text of the application.

(3) The official language of the European Patent Office in which the European patent application is filed or, in the case referred to in paragraph 2, that of the translation, shall be used as the language of the proceedings in all proceedings before the European Patent Office concerning the application or the resulting patent, unless otherwise provided in the Implementing Regulations.

⁸ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 6/91, G 2/95 (Anhang I).

⁸ See decisions of the Enlarged Board of Appeal G 6/91, G 2/95 (Annex I).

Devoirs de la fonction

Les agents de l'Office européen des brevets sont tenus, même après la cessation de leurs fonctions, de ne pas divulguer ni utiliser les informations qui, par leur nature, sont couvertes par le secret professionnel.

Article 13

Litiges entre l'Organisation et les agents de l'Office européen des brevets

(1) Un agent ou un ancien agent de l'Office européen des brevets, ou leurs ayants droit, peuvent recourir au Tribunal administratif de l'Organisation internationale du travail pour les litiges qui les opposent à l'Organisation européenne des brevets, conformément au statut dudit Tribunal et dans les limites et conditions déterminées par le statut des fonctionnaires, par le règlement de pensions ou résultant du régime applicable aux autres agents.

(2) Un recours n'est recevable que si l'intéressé a épuisé tous les moyens de recours qui lui sont ouverts par le statut des fonctionnaires, par le règlement de pensions ou par le régime applicable aux autres agents, selon le cas.

Article 14⁸

Langues de l'Office européen des brevets

(1) Les langues officielles de l'Office européen des brevets sont l'allemand, l'anglais et le français. Les demandes de brevet européen sont déposées dans une de ces langues.

(2) Néanmoins, les personnes physiques et morales ayant leur domicile ou leur siège sur le territoire d'un Etat contractant ayant une langue autre que l'allemand, l'anglais ou le français comme langue officielle, et les nationaux de cet Etat ayant leur domicile à l'étranger peuvent déposer des demandes de brevet européen dans une langue officielle de cet Etat. Toutefois, une traduction dans une des langues officielles de l'Office européen des brevets doit être produite dans le délai prévu par le règlement d'exécution ; pendant toute la durée de la procédure devant l'Office européen des brevets, cette traduction peut être rendue conforme au texte original de la demande.

(3) La langue officielle de l'Office européen des brevets dans laquelle la demande de brevet européen a été déposée ou celle dans laquelle cette demande a été traduite, dans le cas visé au paragraphe 2, doit être utilisée, sauf s'il en est disposé autrement par le règlement d'exécution, dans toutes les procédures devant l'Office européen des brevets relatives à cette demande ou au brevet délivré à la suite de cette demande.

Art. 70, 80, 90, 93, 97, 98, 103, 127, 129
R. 1, 2, 4-7, 35, 44, 69

Remarque : le texte français de l'article 14, paragraphe 4, seconde phrase, seconde partie comporte une erreur évidente qui consiste en l'absence des mots «dans les cas prévus au règlement d'exécution», qui figurent dans les textes allemand et anglais. Par conséquent, le texte français doit se lire comme comprenant également ces mots.

⁸ Cf. les décisions de la Grande Chambre de recours G 6/91, G 2/95 (Annexe I).

(4) Die in Absatz 2 genannten Personen können auch fristgebundene Schriftstücke in einer Amtssprache des betreffenden Vertragsstaats einreichen. Sie müssen jedoch innerhalb einer in der Ausführungsordnung vorgeschriebenen Frist eine Übersetzung in der Verfahrenssprache einreichen; in den in der Ausführungsordnung vorgesehenen Fällen können sie auch eine Übersetzung in einer anderen Amtssprache des Europäischen Patentamts einreichen.

(5) Wird ein Schriftstück, das nicht zu den Unterlagen der europäischen Patentanmeldung gehört, nicht in der in diesem Übereinkommen vorgeschriebenen Sprache eingereicht oder wird eine Übersetzung, die in diesem Übereinkommen vorgeschrieben ist, nicht rechtzeitig eingereicht, so gilt das Schriftstück als nicht eingegangen.

(6) Die europäischen Patentanmeldungen werden in der Verfahrenssprache veröffentlicht.

(7) Die europäischen Patentschriften werden in der Verfahrenssprache veröffentlicht; sie enthalten eine Übersetzung der Patentansprüche in den beiden anderen Amtssprachen des Europäischen Patentamts.

(8) In den drei Amtssprachen des Europäischen Patentamts werden veröffentlicht:

- a) das Europäische Patentblatt;
- b) das Amtsblatt des Europäischen Patentamts.

(9) Die Eintragungen in das europäische Patentregister werden in den drei Amtssprachen des Europäischen Patentamts vorgenommen. In Zweifelsfällen ist die Eintragung in der Verfahrenssprache maßgebend.

(4) The persons referred to in paragraph 2 may also file documents which have to be filed within a time limit in an official language of the Contracting State concerned. They must however file a translation in the language of the proceedings within the time limit prescribed in the Implementing Regulations; in the cases provided for in the Implementing Regulations, they may file a translation in a different official language of the European Patent Office.

(5) If any document, other than those making up the European patent application, is not filed in the language prescribed by this Convention, or if any translation required by virtue of this Convention is not filed in due time, the document shall be deemed not to have been received.

(6) European patent applications shall be published in the language of the proceedings.

(7) The specifications of European patents shall be published in the language of the proceedings; they shall include a translation of the claims in the two other official languages of the European Patent Office.

(8) There shall be published in the three official languages of the European Patent Office:

- (a) the European Patent Bulletin;
- (b) the Official Journal of the European Patent Office.

(9) Entries in the Register of European Patents shall be made in the three official languages of the European Patent Office. In cases of doubt, the entry in the language of the proceedings shall be authentic.

Artikel 15⁹

Organe im Verfahren

Im Europäischen Patentamt werden für die Durchführung der in diesem Übereinkommen vorgeschriebenen Verfahren gebildet:

- a) eine Eingangsstelle;
- b) Recherchenabteilungen;
- c) Prüfungsabteilungen;
- d) Einspruchsabteilungen;
- e) eine Rechtsabteilung;
- f) Beschwerdekammern;
- g) eine Große Beschwerdekammer.

⁹ Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 1/02 (Anhang I).

Article 15⁹

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.

⁹ See opinion of the Enlarged Board of Appeal G 1/02 (Annex I).

(4) Les personnes visées au paragraphe 2 peuvent également déposer, dans une langue officielle de l'Etat contractant en question, des pièces devant être produites dans un délai déterminé. Toutefois, elles sont tenues de produire une traduction dans la langue de la procédure dans le délai prescrit par le règlement d'exécution ; elles peuvent également déposer une traduction dans une autre langue officielle de l'Office européen des brevets.

(5) Si une pièce qui n'est pas comprise dans les pièces de la demande de brevet européen n'est pas produite dans la langue prescrite par la présente convention ou si une traduction requise en application de la présente convention n'est pas produite dans les délais, la pièce est réputée n'avoir pas été reçue.

(6) Les demandes de brevet européen sont publiées dans la langue de la procédure.

(7) Les fascicules de brevet européen sont publiés dans la langue de la procédure ; ils comportent une traduction des revendications dans les deux autres langues officielles de l'Office européen des brevets.

(8) Sont publiés dans les trois langues officielles de l'Office européen des brevets :

- a) le Bulletin européen des brevets ;
- b) le Journal officiel de l'Office européen des brevets.

(9) Les inscriptions au Registre européen des brevets sont effectuées dans les trois langues officielles de l'Office européen des brevets. En cas de doute, l'inscription dans la langue de la procédure fait foi.

Article 15⁹

Instances chargées des procédures

*Art. 16-22, 143
R. 8, 9, 10, 12*

Pour l'application des procédures prescrites par la présente convention, il est institué à l'Office européen des brevets :

- a) une section de dépôt ;
- b) des divisions de la recherche ;
- c) des divisions d'examen ;
- d) des divisions d'opposition ;
- e) une division juridique ;
- f) des chambres de recours ;
- g) une Grande Chambre de recours.

⁹ Cf. l'avis de la Grande Chambre de recours G 1/02 (Annexe I).

[Artikel 16

Eingangsstelle

Die Eingangsstelle gehört zur Zweigstelle in Den Haag. Sie ist für die Eingangs- und Formalprüfung europäischer Patentanmeldungen bis zu dem Zeitpunkt zuständig, zu dem ein Prüfungsantrag gestellt worden ist oder der Anmelder nach Artikel 96 Absatz 1 erklärt hat, dass er die Anmeldung aufrechterhält. Außerdem obliegt ihr die Veröffentlichung der europäischen Patentanmeldungen und europäischen Recherchenberichte.]

Artikel 16¹⁰

Eingangsstelle

Die Eingangsstelle ist für die Eingangs- und Formalprüfung europäischer Patentanmeldungen zuständig.

[Artikel 17

Recherchenabteilungen

Die Recherchenabteilungen gehören zur Zweigstelle in Den Haag. Sie sind für die Erstellung europäischer Recherchenberichte zuständig.]

Artikel 17¹¹

Recherchenabteilungen

Die Recherchenabteilungen sind für die Erstellung europäischer Recherchenberichte zuständig.

[Artikel 18

Prüfungsabteilungen

(1) Die Prüfungsabteilungen sind für die Prüfung europäischer Patentanmeldungen von dem Zeitpunkt an zuständig, von dem an die Eingangsstelle nicht mehr zuständig ist.

(2) Eine Prüfungsabteilung setzt sich aus drei technisch vorgebildeten Prüfern zusammen. Bis zum Erlass der Entscheidung über die europäische Patentanmeldung wird jedoch in der Regel ein Prüfer der Prüfungsabteilung mit der Bearbeitung der Anmeldung beauftragt. Die mündliche Verhandlung findet vor der Prüfungsabteilung selbst statt. Hält es die Prüfungsabteilung nach Art der Entscheidung für erforderlich, so wird sie durch einen rechtskundigen Prüfer ergänzt. Im Fall der Stimmengleichheit gibt die Stimme des Vorsitzenden der Prüfungsabteilung den Ausschlag.]

[Article 16

Receiving Section

The Receiving Section shall be in the branch at The Hague. It shall be responsible for the examination on filing and the examination as to formal requirements of each European patent application up to the time when a request for examination has been made or the applicant has indicated under Article 96, paragraph 1, that he desires to proceed further with his application. It shall also be responsible for the publication of the European patent application and of the European search report.]

Article 16¹⁰

Receiving Section

The Receiving Section shall be responsible for the examination on filing and the examination as to formal requirements of European patent applications.

[Article 17

Search Divisions

The Search Divisions shall be in the branch at The Hague. They shall be responsible for drawing up European search reports.]

Article 17¹¹

Search Divisions

The Search Divisions shall be responsible for drawing up European search reports.

[Article 18

Examining Divisions

(1) An Examining Division shall be responsible for the examination of each European patent application from the time when the Receiving Section ceases to be responsible.

(2) An Examining Division shall consist of three technical examiners. Nevertheless, the examination prior to a final decision shall, as a general rule, be entrusted to one member of the Division. Oral proceedings shall be before the Examining Division itself. If the Examining Division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner. In the event of parity of votes, the vote of the Chairman of the Division shall be decisive.]

¹⁰ Geändert durch die Akte zur Revision des Europäischen Patentübereinkommens vom 29.11.2000, vorläufig anwendbar ab 29.11.2000 (ABI. EPA 2001, Sonderausgabe Nr. 4).

¹¹ Geändert durch die Akte zur Revision des Europäischen Patentübereinkommens vom 29.11.2000, vorläufig anwendbar ab 29.11.2000 (ABI. EPA 2001, Sonderausgabe Nr. 4).

¹⁰ Amended by the Act revising the European Patent Convention of 29.11.2000, provisionally applicable as of 29.11.2000 (OJ EPO 2001, Special edition No. 4).

¹¹ Amended by the Act revising the European Patent Convention of 29.11.2000, provisionally applicable as of 29.11.2000 (OJ EPO 2001, Special edition No. 4).

[Article 16

Section de dépôt

La section de dépôt fait partie du département de La Haye. Elle est compétente pour examiner la demande de brevet européen lors du dépôt et quant à certaines irrégularités jusqu'à la présentation de la requête en examen ou jusqu'à ce que le demandeur ait déclaré, conformément à l'article 96, paragraphe 1, qu'il maintient sa demande. Elle est en outre chargée de publier la demande de brevet européen et le rapport de recherche européenne.]

Article 16¹⁰

Section de dépôt

La section de dépôt est compétente pour examiner les demandes de brevet européen lors du dépôt et quant aux exigences de forme.

[Article 17

Divisions de la recherche

Les divisions de la recherche font partie du département de La Haye. Elles sont compétentes pour établir les rapports de recherche européenne.]

Article 17¹¹

Divisions de la recherche

Les divisions de la recherche sont compétentes pour établir les rapports de recherche européenne.

[Article 18

Divisions d'examen

(1) Les divisions d'examen sont compétentes pour examiner les demandes de brevet européen à compter du moment où cesse la compétence de la section de dépôt.

(2) Une division d'examen se compose de trois examinateurs techniciens. Toutefois, l'instruction de la demande est, en règle générale, confiée à l'un des examinateurs de la division. La procédure orale est de la compétence de la division d'examen elle-même. Si elle estime que la nature de la décision l'exige, la division d'examen est complétée par un examinateur juriste. En cas de partage des voix, la voix du président de la division d'examen est prépondérante.]

Verweisungen / References / Références

Art. 6, 15, 18, 90, 91, 93, 94, 95
R. 9

Art. 6, 15, 92
R. 9

Art. 15, 16, 33, 94, 153
R. 9

¹⁰ Modifié par l'acte portant révision de la Convention sur le brevet européen en date du 29.11.2000, applicable à titre provisoire à partir du 29.11.2000 (JO OEB 2001, édition spéciale n° 4).

¹¹ Modifié par l'acte portant révision de la Convention sur le brevet européen en date du 29.11.2000, applicable à titre provisoire à partir du 29.11.2000 (JO OEB 2001, édition spéciale n° 4).

Artikel 18¹²

Prüfungsabteilungen

(1) Die Prüfungsabteilungen sind für die Prüfung europäischer Patentanmeldungen zuständig.

(2)¹³ Eine Prüfungsabteilung setzt sich aus drei technisch vorgebildeten Prüfern zusammen. Bis zum Erlass der Entscheidung über die europäische Patentanmeldung wird jedoch in der Regel ein Mitglied der Prüfungsabteilung mit der Bearbeitung der Anmeldung beauftragt. Die mündliche Verhandlung findet vor der Prüfungsabteilung selbst statt. Hält es die Prüfungsabteilung nach Art der Entscheidung für erforderlich, so wird sie durch einen rechtskundigen Prüfer ergänzt. Bei Stimmgleichheit gibt die Stimme des Vorsitzenden der Prüfungsabteilung den Ausschlag.

Artikel 19¹⁴

Einspruchsabteilungen

(1) Die Einspruchsabteilungen sind für die Prüfung von Einsprüchen gegen europäische Patente zuständig.

(2) Eine Einspruchsabteilung setzt sich aus drei technisch vorgebildeten Prüfern zusammen, von denen mindestens zwei in dem Verfahren zur Erteilung des europäischen Patents, gegen das sich der Einspruch richtet, nicht mitgewirkt haben dürfen. Ein Prüfer, der in dem Verfahren zur Erteilung des europäischen Patents mitgewirkt hat, kann nicht den Vorsitz führen. Bis zum Erlass der Entscheidung über den Einspruch kann die Einspruchsabteilung eines ihrer Mitglieder mit der Bearbeitung des Einspruchs beauftragen. Die mündliche Verhandlung findet vor der Einspruchsabteilung selbst statt. Hält es die Einspruchsabteilung nach Art der Entscheidung für erforderlich, so wird sie durch einen rechtskundigen Prüfer ergänzt, der in dem Verfahren zur Erteilung des Patents nicht mitgewirkt haben darf. Im Fall der Stimmgleichheit gibt die Stimme des Vorsitzenden der Einspruchsabteilung den Ausschlag.

Artikel 20¹⁵

Rechtsabteilung

(1) Die Rechtsabteilung ist zuständig für Entscheidungen über Eintragungen und Löschungen von Angaben im europäischen Patentregister sowie für Entscheidungen über Eintragungen und Löschungen in der Liste der zugelassenen Vertreter.

Article 18¹²

Examining Divisions

(1) The Examining Divisions shall be responsible for the examination of European patent applications.

(2)¹³ An Examining Division shall consist of three technically qualified examiners. However, before a decision is taken on a European patent application, its examination shall, as a general rule, be entrusted to one member of the Examining Division. Oral proceedings shall be before the Examining Division itself. If the Examining Division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner. In the event of parity of votes, the vote of the Chairman of the Examining Division shall be decisive.

Article 19¹⁴

Opposition Divisions

(1) An Opposition Division shall be responsible for the examination of oppositions against any European patent.

(2) An Opposition Division shall consist of three technical examiners, at least two of whom shall not have taken part in the proceedings for grant of the patent to which the opposition relates. An examiner who has taken part in the proceedings for the grant of the European patent shall not be the Chairman. Prior to the taking of a final decision on the opposition, the Opposition Division may entrust the examination of the opposition to one of its members. Oral proceedings shall be before the Opposition Division itself. If the Opposition Division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner who shall not have taken part in the proceedings for grant of the patent. In the event of parity of votes, the vote of the Chairman of the Division shall be decisive.

Article 20¹⁵

Legal Division

(1) The Legal Division shall be responsible for decisions in respect of entries in the Register of European Patents and in respect of registration on, and deletion from, the list of professional representatives.

¹² Geändert durch die Akte zur Revision des Europäischen Patentübereinkommens vom 29.11.2000, vorläufig anwendbar ab 29.11.2000 (ABI. EPA 2001, Sonderausgabe Nr. 4).

¹³ Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 1/02 (Anhang I).

¹⁴ Siehe hierzu Entscheidung/Stellungnahme der Großen Beschwerdekammer G 5/91, G 1/02 (Anhang I).

¹⁵ Siehe hierzu den Beschluss des Präsidenten des EPA vom 10.03.1989 über die Zuständigkeit der Rechtsabteilung (ABI. EPA 1989, 177 f.) und die Mitteilung des Vizepräsidenten Generaldirektion 5 des EPA vom 05.07.1990 über den Schriftverkehr mit der Rechtsabteilung (ABI. EPA 1990, 404 f.).

¹² Amended by the Act revising the European Patent Convention of 29.11.2000, provisionally applicable as of 29.11.2000 (OJ EPO 2001, Special edition No. 4).

¹³ See opinion of the Enlarged Board of Appeal G 1/02 (Annex I).

¹⁴ See decision/opinion of the Enlarged Board of Appeal G 5/91, G 1/02 (Annex I).

¹⁵ See decision of the President of the EPO dated 10.03.1989 concerning the responsibilities of the Legal Division (OJ EPO 1989, 177 ff) and the notice of the Vice-President, DG 5 of the EPO dated 05.07.1990 concerning correspondence with the Legal Division (OJ EPO 1990, 404 f.).

Divisions d'examen

(1) Les divisions d'examen sont compétentes pour examiner les demandes de brevet européen.

(2)¹³ Une division d'examen se compose de trois examinateurs techniciens. Toutefois, l'instruction de la demande de brevet européen est, en règle générale, confiée à l'un des membres de la division d'examen. La procédure orale se déroule devant la division d'examen elle-même. Si elle estime que la nature de la décision l'exige, la division d'examen est complétée par un examinateur juriste. En cas de partage égal des voix, la voix du président de la division d'examen est prépondérante.

Article 19¹⁴

Divisions d'opposition

(1) Les divisions d'opposition sont compétentes pour examiner les oppositions aux brevets européens.

(2) Une division d'opposition se compose de trois examinateurs techniciens, dont deux au moins ne doivent pas avoir participé à la procédure de délivrance du brevet qui est l'objet de l'opposition. Un examinateur qui a participé à la procédure de délivrance du brevet européen ne peut assumer la présidence. La division d'opposition peut confier à l'un de ses membres l'instruction de l'opposition. La procédure orale est de la compétence de la division d'opposition elle-même. Si elle estime que la nature de la décision l'exige, la division d'opposition est complétée par un examinateur juriste qui ne doit pas avoir participé à la procédure de délivrance du brevet. En cas de partage des voix, la voix du président de la division d'opposition est prépondérante.

Art. 99
R. 9

Article 20¹⁵

Division juridique

(1) La division juridique est compétente pour toute décision relative, d'une part, aux mentions à porter sur le Registre européen des brevets, d'autre part, à l'inscription sur la liste des mandataires agréés et à leur radiation de celle-ci.

Art. 15, 127, 134
R. 9

¹² Modifié par l'acte portant révision de la Convention sur le brevet européen en date du 29.11.2000, applicable à titre provisoire à partir du 29.11.2000 (JO OEB 2001, édition spéciale n° 4).

¹³ Cf. l'avis de la Grande Chambre de recours G 1/02 (Annexe I).

¹⁴ Cf. la décision/l'avis de la Grande Chambre de recours G 5/91, G 1/02 (Annexe I).

¹⁵ Cf. la décision du Président de l'OEB, en date du 10.03.1989, relative à la compétence de la division juridique (JO OEB 1989, 177 s.) et le communiqué du Vice-Président chargé de la DG 5 de l'OEB, en date du 05.07.1990, relatif à la correspondance avec la division juridique (JO OEB 1990, 404 s.).

(2) Entscheidungen der Rechtsabteilung werden von einem rechtskundigen Mitglied getroffen.

*Artikel 21*¹⁶

Beschwerdekammern

(1) Die Beschwerdekammern sind für die Prüfung von Beschwerden gegen Entscheidungen der Eingangsstelle, der Prüfungsabteilungen, der Einspruchsabteilungen und der Rechtsabteilung zuständig.

(2) Bei Beschwerden gegen die Entscheidung der Eingangsstelle und der Rechtsabteilung setzt sich eine Beschwerdekammer aus drei rechtskundigen Mitgliedern zusammen.

(3) Bei Beschwerden gegen die Entscheidung einer Prüfungsabteilung setzt sich eine Beschwerdekammer zusammen aus:

a) zwei technisch vorgebildeten Mitgliedern und einem rechtskundigen Mitglied, wenn die Entscheidung die Zurückweisung einer europäischen Patentanmeldung oder die Erteilung eines europäischen Patents betrifft und von einer aus weniger als vier Mitgliedern bestehenden Prüfungsabteilung gefasst worden ist;

b) drei technisch vorgebildeten Mitgliedern und zwei rechtskundigen Mitgliedern, wenn die Entscheidung von einer aus vier Mitgliedern bestehenden Prüfungsabteilung gefasst worden ist oder die Beschwerdekammer der Meinung ist, dass es die Art der Beschwerde erfordert;

c) drei rechtskundigen Mitgliedern in allen anderen Fällen.

(4) Bei Beschwerden gegen die Entscheidung einer Einspruchsabteilung setzt sich eine Beschwerdekammer zusammen aus:

a) zwei technisch vorgebildeten Mitgliedern und einem rechtskundigen Mitglied, wenn die Entscheidung von einer aus drei Mitgliedern bestehenden Einspruchsabteilung gefasst worden ist;

b) drei technisch vorgebildeten Mitgliedern und zwei rechtskundigen Mitgliedern, wenn die Entscheidung von einer aus vier Mitgliedern bestehenden Einspruchsabteilung gefasst worden ist oder die Beschwerdekammer der Meinung ist, dass es die Art der Beschwerde erfordert.

Artikel 22

Große Beschwerdekammer

(1) Die Große Beschwerdekammer ist zuständig für:

a) Entscheidungen über Rechtsfragen, die ihr von den Beschwerdekammern vorgelegt werden;

(2) Decisions of the Legal Division shall be taken by one legally qualified member.

*Article 21*¹⁶

Boards of Appeal

(1) The Boards of Appeal shall be responsible for the examination of appeals from the decisions of the Receiving Section, Examining Divisions, Opposition Divisions and of the Legal Division.

(2) For appeals from a decision of the Receiving Section or the Legal Division, a Board of Appeal shall consist of three legally qualified members.

(3) For appeals from a decision of an Examining Division, a Board of Appeal shall consist of:

(a) two technically qualified members and one legally qualified member, when the decision concerns the refusal of a European patent application or the grant of a European patent and was taken by an Examining Division consisting of less than four members;

(b) three technically qualified members and two legally qualified members, when the decision was taken by an Examining Division consisting of four members or when the Board of Appeal considers that the nature of the appeal so requires;

(c) three legally qualified members in all other cases.

(4) For appeals from a decision of an Opposition Division, a Board of Appeal shall consist of:

(a) two technically qualified members and one legally qualified member, when the decision was taken by an Opposition Division consisting of three members;

(b) three technically qualified members and two legally qualified members, when the decision was taken by an Opposition Division consisting of four members or when the Board of Appeal considers that the nature of the appeal so requires.

Article 22

Enlarged Board of Appeal

(1) The Enlarged Board of Appeal shall be responsible for:

(a) deciding points of law referred to it by Boards of Appeal;

¹⁶ Siehe hierzu Entscheidungen/Stellnahmen der Großen Beschwerdekammer G 2/90, G 8/95, G 1/97, G 1/02, G 3/03 (Anhang I).

¹⁶ See decisions/opinions of the Enlarged Board of Appeal G 2/90, G 8/95, G 1/97, G 1/02, G 3/03 (Annex I).

(2) Les décisions de la division juridique sont prises par un membre juriste.

Verweisungen / References / Références

*Article 21*¹⁶

Chambres de recours

Art. 11, 15, 106, 154, 155
R. 10

(1) Les chambres de recours sont compétentes pour examiner les recours formés contre les décisions de la section de dépôt, des divisions d'examen, des divisions d'opposition et de la division juridique.

(2) Dans le cas d'un recours formé contre une décision de la section de dépôt ou de la division juridique, la chambre de recours se compose de trois membres juristes.

(3) Dans le cas d'un recours formé contre une décision d'une division d'examen, la chambre de recours se compose de :

a) deux membres techniciens et un membre juriste lorsque la décision est relative au rejet d'une demande de brevet européen ou à la délivrance d'un brevet européen et qu'elle a été prise par une division d'examen composée de moins de quatre membres ;

b) trois membres techniciens et deux membres juristes lorsque la décision a été prise par une division d'examen composée de quatre membres ou si la chambre de recours estime que la nature du recours l'exige ;

c) trois membres juristes dans les autres cas.

(4) Dans le cas d'un recours formé contre une décision d'une division d'opposition, la chambre de recours se compose de :

a) deux membres techniciens et un membre juriste lorsque la décision a été prise par une division d'opposition composée de trois membres ;

b) trois membres techniciens et deux membres juristes lorsque la décision a été prise par une division d'opposition composée de quatre membres ou si la chambre de recours estime que la nature du recours l'exige.

Article 22

Grande Chambre de recours

Art. 11, 15
R. 10

(1) La Grande Chambre de recours est compétente pour :

a) statuer sur les questions de droit qui lui sont soumises par les chambres de recours ;

¹⁶ Cf. les décisions/avis de la Grande Chambre de recours G 2/90, G 8/95, G 1/97, G 1/02, G 3/03 (Annexe I).

b) die Abgabe von Stellungnahmen zu Rechtsfragen, die ihr vom Präsidenten des Europäischen Patentamts nach Artikel 112 vorgelegt werden.

(2) Die Große Beschwerdekammer beschließt in der Besetzung von fünf rechtskundigen Mitgliedern und zwei technisch vorgebildeten Mitgliedern. Ein rechtskundiges Mitglied führt den Vorsitz.

Artikel 23¹⁷

Unabhängigkeit der Mitglieder der Kammern

(1) Die Mitglieder der Großen Beschwerdekammer und der Beschwerdekammern werden für einen Zeitraum von fünf Jahren ernannt und können während dieses Zeitraums ihrer Funktion nicht enthoben werden, es sei denn, dass schwerwiegende Gründe vorliegen und der Verwaltungsrat auf Vorschlag der Großen Beschwerdekammer einen entsprechenden Beschluss fasst.

(2) Die Mitglieder der Kammern dürfen nicht der Eingangsstelle, den Prüfungsabteilungen, den Einspruchsabteilungen oder der Rechtsabteilung angehören.

(3) Die Mitglieder der Kammern sind für ihre Entscheidungen an Weisungen nicht gebunden und nur diesem Übereinkommen unterworfen.

(4)¹⁸ Die Verfahrensordnungen der Beschwerdekammern und der Großen Beschwerdekammer werden nach Maßgabe der Ausführungsordnung erlassen. Sie bedürfen der Genehmigung des Verwaltungsrats.

Artikel 24¹⁹

Ausschließung und Ablehnung

(1) Die Mitglieder der Beschwerdekammern und der Großen Beschwerdekammer dürfen nicht an der Erledigung einer Sache mitwirken, an der sie ein persönliches Interesse haben, in der sie vorher als Vertreter eines Beteiligten tätig gewesen sind oder an deren abschließender Entscheidung in der Vorinstanz sie mitgewirkt haben.

(2) Glaubt ein Mitglied einer Beschwerdekammer oder der Großen Beschwerdekammer aus einem der in Absatz 1 genannten Gründe oder aus einem sonstigen Grund an einem Verfahren nicht mitwirken zu können, so teilt es dies der Kammer mit.

¹⁷ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 6/95, G 1/97, G 2/02 und G 3/02 (Anhang I).

¹⁸ Siehe hierzu die Verfahrensordnung der Beschwerdekammern in der Fassung vom 01.01.2005 (ABI. EPA 2003, 89 ff. und ABI. EPA 2004, 541) und die Verfahrensordnung der Großen Beschwerdekammer in der Fassung vom 01.05.2003 (ABI. EPA 2003, 83 ff.).

¹⁹ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 5/91, G 1/97 (Anhang I).

(b) giving opinions on points of law referred to it by the President of the European Patent Office under the conditions laid down in Article 112.

(2) For giving decisions or opinions, the Enlarged Board of Appeal shall consist of five legally qualified members and two technically qualified members. One of the legally qualified members shall be the Chairman.

Article 23¹⁷

Independence of the members of the Boards

(1) The members of the Enlarged Board of Appeal and of the Boards of Appeal shall be appointed for a term of five years and may not be removed from office during this term, except if there are serious grounds for such removal and if the Administrative Council, on a proposal from the Enlarged Board of Appeal, takes a decision to this effect.

(2) The members of the Boards may not be members of the Receiving Section, Examining Divisions, Opposition Divisions or of the Legal Division.

(3) In their decisions the members of the Boards shall not be bound by any instructions and shall comply only with the provisions of this Convention.

(4)¹⁸ The Rules of Procedure of the Boards of Appeal and the Enlarged Board of Appeal shall be adopted in accordance with the provisions of the Implementing Regulations. They shall be subject to the approval of the Administrative Council.

Article 24¹⁹

Exclusion and objection

(1) Members of the Boards of Appeal or of the Enlarged Board of Appeal may not take part in any appeal if they have any personal interest therein, if they have previously been involved as representatives of one of the parties, or if they participated in the decision under appeal.

(2) If, for one of the reasons mentioned in paragraph 1, or for any other reason, a member of a Board of Appeal or of the Enlarged Board of Appeal considers that he should not take part in any appeal, he shall inform the Board accordingly.

¹⁷ See decisions of the Enlarged Board of Appeal G 6/95, G 1/97, G 2/02 and G 3/02 (Annex I).

¹⁸ See the Rules of Procedure of the Boards of Appeal as of 01.01.2005 (OJ EPO 2003, 89 ff and OJ EPO 2004, 541) and the Rules of Procedure of the Enlarged Board of Appeal as of 01.05.2003 (OJ EPO 2003, 83 ff).

¹⁹ See decisions of the Enlarged Board of Appeal G 5/91, G 1/97 (Annex I).

b) donner des avis sur les questions de droit qui lui sont soumises par le Président de l'Office européen des brevets dans les conditions prévues à l'article 112.

Verweisungen / References / Références

(2) Pour statuer ou donner des avis, la Grande Chambre de recours se compose de cinq membres juristes et de deux membres techniciens. La présidence est assurée par l'un des membres juristes.

*Article 23*¹⁷

Indépendance des membres des chambres

R. 11

(1) Les membres de la Grande Chambre de recours et des chambres de recours sont nommés pour une période de cinq ans et ne peuvent être relevés de leurs fonctions pendant cette période, sauf pour motifs graves et si le Conseil d'administration, sur proposition de la Grande Chambre de recours, prend une décision à cet effet.

(2) Les membres des chambres ne peuvent être membres de la section de dépôt, des divisions d'examen, des divisions d'opposition ou de la division juridique.

(3) Dans leurs décisions, les membres des chambres ne sont liés par aucune instruction et ne doivent se conformer qu'aux seules dispositions de la présente convention.

(4)¹⁸ Les règlements de procédure des chambres de recours et de la Grande Chambre de recours sont arrêtés conformément aux dispositions du règlement d'exécution. Ils sont soumis à l'approbation du Conseil d'administration.

*Article 24*¹⁹

Récusation

R. 93

(1) Les membres d'une chambre de recours et de la Grande Chambre de recours ne peuvent participer au règlement d'une affaire s'ils y possèdent un intérêt personnel, s'ils y sont antérieurement intervenus en qualité de représentants de l'une des parties ou s'ils ont pris part à la décision qui fait l'objet du recours.

(2) Si, pour l'une des raisons mentionnées au paragraphe 1 ou pour tout autre motif, un membre d'une chambre de recours ou de la Grande Chambre de recours estime ne pas pouvoir participer au règlement d'une affaire, il en avertit la chambre.

¹⁷ Cf. les décisions de la Grande Chambre de recours G 6/95, G 1/97, G 2/02 et G 3/02 (Annexe I).

¹⁸ Cf. le règlement de procédure des chambres de recours, tel que modifié le 01.01.2005 (JO OEB 2003, 89 s. et JO OEB 2004, 541) et le règlement de procédure de la Grande Chambre de recours du 01.05.2003 (JO OEB 2003, 83 s.).

¹⁹ Cf. les décisions de la Grande Chambre de recours G 5/91, G 1/97 (Annexe I).

(3) Die Mitglieder der Beschwerdekammern oder der Großen Beschwerdekammer können von jedem Beteiligten aus einem der in Absatz 1 genannten Gründe oder wegen Besorgnis der Befangenheit abgelehnt werden. Die Ablehnung ist nicht zulässig, wenn der Beteiligte im Verfahren Anträge gestellt oder Stellungnahmen abgegeben hat, obwohl er bereits den Ablehnungsgrund kannte. Die Ablehnung kann nicht mit der Staatsangehörigkeit der Mitglieder begründet werden.

(4) Die Beschwerdekammern und die Große Beschwerdekammer entscheiden in den Fällen der Absätze 2 und 3 ohne Mitwirkung des betroffenen Mitglieds. Bei dieser Entscheidung wird das abgelehnte Mitglied durch seinen Vertreter ersetzt.

Artikel 25

Technische Gutachten

Auf Ersuchen des mit einer Verletzungs- oder Nichtigkeitsklage befassten zuständigen nationalen Gerichts ist das Europäische Patentamt verpflichtet, gegen eine angemessene Gebühr²⁰ ein technisches Gutachten über das europäische Patent zu erstatten, das Gegenstand des Rechtsstreits ist. Für die Erstattung der Gutachten sind die Prüfungsabteilungen zuständig.

Kapitel IV

Der Verwaltungsrat

Artikel 26

Zusammensetzung

(1) Der Verwaltungsrat besteht aus den Vertretern der Vertragsstaaten und deren Stellvertretern. Jeder Vertragsstaat ist berechtigt, einen Vertreter und einen Stellvertreter für den Verwaltungsrat zu bestellen.

(2) Die Mitglieder des Verwaltungsrats können nach Maßgabe der Geschäftsordnung des Verwaltungsrats Berater oder Sachverständige hinzuziehen.

Artikel 27

Vorsitz

(1) Der Verwaltungsrat wählt aus den Vertretern der Vertragsstaaten und deren Stellvertretern einen Präsidenten und einen Vizepräsidenten. Der Vizepräsident tritt im Fall der Verhinderung des Präsidenten von Amts wegen an dessen Stelle.

(2) Die Amtszeit des Präsidenten und des Vizepräsidenten beträgt drei Jahre. Wiederwahl ist zulässig.

(3) Members of a Board of Appeal or of the Enlarged Board of Appeal may be objected to by any party for one of the reasons mentioned in paragraph 1, or if suspected of partiality. An objection shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step. No objection may be based upon the nationality of members.

(4) The Boards of Appeal and the Enlarged Board of Appeal shall decide as to the action to be taken in the cases specified in paragraphs 2 and 3 without the participation of the member concerned. For the purposes of taking this decision the member objected to shall be replaced by his alternate.

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 fee²⁰, 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.

Chapter IV

The Administrative Council

Article 26

Membership

(1) The Administrative Council shall be composed of the Representatives and the alternate Representatives of the Contracting States. Each Contracting State shall be entitled to appoint one Representative and one alternate Representative to the Administrative Council.

(2) The members of the Administrative Council may, subject to the provisions of its Rules of Procedure, be assisted by advisers or experts.

Article 27

Chairmanship

(1) The Administrative Council shall elect a Chairman and a Deputy Chairman from among the Representatives and alternate Representatives of the Contracting States. The Deputy Chairman shall ex officio replace the Chairman in the event of his being prevented from attending to his duties.

(2) The duration of the terms of office of the Chairman and the Deputy Chairman shall be three years. The terms of office shall be renewable.

²⁰ Siehe Artikel 2, Nummer 20 der Gebührenordnung.

²⁰ See Article 2, item 20, of the Rules relating to Fees.

(3) Les membres d'une chambre de recours ou de la Grande Chambre de recours peuvent être récusés par toute partie pour l'une des raisons mentionnées au paragraphe 1 ou s'ils peuvent être soupçonnés de partialité. La récusation n'est pas recevable lorsque la partie en cause a fait des actes de procédure, bien qu'elle ait déjà eu connaissance du motif de récusation. Aucune récusation ne peut être fondée sur la nationalité des membres.

(4) Les chambres de recours et la Grande Chambre de recours statuent, dans les cas visés aux paragraphes 2 et 3, sans la participation du membre intéressé. Pour prendre cette décision, le membre récusé est remplacé, au sein de la chambre, par son suppléant.

Article 25

Avis technique

A la requête du tribunal national compétent saisi de l'action en contrefaçon ou en nullité, l'Office européen des brevets est tenu de fournir, contre paiement d'une redevance appropriée²⁰, un avis technique sur le brevet européen en cause. Les divisions d'examen sont compétentes pour la délivrance de ces avis.

Chapitre IV

Le Conseil d'administration

Article 26

Composition

(1) Le Conseil d'administration se compose des représentants des Etats contractants et de leurs suppléants. Chaque Etat contractant a le droit de désigner un représentant au Conseil d'administration et un suppléant.

(2) Les membres du Conseil d'administration peuvent se faire assister de conseillers ou d'experts, dans les limites prévues par son règlement intérieur.

Article 27

Présidence

(1) Le Conseil d'administration élit parmi les représentants des Etats contractants et leurs suppléants un Président et un Vice-Président. Le Vice-Président remplace de droit le Président en cas d'empêchement.

(2) La durée du mandat du Président et du Vice-Président est de trois ans. Ce mandat est renouvelable.

²⁰ Cf. article 2, point 20 du règlement relatif aux taxes.

Artikel 28²¹

Präsidium

(1) Beträgt die Zahl der Vertragsstaaten mindestens acht, so kann der Verwaltungsrat ein aus fünf seiner Mitglieder bestehendes Präsidium bilden.

(2) Der Präsident und der Vizepräsident des Verwaltungsrats sind von Amts wegen Mitglieder des Präsidiums; die drei übrigen Mitglieder werden vom Verwaltungsrat gewählt.

(3) Die Amtszeit der vom Verwaltungsrat gewählten Präsidiumsmitglieder beträgt drei Jahre. Die Wiederwahl dieser Mitglieder ist nicht zulässig.

(4) Das Präsidium nimmt die Aufgaben wahr, die ihm der Verwaltungsrat nach Maßgabe der Geschäftsordnung zuweist.

Artikel 29

Tagungen

(1) Der Verwaltungsrat wird von seinem Präsidenten einberufen.

(2) Der Präsident des Europäischen Patentamts nimmt an den Beratungen teil.

(3) Der Verwaltungsrat hält jährlich eine ordentliche Tagung ab; außerdem tritt er auf Veranlassung seines Präsidenten oder auf Antrag eines Drittels der Vertragsstaaten zusammen.

(4) Der Verwaltungsrat berät auf Grund einer Tagesordnung nach Maßgabe seiner Geschäftsordnung.

(5) Jede Frage, die auf Antrag eines Vertragsstaats nach Maßgabe der Geschäftsordnung auf die Tagesordnung gesetzt werden soll, wird in die vorläufige Tagesordnung aufgenommen.

Artikel 30

Teilnahme von Beobachtern

(1) Die Weltorganisation für geistiges Eigentum ist auf den Tagungen des Verwaltungsrats nach Maßgabe eines Abkommens vertreten, das die Europäische Patentorganisation mit der Weltorganisation für geistiges Eigentum schließt.

(2) Andere zwischenstaatliche Organisationen, die mit der Durchführung internationaler patentrechtlicher Verfahren beauftragt sind und mit denen die Organisation ein Abkommen geschlossen hat, sind, wenn dieses Abkommen entsprechende Vorschriften enthält, nach Maßgabe dieser Vorschriften auf den Tagungen des Verwaltungsrats vertreten.

Article 28²¹

Board

(1) When there are at least eight Contracting States, the Administrative Council may set up a Board composed of five of its members.

(2) The Chairman and the Deputy Chairman of the Administrative Council shall be members of the Board ex officio; the other three members shall be elected by the Administrative Council.

(3) The term of office of the members elected by the Administrative Council shall be three years. This term of office shall not be renewable.

(4) The Board shall perform the duties given to it by the Administrative Council in accordance with the Rules of Procedure.

Article 29

Meetings

(1) Meetings of the Administrative Council shall be convened by its Chairman.

(2) The President of the European Patent Office shall take part in the deliberations of the Administrative Council.

(3) The Administrative Council shall hold an ordinary meeting once each year. In addition, it shall meet on the initiative of its Chairman or at the request of one-third of the Contracting States.

(4) The deliberations of the Administrative Council shall be based on an agenda, and shall be held in accordance with its Rules of Procedure.

(5) The provisional agenda shall contain any question whose inclusion is requested by any Contracting State in accordance with the Rules of Procedure.

Article 30

Attendance of observers

(1) The World Intellectual Property Organization shall be represented at the meetings of the Administrative Council, in accordance with the provisions of an agreement to be concluded between the European Patent Organisation and the World Intellectual Property Organization.

(2) Any other intergovernmental organisation charged with the implementation of international procedures in the field of patents with which the Organisation has concluded an agreement shall be represented at the meetings of the Administrative Council, in accordance with any provisions contained in such agreement.

²¹ Siehe hierzu Beschlüsse des Verwaltungsrats vom 05.06.2003 zur Einsetzung eines Präsidiums des Verwaltungsrats (ABI. EPA 2003, 333) und vom 30.10.2003 betreffend die Einsetzung des Präsidiums des Verwaltungsrats (ABI. EPA 2003, 579).

²¹ See decisions of the Administrative Council of 05.06.2003 setting up a Board of the Administrative Council (OJ EPO 2003, 333) and of 30.10.2003 concerning the operation of the Board of the Administrative Council (OJ EPO 2003, 579).

Bureau

- (1) Le Conseil d'administration peut instituer un Bureau composé de cinq de ses membres, dès lors que le nombre des Etats contractants est de huit au minimum.
- (2) Le Président et le Vice-Président du Conseil d'administration sont de droit membres du Bureau ; les trois autres membres sont élus par le Conseil d'administration.
- (3) La durée du mandat des membres élus par le Conseil d'administration est de trois ans. Ce mandat n'est pas renouvelable.
- (4) Le Bureau assume l'exécution des tâches que le Conseil d'administration lui confie dans le cadre du règlement intérieur.

Article 29

Sessions

- (1) Le Conseil d'administration se réunit sur convocation de son Président.
- (2) Le Président de l'Office européen des brevets prend part aux délibérations.
- (3) Le Conseil d'administration tient une session ordinaire une fois par an ; en outre, il se réunit à l'initiative de son Président ou à la demande du tiers des Etats contractants.
- (4) Le Conseil d'administration délibère sur un ordre du jour déterminé, conformément à son règlement intérieur.
- (5) Toute question dont l'inscription est demandée par un Etat contractant dans les conditions prévues par le règlement intérieur est inscrite à l'ordre du jour provisoire.

Article 30

Participation d'observateurs

- (1) L'Organisation Mondiale de la Propriété Intellectuelle est représentée aux sessions du Conseil d'administration, conformément aux dispositions d'un accord à conclure entre l'Organisation européenne des brevets et l'Organisation Mondiale de la Propriété Intellectuelle.
- (2) D'autres organisations intergouvernementales, qui sont chargées de la mise en oeuvre de procédures internationales dans le domaine des brevets, avec lesquelles l'Organisation a conclu un accord, sont représentées aux sessions du Conseil d'administration, conformément aux dispositions figurant éventuellement à cet effet dans ledit accord.

²¹ Cf. les décisions du Conseil d'administration du 05.06.2003 instituant un Bureau du Conseil d'administration (JO OEB 2003, 333) et du 30.10.2003 relative à la mise en oeuvre du Bureau du Conseil d'administration (JO OEB 2003, 579).

(3) Alle anderen zwischenstaatlichen und nichtstaatlichen internationalen Organisationen, die eine die Organisation betreffende Tätigkeit ausüben, können vom Verwaltungsrat eingeladen werden, sich auf seinen Tagungen bei der Erörterung von Fragen, die von gemeinsamem Interesse sind, vertreten zu lassen.

Artikel 31

Sprachen des Verwaltungsrats

(1) Der Verwaltungsrat bedient sich bei seinen Beratungen der deutschen, englischen und französischen Sprache.

(2) Die dem Verwaltungsrat unterbreiteten Dokumente und die Protokolle über seine Beratungen werden in den drei in Absatz 1 genannten Sprachen erstellt.

Artikel 32

Personal, Räumlichkeiten und Ausstattung

Das Europäische Patentamt stellt dem Verwaltungsrat sowie den vom Verwaltungsrat eingesetzten Ausschüssen das Personal, die Räumlichkeiten und die Ausstattung zur Verfügung, die sie zur Durchführung ihrer Aufgaben benötigen.

Artikel 33²²

Befugnisse des Verwaltungsrats in bestimmten Fällen

(1) Der Verwaltungsrat ist befugt, folgende Vorschriften zu ändern:

- a) die Dauer der in diesem Übereinkommen festgesetzten Fristen; dies gilt für die in Artikel 94 genannte Frist nur unter den in Artikel 95 festgelegten Voraussetzungen;
- b) die Ausführungsordnung.

(2) Der Verwaltungsrat ist befugt, in Übereinstimmung mit diesem Übereinkommen folgende Vorschriften zu erlassen und zu ändern:

- a) die Finanzordnung;
- b) das Statut der Beamten und die Beschäftigungsbedingungen für die sonstigen Bediensteten des Europäischen Patentamts, ihre Besoldung sowie die Art der zusätzlichen Vergütung und die Verfahrensrichtlinien für deren Gewährung;
- c) die Versorgungsordnung und Erhöhungen der Versorgungsbezüge entsprechend einer Erhöhung der Dienstbezüge;

²² Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 5/88, G 7/88, G 8/88, G 6/95, G 1/02, G 2/02 und G 3/02 (Anhang I).

(3) Any other intergovernmental and international non-governmental organisations exercising an activity of interest to the Organisation may be invited by the Administrative Council to arrange to be represented at its meetings during any discussion of matters of mutual interest.

Article 31

Languages of the Administrative Council

(1) The languages in use in the deliberations of the Administrative Council shall be English, French and German.

(2) Documents submitted to the Administrative Council, and the minutes of its deliberations, shall be drawn up in the three languages mentioned in paragraph 1.

Article 32

Staff, premises and equipment

The European Patent Office shall place at the disposal of the Administrative Council and any body established by it such staff, premises and equipment as may be necessary for the performance of their duties.

Article 33²²

Competence of the Administrative Council in certain cases

(1) The Administrative Council shall be competent to amend the following provisions of this Convention:

- (a) the time limits laid down in this Convention; this shall apply to the time limit laid down in Article 94 only in the conditions laid down in Article 95;
- (b) the Implementing Regulations.

(2) The Administrative Council shall be competent, in conformity with this Convention, to adopt or amend the following provisions:

- (a) the Financial Regulations;
- (b) the Service Regulations for permanent employees and the conditions of employment of other employees of the European Patent Office, the salary scales of the said permanent and other employees, and also the nature, and rules for the grant, of any supplementary benefits;
- (c) the Pension Scheme Regulations and any appropriate increases in existing pensions to correspond to increases in salaries;

²² See decisions/opinions of the Enlarged Board of Appeal G 5/88, G 7/88, G 8/88, G 6/95, G 1/02, G 2/02 and G 3/02 (Annex I).

(3) Toute autre organisation intergouvernementale ou internationale non gouvernementale exerçant une activité intéressant l'Organisation peut être invitée par le Conseil d'administration à se faire représenter à ses sessions lors de toute discussion de questions d'intérêt commun.

Verweisungen / References / Références

Article 31

Langues du Conseil d'administration

(1) Les langues utilisées dans les délibérations du Conseil d'administration sont l'allemand, l'anglais et le français.

(2) Les documents soumis au Conseil d'administration et les procès-verbaux de ses délibérations sont établis dans les trois langues visées au paragraphe 1.

Article 32

Personnel, locaux et matériel

L'Office européen des brevets met à la disposition du Conseil d'administration et des comités que celui-ci a institués le personnel, les locaux et les moyens matériels nécessaires à l'accomplissement de leur mission.

*Article 33*²²

Compétence du Conseil d'administration dans certains cas

*Art. 35
R. 10, 74*

(1) Le Conseil d'administration a compétence pour modifier les dispositions de la présente convention énumérées ci-après :

a) les articles de la présente convention dans la mesure où ils fixent la durée d'un délai, cette disposition n'étant applicable au délai visé à l'article 94 que s'il est satisfait aux conditions prévues à l'article 95 ;

b) les dispositions du règlement d'exécution.

(2) Le Conseil d'administration a compétence, conformément aux termes de la présente convention, pour arrêter et modifier :

a) le règlement financier ;

b) le statut des fonctionnaires et le régime applicable aux autres agents de l'Office européen des brevets, le barème de leurs rémunérations ainsi que la nature et les règles d'octroi des avantages accessoires ;

c) le règlement de pensions et toute augmentation des pensions existantes correspondant aux relèvements des traitements ;

²² Cf. les décisions/avis de la Grande Chambre de recours G 5/88, G 7/88, G 8/88, G 6/95, G 1/02, G 2/02 et G 3/02 (Annexe I).

d) die Gebührenordnung;

e) seine Geschäftsordnung.

(3) Der Verwaltungsrat ist befugt, zu beschließen, dass abweichend von Artikel 18 Absatz 2 die Prüfungsabteilungen für bestimmte Gruppen von Fällen aus einem technisch vorgebildeten Prüfer bestehen, wenn die Erfahrung dies rechtfertigt. Dieser Beschluss kann rückgängig gemacht werden.

(4) Der Verwaltungsrat ist befugt, den Präsidenten des Europäischen Patentamts zu ermächtigen, Verhandlungen über den Abschluss von Abkommen mit Staaten oder zwischenstaatlichen Organisationen sowie mit Dokumentationszentren, die auf Grund von Vereinbarungen mit solchen Organisationen errichtet worden sind, zu führen und diese Abkommen mit Genehmigung des Verwaltungsrats für die Europäische Patentorganisation zu schließen.

Artikel 34

Stimmrecht

(1) Stimmberechtigt im Verwaltungsrat sind nur die Vertragsstaaten.

(2) Jeder Vertragsstaat verfügt über eine Stimme, soweit nicht Artikel 36 anzuwenden ist.

Artikel 35

Abstimmungen

(1) Der Verwaltungsrat fasst seine Beschlüsse vorbehaltlich Absatz 2 mit der einfachen Mehrheit der vertretenen Vertragsstaaten, die eine Stimme abgeben.

(2) Dreiviertelmehrheit der vertretenen Vertragsstaaten, die eine Stimme abgeben, ist für die Beschlüsse erforderlich, zu denen der Verwaltungsrat nach den Artikeln 7, 11 Absatz 1, 33, 39 Absatz 1, 40 Absätze 2 und 4, 46, 87, 95, 134, 151 Absatz 3, 154 Absatz 2, 155 Absatz 2, 156, 157 Absätze 2 bis 4, 160 Absatz 1 Satz 2, 162, 163, 166, 167 und 172 befugt ist.

(3) Stimmenthaltung gilt nicht als Stimmabgabe.

(d) the Rules relating to Fees;

(e) its Rules of Procedure.

(3) Notwithstanding Article 18, paragraph 2, the Administrative Council shall be competent to decide, in the light of experience, that in certain categories of cases Examining Divisions shall consist of one technical examiner. Such decision may be rescinded.

(4) The Administrative Council shall be competent to authorise the President of the European Patent Office to negotiate and, with its approval, to conclude agreements on behalf of the European Patent Organisation with States, with intergovernmental organisations and with documentation centres set up by virtue of agreements with such organisations.

Article 34

Voting rights

(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.

Article 35

Voting rules

(1) The Administrative Council shall take its decisions other than those referred to in paragraph 2 by a simple majority of the Contracting States represented and voting.

(2) A majority of three-quarters of the votes of the Contracting States represented and voting shall be required for the decisions which the Administrative Council is empowered to take under Article 7, Article 11, paragraph 1, Article 33, Article 39, paragraph 1, Article 40, paragraphs 2 and 4, Article 46, Article 87, Article 95, Article 134, Article 151, paragraph 3, Article 154, paragraph 2, Article 155, paragraph 2, Article 156, Article 157, paragraphs 2 to 4, Article 160, paragraph 1, second sentence, Article 162, Article 163, Article 166, Article 167 and Article 172.

(3) Abstentions shall not be considered as votes.

d) le règlement relatif aux taxes ;

Verweisungen / References / Références

e) son règlement intérieur.

(3) Nonobstant les dispositions de l'article 18, paragraphe 2, le Conseil d'administration a compétence pour décider, si l'expérience le justifie, que, dans certaines catégories de cas, les divisions d'examen se composent d'un seul examinateur technicien. Cette décision peut être rapportée.

(4) Le Conseil d'administration a compétence pour autoriser le Président de l'Office européen des brevets à négocier et, sous réserve de son approbation, à conclure, au nom de l'Organisation européenne des brevets, des accords avec des Etats ou des organisations intergouvernementales ainsi qu'avec des centres de documentation créés en vertu d'accords conclus avec ces organisations.

Article 34

Droit de vote

(1) Les Etats contractants ont seuls droit de vote au Conseil d'administration.

(2) Chaque Etat contractant dispose d'une voix, sous réserve de l'application des dispositions de l'article 36.

Article 35

Votes

(1) Sous réserve des dispositions du paragraphe 2, le Conseil d'administration prend ses décisions à la majorité simple des Etats contractants représentés et votants.

(2) Requièrent la majorité des trois quarts des Etats contractants représentés et votants, les décisions que le Conseil d'administration est compétent pour prendre en vertu des articles 7, 11 paragraphe 1, 33, 39 paragraphe 1, 40 paragraphes 2 et 4, 46, 87, 95, 134, 151 paragraphe 3, 154 paragraphe 2, 155 paragraphe 2, 156, 157 paragraphes 2 à 4, 160 paragraphe 1 deuxième phrase, 62, 163, 166, 167 et 172.

(3) L'abstention n'est pas considérée comme un vote.

Artikel 36

Stimmenwägung

Article 36

Weighting of votes

(1) Jeder Vertragsstaat kann für die Annahme und Änderung der Gebührenordnung sowie, falls dadurch die finanzielle Belastung der Vertragsstaaten vergrößert wird, für die Feststellung des Haushaltsplans und eines Berichtigungs- oder Nachtragshaushaltsplans der Organisation nach einer ersten Abstimmung, in der jeder Vertragsstaat über eine Stimme verfügt, unabhängig vom Ausgang der Abstimmung verlangen, dass unverzüglich eine zweite Abstimmung vorgenommen wird, in der die Stimmen nach Absatz 2 gewogen werden. Diese zweite Abstimmung ist für den Beschluss maßgebend.

(2) Die Zahl der Stimmen, über die jeder Vertragsstaat in der neuen Abstimmung verfügt, errechnet sich wie folgt:

- a) Die sich für jeden Vertragsstaat ergebende Prozentzahl des in Artikel 40 Absätze 3 und 4 vorgesehenen Aufbringungsschlüssels für die besonderen Finanzbeiträge wird mit der Zahl der Vertragsstaaten multipliziert und durch fünf dividiert.
- b) Die so errechnete Stimmenzahl wird auf eine ganze Zahl aufgerundet.
- c) Dieser Stimmenzahl werden fünf weitere Stimmen hinzugezählt.
- d) Die Zahl der Stimmen eines Vertragsstaats beträgt jedoch höchstens 30.

(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.

Kapitel V

Finanzvorschriften

[Artikel 37]

Deckung der Ausgaben

Chapter V

Financial provisions

[Article 37]

Cover for expenditure

Die Ausgaben der Organisation werden gedeckt:

- a) *durch eigene Mittel der Organisation;*
- b) *durch Zahlungen der Vertragsstaaten auf Grund der für die Aufrechterhaltung der europäischen Patente in diesen Staaten erhobenen Gebühren;*
- c) *erforderlichenfalls durch besondere Finanzbeiträge der Vertragsstaaten;*
- d) *gegebenenfalls durch die in Artikel 146 vorgesehenen Einnahmen.]*

The expenditure of the Organisation shall be covered:

- (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.]*

Pondération des voix

(1) Pour l'adoption et la modification du règlement relatif aux taxes ainsi que, si la charge financière des Etats contractants s'en trouve accrue, pour l'adoption du budget de l'Organisation et des budgets modificatifs ou additionnels, tout Etat contractant peut exiger, après un premier scrutin dans lequel chaque Etat contractant dispose d'une voix et quel que soit le résultat de ce scrutin, qu'il soit procédé immédiatement à un second scrutin dans lequel les voix sont pondérées conformément aux dispositions du paragraphe 2. La décision résulte de ce second scrutin.

(2) Le nombre de voix dont chaque Etat contractant dispose dans le nouveau scrutin se calcule comme suit :

- a) le nombre correspondant au pourcentage qui résulte pour chaque Etat contractant de la clé de répartition des contributions financières exceptionnelles prévue à l'article 40, paragraphes 3 et 4, est multiplié par le nombre d'Etats contractants et divisé par cinq ;
- b) le nombre de voix ainsi calculé est arrondi au nombre entier supérieur ;
- c) à ce nombre de voix s'ajoutent cinq voix supplémentaires ;
- d) toutefois, aucun Etat contractant ne peut disposer de plus de trente voix.

Chapitre V

Dispositions financières*[Article 37**Couverture des dépenses*

Art. 47, 50

Les dépenses de l'Organisation sont couvertes :

- a) *par les ressources propres de l'Organisation ;*
- b) *par les versements des Etats contractants au titre des taxes de maintien en vigueur des brevets européens perçues dans ces Etats ;*
- c) *éventuellement, par des contributions financières exceptionnelles des Etats contractants ; et*
- d) *le cas échéant, par les recettes prévues à l'article 146.]*

*Artikel 37*²³

Finanzierung des Haushalts

Der Haushalt der Organisation wird finanziert:

- a) durch eigene Mittel der Organisation;
- b) durch Zahlungen der Vertragsstaaten auf Grund der für die Aufrechterhaltung der europäischen Patente in diesen Staaten erhobenen Gebühren;
- c) erforderlichenfalls durch besondere Finanzbeiträge der Vertragsstaaten;
- d) gegebenenfalls durch die in Artikel 146 vorgesehenen Einnahmen;
- e) gegebenenfalls und ausschließlich für Sachanlagen durch bei Dritten aufgenommene und durch Grundstücke oder Gebäude gesicherte Darlehen;
- f) gegebenenfalls durch Drittmittel für bestimmte Projekte.

[Artikel 38

Eigene Mittel der Organisation

Eigene Mittel der Organisation sind das Aufkommen an Gebühren, die in diesem Übereinkommen vorgesehen sind, sowie alle sonstigen Einnahmen.]

*Artikel 38*²⁴

Eigene Mittel der Organisation

Eigene Mittel der Organisation sind:

- a) alle Einnahmen aus Gebühren und sonstigen Quellen sowie Rücklagen der Organisation;
- b) die Mittel des Pensionsreservefonds, der als zweckgebundenes Sondervermögen der Organisation zur Sicherung ihres Versorgungssystems durch die Bildung angemessener Rücklagen dient.

*Article 37*²³

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;
- (e) where appropriate, and for tangible assets only, by third-party borrowings secured on land or buildings;
- (f) where appropriate, by third-party funding for specific projects.

[Article 38

The Organisation's own resources

The Organisation's own resources shall be the yield from the fees laid down in this Convention, and also all receipts, whatever their nature.]

*Article 38*²⁴

The Organisation's own resources

The Organisation's own resources shall comprise:

- (a) all income from fees and other sources and also the reserves of the Organisation;
- (b) the resources of the Pension Reserve Fund, which shall be treated as a special class of asset of the Organisation, designed to support the Organisation's pension scheme by providing the appropriate reserves.

²³ Geändert durch die Akte zur Revision des Europäischen Patentübereinkommens vom 29.11.2000, vorläufig anwendbar ab 29.11.2000 (ABl. EPA 2001, Sonderausgabe Nr. 4).

²⁴ Geändert durch die Akte zur Revision des Europäischen Patentübereinkommens vom 29.11.2000, vorläufig anwendbar ab 29.11.2000 (ABl. EPA 2001, Sonderausgabe Nr. 4).

²³ Amended by the Act revising the European Patent Convention of 29.11.2000, provisionally applicable as of 29.11.2000 (OJ EPO 2001, Special edition No. 4).

²⁴ Amended by the Act revising the European Patent Convention of 29.11.2000, provisionally applicable as of 29.11.2000 (OJ EPO 2001, Special edition No. 4).

Financement du budget

Le budget de l'Organisation est financé :

- a) par les ressources propres de l'Organisation ;
- b) par les versements des Etats contractants au titre des taxes de maintien en vigueur des brevets européens perçues dans ces Etats ;
- c) si nécessaire, par des contributions financières exceptionnelles des Etats contractants ;
- d) le cas échéant, par les recettes prévues à l'article 146 ;
- e) le cas échéant et exclusivement pour les immobilisations corporelles, par des emprunts contractés auprès de tiers et garantis par des terrains ou des bâtiments ;
- f) le cas échéant, par des fonds provenant de tiers pour des projets spécifiques.

[Article 38

Ressources propres de l'Organisation

Art. 40

Les ressources propres de l'Organisation sont constituées par le produit des taxes prévues dans la présente convention ainsi que par les autres recettes de toute nature.]

Article 38²⁴

Ressources propres de l'Organisation

Les ressources propres de l'Organisation comprennent :

- a) toutes les recettes provenant des taxes et d'autres sources ainsi que des réserves de l'Organisation ;
- b) les ressources du Fonds de réserve pour pensions, qui doit être considéré comme un patrimoine spécial de l'Organisation servant à assister son régime de pensions par la constitution de réserves appropriées.

²³ Modifié par l'acte portant révision de la Convention sur le brevet européen en date du 29.11.2000, applicable à titre provisoire à partir du 29.11.2000 (JO OEB 2001, édition spéciale n° 4).

²⁴ Modifié par l'acte portant révision de la Convention sur le brevet européen en date du 29.11.2000, applicable à titre provisoire à partir du 29.11.2000 (JO OEB 2001, édition spéciale n° 4).

Artikel 39

Zahlungen der Vertragsstaaten auf Grund der für die Aufrechterhaltung der europäischen Patente erhobenen Gebühren

(1)²⁵ Jeder Vertragsstaat zahlt an die Organisation für jedes in diesem Staat aufrechterhaltene europäische Patent einen Betrag in Höhe eines vom Verwaltungsrat festzusetzenden Anteils an der Jahresgebühr, der 75 % nicht übersteigen darf und für alle Vertragsstaaten gleich ist. Liegt der Betrag unter einem vom Verwaltungsrat festgesetzten einheitlichen Mindestbetrag, so hat der betreffende Vertragsstaat der Organisation diesen Mindestbetrag zu zahlen.

(2) Jeder Vertragsstaat teilt der Organisation alle Angaben mit, die der Verwaltungsrat für die Feststellung der Höhe dieser Zahlungen für notwendig erachtet.

(3) Die Fälligkeit der Zahlung wird vom Verwaltungsrat festgelegt.

(4) Sind die genannten Zahlungen nicht fristgerecht in voller Höhe geleistet worden, so hat der Vertragsstaat den ausstehenden Betrag vom Fälligkeitstag an zu verzinsen.

Artikel 40

Bemessung der Gebühren und Anteile - besondere Finanzbeiträge

(1) Die Höhe der Gebühren nach Artikel 38 und der Anteil nach Artikel 39 sind so zu bemessen, dass die Einnahmen hieraus den Ausgleich des Haushalts der Organisation gewährleisten.

(2) Ist die Organisation jedoch nicht in der Lage, den Haushaltsplan nach Maßgabe des Absatzes 1 auszugleichen, so zahlen die Vertragsstaaten der Organisation besondere Finanzbeiträge, deren Höhe der Verwaltungsrat für das betreffende Haushaltsjahr festsetzt.

(3) Die besonderen Finanzbeiträge werden für jeden Vertragsstaat auf der Grundlage der Anzahl der Patentanmeldungen des vorletzten Jahrs vor dem Inkrafttreten dieses Übereinkommens nach folgendem Aufbringungsschlüssel festgelegt:

a) zur Hälfte im Verhältnis der Zahl der in dem jeweiligen Vertragsstaat eingereichten Patentanmeldungen;

Article 39

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

(1)²⁵ 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 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) 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.

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

(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.

Article 40

Level of fees and payments - Special financial contributions

(1) The amounts of the fees referred to under Article 38 and the proportion referred to under Article 39 shall be fixed at such a level as to ensure that the revenue in respect thereof is sufficient for the budget of the Organisation to be balanced.

(2) However, if the Organisation is unable to balance its budget under the conditions laid down in paragraph 1, the Contracting States shall remit to the Organisation special financial contributions, the amount of which shall be determined by the Administrative Council for the accounting period in question.

(3) These special financial contributions shall be determined in respect of any Contracting State on the basis of the number of patent applications filed in the last year but one prior to that of entry into force of this Convention, and calculated in the following manner:

(a) one half in proportion to the number of patent applications filed in that Contracting State;

²⁵ Siehe hierzu den Beschluss des Verwaltungsrats vom 08.06.1984 über den an die EPO zu zahlenden Anteil der Jahresgebühren für europäische Patente (ABI. EPA 1984, 296).

²⁵ See decision of the Administrative Council of 08.06.1984 on the proportion of renewal fees for European patents to be remitted to the EPO (OJ EPO 1984, 296).

Article 39

Verweisungen / References / Références

Versements des Etats contractants au titre des taxes de maintien en vigueur des brevets européens

Art. 35, 40, 41, 47, 50, 141, 146, 147, 161, 176

(1)²⁵ Chaque Etat contractant verse à l'Organisation, au titre de chaque taxe perçue pour le maintien en vigueur d'un brevet européen dans cet Etat, une somme dont le montant correspond à un pourcentage de cette taxe, à fixer par le Conseil d'administration, qui ne peut excéder 75 % et est uniforme pour tous les Etats contractants. Si ledit pourcentage correspond à un montant inférieur au minimum uniforme fixé par le Conseil d'administration, l'Etat contractant verse ce minimum à l'Organisation.

(2) Chaque Etat contractant communique à l'Organisation tous les éléments jugés nécessaires par le Conseil d'administration pour déterminer le montant de ces versements.

(3) La date à laquelle les versements doivent être effectués est fixée par le Conseil d'administration.

(4) Si un versement n'est pas intégralement effectué à la date fixée, l'Etat contractant est redevable, à compter de cette date, d'un intérêt sur le montant impayé.

Article 40

Niveau des taxes et des versements - Contributions financières exceptionnelles

Art. 35, 36, 47, 50, 161, 170, 176

(1) Le montant des taxes et le pourcentage, visés respectivement aux articles 38 et 39, doivent être déterminés de manière que les recettes correspondantes permettent d'assurer l'équilibre du budget de l'Organisation.

(2) Toutefois, lorsque l'Organisation se trouve dans l'impossibilité de réaliser l'équilibre du budget dans les conditions prévues au paragraphe 1, les Etats contractants versent à l'Organisation des contributions financières exceptionnelles, dont le montant est fixé par le Conseil d'administration pour l'exercice budgétaire considéré.

(3) Les contributions financières exceptionnelles sont déterminées pour chacun des Etats contractants par référence au nombre des demandes de brevet déposées au cours de l'avant-dernière année précédant celle de l'entrée en vigueur de la présente convention et selon la clé de répartition ci-après :

a) pour moitié, proportionnellement au nombre des demandes de brevet déposées dans l'Etat contractant concerné ;

²⁵ Cf. la décision du Conseil d'administration du 08.06.1984 relative au pourcentage à reverser à l'OEB au titre des taxes de maintien en vigueur des brevets européens (JO OEB 1984, 296).

b) zur Hälfte im Verhältnis der zweithöchsten Zahl von Patentanmeldungen, die von natürlichen oder juristischen Personen mit Wohnsitz oder Sitz in dem jeweiligen Vertragsstaat in den anderen Vertragsstaaten eingereicht worden sind.

Die Beträge, die von den Staaten zu tragen sind, in denen mehr als 25 000 Patentanmeldungen eingereicht worden sind, werden jedoch zusammengefasst und erneut im Verhältnis der Gesamtzahl der in diesen Staaten eingereichten Patentanmeldungen aufgeteilt.

(4) Kann für einen Vertragsstaat ein Beteiligungssatz nicht nach Absatz 3 ermittelt werden, so legt ihn der Verwaltungsrat im Einvernehmen mit diesem Staat fest.

(5) Artikel 39 Absätze 3 und 4 ist auf die besonderen Finanzbeiträge entsprechend anzuwenden.

(6) Die besonderen Finanzbeiträge werden mit Zinsen zu einem Satz zurückgezahlt, der für alle Vertragsstaaten einheitlich ist. Die Rückzahlungen erfolgen, soweit zu diesem Zweck Mittel im Haushaltsplan bereitgestellt werden können; der bereitgestellte Betrag wird nach dem in den Absätzen 3 und 4 vorgesehenen Aufbringungs Schlüssel auf die Vertragsstaaten verteilt.

(7) Die in einem bestimmten Haushaltsjahr gezahlten besonderen Finanzbeiträge müssen in vollem Umfang zurückgezahlt sein, bevor in einem späteren Haushaltsjahr gezahlte besondere Finanzbeiträge ganz oder teilweise zurückgezahlt werden.

Artikel 41

Vorschüsse

(1) Die Vertragsstaaten gewähren der Organisation auf Antrag des Präsidenten des Europäischen Patentamts Vorschüsse auf ihre Zahlungen und Beiträge in der vom Verwaltungsrat festgesetzten Höhe. Diese Vorschüsse werden auf die Vertragsstaaten im Verhältnis der Beträge, die von diesen Staaten für das betreffende Haushaltsjahr zu zahlen sind, aufgeteilt.

(2) Artikel 39 Absätze 3 und 4 ist auf die Vorschüsse entsprechend anzuwenden.

[Artikel 42

Haushaltsplan

(1) *Alle Einnahmen und Ausgaben der Organisation werden für jedes Haushaltsjahr veranschlagt und in den Haushaltsplan eingesetzt. Falls erforderlich, können Berichtigungs- und Nachtragshaushaltspläne festgelegt werden.*

(b) one half in proportion to the second highest number of patent applications filed in the other Contracting States by natural or legal persons having their residence or principal place of business in that Contracting State.

However, the amounts to be contributed by States in which the number of patent applications filed exceeds 25 000 shall then be taken as a whole and a new scale drawn up determined in proportion to the total number of patent applications filed in these States.

(4) Where, in respect of any Contracting State, its scale position cannot be established in accordance with paragraph 3, the Administrative Council shall, with the consent of that State, decide its scale position.

(5) Article 39, paragraphs 3 and 4, shall apply mutatis mutandis to the special financial contributions.

(6) The special financial contributions shall be repaid together with interest at a rate which shall be the same for all Contracting States. Repayments shall be made in so far as it is possible to provide for this purpose in the budget; the amount thus provided shall be distributed among the Contracting States in accordance with the scale mentioned in paragraphs 3 and 4 above.

(7) The special financial contributions remitted in any accounting period shall be wholly repaid before any such contributions or parts thereof remitted in any subsequent accounting period are repaid.

Article 41

Advances

(1) At the request of the President of the European Patent Office, the Contracting States shall make advances to the Organisation, on account of their payments and contributions, within the limit of the amount fixed by the Administrative Council. Such advances shall be apportioned in proportion to the amounts due by the Contracting States for the accounting period in question.

(2) Article 39, paragraphs 3 and 4, shall apply mutatis mutandis to the advances.

[Article 42

Budget

(1) *Income and expenditure of the Organisation shall form the subject of estimates in respect of each accounting period and shall be shown in the budget. If necessary, there may be amending or supplementary budgets.*

b) pour moitié, proportionnellement au nombre des demandes de brevet déposées par les personnes physiques et morales ayant leur domicile ou leur siège sur le territoire de cet Etat dans celui des autres Etats contractants placé en seconde position, dans l'ordre décroissant des dépôts effectués par lesdites personnes dans les autres Etats contractants.

Toutefois, les sommes mises à la charge des Etats dans lesquels le nombre des demandes de brevet déposées est supérieur à 25 000 sont reprises globalement et réparties à nouveau proportionnellement au nombre total des demandes de brevet déposées dans ces mêmes Etats.

(4) Lorsque le montant de la contribution d'un Etat contractant ne peut être déterminé dans les conditions visées au paragraphe 3, le Conseil d'administration fixe ce montant en accord avec l'Etat intéressé.

(5) Les dispositions de l'article 39, paragraphes 3 et 4, sont applicables aux contributions financières exceptionnelles.

(6) Les contributions financières exceptionnelles sont remboursées avec un intérêt dont le taux est uniforme pour tous les Etats contractants. Les remboursements interviennent dans la mesure où il est possible de prévoir des crédits à cet effet dans le budget et le montant ainsi prévu sera réparti entre les Etats contractants en fonction de la clé de répartition mentionnée aux paragraphes 3 et 4 du présent article.

(7) Les contributions financières exceptionnelles versées au cours d'un exercice déterminé sont intégralement remboursées avant qu'il ne soit procédé au remboursement total ou partiel de toute contribution exceptionnelle versée au cours d'un exercice ultérieur.

Article 41

Avances

Art. 50, 146

(1) Sur demande du Président de l'Office européen des brevets, les Etats contractants consentent à l'Organisation des avances de trésorerie, à valoir sur leurs versements et contributions, dans la limite du montant fixé par le Conseil d'administration. Ces avances sont réparties au prorata des sommes dues par les Etats contractants pour l'exercice considéré.

(2) Les dispositions de l'article 39, paragraphes 3 et 4, sont applicables aux avances.

[Article 42

Budget

(1) *Toutes les recettes et dépenses de l'Organisation doivent faire l'objet de prévisions pour chaque exercice budgétaire et être inscrites au budget. En tant que de besoin, des budgets modificatifs ou additionnels peuvent être établis.*

(2) Der Haushaltsplan ist in Einnahmen und Ausgaben auszugleichen.

(3) Der Haushaltsplan wird in der Rechnungseinheit aufgestellt, die in der Finanzordnung bestimmt wird.]

*Artikel 42*²⁶

Haushaltsplan

(1) Der Haushaltsplan der Organisation ist auszugleichen. Er wird nach Maßgabe der in der Finanzordnung festgelegten allgemein anerkannten Rechnungslegungsgrundsätze aufgestellt. Falls erforderlich, können Berichtigungs- und Nachtragshaushaltspläne festgestellt werden.

(2) Der Haushaltsplan wird in der Rechnungseinheit aufgestellt, die in der Finanzordnung bestimmt wird.

Artikel 43

Bewilligung der Ausgaben

(1) Die in den Haushaltsplan eingesetzten Ausgaben werden für ein Haushaltsjahr bewilligt, soweit die Finanzordnung nichts anderes bestimmt.

(2) Nach Maßgabe der Finanzordnung dürfen Mittel, die bis zum Ende eines Haushaltsjahrs nicht verbraucht worden sind, lediglich auf das nächste Haushaltsjahr übertragen werden; eine Übertragung von Mitteln, die für personelle Ausgaben vorgesehen sind, ist nicht zulässig.

(3) Die vorgesehenen Mittel werden nach Kapiteln gegliedert, in denen die Ausgaben nach Art oder Bestimmung zusammengefasst sind; soweit erforderlich, werden die Kapitel nach der Finanzordnung unterteilt.

Artikel 44

Mittel für unvorhergesehene Ausgaben

(1) Im Haushaltsplan der Organisation können Mittel für unvorhergesehene Ausgaben veranschlagt werden.

(2) Die Verwendung dieser Mittel durch die Organisation setzt die vorherige Zustimmung des Verwaltungsrats voraus.

Artikel 45

Haushaltsjahr

Das Haushaltsjahr beginnt am 1. Januar und endet am 31. Dezember.

(2) The budget shall be balanced as between income and expenditure.

(3) The budget shall be drawn up in the unit of account fixed in the Financial Regulations.]

*Article 42*²⁶

Budget

(1) The budget of the Organisation shall be balanced. It shall be drawn up in accordance with the generally accepted accounting principles laid down in the Financial Regulations. If necessary, there may be amending or supplementary budgets.

(2) The budget shall be drawn up in the unit of account fixed in the Financial Regulations.

Article 43

Authorisation for expenditure

(1) The expenditure entered in the budget shall be authorised for the duration of one accounting period, unless any provisions to the contrary are contained in the Financial Regulations.

(2) Subject to the conditions to be laid down in the Financial Regulations, any appropriations, other than those relating to staff costs, which are unexpended at the end of the accounting period may be carried forward, but not beyond the end of the following accounting period.

(3) Appropriations shall be set out under different headings according to type and purpose of the expenditure and subdivided, as far as necessary, in accordance with the Financial Regulations.

Article 44

Appropriations for unforeseeable expenditure

(1) The budget of the Organisation may contain appropriations for unforeseeable expenditure.

(2) The employment of these appropriations by the Organisation shall be subject to the prior approval of the Administrative Council.

Article 45

Accounting period

The accounting period shall commence on 1 January and end on 31 December.

²⁶ Geändert durch die Akte zur Revision des Europäischen Patentübereinkommens vom 29.11.2000, vorläufig anwendbar ab 29.11.2000 (ABl. EPA 2001, Sonderausgabe Nr. 4).

²⁶ Amended by the Act revising the European Patent Convention of 29.11.2000, provisionally applicable as of 29.11.2000 (OJ EPO 2001, Special edition No. 4).

(2) *Le budget doit être équilibré en recettes et en dépenses.*

Verweisungen / References / Références

(3) *Le budget est établi dans l'unité de compte fixée par le règlement financier.]*

*Article 42*²⁶

Budget

(1) Le budget de l'Organisation doit être équilibré. Il est établi selon les principes comptables généralement admis, tels que définis au règlement financier. En tant que de besoin, des budgets modificatifs ou additionnels peuvent être établis.

(2) Le budget est établi dans l'unité de compte fixée par le règlement financier.

Article 43

Autorisations de dépenses

(1) Les dépenses inscrites au budget sont autorisées pour la durée de l'exercice budgétaire, sauf dispositions contraires du règlement financier.

(2) Dans les conditions qui seront déterminées par le règlement financier, les crédits qui ne sont pas utilisés à la fin de l'exercice budgétaire, à l'exception de ceux relatifs aux dépenses de personnel, peuvent faire l'objet d'un report qui sera limité au seul exercice suivant.

(3) Les crédits sont spécialisés par chapitres groupant les dépenses selon leur nature ou leur destination et subdivisés, en tant que de besoin, conformément au règlement financier.

Article 44

Crédits pour dépenses imprévisibles

(1) Des crédits pour dépenses imprévisibles peuvent être inscrits au budget de l'Organisation.

(2) L'utilisation de ces crédits par l'Organisation est subordonnée à l'autorisation préalable du Conseil d'administration.

Article 45

Exercice budgétaire

L'exercice budgétaire commence le 1^{er} janvier et s'achève le 31 décembre.

²⁶ Modifié par l'acte portant révision de la Convention sur le brevet européen en date du 29.11.2000, applicable à titre provisoire à partir du 29.11.2000 (JO OEB 2001, édition spéciale n° 4).

Artikel 46

Entwurf und Feststellung des Haushaltsplans

(1) Der Präsident des Europäischen Patentamts legt dem Verwaltungsrat den Entwurf des Haushaltsplans bis zu dem in der Finanzordnung vorgeschriebenen Zeitpunkt vor.

(2) Der Haushaltsplan sowie Berichtigungs- und Nachtragshaushaltspläne werden vom Verwaltungsrat festgestellt.

Artikel 47

Vorläufige Haushaltsführung

(1) Ist zu Beginn eines Haushaltsjahrs der Haushaltsplan vom Verwaltungsrat noch nicht festgestellt, so können nach der Finanzordnung für jedes Kapitel oder jede sonstige Untergliederung monatliche Ausgaben bis zur Höhe eines Zwölftels der im Haushaltsplan für das vorausgegangene Haushaltsjahr bereitgestellten Mittel vorgenommen werden; der Präsident des Europäischen Patentamts darf jedoch höchstens über ein Zwölftel der Mittel verfügen, die in dem Entwurf des Haushaltsplans vorgesehen sind.

(2) Der Verwaltungsrat kann unter Beachtung der sonstigen Vorschriften des Absatzes 1 Ausgaben genehmigen, die über dieses Zwölftel hinausgehen.

(3) Die in Artikel 37 Buchstabe b genannten Zahlungen werden einstweilen weiter nach Maßgabe der Bedingungen geleistet, die nach Artikel 39 für das vorausgegangene Haushaltsjahr festgelegt worden sind.

(4) Jeden Monat zahlen die Vertragsstaaten einstweilen nach dem in Artikel 40 Absätze 3 und 4 festgelegten Aufbringungsschlüssel besondere Finanzbeiträge, sofern dies notwendig ist, um die Durchführung der Absätze 1 und 2 zu gewährleisten. Artikel 39 Absatz 4 ist auf diese Beiträge entsprechend anzuwenden.

Artikel 48

Ausführung des Haushaltsplans

(1) Im Rahmen der zugewiesenen Mittel führt der Präsident des Europäischen Patentamts den Haushaltsplan sowie Berichtigungs- und Nachtragshaushaltspläne in eigener Verantwortung aus.

(2) Der Präsident des Europäischen Patentamts kann im Rahmen des Haushaltsplans nach Maßgabe der Finanzordnung Mittel von Kapitel zu Kapitel oder von Untergliederung zu Untergliederung übertragen.

Article 46

Preparation and adoption of the budget

(1) The President of the European Patent Office shall lay the draft budget before the Administrative Council not later than the date prescribed in the Financial Regulations.

(2) The budget and any amending or supplementary budget shall be adopted by the Administrative Council.

Article 47

Provisional budget

(1) If, at the beginning of the accounting period, the budget has not been adopted by the Administrative Council, expenditures may be effected on a monthly basis per heading or other division of the budget, according to the provisions of the Financial Regulations, up to one-twelfth of the budget appropriations for the preceding accounting period, provided that the appropriations thus made available to the President of the European Patent Office shall not exceed one-twelfth of those provided for in the draft budget.

(2) The Administrative Council may, subject to the observance of the other provisions laid down in paragraph 1, authorise expenditure in excess of one-twelfth of the appropriations.

(3) The payments referred to in Article 37, subparagraph (b), shall continue to be made, on a provisional basis, under the conditions determined under Article 39 for the year preceding that to which the draft budget relates.

(4) The Contracting States shall pay each month, on a provisional basis and in accordance with the scale referred to in Article 40, paragraphs 3 and 4, any special financial contributions necessary to ensure implementation of paragraphs 1 and 2 above. Article 39, paragraph 4, shall apply *mutatis mutandis* to these contributions.

Article 48

Budget implementation

(1) The President of the European Patent Office shall implement the budget and any amending or supplementary budget on his own responsibility and within the limits of the allocated appropriations.

(2) Within the budget, the President of the European Patent Office may, subject to the limits and conditions laid down in the Financial Regulations, transfer funds as between the various headings or sub-headings.

Article 46

Préparation et adoption du budget

- (1) Le Président de l'Office européen des brevets saisit le Conseil d'administration du projet de budget, au plus tard à la date fixée par le règlement financier.
- (2) Le budget, ainsi que tout budget modificatif ou additionnel, sont arrêtés par le Conseil d'administration.

Verweisungen / References / Références

Art. 35

Article 47

Budget provisoire

- (1) Si, au début d'un exercice budgétaire, le budget n'a pas encore été arrêté par le Conseil d'administration, les dépenses pourront être effectuées mensuellement par chapitre ou par une autre division, d'après les dispositions du règlement financier, dans la limite du douzième des crédits ouverts au budget de l'exercice précédent, sans que cette mesure puisse avoir pour effet de mettre à la disposition du Président de l'Office européen des brevets des crédits supérieurs au douzième de ceux prévus dans le projet de budget.
- (2) Le Conseil d'administration peut, sous réserve que les autres conditions fixées au paragraphe premier soient respectées, autoriser les dépenses excédant le douzième.
- (3) A titre provisionnel, les versements visés à l'article 37, lettre b) continueront à être effectués dans les conditions fixées par l'article 39 pour l'exercice précédant celui auquel se rapporte le projet de budget.
- (4) Les Etats contractants versent chaque mois, à titre provisionnel et conformément à la clé de répartition mentionnée à l'article 40, paragraphes 3 et 4, toutes contributions financières spéciales nécessaires en vue d'assurer l'application des paragraphes 1 et 2 du présent article. L'article 39, paragraphe 4 est applicable à ces contributions.

Art. 59, 146

Article 48

Exécution du budget

- (1) Le Président de l'Office européen des brevets exécute le budget ainsi que les budgets modificatifs ou additionnels, sous sa propre responsabilité et dans la limite des crédits alloués.
- (2) A l'intérieur du budget, le Président de l'Office européen des brevets peut procéder, dans les limites et conditions fixées par le règlement financier, à des virements de crédits, soit de chapitre à chapitre, soit de subdivision à subdivision.

Artikel 49

Rechnungsprüfung

(1) Die Rechnung über alle Einnahmen und Ausgaben des Haushaltsplans sowie eine Übersicht über das Vermögen und die Schulden der Organisation werden von Rechnungsprüfern geprüft, die volle Gewähr für ihre Unabhängigkeit bieten müssen und vom Verwaltungsrat für einen Zeitraum von fünf Jahren bestellt werden; die Bestellung kann verlängert oder erneuert werden.

(2) Durch die Prüfung, die anhand der Rechnungsunterlagen und erforderlichenfalls an Ort und Stelle erfolgt, wird die Rechtmäßigkeit und Ordnungsmäßigkeit der Einnahmen und Ausgaben sowie die Wirtschaftlichkeit der Haushaltsführung festgestellt. Nach Abschluss eines jeden Haushaltsjahrs erstatten die Rechnungsprüfer einen Bericht.

(3) Der Präsident des Europäischen Patentamts legt dem Verwaltungsrat jährlich die Rechnungen des abgelaufenen Haushaltsjahrs für die Rechnungsvorgänge des Haushaltsplans und die Übersicht über das Vermögen und die Schulden zusammen mit dem Bericht der Rechnungsprüfer vor.

(4) Der Verwaltungsrat genehmigt die Jahresrechnung sowie den Bericht der Rechnungsprüfer und erteilt dem Präsidenten des Europäischen Patentamts Entlastung hinsichtlich der Ausführung des Haushaltsplans.

[Artikel 50

Finanzordnung

Die Finanzordnung bestimmt insbesondere:

- a) *die Art und Weise der Aufstellung und Ausführung des Haushaltsplans sowie der Rechnungslegung und Rechnungsprüfung;*
- b) *die Art und Weise sowie das Verfahren, nach denen die in Artikel 37 vorgesehenen Zahlungen und Beiträge sowie die in Artikel 41 vorgesehenen Vorschüsse von den Vertragsstaaten der Organisation zur Verfügung zu stellen sind;*
- c) *die Vorschriften über die Verantwortung der Anweisungsbefugten und der Rechnungsführer sowie die entsprechenden Kontrollmaßnahmen;*
- d) *die Sätze der in den Artikeln 39, 40 und 47 vorgesehenen Zinsen;*
- e) *die Art und Weise der Berechnung der nach Artikel 146 zu leistenden Beiträge;*
- f) *Zusammensetzung und Aufgaben eines Haushalts- und Finanzausschusses, der vom Verwaltungsrat eingesetzt werden soll.]*

Article 49

Auditing of accounts

(1) The income and expenditure account and a balance sheet of the Organisation shall be examined by auditors whose independence is beyond doubt, appointed by the Administrative Council for a period of five years, which shall be renewable or extensible.

(2) The audit, which shall be based on vouchers and shall take place, if necessary, in situ, shall ascertain that all income has been received and all expenditure effected in a lawful and proper manner and that the financial management is sound. The auditors shall draw up a report after the end of each accounting period.

(3) The President of the European Patent Office shall annually submit to the Administrative Council the accounts of the preceding accounting period in respect of the budget and the balance sheet showing the assets and liabilities of the Organisation together with the report of the auditors.

(4) The Administrative Council shall approve the annual accounts together with the report of the auditors and shall give the President of the European Patent Office a discharge in respect of the implementation of the budget.

[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 payable by virtue of Article 146;*
- f) *the composition of and duties to be assigned to a Budget and Finance Committee which should be set up by the Administrative Council.]*

Vérification des comptes

- (1) Les comptes de la totalité des recettes et dépenses du budget, ainsi que le bilan de l'Organisation, sont examinés par des commissaires aux comptes offrant toutes les garanties d'indépendance, nommés par le Conseil d'administration pour une période de cinq ans qui peut être prolongée ou renouvelée.
- (2) La vérification, qui a lieu sur pièces, et au besoin sur place, a pour objet de constater la légalité et la régularité des recettes et dépenses et de s'assurer de la bonne gestion financière. Les commissaires établissent un rapport après la clôture de chaque exercice.
- (3) Le Président de l'Office européen des brevets soumet chaque année au Conseil d'administration les comptes de l'exercice écoulé afférents aux opérations du budget, ainsi que le bilan de l'actif et du passif de l'Organisation, accompagnés du rapport des commissaires aux comptes.
- (4) Le Conseil d'administration approuve le bilan annuel ainsi que le rapport des commissaires aux comptes et donne décharge au Président de l'Office européen des brevets pour l'exécution du budget.

*[Article 50**Règlement financier*

Le règlement financier détermine notamment :

- a) les modalités relatives à l'établissement et à l'exécution du budget ainsi qu'à la reddition et à la vérification des comptes ;*
- b) les modalités et la procédure selon lesquelles les versements et contributions prévus à l'article 37, ainsi que les avances prévues à l'article 41, doivent être mis à la disposition de l'Organisation par les Etats contractants ;*
- c) les règles et l'organisation du contrôle et la responsabilité des ordonnateurs et comptables ;*
- d) les taux d'intérêts prévus aux articles 39, 40 et 47 ;*
- e) les modalités de calcul des contributions à verser au titre de l'article 146 ;*
- f) la composition et les tâches d'une commission du budget et des finances qui devrait être instituée par le Conseil d'administration.]*

*Artikel 50*²⁷

Finanzordnung

Die Finanzordnung regelt insbesondere:

- a) die Art und Weise der Aufstellung und Ausführung des Haushaltsplans sowie der Rechnungslegung und Rechnungsprüfung;
- b) die Art und Weise sowie das Verfahren, wie die in Artikel 37 vorgesehenen Zahlungen und Beiträge sowie die in Artikel 41 vorgesehenen Vorschüsse von den Vertragsstaaten der Organisation zur Verfügung zu stellen sind;
- c) die Verantwortung der Anweisungsbefugten und der Rechnungsführer sowie die entsprechenden Kontrollmaßnahmen;
- d) die Sätze der in den Artikeln 39, 40 und 47 vorgesehenen Zinsen;
- e) die Art und Weise der Berechnung der nach Artikel 146 zu leistenden Beiträge;
- f) Zusammensetzung und Aufgaben eines Haushalts- und Finanzausschusses, der vom Verwaltungsrat eingesetzt werden soll;
- g) die dem Haushaltsplan und dem Jahresabschluss zu Grunde zu legenden allgemein anerkannten Rechnungslegungsgrundsätze.

Artikel 51

Gebührenordnung

Die Gebührenordnung bestimmt insbesondere die Höhe der Gebühren und die Art und Weise, wie sie zu entrichten sind.

*Article 50*²⁷

Financial Regulations

The Financial Regulations shall lay down in particular:

- (a) the arrangements 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 authorising and accounting 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 payable by virtue of Article 146;
- (f) the composition of and duties to be assigned to a Budget and Finance Committee which should be set up by the Administrative Council;
- (g) the generally accepted accounting principles on which the budget and the annual financial statements shall be based.

Article 51

Rules relating to Fees

The Rules relating to Fees shall determine in particular the amounts of the fees and the ways in which they are to be paid.

²⁷ Geändert durch die Akte zur Revision des Europäischen Patentübereinkommens vom 29.11.2000, vorläufig anwendbar ab 29.11.2000 (ABl. EPA 2001, Sonderausgabe Nr. 4).

²⁷ Amended by the Act revising the European Patent Convention of 29.11.2000, provisionally applicable as of 29.11.2000 (OJ EPO 2001, Special edition No. 4).

Règlement financier

Le règlement financier détermine notamment :

- a) les modalités relatives à l'établissement et à l'exécution du budget ainsi qu'à la reddition et à la vérification des comptes ;
- b) les modalités et la procédure selon lesquelles les versements et contributions prévus à l'article 37, ainsi que les avances prévues à l'article 41, doivent être mis à la disposition de l'Organisation par les Etats contractants ;
- c) les règles et l'organisation du contrôle et la responsabilité des ordonnateurs et comptables ;
- d) les taux d'intérêts prévus aux articles 39, 40 et 47 ;
- e) les modalités de calcul des contributions à verser au titre de l'article 146 ;
- f) la composition et les tâches d'une commission du budget et des finances qui devrait être instituée par le Conseil d'administration ;
- g) les principes comptables généralement admis sur lesquels se fondent le budget et les états financiers annuels.

Article 51

Règlement relatif aux taxes

Le règlement relatif aux taxes fixe notamment le montant des taxes et leur mode de perception.

²⁷ Modifié par l'acte portant révision de la Convention sur le brevet européen en date du 29.11.2000, applicable à titre provisoire à partir du 29.11.2000 (JO OEB 2001, édition spéciale n° 4).

ZWEITER TEIL

MATERIELLES PATENTRECHT

Kapitel I

Patentierbarkeit

Artikel 52²⁸

Patentfähige Erfindungen

(1) Europäische Patente werden für Erfindungen erteilt, die neu sind, auf einer erfinderischen Tätigkeit beruhen und gewerblich anwendbar sind.

(2) Als Erfindungen im Sinn des Absatzes 1 werden insbesondere nicht angesehen:

- a) Entdeckungen sowie wissenschaftliche Theorien und mathematische Methoden;
- b) ästhetische Formschöpfungen;
- c) Pläne, Regeln und Verfahren für gedankliche Tätigkeiten, für Spiele oder für geschäftliche Tätigkeiten sowie Programme für Datenverarbeitungsanlagen;
- d) die Wiedergabe von Informationen.

(3) Absatz 2 steht der Patentfähigkeit der in dieser Vorschrift genannten Gegenstände oder Tätigkeiten nur insoweit entgegen, als sich die europäische Patentanmeldung oder das europäische Patent auf die genannten Gegenstände oder Tätigkeiten als solche bezieht.

(4) Verfahren zur chirurgischen oder therapeutischen Behandlung des menschlichen oder tierischen Körpers und Diagnostizierverfahren, die am menschlichen oder tierischen Körper vorgenommen werden, gelten nicht als gewerblich anwendbare Erfindungen im Sinn des Absatzes 1. Dies gilt nicht für Erzeugnisse, insbesondere Stoffe oder Stoffgemische, zur Anwendung in einem der vorstehend genannten Verfahren.

Artikel 53²⁹

Ausnahmen von der Patentierbarkeit

Europäische Patente werden nicht erteilt für:

- a) Erfindungen, deren Veröffentlichung oder Verwertung gegen die öffentliche Ordnung oder die guten Sitten verstoßen würde; ein solcher Verstoß kann nicht allein aus der Tatsache hergeleitet werden, dass die Verwertung der Erfindung in allen oder einem Teil der Vertragsstaaten durch Gesetz oder Verwaltungsvorschrift verboten ist;

PART II

SUBSTANTIVE PATENT LAW

Chapter I

Patentability

Article 52²⁸

Patentable inventions

(1) European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.

(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:

- (a) discoveries, scientific theories and mathematical methods;
- (b) aesthetic creations;
- (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- (d) presentations of information.

(3) The provisions of paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.

(4) Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph 1. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

Article 53²⁹

Exceptions to patentability

European patents shall not be granted in respect of:

- (a) inventions the publication or exploitation of which would be contrary to "ordre public" or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States;

²⁸ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 1/83, G 5/83, G 6/83, G 1/98, G 1/03, G 2/03 (Anhang I).

²⁹ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 3/95, G 1/98, G 1/03, G 2/03 (Anhang I).

²⁸ See decisions of the Enlarged Board of Appeal G 1/83, G 5/83, G 6/83, G 1/98, G 1/03, G 2/03 (Annex I).

²⁹ See decisions of the Enlarged Board of Appeal G 3/95, G 1/98, G 1/03, G 2/03 (Annex I).

DEUXIÈME PARTIE

Verweisungen / References / Références

DROIT DES BREVETS

Chapitre I

Brevetabilité

Article 52²⁸

Inventions brevetables

Art. 54, 56, 57, 100, 138

R. 23b/ter, 23c/quater, 23e/sexies

(1) Les brevets européens sont délivrés pour les inventions nouvelles impliquant une activité inventive et susceptibles d'application industrielle.

(2) Ne sont pas considérés comme des inventions au sens du paragraphe 1 notamment :

a) les découvertes ainsi que les théories scientifiques et les méthodes mathématiques ;

b) les créations esthétiques ;

c) les plans, principes et méthodes dans l'exercice d'activités intellectuelles, en matière de jeu ou dans le domaine des activités économiques, ainsi que les programmes d'ordinateurs ;

d) les présentations d'informations.

(3) Les dispositions du paragraphe 2 n'excluent la brevetabilité des éléments énumérés auxdites dispositions que dans la mesure où la demande de brevet européen ou le brevet européen ne concerne que l'un de ces éléments, considéré en tant que tel.

(4) Ne sont pas considérées comme des inventions susceptibles d'application industrielle au sens du paragraphe 1, les méthodes de traitement chirurgical ou thérapeutique du corps humain ou animal et les méthodes de diagnostic appliquées au corps humain ou animal. Cette disposition ne s'applique pas aux produits, notamment aux substances ou compositions, pour la mise en oeuvre d'une de ces méthodes.

Article 53²⁹

Exceptions à la brevetabilité

Art. 100, 138, 167

R. 23d/quinquies, 23e/sexies

Les brevets européens ne sont pas délivrés pour :

a) les inventions dont la publication ou la mise en oeuvre serait contraire à l'ordre public ou aux bonnes moeurs, la mise en oeuvre d'une invention ne pouvant être considérée comme telle du seul fait qu'elle est interdite, dans tous les Etats contractants ou dans l'un ou plusieurs d'entre eux, par une disposition légale ou réglementaire ;

²⁸ Cf. les décisions de la Grande Chambre de recours G 1/83, G 5/83, G 6/83, G 1/98, G 1/03, G 2/03 (Annexe I).

²⁹ Cf. les décisions de la Grande Chambre de recours G 3/95, G 1/98, G 1/03, G 2/03 (Annexe I).

b) Pflanzensorten oder Tierarten sowie für im Wesentlichen biologische Verfahren zur Züchtung von Pflanzen oder Tieren; diese Vorschrift ist auf mikrobiologische Verfahren und auf die mit Hilfe dieser Verfahren gewonnenen Erzeugnisse nicht anzuwenden.

Artikel 54³⁰

Neuheit

(1) Eine Erfindung gilt als neu, wenn sie nicht zum Stand der Technik gehört.

(2) Den Stand der Technik bildet alles, was vor dem Anmeldetag der europäischen Patentanmeldung der Öffentlichkeit durch schriftliche oder mündliche Beschreibung, durch Benutzung oder in sonstiger Weise zugänglich gemacht worden ist.

(3) Als Stand der Technik gilt auch der Inhalt der europäischen Patentanmeldungen in der ursprünglich eingereichten Fassung, deren Anmeldetag vor dem in Absatz 2 genannten Tag liegt und die erst an oder nach diesem Tag nach Artikel 93 veröffentlicht worden sind.

(4) Absatz 3 ist nur insoweit anzuwenden, als ein für die spätere europäische Patentanmeldung benannter Vertragsstaat auch für die veröffentlichte frühere Anmeldung benannt worden ist.

(5) Gehören Stoffe oder Stoffgemische zum Stand der Technik, so wird ihre Patentfähigkeit durch die Absätze 1 bis 4 nicht ausgeschlossen, sofern sie zur Anwendung in einem der in Artikel 52 Absatz 4 genannten Verfahren bestimmt sind und ihre Anwendung zu einem dieser Verfahren nicht zum Stand der Technik gehört.

Artikel 55

Unschädliche Offenbarungen

(1) Für die Anwendung des Artikels 54 bleibt eine Offenbarung der Erfindung außer Betracht, wenn sie nicht früher als sechs Monate vor Einreichung der europäischen Patentanmeldung erfolgt ist und unmittelbar oder mittelbar zurückgeht:

a)³¹ auf einen offensichtlichen Missbrauch zum Nachteil des Anmelders oder seines Rechtsvorgängers oder

b) auf die Tatsache, dass der Anmelder oder sein Rechtsvorgänger die Erfindung auf amtlichen oder amtlich anerkannten Ausstellungen im Sinn des am 22. November 1928 in Paris unterzeichneten und zuletzt am 30. November 1972 revidierten Übereinkommens über internationale Ausstellungen zur Schau gestellt hat.

³⁰ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 1/83, G 5/83, G 6/83, G 2/88, G 6/88, G 1/92, G 3/93, G 1/98, G 3/98, G 2/98, G 2/99, G 1/03, G 2/03 (Anhang I).

³¹ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 3/98, G 2/99 (Anhang I).

(b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof.

Article 54³⁰

Novelty

(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

(3) Additionally, the content of European patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published under Article 93 on or after that date, shall be considered as comprised in the state of the art.

(4) Paragraph 3 shall be applied only in so far as a Contracting State designated in respect of the later application, was also designated in respect of the earlier application as published.

(5) The provisions of paragraphs 1 to 4 shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Article 52, paragraph 4, provided that its use for any method referred to in that paragraph is not comprised in the state of the art.

Article 55

Non-prejudicial disclosures

(1) For the application of Article 54 a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months preceding the filing of the European patent application and if it was due to, or in consequence of:

(a)³¹ an evident abuse in relation to the applicant or his legal predecessor, or

(b) the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognised, international exhibition falling within the terms of the Convention on international exhibitions signed at Paris on 22 November 1928 and last revised on 30 November 1972.

³⁰ See decisions/opinions of the Enlarged Board of Appeal G 1/83, G 5/83, G 6/83, G 2/88, G 6/88, G 1/92, G 3/93, G 1/98, G 2/98, G 3/98, G 2/99, G 1/03, G 2/03 (Annex I).

³¹ See decisions of the Enlarged Board of Appeal G 3/98, G 2/99 (Annex I).

b) les variétés végétales ou les races animales ainsi que les procédés essentiellement biologiques d'obtention de végétaux ou d'animaux, cette disposition ne s'appliquant pas aux procédés microbiologiques et aux produits obtenus par ces procédés.

Verweisungen / References / Références

*Article 54*³⁰

Nouveauté

Art. 52, 55, 56, 80, 85, 89, 100, 138, 158
R. 27, 44, 87

- (1) Une invention est considérée comme nouvelle si elle n'est pas comprise dans l'état de la technique.
- (2) L'état de la technique est constitué par tout ce qui a été rendu accessible au public avant la date de dépôt de la demande de brevet européen par une description écrite ou orale, un usage ou tout autre moyen.
- (3) Est également considéré comme compris dans l'état de la technique le contenu de demandes de brevet européen telles qu'elles ont été déposées, qui ont une date de dépôt antérieure à celle mentionnée au paragraphe 2 et qui n'ont été publiées, en vertu de l'article 93, qu'à cette date ou qu'à une date postérieure.
- (4) Le paragraphe 3 n'est applicable que dans la mesure où un Etat contractant désigné dans la demande ultérieure l'était également dans la demande antérieure publiée.
- (5) Les dispositions des paragraphes 1 à 4 n'excluent pas la brevetabilité, pour la mise en oeuvre d'une des méthodes visées à l'article 52, paragraphe 4, d'une substance ou composition exposée dans l'état de la technique, à condition que son utilisation pour toute méthode visée audit paragraphe ne soit pas contenue dans l'état de la technique.

Article 55

Divulgations non opposables

Art. 100, 138
R. 23, 107

(1) Pour l'application de l'article 54, une divulgation de l'invention n'est pas prise en considération si elle n'est pas intervenue plus tôt que six mois avant le dépôt de la demande de brevet européen et si elle résulte directement ou indirectement :

- a)³¹ d'un abus évident à l'égard du demandeur ou de son prédécesseur en droit ou
- b) du fait que le demandeur ou son prédécesseur en droit a exposé l'invention dans des expositions officielles ou officiellement reconnues au sens de la Convention concernant les expositions internationales, signée à Paris le 22 novembre 1928 et révisée en dernier lieu le 30 novembre 1972.

³⁰ Cf. les décisions/avis de la Grande Chambre de recours G 1/83, G 5/83, G 6/83, G 2/88, G 6/88, G 1/92, G 3/93, G 1/98, G 2/98, G 3/98, G 2/99, G 1/03, G 2/03 (Annexe I).

³¹ Cf. les décisions de la Grande Chambre de recours G 3/98, G 2/99 (Annexe I).

(2) Im Fall des Absatzes 1 Buchstabe b ist Absatz 1 nur anzuwenden, wenn der Anmelder bei Einreichung der europäischen Patentanmeldung angibt, dass die Erfindung tatsächlich zur Schau gestellt worden ist, und innerhalb der Frist und unter den Bedingungen, die in der Ausführungsordnung vorgeschrieben sind, eine entsprechende Bescheinigung einreicht.

*Artikel 56*³²

Erfinderische Tätigkeit

Eine Erfindung gilt als auf einer erfinderischen Tätigkeit beruhend, wenn sie sich für den Fachmann nicht in nahe liegender Weise aus dem Stand der Technik ergibt. Gehören zum Stand der Technik auch Unterlagen im Sinn des Artikels 54 Absatz 3, so werden diese bei der Beurteilung der erfinderischen Tätigkeit nicht in Betracht gezogen.

*Artikel 57*³³

Gewerbliche Anwendbarkeit

Eine Erfindung gilt als gewerblich anwendbar, wenn ihr Gegenstand auf irgendeinem gewerblichen Gebiet einschließlich der Landwirtschaft hergestellt oder benutzt werden kann.

Kapitel II

Zur Einreichung und Erlangung des europäischen Patents berechnigte Personen - Erfindernennung

*Artikel 58*³⁴

Recht zur Anmeldung europäischer Patente

Jede natürliche oder juristische Person und jede einer juristischen Person nach dem für sie maßgebenden Recht gleichgestellte Gesellschaft kann die Erteilung eines europäischen Patents beantragen.

Artikel 59

Mehrere Anmelder

Die europäische Patentanmeldung kann auch von gemeinsamen Anmeldern oder von mehreren Anmeldern, die verschiedene Vertragsstaaten benennen, eingereicht werden.

(2) In the case of paragraph 1(b), paragraph 1 shall apply only if the applicant states, when filing the European patent application, that the invention has been so displayed and files a supporting certificate within the period and under the conditions laid down in the Implementing Regulations.

*Article 56*³²

Inventive step

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 54, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

*Article 57*³³

Industrial application

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

Chapter II

Persons entitled to apply for and obtain European patents - Mention of the inventor

*Article 58*³⁴

Entitlement to file a European patent application

A European patent application may be filed by any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it.

Article 59

Multiple applicants

A European patent application may also be filed either by joint applicants or by two or more applicants designating different Contracting States.

³² Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 3/98, G 2/98, G 2/99, G 1/03, G 2/03 (Anhang I).

³³ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 1/83, G 5/83, G 6/83, G 1/03, G 2/03 (Anhang I).

³⁴ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/99 (Anhang I).

³² See decisions/opinions of the Enlarged Board of Appeal G 2/98, G 3/98, G 2/99, G 1/03, G 2/03 (Annex I).

³³ See decisions of the Enlarged Board of Appeal G 1/83, G 5/83, G 6/83, G 1/03, G 2/03 (Annex I).

³⁴ See decision of the Enlarged Board of Appeal G 3/99 (Annex I).

(2) Dans le cas visé sous la lettre b) du paragraphe 1, ce dernier n'est applicable que si le demandeur déclare, lors du dépôt de la demande, que l'invention a été réellement exposée et produit une attestation à l'appui de sa déclaration dans le délai et dans les conditions prévus par le règlement d'exécution.

Verweisungen / References / Références

*Article 56*³²

Activité inventive

Art. 52, 100, 138
R. 27, 27a/bis, 44

Une invention est considérée comme impliquant une activité inventive si, pour un homme du métier, elle ne découle pas d'une manière évidente de l'état de la technique. Si l'état de la technique comprend des documents visés à l'article 54, paragraphe 3, ils ne sont pas pris en considération pour l'appréciation de l'activité inventive.

*Article 57*³³

Application industrielle

Art. 52, 100, 138
R. 23e/sexies, 27, 27a/bis

Une invention est considérée comme susceptible d'application industrielle si son objet peut être fabriqué ou utilisé dans tout genre d'industrie, y compris l'agriculture.

Chapitre II

Personnes habilitées à demander et à obtenir un brevet européen - Désignation de l'inventeur

*Article 58*³⁴

Habilitation à déposer une demande de brevet européen

Toute personne physique ou morale et toute société, assimilée à une personne morale en vertu du droit dont elle relève, peut demander un brevet européen.

Article 59

Pluralité de demandeurs

Art. 118
R. 26, 52, 100

Une demande de brevet européen peut être également déposée soit par des codemandeurs, soit par plusieurs demandeurs qui désignent des Etats contractants différents.

³² Cf. les décisions/avis de la Grande Chambre de recours G 2/98, G 3/98, G 2/99, G 1/03, G 2/03 (Annexe I).

³³ Cf. les décisions de la Grande Chambre de recours G 1/83, G 5/83, G 6/83, G 1/03, G 2/03 (Annexe I).

³⁴ Cf. la décision de la Grande Chambre de recours G 3/99 (Annexe I).

Recht auf das europäische Patent

(1) Das Recht auf das europäische Patent steht dem Erfinder oder seinem Rechtsnachfolger zu. Ist der Erfinder ein Arbeitnehmer, so bestimmt sich das Recht auf das europäische Patent nach dem Recht des Staats, in dem der Arbeitnehmer überwiegend beschäftigt ist; ist nicht festzustellen, in welchem Staat der Arbeitnehmer überwiegend beschäftigt ist, so ist das Recht des Staats anzuwenden, in dem der Arbeitgeber den Betrieb unterhält, dem der Arbeitnehmer angehört.

(2) Haben mehrere eine Erfindung unabhängig voneinander gemacht, so steht das Recht auf das europäische Patent demjenigen zu, dessen europäische Patentanmeldung den früheren Anmeldetag hat; dies gilt jedoch nur, wenn diese frühere Anmeldung nach Artikel 93 veröffentlicht worden ist, und nur mit Wirkung für die in der veröffentlichten früheren Anmeldung benannten Vertragsstaaten.

(3) Im Verfahren vor dem Europäischen Patentamt gilt der Anmelder als berechtigt, das Recht auf das europäische Patent geltend zu machen.

Anmeldung europäischer Patente durch Nichtberechtigte

(1) Wird durch rechtskräftige Entscheidung der Anspruch auf Erteilung eines europäischen Patents einer in Artikel 60 Absatz 1 genannten Person, die nicht der Anmelder ist, zugesprochen, so kann diese Person, sofern das europäische Patent noch nicht erteilt worden ist, innerhalb von drei Monaten nach Eintritt der Rechtskraft der Entscheidung in Bezug auf die in der europäischen Patentanmeldung benannten Vertragsstaaten, in denen die Entscheidung ergangen oder anerkannt worden ist oder auf Grund des diesem Überkommen beigefügten Anerkennungsprotokolls anzuerkennen ist,

- a) die europäische Patentanmeldung anstelle des Anmelders als eigene Anmeldung weiterverfolgen,
- b) eine neue europäische Patentanmeldung für dieselbe Erfindung einreichen oder
- c) beantragen, dass die europäische Patentanmeldung zurückgewiesen wird.

(2) Auf eine nach Absatz 1 eingereichte neue europäische Patentanmeldung ist Artikel 76 Absatz 1 entsprechend anzuwenden.

³⁵ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 3/92, G 2/98, G 1/03, G 2/03 (Anhang I).

³⁶ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/92 (Anhang I).

Right to a European patent

(1) The right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee the right to the European patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has his place of business to which the employee is attached.

(2) If two or more persons have made an invention independently of each other, the right to the European patent shall belong to the person whose European patent application has the earliest date of filing; however, this provision shall apply only if this first application has been published under Article 93 and shall only have effect in respect of the Contracting States designated in that application as published.

(3) For the purposes of proceedings before the European Patent Office, the applicant shall be deemed to be entitled to exercise the right to the European patent.

European patent applications by persons not having the right to a European patent

(1) If by a final decision it is adjudged that a person referred to in Article 60, paragraph 1, other than the applicant, is entitled to the grant of a European patent, that person may, within a period of three months after the decision has become final, provided that the European patent has not yet been granted, in respect of those Contracting States designated in the European patent application in which the decision has been taken or recognised, or has to be recognised on the basis of the Protocol on Recognition annexed to this Convention:

- (a) prosecute the application as his own application in place of the applicant,
- (b) file a new European patent application in respect of the same invention, or
- (c) request that the application be refused.

(2) The provisions of Article 76, paragraph 1, shall apply *mutatis mutandis* to a new application filed under paragraph 1.

³⁵ See decisions/opinions of the Enlarged Board of Appeal G 3/92, G 2/98, G 1/03, G 2/03 (Annex I).

³⁶ See decision of the Enlarged Board of Appeal G 3/92 (Annex I).

Droit au brevet européen

Art. 61, 80, 89, 138

(1) Le droit au brevet européen appartient à l'inventeur ou à son ayant cause. Si l'inventeur est un employé, le droit au brevet européen est défini selon le droit de l'Etat sur le territoire duquel l'employé exerce son activité principale ; si l'Etat sur le territoire duquel s'exerce l'activité principale ne peut être déterminé, le droit applicable est celui de l'Etat sur le territoire duquel se trouve l'établissement de l'employeur auquel l'employé est attaché.

(2) Si plusieurs personnes ont réalisé l'invention indépendamment l'une de l'autre, le droit au brevet européen appartient à celle qui a déposé la demande de brevet dont la date de dépôt est la plus ancienne ; toutefois, cette disposition n'est applicable que si la première demande a été publiée en vertu de l'article 93 et elle n'a d'effet que dans les Etats contractants désignés dans cette première demande telle qu'elle a été publiée.

(3) Dans la procédure devant l'Office européen des brevets, le demandeur est réputé habilité à exercer le droit au brevet européen.

Article 61³⁶

Demande de brevet européen par une personne non habilitée

Art. 100, 122, 128, 138

R. 6, 13-16, 31, 37, 42, 85a/bis, 92, 95a/bis

(1) Si une décision passée en force de chose jugée a reconnu le droit à l'obtention du brevet européen à une personne visée à l'article 60, paragraphe 1, autre que le demandeur, et à condition que le brevet européen n'ait pas encore été délivré, cette personne peut, dans un délai de trois mois après que la décision est passée en force de chose jugée, et en ce qui concerne les Etats contractants désignés dans la demande de brevet européen dans lesquels la décision a été rendue ou reconnue, ou doit être reconnue en vertu du protocole sur la reconnaissance, annexé à la présente convention :

- a) poursuivre, aux lieu et place du demandeur, la procédure relative à la demande, en prenant cette demande à son compte,
- b) déposer une nouvelle demande de brevet européen pour la même invention, ou
- c) demander le rejet de la demande.

(2) Les dispositions de l'article 76, paragraphe 1, sont applicables à toute nouvelle demande déposée en vertu des dispositions du paragraphe 1.

³⁵ Cf. les décisions/avis de la Grande Chambre de recours G 3/92, G 2/98, G 1/03, G 2/03 (Annexe I).

³⁶ Cf. la décision de la Grande Chambre de recours G 3/92 (Annexe I).

(3) Das Verfahren zur Durchführung des Absatzes 1, die besonderen Erfordernisse für eine nach Absatz 1 eingereichte neue europäische Patentanmeldung und die Frist zur Zahlung der Anmeldegebühr, der Recherchegebühr und der Benennungsgebühren für die neue Anmeldung sind in der Ausführungsordnung vorgeschrieben.

Artikel 62

Anspruch auf Erfindernennung

Der Erfinder hat gegenüber dem Anmelder oder Inhaber des europäischen Patents das Recht, vor dem Europäischen Patentamt als Erfinder genannt zu werden.

Kapitel III

Wirkungen des europäischen Patents und der europäischen Patentanmeldung

Artikel 63³⁷

Laufzeit des europäischen Patents

(1) Die Laufzeit des europäischen Patents beträgt zwanzig Jahre, gerechnet vom Anmeldetag an.

(2) Absatz 1 lässt das Recht eines Vertragsstaats unberührt, unter den gleichen Bedingungen, die für nationale Patente gelten, die Laufzeit eines europäischen Patents zu verlängern oder entsprechenden Schutz zu gewähren, der sich an den Ablauf der Laufzeit des Patents unmittelbar anschließt,

a) um einem Kriegsfall oder einer vergleichbaren Krisenlage dieses Staats Rechnung zu tragen;

b) wenn der Gegenstand des europäischen Patents ein Erzeugnis oder ein Verfahren zur Herstellung oder eine Verwendung eines Erzeugnisses ist, das vor seinem Inverkehrbringen in diesem Staat einem gesetzlich vorgeschriebenen behördlichen Genehmigungsverfahren unterliegt.

(3) Absatz 2 ist auf die für eine Gruppe von Vertragsstaaten im Sinne des Artikels 142 gemeinsam erteilten europäischen Patente entsprechend anzuwenden.

(4) Ein Vertragsstaat, der eine Verlängerung der Laufzeit oder einen entsprechenden Schutz nach Absatz 2 Buchstabe b vorsieht, kann auf Grund eines Abkommens mit der Organisation dem Europäischen Patentamt mit der Durchführung dieser Vorschriften verbundene Aufgaben übertragen.

(3) The procedure to be followed in carrying out the provisions of paragraph 1, the special conditions applying to a new application filed under paragraph 1 and the time limit for paying the filing, search and designation fees on it are laid down in the Implementing Regulations.

Article 62

Right of the inventor to be mentioned

The inventor shall have the right, vis-à-vis the applicant for or proprietor of a European patent, to be mentioned as such before the European Patent Office.

Chapter III

Effects of the European patent and the European patent application

Article 63³⁷

Term of the European patent

(1) The term of the European patent shall be 20 years as from the date of filing of the application.

(2) Nothing in the preceding paragraph shall limit the right of a Contracting State to extend the term of a European patent, or to grant corresponding protection which follows immediately on expiry of the term of the patent, under the same conditions as those applying to national patents:

(a) in order to take account of a state of war or similar emergency conditions affecting that State;

(b) if the subject-matter of the European patent is a product or a process of manufacturing a product or a use of a product which has to undergo an administrative authorisation procedure required by law before it can be put on the market in that State.

(3) Paragraph 2 shall apply mutatis mutandis to European patents granted jointly for a group of Contracting States in accordance with Article 142.

(4) A Contracting State which makes provision for extension of the term or corresponding protection under paragraph 2(b) may, in accordance with an agreement concluded with the Organisation, entrust to the European Patent Office tasks associated with implementation of the relevant provisions.

³⁷ Geändert durch die Akte zur Revision von Artikel 63 EPÜ vom 17.12.1991, in Kraft getreten am 04.07.1997 (ABl. EPA 1992, 1 ff.).

³⁷ Amended by act revising Article 63 EPC of 17.12.1991, which entered into force on 04.07.1997 (OJ EPO 1992, 1 ff.).

(3) Les procédures destinées à assurer l'application du paragraphe 1, les dispositions particulières applicables à la nouvelle demande de brevet européen déposée en application du paragraphe 1, ainsi que le délai pour le paiement des taxes de dépôt, de recherche et de désignation exigibles au titre de cette demande sont fixés par le règlement d'exécution.

Verweisungen / References / Références

Article 62

Droit de l'inventeur à être désigné

L'inventeur a le droit, à l'égard du titulaire de la demande de brevet européen ou du brevet européen, d'être désigné en tant que tel auprès de l'Office européen des brevets.

Art. 81

R. 17-19, 42, 92

Chapitre III

Effets du brevet européen et de la demande de brevet européen

*Article 63*³⁷

Durée du brevet européen

Art. 2, 167

(1) La durée du brevet européen est de vingt années à compter de la date de dépôt de la demande.

(2) Le paragraphe 1 ne saurait limiter le droit d'un Etat contractant de prolonger la durée d'un brevet européen ou d'accorder une protection correspondante dès l'expiration de cette durée aux mêmes conditions que celles applicables aux brevets nationaux,

a) pour tenir compte d'un état de guerre ou d'un état de crise comparable affectant ledit Etat ;

b) si l'objet du brevet européen est un produit ou un procédé de fabrication ou une utilisation d'un produit qui, avant sa mise sur le marché dans cet Etat, est soumis à une procédure administrative d'autorisation instituée par la loi.

(3) Les dispositions du paragraphe 2 s'appliquent aux brevets européens délivrés conjointement pour tout groupe d'Etats contractants visé à l'article 142.

(4) Tout Etat contractant qui prévoit une prolongation de la durée du brevet ou une protection correspondante conformément au paragraphe 2, lettre b) peut, sur la base d'un accord conclu avec l'Organisation, transférer à l'Office européen des brevets des tâches afférentes à l'application de ces dispositions.

³⁷ Modifié par l'acte portant révision de l'article 63 CBE en date du 17.12.1991, entrée en vigueur le 04.07.1997 (JO OEB 1992, 1 s.).

Artikel 64³⁸

Rechte aus dem europäischen Patent

(1) Das europäische Patent gewährt seinem Inhaber von dem Tag der Bekanntmachung des Hinweises auf seine Erteilung an in jedem Vertragsstaat, für den es erteilt ist, vorbehaltlich Absatz 2 dieselben Rechte, die ihm ein in diesem Staat erteiltes nationales Patent gewähren würde.

(2) Ist Gegenstand des europäischen Patents ein Verfahren, so erstreckt sich der Schutz auch auf die durch das Verfahren unmittelbar hergestellten Erzeugnisse.

(3) Eine Verletzung des europäischen Patents wird nach nationalem Recht behandelt.

Artikel 65

Übersetzung der europäischen Patentschrift

(1)³⁹ Jeder Vertragsstaat kann für den Fall, dass die Fassung, in der das Europäische Patentamt für diesen Staat ein europäisches Patent zu erteilen oder in geänderter Fassung aufrechtzuerhalten beabsichtigt, nicht in einer seiner Amtssprachen vorliegt, vorschreiben, dass der Anmelder oder Patentinhaber bei der Zentralbehörde für den gewerblichen Rechtsschutz eine Übersetzung der Fassung nach seiner Wahl in einer der Amtssprachen dieses Staats, oder, soweit der betreffende Staat die Verwendung einer bestimmten Amtssprache vorgeschrieben hat, in dieser Amtssprache einzureichen hat. Die Frist für die Einreichung der Übersetzung endet drei Monate, nachdem der Hinweis auf die Erteilung des europäischen Patents oder die Aufrechterhaltung des europäischen Patents in geändertem Umfang im Europäischen Patentblatt bekannt gemacht worden ist, sofern nicht der betreffende Staat eine längere Frist vorschreibt.

(2) Jeder Vertragsstaat, der eine Vorschrift nach Absatz 1 erlassen hat, kann vorschreiben, dass der Anmelder oder Patentinhaber innerhalb einer von diesem Staat bestimmten Frist die Kosten für eine Veröffentlichung der Übersetzung ganz oder teilweise zu entrichten hat.

(3) Jeder Vertragsstaat kann vorschreiben, dass im Fall der Nichtbeachtung einer auf Grund der Absätze 1 und 2 erlassenen Vorschrift die Wirkungen des europäischen Patents in diesem Staat als von Anfang an nicht eingetreten gelten.

³⁸ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 2/88, G 1/98 (Anhang I).

³⁹ Geändert durch Beschluss des Verwaltungsrats vom 13.12.1994, in Kraft getreten am 01.01.1996 (ABI. EPA 1995, 9 ff.).

Article 64³⁸

Rights conferred by a European patent

(1) A European patent shall, subject to the provisions of paragraph 2, confer on its proprietor from the date of publication of the mention of its grant, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.

(2) If the subject-matter of the European patent is a process, the protection conferred by the patent shall extend to the products directly obtained by such process.

(3) Any infringement of a European patent shall be dealt with by national law.

Article 65

Translation of the specification of the European patent

(1)³⁹ 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.

(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.

(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.

³⁸ See decisions of the Enlarged Board of Appeal G 2/88, G 1/98 (Annex I).

³⁹ Amended by decision of the Administrative Council of 13.12.1994 which entered into force on 01.01.1996 (OJ EPO 1995, 9 ff.).

Article 64³⁸

Verweisungen / References / Références

Droits conférés par le brevet européen

Art. 2, 67, 68, 97

(1) Sous réserve du paragraphe 2, le brevet européen confère à son titulaire, à compter du jour de la publication de la mention de sa délivrance et dans chacun des Etats contractants pour lesquels il a été délivré, les mêmes droits que lui conférerait un brevet national délivré dans cet Etat.

(2) Si l'objet du brevet européen porte sur un procédé, les droits conférés par ce brevet s'étendent aux produits obtenus directement par ce procédé.

(3) Toute contrefaçon du brevet européen est appréciée conformément aux dispositions de la législation nationale.

Article 65

Traduction du fascicule du brevet européen

Art. 2, 70
R. 51, 58

(1)³⁹ Tout Etat contractant peut prescrire, lorsque le texte dans lequel l'Office européen des brevets envisage de délivrer un brevet européen pour cet Etat ou de maintenir pour ledit Etat un brevet européen sous sa forme modifiée n'est pas rédigé dans une des langues officielles de l'Etat considéré, que le demandeur ou le titulaire du brevet doit fournir au service central de la propriété industrielle une traduction de ce texte dans l'une de ces langues officielles, à son choix, ou, dans la mesure où l'Etat en question a imposé l'utilisation d'une langue officielle déterminée, dans cette dernière langue. La traduction doit être produite dans un délai de trois mois à compter de la date de publication au Bulletin européen des brevets de la mention de la délivrance du brevet européen ou du maintien du brevet européen tel qu'il a été modifié, à moins que l'Etat considéré n'accorde un délai plus long.

(2) Tout Etat contractant qui a adopté des dispositions en vertu du paragraphe 1 peut prescrire que le demandeur ou le titulaire du brevet acquitte, dans un délai fixé par cet Etat, tout ou partie des frais de publication de la traduction.

(3) Tout Etat contractant peut prescrire que, si les dispositions adoptées en vertu des paragraphes 1 et 2 ne sont pas observées, le brevet européen est, dès l'origine, réputé sans effet dans cet Etat.

³⁸ Cf. les décisions de la Grande Chambre de recours G 2/88, G 1/98 (Annexe I).

³⁹ Modifié par décision du Conseil d'administration en date du 13.12.1994, entrée en vigueur le 01.01.1996 (JO OEB 1995, 9 s.).

*Artikel 66*⁴⁰

Wirkung der europäischen Patentanmeldung als nationale Hinterlegung

Eine europäische Patentanmeldung, deren Anmeldetag feststeht, hat in den benannten Vertragsstaaten die Wirkung einer vorschriftsmäßigen nationalen Hinterlegung, gegebenenfalls mit der für die europäische Patentanmeldung in Anspruch genommenen Priorität.

*Artikel 67*⁴¹

Rechte aus der europäischen Patentanmeldung nach Veröffentlichung

(1) Die europäische Patentanmeldung gewährt dem Anmelder vom Tag ihrer Veröffentlichung nach Artikel 93 an in den in der Veröffentlichung angegebenen benannten Vertragsstaaten einstweilen den Schutz nach Artikel 64.

(2) Jeder Vertragsstaat kann vorsehen, dass die europäische Patentanmeldung nicht den Schutz nach Artikel 64 gewährt. Der Schutz, der mit der Veröffentlichung der europäischen Patentanmeldung verbunden ist, darf jedoch nicht geringer sein als der Schutz, der sich auf Grund des Rechts des betreffenden Staats aus der zwingend vorgeschriebenen Veröffentlichung der ungeprüften nationalen Patentanmeldungen ergibt. Zumindest hat jeder Vertragsstaat vorzusehen, dass der Anmelder für die Zeit von der Veröffentlichung der europäischen Patentanmeldung an von demjenigen, der die Erfindung in diesem Vertragsstaat unter Voraussetzungen benutzt hat, die nach dem nationalen Recht im Fall der Verletzung eines nationalen Patents sein Verschulden begründen würden, eine den Umständen nach angemessene Entschädigung verlangen kann.

(3) Jeder Vertragsstaat kann für den Fall, dass eine seiner Amtssprachen nicht die Verfahrenssprache ist, vorsehen, dass der einstweilige Schutz nach den Absätzen 1 und 2 erst von dem Tag an eintritt, an dem eine Übersetzung der Patentansprüche nach Wahl des Anmelders in einer der Amtssprachen dieses Staats oder, soweit der betreffende Staat die Verwendung einer bestimmten Amtssprache vorgeschrieben hat, in dieser Amtssprache

a) der Öffentlichkeit unter den nach nationalem Recht vorgesehenen Voraussetzungen zugänglich gemacht worden ist oder

b) demjenigen übermittelt worden ist, der die Erfindung in diesem Vertragsstaat benutzt.

*Article 66*⁴⁰

Equivalence of European filing with national filing

A European patent application which has been accorded a date of filing shall, in the designated Contracting States, be equivalent to a regular national filing, where appropriate with the priority claimed for the European patent application.

*Article 67*⁴¹

Rights conferred by a European patent application after publication

(1) A European patent application shall, from the date of its publication under Article 93, provisionally confer upon the applicant such protection as is conferred by Article 64, in the Contracting States designated in the application as published.

(2) Any Contracting State may prescribe that a European patent application shall not confer such protection as is conferred by Article 64. However, the protection attached to the publication of the European patent application may not be less than that which the laws of the State concerned attach to the compulsory publication of unexamined national patent applications. In any event, every State shall ensure at least that, from the date of publication of a European patent application, the applicant can claim compensation reasonable in the circumstances from any person who has used the invention in the said State in circumstances where that person would be liable under national law for infringement of a national patent.

(3) Any Contracting State which does not have as an official language the language of the proceedings, may prescribe that provisional protection in accordance with paragraphs 1 and 2 above shall not be effective until such time as a translation of the claims in one of its official languages at the option of the applicant or, where that State has prescribed the use of one specific official language, in that language:

(a) has been made available to the public in the manner prescribed by national law, or

(b) has been communicated to the person using the invention in the said State.

⁴⁰ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 4/98, G 2/02 und G 3/02 (Anhang I).

⁴¹ Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 4/98 (Anhang I).

⁴⁰ See decisions/opinions of the Enlarged Board of Appeal G 4/98, G 2/02 and G 3/02 (Annex I).

⁴¹ See opinion of the Enlarged Board of Appeal G 4/98 (Annex I).

Valeur de dépôt national du dépôt européen

Art. 80, 87, 88, 135, 136, 140

La demande de brevet européen à laquelle une date de dépôt a été accordée a, dans les Etats contractants désignés, la valeur d'un dépôt national régulier, compte tenu, le cas échéant, du droit de priorité invoqué à l'appui de la demande de brevet européen.

Article 67⁴¹

Droits conférés par la demande de brevet européen après sa publication

Art. 68, 70, 93, 158

(1) A compter de sa publication en vertu de l'article 93, la demande de brevet européen assure provisoirement au demandeur, dans les Etats contractants désignés dans la demande de brevet telle que publiée, la protection prévue à l'article 64.

(2) Chaque Etat contractant peut prévoir que la demande de brevet européen n'assure pas la protection prévue à l'article 64. Toutefois, la protection attachée à la publication de la demande de brevet européen ne peut être inférieure à celle que la législation de l'Etat considéré attache à la publication obligatoire des demandes de brevet national non examinées. En tout état de cause, chaque Etat contractant doit, pour le moins, prévoir qu'à partir de la publication de la demande de brevet européen, le demandeur peut exiger une indemnité raisonnable, fixée suivant les circonstances, de toute personne ayant exploité, dans cet Etat contractant, l'invention qui fait l'objet de la demande de brevet européen, dans des conditions qui, selon le droit national, mettraient en jeu sa responsabilité s'il s'agissait d'une contrefaçon d'un brevet national.

(3) Chaque Etat contractant qui n'a pas comme langue officielle la langue de la procédure peut prévoir que la protection provisoire visée aux paragraphes 1 et 2 n'est assurée qu'à partir de la date à laquelle une traduction des revendications, soit dans l'une des langues officielles de cet Etat, au choix du demandeur, soit, dans la mesure où l'Etat en question a imposé l'utilisation d'une langue officielle déterminée, dans cette dernière langue :

a) a été rendue accessible au public, dans les conditions prévues par sa législation nationale, ou

b) a été remise à la personne exploitant, dans celui-ci, l'invention qui fait l'objet de la demande de brevet européen.

⁴⁰ Cf. les décisions/avis de la Grande Chambre de recours G 4/98, G 2/02 et G 3/02 (Annexe I).

⁴¹ Cf. l'avis de la Grande Chambre de recours G 4/98 (Annexe I).

(4) Die in den Absätzen 1 und 2 vorgesehenen Wirkungen der europäischen Patentanmeldung gelten als von Anfang an nicht eingetreten, wenn die europäische Patentanmeldung zurückgenommen worden ist, als zurückgenommen gilt oder rechtskräftig zurückgewiesen worden ist. Das Gleiche gilt für die Wirkungen der europäischen Patentanmeldung in einem Vertragsstaat, dessen Benennung zurückgenommen worden ist oder als zurückgenommen gilt.

*Artikel 68*⁴²

Wirkung des Widerrufs des europäischen Patents

Die in den Artikeln 64 und 67 vorgesehenen Wirkungen der europäischen Patentanmeldung und des darauf erteilten europäischen Patents gelten in dem Umfang, in dem das Patent im Einspruchsverfahren widerrufen ist, als von Anfang an nicht eingetreten.

Artikel 69^{43/44}

Schutzbereich

(1) Der Schutzbereich des europäischen Patents und der europäischen Patentanmeldung wird durch den Inhalt der Patentansprüche bestimmt. Die Beschreibung und die Zeichnungen sind jedoch zur Auslegung der Patentansprüche heranzuziehen.

(2) Für den Zeitraum bis zur Erteilung des europäischen Patents wird der Schutzbereich der europäischen Patentanmeldung durch die zuletzt eingereichten Patentansprüche, die in der Veröffentlichung nach Artikel 93 enthalten sind, bestimmt. Jedoch bestimmt das europäische Patent in seiner erteilten oder im Einspruchsverfahren geänderten Fassung rückwirkend den Schutzbereich der Anmeldung, soweit dieser Schutzbereich nicht erweitert wird.

⁴² Siehe hierzu Rechtsauskunft Nr. 11/82 (Anhang II).

⁴³ Siehe nachstehendes Protokoll über die Auslegung des Artikels 69 des Übereinkommens, beschlossen auf der Münchner Diplomatischen Konferenz über die Einführung eines europäischen Patenterteilungsverfahrens am 5. Oktober 1973:
"Artikel 69 ist nicht in der Weise auszulegen, dass unter dem Schutzbereich des europäischen Patents der Schutzbereich zu verstehen ist, der sich aus dem genauen Wortlaut der Patentansprüche ergibt, und dass die Beschreibung sowie die Zeichnungen nur zur Behebung etwaiger Unklarheiten in den Patentansprüchen anzuwenden sind. Ebenso wenig ist Artikel 69 dahin gehend auszulegen, dass die Patentansprüche lediglich als Richtlinie dienen und der Schutzbereich sich auch auf das erstreckt, was sich dem Fachmann nach Prüfung der Beschreibung und der Zeichnungen als Schutzbegehren des Patentinhabers darstellt. Die Auslegung soll vielmehr zwischen diesen extremen Auffassungen liegen und einen angemessenen Schutz für den Patentinhaber mit ausreichender Rechtssicherheit für Dritte verbinden." (Das Protokoll ist gemäß Artikel 164 Absatz 1 Bestandteil des Übereinkommens.)

⁴⁴ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 2/88, G 6/88 (Anhang I).

(4) The European patent application shall be deemed never to have had the effects set out in paragraphs 1 and 2 above when it has been withdrawn, deemed to be withdrawn or finally refused. The same shall apply in respect of the effects of the European patent application in a Contracting State the designation of which is withdrawn or deemed to be withdrawn.

*Article 68*⁴²

Effect of revocation of the European patent

The European patent application and the resulting patent shall be deemed not to have had, as from the outset, the effects specified in Articles 64 and 67, to the extent that the patent has been revoked in opposition proceedings.

Article 69^{43/44}

Extent of protection

(1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

(2) For the period up to grant of the European patent, the extent of the protection conferred by the European patent application shall be determined by the latest filed claims contained in the publication under Article 93. However, the European patent as granted or as amended in opposition proceedings shall determine retroactively the protection conferred by the European patent application, in so far as such protection is not thereby extended.

⁴² See Legal advice No. 11/82 (Annex II).

⁴³ See Protocol on the Interpretation of Article 69 of the Convention, adopted at the Munich Diplomatic Conference for the setting up of a European System for the Grant of Patents on 5 October 1973, as set out below:
"Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties."
(The Protocol shall be an integral part of the Convention pursuant to Article 164, paragraph 1.)

⁴⁴ See decisions of the Enlarged Board of Appeal G 2/88, G 6/88 (Annex I).

(4) Les effets de la demande de brevet européen prévus aux paragraphes 1 et 2 sont réputés nuls et non avenues lorsque la demande de brevet européen a été retirée, ou est réputée retirée, ou a été rejetée en vertu d'une décision passée en force de chose jugée. Il en est de même des effets de la demande de brevet européen dans un Etat contractant dont la désignation a été retirée ou est réputée retirée.

Verweisungen / References / Références

Article 68⁴²

Effets de la révocation du brevet européen

La demande de brevet européen ainsi que le brevet européen auquel elle a donné lieu sont réputés n'avoir pas eu dès l'origine, totalement ou partiellement, les effets prévus aux articles 64 et 67, selon que le brevet a été révoqué en tout ou en partie au cours d'une procédure d'opposition.

Article 69^{43/44}

Etendue de la protection

(1) L'étendue de la protection conférée par le brevet européen ou par la demande de brevet européen est déterminée par la teneur des revendications. Toutefois, la description et les dessins servent à interpréter les revendications.

(2) Pour la période allant jusqu'à la délivrance du brevet européen, l'étendue de la protection conférée par la demande de brevet européen est déterminée par les revendications déposées en dernier lieu contenues dans la publication prévue à l'article 93. Toutefois, le brevet européen tel que délivré ou modifié au cours de la procédure d'opposition détermine rétroactivement cette protection pour autant que celle-ci n'est pas étendue.

Art. 2, 102

Remarque : le texte français de l'article 68, dans la version signée le 5 octobre 1973, comporte une référence aux articles 64 et 66, alors qu'il convient de se référer aux articles 64 et 67, comme cela est indiqué dans les textes allemand et anglais. Il ressort du contexte que seule la référence à l'article 67 est justifiée ; elle a par conséquent été indiquée dans la présente édition.

Art. 2, 164

⁴² Cf. le renseignement juridique n° 11/82 (Annexe II).

⁴³ Voir ci-après le protocole interprétatif de l'article 69 de la convention, approuvé le 5 octobre 1973 à l'issue de la Conférence diplomatique de Munich pour l'institution d'un système européen de délivrance de brevets :
«L'article 69 ne doit pas être interprété comme signifiant que l'étendue de la protection conférée par le brevet européen est déterminée au sens étroit et littéral du texte des revendications et que la description et les dessins servent uniquement à dissiper les ambiguïtés que pourraient recéler les revendications. Il ne doit pas davantage être interprété comme signifiant que les revendications servent uniquement de ligne directrice et que la protection s'étend également à ce que, de l'avis d'un homme du métier ayant examiné la description et les dessins, le titulaire du brevet a entendu protéger. L'article 69 doit, par contre, être interprété comme définissant entre ces extrêmes une position qui assure à la fois une protection équitable au demandeur et un degré raisonnable de certitude aux tiers.»
(Le protocole fait partie intégrante de la présente convention conformément à l'article 164, paragraphe 1.)

⁴⁴ Cf. les décisions de la Grande Chambre de recours G 2/88, G 6/88 (Annexe I).

Verbindliche Fassung einer europäischen Patentanmeldung oder eines europäischen Patents

(1) Der Wortlaut einer europäischen Patentanmeldung oder eines europäischen Patents in der Verfahrenssprache stellt in Verfahren vor dem Europäischen Patentamt sowie in jedem Vertragsstaat die verbindliche Fassung dar.

(2) Im Fall des Artikels 14 Absatz 2 ist jedoch in Verfahren vor dem Europäischen Patentamt der ursprüngliche Text für die Feststellung maßgebend, ob der Gegenstand der europäischen Patentanmeldung oder des europäischen Patents nicht über den Inhalt der Anmeldung in der eingereichten Fassung hinausgeht.

(3) Jeder Vertragsstaat kann vorsehen, dass in seinem Staat eine im Übereinkommen vorgeschriebene Übersetzung in einer seiner Amtssprachen für den Fall maßgebend ist, dass der Schutzbereich der europäischen Patentanmeldung oder des europäischen Patents in der Sprache der Übersetzung enger ist als der Schutzbereich in der Verfahrenssprache; dies gilt nicht für Nichtigkeitsverfahren.

(4) Jeder Vertragsstaat, der eine Vorschrift nach Absatz 3 erlässt,

a) muss dem Anmelder oder Patentinhaber gestatten, eine berichtigte Übersetzung der europäischen Patentanmeldung oder des europäischen Patents einzureichen. Die berichtigte Übersetzung hat erst dann rechtliche Wirkung, wenn die von dem Vertragsstaat in entsprechender Anwendung der Artikel 65 Absatz 2 und Artikel 67 Absatz 3 aufgestellten Voraussetzungen erfüllt sind;

b) kann vorsehen, dass derjenige, der in diesem Staat in gutem Glauben eine Erfindung in Benutzung genommen oder wirkliche und ernsthafte Veranstaltungen zur Benutzung einer Erfindung getroffen hat, deren Benutzung keine Verletzung der Anmeldung oder des Patents in der Fassung der ursprünglichen Übersetzung darstellen würde, nach Eintritt der rechtlichen Wirkung der berichtigten Übersetzung die Benutzung in seinem Betrieb oder für die Bedürfnisse seines Betriebs unentgeltlich fortsetzen darf.

Kapitel IV

Die europäische Patentanmeldung als Gegenstand des Vermögens

Artikel 71

Übertragung und Bestellung von Rechten

Die europäische Patentanmeldung kann für einen oder mehrere der benannten Vertragsstaaten übertragen werden oder Gegenstand von Rechten sein.

Authentic text of a European patent application or European patent

(1) The text of a European patent application or a European patent in the language of the proceedings shall be the authentic text in any proceedings before the European Patent Office and in any Contracting State.

(2) However, in the case referred to in Article 14, paragraph 2, the original text shall, in proceedings before the European Patent Office, constitute the basis for determining whether the subject-matter of the application or patent extends beyond the content of the application as filed.

(3) Any Contracting State may provide that a translation, as provided for in this Convention, in an official language of that State, shall in that State be regarded as authentic, except for revocation proceedings, in the event of the application or patent in the language of the translation conferring protection which is narrower than that conferred by it in the language of the proceedings.

(4) Any Contracting State which adopts a provision under paragraph 3:

(a) must allow the applicant for or proprietor of the patent to file a corrected translation of the European patent application or European patent. Such corrected translation shall not have any legal effect until any conditions established by the Contracting State under Article 65, paragraph 2, and Article 67, paragraph 3, have been complied with *mutatis mutandis*;

(b) may prescribe that any person who, in that State, in good faith is using or has made effective and serious preparations for using an invention the use of which would not constitute infringement of the application or patent in the original translation may, after the corrected translation takes effect, continue such use in the course of his business or for the needs thereof without payment.

Chapter IV

The European patent application as an object of property

Article 71

Transfer and constitution of rights

A European patent application may be transferred or give rise to rights for one or more of the designated Contracting States.

⁴⁵ Siehe hierzu Rechtsauskunft Nr. 17/90 (Anhang II).

⁴⁵ See Legal advice No. 17/90 (Annex II).

Texte de la demande de brevet européen ou du brevet européen faisant foi

Art. 2
R. 7

(1) Le texte de la demande de brevet européen ou du brevet européen rédigé dans la langue de la procédure est le texte qui fait foi dans toutes les procédures devant l'Office européen des brevets et dans tous les Etats contractants.

(2) Toutefois, dans le cas visé à l'article 14, paragraphe 2, le texte initialement déposé est pris en considération pour déterminer, dans les procédures devant l'Office européen des brevets, si l'objet de la demande de brevet européen ou du brevet européen n'a pas été étendu au-delà du contenu de la demande telle qu'elle a été déposée.

(3) Tout Etat contractant peut prévoir qu'une traduction dans une langue officielle de cet Etat, ainsi qu'en dispose la présente convention, est considérée dans ledit Etat comme étant le texte qui fait foi, hormis les cas d'actions en nullité, si la demande de brevet européen ou le brevet européen dans la langue de la traduction confère une protection moins étendue que celle conférée par ladite demande ou par ledit brevet dans la langue de la procédure.

(4) Tout Etat contractant qui arrête une disposition en application du paragraphe 3,

a) doit permettre au demandeur ou au titulaire du brevet européen de produire une traduction révisée de la demande ou du brevet. Cette traduction révisée n'a pas d'effet juridique aussi longtemps que les conditions fixées par l'Etat contractant en application de l'article 65, paragraphe 2 et de l'article 67, paragraphe 3, n'ont pas été remplies ;

b) peut prévoir que celui qui, dans cet Etat, a, de bonne foi, commencé à exploiter une invention ou a fait des préparatifs effectifs et sérieux à cette fin, sans que cette exploitation constitue une contrefaçon de la demande ou du brevet dans le texte de la traduction initiale, peut, après que la traduction révisée a pris effet, poursuivre à titre gratuit son exploitation dans son entreprise ou pour les besoins de celle-ci.

Chapitre IV

De la demande de brevet européen comme objet de propriété

Article 71

Transfert et constitution de droits

R. 20, 21, 61

La demande de brevet européen peut être transférée ou donner lieu à la constitution de droits pour un ou plusieurs des Etats contractants désignés.

⁴⁵ Cf. le renseignement juridique n° 17/90 (Annexe II).

Artikel 72

Rechtsgeschäftliche Übertragung

Die rechtsgeschäftliche Übertragung der europäischen Patentanmeldung muss schriftlich erfolgen und bedarf der Unterschrift der Vertragsparteien.

Article 72

Assignment

An assignment of a European patent application shall be made in writing and shall require the signature of the parties to the contract.

Artikel 73

Vertragliche Lizenzen

Eine europäische Patentanmeldung kann ganz oder teilweise Gegenstand von Lizenzen für alle oder einen Teil der Hoheitsgebiete der benannten Vertragsstaaten sein.

Article 73

Contractual licensing

A European patent application may be licensed in whole or in part for the whole or part of the territories of the designated Contracting States.

Artikel 74

Anwendbares Recht

Soweit in diesem Übereinkommen nichts anderes bestimmt ist, unterliegt die europäische Patentanmeldung als Gegenstand des Vermögens in jedem benannten Vertragsstaat und mit Wirkung für diesen Staat dem Recht, das in diesem Staat für nationale Patentanmeldungen gilt.

Article 74

Law applicable

Unless otherwise specified in this Convention, the European patent application as an object of property shall, in each designated Contracting State and with effect for such State, be subject to the law applicable in that State to national patent applications.

Article 72

Cession

La cession de la demande de brevet européen doit être faite par écrit et requiert la signature des parties au contrat.

Verweisungen / References / Références

R. 20, 61

Article 73

Licence contractuelle

Une demande de brevet européen peut faire, en sa totalité ou en partie, l'objet de licences pour tout ou partie des territoires des Etats contractants désignés.

R. 21, 22

Article 74

Droit applicable

Sauf dispositions contraires de la présente convention, la demande de brevet européen comme objet de propriété est soumise, dans chaque Etat contractant désigné et avec effet dans cet Etat, à la législation applicable dans ledit Etat aux demandes de brevet national.

Art. 148

DRITTER TEIL

DIE EUROPÄISCHE PATENTANMELDUNG

Kapitel I

Einreichung und Erfordernisse der europäischen Patentanmeldung

Artikel 75

Einreichung der europäischen Patentanmeldung

(1) Die europäische Patentanmeldung kann eingereicht werden:

a)⁴⁶ beim Europäischen Patentamt in München oder seiner Zweigstelle in Den Haag oder

b) bei der Zentralbehörde für den gewerblichen Rechtsschutz oder bei anderen zuständigen Behörden eines Vertragsstaats, wenn das Recht dieses Staats es gestattet. Eine in dieser Weise eingereichte Anmeldung hat dieselbe Wirkung, wie wenn sie an demselben Tag beim Europäischen Patentamt eingereicht worden wäre.

(2) Absatz 1 steht der Anwendung der Rechts- und Verwaltungsvorschriften nicht entgegen, die in einem Vertragsstaat

a) für Erfindungen gelten, die wegen ihres Gegenstands nicht ohne vorherige Zustimmung der zuständigen Behörden dieses Staats ins Ausland übermittelt werden dürfen, oder

b) bestimmen, dass Patentanmeldungen zuerst bei einer nationalen Behörde eingereicht werden müssen, oder die die unmittelbare Einreichung bei einer anderen Behörde von einer vorherigen Zustimmung abhängig machen.

(3) Ein Vertragsstaat darf weder vorschreiben noch zulassen, dass europäische Teilanmeldungen bei einer in Absatz 1 Buchstabe b genannten Behörde eingereicht werden.

Artikel 76⁴⁷

Europäische Teilanmeldung

(1) Eine europäische Teilanmeldung ist unmittelbar beim Europäischen Patentamt in München oder seiner Zweigstelle in Den Haag einzureichen. Sie kann nur für einen Gegenstand eingereicht werden, der nicht über den Inhalt der früheren Anmeldung in der ursprünglich eingereichten Fassung hinausgeht; soweit diesem Erfordernis entsprochen wird, gilt die Teilanmeldung als an dem Anmeldetag der früheren Anmeldung eingereicht und genießt deren Prioritätsrecht.

⁴⁶ Siehe hierzu die Beschlüsse des Präsidenten des EPA vom 10.05.1989 über die Errichtung einer Annahmestelle bei der Dienststelle Berlin des EPA (ABl. EPA 1989, 218) und vom 18.03.1991 über die Errichtung einer Annahmestelle in dem Dienstgebäude "Pschorrrhöfe" in München (ABl. EPA 1991, 223).

⁴⁷ Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 4/98 (Anhang I).

PART III

APPLICATION FOR EUROPEAN PATENTS

Chapter I

Filing and requirements of the European patent application

Article 75

Filing of the European patent application

(1) A European patent application may be filed:

(a)⁴⁶ at the European Patent Office at Munich or its branch at The Hague, or

(b) if the law of a Contracting State so permits, at the central industrial property office or other competent authority of that State. An application filed in this way shall have the same effect as if it had been filed on the same date at the European Patent Office.

(2) The provisions of paragraph 1 shall not preclude the application of legislative or regulatory provisions which, in any Contracting State:

(a) govern inventions which, owing to the nature of their subject-matter, may not be communicated abroad without the prior authorisation of the competent authorities of that State, or

(b) prescribe that each application is to be filed initially with a national authority or make direct filing with another authority subject to prior authorisation.

(3) No Contracting State may provide for or allow the filing of European divisional applications with an authority referred to in paragraph 1(b).

Article 76⁴⁷

European divisional applications

(1) A European divisional application must be filed directly with the European Patent Office at Munich or its branch at The Hague. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority.

⁴⁶ See decisions of the President of the EPO dated 10.05.1989 on the setting up of a filing office in the Berlin sub-office of the EPO (OJ EPO 1989, 218) and dated 18.03.1991 on the setting up of a filing office in the Munich building "Pschorrrhöfe" (OJ EPO 1991, 223).

⁴⁷ See opinion of the Enlarged Board of Appeal G 4/98 (Annex I).

TROISIÈME PARTIE

Verweisungen / References / Références

LA DEMANDE DE BREVET EUROPÉEN

Chapitre I

Dépôt de la demande de brevet européen et conditions auxquelles elle doit satisfaire

Article 75

Dépôt de la demande de brevet européen

Art. 76, 120, 130, 152
R. 24, 26, 84a/bis, 85, 95a/bis

(1) La demande de brevet européen peut être déposée :

a)⁴⁶ soit auprès de l'Office européen des brevets à Munich ou de son département à La Haye ;

b) soit, si la législation d'un Etat contractant le permet, auprès du service central de la propriété industrielle ou des autres services compétents de cet Etat. Une demande ainsi déposée a les mêmes effets que si elle avait été déposée à la même date à l'Office européen des brevets.

(2) Les dispositions du paragraphe 1 ne peuvent faire obstacle à l'application des dispositions législatives ou réglementaires qui, dans un Etat contractant :

a) régissent les inventions qui ne peuvent, en raison de leur objet, être communiquées à l'étranger sans autorisation préalable des autorités compétentes de l'Etat en cause, ou

b) prescrivent que toute demande de brevet doit être initialement déposée auprès d'une autorité nationale, ou soumettent à une autorisation préalable le dépôt direct auprès d'une autre autorité.

(3) Aucun Etat contractant ne peut prévoir ni autoriser le dépôt d'une demande divisionnaire de brevet européen auprès d'une autorité visée au paragraphe 1, lettre b).

Article 76⁴⁷

Demandes divisionnaires européennes

Art. 61, 75, 100, 122, 128, 138
R. 4, 6, 25, 26, 31, 37, 42, 85a/bis, 92, 95a/bis

(1) Une demande divisionnaire de brevet européen doit être déposée directement auprès de l'Office européen des brevets à Munich ou de son département à La Haye. Elle ne peut être déposée que pour des éléments qui ne s'étendent pas au-delà du contenu de la demande initiale telle qu'elle a été déposée ; dans la mesure où il est satisfait à cette exigence, la demande divisionnaire est considérée comme déposée à la date de dépôt de la demande initiale et bénéficie du droit de priorité.

⁴⁶ Cf. la décision du Président de l'OEB du 10.05.1989, relative à la création d'un bureau de réception à l'agence de Berlin de l'OEB (JO OEB 1989, 218) et celle du 18.03.1991, relative à la création d'un bureau de réception au bâtiment "PschorrrHöfe" à Munich (JO OEB 1991, 223).

⁴⁷ Cf. l'avis de la Grande Chambre de recours G 4/98 (Annexe I).

(2) In der europäischen Teilanmeldung dürfen nur Vertragsstaaten benannt werden, die in der früheren Anmeldung benannt worden sind.

(3) Das Verfahren zur Durchführung des Absatzes 1, die besonderen Erfordernisse der europäischen Teilanmeldung und die Frist zur Zahlung der Anmeldegebühr, der Recherchegebühr und der Benennungsgebühren sind in der Ausführungsordnung vorgeschrieben.

Artikel 77

Übermittlung europäischer Patentanmeldungen

(1) Die Zentralbehörde für den gewerblichen Rechtsschutz eines Vertragsstaats hat die bei ihr oder bei anderen zuständigen Behörden dieses Staats eingereichten europäischen Patentanmeldungen innerhalb der kürzesten Frist, die mit der Anwendung der nationalen Vorschriften über die Geheimhaltung von Erfindungen im Interesse des Staats vereinbar ist, an das Europäische Patentamt weiterzuleiten.

(2) Die Vertragsstaaten ergreifen alle geeigneten Maßnahmen, damit die europäischen Patentanmeldungen, deren Gegenstand offensichtlich im Sinn der in Absatz 1 genannten Vorschriften nicht geheimhaltungsbedürftig ist, innerhalb von sechs Wochen nach Einreichung der Anmeldung an das Europäische Patentamt weitergeleitet werden.

(3) Europäische Patentanmeldungen, bei denen näher geprüft werden muss, ob sie geheimhaltungsbedürftig sind, sind so rechtzeitig weiterzuleiten, dass sie innerhalb von vier Monaten nach Einreichung der Anmeldung oder, wenn eine Priorität in Anspruch genommen worden ist, innerhalb von vierzehn Monaten nach dem Prioritätstag beim Europäischen Patentamt eingehen.

(4) Eine europäische Patentanmeldung, deren Gegenstand unter Geheimschutz gestellt worden ist, wird nicht an das Europäische Patentamt weitergeleitet.

(5) Europäische Patentanmeldungen, die nicht bis zum Ablauf des vierzehnten Monats nach Einreichung der Anmeldung oder, wenn eine Priorität in Anspruch genommen worden ist, nach dem Prioritätstag dem Europäischen Patentamt zugehen, gelten als zurückgenommen. Die Anmeldegebühr, die Recherchegebühr und die Benennungsgebühren werden zurückgezahlt.

Artikel 78

Erfordernisse der europäischen Patentanmeldung

(1) Die europäische Patentanmeldung muss enthalten:

a)⁴⁸ einen Antrag auf Erteilung eines europäischen Patents;

(2) The European divisional application shall not designate Contracting States which were not designated in the earlier application.

(3) The procedure to be followed in carrying out the provisions of paragraph 1, the special conditions to be complied with by a divisional application and the time limit for paying the filing, search and designation fees are laid down in the Implementing Regulations.

Article 77

Forwarding of European patent applications

(1) The central industrial property office of a Contracting State shall be obliged to forward to the European Patent Office, in the shortest time compatible with the application of national law concerning the secrecy of inventions in the interests of the State, any European patent applications which have been filed with that office or with other competent authorities in that State.

(2) The Contracting States shall take all appropriate steps to ensure that European patent applications, the subject of which is obviously not liable to secrecy by virtue of the law referred to in paragraph 1, shall be forwarded to the European Patent Office within six weeks after filing.

(3) European patent applications which require further examination as to their liability to secrecy shall be forwarded in such manner as to reach the European Patent Office within four months after filing, or, where priority has been claimed, fourteen months after the date of priority.

(4) A European patent application, the subject of which has been made secret, shall not be forwarded to the European Patent Office.

(5) European patent applications which do not reach the European Patent Office before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority, shall be deemed to be withdrawn. The filing, search and designation fees shall be refunded.

Article 78

Requirements of the European patent application

(1) A European patent application shall contain:

(a)⁴⁸ a request for the grant of a European patent;

⁴⁸ Siehe hierzu Rechtsauskunft Nr. 8/80 (Anhang II).

⁴⁸ See Legal advice No. 8/80 (Annex II).

(2) Une demande divisionnaire de brevet européen ne peut désigner d'autres Etats contractants que ceux qui étaient désignés dans la demande initiale.

Verweisungen / References / Références

(3) La procédure destinée à assurer l'application du paragraphe 1, les conditions particulières auxquelles doit satisfaire une demande divisionnaire ainsi que le délai pour le paiement des taxes de dépôt, de recherche et de désignation sont fixés par le règlement d'exécution.

Article 77

Transmission des demandes de brevet européen

Art. 135, 136

R. 15, 24, 31, 69, 85

(1) Le service central de la propriété industrielle de l'Etat contractant est tenu de transmettre à l'Office européen des brevets, dans le plus court délai compatible avec l'application de la législation nationale relative à la mise au secret des inventions dans l'intérêt de l'Etat, les demandes de brevet européen déposées auprès de lui ou auprès des autres services compétents de cet Etat.

(2) Les Etats contractants prennent toutes mesures utiles pour que les demandes de brevet européen dont l'objet n'est manifestement pas susceptible d'être mis au secret en vertu de la législation visée au paragraphe 1, soient transmises à l'Office européen des brevets dans un délai de six semaines après leur dépôt.

(3) Les demandes de brevet européen pour lesquelles il convient d'examiner si les inventions exigent une mise au secret doivent être transmises suffisamment tôt pour qu'elles parviennent à l'Office européen des brevets dans un délai de quatre mois, à compter du dépôt ou, lorsqu'une priorité a été revendiquée, de quatorze mois, à compter de la date de priorité.

(4) Une demande de brevet européen dont l'objet a été mis au secret n'est pas transmise à l'Office européen des brevets.

(5) Les demandes de brevet européen qui ne parviennent pas à l'Office européen des brevets dans un délai de quatorze mois à compter du dépôt ou, si une priorité a été revendiquée, à compter de la date de priorité, sont réputées retirées. Les taxes de dépôt, de recherche et de désignation sont restituées.

Article 78

Conditions auxquelles doit satisfaire la demande de brevet européen

Art. 79, 80, 83-85, 90, 91, 122

R. 6, 15, 25-28, 29-36, 85a/bis, 88, 106

(1) La demande de brevet européen doit contenir :

a)⁴⁸ une requête en délivrance d'un brevet européen ;

⁴⁸ Cf. le renseignement juridique n° 8/80 (Annexe II).

- b) eine Beschreibung der Erfindung;
- c) einen oder mehrere Patentansprüche;
- d) die Zeichnungen, auf die sich die Beschreibung oder die Patentansprüche beziehen;
- e) eine Zusammenfassung.

(2)⁴⁹ Für die europäische Patentanmeldung sind die Anmeldegebühr und die Recherchegebühr innerhalb eines Monats nach Einreichung der Anmeldung zu entrichten.

(3) Die europäische Patentanmeldung muss den Erfordernissen genügen, die in der Ausführungsordnung vorgeschrieben sind.

*Artikel 79*⁵⁰

Benennung von Vertragsstaaten

(1) Im Antrag auf Erteilung eines europäischen Patents sind der Vertragsstaat oder die Vertragsstaaten, in denen für die Erfindung Schutz begehrt wird, zu benennen.

(2)⁵¹ Für die Benennung eines Vertragsstaats ist die Benennungsgebühr zu entrichten. Die Benennungsgebühren sind innerhalb von sechs Monaten nach dem Tag zu entrichten, an dem im Europäischen Patentblatt auf die Veröffentlichung des europäischen Recherchenberichts hingewiesen worden ist.

(3) Die Benennung eines Vertragsstaats kann bis zur Erteilung des europäischen Patents zurückgenommen werden. Die Zurücknahme der Benennung aller Vertragsstaaten gilt als Zurücknahme der europäischen Patentanmeldung. Die Benennungsgebühren werden nicht zurückgezahlt.

*Artikel 80*⁵²

Anmeldetag

Der Anmeldetag einer europäischen Patentanmeldung ist der Tag, an dem die vom Anmelder eingereichten Unterlagen enthalten:

- a) einen Hinweis, dass ein europäisches Patent beantragt wird;
- b) die Benennung mindestens eines Vertragsstaats;

- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract.

(2)⁴⁹ A European patent application shall be subject to the payment of the filing fee and the search fee within one month after the filing of the application.

(3) A European patent application must satisfy the conditions laid down in the Implementing Regulations.

*Article 79*⁵⁰

Designation of Contracting States

(1) The request for the grant of a European patent shall contain the designation of the Contracting State or States in which protection for the invention is desired.

(2)⁵¹ The designation of a contracting state shall be subject to the payment of the designation fee. The designation fees shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report.

(3) The designation of a Contracting State may be withdrawn at any time up to the grant of the European patent. Withdrawal of the designation of all the Contracting States shall be deemed to be a withdrawal of the European patent application. Designation fees shall not be refunded.

*Article 80*⁵²

Date of filing

The date of filing of a European patent application shall be the date on which documents filed by the applicant contain:

- (a) an indication that a European patent is sought;
- (b) the designation of at least one Contracting State;

⁴⁹ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/91 (Anhang I).

⁵⁰ Siehe hierzu Entscheidung/Stellungnahme der Großen Beschwerdekammer G 3/91, G 4/98 (Anhang I).

⁵¹ Geändert durch Beschluss des Verwaltungsrats vom 05.12.1996, in Kraft getreten am 01.07.1997 (ABI. EPA 1997, 13 f.).

⁵² Siehe hierzu Entscheidung/Stellungnahme der Großen Beschwerdekammer G 2/95, G 4/98 (Anhang I).

⁴⁹ See decision of the Enlarged Board of Appeal G 3/91 (Annex I).

⁵⁰ See decision/opinion of the Enlarged Board of Appeal G 3/91, G 4/98 (Annex I).

⁵¹ Amended by decision of the Administrative Council of 05.12.1996 which entered into force on 01.07.1997 (OJ EPO 1997, 13 f.).

⁵² See decision/opinion of the Enlarged Board of Appeal G 2/95, G 4/98 (Annex I).

- b) une description de l'invention ;
- c) une ou plusieurs revendications ;
- d) les dessins auxquels se réfèrent la description ou les revendications ;
- e) un abrégé.

Verweisungen / References / Références

(2)⁴⁹ La demande de brevet européen donne lieu au paiement de la taxe de dépôt et de la taxe de recherche ; ces taxes doivent être acquittées au plus tard un mois après le dépôt de la demande.

(3) La demande de brevet européen doit satisfaire aux conditions prévues par le règlement d'exécution.

*Article 79*⁵⁰

Désignation des Etats contractants

(1) L'Etat contractant ou les Etats contractants dans lequel ou dans lesquels il est demandé que l'invention soit protégée doivent être désignés dans la requête en délivrance du brevet européen.

(2)⁵¹ La désignation d'un Etat contractant donne lieu au paiement d'une taxe de désignation. Les taxes de désignation sont acquittées dans un délai de six mois à compter de la date à laquelle le Bulletin européen des brevets a mentionné la publication du rapport de recherche européenne.

(3) La désignation d'un Etat contractant peut être retirée jusqu'à la délivrance du brevet européen. Le retrait de la désignation de tous les Etats contractants est réputé être un retrait de la demande de brevet européen. Les taxes de désignation ne sont pas restituées.

Art. 3, 66, 80, 88, 122, 149

R. 14, 15, 23a/bis, 25, 26, 51, 69, 85a/bis, 88, 92, 106, 107, 108

*Article 80*⁵²

Date de dépôt

La date de dépôt de la demande de brevet européen est celle à laquelle le demandeur a produit des documents qui contiennent :

- a) une indication selon laquelle un brevet européen est demandé ;
- b) la désignation d'au moins un Etat contractant ;

Art. 54, 60, 66, 78, 79, 83, 84, 90-92

R. 26, 27, 27a/bis, 29, 35, 39, 43, 92

⁴⁹ Cf. la décision de la Grande Chambre de recours G 3/91 (Annexe I).

⁵⁰ Cf. la décision/l'avis de la Grande Chambre de recours G 3/91, G 4/98 (Annexe I).

⁵¹ Modifié par décision du Conseil d'administration en date du 05.12.1996, entrée en vigueur le 01.07.1997 (JO OEB 1997, 13 s.).

⁵² Cf. la décision/l'avis de la Grande Chambre de recours G 2/95, G 4/98 (Annexe I).

c) Angaben, die es erlauben, die Identität des Anmelders festzustellen;

d) in einer der in Artikel 14 Absätze 1 und 2 vorgesehenen Sprachen eine Beschreibung und einen oder mehrere Patentansprüche, selbst wenn die Beschreibung und die Patentansprüche nicht den übrigen Vorschriften dieses Übereinkommens entsprechen.

Artikel 81

Erfindernennung

In der europäischen Patentanmeldung ist der Erfinder zu nennen. Ist der Anmelder nicht oder nicht allein der Erfinder, so hat die Erfindernennung eine Erklärung darüber zu enthalten, wie der Anmelder das Recht auf das europäische Patent erlangt hat.

*Artikel 82*⁵³

Einheitlichkeit der Erfindung

Die europäische Patentanmeldung darf nur eine einzige Erfindung enthalten oder eine Gruppe von Erfindungen, die untereinander in der Weise verbunden sind, dass sie eine einzige allgemeine erfinderische Idee verwirklichen.

*Artikel 83*⁵⁴

Offenbarung der Erfindung

Die Erfindung ist in der europäischen Patentanmeldung so deutlich und vollständig zu offenbaren, dass ein Fachmann sie ausführen kann.

*Artikel 84*⁵⁵

Patentansprüche

Die Patentansprüche müssen den Gegenstand angeben, für den Schutz begehrt wird. Sie müssen deutlich, knapp gefasst und von der Beschreibung gestützt sein.

Artikel 85

Zusammenfassung

Die Zusammenfassung dient ausschließlich der technischen Information; sie kann nicht für andere Zwecke, insbesondere nicht für die Bestimmung des Umfangs des begehrten Schutzes und für die Anwendung des Artikels 54 Absatz 3, herangezogen werden.

(c) information identifying the applicant;

(d) a description and one or more claims in one of the languages referred to in Article 14, paragraphs 1 and 2, even though the description and the claims do not comply with the other requirements of this Convention.

Article 81

Designation of the inventor

The European patent application shall designate the inventor. If the applicant is not the inventor or is not the sole inventor, the designation shall contain a statement indicating the origin of the right to the European patent.

*Article 82*⁵³

Unity of invention

The European patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

*Article 83*⁵⁴

Disclosure of the invention

The European patent application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

*Article 84*⁵⁵

The claims

The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

Article 85

The abstract

The abstract shall merely serve for use as technical information; it may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought nor for the purpose of applying Article 54, paragraph 3.

⁵³ Siehe hierzu Entscheidung/Stellungnahme der Großen Beschwerdekammer G 1/91, G 2/92 (Anhang I).

⁵⁴ Siehe hierzu Entscheidung/Stellungnahme der Großen Beschwerdekammer G 2/93, G 2/98 (Anhang I).

⁵⁵ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 2/98, G 1/03, G 2/03 (Anhang I).

⁵³ See decision/opinion of the Enlarged Board of Appeal G 1/91, G 2/92 (Annex I).

⁵⁴ See decision/opinion of the Enlarged Board of Appeal G 2/93, G 2/98 (Annex I).

⁵⁵ See decisions/opinions of the Enlarged Board of Appeal G 2/98, G 1/03, G 2/03 (Annex I).

c) les indications qui permettent d'identifier le demandeur ;

Verweisungen / References / Références

d) une description et une ou plusieurs revendications dans une des langues visées à l'article 14, paragraphes 1 et 2, même si la description et les revendications ne sont pas conformes aux autres exigences de la présente convention.

Article 81

Désignation de l'inventeur

Art. 62, 91

R. 17-19, 26, 42, 92, 93, 111

La demande de brevet européen doit comprendre la désignation de l'inventeur. Si le demandeur n'est pas l'inventeur ou l'unique inventeur, cette désignation doit comporter une déclaration indiquant l'origine de l'acquisition du droit au brevet.

*Article 82*⁵³

Unité d'invention

R. 29, 30, 46, 112

La demande de brevet européen ne peut concerner qu'une invention ou une pluralité d'inventions liées entre elles de telle sorte qu'elles ne forment qu'un seul concept inventif général.

*Article 83*⁵⁴

Exposé de l'invention

Art. 78, 80, 100, 138

R. 27, 28, 28a/bis

L'invention doit être exposée dans la demande de brevet européen de façon suffisamment claire et complète pour qu'un homme du métier puisse l'exécuter.

*Article 84*⁵⁵

Revendications

Art. 78, 80

R. 29, 31, 35

Les revendications définissent l'objet de la protection demandée. Elles doivent être claires et concises et se fonder sur la description.

Article 85

Abrégé

Art. 78

R. 33, 35, 47, 49

L'abrégé sert exclusivement à des fins d'information technique ; il ne peut être pris en considération pour aucune autre fin, notamment pour apprécier l'étendue de la protection demandée et pour l'application de l'article 54, paragraphe 3.

⁵³ Cf. la décision/l'avis de la Grande Chambre de recours G 1/91, G 2/92 (Annexe I).

⁵⁴ Cf. la décision/l'avis de la Grande Chambre de recours G 2/93, G 2/98 (Annexe I).

⁵⁵ Cf. les décisions/avis de la Grande Chambre de recours G 2/98, G 1/03, G 2/03 (Annexe I).

Jahresgebühren für die europäische
Patentanmeldung

(1) Für die europäische Patentanmeldung sind nach Maßgabe der Ausführungsordnung Jahresgebühren an das Europäische Patentamt zu entrichten. Sie werden für das dritte und jedes weitere Jahr, gerechnet vom Anmeldetag an, geschuldet.

(2) Erfolgt die Zahlung einer Jahresgebühr nicht bis zum Fälligkeitstag, so kann die Jahresgebühr noch innerhalb von sechs Monaten nach Fälligkeit wirksam entrichtet werden, sofern gleichzeitig die Zuschlagsgebühr entrichtet wird.

(3) Werden die Jahresgebühr und gegebenenfalls die Zuschlagsgebühr nicht rechtzeitig entrichtet, so gilt die europäische Patentanmeldung als zurückgenommen. Das Europäische Patentamt ist allein befugt, hierüber zu entscheiden.

(4) Die Verpflichtung zur Zahlung von Jahresgebühren endet mit der Zahlung der Jahresgebühr, die für das Jahr fällig ist, in dem der Hinweis auf die Erteilung des europäischen Patents bekannt gemacht wird.

Kapitel II

Priorität

Artikel 87⁵⁷

Prioritätsrecht

(1) Jedermann, der in einem oder mit Wirkung für einen Vertragsstaat der Pariser Verbandsübereinkunft zum Schutz des gewerblichen Eigentums eine Anmeldung für ein Patent, ein Gebrauchsmuster, ein Gebrauchszertifikat oder einen Erfinderschein vorschriftsmäßig eingereicht hat, oder sein Rechtsnachfolger genießt für die Anmeldung derselben Erfindung zum europäischen Patent während einer Frist von zwölf Monaten nach der Einreichung der ersten Anmeldung ein Prioritätsrecht.

(2) Als prioritätsbegründend wird jede Anmeldung anerkannt, der nach dem nationalen Recht des Staats, in dem die Anmeldung eingereicht worden ist, oder nach zwei- oder mehrseitigen Verträgen unter Einschluss dieses Übereinkommens die Bedeutung einer vorschriftsmäßigen nationalen Anmeldung zukommt.

⁵⁶ Siehe hierzu den Hinweis zur Zahlung von Jahresgebühren für europäische Patentanmeldungen und Patente (ABI. EPA 1984, 272 ff.).

⁵⁷ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 3/93, G 2/95, G 2/98, G 2/02 und G 3/02, G 1/03, G 2/03 (Anhang I).

Renewal fees for European patent applications

(1) Renewal fees shall be paid to the European Patent Office in accordance with the Implementing Regulations in respect of European patent applications. These fees shall be due in respect of the third year and each subsequent year, calculated from the date of filing of the application.

(2) When a renewal fee has not been paid on or before the due date, the fee may be validly paid within six months of the said date, provided that the additional fee is paid at the same time.

(3) If the renewal fee and any additional fee have not been paid in due time the European patent application shall be deemed to be withdrawn. The European Patent Office alone shall be competent to decide this.

(4) The obligation to pay renewal fees shall terminate with the payment of the renewal fee due in respect of the year in which the mention of the grant of the European patent is published.

Chapter II

Priority

Article 87⁵⁷

Priority right

(1) A person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property, an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate, or his successors in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

(2) Every filing that is equivalent to a regular national filing under the national law of the State where it was made or under bilateral or multilateral agreements, including this Convention, shall be recognised as giving rise to a right of priority.

⁵⁶ See instructions for paying renewal fees for European patent applications and patents (OJ EPO 1984, 272 ff).

⁵⁷ See decisions/opinions of the Enlarged Board of Appeal G 3/93, G 2/95, G 2/98, G 2/02 and G 3/02, G 1/03, G 2/03 (Annex I).

Article 86⁵⁶

Taxes annuelles pour la demande de brevet européen

- (1) Des taxes annuelles doivent, conformément aux dispositions du règlement d'exécution, être payées à l'Office européen des brevets pour les demandes de brevet européen. Ces taxes sont dues pour la troisième année, calculée du jour anniversaire du dépôt de la demande, et pour chacune des années suivantes.
- (2) Lorsque le paiement d'une taxe annuelle n'a pas été effectué à l'échéance, cette taxe peut encore être valablement acquittée dans un délai de six mois à compter de l'échéance, sous réserve du paiement simultané d'une surtaxe.
- (3) Si la taxe annuelle et, le cas échéant, la surtaxe n'a pas été acquittée dans les délais, la demande de brevet européen est réputée retirée. Seul, l'Office européen des brevets est habilité à prendre cette décision.
- (4) Aucune taxe annuelle n'est plus exigible après le paiement de celle qui doit être acquittée au titre de l'année au cours de laquelle est publiée la mention de la délivrance du brevet européen.

Chapitre II

Priorité

Article 87⁵⁷

Droit de priorité

- (1) Celui qui a régulièrement déposé, dans ou pour l'un des Etats parties à la Convention de Paris pour la protection de la propriété industrielle, une demande de brevet d'invention, de modèle d'utilité, de certificat d'utilité ou de certificat d'inventeur, ou son ayant cause, jouit, pour effectuer le dépôt d'une demande de brevet européen pour la même invention, d'un droit de priorité pendant un délai de douze mois après le dépôt de la première demande.
- (2) Est reconnu comme donnant naissance au droit de priorité, tout dépôt ayant la valeur d'un dépôt national régulier en vertu de la législation nationale de l'Etat dans lequel il a été effectué ou d'accords bilatéraux ou multilatéraux, y compris la présente convention.

Verweisungen / References / Références

Art. 122, 141

R. 13, 37, 51, 69, 90, 107

Remarque : dans la seconde phrase de l'article 86, paragraphe 1, le texte français diffère des textes allemand et anglais, selon lesquels les taxes annuelles sont dues pour la troisième année, calculée de la date de dépôt, et pour chacune des années suivantes. Il convient, en vue d'une application uniforme, de considérer qu'au lieu de l'expression «du jour anniversaire du dépôt» aucun texte autre que «de la date de dépôt» n'a pu être envisagé.

Art. 35, 66, 122

R. 41

⁵⁶ Cf. l'avis concernant le paiement des taxes annuelles pour les demandes de brevet européen et pour les brevets européens (JO OEB 1984, 272 s.).

⁵⁷ Cf. les décisions/avis de la Grande Chambre de recours G 3/93, G 2/95, G 2/98, G 2/02 et G 3/02, G 1/03, G 2/03 (Annexe I).

(3) Unter vorschriftsmäßiger nationaler Anmeldung ist jede Anmeldung zu verstehen, die zur Festlegung des Tags ausreicht, an dem die Anmeldung eingereicht worden ist, wobei das spätere Schicksal der Anmeldung ohne Bedeutung ist.

(4) Als die erste Anmeldung, von deren Einreichung an die Prioritätsfrist läuft, wird auch eine jüngere Anmeldung angesehen, die denselben Gegenstand betrifft wie eine erste ältere in demselben oder für denselben Staat eingereichte Anmeldung, sofern diese ältere Anmeldung bis zur Einreichung der jüngeren Anmeldung zurückgenommen, fallen gelassen oder zurückgewiesen worden ist, und zwar bevor sie öffentlich ausgelegt worden ist und ohne dass Rechte bestehen geblieben sind; ebenso wenig darf diese ältere Anmeldung schon Grundlage für die Inanspruchnahme des Prioritätsrechts gewesen sein. Die ältere Anmeldung kann in diesem Fall nicht mehr als Grundlage für die Inanspruchnahme des Prioritätsrechts dienen.

(5) Ist die erste Anmeldung in einem nicht zu den Vertragsstaaten der Pariser Verbandsübereinkunft zum Schutz des gewerblichen Eigentums gehörenden Staat eingereicht worden, so sind die Absätze 1 bis 4 nur insoweit anzuwenden, als dieser Staat nach einer Bekanntmachung des Verwaltungsrats auf Grund einer ersten Anmeldung beim Europäischen Patentamt und auf Grund einer ersten Anmeldung in jedem oder für jeden Vertragsstaat gemäß zwei- oder mehrseitigen Verträgen ein Prioritätsrecht gewährt, und zwar unter Voraussetzungen und mit Wirkungen, die denen der Pariser Verbandsübereinkunft vergleichbar sind.

*Artikel 88*⁵⁸

Inanspruchnahme der Priorität

(1) Der Anmelder, der die Priorität einer früheren Anmeldung in Anspruch nehmen will, hat eine Prioritätserklärung, eine Abschrift der früheren Anmeldung und, wenn die Sprache der früheren Anmeldung nicht eine Amtssprache des Europäischen Patentamts ist, eine Übersetzung der früheren Anmeldung in einer der Amtssprachen einzureichen. Das Verfahren zur Durchführung dieser Vorschrift ist in der Ausführungsordnung vorgeschrieben.

(2) Für eine europäische Patentanmeldung können mehrere Prioritäten in Anspruch genommen werden, selbst wenn sie aus verschiedenen Staaten stammen. Für einen Patentanspruch können mehrere Prioritäten in Anspruch genommen werden. Werden mehrere Prioritäten in Anspruch genommen, so beginnen Fristen, die vom Prioritätstag an laufen, vom frühesten Prioritätstag an zu laufen.

⁵⁸ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 3/93, G 2/98, G 2/02 und G 3/02 (Anhang I).

(3) By a regular national filing is meant any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application.

(4) A subsequent application for the same subject-matter as a previous first application and filed in or in respect of the same State shall be considered as the first application for the purposes of determining priority, provided that, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

(5) If the first filing has been made in a State which is not a party to the Paris Convention for the Protection of Industrial Property, paragraphs 1 to 4 shall apply only in so far as that State, according to a notification published by the Administrative Council, and by virtue of bilateral or multilateral agreements, grants on the basis of a first filing made at the European Patent Office as well as on the basis of a first filing made in or for any Contracting State and subject to conditions equivalent to those laid down in the Paris Convention, a right of priority having equivalent effect.

*Article 88*⁵⁸

Claiming priority

(1) An applicant for a European patent desiring to take advantage of the priority of a previous application shall file a declaration of priority, a copy of the previous application and, if the language of the latter is not one of the official languages of the European Patent Office, a translation of it in one of such official languages. The procedure to be followed in carrying out these provisions is laid down in the Implementing Regulations.

(2) Multiple priorities may be claimed in respect of a European patent application, notwithstanding the fact that they originated in different countries. Where appropriate, multiple priorities may be claimed for any one claim. Where multiple priorities are claimed, time limits which run from the date of priority shall run from the earliest date of priority.

⁵⁸ See decisions/opinions of the Enlarged Board of Appeal G 3/93, G 2/98, G 2/02 and G 3/02 (Annex I).

(3) Par dépôt national régulier, on doit entendre tout dépôt qui suffit à établir la date à laquelle la demande a été déposée, quel que soit le sort ultérieur de cette demande.

(4) Est considérée comme première demande, dont la date de dépôt est le point de départ du délai de priorité, une demande ultérieure ayant le même objet qu'une première demande antérieure, déposée dans ou pour le même Etat, à la condition que cette demande antérieure, à la date de dépôt de la demande ultérieure, ait été retirée, abandonnée ou refusée, sans avoir été soumise à l'inspection publique et sans laisser subsister de droits, et qu'elle n'ait pas encore servi de base pour la revendication du droit de priorité. La demande antérieure ne peut plus alors servir de base pour la revendication du droit de priorité.

(5) Si le premier dépôt a été effectué dans un Etat qui n'est pas partie à la Convention de Paris pour la protection de la propriété industrielle, les dispositions des paragraphes 1 à 4 ne s'appliquent que dans la mesure où, suivant une communication publique du Conseil d'administration, cet Etat accorde, en vertu d'accords bilatéraux ou multilatéraux, sur la base d'un premier dépôt effectué auprès de l'Office européen des brevets, ainsi que sur la base d'un premier dépôt effectué dans ou pour tout Etat contractant, un droit de priorité soumis à des conditions et ayant des effets équivalents à ceux prévus par la Convention de Paris.

*Article 88*⁵⁸

Revendication de priorité

Art. 66, 79, 91, 93

R. 5, 6, 26, 38, 41, 88, 111

(1) Le demandeur d'un brevet européen qui veut se prévaloir de la priorité d'un dépôt antérieur est tenu de produire une déclaration de priorité, une copie de la demande antérieure accompagnée de sa traduction dans une des langues officielles de l'Office européen des brevets si la langue de la demande antérieure n'est pas une des langues officielles de l'Office. La procédure pour l'application de ces dispositions est prescrite par le règlement d'exécution.

(2) Des priorités multiples peuvent être revendiquées pour une demande de brevet européen même si elles proviennent d'Etats différents. Le cas échéant, des priorités multiples peuvent être revendiquées pour une même revendication. Si des priorités multiples sont revendiquées, les délais qui ont pour point de départ la date de priorité sont calculés à compter de la date de la priorité la plus ancienne.

⁵⁸ Cf. les décisions/avis de la Grande Chambre de recours G 3/93, G 2/98, G 2/02 et G 3/02 (Annexe I).

(3) Werden eine oder mehrere Prioritäten für die europäische Patentanmeldung in Anspruch genommen, so umfasst das Prioritätsrecht nur die Merkmale der europäischen Patentanmeldung, die in der Anmeldung oder den Anmeldungen enthalten sind, deren Priorität in Anspruch genommen worden ist.

(4) Sind bestimmte Merkmale der Erfindung, für die die Priorität in Anspruch genommen wird, nicht in den in der früheren Anmeldung aufgestellten Patentansprüchen enthalten, so reicht es für die Gewährung der Priorität aus, dass die Gesamtheit der Anmeldeunterlagen der früheren Anmeldung diese Merkmale deutlich offenbart.

*Artikel 89*⁵⁹

Wirkung des Prioritätsrechts

Das Prioritätsrecht hat die Wirkung, dass der Prioritätstag als Tag der europäischen Patentanmeldung für die Anwendung des Artikels 54 Absätze 2 und 3 sowie des Artikels 60 Absatz 2 gilt.

(3) If one or more priorities are claimed in respect of a European patent application, the right of priority shall cover only those elements of the European patent application which are included in the application or applications whose priority is claimed.

(4) If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted, provided that the documents of the previous application as a whole specifically disclose such elements.

*Article 89*⁵⁹

Effect of priority right

The right of priority shall have the effect that the date of priority shall count as the date of filing of the European patent application for the purposes of Article 54, paragraphs 2 and 3, and Article 60, paragraph 2.

⁵⁹ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 3/93, G 2/98, G 3/98, G 2/99 (Anhang I).

⁵⁹ See decisions/opinions of the Enlarged Board of Appeal G 3/93, G 2/98, G 3/98, G 2/99 (Annex I).

(3) Lorsqu'une ou plusieurs priorités sont revendiquées pour la demande de brevet européen, le droit de priorité ne couvre que les éléments de la demande de brevet européen qui sont contenus dans la demande ou dans les demandes dont la priorité est revendiquée.

(4) Si certains éléments de l'invention pour lesquels la priorité est revendiquée ne figurent pas parmi les revendications formulées dans la demande antérieure, il suffit, pour que la priorité puisse être accordée, que l'ensemble des pièces de la demande antérieure révèle d'une façon précise lesdits éléments.

*Article 89*⁵⁹

Effet du droit de priorité

Par l'effet du droit de priorité, la date de priorité est considérée comme celle du dépôt de la demande de brevet européen pour l'application de l'article 54, paragraphes 2 et 3, et de l'article 60, paragraphe 2.

⁵⁹ Cf. les décisions/avis de la Grande Chambre de recours G 3/93, G 2/98, G 3/98, G 2/99 (Annexe I).

VIERTER TEIL
ERTEILUNGSVERFAHREN

*Artikel 90*⁶⁰

Eingangsprüfung

- (1) Die Eingangsstelle prüft, ob
- a) die europäische Patentanmeldung den Erfordernissen für die Zuerkennung eines Anmeldetags genügt;
 - b) die Anmeldegebühr und die Recherchegebühr rechtzeitig entrichtet worden sind;
 - c) im Fall des Artikels 14 Absatz 2 die Übersetzung der europäischen Patentanmeldung in der Verfahrenssprache rechtzeitig eingereicht worden ist.
- (2) Kann ein Anmeldetag nicht zuerkannt werden, so gibt die Eingangsstelle dem Anmelder nach Maßgabe der Ausführungsordnung Gelegenheit, die festgestellten Mängel zu beseitigen. Werden die Mängel nicht rechtzeitig beseitigt, so wird die Anmeldung nicht als europäische Patentanmeldung behandelt.
- (3) Sind die Anmeldegebühr und die Recherchegebühr nicht rechtzeitig entrichtet worden oder ist im Fall des Artikels 14 Absatz 2 die Übersetzung der europäischen Patentanmeldung in der Verfahrenssprache nicht rechtzeitig eingereicht worden, so gilt die europäische Patentanmeldung als zurückgenommen.

*Artikel 91*⁶¹

Formalprüfung

- (1) Steht der Anmeldetag einer europäischen Patentanmeldung fest und gilt die Anmeldung nicht nach Artikel 90 Absatz 3 als zurückgenommen, so prüft die Eingangsstelle, ob
- a) den Erfordernissen des Artikels 133 Absatz 2 entsprochen worden ist;
 - b) die Anmeldung den Formerfordernissen genügt, die zur Durchführung dieser Vorschrift in der Ausführungsordnung vorgeschrieben sind;
 - c) die Zusammenfassung eingereicht worden ist;
 - d) der Antrag auf Erteilung eines europäischen Patents hinsichtlich seines Inhalts den zwingenden Vorschriften genügt, die in der Ausführungsordnung vorgeschrieben sind, und ob gegebenenfalls den Vorschriften dieses Übereinkommens über die Inanspruchnahme der Priorität entsprochen worden ist;
 - e) die Benennungsgebühren entrichtet worden sind;

⁶⁰ Siehe hierzu Stellungnahmen der Großen Beschwerdekammer G 4/98, G 1/02 (Anhang I).

⁶¹ Siehe hierzu Stellungnahmen der Großen Beschwerdekammer G 4/98, G 1/02 (Anhang I).

PART IV
PROCEDURE UP TO GRANT

*Article 90*⁶⁰

Examination on filing

- (1) The Receiving Section shall examine whether:
- (a) the European patent application satisfies the requirements for the accordancy of a date of filing;
 - (b) the filing fee and the search fee have been paid in due time;
 - (c) in the case provided for in Article 14, paragraph 2, the translation of the European patent application in the language of the proceedings has been filed in due time.
- (2) If a date of filing cannot be accorded, the Receiving Section shall give the applicant an opportunity to correct the deficiencies in accordance with the Implementing Regulations. If the deficiencies are not remedied in due time, the application shall not be dealt with as a European patent application.
- (3) If the filing fee and the search fee have not been paid in due time or, in the case provided for in Article 14, paragraph 2, the translation of the application in the language of the proceedings has not been filed in due time, the application shall be deemed to be withdrawn.

*Article 91*⁶¹

Examination as to formal requirements

- (1) If a European patent application has been accorded a date of filing, and is not deemed to be withdrawn by virtue of Article 90, paragraph 3, the Receiving Section shall examine whether:
- (a) the requirements of Article 133, paragraph 2, have been satisfied;
 - (b) the application meets the physical requirements laid down in the Implementing Regulations for the implementation of this provision;
 - (c) the abstract has been filed;
 - (d) the request for the grant of a European patent satisfies the mandatory provisions of the Implementing Regulations concerning its content and, where appropriate, whether the requirements of this Convention concerning the claim to priority have been satisfied;
 - (e) the designation fees have been paid;

⁶⁰ See opinions of the Enlarged Board of Appeal G 4/98, G 1/02 (Annex I).

⁶¹ See opinions of the Enlarged Board of Appeal G 4/98, G 1/02 (Annex I).

QUATRIÈME PARTIE

Verweisungen / References / Références

PROCÉDURE JUSQU'À LA DÉLIVRANCE

*Article 90*⁶⁰

Examen lors du dépôt

Art. 16, 78, 80, 91, 92
R. 6, 39, 69, 70, 85a/bis, 90

- (1) La section de dépôt examine
- a) si la demande de brevet européen remplit les conditions pour qu'il lui soit accordé une date de dépôt ;
 - b) si les taxes de dépôt et de recherche ont été acquittées dans les délais et
 - c) si, dans le cas prévu à l'article 14, paragraphe 2, la traduction de la demande de brevet européen dans la langue de la procédure a été produite dans les délais.
- (2) Si une date de dépôt ne peut être accordée, la section de dépôt invite le demandeur à remédier, dans les conditions prévues par le règlement d'exécution, aux irrégularités constatées. S'il n'est pas remédié en temps utile à ces irrégularités, la demande n'est pas traitée en tant que demande de brevet européen.
- (3) Si les taxes de dépôt et de recherche n'ont pas été acquittées dans les délais ou si, dans le cas visé à l'article 14, paragraphe 2, la traduction de la demande dans la langue de la procédure n'a pas été produite dans les délais, la demande de brevet européen est réputée retirée.

*Article 91*⁶¹

Examen de la demande de brevet européen quant à certaines irrégularités

Art. 16, 80, 88
R. 31, 40-43, 68-70, 85a/bis, 86, 88, 89, 90, 101

- (1) Si une date de dépôt a été accordée à une demande de brevet européen, et si la demande n'est pas réputée retirée en vertu de l'article 90, paragraphe 3, la section de dépôt examine :
- a) s'il est satisfait aux exigences de l'article 133, paragraphe 2 ;
 - b) si la demande satisfait aux conditions de forme prévues par le règlement d'exécution pour l'application de la présente disposition ;
 - c) si l'abrégé a été déposé ;
 - d) si la requête en délivrance du brevet européen satisfait, en ce qui concerne son contenu, aux dispositions impératives du règlement d'exécution et, le cas échéant, s'il est satisfait aux exigences de la présente convention concernant la revendication de priorité ;
 - e) si les taxes de désignation ont été acquittées ;

⁶⁰ Cf. les avis de la Grande Chambre de recours G 4/98, G 1/02 (Annexe I).

⁶¹ Cf. les avis de la Grande Chambre de recours G 4/98, G 1/02 (Annexe I).

f) die Erfindernennung nach Artikel 81 erfolgt ist;

g) die in Artikel 78 Absatz 1 Buchstabe d genannten Zeichnungen am Anmeldetag eingereicht worden sind.

(2) Stellt die Eingangsstelle behebbare Mängel fest, so gibt sie dem Anmelder nach Maßgabe der Ausführungsordnung Gelegenheit, diese Mängel zu beseitigen.

(3) Werden die in den Fällen des Absatzes 1 Buchstaben a bis d festgestellten Mängel nicht nach Maßgabe der Ausführungsordnung beseitigt, so wird die europäische Patentanmeldung zurückgewiesen; betreffen die in Absatz 1 Buchstabe d genannten Vorschriften den Prioritätsanspruch, so erlischt der Prioritätsanspruch für die Anmeldung.

(4) Wird im Fall des Absatzes 1 Buchstabe e die Benennungsgebühr für einen Vertragsstaat nicht rechtzeitig entrichtet, so gilt die Benennung dieses Staats als zurückgenommen.

(5) Wird im Fall des Absatzes 1 Buchstabe f die Erfindernennung nicht nach Maßgabe der Ausführungsordnung vorbehaltlich der darin vorgesehenen Ausnahmen innerhalb von sechzehn Monaten nach dem Anmeldetag oder, wenn eine Priorität in Anspruch genommen worden ist, nach dem Prioritätstag nachgeholt, so gilt die europäische Patentanmeldung als zurückgenommen.

(6) Werden im Fall des Absatzes 1 Buchstabe g die Zeichnungen nicht am Anmeldetag eingereicht und wird der Mangel nicht nach Maßgabe der Ausführungsordnung beseitigt, so tritt nach der vom Anmelder auf Grund der Ausführungsordnung getroffenen Wahl die Rechtsfolge ein, dass entweder der Anmeldetag neu auf den Tag der Einreichung der Zeichnungen festgesetzt wird oder die Bezugnahmen auf die Zeichnungen in der Anmeldung als gestrichen gelten.

(f) the designation of the inventor has been made in accordance with Article 81;

(g) the drawings referred to in Article 78, paragraph 1(d), were filed on the date of filing of the application.

(2) Where the Receiving Section notes that there are deficiencies which may be corrected, it shall give the applicant an opportunity to correct them in accordance with the Implementing Regulations.

(3) If any deficiencies noted in the examination under paragraph 1(a) to (d) are not corrected in accordance with the Implementing Regulations, the application shall be refused; where the provisions referred to in paragraph 1(d) concern the right of priority, this right shall be lost for the application.

(4) Where, in the case referred to in paragraph 1(e), the designation fee has not been paid in due time in respect of any designated State, the designation of that State shall be deemed to be withdrawn.

(5) Where, in the case referred to in paragraph 1(f), the omission of the designation of the inventor is not, in accordance with the Implementing Regulations and subject to the exceptions laid down therein, corrected within 16 months after the date of filing of the European patent application or, if priority is claimed, after the date of priority, the application shall be deemed to be withdrawn.

(6) Where, in the case referred to in paragraph 1(g), the drawings were not filed on the date of filing of the application and no steps have been taken to correct the deficiency in accordance with the Implementing Regulations, either the application shall be re-dated to the date of filing of the drawings or any reference to the drawings in the application shall be deemed to be deleted, according to the choice exercised by the applicant in accordance with the Implementing Regulations.

Artikel 92

Erstellung des europäischen Recherchenberichts

(1) Steht der Anmeldetag einer europäischen Patentanmeldung fest und gilt die Anmeldung nicht nach Artikel 90 Absatz 3 als zurückgenommen, so erstellt die Recherchenabteilung den europäischen Recherchenbericht auf der Grundlage der Patentansprüche unter angemessener Berücksichtigung der Beschreibung und der vorhandenen Zeichnungen in der in der Ausführungsordnung vorgeschriebenen Form.

(2) Der europäische Recherchenbericht wird unmittelbar nach seiner Erstellung dem Anmelder zusammen mit den Abschriften aller angeführten Schriftstücke übersandt.

Article 92

The drawing up of the European search report

(1) If a European patent application has been accorded a date of filing and is not deemed to be withdrawn by virtue of Article 90, paragraph 3, the Search Division shall draw up the European search report on the basis of the claims, with due regard to the description and any drawings, in the form prescribed in the Implementing Regulations.

(2) Immediately after it has been drawn up, the European search report shall be transmitted to the applicant together with copies of any cited documents.

f) si la désignation de l'inventeur a été faite conformément à l'article 81 ;

g) si les dessins auxquels fait référence l'article 78, paragraphe 1, lettre d) ont été déposés à la date de dépôt de la demande.

(2) Lorsque la section de dépôt constate l'existence d'irrégularités auxquelles il peut être remédié, elle donne au demandeur, conformément aux dispositions du règlement d'exécution, la faculté de remédier à ces irrégularités.

(3) Lorsqu'il n'est pas remédié, conformément aux dispositions du règlement d'exécution, aux irrégularités constatées lors de l'examen effectué au titre du paragraphe 1, lettres a) à d), la demande de brevet européen est rejetée ; lorsque les dispositions auxquelles il est fait référence au paragraphe 1, lettre d) concernent le droit de priorité, leur inobservation entraîne la perte de ce droit pour la demande.

(4) Si, dans le cas visé au paragraphe 1, lettre e), la taxe de désignation afférente à un Etat désigné n'a pas été acquittée dans les délais, cette désignation est réputée retirée.

(5) Lorsque, dans le cas visé au paragraphe 1, lettre f), il n'a pas été remédié au défaut de désignation de l'inventeur conformément aux dispositions du règlement d'exécution et sous réserve des exceptions prévues par celui-ci, dans un délai de seize mois à compter de la date de dépôt de la demande de brevet européen ou, si une priorité est revendiquée, à compter de la date de priorité, la demande de brevet est réputée retirée.

(6) Si, dans le cas visé au paragraphe 1, lettre g), les dessins n'ont pas été déposés à la date de dépôt de la demande et si des mesures n'ont pas été prises dans les conditions prévues par le règlement d'exécution en vue de pallier cette situation, la date de dépôt de la demande sera celle à laquelle les dessins ont été déposés ou les références aux dessins dans la demande seront réputées supprimées, au choix du demandeur, dans les conditions prévues par le règlement d'exécution.

Article 92

Etablissement du rapport de recherche européenne

*Art. 17, 80, 96, 157
R. 44-47, 86*

(1) Si une date de dépôt a été accordée à une demande de brevet européen, et si la demande n'est pas réputée retirée en vertu de l'article 90, paragraphe 3, la division de la recherche établit le rapport de recherche européenne dans la forme prescrite par le règlement d'exécution, sur la base des revendications, en tenant dûment compte de la description et, le cas échéant, des dessins existants.

(2) Dès qu'il est établi, le rapport de recherche européenne est notifié au demandeur ; il est accompagné de copies de tous les documents cités.

Veröffentlichung der europäischen Patentanmeldung

(1) Die europäische Patentanmeldung wird unverzüglich nach Ablauf von achtzehn Monaten nach dem Anmeldetag oder, wenn eine Priorität in Anspruch genommen worden ist, nach dem Prioritätstag veröffentlicht. Sie kann jedoch auf Antrag des Anmelders vor Ablauf dieser Frist veröffentlicht werden. Wird die Entscheidung, durch die das europäische Patent erteilt worden ist, vor Ablauf dieser Frist wirksam, so wird die Anmeldung gleichzeitig mit der europäischen Patentschrift veröffentlicht.

(2) Die Veröffentlichung enthält die Beschreibung, die Patentansprüche und gegebenenfalls die Zeichnungen jeweils in der ursprünglich eingereichten Fassung sowie als Anlage den europäischen Recherchenbericht und die Zusammenfassung, sofern diese vor Abschluss der technischen Vorbereitungen für die Veröffentlichung vorliegen. Sind der europäische Recherchenbericht und die Zusammenfassung nicht mit der Anmeldung veröffentlicht worden, so werden sie gesondert veröffentlicht.

Artikel 94

Prüfungsantrag

(1) Das Europäische Patentamt prüft auf schriftlichen Antrag, ob die europäische Patentanmeldung und die Erfindung, die sie zum Gegenstand hat, den Erfordernissen dieses Übereinkommens genügen.

(2)⁶³ Der Prüfungsantrag kann vom Anmelder bis zum Ablauf von sechs Monaten nach dem Tag gestellt werden, an dem im Europäischen Patentblatt auf die Veröffentlichung des europäischen Recherchenberichts hingewiesen worden ist. Der Antrag gilt erst als gestellt, wenn die Prüfungsgebühr entrichtet worden ist. Der Antrag kann nicht zurückgenommen werden.

(3) Wird bis zum Ablauf der in Absatz 2 genannten Frist ein Prüfungsantrag nicht gestellt, so gilt die europäische Patentanmeldung als zurückgenommen.

Artikel 95

Verlängerung der Frist zur Stellung des Prüfungsantrags

(1) Der Verwaltungsrat kann die Frist zur Stellung des Prüfungsantrags verlängern, wenn feststeht, dass die europäischen Patentanmeldungen nicht in angemessener Zeit geprüft werden können.

Publication of a European patent application

(1) A European patent application shall be published as soon as possible after the expiry of a period of eighteen months from the date of filing or, if priority has been claimed, as from the date of priority. Nevertheless, at the request of the applicant the application may be published before the expiry of the period referred to above. It shall be published simultaneously with the publication of the specification of the European patent when the grant of the patent has become effective before the expiry of the period referred to above.

(2) The publication shall contain the description, the claims and any drawings as filed and, in an annex, the European search report and the abstract, in so far as the latter are available before the termination of the technical preparations for publication. If the European search report and the abstract have not been published at the same time as the application, they shall be published separately.

Article 94

Request for examination

(1) The European Patent Office shall examine, on written request, whether a European patent application and the invention to which it relates meet the requirements of this Convention.

(2)⁶³ A request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request shall not be deemed to be filed until after the examination fee has been paid. The request may not be withdrawn.

(3) If no request for examination has been filed by the end of the period referred to in paragraph 2, the application shall be deemed to be withdrawn.

Article 95

Extension of the period within which requests for examination may be filed

(1) The Administrative Council may extend the period within which requests for examination may be filed if it is established that European patent applications cannot be examined in due time.

⁶² Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 2/98 (Anhang I).

⁶³ Siehe hierzu Rechtsauskunft Nr. 10/92 rev. (Anhang II).

⁶² See opinion of the Enlarged Board of Appeal G 2/98 (Annex I).

⁶³ See Legal advice No. 10/92 rev. (Annex II).

Article 93⁶²

Publication de la demande de brevet européen

(1) Toute demande de brevet européen est publiée dès que possible après l'expiration d'un délai de dix-huit mois à compter de la date de dépôt ou, si une priorité a été revendiquée, à compter de la date de cette priorité. Toutefois, elle peut être publiée avant le terme de ce délai sur requête du demandeur. Cette publication et celle du fascicule du brevet européen sont effectuées simultanément lorsque la décision relative à la délivrance du brevet européen a pris effet avant l'expiration dudit délai.

(2) Cette publication comporte la description, les revendications et, le cas échéant, les dessins, tels que ces documents ont été déposés, ainsi que, en annexe, le rapport de recherche européenne et l'abrégé, pour autant que ces derniers documents soient disponibles avant la fin des préparatifs techniques entrepris en vue de la publication. Si le rapport de recherche européenne et l'abrégé n'ont pas été publiés à la même date que la demande, ils font l'objet d'une publication séparée.

Article 94

Requête en examen

(1) Sur requête écrite, l'Office européen des brevets examine si la demande de brevet européen et l'invention qui en fait l'objet satisfont aux conditions prévues par la présente convention.

(2)⁶³ La requête en examen peut être formulée par le demandeur jusqu'à l'expiration d'un délai de six mois à compter de la date à laquelle le Bulletin européen des brevets a mentionné la publication du rapport de recherche européenne. La requête n'est considérée comme formulée qu'après le paiement de la taxe d'examen et ne peut être retirée.

(3) Lorsque la requête n'est pas formulée avant l'expiration du délai visé au paragraphe 2, la demande de brevet européen est réputée retirée.

Article 95

Prorogation du délai de présentation de la requête en examen

(1) Le Conseil d'administration peut proroger le délai de présentation de la requête en examen s'il est établi que les demandes de brevet européen ne peuvent être instruites en temps utile.

Verweisungen / References / Références

Art. 14, 16, 54, 67, 69, 88, 92, 98, 115, 127, 128, 157, 158

R. 13, 18, 33, 34, 38, 47-50, 92

Art. 16, 95, 122, 129, 150

R. 6, 50, 69, 85b/ter, 90, 107

⁶² Cf. l'avis de la Grande Chambre de recours G 2/98 (Annexe I).

⁶³ Cf. le renseignement juridique n° 10/92 rév. (Annexe II).

(2) Verlängert der Verwaltungsrat die Frist, so kann er beschließen, dass auch ein Dritter die Prüfung beantragen kann. In diesem Fall legt der Verwaltungsrat in der Ausführungsordnung die Vorschriften zur Durchführung dieses Beschlusses fest.

(3) Ein Beschluss des Verwaltungsrats, die Frist zu verlängern, ist nur auf die europäischen Patentanmeldungen anzuwenden, die nach der Veröffentlichung dieses Beschlusses im Amtsblatt des Europäischen Patentamts eingereicht werden.

(4) Verlängert der Verwaltungsrat die Frist, so hat er Maßnahmen zu treffen, um die ursprüngliche Frist so schnell wie möglich wiederherzustellen.

Artikel 96

Prüfung der europäischen Patentanmeldung

(1) Hat der Anmelder den Prüfungsantrag gestellt, bevor ihm der europäische Recherchenbericht zugegangen ist, so fordert ihn das Europäische Patentamt nach Übersendung des Berichts auf, innerhalb einer zu bestimmenden Frist zu erklären, ob er die europäische Patentanmeldung aufrechterhält.

(2)⁶⁴ Ergibt die Prüfung, dass die europäische Patentanmeldung oder die Erfindung, die sie zum Gegenstand hat, den Erfordernissen dieses Übereinkommens nicht genügt, so fordert die Prüfungsabteilung den Anmelder nach Maßgabe der Ausführungsordnung so oft wie erforderlich auf, innerhalb einer von ihr zu bestimmenden Frist eine Stellungnahme einzureichen.

(3) Unterlässt es der Anmelder, auf eine Aufforderung nach Absatz 1 oder 2 rechtzeitig zu antworten, so gilt die europäische Patentanmeldung als zurückgenommen.

Artikel 97⁶⁵

Zurückweisung oder Erteilung

(1) Ist die Prüfungsabteilung der Auffassung, dass die europäische Patentanmeldung oder die Erfindung, die sie zum Gegenstand hat, den Erfordernissen dieses Übereinkommens nicht genügt, so weist sie die europäische Patentanmeldung zurück, sofern in diesem Übereinkommen nicht eine andere Rechtsfolge vorgeschrieben ist.

⁶⁴ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 7/93, G 10/93 (Anhang I).

⁶⁵ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 10/93 (Anhang I) und die Rechtsauskünfte Nr. 17/90 und Nr. 15/05 (rev. 2) (Anhang II).

(2) If the Administrative Council extends the period, it may decide that third parties will be entitled to make requests for examination. In such cases, it shall determine the appropriate rules in the Implementing Regulations.

(3) Any decision of the Administrative Council to extend the period shall apply only in respect of applications filed after the publication of such decision in the Official Journal of the European Patent Office.

(4) If the Administrative Council extends the period, it must lay down measures with a view to restoring the original period as soon as possible.

Article 96

Examination of the European patent application

(1) If the applicant for a European patent has filed the request for examination before the European search report has been transmitted to him, the European Patent Office shall invite him after the transmission of the report to indicate, within a period to be determined, whether he desires to proceed further with the European patent application.

(2)⁶⁴ If the examination of a European patent application reveals that the application or the invention to which it relates does not meet the requirements of this Convention, the Examining Division shall invite the applicant, in accordance with the Implementing Regulations and as often as necessary, to file his observations within a period to be fixed by the Examining Division.

(3) If the applicant fails to reply in due time to any invitation under paragraph 1 or paragraph 2, the application shall be deemed to be withdrawn.

Article 97⁶⁵

Refusal or grant

(1) The Examining Division shall refuse a European patent application if it is of the opinion that such application or the invention to which it relates does not meet the requirements of this Convention, except where a different sanction is provided for by this Convention.

⁶⁴ See decisions of the Enlarged Board of Appeal G 7/93, G 10/93 (Annex I).

⁶⁵ See decision of the Enlarged Board of Appeal G 10/93 (Annex I) and Legal advice No. 17/90 and No. 15/05 (rev. 2) (Annex II).

(2) Si le Conseil d'administration proroge le délai, il peut décider que les tiers seront habilités à présenter la requête en examen. En pareil cas, il arrête dans le règlement d'exécution les dispositions appropriées.

Verweisungen / References / Références

(3) Toute décision du Conseil d'administration relative à la prorogation du délai n'affecte que les demandes de brevet européen déposées après la publication de cette décision au Journal officiel de l'Office européen des brevets.

(4) Si le Conseil d'administration proroge le délai, il est tenu de prendre des mesures afin de rétablir aussi rapidement que possible le délai initial.

Article 96

Examen de la demande de brevet européen

R. 51, 69, 70, 86, 87

(1) Si le demandeur d'un brevet européen a présenté la requête en examen avant que le rapport de recherche européenne ne lui ait été notifié, il est, après la notification du rapport, invité par l'Office européen des brevets à déclarer, dans le délai que celui-ci lui impartit, s'il maintient sa demande.

(2)⁶⁴ S'il résulte de l'examen que la demande de brevet européen et l'invention qui en fait l'objet ne satisfont pas aux conditions prévues par la présente convention, la division d'examen invite le demandeur, dans les conditions prévues par le règlement d'exécution et aussi souvent qu'il est nécessaire, à présenter ses observations dans le délai qu'elle lui impartit.

(3) Si, dans le délai qui lui a été impartit, le demandeur ne défère pas aux invitations qui lui ont été adressées en vertu des paragraphes 1 ou 2, la demande est réputée retirée.

*Article 97*⁶⁵

Rejet de la demande ou délivrance du brevet

Art. 14, 64, 65, 113, 129, 141
R. 51, 52, 68, 69, 70, 87, 89

(1) La division d'examen rejette la demande de brevet européen si elle estime que cette demande ou l'invention qui en fait l'objet ne satisfait pas aux conditions prévues par la présente convention, à moins que des sanctions différentes du rejet ne soient prévues par la convention.

⁶⁴ Cf. les décisions de la Grande Chambre de recours G 7/93, G 10/93 (Annexe I).

⁶⁵ Cf. la décision de la Grande Chambre de recours G 10/93 (Annexe I) et les renseignements juridiques n° 17/90 et n° 15/05 (rév. 2) (Annexe II).

(2) Ist die Prüfungsabteilung der Auffassung, dass die europäische Patentanmeldung und die Erfindung, die sie zum Gegenstand hat, den Erfordernissen dieses Übereinkommens genügen, so beschließt sie die Erteilung des europäischen Patents für die benannten Vertragsstaaten, vorausgesetzt, dass

a) gemäß der Ausführungsordnung feststeht, dass der Anmelder mit der Fassung, in der die Prüfungsabteilung das europäische Patent zu erteilen beabsichtigt, einverstanden ist,

b) die Erteilungsgebühr und die Druckkostengebühr innerhalb der in der Ausführungsordnung vorgeschriebenen Frist entrichtet und

c) die bereits fälligen Jahresgebühren und Zuschlagsgebühren entrichtet worden sind.

(3) Werden die Erteilungsgebühr und die Druckkostengebühr nicht rechtzeitig entrichtet, so gilt die europäische Patentanmeldung als zurückgenommen.

(4)⁶⁶ Die Entscheidung über die Erteilung des europäischen Patents wird erst an dem Tag wirksam, an dem im Europäischen Patentblatt auf die Erteilung hingewiesen worden ist. Dieser Hinweis wird frühestens zwei Monate nach Beginn der in Absatz 2 Buchstabe b genannten Frist bekannt gemacht.

(5)⁶⁶ In der Ausführungsordnung kann vorgesehen werden, dass der Anmelder eine Übersetzung der Fassung der Patentansprüche, in der die Prüfungsabteilung das europäische Patent zu erteilen beabsichtigt, in den beiden Amtssprachen des Europäischen Patentamts einzureichen hat, die nicht die Verfahrenssprache sind. In diesem Fall beträgt die in Absatz 4 vorgesehene Frist mindestens drei Monate. Wird die Übersetzung nicht rechtzeitig eingereicht, so gilt die europäische Patentanmeldung als zurückgenommen.

(6)⁶⁷ Auf Antrag des Anmelders wird der Hinweis auf die Erteilung des europäischen Patents vor Ablauf der Frist nach Absatz 4 oder 5 bekannt gemacht. Der Antrag kann erst gestellt werden, wenn die Erfordernisse nach den Absätzen 2 und 5 erfüllt sind.

Artikel 98⁶⁸

Veröffentlichung der europäischen Patentschrift

Das Europäische Patentamt gibt gleichzeitig mit der Bekanntmachung des Hinweises auf die Erteilung des europäischen Patents eine europäische Patentschrift heraus, in der die Beschreibung, die Patentansprüche und gegebenenfalls die Zeichnungen enthalten sind.

(2) If the Examining Division is of the opinion that the application and the invention to which it relates meet the requirements of this Convention, it shall decide to grant the European patent for the designated Contracting States provided that:

(a) it is established, in accordance with the provisions of the Implementing Regulations, that the applicant approves the text in which the Examining Division intends to grant the patent;

(b) the fees for grant and printing are paid within the time limit prescribed in the Implementing Regulations;

(c) the renewal fees and any additional fees already due have been paid.

(3) If the fees for grant and printing are not paid in due time, the application shall be deemed to be withdrawn.

(4)⁶⁶ The decision to grant a European patent shall not take effect until the date on which the European Patent Bulletin mentions the grant. This mention shall be published at least two months after the start of the time limit referred to in paragraph 2(b).

(5)⁶⁶ Provision may be made in the Implementing Regulations for the applicant to file a translation, in the two official languages of the European Patent Office other than the language of the proceedings, of the claims appearing in the text in which the Examining Division intends to grant the patent. In such case, the period laid down in paragraph 4 shall be at least three months. If the translation has not been filed in due time, the application shall be deemed to be withdrawn.

(6)⁶⁷ At the request of the applicant, mention of grant of the European patent shall be published before expiry of the time limit under paragraph 4 or 5. Such request may only be made if the requirements pursuant to paragraphs 2 and 5 are met.

Article 98⁶⁸

Publication of a specification of the European patent

At the same time as it publishes the mention of the grant of the European patent, the European Patent Office shall publish a specification of the European patent containing the description, the claims and any drawings.

⁶⁶ Geändert durch Beschluss des Verwaltungsrats vom 27.10.2005, in Kraft getreten am 01.01.2006 (ABl. EPA 2005, 545).

⁶⁷ Eingefügt durch Beschluss des Verwaltungsrats vom 20.10.1995, in Kraft getreten am 01.01.1996 (ABl. EPA 1995, 741).

⁶⁸ Siehe hierzu die Rechtsauskunft Nr. 17/90 (Anhang II).

⁶⁶ Amended by decision of the Administrative Council of 27.10.2005 which entered into force on 01.01.2006 (OJ EPO 2005, 545).

⁶⁷ Inserted by decision of the Administrative Council of 20.10.1995 which entered into force on 01.01.1996 (OJ EPO 1995, 741).

⁶⁸ See Legal advice No. 17/90 (Annex II).

(2) Lorsque la division d'examen estime que la demande de brevet européen et l'invention qui en fait l'objet satisfont aux conditions prévues par la présente convention, elle décide de délivrer le brevet européen pour les Etats désignés si,

a) dans les conditions prévues par le règlement d'exécution, il est établi que le demandeur est d'accord sur le texte dans lequel la division d'examen envisage de délivrer le brevet européen ;

b) les taxes de délivrance du brevet et d'impression du fascicule du brevet ont été acquittées dans le délai prescrit par le règlement d'exécution ;

c) les taxes annuelles et, le cas échéant, les surtaxes déjà exigibles ont été acquittées.

(3) Si les taxes de délivrance du brevet et d'impression du fascicule du brevet n'ont pas été acquittées dans les délais, la demande est réputée retirée.

(4)⁶⁶ La décision relative à la délivrance du brevet européen ne prend effet qu'au jour de la publication au Bulletin européen des brevets de la mention de cette délivrance. Cette mention est publiée au plus tôt deux mois à compter du point de départ du délai visé au paragraphe 2, lettre b).

(5)⁶⁶ Le règlement d'exécution peut prévoir que le demandeur produira une traduction des revendications figurant dans le texte dans lequel la division d'examen envisage de délivrer le brevet européen, dans les deux langues officielles de l'Office européen des brevets autres que celle de la procédure. Dans ce cas, le délai prévu au paragraphe 4 ne peut être inférieur à trois mois. Si la traduction n'est pas produite dans les délais, la demande est réputée retirée.

(6)⁶⁷ Sur requête du demandeur, la mention de la délivrance du brevet européen sera publiée avant l'expiration du délai prévu au paragraphe 4 ou 5. La requête ne peut être faite que si les exigences visées aux paragraphes 2 et 5 sont remplies.

*Article 98*⁶⁸

Publication du fascicule du brevet européen

L'Office européen des brevets publie simultanément la mention de la délivrance du brevet européen et le fascicule du brevet européen contenant la description, les revendications et, le cas échéant, les dessins.

Art. 14, 93

R. 18, 19, 38, 53, 54, 87

⁶⁶ Modifié par décision du Conseil d'administration en date du 27.10.2005, entrée en vigueur le 01.01.2006 (JO OEB 2005, 545).

⁶⁷ Inséré par décision du Conseil d'administration en date du 20.10.1995, entrée en vigueur le 01.01.1996 (JO OEB 1995, 741 s.).

⁶⁸ Cf. le renseignement juridique n° 17/90 (Annexe II).

FÜNFTER TEIL

EINSPRUCHSVERFAHREN

Artikel 99⁶⁹

Einspruch

(1) Innerhalb von neun Monaten nach der Bekanntmachung des Hinweises auf die Erteilung des europäischen Patents kann jedermann beim Europäischen Patentamt gegen das erteilte europäische Patent Einspruch einlegen. Der Einspruch ist schriftlich einzureichen und zu begründen. Er gilt erst als eingelegt, wenn die Einspruchsgebühr entrichtet worden ist.

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

(3) Der Einspruch kann auch eingelegt werden, wenn für alle benannten Vertragsstaaten auf das europäische Patent verzichtet worden ist oder wenn das europäische Patent für alle diese Staaten erloschen ist.

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

(5) Weist jemand nach, dass er in einem Vertragsstaat auf Grund einer rechtskräftigen Entscheidung anstelle des bisherigen Patentinhabers in das Patentregister dieses Staats eingetragen ist, so tritt er auf Antrag in Bezug auf diesen Staat an die Stelle des bisherigen Patentinhabers. Abweichend von Artikel 118 gelten der bisherige Patentinhaber und derjenige, der sein Recht geltend macht, nicht als gemeinsame Inhaber, es sei denn, dass beide dies verlangen.

Artikel 100⁷⁰

Einspruchsgründe

Der Einspruch kann nur darauf gestützt werden, dass

a) der Gegenstand des europäischen Patents nach den Artikeln 52 bis 57 nicht patentfähig ist;

b) das europäische Patent die Erfindung nicht so deutlich und vollständig offenbart, dass ein Fachmann sie ausführen kann;

c) der Gegenstand des europäischen Patents über den Inhalt der Anmeldung in der ursprünglich eingereichten Fassung oder, wenn das Patent auf einer europäischen Teilanmeldung oder einer nach Artikel 61 eingereichten neuen europäischen Patentanmeldung beruht, über den Inhalt der früheren Anmeldung in der ursprünglich eingereichten Fassung hinausgeht.

⁶⁹ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 4/88, G 5/88, G 7/88, G 8/88, G 10/91, G 9/93, G 1/95, G 7/95, G 3/97, G 4/97, G 3/99, G 1/02 (Anhang I).

⁷⁰ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 3/89, G 10/91, G 11/91, G 1/95, G 2/95, G 7/95, G 1/99 (Anhang I).

PART V

OPPOSITION PROCEDURE

Article 99⁶⁹

Opposition

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

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

(3) An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States.

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

(5) Where a person provides evidence that in a Contracting State, following a final decision, he has been entered in the patent register of such State instead of the previous proprietor, such person shall, at his request, replace the previous proprietor in respect of such State. By derogation from Article 118, the previous proprietor and the person making the request shall not be deemed to be joint proprietors unless both so request.

Article 100⁷⁰

Grounds for opposition

Opposition may only be filed on the grounds that:

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

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

(c) the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 61, beyond the content of the earlier application as filed.

⁶⁹ See decisions/opinions of the Enlarged Board of Appeal G 4/88, G 5/88, G 7/88, G 8/88, G 10/91, G 9/93, G 1/95, G 7/95, G 3/97, G 4/97, G 3/99, G 1/02 (Annex I).

⁷⁰ See decisions/opinions of the Enlarged Board of Appeal G 3/89, G 10/91, G 11/91; G 1/95, G 2/95, G 7/95, G 1/99 (Annex I).

CINQUIÈME PARTIE

Verweisungen / References / Références

PROCÉDURE D'OPPOSITION

*Article 99*⁶⁹

Opposition

(1) Dans un délai de neuf mois à compter de la date de publication de la mention de la délivrance du brevet européen, toute personne peut faire opposition au brevet européen délivré, auprès de l'Office européen des brevets. L'opposition doit être formée par écrit et motivée. Elle n'est réputée formée qu'après paiement de la taxe d'opposition.

(2) L'opposition au brevet européen affecte ce brevet dans tous les Etats contractants dans lesquels il produit ses effets.

(3) L'opposition peut être formée même s'il a été renoncé au brevet européen pour tous les Etats désignés ou si celui-ci s'est éteint pour tous ces Etats.

(4) Les tiers qui ont fait opposition sont parties, avec le titulaire du brevet, à la procédure d'opposition.

(5) Si une personne apporte la preuve que, dans un Etat contractant, elle est inscrite au registre des brevets, en vertu d'un jugement passé en force de chose jugée, au lieu et place du titulaire précédent, elle est, sur requête, substituée à ce dernier pour ledit Etat. Nonobstant les dispositions de l'article 118, le titulaire précédent du brevet et la personne qui fait ainsi valoir ses droits ne sont pas considérés comme copropriétaires, à moins qu'ils ne demandent tous deux à l'être.

*Article 100*⁷⁰

Motifs d'opposition

L'opposition ne peut être fondée que sur les motifs selon lesquels :

- a) l'objet du brevet européen n'est pas brevetable aux termes des articles 52 à 57 ;
- b) le brevet européen n'expose pas l'invention de façon suffisamment claire et complète pour qu'un homme du métier puisse l'exécuter ;
- c) l'objet du brevet européen s'étend au-delà du contenu de la demande telle qu'elle a été déposée ou, si le brevet a été délivré sur la base d'une demande divisionnaire ou d'une nouvelle demande déposée en vertu de l'article 61, au-delà du contenu de la demande initiale telle qu'elle a été déposée.

Art. 105

R. 1, 6, 13, 16, 53, 55, 56, 60, 61, 61a/bis, 69, 90, 92

Art. 76, 83, 101, 102, 123

R. 55, 57a/bis

⁶⁹ Cf. les décisions/avis de la Grande Chambre de recours G 4/88, G 5/88, G 7/88, G 8/88, G 10/91, G 9/93, G 1/95, G 7/95, G 3/97, G 4/97, G 3/99, G 1/02 (Annexe I).

⁷⁰ Cf. les décisions/avis de la Grande Chambre de recours G 3/89, G 10/91, G 11/91, G 1/95, G 2/95, G 7/95, G 1/99 (Annexe I).

Prüfung des Einspruchs

(1) Ist der Einspruch zulässig, so prüft die Einspruchsabteilung, ob die in Artikel 100 genannten Einspruchsgründe der Aufrechterhaltung des europäischen Patents entgegenstehen.

(2) Bei der Prüfung des Einspruchs, die nach Maßgabe der Ausführungsordnung durchzuführen ist, fordert die Einspruchsabteilung die Beteiligten so oft wie erforderlich auf, innerhalb einer von ihr zu bestimmten Frist eine Stellungnahme zu ihren Bescheiden oder zu den Schriftsätzen anderer Teilnehmer einzureichen.

Widerruf oder Aufrechterhaltung des europäischen Patents

(1) Ist die Einspruchsabteilung der Auffassung, dass die in Artikel 100 genannten Einspruchsgründe der Aufrechterhaltung des europäischen Patents entgegenstehen, so widerruft sie das Patent.

(2) Ist die Einspruchsabteilung der Auffassung, dass die in Artikel 100 genannten Einspruchsgründe der Aufrechterhaltung des europäischen Patents in unveränderter Form nicht entgegenstehen, so weist sie den Einspruch zurück.

(3) Ist die Einspruchsabteilung der Auffassung, dass unter Berücksichtigung der vom Patentinhaber im Einspruchsverfahren vorgenommenen Änderungen das europäische Patent und die Erfindung, die es zum Gegenstand hat, den Erfordernissen dieses Übereinkommens genügen, so beschließt sie die Aufrechterhaltung des Patents in dem geänderten Umfang, vorausgesetzt, dass

a) gemäß der Ausführungsordnung feststeht, dass der Patentinhaber mit der Fassung, in der die Einspruchsabteilung das Patent aufrechtzuerhalten beabsichtigt, einverstanden ist, und

b) die Druckkostengebühr für eine neue europäische Patentschrift innerhalb der in der Ausführungsordnung vorgeschriebenen Frist entrichtet worden ist.

(4) Wird die Druckkostengebühr für eine neue europäische Patentschrift nicht rechtzeitig entrichtet, so wird das europäische Patent widerrufen.

(5) In der Ausführungsordnung kann vorgesehen werden, dass der Patentinhaber eine Übersetzung der geänderten Patentansprüche in den beiden Amtssprachen des Europäischen Patentamts, die nicht Verfahrenssprache sind, einzureichen hat. Wird die Übersetzung nicht rechtzeitig eingereicht, so wird das europäische Patent widerrufen.

⁷¹ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 9/91, G 10/91, G 9/92, G 1/99 (Anhang I).

⁷² Siehe hierzu die Rechtsauskünfte Nr. 11/82 und Nr. 15/05 (rev. 2) (Anhang II) und Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 1/88, G 1/90, G 1/91, G 9/91, G 10/91, G 1/99, G 1/02 (Anhang I).

Examination of the opposition

(1) If the opposition is admissible, the Opposition Division shall examine whether the grounds for opposition laid down in Article 100 prejudice the maintenance of the European patent.

(2) In the examination of the opposition, which shall be conducted in accordance with the provisions of the Implementing Regulations, the Opposition Division shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Opposition Division, on communications from another party or issued by itself.

Revocation or maintenance of the European patent

(1) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Article 100 prejudice the maintenance of the European patent, it shall revoke the patent.

(2) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Article 100 do not prejudice the maintenance of the patent unamended, it shall reject the opposition.

(3) If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that:

(a) it is established, in accordance with the provisions of the Implementing Regulations, that the proprietor of the patent approves the text in which the Opposition Division intends to maintain the patent;

(b) the fee for the printing of a new specification of the European patent is paid within the time limit prescribed in the Implementing Regulations.

(4) If the fee for the printing of a new specification is not paid in due time, the patent shall be revoked.

(5) Provision may be made in the Implementing Regulations for the proprietor of the patent to file a translation of any amended claims in the two official languages of the European Patent Office other than the language of the proceedings. If the translation has not been filed in due time the patent shall be revoked.

⁷¹ See decisions/opinions of the Enlarged Board of Appeal G 9/91, G 10/91, G 9/92, G 1/99 (Annex I).

⁷² See Legal advice No. 11/82 and No. 15/05 (rev. 2) (Annex II) and decisions/opinions of the Enlarged Board of Appeal G 1/88, G 1/90, G 1/91, G 9/91, G 10/91, G 1/99, G 1/02 (Annex I).

Examen de l'opposition

(1) Si l'opposition est recevable, la division d'opposition examine si les motifs d'opposition visés à l'article 100 s'opposent au maintien du brevet européen.

(2) Au cours de l'examen de l'opposition qui doit se dérouler conformément aux dispositions du règlement d'exécution, la division d'opposition invite les parties, aussi souvent qu'il est nécessaire, à présenter, dans un délai qu'elle leur impartit, leurs observations sur les notifications qu'elle leur a adressées ou sur les communications qui émanent d'autres parties.

Article 102⁷²

Révocation ou maintien du brevet européen

(1) Si la division d'opposition estime que les motifs d'opposition visés à l'article 100 s'opposent au maintien du brevet européen, elle révoque le brevet.

(2) Si la division d'opposition estime que les motifs d'opposition visés à l'article 100 ne s'opposent pas au maintien du brevet européen sans modification, elle rejette l'opposition.

(3) Si la division d'opposition estime que, compte tenu des modifications apportées par le titulaire du brevet européen au cours de la procédure d'opposition, le brevet et l'invention qui en fait l'objet satisfont aux conditions de la présente convention, elle décide de maintenir le brevet tel qu'il a été modifié pour autant que :

a) conformément aux dispositions du règlement d'exécution, il est établi que le titulaire du brevet est d'accord sur le texte dans lequel la division d'opposition envisage de maintenir le brevet, et que

b) la taxe d'impression d'un nouveau fascicule du brevet a été acquittée dans le délai prescrit par le règlement d'exécution.

(4) Si la taxe d'impression d'un nouveau fascicule du brevet européen n'est pas acquittée dans les délais, le brevet est révoqué.

(5) Le règlement d'exécution peut prévoir que le titulaire du brevet européen produira une traduction des revendications modifiées dans les deux langues officielles de l'Office européen des brevets autres que celle de la procédure. Si la traduction n'est pas produite dans les délais, le brevet est révoqué.

R. 56-61a/bis, 70, 87

Art. 65, 68, 103

R. 16, 58, 68, 70, 87, 89, 92

⁷¹ Cf. les décisions/avis de la Grande Chambre de recours G 9/91, G 10/91, G 9/92, G 1/99 (Annexe I).

⁷² Cf. les renseignements juridiques n° 11/82 et n° 15/05 (rév. 2) (Annexe II) et les décisions/avis de la Grande Chambre de recours G 1/88, G 1/90, G 1/91, G 9/91, G 10/91, G 1/99, G 1/02 (Annexe I).

Artikel 103

Veröffentlichung einer neuen europäischen Patentschrift

Ist das europäische Patent nach Artikel 102 Absatz 3 geändert worden, so gibt das Europäische Patentamt gleichzeitig mit der Bekanntmachung des Hinweises auf die Entscheidung über den Einspruch eine neue europäische Patentschrift heraus, in der die Beschreibung, die Patentansprüche und gegebenenfalls die Zeichnungen in der geänderten Form enthalten sind.

Artikel 104⁷³

Kosten

(1) Im Einspruchsverfahren trägt jeder Beteiligte die ihm erwachsenen Kosten selbst, soweit nicht die Einspruchsabteilung oder die Beschwerdekammer, wenn und soweit dies der Billigkeit entspricht, über eine Verteilung der Kosten, die durch eine mündliche Verhandlung oder eine Beweisaufnahme verursacht worden sind, nach Maßgabe der Ausführungsordnung anders entscheidet.

(2) Die Geschäftsstelle der Einspruchsabteilung setzt auf Antrag den Betrag der Kosten fest, die auf Grund einer Entscheidung über die Verteilung zu erstatten sind. Gegen die Kostenfestsetzung der Geschäftsstelle ist der Antrag auf Entscheidung durch die Einspruchsabteilung innerhalb einer in der Ausführungsordnung vorgeschriebenen Frist zulässig.

(3) Jede unanfechtbare Entscheidung des Europäischen Patentamts über die Festsetzung der Kosten wird in jedem Vertragsstaat in Bezug auf die Vollstreckung wie ein rechtskräftiges Urteil eines Zivilgerichts des Staats behandelt, in dessen Hoheitsgebiet die Vollstreckung stattfindet. Eine Überprüfung dieser Entscheidung darf sich lediglich auf ihre Echtheit beziehen.

Artikel 105⁷⁴

Beitritt des vermeintlichen Patentverletzers

(1) Ist gegen ein europäisches Patent Einspruch eingelegt worden, so kann jeder Dritte, der nachweist, dass gegen ihn Klage wegen Verletzung dieses Patents erhoben worden ist, nach Ablauf der Einspruchsfrist dem Einspruchsverfahren beitreten, wenn er den Beitritt innerhalb von drei Monaten nach dem Tag erklärt, an dem die Verletzungsklage erhoben worden ist. Das Gleiche gilt für jeden Dritten, der nachweist, dass er nach einer Aufforderung des Patentinhabers, eine angebliche Patentverletzung zu unterlassen, gegen diesen Klage auf gerichtliche Feststellung erhoben hat, dass er das Patent nicht verletze.

Article 103

Publication of a new specification of the European patent

If a European patent is amended under Article 102, paragraph 3, the European Patent Office shall, at the same time as it publishes the mention of the opposition decision, publish a new specification of the European patent containing the description, the claims and any drawings, in the amended form.

Article 104⁷³

Costs

(1) Each party to the proceedings shall meet the costs he has incurred unless a decision of an Opposition Division or Board of Appeal, for reasons of equity, orders, in accordance with the Implementing Regulations, a different apportionment of costs incurred during taking of evidence or in oral proceedings.

(2) On request, the registry of the Opposition Division shall fix the amount of the costs to be paid under a decision apportioning them. The fixing of the costs by the registry may be reviewed by a decision of the Opposition Division on a request filed within the period laid down in the Implementing Regulations.

(3) Any final decision of the European Patent Office fixing the amount of costs shall be dealt with, for the purpose of enforcement in the Contracting States, in the same way as a final decision given by a civil court of the State in the territory of which enforcement is to be carried out. Verification of such decision shall be limited to its authenticity.

Article 105⁷⁴

Intervention of the assumed infringer

(1) In the event of an opposition to a European patent being filed, any third party who proves that proceedings for infringement of the same patent have been instituted against him may, after the opposition period has expired, intervene in the opposition proceedings, if he gives notice of intervention within three months of the date on which the infringement proceedings were instituted. The same shall apply in respect of any third party who proves both that the proprietor of the patent has requested that he cease alleged infringement of the patent and that he has instituted proceedings for a court ruling that he is not infringing the patent.

⁷³ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/99 (Anhang I).

⁷⁴ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 4/91, G 1/94 (Anhang I).

⁷³ See decision of the Enlarged Board of Appeal G 3/99 (Annex I).

⁷⁴ See decisions of the Enlarged Board of Appeal G 4/91, G 1/94 (Annex I).

Article 103

Publication d'un nouveau fascicule du brevet européen

Lorsque le brevet européen a été modifié en vertu de l'article 102, paragraphe 3, l'Office européen des brevets publie simultanément la mention de la décision concernant l'opposition et un nouveau fascicule du brevet européen contenant, dans la forme modifiée, la description, les revendications et, le cas échéant, les dessins.

Article 104⁷³

Frais

(1) Chacune des parties à la procédure d'opposition supporte les frais qu'elle a exposés, sauf décision de la division d'opposition ou de la chambre de recours, prise conformément au règlement d'exécution, prescrivant, dans la mesure où l'équité l'exige, une répartition différente des frais occasionnés par une procédure orale ou une mesure d'instruction.

(2) Sur requête, le greffe de la division d'opposition fixe le montant des frais à rembourser en vertu d'une décision de répartition. Le montant des frais tels qu'ils ont été fixés par le greffe, sur une requête présentée dans le délai prescrit par le règlement d'exécution, peut être réformé par une décision de la division d'opposition.

(3) Toute décision finale de l'Office européen des brevets fixant le montant des frais est, aux fins de son exécution dans les Etats contractants, réputée être une décision passée en force de chose jugée rendue par une juridiction civile de l'Etat sur le territoire duquel cette exécution doit être poursuivie. Le contrôle d'une telle décision ne peut porter que sur son authenticité.

Article 105⁷⁴

Intervention du contrefacteur présumé

(1) Lorsqu'une opposition au brevet européen a été formée, tout tiers qui apporte la preuve qu'une action en contrefaçon fondée sur ce brevet a été introduite à son encontre, peut, après l'expiration du délai d'opposition, intervenir dans la procédure d'opposition à condition qu'il produise une déclaration d'intervention dans un délai de trois mois à compter de la date à laquelle l'action en contrefaçon a été introduite. Cette disposition s'applique à tout tiers qui apporte la preuve, qu'après avoir été requis par le titulaire du brevet de cesser la contrefaçon présumée de ce brevet, il a introduit à l'encontre dudit titulaire une action tendant à faire constater judiciairement qu'il n'est pas contrefacteur.

Verweisungen / References / Références

Art. 14

R. 18, 19, 38, 62, 62a/bis, 87

Art. 106

R. 9, 63, 68, 89

Art. 99

R. 1, 55-61a/bis, 69

⁷³ Cf. la décision de la Grande Chambre de recours G 3/99 (Annexe I).

⁷⁴ Cf. les décisions de la Grande Chambre de recours G 4/91, G 1/94 (Annexe I).

(2) Der Beiritt ist schriftlich zu erklären und zu begründen. Er ist erst wirksam, wenn die Einspruchsgebühr entrichtet worden ist. Im Übrigen wird der Beiritt als Einspruch behandelt, soweit in der Ausführungsordnung nichts anderes bestimmt ist.

(2) Notice of intervention shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid. Thereafter the intervention shall, subject to any exceptions laid down in the Implementing Regulations, be treated as an opposition.

(2) La déclaration d'intervention doit être présentée par écrit et motivée. Elle ne prend effet qu'après paiement de la taxe d'opposition. Après l'accomplissement de cette formalité, l'intervention est assimilée à une opposition, sous réserve des dispositions du règlement d'exécution.

Verweisungen / References / Références

SECHSTER TEIL

BESCHWERDEVERFAHREN

*Artikel 106*⁷⁵

Beschwerdefähige Entscheidungen

- (1) Die Entscheidungen der Eingangsstelle, der Prüfungsabteilungen, der Einspruchsabteilungen und der Rechtsabteilung sind mit der Beschwerde anfechtbar. Die Beschwerde hat aufschiebende Wirkung.
- (2) Beschwerde gegen die Entscheidung der Einspruchsabteilung kann auch eingelegt werden, wenn für alle benannten Vertragsstaaten auf das europäische Patent verzichtet worden ist oder wenn das europäische Patent für alle diese Staaten erloschen ist.
- (3) Eine Entscheidung, die ein Verfahren gegenüber einem Beteiligten nicht abschließt, ist nur zusammen mit der Endentscheidung anfechtbar, sofern nicht in der Entscheidung die gesonderte Beschwerde zugelassen ist.
- (4) Die Verteilung der Kosten des Einspruchsverfahrens kann nicht einziger Gegenstand einer Beschwerde sein.
- (5) Eine Entscheidung über die Festsetzung des Betrags der Kosten des Einspruchsverfahrens ist mit der Beschwerde nur anfechtbar, wenn der Betrag eine in der Gebührenordnung bestimmte Höhe übersteigt.

*Artikel 107*⁷⁶

Beschwerdeberechtigte und Verfahrensbeteiligte

Die Beschwerde steht denjenigen zu, die an dem Verfahren beteiligt waren, das zu der Entscheidung geführt hat, soweit sie durch die Entscheidung beschwert sind. Die übrigen an diesem Verfahren Beteiligten sind am Beschwerdeverfahren beteiligt.

*Artikel 108*⁷⁷

Frist und Form

Die Beschwerde ist innerhalb von zwei Monaten nach Zustellung der Entscheidung schriftlich beim Europäischen Patentamt einzulegen. Die Beschwerde gilt erst als eingelegt, wenn die Beschwerdegebühr entrichtet worden ist. Innerhalb von vier Monaten nach Zustellung der Entscheidung ist die Beschwerde schriftlich zu begründen.

⁷⁵ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 1/90, G 1/97, G 1/99, G 1/02, G 3/03 (Anhang I).

⁷⁶ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 1/88, G 2/91, G 4/91, G 9/92, G 1/99, G 3/99, G 3/03 (Anhang I).

⁷⁷ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 1/86, G 2/97, G 1/99, G 3/03 (Anhang I).

PART VI

APPEALS PROCEDURE

*Article 106*⁷⁵

Decisions subject to appeal

- (1) An appeal shall lie from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division. It shall have suspensive effect.
- (2) An appeal may be filed against the decision of the Opposition Division even if the European patent has been surrendered or has lapsed for all the designated States.
- (3) A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.
- (4) The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal.
- (5) A decision fixing the amount of costs of opposition proceedings cannot be appealed unless the amount is in excess of that laid down in the Rules relating to Fees.

*Article 107*⁷⁶

Persons entitled to appeal and to be parties to appeal proceedings

Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings as of right.

*Article 108*⁷⁷

Time limit and form of appeal

Notice of appeal must be filed in writing at the European Patent Office within two months after the date of notification of the decision appealed from. The notice shall not be deemed to have been filed until after the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

⁷⁵ See decisions/opinions of the Enlarged Board of Appeal G 1/90, G 1/97, G 1/99, G 1/02, G 3/03 (Annex I).

⁷⁶ See decisions of the Enlarged Board of Appeal G 1/88, G 2/91, G 4/91, G 9/92, G 1/99, G 3/99, G 3/03 (Annex I).

⁷⁷ See decisions of the Enlarged Board of Appeal G 1/86, G 2/97, G 1/99, G 3/03 (Annex I).

SIXIÈME PARTIE

Verweisungen / References / Références

PROCÉDURE DE RECOURS

*Article 106*⁷⁵

Décisions susceptibles de recours

(1) Les décisions de la section de dépôt, des divisions d'examen, des divisions d'opposition et de la division juridique sont susceptibles de recours. Le recours a un effet suspensif.

(2) Un recours peut être formé contre la décision de la division d'opposition même s'il a été renoncé au brevet européen pour tous les Etats désignés ou si celui-ci s'est éteint pour tous ces Etats.

(3) Une décision qui ne met pas fin à une procédure à l'égard d'une des parties ne peut faire l'objet d'un recours qu'avec la décision finale, à moins que ladite décision ne prévoie un recours indépendant.

(4) Aucun recours ne peut avoir pour seul objet la répartition des frais de la procédure d'opposition.

(5) Une décision fixant le montant des frais de la procédure d'opposition ne peut faire l'objet d'un recours que si le montant est supérieur à celui fixé par le règlement relatif aux taxes.

Art. 104

R. 63, 65, 68, 90

*Article 107*⁷⁶

Personnes admises à former le recours et à être parties à la procédure

R. 65, 68

Toute partie à la procédure ayant conduit à une décision peut recourir contre cette décision pour autant qu'elle n'ait pas fait droit à ses prétentions. Les autres parties à ladite procédure sont de droit parties à la procédure de recours.

*Article 108*⁷⁷

Délai et forme

R. 1, 6, 64, 65, 68

Le recours doit être formé par écrit auprès de l'Office européen des brevets dans un délai de deux mois à compter du jour de la signification de la décision. Le recours n'est considéré comme formé qu'après le paiement de la taxe de recours. Un mémoire exposant les motifs du recours doit être déposé par écrit dans un délai de quatre mois à compter de la date de la signification de la décision.

⁷⁵ Cf. les décisions/avis de la Grande Chambre de recours G 1/90, G 1/97, G 1/99, G 1/02, G 3/03 (Annexe I).

⁷⁶ Cf. les décisions de la Grande Chambre de recours G 1/88, G 2/91, G 4/91, G 9/92, G 1/99, G 3/99, G 3/03 (Annexe I).

⁷⁷ Cf. les décisions de la Grande Chambre de recours G 1/86, G 2/97, G 1/99, G 3/03 (Annexe I).

Artikel 109⁷⁸

Abhilfe

(1) Erachtet das Organ, dessen Entscheidung angefochten wird, die Beschwerde für zulässig und begründet, so hat es ihr abzuhelfen. Dies gilt nicht, wenn dem Beschwerdeführer ein anderer an dem Verfahren Beteiligten gegenübersteht.

(2)⁷⁹ Wird der Beschwerde innerhalb von drei Monaten nach Eingang der Begründung nicht abgeholfen, so ist sie unverzüglich ohne sachliche Stellungnahme der Beschwerdekammer vorzulegen.

Artikel 110⁸⁰

Prüfung der Beschwerde

(1) Ist die Beschwerde zulässig, so prüft die Beschwerdekammer, ob die Beschwerde begründet ist.

(2) Bei der Prüfung der Beschwerde, die nach Maßgabe der Ausführungsordnung durchzuführen ist, fordert die Beschwerdekammer die Beteiligten so oft wie erforderlich auf, innerhalb einer von ihr zu bestimmenden Frist eine Stellungnahme zu ihren Bescheiden oder zu den Schriftsätzen anderer Beteiligter einzureichen.

(3) Unterlässt es der Anmelder, auf eine Aufforderung nach Absatz 2 rechtzeitig zu antworten, so gilt die europäische Patentanmeldung als zurückgenommen, es sei denn, dass die mit der Beschwerde angefochtene Entscheidung von der Rechtsabteilung erlassen worden ist.

Artikel 111⁸¹

Entscheidung über die Beschwerde

(1) Nach der Prüfung, ob die Beschwerde begründet ist, entscheidet die Beschwerdekammer über die Beschwerde. Die Beschwerdekammer wird entweder im Rahmen der Zuständigkeit des Organs tätig, das die angefochtene Entscheidung erlassen hat, oder verweist die Angelegenheit zur weiteren Entscheidung an dieses Organ zurück.

(2) Verweist die Beschwerdekammer die Angelegenheit zur weiteren Entscheidung an das Organ zurück, das die angefochtene Entscheidung erlassen hat, so ist dieses Organ durch die rechtliche Beurteilung der Beschwerdekammer, die der Entscheidung zu Grunde 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.

⁷⁸ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/03 (Anhang I).

⁷⁹ Geändert durch Beschluss des Verwaltungsrats vom 10.12.1998, in Kraft getreten am 01.01.1999 (ABI. EPA 1999, 1 ff.).

⁸⁰ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 9/91, G 10/91, G 10/93, G 1/97, G 3/99 (Anhang I).

⁸¹ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 9/92, G 10/93, G 1/97, G 3/03 (Anhang I).

Article 109⁷⁸

Interlocutory revision

(1) If the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision. This shall not apply where the appellant is opposed by another party to the proceedings.

(2)⁷⁹ If the appeal is not allowed within three months after receipt of the statement of grounds, it shall be remitted to the Board of Appeal without delay, and without comment as to its merit.

Article 110⁸⁰

Examination of appeals

(1) If the appeal is admissible, the Board of Appeal shall examine whether the appeal is allowable.

(2) In the examination of the appeal, which shall be conducted in accordance with the provisions of the Implementing Regulations, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from another party or issued by itself.

(3) 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, unless the decision under appeal was taken by the Legal Division.

Article 111⁸¹

Decision in respect of appeals

(1) Following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

(2) If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts 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.

⁷⁸ See decision of the Enlarged Board of Appeal G 3/03 (Annex I).

⁷⁹ Amended by decision of the Administrative Council of 10.12.1998 which entered into force on 01.01.1999 (OJ EPO 1999, 1 ff).

⁸⁰ See decisions/opinions of the Enlarged Board of Appeal G 9/91, G 10/91, G 10/93, G 1/97, G 3/99 (Annex I).

⁸¹ See decisions of the Enlarged Board of Appeal G 9/92, G 10/93, G 1/97, G 3/03 (Annex I).

*Article 109*⁷⁸

Révision préjudicielle

(1) Si l'instance dont la décision est attaquée considère le recours comme recevable et fondé, elle doit y faire droit. Cette disposition ne s'applique pas lorsque la procédure oppose celui qui a introduit le recours à une autre partie.

(2)⁷⁹ S'il n'est pas fait droit au recours dans un délai de trois mois après réception du mémoire exposant les motifs, le recours doit être immédiatement déféré à la chambre de recours, sans avis sur le fond.

*Article 110*⁸⁰

Examen du recours

(1) Si le recours est recevable, la chambre de recours examine s'il peut y être fait droit.

(2) Au cours de l'examen du recours qui doit se dérouler conformément aux dispositions du règlement d'exécution, la chambre de recours invite les parties, aussi souvent qu'il est nécessaire, à présenter, dans un délai qu'elle leur impartit, leurs observations sur les notifications qu'elle leur a adressées ou sur les communications qui émanent d'autres parties.

(3) Si, dans le délai qui lui a été imparti, le demandeur ne défère pas à cette invitation, la demande de brevet européen est réputée retirée, à moins que la décision faisant l'objet du recours n'ait été prise par la division juridique.

*Article 111*⁸¹

Décision sur le recours

(1) A la suite de l'examen au fond du recours, la chambre de recours statue sur le recours. Elle peut, soit exercer les compétences de l'instance qui a pris la décision attaquée, soit renvoyer l'affaire à ladite instance pour suite à donner.

(2) Si la chambre de recours renvoie l'affaire pour suite à donner à l'instance qui a pris la décision attaquée, cette instance est liée par les motifs et le dispositif de la décision de la chambre de recours pour autant que les faits de la cause soient les mêmes. Si la décision attaquée a été prise par la section de dépôt, la division d'examen est également liée par les motifs et le dispositif de la décision de la chambre de recours.

Verweisungen / References / Références

R. 67

R. 66, 69, 70

R. 66, 67, 68, 89

⁷⁸ Cf. la décision de la Grande Chambre de recours G 3/03 (Annexe I).

⁷⁹ Modifié par décision du Conseil d'administration en date du 10.12.1998, entrée en vigueur le 01.01.1999 (JO OEB 1999, 1 s.).

⁸⁰ Cf. les décisions/avis de la Grande Chambre de recours G 9/91, G 10/91, G 10/93, G 1/97, G 3/99 (Annexe I).

⁸¹ Cf. les décisions de la Grande Chambre de recours G 9/92, G 10/93, G 1/97, G 3/03 (Annexe I).

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) In den Fällen des Absatzes 1 Buchstabe a sind die am Beschwerdeverfahren Beteiligten am Verfahren vor der Großen Beschwerdekammer beteiligt.

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

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 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.

⁸² Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 1/86, G 2/88, G 4/88, G 5/88, G 6/88, G 7/88, G 8/88, G 1/89, G 2/89, G 1/90, G 1/92, G 3/95, G 6/95, G 2/97, G 2/98, G 3/98, G 4/98, G 1/99, G 2/99, G 3/99, G 1/02, G 2/02 und G 3/02, G 1/03, G 2/03, G 3/03 (Anhang I).

⁸² See decisions/opinions of the Enlarged Board of Appeal G 1/86, G 2/88, G 4/88, G 5/88, G 6/88, G 7/88, G 8/88, G 1/89, G 2/89, G 1/90, G 1/92, G 3/95, G 6/95, G 2/97, G 2/98, G 3/98, G 4/98, G 1/99, G 2/99, G 3/99, G 1/02, G 2/02 and G 3/02, G 1/03, G 2/03, G 3/03 (Annex I).

Décisions ou avis de la Grande Chambre de recours

Art. 22

R. 68, 89

(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, soit d'office, soit à la requête de l'une des parties, saisit en cours d'instance la Grande Chambre de recours lorsqu'une décision est nécessaire à ces fins. Lorsque la chambre de recours rejette la requête, elle doit motiver son refus dans sa décision finale ;

b) le Président de l'Office européen des brevets peut 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) Dans les cas visés au paragraphe 1, lettre a), les parties à la procédure de recours sont parties à la procédure devant la Grande Chambre de recours.

(3) 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.

⁸² Cf. les décisions/avis de la Grande Chambre de recours G 1/86, G 2/88, G 4/88, G 5/88, G 6/88, G 7/88, G 8/88, G 1/89, G 2/89, G 1/90, G 1/92, G 3/95, G 6/95, G 2/97, G 2/98, G 3/98, G 4/98, G 1/99, G 2/99, G 3/99, G 1/02, G 2/02 et G 3/02, G 1/03, G 2/03, G 3/03 (Annexe I).

SIEBENTER TEIL

GEMEINSAME VORSCHRIFTEN

Kapitel I

Allgemeine Vorschriften für das Verfahren

Artikel 113⁸³

Rechtliches Gehör

(1) Entscheidungen des Europäischen Patentamts dürfen nur auf Gründe gestützt werden, zu denen die Beteiligten sich äußern konnten.

(2) Bei der Prüfung der europäischen Patentanmeldung oder des europäischen Patents und bei den Entscheidungen darüber hat sich das Europäische Patentamt an die vom Anmelder oder Patentinhaber vorgelegte oder gebilligte Fassung zu halten.

Artikel 114⁸⁴

Ermittlung von Amts wegen

(1) In den Verfahren vor dem Europäischen Patentamt ermittelt das Europäische Patentamt den Sachverhalt von Amts wegen; es ist dabei weder auf das Vorbringen noch auf die Anträge der Beteiligten beschränkt.

(2) Das Europäische Patentamt braucht Tatsachen und Beweismittel, die von den Beteiligten verspätet vorgebracht werden, nicht zu berücksichtigen.

Artikel 115

Einwendungen Dritter

(1) Nach der Veröffentlichung der europäischen Patentanmeldung kann jeder Dritte Einwendungen gegen die Patentierbarkeit der angemeldeten Erfindung erheben. Die Einwendungen sind schriftlich einzureichen und zu begründen. Der Dritte ist am Verfahren vor dem Europäischen Patentamt nicht beteiligt.

(2) Die Einwendungen werden dem Anmelder oder Patentinhaber mitgeteilt, der dazu Stellung nehmen kann.

⁸³ Siehe hierzu die Rechtsauskünfte Nr. 11/82 und Nr. 15/05 (rev. 2) (Anhang II) und Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 7/91, G 8/91, G 9/91, G 10/91, G 4/92, G 7/93, G 1/97 (Anhang I).

⁸⁴ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 7/91, G 8/91, G 9/91, G 10/91, G 4/92, G 9/92, G 8/93, G 10/93, G 1/95, G 7/95, G 1/97, G 1/99 (Anhang I).

PART VII

COMMON PROVISIONS

Chapter I

Common provisions governing procedure

Article 113⁸³

Basis of decisions

(1) The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

(2) The European Patent Office shall consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent.

Article 114⁸⁴

Examination by the European Patent Office of its own motion

(1) In proceedings before it, the European Patent Office shall examine the facts of its own motion; it shall not be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

(2) The European Patent Office may disregard facts or evidence which are not submitted in due time by the parties concerned.

Article 115

Observations by third parties

(1) Following the publication of the European patent application, any person may present observations concerning the patentability of the invention in respect of which the application has been filed. Such observations must be filed in writing and must include a statement of the grounds on which they are based. That person shall not be a party to the proceedings before the European Patent Office.

(2) The observations referred to in paragraph 1 shall be communicated to the applicant for or proprietor of the patent who may comment on them.

⁸³ See Legal advice No. 11/82 and No. 15/05 (rev. 2) (Annex II) and decisions/opinions of the Enlarged Board of Appeal G 7/91, G 8/91, G 4/92, G 7/93, G 1/97 (Annex I).

⁸⁴ See decisions/opinions of the Enlarged Board of Appeal G 7/91, G 8/91, G 9/91, G 10/91, G 4/92, G 9/92, G 8/93, G 10/93, G 1/95, G 7/95, G 1/97, G 1/99 (Annex I).

SEPTIÈME PARTIE

Verweisungen / References / Références

DISPOSITIONS COMMUNES

Chapitre I

Dispositions générales de procédure

*Article 113*⁸³

Fondement des décisions

- (1) Les décisions de l'Office européen des brevets ne peuvent être fondées que sur des motifs au sujet desquels les parties ont pu prendre position.
- (2) L'Office européen des brevets n'examine et ne prend de décision sur la demande de brevet européen ou le brevet européen que dans le texte proposé ou accepté par le demandeur ou par le titulaire du brevet.

*Article 114*⁸⁴

Examen d'office

R. 71a/bis

- (1) Au cours de la procédure, l'Office européen des brevets procède à l'examen d'office des faits ; cet examen n'est limité ni aux moyens invoqués ni aux demandes présentées par les parties.
- (2) L'Office européen des brevets peut ne pas tenir compte des faits que les parties n'ont pas invoqués ou des preuves qu'elles n'ont pas produites en temps utile.

Article 115

Observations des tiers

Art. 93

R. 70

- (1) Après la publication de la demande de brevet européen, tout tiers peut présenter des observations sur la brevetabilité de l'invention faisant l'objet de la demande. Les observations doivent être faites par écrit et dûment motivées. Les tiers n'acquièrent pas la qualité de parties à la procédure devant l'Office européen des brevets.
- (2) Les observations visées au paragraphe 1 sont notifiées au demandeur ou au titulaire du brevet qui peut prendre position.

⁸³ Cf. les renseignements juridiques n° 11/82 et n° 15/05 (rév. 2) (Annexe II) et les décisions/avis de la Grande Chambre de recours G 7/91, G 8/91, G 4/92, G 7/93, G 1/97 (Annexe I).

⁸⁴ Cf. les décisions/avis de la Grande Chambre de recours G 7/91, G 8/91, G 9/91, G 10/91, G 4/92, G 9/92, G 8/93, G 10/93, G 1/95, G 7/95, G 1/97, G 1/99 (Annexe I).

Mündliche Verhandlung

(1) Eine mündliche Verhandlung findet entweder auf Antrag eines Beteiligten oder, sofern das Europäische Patentamt dies für sachdienlich erachtet, von Amts wegen statt. Das Europäische Patentamt kann jedoch einen Antrag auf erneute mündliche Verhandlung vor demselben Organ ablehnen, wenn die Parteien und der dem Verfahren zu Grunde liegende Sachverhalt unverändert geblieben sind.

(2) Vor der Eingangsstelle findet eine mündliche Verhandlung auf Antrag des Anmelders nur statt, wenn die Eingangsstelle dies für sachdienlich erachtet oder beabsichtigt, die europäische Patentanmeldung zurückzuweisen.

(3) Die mündliche Verhandlung vor der Eingangsstelle, den Prüfungsabteilungen und der Rechtsabteilung ist nicht öffentlich.

(4) Die mündliche Verhandlung, einschließlich der Verkündung der Entscheidung, ist vor den Beschwerdekammern und der Großen Beschwerdekammer nach Veröffentlichung der europäischen Patentanmeldung sowie vor der Einspruchsabteilung öffentlich, sofern das angerufene Organ nicht in Fällen anderweitig entscheidet, in denen insbesondere für eine am Verfahren beteiligte Partei die Öffentlichkeit des Verfahrens schwerwiegende und ungerechtfertigte Nachteile zur Folge haben könnte.

Beweisaufnahme

(1) In den Verfahren vor einer Prüfungsabteilung, einer Einspruchsabteilung, der Rechtsabteilung oder einer Beschwerdekammer sind insbesondere folgende Beweismittel zulässig:

- a) Vernehmung der Beteiligten;
- b) Einholung von Auskünften;
- c) Vorlegung von Urkunden;
- d) Vernehmung von Zeugen;
- e) Begutachtung durch Sachverständige;
- f) Einnahme des Augenscheins;
- g) Abgabe einer schriftlichen Erklärung unter Eid.

⁸⁵ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 2/94, G 4/95, G 1/97 (Anhang I).

⁸⁶ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 3/89, G 11/91, G 4/95 (Anhang I).

Oral proceedings

(1) Oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at the request of any party to the proceedings. However, the European Patent Office may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same.

(2) Nevertheless, oral proceedings shall take place before the Receiving Section at the request of the applicant only where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application.

(3) Oral proceedings before the Receiving Section, the Examining Divisions and the Legal Division shall not be public.

(4) Oral proceedings, including delivery of the decision, shall be public, as regards the Boards of Appeal and the Enlarged Board of Appeal, after publication of the European patent application, and also before the Opposition Divisions, in so far as the department before which the proceedings are taking place does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings.

Taking of evidence

(1) In any proceedings before an Examining Division, an Opposition Division, the Legal Division or a Board of Appeal the means of giving or obtaining evidence shall include the following:

- (a) hearing the parties;
- (b) requests for information;
- (c) the production of documents;
- (d) hearing the witnesses;
- (e) opinions by experts;
- (f) inspection;
- (g) sworn statements in writing.

⁸⁵ See decisions of the Enlarged Board of Appeal G 2/94, G 4/95, G 1/97 (Annex I).

⁸⁶ See decisions/opinions of the Enlarged Board of Appeal G 3/89, G 11/91, G 4/95 (Annex I).

*Article 116*⁸⁵

Procédure orale

Verweisungen / References / Références

R. 2, 71, 71a/bis, 76

(1) Il est recouru à la procédure orale soit d'office lorsque l'Office européen des brevets le juge utile, soit sur requête d'une partie à la procédure. Toutefois, l'Office européen des brevets peut rejeter une requête tendant à recourir à nouveau à la procédure orale devant une même instance pour autant que les parties ainsi que les faits de la cause soient les mêmes.

(2) Toutefois, il n'est recouru, sur requête du demandeur, à la procédure orale devant la section de dépôt que lorsque celle-ci le juge utile ou lorsqu'elle envisage de rejeter la demande de brevet européen.

(3) La procédure orale devant la section de dépôt, les divisions d'examen et la division juridique n'est pas publique.

(4) La procédure orale, y compris le prononcé de la décision, est publique devant les chambres de recours et la Grande Chambre de recours après la publication de la demande de brevet européen ainsi que devant les divisions d'opposition, sauf décision contraire de l'instance saisie, au cas où la publicité pourrait présenter, notamment pour une partie à la procédure, des inconvénients graves et injustifiés.

*Article 117*⁸⁶

Instruction

R. 2, 72-76, 99

(1) Dans toute procédure devant une division d'examen, une division d'opposition, la division juridique ou une chambre de recours, les mesures d'instruction suivantes peuvent notamment être prises :

- a) l'audition des parties ;
- b) la demande de renseignements ;
- c) la production de documents ;
- d) l'audition de témoins ;
- e) l'expertise ;
- f) la descente sur les lieux ;
- g) les déclarations écrites faites sous la foi du serment.

⁸⁵ Cf. les décisions de la Grande Chambre de recours G 2/94, G 4/95, G 1/97 (Annexe I).

⁸⁶ Cf. les décisions/avis de la Grande Chambre de recours G 3/89, G 11/91, G 4/95 (Annexe I).

(2) Die Prüfungsabteilung, die Einspruchsabteilung und die Beschwerdekammer können eines ihrer Mitglieder mit der Durchführung der Beweisaufnahme beauftragen.

(3) Hält das Europäische Patentamt die mündliche Vernehmung eines Beteiligten, Zeugen oder Sachverständigen für erforderlich, so wird

a) der Betroffene zu einer Vernehmung vor dem Europäischen Patentamt geladen oder

b) das zuständige Gericht des Staats, in dem der Betroffene seinen Wohnsitz hat, nach Artikel 131 Absatz 2 ersucht, den Betroffenen zu vernehmen.

(4) Ein vor das Europäische Patentamt geladener Beteiligter, Zeuge oder Sachverständiger kann beim Europäischen Patentamt beantragen, dass er vor einem zuständigen Gericht in seinem Wohnsitzstaat vernommen wird. Nach Erhalt eines solchen Antrags oder in dem Fall, dass innerhalb der vom Europäischen Patentamt in der Ladung festgesetzten Frist keine Äußerung auf die Ladung erfolgt ist, kann das Europäische Patentamt nach Artikel 131 Absatz 2 das zuständige Gericht ersuchen, den Betroffenen zu vernehmen.

(5) Hält das Europäische Patentamt die erneute Vernehmung eines von ihm vernommenen Beteiligten, Zeugen oder Sachverständigen unter Eid oder in gleichermaßen verbindlicher Form für zweckmäßig, so kann es das zuständige Gericht im Wohnsitzstaat des Betroffenen hierum ersuchen.

(6) Ersucht das Europäische Patentamt das zuständige Gericht um die Vernehmung, so kann es das Gericht ersuchen, die Vernehmung unter Eid oder in gleichermaßen verbindlicher Form vorzunehmen und es einem Mitglied des betreffenden Organs zu gestatten, der Vernehmung beizuwohnen und über das Gericht oder unmittelbar Fragen an die Beteiligten, Zeugen oder Sachverständigen zu richten.

Artikel 118

Einheit der europäischen Patentanmeldung oder des europäischen Patents

Verschiedene Anmelder oder Inhaber eines europäischen Patents für verschiedene benannte Vertragsstaaten gelten im Verfahren vor dem Europäischen Patentamt als gemeinsame Anmelder oder gemeinsame Patentinhaber. Die Einheit der Anmeldung oder des Patents im Verfahren vor dem Europäischen Patentamt wird nicht beeinträchtigt; insbesondere ist die Fassung der Anmeldung oder des Patents für alle benannten Vertragsstaaten einheitlich, sofern in diesem Übereinkommen nichts anderes vorgeschrieben ist.

(2) The Examining Division, Opposition Division or Board of Appeal may commission one of its members to examine the evidence adduced.

(3) If the European Patent Office considers it necessary for a party, witness or expert to give evidence orally, it shall either:

(a) issue a summons to the person concerned to appear before it, or

(b) request, in accordance with the provisions of Article 131, paragraph 2, the competent court in the country of residence of the person concerned to take such evidence.

(4) A party, witness or expert who is summoned before the European Patent Office may request the latter to allow his evidence to be heard by a competent court in his country of residence. On receipt of such a request, or if there has been no reply to the summons by the expiry of a period fixed by the European Patent Office in the summons, the European Patent Office may, in accordance with the provisions of Article 131, paragraph 2, request the competent court to hear the person concerned.

(5) If a party, witness or expert gives evidence before the European Patent Office, the latter may, if it considers it advisable for the evidence to be given on oath or in an equally binding form, request the competent court in the country of residence of the person concerned to re-examine his evidence under such conditions.

(6) When the European Patent Office requests a competent court to take evidence, it may request the court to take the evidence on oath or in an equally binding form and to permit a member of the department concerned to attend the hearing and question the party, witness or expert either through the intermediary of the court or directly.

Article 118

Unity of the European patent application or European patent

Where the applicants for or proprietors of a European patent are not the same in respect of different designated Contracting States, they shall be regarded as joint applicants or proprietors for the purposes of proceedings before the European Patent Office. The unity of the application or patent in these proceedings shall not be affected; in particular the text of the application or patent shall be uniform for all designated Contracting States unless otherwise provided for in this Convention.

(2) La division d'examen, la division d'opposition et la chambre de recours peuvent charger un de leurs membres de procéder aux mesures d'instruction.

(3) Si l'Office européen des brevets estime nécessaire qu'une partie, un témoin ou un expert dépose oralement,

a) il cite devant lui la personne concernée ou

b) il demande, conformément aux dispositions de l'article 131, paragraphe 2, aux autorités judiciaires compétentes de l'Etat sur le territoire duquel réside cette personne, de recueillir sa déposition.

(4) Une partie, un témoin ou un expert cité devant l'Office européen des brevets peut lui demander l'autorisation d'être entendu par les autorités judiciaires compétentes de l'Etat sur le territoire duquel il réside. Après avoir reçu cette requête ou, si aucune suite n'a été donnée à la citation à l'expiration du délai imparti par l'Office européen des brevets dans cette citation, ce dernier peut, conformément aux dispositions de l'article 131, paragraphe 2, demander aux autorités judiciaires compétentes de recueillir la déposition de la personne concernée.

(5) Si une partie, un témoin ou un expert dépose devant l'Office européen des brevets, ce dernier peut, s'il estime souhaitable que la déposition soit recueillie sous la foi du serment ou sous une autre forme également contraignante, demander aux autorités judiciaires compétentes de l'Etat sur le territoire duquel réside la personne concernée, de l'entendre à nouveau dans ces dernières conditions.

(6) Lorsque l'Office européen des brevets demande à une autorité judiciaire compétente de recueillir une déposition, il peut lui demander de recueillir la déposition sous la foi du serment ou sous une autre forme également contraignante et d'autoriser un des membres de l'instance intéressée à assister à l'audition de la partie, du témoin ou de l'expert et à l'interroger, soit par l'entremise de ladite autorité, soit directement.

Article 118

Unicité de la demande ou du brevet européen

*Art. 59, 99
R. 16, 87*

Lorsque les demandeurs ou les titulaires d'un brevet européen ne sont pas les mêmes pour différents Etats contractants désignés, ils sont considérés comme co-demandeurs ou comme copropriétaires aux fins de la procédure devant l'Office européen des brevets. L'unicité de la demande ou du brevet au cours de cette procédure n'en est pas affectée ; en particulier, le texte de la demande ou du brevet doit être identique pour tous les Etats désignés, à moins que la présente convention n'en dispose autrement.

Artikel 119

Zustellung

Das Europäische Patentamt stellt von Amts wegen alle Entscheidungen und Ladungen sowie die Bescheide und Mitteilungen zu, durch die eine Frist in Lauf gesetzt wird oder die nach anderen Vorschriften des Übereinkommens zuzustellen sind oder für die der Präsident des Europäischen Patentamts die Zustellung vorgeschrieben hat. Die Zustellungen können, soweit dies außergewöhnliche Umstände erfordern, durch Vermittlung der Zentralbehörden für den gewerblichen Rechtsschutz der Vertragsstaaten bewirkt werden.

Artikel 120

Fristen

In der Ausführungsordnung wird bestimmt:

- a) die Art der Berechnung der Fristen sowie die Voraussetzungen, unter denen Fristen verlängert werden können, wenn das Europäische Patentamt oder die in Artikel 75 Absatz 1 Buchstabe b genannten Behörden zur Entgegennahme von Schriftstücken nicht geöffnet sind oder Postsendungen am Sitz des Europäischen Patentamts oder der genannten Behörden nicht zugestellt werden oder die Postzustellung allgemein unterbrochen oder im Anschluss an eine solche Unterbrechung gestört ist;
- b) die Mindest- und die Höchstdauer der vom Europäischen Patentamt zu bestimmenden Fristen.

*Artikel 121*⁸⁷

Weiterbehandlung der europäischen Patentanmeldung

- (1) Ist nach Versäumung einer vom Europäischen Patentamt bestimmten Frist die europäische Patentanmeldung zurückzuweisen oder zurückgewiesen worden oder gilt sie als zurückgenommen, so tritt die vorgesehene Rechtsfolge nicht ein oder wird, falls sie bereits eingetreten ist, rückgängig gemacht, wenn der Anmelder die Weiterbehandlung der Anmeldung beantragt.
- (2) Der Antrag ist innerhalb von zwei Monaten nach dem Tag, an dem die Entscheidung über die Zurückweisung der europäischen Patentanmeldung oder an dem die Mitteilung, dass die Anmeldung als zurückgenommen gilt, zugestellt worden ist, schriftlich einzureichen. Die versäumte Handlung ist innerhalb dieser Frist nachzuholen. Der Antrag gilt erst als gestellt, wenn die Weiterbehandlungsgebühr entrichtet worden ist.
- (3) Über den Antrag entscheidet das Organ, das über die versäumte Handlung zu entscheiden hat.

⁸⁷ Siehe hierzu die Entscheidung der Großen Beschwerdekammer G 1/97 (Anhang I) und die Rechtsauskunft Nr. 13/82 (Anhang II).

Article 119

Notification

The European Patent Office shall, as a matter of course, notify those concerned of decisions and summonses, and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Convention, or of which notification has been ordered by the President of the European Patent Office. Notifications may, where exceptional circumstances so require, be given through the intermediary of the central industrial property offices of the Contracting States.

Article 120

Time limits

The Implementing Regulations shall specify:

- (a) the manner of computation of time limits and the conditions under which such time limits may be extended, either because the European Patent Office or the authorities referred to in Article 75, paragraph 1(b), are not open to receive documents or because mail is not delivered in the localities in which the European Patent Office or such authorities are situated or because postal services are generally interrupted or subsequently dislocated;
- (b) the minima and maxima for time limits to be determined by the European Patent Office.

*Article 121*⁸⁷

Further processing of the European patent application

- (1) If the European patent application is to be refused or is refused or deemed to be withdrawn following failure to reply within a time limit set by the European Patent Office, the legal consequence provided for shall not ensue or, if it has already ensued, shall be retracted if the applicant requests further processing of the application.
- (2) The request shall be filed in writing within two months of the date on which either the decision to refuse the application or the communication that the application is deemed to be withdrawn was notified. The omitted act must be completed within this time limit. The request shall not be deemed to have been filed until the fee for further processing has been paid.
- (3) The department competent to decide on the omitted act shall decide on the request.

⁸⁷ See decision of the Enlarged Board of Appeal G 1/97 (Annex I) and Legal advice No. 13/82 (Annex II).

Article 119

Signification

L'Office européen des brevets signifie d'office toutes les décisions et citations ainsi que les notifications qui font courir un délai ou dont la signification est prévue par d'autres dispositions de la présente convention ou prescrite par le Président de l'Office européen des brevets. Les significations peuvent être faites, lorsque des circonstances exceptionnelles l'exigent, par l'intermédiaire des services centraux de la propriété industrielle des Etats contractants.

Verweisungen / References / Références

R. 69, 77-82

Article 120

Délais

Le règlement d'exécution détermine :

a) le mode de calcul des délais ainsi que les conditions dans lesquelles ils peuvent être prorogés, soit parce que les bureaux de l'Office européen des brevets ou des administrations visées à l'article 75, paragraphe 1, lettre b), ne sont pas ouverts pour la réception de documents, soit en raison d'un défaut de distribution du courrier dans les localités où l'Office ou ces administrations ont leur siège, ou en raison d'une interruption générale du service postal ou bien de la perturbation résultant de cette interruption ;

b) la durée minimale et maximale des délais qui sont impartis par l'Office européen des brevets.

R. 83-85b/ter, 108

*Article 121*⁸⁷

Poursuite de la procédure de la demande de brevet européen

R. 69

(1) Lorsque la demande de brevet européen doit être ou est rejetée ou est réputée retirée faute de l'observation d'un délai impartit par l'Office européen des brevets, l'effet juridique prévu ne se produit pas ou, s'il s'est produit, se trouve annulé si le demandeur requiert la poursuite de la procédure relative à la demande.

(2) La requête doit être présentée par écrit dans un délai de deux mois à compter de la date à laquelle la décision de rejet de la demande de brevet européen a été signifiée, ou à compter de la date à laquelle la notification que la demande est réputée retirée a été signifiée. L'acte non accompli doit l'être dans ces délais. La requête n'est réputée présentée qu'après paiement de la taxe de poursuite de la procédure.

(3) L'instance qui est compétente pour statuer sur l'acte non accompli décide sur la requête.

⁸⁷ Cf. la décision de la Grande Chambre de recours G 1/97 (Annexe I) et le renseignement juridique n° 13/82 (Annexe II).

Wiedereinsetzung in den vorigen Stand

(1) Der Anmelder oder Patentinhaber, der trotz Beachtung aller nach den gegebenen Umständen gebotenen Sorgfalt verhindert worden ist, gegenüber dem Europäischen Patentamt eine Frist einzuhalten, wird auf Antrag wieder in den vorigen Stand eingesetzt, wenn die Verhinderung nach dem Übereinkommen zur unmittelbaren Folge hat, dass die europäische Patentanmeldung oder ein Antrag zurückgewiesen wird, die Anmeldung als zurückgenommen gilt, das europäische Patent widerrufen wird oder der Verlust eines sonstigen Rechts oder eines Rechtsmittels eintritt.

(2) Der Antrag ist innerhalb von zwei Monaten nach Wegfall des Hindernisses schriftlich einzureichen. Die versäumte Handlung ist innerhalb dieser Frist nachzuholen. Der Antrag ist nur innerhalb eines Jahres nach Ablauf der versäumten Frist zulässig. Im Fall der Nichtzahlung einer Jahresgebühr wird die in Artikel 86 Absatz 2 vorgesehene Frist in die Frist von einem Jahr eingerechnet.

(3) Der Antrag ist zu begründen, wobei die zur Begründung dienenden Tatsachen glaubhaft zu machen sind. Er gilt erst als gestellt, wenn die Wiedereinsetzungsgebühr entrichtet worden ist.

(4) Über den Antrag entscheidet das Organ, das über die versäumte Handlung zu entscheiden hat.

(5) Dieser Artikel ist nicht anzuwenden auf die Fristen des Absatzes 2 sowie der Artikel 61 Absatz 3, 76 Absatz 3, 78 Absatz 2, 79 Absatz 2, 87 Absatz 1 und 94 Absatz 2.

(6) Wer in einem benannten Vertragsstaat in gutem Glauben die Erfindung, die Gegenstand einer veröffentlichten europäischen Patentanmeldung oder eines europäischen Patents ist, in der Zeit zwischen dem Eintritt eines Rechtsverlusts nach Absatz 1 und der Bekanntmachung des Hinweises auf die Wiedereinsetzung in den vorigen Stand in Benutzung genommen oder wirkliche und ernsthafte Veranstaltungen zur Benutzung getroffen hat, darf die Benutzung in seinem Betrieb oder für die Bedürfnisse seines Betriebs unentgeltlich fortsetzen.

(7) Dieser Artikel lässt das Recht eines Vertragsstaats unberührt, Wiedereinsetzung in den vorigen Stand in Fristen zu gewähren, die in diesem Übereinkommen vorgesehen und den Behörden dieses Staats gegenüber einzuhalten sind.

Restitutio in integrum

(1) The applicant for or proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the European Patent Office shall, upon application, have his rights re-established if the non-observance in question has the direct consequence, by virtue of this Convention, of causing the refusal of the European patent application, or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress.

(2) The application must be filed in writing within two months from the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-payment of a renewal fee, the period specified in Article 86, paragraph 2, shall be deducted from the period of one year.

(3) The application must state the grounds on which it is based, and must set out the facts on which it relies. It shall not be deemed to be filed until after the fee for re-establishment of rights has been paid.

(4) The department competent to decide on the omitted act shall decide upon the application.

(5) The provisions of this Article shall not be applicable to the time limits referred to in paragraph 2 of this Article, Article 61, paragraph 3, Article 76, paragraph 3, Article 78, paragraph 2, Article 79, paragraph 2, Article 87, paragraph 1, and Article 94, paragraph 2.

(6) Any person who, in a designated Contracting State, in good faith has used or made effective and serious preparations for using an invention which is the subject of a published European patent application or a European patent in the course of the period between the loss of rights referred to in paragraph 1 and publication of the mention of re-establishment of those rights, may without payment continue such use in the course of his business or for the needs thereof.

(7) Nothing in this Article shall limit the right of a Contracting State to grant restitutio in integrum in respect of time limits provided for in this Convention and to be observed vis-à-vis the authorities of such State.

⁸⁸ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 1/86, G 3/91, G 5/92, G 6/92, G 5/93, G 1/97 (Anhang I).

⁸⁸ See decisions of the Enlarged Board of Appeal G 1/86, G 3/91, G 5/92, G 6/92, G 5/93, G 1/97 (Annex I).

Restitutio in integrum

R. 69, 92

(1) Le demandeur ou le titulaire d'un brevet européen qui, bien qu'ayant fait preuve de toute la vigilance nécessaire par les circonstances, n'a pas été en mesure d'observer un délai à l'égard de l'Office européen des brevets est, sur requête, rétabli dans ses droits si l'empêchement a pour conséquence directe, en vertu des dispositions de la présente convention, le rejet de la demande de brevet européen ou d'une requête, le fait que la demande de brevet européen est réputée retirée, la révocation du brevet européen, la perte de tout autre droit ou celle d'un moyen de recours.

(2) La requête doit être présentée par écrit dans un délai de deux mois à compter de la cessation de l'empêchement. L'acte non accompli doit l'être dans ce délai. La requête n'est recevable que dans un délai d'un an à compter de l'expiration du délai non observé. Dans le cas de non-paiement d'une taxe annuelle, le délai prévu à l'article 86, paragraphe 2, est déduit de la période d'une année.

(3) La requête doit être motivée et indiquer les faits et les justifications invoqués à son appui. Elle n'est réputée présentée qu'à la condition que la taxe de restitutio in integrum ait été acquittée.

(4) L'instance qui est compétente pour statuer sur l'acte non accompli décide sur la requête.

(5) Les dispositions du présent article ne sont pas applicables aux délais prévus au paragraphe 2 ainsi qu'aux articles 61, paragraphe 3, 76, paragraphe 3, 78, paragraphe 2, 79, paragraphe 2, 87, paragraphe 1 et 94, paragraphe 2.

(6) Quiconque, dans un Etat contractant a, de bonne foi, au cours de la période comprise entre la perte d'un droit visé au paragraphe 1 et la publication de la mention du rétablissement dudit droit, commencé à exploiter ou a fait des préparatifs effectifs et sérieux pour exploiter l'invention qui fait l'objet d'une demande de brevet européen publiée ou d'un brevet européen, peut, à titre gratuit, poursuivre cette exploitation dans son entreprise ou pour les besoins de son entreprise.

(7) Le présent article n'affecte pas le droit pour un Etat contractant d'accorder la restitutio in integrum quant aux délais prévus par la présente convention et qui doivent être observés vis-à-vis des autorités de cet Etat.

⁸⁸ Cf. les décisions de la Grande Chambre de recours G 1/86, G 3/91, G 5/92, G 6/92, G 5/93, G 1/97 (Annexe I).

Artikel 123⁸⁹

Änderungen

- (1) Die Voraussetzungen, unter denen eine europäische Patentanmeldung oder ein europäisches Patent im Verfahren vor dem Europäischen Patentamt geändert werden kann, sind in der Ausführungsordnung geregelt. In jedem Fall ist dem Anmelder zumindest einmal Gelegenheit zu geben, von sich aus die Beschreibung, die Patentansprüche und die Zeichnungen zu ändern.
- (2) Eine europäische Patentanmeldung und ein europäisches Patent dürfen nicht in der Weise geändert werden, dass ihr Gegenstand über den Inhalt der Anmeldung in der ursprünglich eingereichten Fassung hinausgeht.
- (3) Im Einspruchsverfahren dürfen die Patentansprüche des europäischen Patents nicht in der Weise geändert werden, dass der Schutzbereich erweitert wird.

Artikel 124

Angaben über nationale Patentanmeldungen

- (1) Die Prüfungsabteilung oder die Beschwerdekammer kann den Anmelder auffordern, innerhalb einer von ihr zu bestimmenden Frist die Staaten anzugeben, in denen er nationale Patentanmeldungen für die Erfindung oder einen Teil der Erfindung, die Gegenstand der europäischen Patentanmeldung ist, eingereicht hat, und die Aktenzeichen der genannten Anmeldungen mitzuteilen.
- (2) Unterlässt es der Anmelder, auf eine Aufforderung nach Absatz 1 rechtzeitig zu antworten, so gilt die europäische Patentanmeldung als zurückgenommen.

Artikel 125⁹⁰

Heranziehung allgemeiner Grundsätze

Soweit dieses Übereinkommen Vorschriften über das Verfahren nicht enthält, berücksichtigt das Europäische Patentamt die in den Vertragsstaaten im Allgemeinen anerkannten Grundsätze des Verfahrensrechts.

Artikel 126

Beendigung von Zahlungsverpflichtungen

- (1) Ansprüche der Organisation auf Zahlung von Gebühren an das Europäische Patentamt erlöschen nach vier Jahren nach Ablauf des Kalenderjahrs, in dem die Gebühr fällig geworden ist.

Article 123⁸⁹

Amendments

- (1) The conditions under which a European patent application or a European patent may be amended in proceedings before the European Patent Office are laid down in the Implementing Regulations. In any case, an applicant shall be allowed at least one opportunity of amending the description, claims and drawings of his own volition.
- (2) A European patent application or a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.
- (3) The claims of the European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred.

Article 124

Information concerning national patent applications

- (1) The Examining Division or the Board of Appeal may invite the applicant to indicate, within a period to be determined by it, the States in which he has made applications for national patents for the whole or part of the invention to which the European patent application relates, and to give the reference numbers of the said applications.
- (2) If the applicant fails to reply in due time to an invitation under paragraph 1, the European patent application shall be deemed to be withdrawn.

Article 125⁹⁰

Reference to general principles

In the absence of procedural provisions in this Convention, the European Patent Office shall take into account the principles of procedural law generally recognised in the Contracting States.

Article 126

Termination of financial obligations

- (1) Rights of the Organisation to the payment of a fee to the European Patent Office shall be extinguished after four years from the end of the calendar year in which the fee fell due.

⁸⁹ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 2/88, G 3/89, G 11/91, G 1/93, G 7/93, G 2/95, G 2/98, G 1/99, G 1/03, G 2/03 (Anhang I).

⁹⁰ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 1/97, G 1/99 (Anhang I).

⁸⁹ See decisions/opinions of the Enlarged Board of Appeal G 2/88, G 3/89, G 11/91, G 1/93, G 7/93, G 2/95, G 2/98, G 1/99, G 1/03, G 2/03 (Annex I).

⁹⁰ See decisions of the Enlarged Board of Appeal G 1/97, G 1/99 (Annex I).

Article 123⁸⁹

Modifications

(1) Les conditions dans lesquelles une demande de brevet européen ou un brevet européen, au cours de la procédure devant l'Office européen des brevets, peut être modifiée sont prévues par le règlement d'exécution. En tout état de cause, le demandeur peut, de sa propre initiative, modifier au moins une fois la description, les revendications et les dessins.

(2) Une demande de brevet européen ou un brevet européen ne peut être modifiée de manière que son objet s'étende au-delà du contenu de la demande telle qu'elle a été déposée.

(3) Au cours de la procédure d'opposition, les revendications du brevet européen ne peuvent être modifiées de façon à étendre la protection.

Article 124

Indications relatives aux demandes de brevet national

(1) La division d'examen ou la chambre de recours peut inviter le demandeur à indiquer, dans un délai qu'elle lui impartit, les pays dans lesquels il a déposé des demandes de brevet national pour tout ou partie de l'invention, objet de la demande de brevet européen, ainsi que le numéro desdites demandes.

(2) Si, dans le délai qui lui a été imparti, le demandeur ne défère pas à cette invitation, la demande de brevet européen est réputée retirée.

Article 125⁹⁰

Référence aux principes généraux

En l'absence d'une disposition de procédure dans la présente convention, l'Office européen des brevets prend en considération les principes généralement admis en la matière dans les Etats contractants.

Article 126

Fin des obligations financières

(1) Le droit de l'Organisation d'exiger le paiement de taxes au profit de l'Office européen des brevets se prescrit par quatre ans à compter de la fin de l'année civile au cours de laquelle la taxe est devenue exigible.

Verweisungen / References / Références

Art. 100, 138

R. 2, 7, 16, 41, 51, 57, 57a/bis, 58, 86, 87

Art. 140

R. 69, 70

R. 91

⁸⁹ Cf. les décisions/avis de la Grande Chambre de recours G 2/88, G 3/89, G 11/91, G 1/93, G 7/93, G 2/95, G 2/98, G 1/99, G 1/03, G 2/03 (Annexe I).

⁹⁰ Cf. les décisions de la Grande Chambre de recours G 1/97, G 1/99 (Annexe I).

(2) Ansprüche gegen die Organisation auf Rückerstattung von Gebühren oder von Geldbeträgen, die bei der Entrichtung einer Gebühr zu viel gezahlt worden sind, durch das Europäische Patentamt erlöschen nach vier Jahren nach Ablauf des Kalenderjahrs, in dem der Anspruch entstanden ist.

(3) Die in den Absätzen 1 und 2 vorgesehene Frist wird im Fall des Absatzes 1 durch eine Aufforderung zur Zahlung der Gebühr und im Fall des Absatzes 2 durch eine schriftliche Geltendmachung des Anspruchs unterbrochen. Diese Frist beginnt mit der Unterbrechung erneut zu laufen und endet spätestens sechs Jahre nach Ablauf des Jahrs, in dem sie ursprünglich zu laufen begonnen hat, es sei denn, dass der Anspruch gerichtlich geltend gemacht worden ist; in diesem Fall endet die Frist frühestens ein Jahr nach der Rechtskraft der Entscheidung.

Kapitel II

Unterrichtung der Öffentlichkeit und Behörden

Artikel 127⁹¹

Europäisches Patentregister

Das Europäische Patentamt führt ein Patentregister mit der Bezeichnung europäisches Patentregister, in dem alle Angaben vermerkt werden, deren Eintragung in diesem Übereinkommen vorgeschrieben ist. Vor der Veröffentlichung der europäischen Patentanmeldung erfolgt keine Eintragung in das Patentregister. Jedermann kann in das Patentregister Einsicht nehmen.

Artikel 128

Akteneinsicht

(1) Einsicht in die Akten europäischer Patentanmeldungen, die noch nicht veröffentlicht worden sind, wird nur mit Zustimmung des Anmelders gewährt.

(2) Wer nachweist, dass der Anmelder sich ihm gegenüber auf seine europäische Patentanmeldung berufen hat, kann vor der Veröffentlichung dieser Anmeldung und ohne Zustimmung des Anmelders Akteneinsicht verlangen.

(3) Nach der Veröffentlichung einer europäischen Teilanmeldung oder einer nach Artikel 61 Absatz 1 eingereichten neuen europäischen Patentanmeldung kann jedermann Einsicht in die Akten der früheren Anmeldung ungeachtet deren Veröffentlichung und ohne Zustimmung des Anmelders verlangen.

⁹¹ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 1/97 (Anhang I).

(2) Rights against the Organisation for the refunding by the European Patent Office of fees or sums of money paid in excess of a fee shall be extinguished after four years from the end of the calendar year in which the right arose.

(3) The period laid down in paragraphs 1 and 2 shall be interrupted in the case covered by paragraph 1 by a request for payment of the fee and in the case covered by paragraph 2 by a reasoned claim in writing. On interruption it shall begin again immediately and shall end at the latest six years after the end of the year in which it originally began, unless, in the meantime, judicial proceedings to enforce the right have begun; in this case the period shall end at the earliest one year after the judgment enters into force.

Chapter II

Information to the public or official authorities

Article 127⁹¹

Register of European Patents

The European Patent Office shall keep a register, to be known as the Register of European Patents, which shall contain those particulars the registration of which is provided for by this Convention. No entry shall be made in the Register prior to the publication of the European patent application. The Register shall be open to public inspection.

Article 128

Inspection of files

(1) The files relating to European patent applications, which have not yet been published, shall not be made available for inspection without the consent of the applicant.

(2) Any person who can prove that the applicant for a European patent has invoked the rights under the application against him may obtain inspection of the files prior to the publication of that application and without the consent of the applicant.

(3) Where a European divisional application or a new European patent application filed under Article 61, paragraph 1, is published, any person may obtain inspection of the files of the earlier application prior to the publication of that application and without the consent of the relevant applicant.

⁹¹ See decision of the Enlarged Board of Appeal G 1/97 (Annex I).

(2) Les droits à l'encontre de l'Organisation en matière de remboursement de taxes ou de trop-perçu par l'Office européen des brevets lors du paiement de taxes se prescrivent par quatre ans à compter de la fin de l'année civile au cours de laquelle le droit a pris naissance.

(3) Le délai prévu aux paragraphes 1 et 2 est interrompu dans le cas visé au paragraphe 1 par une invitation à acquitter la taxe, et dans le cas visé au paragraphe 2 par une requête écrite en vue de faire valoir le droit. Ce délai recommence à courir à compter de la date de son interruption ; il expire au plus tard au terme d'une période de six ans calculée à compter de la fin de l'année civile au cours de laquelle il a commencé à courir initialement, à moins qu'une action en justice n'ait été engagée pour faire valoir le droit ; en pareil cas, le délai expire au plus tôt au terme d'une période d'une année calculée à compter de la date à laquelle la décision est passée en force de chose jugée.

Chapitre II

Information du public et des instances officielles

*Article 127*⁹¹

Registre européen des brevets

L'Office européen des brevets tient un registre, dénommé Registre européen des brevets, où sont portées les indications dont l'enregistrement est prévu par la présente convention. Aucune inscription n'est portée au registre avant que la demande européenne ait été publiée. Le registre est ouvert à l'inspection publique.

Art. 14, 20, 129
R. 19, 20-22, 61, 92

Article 128

Inspection publique

(1) Les dossiers relatifs à des demandes de brevet européen qui n'ont pas encore été publiées ne peuvent être ouverts à l'inspection publique qu'avec l'accord du demandeur.

(2) Quiconque prouve que le demandeur d'un brevet européen s'est prévalu de sa demande à son encontre peut consulter le dossier dès avant la publication de cette demande et sans l'accord du demandeur.

(3) Lorsqu'une demande divisionnaire ou une nouvelle demande de brevet européen déposée en vertu des dispositions de l'article 61, paragraphe 1, est publiée, toute personne peut consulter le dossier de la demande initiale avant la publication de cette demande et sans l'accord du demandeur.

Art. 76, 93, 130, 131
R. 17, 28, 70, 93-96, 98

⁹¹ Cf. la décision de la Grande Chambre de recours G 1/97 (Annexe I).

(4) Nach der Veröffentlichung der europäischen Patentanmeldung wird vorbehaltlich der in der Ausführungsordnung vorgeschriebenen Beschränkungen auf Antrag Einsicht in die Akten der europäischen Patentanmeldung und des darauf erteilten europäischen Patents gewährt.

(5) Das Europäische Patentamt kann folgende Angaben bereits vor der Veröffentlichung der europäischen Patentanmeldung Dritten gegenüber machen oder veröffentlichen:

- a) Nummer der europäischen Patentanmeldung;
- b) Anmeldetag der europäischen Patentanmeldung und, wenn die Priorität einer früheren Anmeldung in Anspruch genommen worden ist, Tag, Staat und Aktenzeichen der früheren Anmeldung;
- c) Name des Anmelders;
- d) Bezeichnung der Erfindung;
- e) die benannten Vertragsstaaten.

Artikel 129

Regelmäßig erscheinende Veröffentlichungen

Das Europäische Patentamt gibt regelmäßig folgende Veröffentlichungen heraus:

- a) ein Europäisches Patentblatt, das die Eintragungen in das europäische Patentregister wiedergibt sowie sonstige Angaben enthält, deren Veröffentlichung in diesem Übereinkommen vorgeschrieben ist;
- b) ein Amtsblatt des Europäischen Patentamts, das allgemeine Bekanntmachungen und Mitteilungen des Präsidenten des Europäischen Patentamts sowie sonstige dieses Übereinkommen und seine Anwendung betreffende Veröffentlichungen enthält.

Artikel 130

Gegenseitige Unterrichtung

(1) Das Europäische Patentamt und vorbehaltlich der Anwendung der in Artikel 75 Absatz 2 genannten Rechts- und Verwaltungsvorschriften die Zentralbehörden für den gewerblichen Rechtsschutz der Vertragsstaaten übermitteln einander auf Ersuchen sachdienliche Angaben über die Einreichung europäischer oder nationaler Patentanmeldungen und über Verfahren, die diese Anmeldungen und die darauf erteilten Patente betreffen.

(2) Absatz 1 gilt nach Maßgabe von Arbeitsabkommen auch für die Übermittlung von Angaben zwischen dem Europäischen Patentamt und

- a) den Zentralbehörden für den gewerblichen Rechtsschutz der Staaten, die nicht Vertragsstaaten sind,
- b) den zwischenstaatlichen Organisationen, die mit der Erteilung von Patenten beauftragt sind, und
- c) jeder anderen Organisation.

(4) Subsequent to the publication of the European patent application, the files relating to such application and the resulting European patent may be inspected on request, subject to the restrictions laid down in the Implementing Regulations.

(5) Even prior to the publication of the European patent application, the European Patent Office may communicate the following bibliographic data to third parties or publish them:

- (a) the number of the European patent application;
- (b) the date of filing of the European patent application and, where the priority of a previous application is claimed, the date, State and file number of the previous application;
- (c) the name of the applicant;
- (d) the title of the invention;
- (e) the Contracting States designated.

Article 129

Periodical publications

The European Patent Office shall periodically publish:

- (a) a European Patent Bulletin containing entries made in the Register of European Patents, as well as other particulars the publication of which is prescribed by this Convention;
- (b) an Official Journal of the European Patent Office, containing notices and information of a general character issued by the President of the European Patent Office, as well as any other information relevant to this Convention or its implementation.

Article 130

Exchanges of information

(1) The European Patent Office and, subject to the application of the legislative or regulatory provisions referred to in Article 75, paragraph 2, the central industrial property office of any Contracting State shall, on request, communicate to each other any useful information regarding the filing of European or national patent applications and regarding any proceedings concerning such applications and the resulting patents.

(2) The provisions of paragraph 1 shall apply to the communication of information by virtue of working agreements between the European Patent Office and:

- (a) the central industrial property office of any State which is not a party to this Convention;
- (b) any intergovernmental organisation entrusted with the task of granting patents;
- (c) any other organisation.

(4) Après la publication de la demande de brevet européen, les dossiers d'une telle demande et du brevet auquel elle a donné lieu peuvent, sur requête, être ouverts à l'inspection publique, sous réserve des restrictions prévues par le règlement d'exécution.

Verweisungen / References / Références

(5) L'Office européen des brevets peut, avant même la publication de la demande de brevet européen, communiquer à des tiers et publier les indications suivantes :

- a) le numéro de la demande de brevet européen ;
- b) la date du dépôt de la demande de brevet européen et, si la priorité d'une demande antérieure a été revendiquée, la date, l'Etat et le numéro de la demande antérieure ;
- c) le nom du demandeur ;
- d) le titre de l'invention ;
- e) la mention des Etats contractants désignés.

Article 129

Publications périodiques

Art. 14, 94, 95, 97, 127, 158
R. 19, 28, 28a/bis, 50, 92, 96

L'Office européen des brevets publie périodiquement :

- a) un Bulletin européen des brevets contenant les inscriptions portées au Registre européen des brevets, ainsi que toutes les autres indications dont la publication est prescrite par la présente convention ;
- b) un Journal officiel de l'Office européen des brevets contenant les communications et les informations d'ordre général émanant du Président de l'Office européen des brevets ainsi que toutes autres informations relatives à la présente convention et à son application.

Article 130

Echange d'informations

R. 97

(1) L'Office européen des brevets et, sous réserve de l'application des dispositions législatives ou réglementaires visées à l'article 75, paragraphe 2, les services centraux de la propriété industrielle des Etats contractants se communiquent, sur requête, toutes informations utiles sur le dépôt de demandes de brevets européens et nationaux ainsi que sur le déroulement des procédures relatives auxdites demandes et aux brevets à la délivrance desquels elles ont donné lieu.

(2) Les dispositions du paragraphe 1 sont applicables à l'échange d'informations, en vertu d'accords de travail, entre l'Office européen des brevets, d'une part, et, d'autre part :

- a) les services centraux de la propriété industrielle d'Etats qui ne sont pas parties à la présente convention ;
- b) toute organisation intergouvernementale chargée de la délivrance de brevets ;
- c) toute autre organisation.

(3) Die Übermittlung von Angaben nach Absatz 1 und Absatz 2 Buchstaben a und b unterliegt nicht den Beschränkungen des Artikels 128. Der Verwaltungsrat kann beschließen, dass die Übermittlung von Angaben nach Absatz 2 Buchstabe c den genannten Beschränkungen nicht unterliegt, sofern die betreffende Organisation die übermittelten Angaben bis zur Veröffentlichung der europäischen Patentanmeldung vertraulich behandelt.

Artikel 131

Amts- und Rechtshilfe

(1) Das Europäische Patentamt und die Gerichte oder Behörden der Vertragsstaaten unterstützen einander auf Antrag durch die Erteilung von Auskünften oder die Gewährung von Akteneinsicht, soweit nicht Vorschriften dieses Übereinkommens oder des nationalen Rechts entgegenstehen. Gewährt das Europäische Patentamt Gerichten, Staatsanwaltschaften oder Zentralbehörden für den gewerblichen Rechtsschutz Akteneinsicht, so unterliegt diese nicht den Beschränkungen des Artikels 128.

(2) Die Gerichte oder andere zuständige Behörden der Vertragsstaaten nehmen für das Europäische Patentamt auf dessen Ersuchen um Rechtshilfe Beweisaufnahmen oder andere gerichtliche Handlungen innerhalb ihrer Zuständigkeit vor.

Artikel 132

Austausch von Veröffentlichungen

(1) Das Europäische Patentamt und die Zentralbehörden für den gewerblichen Rechtsschutz der Vertragsstaaten übermitteln einander auf entsprechendes Ersuchen kostenlos für ihre eigenen Zwecke ein oder mehrere Exemplare ihrer Veröffentlichungen.

(2) Das Europäische Patentamt kann Vereinbarungen über den Austausch oder die Übermittlung von Veröffentlichungen treffen.

Kapitel III

Vertretung

*Artikel 133*⁹²

Allgemeine Grundsätze der Vertretung

(1)⁹³ Vorbehaltlich Absatz 2 ist niemand verpflichtet, sich in den durch dieses Übereinkommen geschaffenen Verfahren durch einen zugelassenen Vertreter vertreten zu lassen.

⁹² Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 2/94, G 4/95, G 3/99 (Anhang I).

⁹³ Siehe hierzu Rechtsauskunft Nr. 6/91 rev. (Anhang II).

(3) The communications under paragraphs 1 and 2(a) and (b) shall not be subject to the restrictions laid down in Article 128. The Administrative Council may decide that communications under paragraph 2(c) shall not be subject to such restrictions, provided that the organisation concerned shall treat the information communicated as confidential until the European patent application has been published.

Article 131

Administrative and legal co-operation

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

Article 132

Exchange of publications

(1) The European Patent Office and the central industrial property offices of the Contracting States shall despatch to each other on request and for their own use one or more copies of their respective publications free of charge.

(2) The European Patent Office may conclude agreements relating to the exchange or supply of publications.

Chapter III

Representation

*Article 133*⁹²

General principles of representation

(1)⁹³ Subject to the provisions of paragraph 2, no person shall be compelled to be represented by a professional representative in proceedings established by this Convention.

⁹² See decisions of the Enlarged Board of Appeal G 2/94, G 4/95, G 3/99 (Annex I).

⁹³ See Legal advice No. 6/91 rev. (Annex II).

(3) Les communications d'informations faites conformément au paragraphe 1 et au paragraphe 2, lettres a) et b), ne sont pas soumises aux restrictions prévues à l'article 128. Le Conseil d'administration peut décider que les communications faites conformément au paragraphe 2, lettre c), ne sont pas soumises aux restrictions prévues à l'article 128, à condition que l'organisation intéressée s'engage à considérer les informations communiquées comme confidentielles jusqu'à la date de publication de la demande de brevet européen.

Verweisungen / References / Références

Article 131

Coopération administrative et judiciaire

(1) Sauf dispositions contraires de la présente convention ou des législations nationales, l'Office européen des brevets et les juridictions ou autres autorités compétentes des Etats contractants s'assistent mutuellement, sur demande, en se communiquant des informations ou des dossiers. Lorsque l'Office européen des brevets communique les dossiers aux juridictions, aux ministères publics ou aux services centraux de la propriété industrielle, la communication n'est pas soumise aux restrictions prévues à l'article 128.

(2) Sur commissions rogatoires émanant de l'Office européen des brevets, les juridictions ou autres autorités compétentes des Etats contractants procèdent pour ledit Office, et dans les limites de leur compétence, aux mesures d'instruction ou autres actes juridictionnels.

Art. 117
R. 72, 97-99

Article 132

Echange de publications

(1) L'Office européen des brevets et les services centraux de la propriété industrielle des Etats contractants échangent sur requête, pour leurs propres besoins et gratuitement, un ou plusieurs exemplaires de leurs publications respectives.

(2) L'Office européen des brevets peut conclure des accords portant sur l'échange ou l'envoi de publications.

Chapitre III

Représentation

*Article 133*⁹²

Principes généraux relatifs à la représentation

(1)⁹³ Sous réserve des dispositions du paragraphe 2, nul n'est tenu de se faire représenter par un mandataire agréé dans les procédures instituées par la présente convention.

Art. 91, 134, 144
R. 26, 55, 78, 90, 92, 100, 101

⁹² Cf. les décisions de la Grande Chambre de recours G 2/94, G 4/95, G 3/99 (Annexe I).

⁹³ Cf. le renseignement juridique n° 6/91 rév. (Annexe II).

(2) Natürliche oder juristische Personen, die weder Wohnsitz noch Sitz in einem Vertragsstaat haben, müssen in jedem durch dieses Übereinkommen geschaffenen Verfahren durch einen zugelassenen Vertreter vertreten sein und Handlungen mit Ausnahme der Einreichung einer europäischen Patentanmeldung durch ihn vornehmen; in der Ausführungsordnung können weitere Ausnahmen zugelassen werden.

(3) Natürliche oder juristische Personen mit Wohnsitz oder Sitz in einem Vertragsstaat können in jedem durch dieses Übereinkommen geschaffenen Verfahren durch einen ihrer Angestellten handeln, der kein zugelassener Vertreter zu sein braucht, aber einer Vollmacht nach Maßgabe der Ausführungsordnung bedarf. In der Ausführungsordnung kann vorgeschrieben werden, ob und unter welchen Voraussetzungen Angestellte einer juristischen Person für andere juristische Personen mit Sitz im Hoheitsgebiet eines Vertragsstaats, die mit ihr wirtschaftlich verbunden sind, handeln können.

(4) In der Ausführungsordnung können Vorschriften über die gemeinsame Vertretung mehrerer Beteiligter, die gemeinsam handeln, vorgesehen werden.

*Artikel 134*⁹⁴

Zugelassene Vertreter

(1) Die Vertretung natürlicher oder juristischer Personen in den durch dieses Übereinkommen geschaffenen Verfahren kann nur durch zugelassene Vertreter wahrgenommen werden, die in einer beim Europäischen Patentamt geführten Liste eingetragen sind.

(2) In der Liste der zugelassenen Vertreter kann jede natürliche Person eingetragen werden, die folgende Voraussetzungen erfüllt:

- a) Sie muss die Staatsangehörigkeit eines Vertragsstaats besitzen;
- b) sie muss ihren Geschäftssitz oder Arbeitsplatz im Hoheitsgebiet des Vertragsstaats haben;
- c) sie muss die europäische Eignungsprüfung bestanden haben.

(3) Die Eintragung erfolgt auf Grund eines Antrags, dem die Bescheinigungen beizufügen sind, aus denen sich die Erfüllung der in Absatz 2 genannten Voraussetzungen ergibt.

(4) Die Personen, die in der Liste der zugelassenen Vertreter eingetragen sind, sind berechtigt, in den durch dieses Übereinkommen geschaffenen Verfahren aufzutreten.

⁹⁴ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 2/94, G 4/95, G 3/99 (Anhang I).

(2) Natural or legal persons not having either a residence or their principal place of business within the territory of one of the Contracting States must be represented by a professional representative and act through him in all proceedings established by this Convention, other than in filing the European patent application; the Implementing Regulations may permit other exceptions.

(3) Natural or legal persons having their residence or principal place of business within the territory of one of the Contracting States may be represented in proceedings established by this Convention by an employee, who need not be a professional representative but who must be authorised in accordance with the Implementing Regulations. The Implementing Regulations may provide whether and under what conditions an employee of such a legal person may also represent other legal persons which have their principal place of business within the territory of one of the Contracting States and which have economic connections with the first legal person.

(4) The Implementing Regulations may prescribe special provisions concerning the common representation of parties acting in common.

*Article 134*⁹⁴

Professional representatives

(1) Professional representation of natural or legal persons in proceedings established by this Convention may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the European Patent Office.

(2) Any natural person who fulfils the following conditions may be entered on the list of professional representatives:

- (a) he must be a national of one of the Contracting States;
- (b) he must have his place of business or employment within the territory of one of the Contracting States;
- (c) he must have passed the European qualifying examination.

(3) Entry shall be effected upon request, accompanied by certificates which must indicate that the conditions laid down in paragraph 2 are fulfilled.

(4) Persons whose names appear on the list of professional representatives shall be entitled to act in all proceedings established by this Convention.

⁹⁴ See decisions of the Enlarged Board of Appeal G 2/94, G 4/95, G 3/99 (Annex I).

(2) Les personnes physiques et morales qui n'ont ni domicile ni siège sur le territoire de l'un des Etats contractants doivent être représentées par un mandataire agréé, et agir par son entremise, dans toute procédure instituée par la présente convention, sauf pour le dépôt d'une demande de brevet européen ; d'autres exceptions peuvent être prévues par le règlement d'exécution.

(3) Les personnes physiques et morales qui ont leur domicile ou leur siège sur le territoire de l'un des Etats contractants peuvent agir par l'entremise d'un employé dans toute procédure instituée par la présente convention ; cet employé, qui doit disposer d'un pouvoir conformément aux dispositions du règlement d'exécution, n'est pas tenu d'être un mandataire agréé. Le règlement d'exécution peut prévoir si et dans quelles conditions l'employé d'une personne morale visée au présent paragraphe peut également agir pour d'autres personnes morales qui ont leur siège sur le territoire de l'un des Etats contractants et ont des liens économiques avec elle.

(4) Des dispositions particulières relatives à la représentation commune de parties agissant en commun peuvent être fixées par le règlement d'exécution.

*Article 134*⁹⁴

Mandataires agréés

*Art. 20, 35, 133
R. 10, 90, 92, 101, 102*

(1) La représentation de personnes physiques ou morales dans les procédures instituées par la présente convention ne peut être assurée que par les mandataires agréés inscrits sur une liste tenue à cet effet par l'Office européen des brevets.

(2) Peut être inscrite sur la liste des mandataires agréés toute personne physique qui :

- a) possède la nationalité de l'un des Etats contractants ;
- b) a son domicile professionnel ou le lieu de son emploi sur le territoire de l'un des Etats contractants ;
- c) a satisfait aux épreuves de l'examen européen de qualification.

(3) L'inscription est faite sur requête accompagnée d'attestations indiquant que les conditions visées au paragraphe 2 sont remplies.

(4) Les personnes qui sont inscrites sur la liste des mandataires agréés sont habilitées à agir dans toute procédure instituée par la présente convention.

⁹⁴ Cf. les décisions de la Grande Chambre de recours G 2/94, G 4/95, G 3/99 (Annexe I).

(5) Jede Person, die in der Liste der zugelassenen Vertreter eingetragen ist, ist berechtigt, zur Ausübung ihrer Tätigkeit als zugelassener Vertreter einen Geschäftssitz in jedem Vertragsstaat zu begründen, in dem die Verfahren durchgeführt werden, die durch dieses Übereinkommen unter Berücksichtigung des dem Übereinkommen beigefügten Zentralisierungsprotokolls geschaffen worden sind. Die Behörden dieses Staats können diese Berechtigung nur im Einzelfall in Anwendung der zum Schutz der öffentlichen Sicherheit und Ordnung erlassenen Rechtsvorschriften entziehen. Vor einer solchen Maßnahme ist der Präsident des Europäischen Patentamts zu hören.

(6) Der Präsident des Europäischen Patentamts kann in besonders gelagerten Fällen von der Voraussetzung nach Absatz 2 Buchstabe a Befreiung erteilen.

(7)⁹⁵ Die Vertretung in den durch dieses Übereinkommen geschaffenen Verfahren kann wie von einem zugelassenen Vertreter auch von jedem Rechtsanwalt, der in einem Vertragsstaat zugelassen ist und seinen Geschäftssitz in diesem Staat hat, in dem Umfang wahrgenommen werden, in dem er in diesem Staat die Vertretung auf dem Gebiet des Patentwesens ausüben kann. Absatz 5 ist entsprechend anzuwenden.

(8) Der Verwaltungsrat kann folgende Vorschriften erlassen:

a)⁹⁶ über die Vorbildung und Ausbildung, die eine Person besitzen muss, um zu der europäischen Eignungsprüfung zugelassen zu werden, und die Durchführung dieser Eignungsprüfung;

b)⁹⁷ über die Errichtung oder Anerkennung eines Instituts, in dem die auf Grund der europäischen Eignungsprüfung oder nach Artikel 163 Absatz 7 zugelassenen Vertreter zusammengeschlossen sind, und

c)⁹⁸ über die Disziplinargewalt, die dieses Institut oder das Europäische Patentamt über diese Personen besitzt.

(5) For the purpose of acting as a professional representative, any person whose name appears on the list referred to in paragraph 1 shall be entitled to establish a place of business in any Contracting State in which proceedings established by this Convention may be conducted, having regard to the Protocol on Centralisation annexed to this Convention. The authorities of such State may remove that entitlement in individual cases only in application of legal provisions adopted for the purpose of protecting public security and law and order. Before such action is taken, the President of the European Patent Office shall be consulted.

(6) The President of the European Patent Office may, in special circumstances, grant exemption from the requirement of paragraph 2(a).

(7)⁹⁵ Professional representation in proceedings established by this Convention may also be undertaken, in the same way as by a professional representative, by any legal practitioner qualified in one of the Contracting States and having his place of business within such State, to the extent that he is entitled, within the said State, to act as a professional representative in patent matters. Paragraph 5 shall apply *mutatis mutandis*.

(8) The Administrative Council may adopt provisions governing:

(a)⁹⁶ the qualifications and training required of a person for admission to the European qualifying examination and the conduct of such examination;

(b)⁹⁷ the establishment or recognition of an institute constituted by the persons entitled to act as professional representatives by virtue of either the European qualifying examination or the provisions of Article 163, paragraph 7;

(c)⁹⁸ any disciplinary power to be exercised by that institute or the European Patent Office on such persons.

⁹⁵ Siehe hierzu Rechtsauskunft Nr. 6/91 rev. (Anhang II).

⁹⁶ Siehe hierzu die Vorschriften über die europäische Eignungsprüfung für die beim Europäischen Patentamt zugelassenen Vertreter in der Fassung vom 24.10.2002 (ABI. EPA 1994, 7 ff.; 2000, 320 ff.; 2002, 565 ff.), die Ausführungsbestimmungen in der Fassung vom 24.10.2002 (ABI. EPA 1998, 364 ff.; 2003, 25 f.) und die Anweisungen betreffend die für die Zulassung zur europäischen Eignungsprüfung erforderlichen Qualifikationen (ABI. EPA 1994, 599).

⁹⁷ Siehe hierzu die Vorschriften über die Errichtung eines Instituts der beim Europäischen Patentamt zugelassenen Vertreter (ABI. EPA 1997, 350) und die Änderungen vom 07.06.2002 (ABI. EPA 2002, 429 ff.) und 17.06.2004 (ABI. EPA 2004, 361).

⁹⁸ Siehe hierzu die Vorschriften in Disziplinarangelegenheiten von zugelassenen Vertretern vom 21.10.1977 (ABI. EPA 1978, 91 ff.), die ergänzenden Verfahrensordnungen der drei Disziplinarorgane vom 06.06.1980 (ABI. EPA 1980, 176 ff.) und die Richtlinien des Instituts der beim EPA zugelassenen Vertreter für die Berufsausübung (ABI. EPA 2003, 523 ff.).

⁹⁵ See Legal advice No. 6/91 rev. (Annex II).

⁹⁶ See Regulation on the European qualifying examination for professional representatives before the European Patent Office as of 24.10.2002 (OJ EPO 1994, 7 ff; 2000, 320 ff; 2002, 565 ff), the implementing provisions as of 24.10.2002 (OJ EPO 1998, 364 ff; 2003, 25 f) and the instructions concerning the qualifications required for enrolment for the European qualifying examination (OJ EPO 1994, 599).

⁹⁷ See Regulation on the establishment of an Institute of Professional Representatives before the European Patent Office (OJ EPO 1997, 350) and the changes of 07.06.2002 (OJ EPO 2002, 429 ff) and of 17.06.2004 (OJ EPO 2004, 361).

⁹⁸ See Regulation on discipline for professional representatives of 21.10.1977 (OJ EPO 1978, 91 ff), the Additional Rules of Procedure of the three Disciplinary Bodies of 06.06.1980 (OJ EPO 1980, 176 ff) and the Code of Conduct of the Institute of Professional Representatives before the EPO (OJ EPO2003, 523 ff).

(5) Aux fins d'agir en qualité de mandataire agréé, toute personne inscrite sur la liste visée au paragraphe 1 est habilitée à avoir un domicile professionnel dans un Etat contractant dans lequel se déroulent les procédures instituées par la présente convention, compte tenu du protocole sur la centralisation annexé à la présente convention. Les autorités de cet Etat ne peuvent retirer cette habilitation que dans des cas particuliers et en vertu de la législation nationale relative à l'ordre public et à la sécurité publique. Le Président de l'Office européen des brevets doit être consulté avant qu'une telle mesure soit prise.

(6) Dans des cas tenant à une situation particulière, le Président de l'Office européen des brevets peut consentir une dérogation à la disposition du paragraphe 2, lettre a).

(7)⁹⁵ La représentation au même titre qu'un mandataire agréé dans les procédures instituées par la présente convention peut être assurée par tout avocat habilité à exercer sur le territoire de l'un des Etats contractants et y possédant son domicile professionnel, dans la mesure où il peut agir dans ledit Etat en qualité de mandataire en matière de brevets d'invention. Les dispositions du paragraphe 5 sont applicables.

(8) Le Conseil d'administration peut prendre des dispositions relatives :

a)⁹⁶ à la qualification et à la formation exigées pour l'admission à l'examen européen de qualification et à l'organisation des épreuves de cet examen ;

b)⁹⁷ à la création ou à l'agrément d'un institut constitué des personnes habilitées à agir en qualité de mandataires agréés soit après avoir satisfait à un examen européen de qualification, soit en application des dispositions de l'article 163, paragraphe 7, et

c)⁹⁸ au pouvoir disciplinaire de l'institut ou de l'Office européen des brevets sur ces personnes.

⁹⁵ Cf. le renseignement juridique n° 6/91 rév. (Annexe II).

⁹⁶ Cf. le règlement relatif à l'examen européen de qualification des mandataires agréés près l'Office européen des brevets, tel que modifié le 24.10.2002 (JO OEB 1994, 7 s. ; 2000, 320 s. ; 2002, 565 s.), les dispositions d'exécution telles que modifiées le 24.10.2002 (JO OEB 1998, 364 s. ; 2003, 25 s.) et les instructions relatives aux qualifications requises pour l'inscription à l'examen européen de qualification (JO OEB 1994, 599).

⁹⁷ Cf. le règlement relatif à la création d'un Institut des mandataires agréés près l'Office européen des brevets (JO OEB 1997, 350), et les modifications du 07.06.2002 (JO OEB 2002, 429 s.) et du 17.06.2004 (JO OEB 2004, 361).

⁹⁸ Cf. le règlement en matière de discipline des mandataires agréés du 21.10.1977 (JO OEB 1978, 91 s.), les règlements de procédure additionnels des trois organes disciplinaires du 06.06.1980 (JO OEB 1980, 176 s.) et le code de conduite professionnelle concernant les membres de l'Institut des mandataires agréés près l'OEB (JO OEB 2003, 523 s.).

ACHTER TEIL

AUSWIRKUNGEN AUF DAS NATIONALE RECHT

Kapitel I

Umwandlung in eine nationale Patentanmeldung

Artikel 135

Umwandlungsantrag

(1) Die Zentralbehörde für den gewerblichen Rechtsschutz eines benannten Vertragsstaats leitet das Verfahren zur Erteilung eines nationalen Patents nur auf Antrag des Anmelders oder Inhabers eines europäischen Patents in den folgenden Fällen ein:

a) wenn die europäische Patentanmeldung nach Artikel 77 Absatz 5 oder Artikel 162 Absatz 4 als zurückgenommen gilt;

b) in den sonstigen vom nationalen Recht vorgesehenen Fällen, in denen nach diesem Übereinkommen die europäische Patentanmeldung zurückgewiesen oder zurückgenommen worden ist oder als zurückgenommen gilt oder das europäische Patent widerrufen worden ist.

(2) Der Umwandlungsantrag muss innerhalb von drei Monaten nach dem Tag eingereicht werden, an dem die europäische Patentanmeldung zurückgenommen worden ist oder die Mitteilung, dass die Anmeldung als zurückgenommen gilt, oder die Entscheidung über die Zurückweisung der Anmeldung oder über den Widerruf des europäischen Patents zugestellt worden ist. Die in Artikel 66 vorgeschriebene Wirkung erlischt, wenn der Antrag nicht rechtzeitig eingereicht worden ist.

Artikel 136

Einreichung und Übermittlung des Antrags

(1) Der Umwandlungsantrag ist beim Europäischen Patentamt zu stellen; im Antrag sind die Vertragsstaaten zu bezeichnen, in denen die Einleitung des Verfahrens zur Erteilung eines nationalen Patents gewünscht wird. Der Antrag gilt erst als gestellt, wenn die Umwandlungsgebühr entrichtet worden ist. Das Europäische Patentamt übermittelt den Umwandlungsantrag den Zentralbehörden für den gewerblichen Rechtsschutz der im Antrag bezeichneten Vertragsstaaten und fügt eine Kopie der Akten der europäischen Patentanmeldung oder des europäischen Patents bei.

(2) Ist dem Anmelder die Mitteilung zugestellt worden, dass die europäische Patentanmeldung nach Artikel 77 Absatz 5 als zurückgenommen gilt, so ist der Umwandlungsantrag bei der Zentralbehörde für den gewerblichen Rechtsschutz zu stellen, bei der die Anmeldung eingereicht worden ist. Diese Behörde leitet vorbehaltlich der Vorschriften über die nationale Sicherheit den Antrag mit einer Kopie der europäischen Patentanmeldung unmittelbar an die Zentralbehörden für den

PART VIII

IMPACT ON NATIONAL LAW

Chapter I

Conversion into a national patent application

Article 135

Request for the application of national procedure

(1) The central industrial property office of a designated Contracting State shall apply the procedure for the grant of a national patent only at the request of the applicant for or proprietor of a European patent, and in the following circumstances:

(a) when the European patent application is deemed to be withdrawn pursuant to Article 77, paragraph 5, or Article 162, paragraph 4;

(b) in such other cases as are provided for by the national law in which the European patent application is refused or withdrawn or deemed to be withdrawn, or the European patent is revoked under this Convention.

(2) The request for conversion shall be filed within three months after the European patent application has been withdrawn or after notification has been made that the application is deemed to be withdrawn, or after a decision has been notified refusing the application or revoking the European patent. The effect referred to in Article 66 shall lapse if the request is not filed in due time.

Article 136

Submission and transmission of the request

(1) A request for conversion shall be filed with the European Patent Office and shall specify the Contracting States in which application of the procedure for the grant of a national patent is desired. The request shall not be deemed to be filed until the conversion fee has been paid. The European Patent Office shall transmit the request to the central industrial property offices of the Contracting States specified therein, accompanied by a copy of the files relating to the European patent application or the European patent.

(2) However, if the applicant is notified that the European patent application has been deemed to be withdrawn pursuant to Article 77, paragraph 5, the request shall be filed with the central industrial property office with which the application has been filed. That office shall, subject to the provisions of national security, transmit the request, together with a copy of the European patent application, directly to the central industrial property offices of the Contracting States specified by

INCIDENCES SUR LE DROIT NATIONAL

Chapitre I

Transformation en demande de brevet national

Article 135

Demande d'engagement de la procédure nationale

Art. 140

R. 69

(1) Le service central de la propriété industrielle d'un Etat contractant désigné ne peut engager la procédure de délivrance d'un brevet national que sur requête du demandeur ou du titulaire d'un brevet européen et dans les cas suivants :

a) si la demande de brevet européen est réputée retirée en vertu de l'article 77, paragraphe 5 ou de l'article 162, paragraphe 4 ;

b) dans les autres cas prévus par la législation nationale où, en vertu de la présente convention, la demande de brevet européen est soit rejetée, soit retirée, soit réputée retirée ou le brevet européen révoqué.

(2) La requête doit être présentée dans un délai de trois mois à compter soit du retrait de la demande de brevet, soit de la signification selon laquelle la demande est réputée retirée ou de la signification de la décision de rejet de la demande ou de révocation du brevet européen. La disposition faisant l'objet de l'article 66 cesse de produire ses effets si la requête n'est pas présentée dans ce délai.

Article 136

Présentation et transmission de la requête

Art. 137, 140

R. 69, 103

(1) La requête en transformation doit être présentée à l'Office européen des brevets ; les Etats contractants dans lesquels le requérant entend que soit engagée la procédure de délivrance d'un brevet national sont mentionnés dans la requête. Cette requête n'est réputée présentée qu'après le paiement de la taxe de transformation. L'Office européen des brevets transmet la requête aux services centraux de la propriété industrielle des Etats qui y sont mentionnés et y joint une copie du dossier de la demande de brevet européen ou une copie du dossier du brevet européen.

(2) Toutefois, s'il a été signifié au demandeur que la demande de brevet européen est réputée retirée conformément à l'article 77, paragraphe 5, la requête doit être introduite auprès du service central national de la propriété industrielle auprès duquel ladite demande avait été déposée. Sous réserve des dispositions de la législation nationale relatives à la défense nationale, ce service transmet directement la requête, à laquelle il joint une copie de la demande de brevet européen, aux

gewerblichen Rechtsschutz der vom Anmelder in dem Antrag bezeichneten Vertragsstaaten weiter. Die in Artikel 66 vorgeschriebene Wirkung erlischt, wenn der Antrag nicht innerhalb von zwanzig Monaten nach dem Anmeldetag oder, wenn eine Priorität in Anspruch genommen worden ist, nach dem Prioritätstag weitergeleitet wird.

Artikel 137

Formvorschriften für die Umwandlung

(1) Eine europäische Patentanmeldung, die nach Artikel 136 übermittelt worden ist, darf nicht solchen Formanforderungen des nationalen Rechts unterworfen werden, die von denen abweichen, die im Übereinkommen vorgesehen sind, oder über sie hinausgehen.

(2) Die Zentralbehörde für den gewerblichen Rechtsschutz, der die europäische Patentanmeldung übermittelt worden ist, kann verlangen, dass der Anmelder innerhalb einer Frist, die nicht weniger als zwei Monate betragen darf,

- a) die nationale Anmeldegebühr entrichtet und
- b) eine Übersetzung der europäischen Patentanmeldung in einer der Amtssprachen des betreffenden Staats einreicht, und zwar in der ursprünglichen Fassung der Anmeldung und gegebenenfalls in der im Verfahren vor dem Europäischen Patentamt geänderten Fassung, die der Anmelder dem nationalen Verfahren zu Grunde zu legen wünscht.

Kapitel II

Nichtigkeit und ältere Rechte

Artikel 138

Nichtigkeitsgründe

(1) Vorbehaltlich Artikel 139 kann auf Grund des Rechts eines Vertragsstaats das europäische Patent mit Wirkung für das Hoheitsgebiet dieses Staats nur für nichtig erklärt werden, wenn

- a) der Gegenstand des europäischen Patents nach den Artikeln 52 bis 57 nicht patentfähig ist;
- b) das europäische Patent die Erfindung nicht so deutlich und vollständig offenbart, dass ein Fachmann sie ausführen kann;
- c)⁹⁹ der Gegenstand des europäischen Patents über den Inhalt der Anmeldung in der eingereichten Fassung oder, wenn das Patent auf einer europäischen Teilanmeldung oder einer nach Artikel 61 eingereichten neuen europäischen Patentanmeldung beruht, über den Inhalt der früheren Anmeldung in der ursprünglich eingereichten Fassung hinausgeht;

⁹⁹ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 3/89, G 11/91, G 2/95 (Anhang I).

the applicant in the request. The effect referred to in Article 66 shall lapse if such transmission is not made within twenty months after the date of filing or, if a priority has been claimed, after the date of priority.

Article 137

Formal requirements for conversion

(1) A European patent application transmitted in accordance with Article 136 shall not be subjected to formal requirements of national law which are different from or additional to those provided for in this Convention.

(2) Any central industrial property office to which the application is transmitted may require that the applicant shall, within not less than two months:

- (a) pay the national application fee;
- (b) file a translation in one of the official languages of the State in question of the original text of the European patent application and, where appropriate, of the text, as amended during proceedings before the European Patent Office, which the applicant wishes to submit to the national procedure.

Chapter II

Revocation and prior rights

Article 138

Grounds for revocation

(1) Subject to the provisions of Article 139, a European patent may only be revoked under the law of a Contracting State, with effect for its territory, on the following grounds:

- (a) if the subject-matter of the European patent is not patentable within the terms of Articles 52 to 57;
- (b) if the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (c)⁹⁹ if the subject-matter of the European patent extends beyond the content of the application as filed or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 61, beyond the content of the earlier application as filed;

⁹⁹ See decisions/opinions of the Enlarged Board of Appeal G 3/89, G 11/91, G 2/95 (Annex I).

services centraux des Etats contractants mentionnés par le requérant dans sa requête. La disposition faisant l'objet de l'article 66 cesse de produire ses effets si cette transmission n'est pas effectuée dans un délai de vingt mois à compter de la date de dépôt ou, si une priorité a été revendiquée, à compter de la date de priorité.

Verweisungen / References / Références

Article 137

Conditions de forme de la transformation

Art. 140

(1) Une demande de brevet européen transmise conformément aux dispositions de l'article 136 ne peut, quant à sa forme, être soumise par la loi nationale à des conditions différentes de celles qui sont prévues par la présente convention ou à des conditions supplémentaires.

(2) Le service central de la propriété industrielle auquel la demande est transmise peut exiger que, dans un délai qui ne peut être inférieur à deux mois, le demandeur :

- a) acquitte la taxe nationale de dépôt ;
- b) produise, dans l'une des langues officielles de l'Etat en cause, une traduction du texte original de la demande de brevet européen ainsi que, le cas échéant, une traduction du texte, modifié au cours de la procédure devant l'Office européen des brevets, sur la base duquel il désire que se déroule la procédure nationale.

Chapitre II

Nullité et droits antérieurs

Article 138

Causes de nullité

Art. 76, 83, 123

(1) Sous réserve des dispositions de l'article 139, le brevet européen ne peut être déclaré nul, en vertu de la législation d'un Etat contractant, avec effet sur le territoire de cet Etat, que :

- a) si l'objet du brevet européen n'est pas brevetable aux termes des articles 52 à 57 ;
- b) si le brevet européen n'expose pas l'invention de façon suffisamment claire et complète pour qu'un homme du métier puisse l'exécuter ;
- c)⁹⁹ si l'objet du brevet européen s'étend au-delà du contenu de la demande telle qu'elle a été déposée ou, lorsque le brevet a été délivré sur la base d'une demande divisionnaire ou d'une nouvelle demande déposée conformément aux dispositions de l'article 61, si l'objet du brevet s'étend au-delà du contenu de la demande initiale telle qu'elle a été déposée ;

⁹⁹ Cf. les décisions/avis de la Grande Chambre de recours G 3/89, G 11/91, G 2/95 (Annexe I).

d) der Schutzbereich des europäischen Patents erweitert worden ist;

e) der Inhaber des europäischen Patents nicht nach Artikel 60 Absatz 1 berechtigt ist.

(2) Betreffen die Nichtigkeitsgründe nur einen Teil des europäischen Patents, so wird die Nichtigkeit durch entsprechende Beschränkung dieses Patents erklärt. Wenn es das nationale Recht zulässt, kann die Beschränkung in Form einer Änderung der Patentansprüche, der Beschreibung oder der Zeichnungen erfolgen.

*Artikel 139*¹⁰⁰

Ältere Rechte und Rechte mit gleichem Anmelde- oder Prioritätstag

(1) In jedem benannten Vertragsstaat haben eine europäische Patentanmeldung und ein europäisches Patent gegenüber einer nationalen Patentanmeldung und einem nationalen Patent die gleiche Wirkung als älteres Recht wie eine nationale Patentanmeldung und ein nationales Patent.

(2) Eine nationale Patentanmeldung und ein nationales Patent in einem Vertragsstaat haben gegenüber einem europäischen Patent, soweit dieser Vertragsstaat benannt ist, die gleiche Wirkung als älteres Recht wie gegenüber einem nationalen Patent.

(3) Jeder Vertragsstaat kann vorschreiben, ob und unter welchen Voraussetzungen eine Erfindung, die sowohl in einer europäischen Patentanmeldung oder einem europäischen Patent als auch in einer nationalen Patentanmeldung oder einem nationalen Patent mit gleichem Anmeldetag oder, wenn eine Priorität in Anspruch genommen worden ist, mit gleichem Prioritätstag offenbart ist, gleichzeitig durch europäische und nationale Anmeldungen oder Patente geschützt werden kann.

Kapitel III

Sonstige Auswirkungen

Artikel 140

Nationale Gebrauchsmuster und Gebrauchszertifikate

Die Artikel 66, 124, 135 bis 137 und 139 sind in den Vertragsstaaten, deren Recht Gebrauchsmuster oder Gebrauchszertifikate vorsieht, auf diese Schutzrechte und deren Anmeldungen entsprechend anzuwenden.

(d) if the protection conferred by the European patent has been extended;

(e) if the proprietor of the European patent is not entitled under Article 60, paragraph 1.

(2) If the grounds for revocation only affect the European patent in part, revocation shall be pronounced in the form of a corresponding limitation of the said patent. If the national law so allows, the limitation may be effected in the form of an amendment to the claims, the description or the drawings.

*Article 139*¹⁰⁰

Rights of earlier date or the same date

(1) In any designated Contracting State a European patent application and a European patent shall have with regard to a national patent application and a national patent the same prior right effect as a national patent application and a national patent.

(2) A national patent application and a national patent in a Contracting State shall have with regard to a European patent in which that Contracting State is designated the same prior right effect as they have with regard to a national patent.

(3) Any Contracting State may prescribe whether and on what terms an invention disclosed in both a European patent application or patent and a national application or patent having the same date of filing or, where priority is claimed, the same date of priority, may be protected simultaneously by both applications or patents.

Chapter III

Miscellaneous effects

Article 140

National utility models and utility certificates

Article 66, Article 124, Articles 135 to 137 and Article 139 shall apply to utility models and utility certificates and to applications for utility models and utility certificates registered or deposited in the Contracting States whose laws make provision for such models or certificates.

¹⁰⁰ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 1/03, G 2/03 (Anhang I).

¹⁰⁰ See decisions of the Enlarged Board of Appeal G 1/03, G 2/03 (Annex I).

d) si la protection conférée par le brevet européen a été étendue ;

Verweisungen / References / Références

e) si le titulaire du brevet européen n'avait pas le droit de l'obtenir aux termes de l'article 60, paragraphe 1.

(2) Si les motifs de nullité n'affectent le brevet européen qu'en partie, la nullité est prononcée sous la forme d'une limitation correspondante dudit brevet. Si la législation nationale l'admet, la limitation peut être effectuée sous la forme d'une modification des revendications, de la description ou des dessins.

*Article 139*¹⁰⁰

Droits antérieurs et droits ayant pris naissance à la même date

Art. 138, 140
R. 87

(1) Dans tout Etat contractant désigné, une demande de brevet européen ou un brevet européen est traité du point de vue des droits antérieurs, par rapport à une demande de brevet national ou à un brevet national, de la même manière que s'il s'agissait d'une demande de brevet national ou d'un brevet national.

(2) Une demande de brevet national ou un brevet national d'un Etat contractant est traité du point de vue des droits antérieurs, par rapport à un brevet européen qui désigne cet Etat contractant, de la même manière que si ce brevet européen était un brevet national.

(3) Tout Etat contractant demeure libre de décider si et dans quelles conditions peuvent être cumulées les protections assurées à une invention exposée à la fois dans une demande de brevet ou un brevet européen et dans une demande de brevet ou un brevet national ayant la même date de dépôt ou, si une priorité est revendiquée, la même date de priorité.

Chapitre III

Autres incidences sur le droit national

Article 140

Modèles d'utilité et certificats d'utilité nationaux

R. 69, 103

Les articles 66, 124, 135 à 137 et 139 sont applicables aux modèles d'utilité ou aux certificats d'utilité ainsi qu'aux demandes correspondantes, dans les Etats contractants dont la législation prévoit de tels titres de protection.

¹⁰⁰ Cf. les décisions de la Grande Chambre de recours G 1/03, G 2/03 (Annexe I).

Artikel 141

Jahresgebühren für das europäische Patent

(1) Jahresgebühren für das europäische Patent können nur für die sich an das in Artikel 86 Absatz 4 genannte Jahr anschließenden Jahre erhoben werden.

(2) Werden Jahresgebühren für das europäische Patent innerhalb von zwei Monaten nach der Bekanntmachung des Hinweises auf die Erteilung des europäischen Patents fällig, so gelten diese Jahresgebühren als wirksam entrichtet, wenn sie innerhalb der genannten Frist gezahlt werden. Eine nach nationalem Recht vorgesehene Zuschlagsgebühr wird nicht erhoben.

Article 141

Renewal fees for European patents

(1) Renewal fees in respect of a European patent may only be imposed for the years which follow that referred to in Article 86, paragraph 4.

(2) Any renewal fees falling due within two months after the publication of the mention of the grant of the European patent shall be deemed to have been validly paid if they are paid within that period. Any additional fee provided for under national law shall not be charged.

Taxes annuelles pour le brevet européen

Art. 39, 97

(1) Les taxes annuelles dues au titre du brevet européen ne peuvent être perçues que pour les années suivant celle qui est visée à l'article 86, paragraphe 4.

(2) Si des taxes annuelles dues au titre du brevet européen viennent à échéance dans les deux mois à compter de la date à laquelle la mention de la délivrance du brevet a été publiée, lesdites taxes annuelles sont réputées avoir été valablement acquittées sous réserve d'être payées dans le délai mentionné. Il n'est perçu aucune surtaxe prévue au titre d'une réglementation nationale.

NEUNTER TEIL

BESONDERE ÜBEREINKOMMEN

Artikel 142

Einheitliche Patente

(1) Eine Gruppe von Vertragsstaaten, die in einem besonderen Übereinkommen bestimmt hat, dass die für diese Staaten erteilten europäischen Patente für die Gesamtheit ihrer Hoheitsgebiete einheitlich sind, kann vorsehen, dass europäische Patente nur für alle diese Staaten gemeinsam erteilt werden können.

(2) Hat eine Gruppe von Vertragsstaaten von der Ermächtigung in Absatz 1 Gebrauch gemacht, so sind die Vorschriften dieses Teils anzuwenden.

Artikel 143

Besondere Organe des Europäischen Patentamts

(1) Die Gruppe von Vertragsstaaten kann dem Europäischen Patentamt zusätzliche Aufgaben übertragen.

(2) Für die Durchführung der in Absatz 1 genannten zusätzlichen Aufgaben können im Europäischen Patentamt besondere, den Vertragsstaaten der Gruppe gemeinsame Organe gebildet werden. Die Leitung dieser besonderen Organe obliegt dem Präsidenten des Europäischen Patentamts; Artikel 10 Absätze 2 und 3 sind entsprechend anzuwenden.

Artikel 144

Vertretung vor den besonderen Organen

Die Gruppe von Vertragsstaaten kann die Vertretung vor den in Artikel 143 Absatz 2 genannten Organen besonders regeln.

Artikel 145

Engerer Ausschuss des Verwaltungsrats

(1) Die Gruppe von Vertragsstaaten kann zur Überwachung der Tätigkeit der nach Artikel 143 Absatz 2 gebildeten besonderen Organe einen engeren Ausschuss des Verwaltungsrats einsetzen, dem das Europäische Patentamt das Personal, die Räumlichkeiten und die Ausstattung zur Verfügung stellt, die er zur Durchführung seiner Aufgaben benötigt. Der Präsident des Europäischen Patentamts ist dem engeren Ausschuss des Verwaltungsrats gegenüber für die Tätigkeit der besonderen Organe verantwortlich.

(2) Die Zusammensetzung, die Zuständigkeit und die Tätigkeit des engeren Ausschusses bestimmt die Gruppe von Vertragsstaaten.

PART IX

SPECIAL AGREEMENTS

Article 142

Unitary patents

(1) Any group of Contracting States, which has provided by a special agreement that a European patent granted for those States has a unitary character throughout their territories, may provide that a European patent may only be granted jointly in respect of all those States.

(2) Where any group of Contracting States has availed itself of the authorisation given in paragraph 1, the provisions of this Part shall apply.

Article 143

Special departments of the European Patent Office

(1) The group of Contracting States may give additional tasks to the European Patent Office.

(2) Special departments common to the Contracting States in the group may be set up within the European Patent Office in order to carry out the additional tasks. The President of the European Patent Office shall direct such special departments; Article 10, paragraphs 2 and 3, shall apply *mutatis mutandis*.

Article 144

Representation before special departments

The group of Contracting States may lay down special provisions to govern representation of parties before the departments referred to in Article 143, paragraph 2.

Article 145

Select committee of the Administrative Council

(1) The group of Contracting States may set up a select committee of the Administrative Council for the purpose of supervising the activities of the special departments set up under Article 143, paragraph 2; the European Patent Office shall place at its disposal such staff, premises and equipment as may be necessary for the performance of its duties. The President of the European Patent Office shall be responsible for the activities of the special departments to the select committee of the Administrative Council.

(2) The composition, powers and functions of the select committee shall be determined by the group of Contracting States.

NEUVIÈME PARTIE

Verweisungen / References / Références

ACCORDS PARTICULIERS

Article 142

Brevet unitaire

Art. 2

(1) Tout groupe d'Etats contractants qui, dans un accord particulier, a disposé que les brevets européens délivrés pour ces Etats auront un caractère unitaire sur l'ensemble de leurs territoires, peut prévoir que les brevets européens ne pourront être délivrés que conjointement pour tous ces Etats.

(2) Les dispositions de la présente partie sont applicables lorsqu'un groupe d'Etats contractants a fait usage de la faculté visée au paragraphe 1.

Article 143

Instances spéciales de l'Office européen des brevets

Art. 15, 144-146

(1) Le groupe d'Etats contractants peut confier des tâches supplémentaires à l'Office européen des brevets.

(2) Il peut, pour l'exécution de ces tâches supplémentaires, être créé à l'Office européen des brevets des instances spéciales communes aux Etats appartenant à ce groupe. Le Président de l'Office européen des brevets assure la direction de ces instances spéciales ; les dispositions de l'article 10, paragraphes 2 et 3, sont applicables.

Article 144

Représentation devant les instances spéciales

Art. 133

Le groupe d'Etats contractants peut prévoir une réglementation spéciale pour la représentation des parties devant les instances visées à l'article 143, paragraphe 2.

Article 145

Comité restreint du Conseil d'administration

(1) Le groupe d'Etats contractants peut instituer un Comité restreint du Conseil d'administration afin de contrôler l'activité des instances spéciales créées en vertu de l'article 143, paragraphe 2 ; l'Office européen des brevets met à la disposition de ce Comité le personnel, les locaux et les moyens matériels nécessaires à l'accomplissement de sa mission. Le Président de l'Office européen des brevets est responsable des activités des instances spéciales devant le Comité restreint du Conseil d'administration.

(2) La composition, les compétences et les activités du Comité restreint sont déterminées par le groupe d'Etats contractants.

Artikel 146

Deckung der Kosten für die Durchführung besonderer Aufgaben

Sind dem Europäischen Patentamt nach Artikel 143 zusätzliche Aufgaben übertragen worden, so trägt die Gruppe von Vertragsstaaten die der Organisation bei der Durchführung dieser Aufgaben entstehenden Kosten. Sind für die Durchführung dieser Aufgaben im Europäischen Patentamt besondere Organe gebildet worden, so trägt die Gruppe die diesen Organen zurechenbaren Kosten für das Personal, die Räumlichkeiten und die Ausstattung. Artikel 39 Absätze 3 und 4, Artikel 41 und Artikel 47 sind entsprechend anzuwenden.

Artikel 147

Zahlungen auf Grund der für die Aufrechterhaltung des einheitlichen Patents erhobenen Gebühren

Hat die Gruppe von Vertragsstaaten für das europäische Patent einheitliche Jahresgebühren festgesetzt, so bezieht sich der Anteil nach Artikel 39 Absatz 1 auf diese einheitlichen Gebühren; der Mindestbetrag nach Artikel 39 Absatz 1 bezieht sich auf das einheitliche Patent. Artikel 39 Absätze 3 und 4 ist entsprechend anzuwenden.

Artikel 148

Die europäische Patentanmeldung als Gegenstand des Vermögens

(1) Artikel 74 ist anzuwenden, wenn die Gruppe von Vertragsstaaten nichts anderes bestimmt hat.

(2) Die Gruppe von Vertragsstaaten kann vorschreiben, dass die europäische Patentanmeldung, soweit für sie diese Vertragsstaaten benannt sind, nur für alle diese Vertragsstaaten und nur nach den Vorschriften des besonderen Übereinkommens Gegenstand eines Rechtsübergangs sein sowie belastet oder Zwangsvollstreckungsmaßnahmen unterworfen werden kann.

Artikel 149¹⁰¹

Gemeinsame Benennung

(1) Die Gruppe von Vertragsstaaten kann vorschreiben, dass ihre Benennung nur gemeinsam erfolgen kann und dass die Benennung eines oder mehrerer der Vertragsstaaten der Gruppe als Benennung aller dieser Vertragsstaaten gilt.

Article 146

Cover for expenditure for carrying out special tasks

Where additional tasks have been given to the European Patent Office under Article 143, the group of Contracting States shall bear the expenses incurred by the Organisation in carrying out these tasks. Where special departments have been set up in the European Patent Office to carry out these additional tasks, the group shall bear the expenditure on staff, premises and equipment chargeable in respect of these departments. Article 39, paragraphs 3 and 4, Article 41 and Article 47 shall apply *mutatis mutandis*.

Article 147

Payments in respect of renewal fees for unitary patents

If the group of Contracting States has fixed a common scale of renewal fees in respect of European patents the proportion referred to in Article 39, paragraph 1, shall be calculated on the basis of the common scale; the minimum amount referred to in Article 39, paragraph 1, shall apply to the unitary patent. Article 39, paragraphs 3 and 4, shall apply *mutatis mutandis*.

Article 148

The European patent application as an object of property

(1) Article 74 shall apply unless the group of Contracting States has specified otherwise.

(2) The group of Contracting States may provide that a European patent application for which these Contracting States are designated may only be transferred, mortgaged or subjected to any legal means of execution in respect of all the Contracting States of the group and in accordance with the provisions of the special agreement.

Article 149¹⁰¹

Joint designation

(1) The group of Contracting States may provide that these States may only be designated jointly, and that the designation of one or some only of such States shall be deemed to constitute the designation of all the States of the group.

¹⁰¹ Siehe hierzu den Vertrag zwischen der Schweizerischen Eidgenossenschaft und dem Fürstentum Liechtenstein über den Schutz der Erfindungspatente vom 22.12.1978 (ABI. EPA 1980, 407 ff.).

¹⁰¹ See the Treaty between the Swiss Confederation and the Principality of Liechtenstein on Patent Protection of 22.12.1978 (OJ EPO 1980, 407 ff.).

Article 146

Couverture des dépenses pour les tâches spéciales

Pour autant qu'un groupe d'Etats contractants ait attribué des tâches supplémentaires à l'Office européen des brevets au sens de l'article 143, il prend à sa charge les frais qu'entraîne pour l'Organisation l'exécution de ces tâches. Si des instances spéciales ont été instituées au sein de l'Office européen des brevets pour l'exécution de ces tâches supplémentaires, le groupe d'Etats contractants prend à sa charge les dépenses de personnel, de locaux et de matériel imputables auxdites instances. Les articles 39, paragraphes 3 et 4, 41 et 47 sont applicables.

Article 147

Versements au titre des taxes de maintien en vigueur du brevet unitaire

Si le groupe d'Etats contractants a établi un barème unique pour les taxes annuelles, le pourcentage visé à l'article 39, paragraphe 1, est calculé sur ce barème unique ; le minimum visé à l'article 39, paragraphe 1, est également un minimum en ce qui concerne le brevet unitaire. L'article 39, paragraphes 3 et 4, est applicable.

Article 148

De la demande de brevet européen comme objet de propriété

(1) L'article 74 est applicable lorsque le groupe d'Etats contractants n'a pas prévu d'autres dispositions.

(2) Le groupe d'Etats contractants peut prescrire que la demande de brevet européen, pour autant que ces Etats contractants sont désignés, ne peut être transférée, faire l'objet d'un nantissement ou d'une exécution forcée que pour tous ces Etats contractants et conformément aux dispositions de l'accord particulier.

*Article 149*¹⁰¹

Désignation conjointe

Verweisungen / References / Références

Art. 37, 50

Art. 3, 79, 156

(1) Le groupe d'Etats contractants peut prescrire que la désignation des Etats du groupe ne peut se faire que conjointement et que la désignation d'un ou de plusieurs Etats dudit groupe vaut désignation de l'ensemble de ceux-ci.

¹⁰¹ Voir le Traité entre la Confédération suisse et la Principauté de Liechtenstein sur la protection conférée par les brevets d'invention du 22.12.1978 (JO OEB 1980, 407 s.).

(2) Ist das Europäische Patentamt nach Artikel 153 Absatz 1 Bestimmungsamt, so ist Absatz 1 anzuwenden, wenn der Anmelder in der internationalen Anmeldung mitgeteilt hat, dass er für einen oder mehrere der benannten Staaten der Gruppe ein europäisches Patent begehrt. Das Gleiche gilt, wenn der Anmelder in der internationalen Anmeldung einen dieser Gruppe angehörenden Vertragsstaat benannt hat, dessen Recht vorschreibt, dass eine Bestimmung dieses Staats die Wirkung einer Anmeldung für ein europäisches Patent hat.

(2) Where the European Patent Office acts as a designated Office under Article 153, paragraph 1, paragraph 1 shall apply if the applicant has indicated in the international application that he wishes to obtain a European patent for one or more of the designated States of the group. The same shall apply if the applicant designates in the international application one of the Contracting States in the group, whose national law provides that the designation of that State shall have the effect of the application being for a European patent.

(2) Lorsque l'Office européen des brevets est l'Office désigné au sens de l'article 153, paragraphe 1, le paragraphe 1 du présent article est applicable si le demandeur fait connaître dans la demande internationale qu'il entend obtenir un brevet européen pour les Etats du groupe qu'il a désignés ou pour l'un d'entre eux seulement. La présente disposition est également applicable lorsque le demandeur a désigné dans la demande internationale un Etat contractant appartenant à ce groupe, si la législation de cet Etat prévoit qu'une désignation dudit Etat a les effets d'une demande de brevet européen.

Verweisungen / References / Références

ZEHNTER TEIL

INTERNATIONALE ANMELDUNG NACH DEM VERTRAG ÜBER DIE INTERNATIONALE ZUSAMMENARBEIT AUF DEM GEBIET DES PATENTWESENS

Artikel 150¹⁰²

Anwendung des Vertrags über die internationale Zusammenarbeit auf dem Gebiet des Patentwesens

(1) Der Vertrag über die internationale Zusammenarbeit auf dem Gebiet des Patentwesens vom 19. Juni 1970, im Folgenden Zusammenarbeitsvertrag genannt, ist nach Maßgabe dieses Teils anzuwenden.

(2) Internationale Anmeldungen nach dem Zusammenarbeitsvertrag können Gegenstand von Verfahren vor dem Europäischen Patentamt sein. In diesen Verfahren sind der Zusammenarbeitsvertrag und ergänzend dieses Übereinkommen anzuwenden. Stehen die Vorschriften dieses Übereinkommens denen des Zusammenarbeitsvertrags entgegen, so sind die Vorschriften des Zusammenarbeitsvertrags maßgebend. Insbesondere läuft die in Artikel 94 Absatz 2 dieses Übereinkommens genannte Frist zur Stellung des Prüfungsantrags für eine internationale Anmeldung nicht vor der in Artikel 22 oder 39 des Zusammenarbeitsvertrags genannten Frist ab.

(3) Eine internationale Anmeldung, für die das Europäische Patentamt als Bestimmungsamt oder ausgewähltes Amt tätig wird, gilt als europäische Patentanmeldung.

(4) Soweit in diesem Übereinkommen auf den Zusammenarbeitsvertrag Bezug genommen ist, erstreckt sich die Bezugnahme auch auf dessen Ausführungsordnung.

Artikel 151

Das Europäische Patentamt als Anmeldeamt

(1) Das Europäische Patentamt kann Anmeldeamt im Sinn des Artikels 2 Ziffer xv des Zusammenarbeitsvertrags sein, wenn der Anmelder Staatsangehöriger eines Vertragsstaats dieses Übereinkommens ist, für den der Zusammenarbeitsvertrag in Kraft getreten ist; das Gleiche gilt, wenn der Anmelder in diesem Staat seinen Wohnsitz oder Sitz hat.

(2) Das Europäische Patentamt kann auch Anmeldeamt sein, wenn der Anmelder Staatsangehöriger eines Staats ist, der nicht Vertragsstaat dieses Übereinkommens, jedoch Vertragsstaat des Zusammenarbeitsvertrags ist und der mit der Organisation eine Vereinbarung geschlossen hat, nach der das Europäische Patentamt nach Maßgabe des Zusammenarbeitsvertrags anstelle des nationalen Amts dieses Staats als Anmeldeamt tätig wird; das Gleiche gilt, wenn der Anmelder in diesem Staat seinen Wohnsitz oder Sitz hat.

¹⁰² Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 5/93, G 2/02 und G 3/02 (Anhang I).

PART X

INTERNATIONAL APPLICATION PURSUANT TO THE PATENT COOPERATION TREATY

Article 150¹⁰²

Application of the Patent Cooperation Treaty

(1) The Patent Cooperation Treaty of 19 June 1970, hereinafter referred to as the Cooperation Treaty, shall be applied in accordance with the provisions of this Part.

(2) International applications filed under the Cooperation Treaty may be the subject of proceedings before the European Patent Office. In such proceedings, the provisions of that Treaty shall be applied, supplemented by the provisions of this Convention. In case of conflict, the provisions of the Cooperation Treaty shall prevail. In particular, for an international application the time limit within which a request for examination must be filed under Article 94, paragraph 2, of this Convention shall not expire before the time prescribed by Article 22 or Article 39 of the Cooperation Treaty as the case maybe.

(3) An international application, for which the European Patent Office acts as designated Office or elected Office, shall be deemed to be a European patent application.

(4) Where reference is made in this Convention to the Cooperation Treaty, such reference shall include the Regulations under that Treaty.

Article 151

The European Patent Office as a receiving Office

(1) The European Patent Office may act as a receiving Office within the meaning of Article 2(xv) of the Cooperation Treaty if the applicant is a resident or national of a Contracting State to this Convention in respect of which the Cooperation Treaty has entered into force.

(2) The European Patent Office may also act as a receiving Office if the applicant is a resident or national of a State which is not a Contracting State to this Convention, but which is a Contracting State to the Cooperation Treaty and which has concluded an agreement with the Organisation whereby the European Patent Office acts as a receiving Office, in accordance with the provisions of the Cooperation Treaty, in place of the national office of that State.

¹⁰² See decisions of the Enlarged Board of Appeal G 5/93, G 2/02 and G 3/02 (Annex I).

DIXIÈME PARTIE

Verweisungen / References / Références

DEMANDE INTERNATIONALE AU SENS DU TRAITÉ DE COOPÉRATION EN MATIÈRE DE BREVETS

*Article 150*¹⁰²

Application du Traité de Coopération en matière de brevets

R. 85b/ter, 107

(1) Le Traité de Coopération en matière de brevets du 19 juin 1970, ci-après dénommé Traité de Coopération, s'applique conformément aux dispositions de la présente partie.

(2) Des demandes internationales déposées conformément au Traité de Coopération peuvent faire l'objet de procédures devant l'Office européen des brevets. Dans ces procédures, les dispositions dudit traité et, à titre complémentaire, les dispositions de la présente convention sont applicables. Les dispositions du Traité de Coopération prévalent en cas de divergence. En particulier, pour une demande internationale, le délai dans lequel la requête en examen doit être présentée en application de l'article 94, paragraphe 2, de la présente convention ne vient pas à expiration avant le délai prescrit, selon le cas, par l'article 22 ou par l'article 39 du Traité de Coopération.

(3) Lorsque l'Office européen des brevets agit en qualité d'Office désigné ou d'Office élu pour une demande internationale, cette demande est réputée être une demande de brevet européen.

(4) Dans la mesure où il est fait référence, dans la présente convention, au Traité de Coopération, cette référence s'étend également au règlement d'exécution de ce dernier.

Article 151

L'Office européen des brevets, Office récepteur

*Art. 35
R. 104*

(1) L'Office européen des brevets peut être Office récepteur au sens de l'article 2 (xv) du Traité de Coopération, lorsque le demandeur a la nationalité d'un Etat partie à la présente convention à l'égard duquel le Traité de Coopération est entré en vigueur ; la présente disposition est également applicable lorsque le demandeur a son domicile ou son siège dans cet Etat.

(2) L'Office européen des brevets peut aussi être Office récepteur lorsque le demandeur a la nationalité d'un Etat qui, n'étant pas partie à la présente convention, est cependant partie au Traité de Coopération et a conclu avec l'Organisation un accord aux termes duquel, conformément aux dispositions dudit traité, l'Office européen des brevets agit en qualité d'Office récepteur au lieu et place de l'office national ; la présente disposition est également applicable lorsque le demandeur a son domicile ou son siège dans cet Etat.

¹⁰² Cf. les décisions de la Grande Chambre de recours G 5/93, G 2/02 et G 3/02 (Annexe I).

(3) Vorbehaltlich der vorherigen Zustimmung des Verwaltungsrats wird das Europäische Patentamt auf Grund einer zwischen der Organisation und dem Internationalen Büro der Weltorganisation für geistiges Eigentum geschlossenen Vereinbarung auch für andere Anmelder als Anmeldeamt tätig.

Artikel 152

Einreichung und Weiterleitung der internationalen Anmeldung

(1) Wählt der Anmelder das Europäische Patentamt als Anmeldeamt für seine internationale Anmeldung, so hat er diese unmittelbar beim Europäischen Patentamt einzureichen. Artikel 75 Absatz 2 ist jedoch entsprechend anzuwenden.

(2) Die Vertragsstaaten ergreifen im Fall der Einreichung einer internationalen Anmeldung beim Europäischen Patentamt durch Vermittlung der zuständigen Zentralbehörde für den gewerblichen Rechtsschutz alle geeigneten Maßnahmen, um sicherzustellen, dass die Anmeldungen so rechtzeitig an das Europäische Patentamt weitergeleitet werden, dass dieses den Übermittlungspflichten nach dem Zusammenarbeitsvertrag rechtzeitig genügen kann.

(3)¹⁰³ Für die internationale Anmeldung ist die Übermittlungsgebühr zu zahlen, die innerhalb eines Monats nach Eingang der Anmeldung zu entrichten ist.

*Artikel 153*¹⁰⁴

Das Europäische Patentamt als Bestimmungsamt

(1) Das Europäische Patentamt ist Bestimmungsamt im Sinn des Artikels 2 Ziffer xiii des Zusammenarbeitsvertrags für die in der internationalen Anmeldung benannten Vertragsstaaten dieses Übereinkommens, für die der Zusammenarbeitsvertrag in Kraft getreten ist, wenn der Anmelder in der internationalen Anmeldung dem Anmeldeamt mitgeteilt hat, dass er für diese Staaten ein europäisches Patent begehrt. Das Gleiche gilt, wenn der Anmelder in der internationalen Anmeldung einen Vertragsstaat benannt hat, dessen Recht vorschreibt, dass eine Bestimmung dieses Staats die Wirkung einer Anmeldung für ein europäisches Patent hat.

(2) Für Entscheidungen, die das Europäische Patentamt als Bestimmungsamt nach Artikel 25 Absatz 2 Buchstabe a des Zusammenarbeitsvertrags zu treffen hat, sind die Prüfungsabteilungen zuständig.

¹⁰³ Geändert durch Beschluss des Verwaltungsrats vom 21.12.1978, in Kraft getreten am 01.03.1979 (ABI. EPA 1979, 3).

¹⁰⁴ Siehe hierzu Rechtsauskunft Nr. 10/92 rev. (Anhang II).

(3) Subject to the prior approval of the Administrative Council, the European Patent Office may also act as a receiving Office for any other applicant, in accordance with an agreement concluded between the Organisation and the International Bureau of the World Intellectual Property Organization.

Article 152

Filing and transmittal of the international application

(1) If the applicant chooses the European Patent Office as a receiving Office for his international application, he shall file it directly with the European Patent Office. Article 75, paragraph 2, shall nevertheless apply *mutatis mutandis*.

(2) In the event of an international application being filed with the European Patent Office through the intermediary of the competent central industrial property office, the Contracting State concerned shall take all necessary measures to ensure that the application is transmitted to the European Patent Office in time for the latter to be able to comply in due time with the conditions for transmittal under the Cooperation Treaty.

(3)¹⁰³ Each international application shall be subject to the payment of the transmittal fee, which shall be payable within one month after receipt of the application.

*Article 153*¹⁰⁴

The European Patent Office as a designated Office

(1) The European Patent Office shall act as a designated Office within the meaning of Article 2(xiii) of the Cooperation Treaty for those Contracting States to this Convention in respect of which the Cooperation Treaty has entered into force and which are designated in the international application if the applicant informs the receiving Office in the international application that he wishes to obtain a European patent for these States. The same shall apply if, in the international application, the applicant designates a Contracting State of which the national law provides that designation of that State shall have the effect of the application being for a European patent.

(2) When the European Patent Office acts as a designated Office, the Examining Division shall be competent to take decisions which are required under Article 25, paragraph 2(a), of the Cooperation Treaty.

¹⁰³ Amended by decision of the Administrative Council of 21.12.1978, which entered into force on 01.03.1979 (OJ EPO 1979, 3).

¹⁰⁴ See Legal advice No. 10/92 rev. (Annex II).

(3) Sous réserve de l'accord préalable du Conseil d'administration, l'Office européen des brevets agit aussi pour tout autre demandeur en qualité d'Office récepteur conformément à un accord conclu entre l'Organisation et le Bureau International de l'Organisation Mondiale de la Propriété Intellectuelle.

Verweisungen / References / Références

Article 152

Dépôt et transmission de la demande internationale

R. 104

(1) Si le demandeur choisit l'Office européen des brevets en qualité d'Office récepteur de sa demande internationale, il doit déposer cette dernière directement auprès de l'Office européen des brevets. Toutefois, les dispositions de l'article 75, paragraphe 2, sont applicables.

(2) Dans le cas où une demande internationale est déposée auprès de l'Office européen des brevets par l'intermédiaire du service central de la propriété industrielle compétent, les Etats contractants prennent toutes les mesures appropriées pour garantir que les demandes soient transmises à l'Office européen des brevets en temps utile afin que celui-ci puisse satisfaire, dans les délais prescrits, aux obligations qui lui incombent aux termes du Traité de Coopération pour la transmission des demandes internationales.

(3)¹⁰³ Le dépôt de la demande internationale donne lieu au paiement de la taxe de transmission, qui doit être versée dans un délai d'un mois à compter du dépôt de la demande.

*Article 153*¹⁰⁴

L'Office européen des brevets, Office désigné

Art. 18, 149, 156
R. 107

(1) Au sens de l'article 2 (xiii) du Traité de Coopération, l'Office européen des brevets est Office désigné pour les Etats qui, parties à la présente convention et pour lesquels le Traité de Coopération est entré en vigueur, sont désignés dans la demande internationale, si le demandeur indique à l'Office récepteur, dans cette demande, qu'il entend obtenir pour ces Etats un brevet européen. La présente disposition est également applicable lorsque le demandeur a désigné, dans la demande internationale, un Etat contractant dont la législation prévoit qu'une désignation de cet Etat a les effets d'une demande de brevet européen.

(2) Lorsque l'Office européen des brevets agit en qualité d'Office désigné, les divisions d'examen sont compétentes pour prendre les décisions prévues à l'article 25, paragraphe 2, lettre a), du Traité de Coopération.

¹⁰³ Modifié par décision du Conseil d'administration en date du 21.12.1978, entrée en vigueur le 01.03.1979 (JO OEB 1979, 3).

¹⁰⁴ Cf. le renseignement juridique n° 10/92 rév. (Annexe II).

Artikel 154

Das Europäische Patentamt als Internationale Recherchenbehörde

(1)¹⁰⁵ Vorbehaltlich einer zwischen der Organisation und dem Internationalen Büro der Weltorganisation für geistiges Eigentum geschlossenen Vereinbarung wird das Europäische Patentamt für Anmelder, die Staatsangehörige eines Vertragsstaats sind, für den der Zusammenarbeitsvertrag in Kraft getreten ist, als Internationale Recherchenbehörde im Sinn des Kapitels I des Zusammenarbeitsvertrags tätig; das Gleiche gilt, wenn der Anmelder in diesem Staat seinen Wohnsitz oder Sitz hat.

(2) Vorbehaltlich der vorherigen Zustimmung des Verwaltungsrats wird das Europäische Patentamt auf Grund einer zwischen der Organisation und dem Internationalen Büro der Weltorganisation für geistiges Eigentum geschlossenen Vereinbarung auch für andere Anmelder als Internationale Recherchenbehörde tätig.

(3)¹⁰⁶ Für Entscheidungen über einen Widerspruch des Anmelders gegen eine vom Europäischen Patentamt nach Artikel 17 Absatz 3 Buchstabe a des Zusammenarbeitsvertrags für die internationale Recherche festgesetzte zusätzliche Gebühr sind die Beschwerdekammern zuständig.

Artikel 155

Das Europäische Patentamt als mit der internationalen vorläufigen Prüfung beauftragte Behörde

(1)¹⁰⁷ Vorbehaltlich einer zwischen der Organisation und dem Internationalen Büro der Weltorganisation für geistiges Eigentum geschlossenen Vereinbarung wird das Europäische Patentamt für Anmelder, die Staatsangehörige eines Vertragsstaats sind, für den Kapitel II des Zusammenarbeitsvertrags verbindlich ist, als mit der internationalen vorläufigen Prüfung beauftragte Behörde im Sinn des Kapitels II des Zusammenarbeitsvertrags tätig; das Gleiche gilt, wenn der Anmelder in diesem Staat seinen Wohnsitz oder Sitz hat.

¹⁰⁵ Siehe hierzu die Vereinbarung zwischen EPO und WIPO nach dem PCT in der Fassung vom 01.11.2001 (ABI. EPA 2001, 601 ff.), geändert mit Wirkung zum 01.01.2004 (ABI. EPA 2003, 631), und die Mitteilung des Präsidenten des EPA vom 26.11.2001 über die Beschränkung der Zuständigkeit des EPA als PCT-Behörde (ABI. EPA 2002, 52 ff.), teilweise aufgehoben durch die Mitteilung des Präsidenten des EPA vom 31.10.2003 (ABI. EPA 2003, 633).

¹⁰⁶ Siehe hierzu Entscheidung/Stellungnahme der Großen Beschwerdekammer G 1/89, G 2/89 (Anhang I).

¹⁰⁷ Siehe hierzu die Vereinbarung zwischen EPO und WIPO nach dem PCT in der Fassung vom 01.11.2001 (ABI. EPA 2001, 601 ff.), geändert mit Wirkung zum 01.01.2004 (ABI. EPA 2003, 631), und die Mitteilung des Präsidenten des EPA vom 26.11.2001 über die Beschränkung der Zuständigkeit des EPA als PCT-Behörde (ABI. EPA 2002, 52 ff.), teilweise aufgehoben durch die Mitteilung des Präsidenten des EPA vom 31.10.2003 (ABI. EPA 2003, 633).

Article 154

The European Patent Office as an International Searching Authority

(1)¹⁰⁵ The European Patent Office shall act as an International Searching Authority within the meaning of Chapter I of the Cooperation Treaty for applicants who are residents or nationals of a Contracting State in respect of which the Cooperation Treaty has entered into force, subject to the conclusion of an agreement between the Organisation and the International Bureau of the World Intellectual Property Organization.

(2) Subject to the prior approval of the Administrative Council, the European Patent Office shall also act as an International Searching Authority for any other applicant, in accordance with an agreement concluded between the Organisation and the International Bureau of the World Intellectual Property Organization.

(3)¹⁰⁶ The Boards of Appeal shall be responsible for deciding on a protest made by an applicant against an additional fee charged by the European Patent Office under the provisions of Article 17, paragraph 3(a), of the Cooperation Treaty.

Article 155

The European Patent Office as an International Preliminary Examining Authority

(1)¹⁰⁷ The European Patent Office shall act as an International Preliminary Examining Authority within the meaning of Chapter II of the Cooperation Treaty for applicants who are residents or nationals of a Contracting State bound by that Chapter, subject to the conclusion of an agreement between the Organisation and the International Bureau of the World Intellectual Property Organization.

¹⁰⁵ See Agreement between the EPO and WIPO under the PCT as of 01.11.2001 (OJ EPO 2001, 601 ff) amended with effect from 01.01.2004 (OJ EPO 2003, 631) and the notice from the President of the EPO dated 26.11.2001 concerning limitation of the EPO's competence as a PCT authority (OJ EPO 2002, 52 ff), partially lifted by the notice from the President of the EPO dated 31.10.2003 (OJ EPO 2003, 633).

¹⁰⁶ See decision/opinion of the Enlarged Board of Appeal G 1/89, G 2/89 (Annex I).

¹⁰⁷ See Agreement between the EPO and WIPO under the PCT as of 01.11.2001 (OJ EPO 2001, 601 ff) amended with effect from 01.01.2004 (OJ EPO 2003, 631) and the notice from the President of the EPO dated 26.11.2001 concerning limitation of the EPO's competence as a PCT authority (OJ EPO 2002, 52 ff), partially lifted by the notice from the President of the EPO dated 31.10.2003 (OJ EPO 2003, 633).

Article 154

L'Office européen des brevets, administration
chargée de la recherche internationale

Verweisungen / References / Références

Art. 21, 35
R. 105

(1)¹⁰⁵ L'Office européen des brevets agit en qualité d'administration chargée de la recherche internationale, au sens du chapitre I du Traité de Coopération, pour les demandeurs ayant la nationalité d'un Etat contractant à l'égard duquel le Traité de Coopération est entré en vigueur, sous réserve de la conclusion d'un accord entre l'Organisation et le Bureau International de l'Organisation Mondiale de la Propriété Intellectuelle ; la présente disposition est applicable lorsque le demandeur a son domicile ou son siège dans cet Etat.

(2) Sous réserve de l'accord préalable du Conseil d'administration, l'Office européen des brevets agit aussi pour tout autre demandeur en qualité d'administration chargée de la recherche internationale, conformément à un accord conclu entre l'Organisation et le Bureau International de l'Organisation Mondiale de la Propriété Intellectuelle.

(3)¹⁰⁶ Les chambres de recours sont compétentes pour statuer sur une réserve formulée par le déposant à l'encontre de la fixation d'une taxe additionnelle par l'Office européen des brevets, en vertu de l'article 17, paragraphe 3, lettre a) du Traité de Coopération.

Article 155

L'Office européen des brevets, administration
chargée de l'examen préliminaire international

Art. 21, 35
R. 105

(1)¹⁰⁷ L'Office européen des brevets agit en qualité d'administration chargée de l'examen préliminaire international, au sens du chapitre II du Traité de Coopération, pour les demandeurs ressortissants d'un Etat contractant à l'égard duquel ce chapitre est entré en vigueur, sous réserve de la conclusion d'un accord entre l'Organisation et le Bureau International de l'Organisation Mondiale de la Propriété Intellectuelle ; la présente disposition est également applicable lorsque le demandeur a son domicile ou son siège dans cet Etat.

¹⁰⁵ Cf. l'Accord entre l'OEB et l'OMPI concernant le PCT, tel que modifié le 01.11.2001 (JO OEB 2001, 601 s.), modifié avec effet au 01.01.2004 (JO OEB 2003, 631), et le communiqué du Président de l'OEB, en date du 26.11.2001, relatif à la limitation de la compétence de l'OEB agissant en qualité d'administration au titre du PCT (JO OEB 2002, 52 s.), supprimée en partie par le communiqué du Président de l'OEB en date du 31.10.2003 (JO OEB 2003, 633).

¹⁰⁶ Cf. la décision/l'avis de la Grande Chambre de recours G 1/89, G 2/89 (Annexe I).

¹⁰⁷ Cf. l'Accord entre l'OEB et l'OMPI concernant le PCT, tel que modifié le 01.11.2001 (JO OEB 2001, 601 s.), modifié avec effet au 01.01.2004 (JO OEB 2003, 631), et le communiqué du Président de l'OEB, en date du 26.11.2001, relatif à la limitation de la compétence de l'OEB agissant en qualité d'administration au titre du PCT (JO OEB 2002, 52 s.), supprimée en partie par le communiqué du Président de l'OEB en date du 31.10.2003 (JO OEB 2003, 633).

(2) Vorbehaltlich der vorherigen Zustimmung des Verwaltungsrats wird das Europäische Patentamt auf Grund einer zwischen der Organisation und dem Internationalen Büro der Weltorganisation für geistiges Eigentum geschlossenen Vereinbarung auch für andere Anmelder als mit der internationalen vorläufigen Prüfung beauftragte Behörde tätig.

(3) Für Entscheidungen über einen Widerspruch des Anmelders gegen eine vom Europäischen Patentamt nach Artikel 34 Absatz 3 Buchstabe a des Zusammenarbeitsvertrags für die internationale vorläufige Prüfung festgesetzte zusätzliche Gebühr sind die Beschwerdekammern zuständig.

Artikel 156

Das Europäische Patentamt als ausgewähltes Amt

Das Europäische Patentamt wird als ausgewähltes Amt im Sinn des Artikels 2 Ziffer xiv des Zusammenarbeitsvertrags tätig, wenn der Anmelder einen der benannten Staaten, auf die sich Artikel 153 Absatz 1 oder Artikel 149 Absatz 2 bezieht, ausgewählt hat und für diesen Staat Kapitel II dieses Vertrags verbindlich geworden ist. Vorbehaltlich der vorherigen Zustimmung des Verwaltungsrats gilt dies auch dann, wenn der Anmelder in einem Staat seinen Wohnsitz oder Sitz hat oder Staatsangehöriger eines Staats ist, der nicht Mitglied des Zusammenarbeitsvertrags ist oder für den Kapitel II nicht verbindlich ist, sofern er einer Personengruppe angehört, der die Versammlung des Internationalen Verbands für die Zusammenarbeit auf dem Gebiet des Patentwesens durch einen Beschluss nach Artikel 31 Absatz 2 Buchstabe b des Zusammenarbeitsvertrags gestattet hat, einen Antrag auf internationale vorläufige Prüfung zu stellen.

Artikel 157

Internationaler Recherchenbericht

(1) Unbeschadet der nachstehenden Absätze treten der internationale Recherchenbericht nach Artikel 18 des Zusammenarbeitsvertrags oder eine Erklärung nach Artikel 17 Absatz 2 Buchstabe a des Vertrags und deren Veröffentlichung nach Artikel 21 des Vertrags an die Stelle des europäischen Recherchenberichts und des Hinweises auf dessen Veröffentlichung im Europäischen Patentblatt.

(2) Vorbehaltlich der Beschlüsse des Verwaltungsrats nach Absatz 3

a) wird zu jeder internationalen Anmeldung ein ergänzender europäischer Recherchenbericht erstellt;

(2) Subject to the prior approval of the Administrative Council, the European Patent Office shall also act as an International Preliminary Examining Authority for any other applicant, in accordance with an agreement concluded between the Organisation and the International Bureau of the World Intellectual Property Organization.

(3) The Boards of Appeal shall be responsible for deciding on a protest made by an applicant against an additional fee charged by the European Patent Office under the provisions of Article 34, paragraph 3(a), of the Cooperation Treaty.

Article 156

The European Patent Office as an elected Office

The European Patent Office shall act as an elected Office within the meaning of Article 2(xiv) of the Cooperation Treaty if the applicant has elected any of the designated States referred to in Article 153, paragraph 1, or Article 149, paragraph 2, for which Chapter II of that Treaty has become binding. Subject to the prior approval of the Administrative Council, the same shall apply where the applicant is a resident or national of a State which is not a party to that Treaty or which is not bound by Chapter II of that Treaty, provided that he is one of the persons whom the Assembly of the International Patent Cooperation Union has decided to allow, pursuant to Article 31, paragraph 2(b), of the Cooperation Treaty, to make a demand for international preliminary examination.

Article 157

International search report

(1) Without prejudice to the provisions of paragraphs 2 to 4, the international search report under Article 18 of the Cooperation Treaty or any declaration under Article 17, paragraph 2(a), of that Treaty and their publication under Article 21 of that Treaty shall take the place of the European search report and the mention of its publication in the European Patent Bulletin.

(2) Subject to the decisions of the Administrative Council referred to in paragraph 3:

(a) a supplementary European search report shall be drawn up in respect of all international applications;

(2) Sous réserve de l'accord préalable du Conseil d'administration, l'Office européen des brevets agit aussi pour tout autre demandeur en qualité d'administration chargée de l'examen préliminaire international conformément à un accord conclu entre l'Organisation et le Bureau International de l'Organisation Mondiale de la Propriété Intellectuelle.

(3) Les chambres de recours sont compétentes pour statuer sur une réserve formulée par le déposant à l'encontre de la fixation d'une taxe additionnelle par l'Office européen des brevets, en vertu de l'article 34, paragraphe 3, lettre a), du Traité de Coopération.

Article 156

L'Office européen des brevets, Office élu

L'Office européen des brevets agit en qualité d'Office élu au sens de l'article 2 (xiv) du Traité de Coopération, si le demandeur a élu l'un des Etats désignés visés à l'article 153, paragraphe 1, ou à l'article 149, paragraphe 2, et à l'égard duquel le chapitre II dudit traité est entré en vigueur. Sous réserve de l'accord préalable du Conseil d'administration, la présente disposition est applicable lorsque le demandeur a la nationalité d'un Etat non contractant ou à l'égard duquel le chapitre II n'est pas entré en vigueur ou lorsqu'il a son domicile ou son siège dans ledit Etat, dans la mesure où il fait partie des personnes auxquelles l'Assemblée de l'Union de coopération internationale en matière de brevets a permis, par une décision prise conformément à l'article 31, paragraphe 2, lettre b), dudit traité, de présenter une demande d'examen préliminaire international.

Article 157

Rapport de recherche internationale

(1) Sans préjudice des dispositions des paragraphes suivants, le rapport de recherche internationale prévu à l'article 18 du Traité de Coopération ou toute déclaration faite en vertu de l'article 17, paragraphe 2, lettre a), de ce traité et leur publication en vertu de l'article 21 du même traité remplacent le rapport de recherche européenne et la mention de sa publication au Bulletin européen des brevets.

(2) Sous réserve des décisions du Conseil d'administration visées au paragraphe 3,

a) il est procédé à l'établissement d'un rapport complémentaire de recherche européenne relatif à toute demande internationale ;

Verweisungen / References / Références

Art. 35
R. 107

Art. 35, 92, 93
R. 69, 107

b)¹⁰⁸ hat der Anmelder die Recherchegebühr zu zahlen, die gleichzeitig mit der nationalen Gebühr nach Artikel 22 Absatz 1 oder Artikel 39 Absatz 1 des Zusammenarbeitsvertrags zu entrichten ist. Ist die Recherchegebühr nicht rechtzeitig entrichtet worden, so gilt die Anmeldung als zurückgenommen.

(3) Der Verwaltungsrat kann beschließen, unter welchen Voraussetzungen und in welchem Umfang

a)¹⁰⁹ auf einen ergänzenden europäischen Recherchenbericht verzichtet wird;

b)¹¹⁰ die Recherchegebühr herabgesetzt wird.

(4)¹¹¹ Der Verwaltungsrat kann die nach Absatz 3 gefassten Beschlüsse jederzeit rückgängig machen.

Artikel 158

Veröffentlichung der internationalen Anmeldung und ihre Übermittlung an das Europäische Patentamt

(1) Die Veröffentlichung einer internationalen Anmeldung nach Artikel 21 des Zusammenarbeitsvertrags, für die das Europäische Patentamt Bestimmungsort ist, tritt vorbehaltlich Absatz 3 an die Stelle der Veröffentlichung der europäischen Patentanmeldung und wird im Europäischen Patentblatt bekannt gemacht. Eine solche Anmeldung gilt jedoch nicht als Stand der Technik nach Artikel 54 Absatz 3, wenn die in Absatz 2 genannten Voraussetzungen nicht erfüllt sind.

¹⁰⁸ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 3/91, G 5/93 (Anhang I).

¹⁰⁹ Siehe hierzu die Beschlüsse des Verwaltungsrats über den Verzicht auf einen ergänzenden europäischen Recherchenbericht vom 21.12.1978 (ABl. EPA 1979, 4, Korr. 50), 17.05.1979 (ABl. EPA 1979, 248) und 09.06.1995 (ABl. EPA 1995, 511), die für vor dem 01.07.2005 eingereichte Anmeldungen weiter gelten. Mit Wirkung für ab dem 01.07.2005 eingereichte Anmeldungen wurden diese Beschlüsse durch den Beschluss des Verwaltungsrats vom 10.06.2005 (ABl. EPA 2005, 422) in der Fassung des Beschlusses vom 27.10.2005 (ABl. EPA 2005, 546) aufgehoben, wobei die Aufhebung des Beschlusses vom 21.12.1978 (ABl. EPA 1979, 4, Korr. 50) sich nicht auf internationale Anmeldungen erstreckt, zu denen das Europäische Patentamt den internationalen Recherchenbericht erstellt.

¹¹⁰ Siehe hierzu den Beschluss des Verwaltungsrats über die Herabsetzung der Gebühr für die ergänzende europäische Recherche vom 10.06.2005 (ABl. EPA 2005, 422) in der Fassung des Beschlusses vom 27.10.2005 (ABl. EPA 2005, 546), geändert durch Beschluss vom 15.12.2005 (ABl. EPA 2006, 13 f.). Siehe hierzu die Beschlüsse des Verwaltungsrats über die Herabsetzung der Gebühr für die ergänzende europäische Recherche vom 14.09.1979 (ABl. EPA 1979, 368), 11.12.1980 (ABl. EPA 1981, 5), 09.12.1993 (ABl. EPA 1994, 6) und 08.06.2000 (ABl. EPA 2000, 321), die für vor dem 01.07.2005 eingereichte Anmeldungen weiter gelten. Für ab dem 01.07.2005 eingereichte Anmeldungen gilt der Beschluss vom 27.10.2005 (ABl. EPA 2005, 548).

¹¹¹ Siehe hierzu den Beschluss des Verwaltungsrats vom 10.06.2005 zur Herabsetzung der Gebühr für die ergänzende europäische Recherche (ABl. EPA 2005, 422) in der Fassung des Beschlusses vom 27.10.2005 (ABl. EPA 2005, 546), geändert durch Beschluss vom 15.12.2005 (ABl. EPA 2006, 13 f.), und den Beschluss vom 27.10.2005 (ABl. EPA 2005, 548).

(b)¹⁰⁸ the applicant shall pay the search fee, which shall be paid at the same time as the national fee provided for in Article 22, paragraph 1, or Article 39, paragraph 1, of the Cooperation Treaty. If the search fee is not paid in due time the application shall be deemed to be withdrawn.

(3) The Administrative Council may decide under what conditions and to what extent:

(a)¹⁰⁹ the supplementary European search report is to be dispensed with;

(b)¹¹⁰ the search fee is to be reduced.

(4)¹¹¹ The Administrative Council may at any time rescind the decisions taken pursuant to paragraph 3.

Article 158

Publication of the international application and its supply to the European Patent Office

(1) Publication under Article 21 of the Cooperation Treaty of an international application for which the European Patent Office is a designated Office shall, subject to paragraph 3, take the place of the publication of a European patent application and shall be mentioned in the European Patent Bulletin. Such an application shall not however be considered as comprised in the state of the art in accordance with Article 54, paragraph 3, if the conditions laid down in paragraph 2 are not fulfilled.

¹⁰⁸ See decisions of the Enlarged Board of Appeal G 3/91, G 5/93 (Annex I).

¹⁰⁹ See the decisions of the Administrative Council of 21.12.1978 (OJ EPO 1979, 4, Corr. 50), 17.05.1979 (OJ EPO 1979, 248) and 09.06.1995 (OJ EPO 1995, 511) dispensing with the supplementary European search report. These decisions continue to apply to applications filed before 01.07.2005, but for those filed on or after that date they have been rescinded by Council decision of 10.06.2005 (OJ EPO 2005, 422) as amended on 27.10.2005 (OJ EPO 2005, 546), except that the rescinding of the decision of 21.12.1978 does not extend to international applications on which the European Patent Office draws up the international search report.

¹¹⁰ See the decision of the Administrative Council of 10.06.2005 reducing the fee for the supplementary European search (OJ EPO 2005, 422) as amended on 27.10.2005 (OJ EPO 2005, 546) and 15.12.2005 (OJ EPO 2006, 13 f.). See also the Council's decisions of 14.09.1979 (OJ EPO 1979, 368), 11.12.1980 (OJ EPO 1981, 5), 09.12.1993 (OJ EPO 1994, 6) and 08.06.2000 (OJ EPO 2000, 321) reducing the fee for the supplementary European search. These decisions continue to apply to applications filed before 01.07.2005; for those filed on or after that date, the decision of 27.10.2005 (OJ EPO 2005, 548) applies.

¹¹¹ See the decision of the Administrative Council of 10.06.2005 reducing the fee for the supplementary European search (OJ EPO 2005, 422), as amended on 27.10.2005 (OJ EPO 2005, 546) and 15.12.2005 (OJ EPO 2006, 13 f.), and the decision of 27.10.2005 (OJ EPO 2005, 548).

b)¹⁰⁸ le demandeur est tenu d'acquitter la taxe de recherche ; ce paiement et celui de la taxe nationale prévue par l'article 22, paragraphe 1 ou par l'article 39, paragraphe 1, du Traité de Coopération doivent être effectués simultanément. Si la taxe de recherche n'est pas acquittée dans les délais, la demande est réputée retirée.

Verweisungen / References / Références

(3) Le Conseil d'administration peut décider des conditions dans lesquelles et de la mesure dans laquelle :

a)¹⁰⁹ il est renoncé au rapport complémentaire de recherche ;

b)¹¹⁰ le montant de la taxe de recherche est réduit.

(4)¹¹¹ A tout moment, le Conseil d'administration peut rapporter les décisions prises en vertu du paragraphe 3.

Article 158

Publication de la demande internationale et communication à l'Office européen des brevets

Art. 93, 129
R. 85a/bis, 106, 107

(1) La publication, en vertu de l'article 21 du Traité de Coopération, d'une demande internationale pour laquelle l'Office européen des brevets est Office désigné remplace, sous réserve des dispositions du paragraphe 3, la publication de la demande de brevet européen et elle est mentionnée au Bulletin européen des brevets. Toutefois, le contenu de cette demande n'est pas considéré comme compris dans l'état de la technique au sens de l'article 54, paragraphe 3 si les conditions prévues au paragraphe 2 ne sont pas remplies.

¹⁰⁸ Cf. les décisions de la Grande Chambre de recours G 3/91, G 5/93 (Annexe I).

¹⁰⁹ Cf. les décisions du Conseil d'administration des 21.12.1978 (JO OEB 1979, 4, Corr. 50), 17.05.1979 (JO OEB 1979, 248) et 09.06.1995 (JO OEB 1995, 511) relatives à la renonciation au rapport complémentaire de recherche européenne. Ces décisions continuent de s'appliquer aux demandes déposées avant le 01.07.2005, mais, s'agissant des demandes déposées à compter de cette date, elles ont été rapportées par la décision du Conseil d'administration du 10.06.2005 (JO OEB 2005, 422) telle que modifiée le 27.10.2005 (JO OEB 2005, 546), le rapport de la décision du 21.12.1978 ne s'étendant toutefois pas aux demandes internationales pour lesquelles l'Office européen des brevets établit le rapport de recherche internationale.

¹¹⁰ Cf. la décision du Conseil d'administration du 10.06.2005 réduisant la taxe due pour la recherche européenne complémentaire (JO OEB 2005, 422), telle que modifiée le 27.10.2005 (JO OEB 2005, 546) et le 15.12.2005 (JO OEB 2006, 13 s.). Cf. également les décisions du Conseil d'administration des 14.09.1979 (JO OEB 1979, 368), 11.12.1980 (JO OEB 1981, 5), 09.12.1993 (JO OEB 1994, 6) et 08.06.2000 (JO OEB 2000, 321) réduisant la taxe due pour la recherche européenne complémentaire. Ces décisions continuent de s'appliquer aux demandes déposées avant le 01.07.2005 ; quant aux demandes déposées à compter de cette date, la décision du 27.10.2005 (JO OEB 2005, 548) est applicable.

¹¹¹ Cf. la décision du Conseil d'administration du 10.06.2005 réduisant la taxe due pour la recherche européenne complémentaire (JO OEB 2005, 422), telle que modifiée le 27.10.2005 (JO OEB 2005, 546) et le 15.12.2005 (JO OEB 2006, 13 s.), et la décision du 27.10.2005 (JO OEB 2005, 548).

(2)¹¹² Die internationale Anmeldung ist dem Europäischen Patentamt in einer seiner Amtssprachen zuzuleiten. Der Anmelder hat die nationale Gebühr nach Artikel 22 Absatz 1 oder Artikel 39 Absatz 1 des Zusammenarbeitsvertrags an das Europäische Patentamt zu entrichten.

(3) Ist die internationale Anmeldung in einer Sprache veröffentlicht, die nicht eine der Amtssprachen des Europäischen Patentamts ist, so veröffentlicht das Europäische Patentamt die ihm nach Absatz 2 zugeleitete internationale Anmeldung. Vorbehaltlich Artikel 67 Absatz 3 tritt der einstweilige Schutz nach Artikel 67 Absätze 1 und 2 erst von dem Tag dieser Veröffentlichung an ein.

(2)¹¹² The international application shall be supplied to the European Patent Office in one of its official languages. The applicant shall pay to the European Patent Office the national fee provided for in Article 22, paragraph 1, or Article 39, paragraph 1, of the Cooperation Treaty.

(3) If the international application is published in a language other than one of the official languages of the European Patent Office, that Office shall publish the international application, supplied as specified in paragraph 2. Subject to the provisions of Article 67, paragraph 3, the provisional protection in accordance with Article 67, paragraphs 1 and 2, shall be effective from the date of that publication.

¹¹² Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 3/91, G 5/93 (Anhang I).

¹¹² See decisions of the Enlarged Board of Appeal G 3/91, G 5/93 (Annex I).

(2)¹¹² La demande internationale doit être remise à l'Office européen des brevets dans l'une de ses langues officielles. Le déposant doit payer à l'Office européen des brevets la taxe nationale prévue par l'article 22, paragraphe 1 ou par l'article 39, paragraphe 1 du Traité de Coopération.

(3) Si la demande internationale est publiée dans une langue autre que l'une des langues officielles de l'Office européen des brevets, celui-ci publie la demande internationale remise dans les conditions prévues au paragraphe 2. Sous réserve des dispositions de l'article 67, paragraphe 3, la protection provisoire visée à l'article 67, paragraphes 1 et 2, n'est assurée qu'à partir de la date de cette publication.

¹¹² Cf. les décisions de la Grande Chambre de recours G 3/91, G 5/93 (Annexe I).

ELFTER TEIL

ÜBERGANGSBESTIMMUNGEN

Artikel 159

Verwaltungsrat während einer Übergangszeit

(1) Die in Artikel 169 Absatz 1 genannten Staaten bestellen ihre Vertreter im Verwaltungsrat; auf Einladung der Regierung der Bundesrepublik Deutschland tritt der Verwaltungsrat nicht später als zwei Monate nach Inkrafttreten des Übereinkommens zusammen, um insbesondere den Präsidenten des Europäischen Patentamts zu ernennen.

(2) Die Amtszeit des ersten nach Inkrafttreten des Übereinkommens ernannten Präsidenten des Verwaltungsrats beträgt vier Jahre.

(3) Die Amtszeit eines gewählten Mitglieds des ersten nach Inkrafttreten des Übereinkommens gebildeten Präsidiums des Verwaltungsrats beträgt fünf Jahre und die Amtszeit eines weiteren gewählten Mitglieds dieses Präsidiums vier Jahre.

Artikel 160

Ernennung von Bediensteten während einer Übergangszeit

(1) Bis zum Erlass des Statuts der Beamten und der für die sonstigen Bediensteten des Europäischen Patentamts geltenden Beschäftigungsbedingungen stellen der Verwaltungsrat und der Präsident des Europäischen Patentamts im Rahmen ihrer Zuständigkeit das erforderliche Personal ein und schließen zu diesem Zweck befristete Verträge. Der Verwaltungsrat kann für die Einstellung des Personals allgemeine Grundsätze aufstellen.

(2) Während einer Übergangszeit, deren Ende der Verwaltungsrat bestimmt, kann der Verwaltungsrat nach Anhörung des Präsidenten des Europäischen Patentamts zu Mitgliedern der Großen Beschwerdekammer oder der Beschwerdekammern auch technisch vorgebildete oder rechtskundige Mitglieder nationaler Gerichte und Behörden der Vertragsstaaten ernennen, die ihre Tätigkeit in den nationalen Gerichten oder Behörden weiterhin ausüben können. Sie können für einen Zeitraum ernannt werden, der weniger als fünf Jahre beträgt, jedoch mindestens ein Jahr betragen muss; sie können wieder ernannt werden.

Artikel 161

Erstes Haushaltsjahr

(1) Das erste Haushaltsjahr der Organisation beginnt mit dem Tag des Inkrafttretens dieses Übereinkommens und endet am 31. Dezember desselben Jahrs. Beginnt das erste Haushaltsjahr in der zweiten Jahreshälfte, so endet es am 31. Dezember des folgenden Jahrs.

PART XI

TRANSITIONAL PROVISIONS

Article 159

Administrative Council during a transitional period

(1) The States referred to in Article 169, paragraph 1, shall appoint their representatives to the Administrative Council; on the invitation of the Government of the Federal Republic of Germany, the Administrative Council shall meet no later than two months after the entry into force of this Convention, particularly for the purpose of appointing the President of the European Patent Office.

(2) The duration of the term of office of the first Chairman of the Administrative Council appointed after the entry into force of this Convention shall be four years.

(3) The term of office of two of the elected members of the first Board of the Administrative Council set up after the entry into force of this Convention shall be five and four years respectively.

Article 160

Appointment of employees during a transitional period

(1) Until such time as the Service Regulations for permanent employees and the conditions of employment of other employees of the European Patent Office have been adopted, the Administrative Council and the President of the European Patent Office, each within their respective powers, shall recruit the necessary employees and shall conclude short-term contracts to that effect. The Administrative Council may lay down general principles in respect of recruitment.

(2) During a transitional period, the expiry of which shall be determined by the Administrative Council, the Administrative Council, after consulting the President of the European Patent Office, may appoint as members of the Enlarged Board of Appeal or of the Boards of Appeal technically or legally qualified members of national courts and authorities of Contracting States who may continue their activities in their national courts or authorities. They may be appointed for a term of less than five years, though this shall not be less than one year, and may be reappointed.

Article 161

First accounting period

(1) The first accounting period of the Organisation shall extend from the date of entry into force of this Convention to 31 December of the same year. If that date falls within the second half of the year, the accounting period shall extend until 31 December of the following year.

DISPOSITIONS TRANSITOIRES*Article 159***Conseil d'administration pendant une période transitoire**

- (1) Les Etats visés à l'article 169, paragraphe 1, nomment leurs représentants au Conseil d'administration ; sur convocation du gouvernement de la République fédérale d'Allemagne, le Conseil siège au plus tard deux mois après l'entrée en vigueur de la présente convention, notamment à l'effet de nommer le Président de l'Office européen des brevets.
- (2) La durée du mandat du premier Président du Conseil d'administration nommé après l'entrée en vigueur de la présente convention est de quatre ans.
- (3) La durée du mandat de deux des membres élus du premier Bureau du Conseil d'administration institué après l'entrée en vigueur de la présente convention est de cinq et quatre ans respectivement.

*Article 160***Nominations d'agents durant une période transitoire****Art. 35
R. 11**

- (1) Jusqu'à l'adoption du statut des fonctionnaires et du régime applicable aux autres agents de l'Office européen des brevets, le Conseil d'administration et le Président de l'Office européen des brevets, chacun dans le cadre de sa compétence, recrutent le personnel nécessaire et concluent à cet effet des contrats de durée limitée. Le Conseil d'administration peut établir des principes généraux concernant le recrutement.
- (2) Durant une période transitoire dont il fixe le terme, le Conseil d'administration peut, le Président de l'Office européen des brevets entendu, nommer en qualité de membres de la Grande Chambre de recours ou des chambres de recours des techniciens ou des juristes, appartenant aux juridictions nationales ou aux services nationaux des Etats contractants, qui peuvent continuer à assumer leurs fonctions au sein de ces juridictions ou de ces services nationaux. Ils peuvent être nommés pour une période inférieure à cinq ans sans toutefois qu'elle soit inférieure à un an et être renouvelés dans leurs fonctions.

*Article 161***Premier exercice budgétaire**

- (1) Le premier exercice budgétaire de l'Organisation s'étend de la date d'entrée en vigueur de la présente convention au 31 décembre suivant. Si cet exercice débute au cours du deuxième semestre, il s'étend jusqu'au 31 décembre de l'année suivante.

(2) Der Haushaltsplan für das erste Haushaltsjahr ist baldmöglichst nach Inkrafttreten dieses Übereinkommens aufzustellen. Bis zum Eingang der in Artikel 40 vorgesehenen Beiträge der Vertragsstaaten im Rahmen des ersten Haushaltsplans zahlen die Vertragsstaaten auf Verlangen des Verwaltungsrats in der von ihm festgesetzten Höhe Vorschüsse, die auf ihre Beiträge für diesen Haushaltsplan angerechnet werden. Die Vorschüsse werden nach dem in Artikel 40 vorgesehenen Aufbringungsschlüssel festgesetzt. Artikel 39 Absätze 3 und 4 ist auf die Vorschüsse entsprechend anzuwenden.

Artikel 162

Stufenweise Ausdehnung des Tätigkeitsbereichs des Europäischen Patentamts

(1)¹¹³ Europäische Patentanmeldungen können von dem Tag an beim Europäischen Patentamt eingereicht werden, den der Verwaltungsrat auf Vorschlag des Präsidenten des Europäischen Patentamts bestimmt.

(2) Der Verwaltungsrat kann auf Vorschlag des Präsidenten des Europäischen Patentamts die Behandlung europäischer Patentanmeldungen von dem in Absatz 1 genannten Zeitpunkt an beschränken. Die Beschränkung kann sich auf bestimmte Gebiete der Technik beziehen. Jedoch sind die Anmeldungen in jedem Fall daraufhin zu prüfen, ob sie einen Anmeldetag haben.

(3) Ist ein Beschluss nach Absatz 2 ergangen, so kann der Verwaltungsrat die Behandlung europäischer Patentanmeldungen nicht mehr weiter beschränken.

(4) Kann eine europäische Patentanmeldung infolge der Beschränkung des Verfahrens nach Absatz 2 nicht weiterbehandelt werden, so teilt das Europäische Patentamt dies dem Anmelder mit und weist ihn darauf hin, dass er einen Umwandlungsantrag stellen kann. Mit dieser Mitteilung gilt die europäische Patentanmeldung als zurückgenommen.

Artikel 163

Zugelassene Vertreter während einer Übergangszeit

(1) Während einer Übergangszeit, deren Ende¹¹⁴ der Verwaltungsrat bestimmt, kann in Abweichung von Artikel 134 Absatz 2 in der Liste der zugelassenen Vertreter jede natürliche Person eingetragen werden, die die folgenden Voraussetzungen erfüllt:

a) Die Person muss die Staatsangehörigkeit eines Vertragsstaats besitzen;

¹¹³ 1. Juni 1978.

¹¹⁴ Die Übergangszeit endete am 7. Oktober 1981 (ABI. EPA 1978, 327).

(2) The budget for the first accounting period shall be drawn up as soon as possible after the entry into force of this Convention. Until contributions provided for in Article 40 due in accordance with the first budget are received by the Organisation, the Contracting States shall, upon the request of and within the limit of the amount fixed by the Administrative Council, make advances which shall be deducted from their contributions in respect of that budget. The advances shall be determined in accordance with the scale referred to in Article 40. Article 39, paragraphs 3 and 4, shall apply mutatis mutandis to the advances.

Article 162

Progressive expansion of the field of activity of the European Patent Office

(1)¹¹³ European patent applications may be filed with the European Patent Office from the date fixed by the Administrative Council on the recommendation of the President of the European Patent Office.

(2) The Administrative Council may, on the recommendation of the President of the European Patent Office, decide that, as from the date referred to in paragraph 1, the processing of European patent applications may be restricted. Such restriction may be in respect of certain areas of technology. However, examination shall in any event be made as to whether European patent applications can be accorded a date of filing.

(3) If a decision has been taken under paragraph 2, the Administrative Council may not subsequently further restrict the processing of European patent applications.

(4) Where, as a result of the procedure being restricted under paragraph 2, a European patent application cannot be further processed, the European Patent Office shall communicate this to the applicant and shall point out that he may make a request for conversion. The European patent application shall be deemed to be withdrawn on receipt of such communication.

Article 163

Professional representatives during a transitional period

(1) During a transitional period, the expiry¹¹⁴ of which shall be determined by the Administrative Council, notwithstanding the provisions of Article 134, paragraph 2, any natural person who fulfils the following conditions may be entered on the list of professional representatives:

(a) he must be a national of a Contracting State;

¹¹³ 1 June 1978.

¹¹⁴ The transitional period expired on 7 October 1981 (OJ EPO 1978, 327).

(2) Le budget du premier exercice est établi aussitôt que possible après l'entrée en vigueur de la présente convention. Dans l'attente du versement des contributions des Etats contractants, prévues à l'article 40 et afférentes au premier budget, ces Etats font, sur requête du Conseil d'administration et dans les limites du montant qu'il fixe, des avances qui viennent en déduction de leurs contributions au titre de ce budget. Le montant de ces avances est déterminé conformément à la clé de répartition visée à l'article 40. Les dispositions de l'article 39, paragraphes 3 et 4, s'appliquent aux avances.

Verweisungen / References / Références

Article 162

Extension progressive du champ d'activité de l'Office européen des brevets

Art. 35, 135
R. 69, 70

(1)¹¹³ Les demandes de brevet européen peuvent être présentées à l'Office européen des brevets à compter de la date fixée par le Conseil d'administration sur proposition du Président de l'Office.

(2) Le Conseil d'administration peut, sur proposition du Président de l'Office européen des brevets, décider qu'à partir de la date visée au paragraphe 1, l'instruction des demandes de brevet européen pourra être limitée. Cette limitation peut n'affecter que certains secteurs de la technique. Toutefois, les demandes de brevet européen doivent, en tout état de cause, faire l'objet d'un examen afin de déterminer si une date de dépôt peut leur être accordée.

(3) Si une décision a été prise en vertu du paragraphe 2, le Conseil d'administration ne peut ultérieurement limiter davantage l'instruction des demandes de brevet européen.

(4) Si l'instruction d'une demande de brevet européen ne peut être poursuivie en raison des limitations apportées à la procédure en vertu du paragraphe 2, l'Office européen des brevets le notifie au demandeur et lui indique qu'il peut présenter une requête en transformation. Dès réception de cette notification, la demande de brevet européen est réputée retirée.

Article 163

Mandataires agréés pendant une période transitoire

Art. 35
R. 101, 102

(1) Durant une période transitoire, dont le terme¹¹⁴ est fixé par le Conseil d'administration, et par dérogation à l'article 134, paragraphe 2, peut être inscrite sur la liste des mandataires agréés toute personne physique qui

a) possède la nationalité de l'un des Etats contractants ;

¹¹³ 1^{er} juin 1978.

¹¹⁴ La période transitoire a pris fin le 7 octobre 1981 (JO OEB 1978, 327).

b) sie muss ihren Geschäftssitz oder Arbeitsplatz im Hoheitsgebiet eines Vertragsstaats haben;

c) sie muss befugt sein, natürliche oder juristische Personen auf dem Gebiet des Patentwesens vor der Zentralbehörde für den gewerblichen Rechtsschutz des Vertragsstaats zu vertreten, in dem sie ihren Geschäftssitz oder Arbeitsplatz hat.

(2) Die Eintragung erfolgt auf Antrag, dem eine Bescheinigung der Zentralbehörde für den gewerblichen Rechtsschutz beizufügen ist, aus der sich die Erfüllung der in Absatz 1 genannten Voraussetzungen ergibt.

(3) Unterliegt in einem Vertragsstaat die in Absatz 1 Buchstabe c genannte Befugnis nicht dem Erfordernis einer besonderen beruflichen Befähigung, so muss der Antragsteller die Vertretung auf dem Gebiet des Patentwesens vor der Zentralbehörde für den gewerblichen Rechtsschutz dieses Staats mindestens fünf Jahre lang regelmäßig ausgeübt haben. Die Voraussetzung der Berufsausübung ist jedoch nicht erforderlich für Personen, deren berufliche Befähigung, natürliche oder juristische Personen auf dem Gebiet des Patentwesens vor der Zentralbehörde für den gewerblichen Rechtsschutz eines Vertragsstaats zu vertreten, nach den Vorschriften dieses Staats amtlich festgestellt worden ist. Aus der Bescheinigung der Zentralbehörde für den gewerblichen Rechtsschutz muss sich ergeben, dass der Antragsteller eine der in diesem Absatz genannten Voraussetzungen erfüllt.

(4) Der Präsident des Europäischen Patentamts kann Befreiung erteilen:

a) vom Erfordernis nach Absatz 3 Satz 1, wenn der Antragsteller nachweist, dass er die erforderliche Befähigung auf andere Weise erworben hat;

b) in besonders gelagerten Fällen vom Erfordernis nach Absatz 1 Buchstabe a.

(5) Der Präsident des Europäischen Patentamts hat von dem Erfordernis des Absatzes 1 Buchstabe a Befreiung zu erteilen, wenn der Antragsteller am 5. Oktober 1973 die Voraussetzungen des Absatzes 1 Buchstaben b und c erfüllt hat.

(6) Personen, die ihren Geschäftssitz oder Arbeitsplatz in einem Staat haben, der diesem Übereinkommen weniger als ein Jahr vor Ablauf der Übergangszeit nach Absatz 1 oder nach Ablauf der Übergangszeit beitrifft, können während eines Zeitraums von einem Jahr, gerechnet vom Zeitpunkt des Wirksamwerdens des Beitritts des genannten Staates an, unter den Voraussetzungen der Absätze 1 bis 5 in die Liste der zugelassenen Vertreter eingetragen werden.

(7) Nach Ablauf der Übergangszeit bleiben unbeschadet der in Anwendung von Artikel 134 Absatz 8 Buchstabe c getroffenen Disziplinarmaßnahmen Personen, die während der Übergangszeit in die Liste der zugelassenen Vertreter eingetragen worden sind, in der Liste eingetragen oder werden auf Antrag in die Liste wieder eingetragen, sofern sie die Voraussetzungen des Absatzes 1 Buchstabe b erfüllen.

(b) he must have his place of business or employment within the territory of one of the Contracting States;

(c) he must be entitled to represent natural or legal persons in patent matters before the central industrial property office of the Contracting State in which he has his place of business or employment.

(2) Entry shall be effected upon request, accompanied by a certificate, furnished by the central industrial property office, which must indicate that the conditions laid down in paragraph 1 are fulfilled.

(3) When, in any Contracting State, the entitlement referred to in paragraph 1(c) is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list who act in patent matters before the central industrial property office of the said State must have habitually so acted for at least five years. However, persons whose professional qualification to represent natural or legal persons in patent matters before the central industrial property office of one of the Contracting States is officially recognised in accordance with the regulations laid down by such State shall not be subject to the condition of having exercised the profession. The certificate furnished by the central industrial property office must indicate that the applicant satisfies one of the conditions referred to in the present paragraph.

(4) The President of the European Patent Office may grant exemption from:

(a) the requirement of paragraph 3, first sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way;

(b) the requirement of paragraph 1(a) in special circumstances.

(5) The President of the European Patent Office shall grant exemption from the requirement of paragraph 1(a) if on 5 October 1973 the applicant fulfilled the requirements of paragraph 1(b) and (c).

(6) Persons having their places of business or employment in a State which acceded to this Convention less than one year before the expiry of the transitional period referred to in paragraph 1 or after the expiry of the transitional period may, under the conditions laid down in paragraphs 1 to 5, during a period of one year calculated from the date of entry into force of the accession of that State, be entered on the list of professional representatives.

(7) After the expiry of the transitional period, any person whose name was entered on the list of professional representatives during that period shall, without prejudice to any disciplinary measures taken under Article 134, paragraph 8(c), remain thereon or, on request, be restored thereto, provided that he then fulfils the requirement of paragraph 1(b).

b) a son domicile professionnel ou le lieu de son emploi sur le territoire de l'un des Etats contractants ;

c) est habilitée à représenter en matière de brevets d'invention des personnes physiques ou morales devant le service central de la propriété industrielle de l'Etat contractant sur le territoire duquel cette personne exerce ou est employée.

(2) L'inscription est faite sur requête accompagnée d'une attestation fournie par le service central de la propriété industrielle indiquant que les conditions visées au paragraphe 1 sont remplies.

(3) Lorsque, dans un Etat contractant, l'habilitation visée au paragraphe 1, lettre c) n'est pas subordonnée à l'exigence d'une qualification professionnelle spéciale, les personnes demandant leur inscription sur la liste qui agissent en matière de brevets d'invention devant le service central de la propriété industrielle dudit Etat doivent avoir exercé à titre habituel pendant cinq ans au moins. Toutefois, sont dispensées de la condition d'exercice de la profession les personnes dont la qualification professionnelle à assurer, en matière de brevets d'invention, la représentation des personnes physiques ou morales devant le service central de la propriété industrielle d'un des Etats contractants est reconnue officiellement conformément à la réglementation établie par cet Etat. L'attestation fournie par le service central de la propriété industrielle doit indiquer que le requérant satisfait à l'une des conditions prévues au présent paragraphe.

(4) Le Président de l'Office européen des brevets peut accorder une dérogation :

a) à l'exigence visée au paragraphe 3, première phrase, lorsque le requérant fournit la preuve qu'il a acquis la qualification requise d'une autre manière ;

b) dans des cas tenant à une situation particulière, à l'exigence visée au paragraphe 1, lettre a).

(5) Le Président de l'Office européen des brevets est tenu d'accorder une dérogation à l'exigence visée au paragraphe 1, lettre a), lorsque, à la date du 5 octobre 1973, le requérant remplissait les conditions visées au paragraphe 1, lettres b) et c).

(6) Les personnes qui ont leur domicile professionnel ou le lieu de leur emploi sur le territoire d'un Etat qui a adhéré à la présente convention moins d'un an avant la date d'expiration de la période transitoire prévue au paragraphe 1 ou postérieurement à cette date peuvent, dans les conditions prévues aux paragraphes 1 à 5, durant une période d'un an à compter de la date d'effet de l'adhésion dudit Etat, être inscrites sur la liste des mandataires agréés.

(7) Après l'expiration de la période transitoire, et sans préjudice des mesures disciplinaires prises en application de l'article 134, paragraphe 8, lettre c), toute personne qui a été inscrite sur la liste des mandataires agréés pendant ladite période y demeure inscrite ou, sur requête, y est inscrite à nouveau, sous réserve de remplir la condition visée au paragraphe 1, lettre b).

ZWÖLFTER TEIL

SCHLUSSBESTIMMUNGEN

Artikel 164

Ausführungsordnung und Protokolle

(1) Die Ausführungsordnung, das Anerkennungsprotokoll, das Protokoll über Vorrechte und Immunitäten, das Zentralisierungsprotokoll sowie das Protokoll über die Auslegung des Artikels 69 sind Bestandteile des Übereinkommens.

(2)¹¹⁵ Im Fall mangelnder Übereinstimmung zwischen Vorschriften des Übereinkommens und Vorschriften der Ausführungsordnung gehen die Vorschriften des Übereinkommens vor.

Artikel 165

Unterzeichnung - Ratifikation

(1)¹¹⁶ Dieses Übereinkommen liegt für die Staaten, die an der Regierungskonferenz über die Einführung eines europäischen Patenterteilungsverfahrens teilgenommen haben oder die über die Abhaltung dieser Konferenz unterrichtet worden sind und denen die Möglichkeit der Teilnahme geboten worden ist, bis zum 5. April 1974 zur Unterzeichnung auf.

(2) Dieses Übereinkommen bedarf der Ratifikation; die Ratifikationsurkunden werden bei der Regierung der Bundesrepublik Deutschland hinterlegt.

Artikel 166

Beitritt

(1) Dieses Übereinkommen steht zum Beitritt offen:

- den in Artikel 165 Absatz 1 genannten Staaten;
- auf Einladung des Verwaltungsrats jedem anderen europäischen Staat.

(2) Jeder ehemalige Vertragsstaat, der dem Übereinkommen nach Artikel 172 Absatz 4 nicht mehr angehört, kann durch Beitritt erneut Vertragspartei des Übereinkommens werden.

(3) Die Beitrittsurkunden werden bei der Regierung der Bundesrepublik Deutschland hinterlegt.

PART XII

FINAL PROVISIONS

Article 164

Implementing Regulations and Protocols

(1) The Implementing Regulations, the Protocol on Recognition, the Protocol on Privileges and Immunities, the Protocol on Centralisation and the Protocol on the Interpretation of Article 69 shall be integral parts of this Convention.

(2)¹¹⁵ In the case of conflict between the provisions of this Convention and those of the Implementing Regulations, the provisions of this Convention shall prevail.

Article 165

Signature - Ratification

(1)¹¹⁶ This Convention shall be open for signature until 5 April 1974 by the States which took part in the Inter-Governmental Conference for the setting up of a European System for the Grant of Patents or were informed of the holding of that conference and offered the option of taking part therein.

(2) This Convention shall be subject to ratification; instruments of ratification shall be deposited with the Government of the Federal Republic of Germany.

Article 166

Accession

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

- the States referred to in Article 165, paragraph 1;
- 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.

¹¹⁵ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 2/95, G 6/95, G 1/02 (Anhang I).

¹¹⁶ Unterzeichnerstaaten: AT, BE, CH, DE, DK, FR, GB, GR, IE, IT, LI, LU, MC, NL, NO, SE.
Konferenzteilnehmer: Unterzeichnerstaaten plus ES, FI, PT, TR, YU.
Eingeladene Staaten: Konferenzteilnehmer plus CY, IS.

¹¹⁵ See decisions/opinions of the Enlarged Board of Appeal G 2/95, G 6/95, G 1/02 (Annex I).

¹¹⁶ Signatory States: AT, BE, CH, DE, DK, FR, GB, GR, IE, IT, LI, LU, MC, NL, NO, SE.
Conference participants: signatory states plus ES, FI, PT, TR, YU.
Invited states: Conference participants plus CY, IS.

DOUZIÈME PARTIE

Verweisungen / References / Références

DISPOSITIONS FINALES

Article 164

Règlement d'exécution et protocoles

(1) Le règlement d'exécution, le protocole sur la reconnaissance, le protocole sur les privilèges et immunités, le protocole sur la centralisation et le protocole interprétatif de l'article 69 font partie intégrante de la présente convention.

(2)¹¹⁵ En cas de divergence entre le texte de la présente convention et le texte du règlement d'exécution, le premier de ces textes fait foi.

Article 165

Signature – Ratification

Art. 166, 178

(1)¹¹⁶ La présente convention est ouverte jusqu'au 5 avril 1974 à la signature des Etats qui ont participé à la Conférence intergouvernementale pour l'institution d'un système européen de délivrance de brevets ou qui ont été informés de la tenue de cette conférence et auxquels la faculté d'y participer a été offerte.

(2) La présente convention est soumise à ratification ; les instruments de ratification sont déposés auprès du gouvernement de la République fédérale d'Allemagne.

Article 166

Adhésion

Art. 35, 178

(1) La présente convention est ouverte à l'adhésion :

- a) des Etats visés à l'article 165, paragraphe 1 ;
- b) de tout autre Etat européen, sur l'invitation du Conseil d'administration.

(2) Tout Etat qui a été partie à la présente convention et qui a cessé de l'être en application de l'article 172, paragraphe 4, peut à nouveau devenir partie à la convention en y adhérant.

(3) Les instruments d'adhésion sont déposés auprès du gouvernement de la République fédérale d'Allemagne.

¹¹⁵ Cf. les décisions/avis de la Grande Chambre de recours G 2/95, G 6/95, G 1/02 (Annexe I).

¹¹⁶ Etats signataires : AT, BE, CH, DE, DK, FR, GB, GR, IE, IT, IL, LU, MC, NL, NO, SE.
Participants à la Conférence : Etats signataires plus ES, FI, PT, TR, YU.
Etats invités : Participants à la Conférence plus CY, IS.

Vorbehalte

(1) Jeder Vertragsstaat kann bei der Unterzeichnung oder bei der Hinterlegung seiner Ratifikations- oder Beitrittsurkunde nur die in Absatz 2 vorgesehenen Vorbehalte machen.

(2) Jeder Vertragsstaat kann sich vorbehalten zu bestimmen:

a)¹¹⁹ dass europäische Patente übereinstimmend mit den für nationale Patente geltenden Vorschriften unwirksam sind oder für nichtig erklärt werden können, soweit sie Schutz für chemische Erzeugnisse als solche oder für Nahrungs- oder Arzneimittel als solche gewähren; ein solcher Vorbehalt berührt nicht den Schutz aus dem Patent, soweit es ein Verfahren zur Herstellung oder Verwendung eines chemischen Erzeugnisses oder ein Verfahren zur Herstellung eines Nahrungs- oder Arzneimittels betrifft;

b) dass europäische Patente übereinstimmend mit den für nationale Patente geltenden Vorschriften unwirksam sind oder für nichtig erklärt werden können, soweit sie Schutz für landwirtschaftliche oder gartenbauliche Verfahren gewähren, auf die nicht bereits Artikel 53 Buchstabe b anzuwenden ist;

c) dass europäische Patente übereinstimmend mit den für nationale Patente geltenden Vorschriften eine kürzere Laufzeit als zwanzig Jahre haben;

d) dass das Anerkennungsprotokoll für ihn nicht verbindlich sein soll.

(3)¹²⁰ Alle von einem Vertragsstaat gemachten Vorbehalte sind für einen Zeitraum von höchstens zehn Jahren vom Inkrafttreten dieses Übereinkommens an wirksam. Hat ein Vertragsstaat Vorbehalte nach Absatz 2 Buchstabe a oder b gemacht, so kann der Verwaltungsrat mit Wirkung für diesen Staat die Frist für alle oder einen Teil der gemachten Vorbehalte um höchstens fünf Jahre verlängern, wenn dieser Staat spätestens ein Jahr vor Ablauf des Zeitraums von zehn Jahren einen begründeten Antrag stellt, der es dem Verwaltungsrat erlaubt, zu entscheiden, dass dieser Vertragsstaat am Ende des Zeitraums von zehn Jahren nicht in der Lage ist, den Vorbehalt zurückzunehmen.

¹¹⁷ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 3/92, G 7/93 (Anhang I).

¹¹⁸ Österreich hat Vorbehalte gemäß Artikel 167 Absatz 2 Buchstaben a und d erklärt (ABI. EPA 1979, 289); diese Vorbehalte wurden mit Ablauf des 7. Oktober 1987 unwirksam. Griechenland und Spanien haben Vorbehalte gemäß Artikel 167 Absatz 2 Buchstabe a erklärt (ABI. EPA 1986, 200). Diese Vorbehalte wurden mit Ablauf des 7. Oktober 1992 unwirksam (ABI. EPA 1992, 301) (siehe jedoch Art. 167 (5)).

¹¹⁹ Siehe hierzu Rechtsauskunft Nr. 4/80 (Anhang II).

¹²⁰ Der Zeitraum für die von Griechenland und Spanien erklärten Vorbehalte ist vom 7. Oktober 1987 an um fünf Jahre verlängert worden (Beschluss des Verwaltungsrats vom 05.12.1986, in Kraft getreten am 05.12.1986 (ABI. EPA 1987, 91 ff.)).

Reservations

(1) Each Contracting State may, at the time of signature or when depositing its instrument of ratification or accession, make only the reservations specified in paragraph 2.

(2) Each Contracting State may reserve the right to provide that:

(a)¹¹⁹ European patents, in so far as they confer protection on chemical, pharmaceutical or food products, as such, shall, in accordance with the provisions applicable to national patents, be ineffective or revocable; this reservation shall not affect protection conferred by the patent in so far as it involves a process of manufacture or use of a chemical product or a process of manufacture of a pharmaceutical or food product;

(b) European patents, in so far as they confer protection on agricultural or horticultural processes other than those to which Article 53, sub-paragraph (b), applies, shall, in accordance with the provisions applicable to national patents, be ineffective or revocable;

(c) European patents shall have a term shorter than twenty years, in accordance with the provisions applicable to national patents;

(d) it shall not be bound by the Protocol on Recognition.

(3)¹²⁰ Any reservation made by a Contracting State shall have effect for a period of not more than ten years from the entry into force of this Convention. However, where a Contracting State has made any of the reservations referred to in paragraph 2(a) and (b), the Administrative Council may, in respect of such State, extend the period by not more than five years for all or part of any reservation made, if that State submits, at the latest one year before the end of the ten-year period, a reasoned request which satisfies the Administrative Council that the State is not in a position to dispense with that reservation by the expiry of the ten-year period.

¹¹⁷ See decisions of the Enlarged Board of Appeal G 3/92, G 7/93 (Annex I).

¹¹⁸ Austria made the reservations provided for in Article 167, paragraph 2(a) and (d) (OJ EPO 1979, 289); these reservations ceased to have effect after 7 October 1987. Greece and Spain made the reservations provided for in Article 167, paragraph 2(a) (OJ EPO 1986, 200). These reservations ceased to have effect after 7 October 1992 (OJ EPO 1992, 301) (but see Art. 167(5)).

¹¹⁹ See Legal advice No. 4/80 (Annex II).

¹²⁰ The period in respect of which Greece and Spain made reservations was extended by five years from 7 October 1987 (Decision of the Administrative Council of 05.12.1986 which entered into force on 05.12.1986 (OJ EPO 1987, 91 ff.)).

Réserves

Art. 35, 63, 178

(1) Tout Etat contractant ne peut, lors de la signature ou du dépôt de son instrument de ratification ou d'adhésion, faire que les seules réserves prévues au paragraphe 2.

(2) Tout Etat contractant peut se réserver la faculté de prévoir :

a)¹¹⁹ que les brevets européens, dans la mesure où ils confèrent la protection à des produits chimiques, pharmaceutiques ou alimentaires en tant que tels, sont sans effet ou peuvent être annulés conformément aux dispositions en vigueur pour les brevets nationaux ; cette réserve n'affecte pas la protection conférée par le brevet dans la mesure où il concerne soit un procédé de fabrication ou d'utilisation d'un produit chimique, soit un procédé de fabrication d'un produit pharmaceutique ou alimentaire ;

b) que les brevets européens, dans la mesure où ils concernent les procédés agricoles ou horticoles autres que ceux auxquels s'applique l'article 53, lettre b), sont sans effet ou peuvent être annulés conformément aux dispositions en vigueur pour les brevets nationaux ;

c) que les brevets européens ont une durée inférieure à vingt ans, conformément aux dispositions en vigueur pour les brevets nationaux ;

d) qu'il n'est pas lié par le protocole sur la reconnaissance.

(3)¹²⁰ Toute réserve faite par un Etat contractant produit ses effets pendant une période de dix ans au maximum à compter de l'entrée en vigueur de la présente convention. Toutefois, lorsqu'un Etat contractant a fait des réserves visées au paragraphe 2, lettres a) et b), le Conseil d'administration peut, en ce qui concerne ledit Etat, étendre cette période de cinq ans au plus, pour tout ou partie des réserves faites, à condition que cet Etat présente, au plus tard un an avant l'expiration de la période de dix ans, une demande motivée permettant au Conseil d'administration de décider que cet Etat n'est pas en mesure de renoncer à ladite réserve à l'expiration de la période de dix ans.

¹¹⁷ Cf. les décisions de la Grande Chambre de recours G 3/92, G 7/93 (Annexe I).

¹¹⁸ L'Autriche a fait les réserves prévues à l'article 167, paragraphe 2, lettres a) et d) (JO OEB 1979, 289) ; ces réserves n'ont plus d'effet depuis le 7 octobre 1987. La Grèce et l'Espagne ont fait les réserves prévues à l'article 167, paragraphe 2, lettre a) (JO OEB 1986, 200). Ces réserves n'ont plus d'effet depuis le 7 octobre 1992 (JO OEB 1992, 301) (voir toutefois l'art. 167(5)).

¹¹⁹ Cf. le renseignement juridique n° 4/80 (Annexe II).

¹²⁰ La période pour laquelle la Grèce et l'Espagne ont fait des réserves a été prolongée de cinq ans à compter du 7 octobre 1987 (Décision du Conseil d'administration en date du 05.12.1986, entrée en vigueur le 05.12.1986 (JO OEB 1987, 91 s.)).

(4) Jeder Vertragsstaat, der einen Vorbehalt gemacht hat, nimmt ihn zurück, sobald es die Umstände gestatten. Die Zurücknahme des Vorbehalts erfolgt durch eine an die Regierung der Bundesrepublik Deutschland gerichtete Notifikation und wird einen Monat nach dem Tag des Eingangs der Notifikation wirksam.

(5) Ein nach Absatz 2 Buchstabe a, b oder c gemachter Vorbehalt erstreckt sich auf die europäischen Patente, die auf Grund von europäischen Patentanmeldungen erteilt worden sind, die während der Wirksamkeit des Vorbehalts eingereicht worden sind. Der Vorbehalt bleibt während der gesamten Geltungsdauer dieser Patente wirksam.

(6) Jeder Vorbehalt wird mit Ablauf des in Absatz 3 Satz 1 erwähnten Zeitraums und, falls der Zeitraum verlängert worden ist, mit Ablauf des verlängerten Zeitraums unwirksam; Absätze 4 und 5 bleiben unberührt.

Artikel 168

Räumlicher Anwendungsbereich

(1) Jeder Vertragsstaat kann in seiner Ratifikations- oder Beitrittsurkunde oder zu jedem späteren Zeitpunkt durch eine Notifikation an die Regierung der Bundesrepublik Deutschland erklären, dass das Übereinkommen auf alle oder einzelne Hoheitsgebiete anzuwenden ist, für deren auswärtige Beziehungen er verantwortlich ist. Die für den betreffenden Vertragsstaat erteilten europäischen Patente haben auch in den Hoheitsgebieten Wirkung, für die eine solche Erklärung wirksam ist.

(2) Ist die in Absatz 1 genannte Erklärung in der Ratifikations- oder Beitrittsurkunde enthalten, so wird sie gleichzeitig mit der Ratifikation oder dem Beitritt wirksam; wird die Erklärung nach der Hinterlegung der Ratifikations- oder Beitrittsurkunde in einer Notifikation abgegeben, so wird diese Notifikation sechs Monate nach dem Tag ihres Eingangs bei der Regierung der Bundesrepublik Deutschland wirksam.

(3) Jeder Vertragsstaat kann jederzeit erklären, dass das Übereinkommen für alle oder einzelne Hoheitsgebiete, für die er nach Absatz 1 eine Notifikation vorgenommen hat, nicht mehr anzuwenden ist. Diese Erklärung wird ein Jahr nach dem Tag wirksam, an dem sie der Regierung der Bundesrepublik Deutschland notifiziert worden ist.

(4) Any Contracting State that has made a reservation shall withdraw this reservation as soon as circumstances permit. Such withdrawal shall be made by notification addressed to the Government of the Federal Republic of Germany and shall take effect one month from the date of receipt of such notification.

(5) Any reservation made in accordance with paragraph 2(a), (b) or (c) shall apply to European patents granted on European patent applications filed during the period in which the reservation has effect. The effect of the reservation shall continue for the term of the patent.

(6) Without prejudice to paragraphs 4 and 5, any reservation shall cease to have effect on expiry of the period referred to in paragraph 3, first sentence, or, if the period is extended, on expiry of the extended period.

Article 168

Territorial field of application

(1) Any Contracting State may declare in its instrument of ratification or accession, or may inform the Government of the Federal Republic of Germany by written notification any time thereafter, that this Convention shall be applicable to one or more of the territories for the external relations of which it is responsible. European patents granted for that Contracting State shall also have effect in the territories for which such a declaration has taken effect.

(2) If the declaration referred to in paragraph 1 is contained in the instrument of ratification or accession, it shall take effect on the same date as the ratification or accession; if the declaration is made in a notification after the deposit of the instrument of ratification or accession, such notification shall take effect six months after the date of its receipt by the Government of the Federal Republic of Germany.

(3) Any Contracting State may at any time declare that the Convention shall cease to apply to some or to all of the territories in respect of which it has given a notification pursuant to paragraph 1. Such declaration shall take effect one year after the date on which the Government of the Federal Republic of Germany received notification thereof.

(4) Tout Etat contractant qui a fait une réserve la retire aussitôt que les circonstances le permettent. Le retrait de la réserve est effectué par une notification adressée au gouvernement de la République fédérale d'Allemagne ; ce retrait prend effet un mois après la date de la réception par ce gouvernement de ladite notification.

(5) Toute réserve faite en vertu du paragraphe 2, lettres a), b) ou c), s'étend aux brevets européens délivrés sur la base de demandes de brevet européen déposées pendant la période au cours de laquelle la réserve produit ses effets. Les effets de cette réserve subsistent pendant toute la durée de ces brevets.

(6) Sans préjudice des dispositions des paragraphes 4 et 5, toute réserve cesse de produire ses effets à l'expiration de la période visée au paragraphe 3, première phrase, ou, si cette période a été étendue, au terme de la période d'extension.

Article 168

Champ d'application territorial

(1) Tout Etat contractant peut déclarer, dans son instrument de ratification ou d'adhésion, ou à tout moment ultérieur, dans une notification adressée au gouvernement de la République fédérale d'Allemagne, que la convention est applicable à un ou plusieurs territoires pour lesquels il assume la responsabilité des relations extérieures. Les brevets européens délivrés pour cet Etat ont également effet sur les territoires pour lesquels cette déclaration a pris effet.

(2) Si la déclaration visée au paragraphe 1 est incluse dans l'instrument de ratification ou d'adhésion, elle prend effet à la même date que la ratification ou l'adhésion ; si la déclaration est faite dans une notification postérieure au dépôt de l'instrument de ratification ou d'adhésion, cette notification prend effet six mois après la date de sa réception par le gouvernement de la République fédérale d'Allemagne.

(3) Tout Etat contractant peut à tout moment déclarer que la convention cesse d'être applicable à certains ou à l'ensemble des territoires pour lesquels il a fait une déclaration en vertu du paragraphe 1. Cette déclaration prend effet à l'expiration d'un délai d'une année à compter du jour où le gouvernement de la République fédérale d'Allemagne en a reçu notification.

Art. 178

Artikel 169

Inkrafttreten¹²¹

(1) Dieses Übereinkommen tritt in Kraft drei Monate nach Hinterlegung der letzten Ratifikations- oder Beitrittsurkunde von sechs Staaten, in deren Hoheitsgebiet im Jahre 1970 insgesamt mindestens 180 000 Patentanmeldungen für die Gesamtheit dieser Staaten eingereicht wurden.

(2) Jede Ratifikation oder jeder Beitritt nach Inkrafttreten dieses Übereinkommens wird am ersten Tag des dritten Monats nach der Hinterlegung der Ratifikations- oder Beitrittsurkunde wirksam.

Artikel 170

Aufnahmebeitrag

(1) Jeder Staat, der nach Inkrafttreten dieses Übereinkommens das Übereinkommen ratifiziert oder ihm beiträgt, hat der Organisation einen Aufnahmebeitrag zu zahlen, der nicht zurückgezahlt wird.

(2) Der Aufnahmebeitrag beträgt 5 % des Betrags, der sich ergibt, wenn der für den betreffenden Staat nach dem in Artikel 40 Absätze 3 und 4 vorgesehenen Aufbringungsschlüssel ermittelte Prozentsatz, der zu dem Zeitpunkt gilt, zu dem die Ratifikation oder der Beitritt wirksam wird, auf die Summe der von den übrigen Vertragsstaaten bis zum Abschluss des diesem Zeitpunkt vorangehenden Haushaltsjahrs geschuldeten besonderen Finanzbeiträge angewendet wird.

(3) Werden besondere Finanzbeiträge für das Haushaltsjahr, das dem in Absatz 2 genannten Zeitpunkt vorausgeht, nicht mehr gefordert, so ist der in Absatz 2 genannte Aufbringungsschlüssel derjenige, der auf den betreffenden Staat auf der Grundlage des letzten Jahrs, für das besondere Finanzbeiträge zu zahlen waren, anzuwenden gewesen wäre.

Artikel 171

Geltungsdauer des Übereinkommens

Dieses Übereinkommen wird auf unbegrenzte Zeit geschlossen.

Article 169

Entry into force¹²¹

(1) This Convention shall enter into force three months after the deposit of the last instrument of ratification or accession by six States on whose territory the total number of patent applications filed in 1970 amounted to at least 180 000 for all the said States.

(2) Any ratification or accession after the entry into force of this Convention shall take effect on the first day of the third month after the deposit of the instrument of ratification or accession.

Article 170

Initial contribution

(1) Any State which ratifies or accedes to this Convention after its entry into force shall pay to the Organisation an initial contribution, which shall not be refunded.

(2) The initial contribution shall be 5% of an amount calculated by applying the percentage obtained for the State in question, on the date on which ratification or accession takes effect, in accordance with the scale provided for in Article 40, paragraphs 3 and 4, to the sum of the special financial contributions due from the other Contracting States in respect of the accounting periods preceding the date referred to above.

(3) In the event that special financial contributions were not required in respect of the accounting period immediately preceding the date referred to in paragraph 2, the scale of contributions referred to in that paragraph shall be the scale that would have been applicable to the State concerned in respect of the last year for which financial contributions were required.

Article 171

Duration of the Convention

The present Convention shall be of unlimited duration.

¹²¹ Für Belgien, Deutschland, Frankreich, Luxemburg, Niederlande, Schweiz und Vereinigtes Königreich: 7. Oktober 1977; Schweden: 1. Mai 1978; Italien: 1. Dezember 1978; Österreich: 1. Mai 1979; Liechtenstein: 1. April 1980; Griechenland und Spanien: 1. Oktober 1986; Dänemark: 1. Januar 1990; Monaco: 1. Dezember 1991; Portugal: 1. Januar 1992; Irland: 1. August 1992; Finnland: 1. März 1996; Zypern: 1. April 1998; Türkei: 1. November 2000; Bulgarien, Estland, Slowakei, Tschechische Republik: 1. Juli 2002; Slowenien: 1. Dezember 2002; Ungarn: 1. Januar 2003; Rumänien: 1. März 2003; Polen: 1. März 2004; Island: 1. November 2004; Litauen: 1. Dezember 2004; Lettland: 1. Juli 2005.

¹²¹ For Belgium, Germany, France, Luxembourg, Netherlands, Switzerland and United Kingdom: 7 October 1977; Sweden: 1 May 1978; Italy: 1 December 1978; Austria: 1 May 1979; Liechtenstein: 1 April 1980; Greece and Spain: 1 October 1986; Denmark: 1 January 1990; Monaco: 1 December 1991; Portugal: 1 January 1992; Ireland: 1 August 1992; Finland: 1 March 1996; Cyprus: 1 April 1998; Turkey: 1 November 2000; Bulgaria, Czech Republic, Estonia, Slovakia: 1 July 2002; Slovenia: 1 December 2002; Hungary: 1 January 2003; Romania: 1 March 2003; Poland: 1 March 2004; Iceland: 1 November 2004; Lithuania: 1 December 2004; Latvia: 1 July 2005.

Article 169

Entrée en vigueur¹²¹

(1) La présente convention entre en vigueur trois mois après le dépôt du dernier des instruments de ratification ou d'adhésion de six Etats sur le territoire desquels le nombre total de demandes de brevet déposées en 1970 s'est élevé à 180 000 au moins pour l'ensemble desdits Etats.

(2) Toute ratification ou adhésion postérieure à l'entrée en vigueur de la présente convention prend effet le premier jour du troisième mois suivant le dépôt de l'instrument de ratification ou d'adhésion.

Article 170

Cotisation initiale

(1) Tout Etat qui ratifie la présente convention ou y adhère après son entrée en vigueur verse à l'Organisation une cotisation initiale qui ne sera pas remboursée.

(2) La cotisation initiale est égale à 5 % du montant qui résulte, pour un tel Etat, de l'application, au montant total des sommes dues par les autres Etats contractants au titre des exercices budgétaires antérieurs, de la clé de répartition des contributions financières exceptionnelles, prévue à l'article 40, paragraphes 3 et 4, telle qu'elle est en vigueur à la date à laquelle la ratification ou l'adhésion dudit Etat prend effet.

(3) Dans le cas où des contributions financières exceptionnelles n'ont pas été exigées pour l'exercice budgétaire qui précède celui où se situe la date visée au paragraphe 2, la clé de répartition à laquelle ledit paragraphe fait référence est celle qui aurait été applicable à l'Etat en cause pour le dernier exercice budgétaire au titre duquel des contributions financières exceptionnelles ont été appelées.

Article 171

Durée de la convention

La présente convention est conclue sans limitation de durée.

¹²¹ Pour la Belgique, la France, le Luxembourg, les Pays-Bas, l'Allemagne, le Royaume-Uni et la Suisse : le 7 octobre 1977 ; pour la Suède : le 1^{er} mai 1978 ; pour l'Italie : le 1^{er} décembre 1978 ; pour l'Autriche : le 1^{er} mai 1979 ; pour le Liechtenstein : le 1^{er} avril 1980 ; pour la Grèce et l'Espagne : le 1^{er} octobre 1986 ; pour le Danemark : le 1^{er} janvier 1990 ; pour Monaco : le 1^{er} décembre 1991 ; pour le Portugal : le 1^{er} janvier 1992 ; pour l'Irlande : le 1^{er} août 1992 ; pour la Finlande : le 1^{er} mars 1996 ; pour la Chypre : le 1^{er} avril 1998 ; pour la Turquie : le 1^{er} novembre 2000 ; pour la Bulgarie, l'Estonie, la Slovaquie, la République tchèque : le 1^{er} juillet 2002 ; pour la Slovénie : 1^{er} décembre 2002 ; pour la Hongrie : 1^{er} janvier 2003 ; pour la Roumanie : 1^{er} mars 2003 ; pour la Pologne : 1^{er} mars 2004 ; pour l'Islande : 1^{er} novembre 2004 ; pour la Lituanie : 1^{er} décembre 2004 ; pour la Lettonie : 1^{er} juillet 2005.

*Artikel 172*¹²²

Revision

- (1) Dieses Übereinkommen kann durch Konferenzen der Vertragsstaaten revidiert werden.
- (2) Die Konferenz wird vom Verwaltungsrat vorbereitet und einberufen. Sie ist nur beschlussfähig, wenn mindestens drei Viertel der Vertragsstaaten auf ihr vertreten sind. Die revidierte Fassung des Übereinkommens bedarf zu ihrer Annahme der Dreiviertelmehrheit der auf der Konferenz vertretenen Vertragsstaaten, die eine Stimme abgeben. Stimmenthaltung gilt nicht als Stimmabgabe.
- (3) Die revidierte Fassung des Übereinkommens tritt nach Hinterlegung der Ratifikations- oder Beitrittsurkunden durch die von der Konferenz festgesetzte Anzahl von Vertragsstaaten und zu dem von der Konferenz bestimmten Zeitpunkt in Kraft.
- (4) Die Staaten, die die revidierte Fassung des Übereinkommens im Zeitpunkt ihres Inkrafttretens weder ratifiziert haben noch ihr beigetreten sind, gehören von diesem Zeitpunkt dem Übereinkommen nicht mehr an.

Artikel 173

Streitigkeiten zwischen Vertragsstaaten

- (1) Jede Streitigkeit zwischen Vertragsstaaten über die Auslegung oder Anwendung dieses Übereinkommens, die nicht im Verhandlungsweg beigelegt worden ist, wird auf Ersuchen eines beteiligten Staats dem Verwaltungsrat unterbreitet, der sich bemüht, eine Einigung zwischen diesen Staaten herbeizuführen.
- (2) Wird eine solche Einigung nicht innerhalb von sechs Monaten nach dem Tag erzielt, an dem der Verwaltungsrat mit der Streitigkeit befasst worden ist, so kann jeder beteiligte Staat die Streitigkeit dem Internationalen Gerichtshof zum Erlass einer bindenden Entscheidung unterbreiten.

Artikel 174

Kündigung

Jeder Vertragsstaat kann dieses Übereinkommen jederzeit kündigen. Die Kündigung wird der Regierung der Bundesrepublik Deutschland notifiziert. Sie wird ein Jahr nach dem Tag dieser Notifikation wirksam.

Artikel 175

Aufrechterhaltung wohl erworbener Rechte

- (1) Hört ein Staat nach Artikel 172 Absatz 4 oder Artikel 174 auf, Vertragspartei dieses Übereinkommens zu sein, so berührt dies nicht die nach diesem Übereinkommen bereits erworbenen Rechte.

*Article 172*¹²²

Revision

- (1) This Convention may be revised by a Conference of the Contracting States.
- (2) The Conference shall be prepared and convened by the Administrative Council. The Conference shall not be deemed to be validly constituted unless at least three-quarters of the Contracting States are represented at it. In order to adopt the revised text there must be a majority of three-quarters of the Contracting States represented and voting at the Conference. Abstentions shall not be considered as votes.
- (3) The revised text shall enter into force when it has been ratified or acceded to by the number of Contracting States specified by the Conference, and at the time specified by that Conference.
- (4) Such States as have not ratified or acceded to the revised text of the Convention at the time of its entry into force shall cease to be parties to this Convention as from that time.

Article 173

Disputes between Contracting States

- (1) Any dispute between Contracting States concerning the interpretation or application of the present Convention which is not settled by negotiation shall be submitted, at the request of one of the States concerned, to the Administrative Council, which shall endeavour to bring about agreement between the States concerned.
- (2) If such agreement is not reached within six months from the date when the Administrative Council was seized of the dispute, any one of the States concerned may submit the dispute to the International Court of Justice for a binding decision.

Article 174

Denunciation

Any Contracting State may at any time denounce this Convention. Notification of denunciation shall be given to the Government of the Federal Republic of Germany. Denunciation shall take effect one year after the date of receipt of such notification.

Article 175

Preservation of acquired rights

- (1) In the event of a State ceasing to be party to this Convention in accordance with Article 172, paragraph 4, or Article 174, rights already acquired pursuant to this Convention shall not be impaired.

¹²² Siehe hierzu Entscheidung der Großen Beschwerdekammer G 2/02 und G 3/02 (Anhang I).

¹²² See decision of the Enlarged Board of Appeal G 2/02 and G 3/02 (Annex I).

Révision

Art. 35, 166, 175, 176

- (1) La présente convention peut être révisée par une conférence des Etats contractants.
- (2) La conférence est préparée et convoquée par le Conseil d'administration. Elle ne délibère valablement que si les trois quarts au moins des Etats parties à la convention y sont représentés. Pour être adopté, le texte révisé de la convention doit être approuvé par les trois quarts des Etats parties représentés à la conférence et votants. L'abstention n'est pas considérée comme un vote.
- (3) Le texte révisé de la convention entre en vigueur après le dépôt des instruments de ratification ou d'adhésion d'un nombre d'Etats déterminé par la conférence et à la date qu'elle a fixée.
- (4) Les Etats qui, à la date d'entrée en vigueur de la convention révisée, ne l'ont pas ratifiée ou n'y ont pas adhéré, cessent d'être parties à la présente convention à compter de ladite date.

Article 173

Différends entre Etats contractants

- (1) Tout différend entre Etats contractants qui concerne l'interprétation ou l'application de la présente convention et n'a pas été réglé par voie de négociation est, sur demande de l'un des Etats intéressés, soumis au Conseil d'administration qui s'emploie à provoquer un accord entre lesdits Etats.
- (2) Si un tel accord n'est pas réalisé dans un délai de six mois à compter de la date à laquelle le Conseil d'administration a été saisi du différend, l'un quelconque des Etats en cause peut porter le différend devant la Cour internationale de Justice en vue d'une décision liant les parties en cause.

Article 174

Dénonciation

Art. 175, 176, 178

Tout Etat contractant peut à tout moment dénoncer la présente convention. La dénonciation est notifiée au gouvernement de la République fédérale d'Allemagne. Elle prend effet à l'expiration du délai d'une année à compter de la date de réception de cette notification.

Article 175

Réserve des droits acquis

- (1) Lorsqu'un Etat cesse d'être partie à la convention en vertu de l'article 172, paragraphe 4, ou de l'article 174, il n'est pas porté atteinte aux droits acquis antérieurement en vertu de la présente convention.

¹²² Cf. la décision de la Grande Chambre de recours G 2/02 et G 3/02 (Annexe I).

(2) Die europäischen Patentanmeldungen, die zu dem Zeitpunkt anhängig sind, zu dem ein benannter Staat aufhört, Vertragspartei dieses Übereinkommens zu sein, werden in Bezug auf diesen Staat vom Europäischen Patentamt so weiterbehandelt, als ob das Übereinkommen in der nach diesem Zeitpunkt geltenden Fassung auf diesen Staat anzuwenden wäre.

(3) Absatz 2 ist auf europäische Patente anzuwenden, für die zu dem in Absatz 2 genannten Zeitpunkt ein Einspruchsverfahren anhängig oder die Einspruchsfrist noch nicht abgelaufen ist.

(4) Das Recht eines ehemaligen Vertragsstaats, ein europäisches Patent nach der Fassung des Übereinkommens zu behandeln, die auf ihn anzuwenden war, wird durch diesen Artikel nicht berührt.

Artikel 176

Finanzielle Rechte und Pflichten eines ausgeschiedenen Vertragsstaats

(1) Jeder Staat, der nach Artikel 172 Absatz 4 oder Artikel 174 nicht mehr dem Übereinkommen angehört, erhält die von ihm nach Artikel 40 Absatz 2 geleisteten besonderen Finanzbeiträge von der Organisation erst zu dem Zeitpunkt und den Bedingungen zurück, zu denen die Organisation besondere Finanzbeiträge, die im gleichen Haushaltsjahr von anderen Staaten gezahlt worden sind, zurückzahlt.

(2) Der in Absatz 1 bezeichnete Staat hat den in Artikel 39 genannten Anteil an den Jahresgebühren für die in diesem Staat aufrechterhaltenen europäischen Patente auch in der Höhe weiterzuzahlen, die zu dem Zeitpunkt maßgebend war, zu dem er aufgehört hat, Vertragspartei zu sein.

Artikel 177

Sprachen des Übereinkommens

(1) Dieses Übereinkommen ist in einer Urschrift in deutscher, englischer und französischer Sprache abgefasst, wobei jeder Wortlaut gleichermaßen verbindlich ist, und wird im Archiv der Regierung der Bundesrepublik Deutschland hinterlegt.

(2) Fassungen des Übereinkommens in anderen als den in Absatz 1 genannten Amtssprachen von Vertragsstaaten, die der Verwaltungsrat genehmigt hat, gelten als amtliche Fassungen. Bei Meinungsverschiedenheiten über die Auslegung der verschiedenen Fassungen sind die in Absatz 1 genannten Fassungen maßgebend.

(2) A European patent application which is pending when a designated State ceases to be party to the Convention shall be processed by the European Patent Office, in so far as that State is concerned, as if the Convention in force thereafter were applicable to that State.

(3) The provisions of paragraph 2 shall apply to European patents in respect of which, on the date mentioned in that paragraph, an opposition is pending or the opposition period has not expired.

(4) Nothing in this Article shall affect the right of any State that has ceased to be a party to this Convention to treat any European patent in accordance with the text to which it was a party.

Article 176

Financial rights and obligations of a former Contracting State

(1) Any State which has ceased to be a party to this Convention in accordance with Article 172, paragraph 4, or Article 174, shall have the special financial contributions which it has paid pursuant to Article 40, paragraph 2, refunded to it by the Organisation only at the time and under the conditions whereby the Organisation refunds special financial contributions paid by other States during the same accounting period.

(2) The State referred to in paragraph 1 shall, even after ceasing to be a party to this Convention, continue to pay the proportion pursuant to Article 39 of renewal fees in respect of European patents remaining in force in that State, at the rate current on the date on which it ceased to be a party.

Article 177

Languages of the Convention

(1) This Convention, drawn up in a single original, in the English, French and German languages, shall be deposited in the archives of the Government of the Federal Republic of Germany, the three texts being equally authentic.

(2) The texts of this Convention drawn up in official languages of Contracting States other than those referred to in paragraph 1 shall, if they have been approved by the Administrative Council, be considered as official texts. In the event of conflict on the interpretation of the various texts, the texts referred to in paragraph 1 shall be authentic.

(2) Les demandes de brevet européen en instance à la date à laquelle un Etat désigné cesse d'être partie à la convention continuent à être instruites par l'Office européen des brevets, en ce qui concerne ledit Etat, comme si la convention, telle qu'elle est en vigueur après cette date, lui était applicable.

(3) Les dispositions du paragraphe 2 sont applicables aux brevets européens à l'égard desquels, à la date mentionnée audit paragraphe, une opposition est en instance ou le délai d'opposition n'est pas expiré.

(4) Le présent article ne porte pas atteinte au droit d'un Etat qui a cessé d'être partie à la présente convention d'appliquer aux brevets européens les dispositions du texte de la convention à laquelle il était partie.

Article 176

Droits et obligations en matière financière d'un Etat contractant ayant cessé d'être partie à la Convention

(1) Tout Etat qui a cessé d'être partie à la présente convention en application de l'article 172, paragraphe 4 ou de l'article 174 n'est remboursé par l'Organisation des contributions financières exceptionnelles qu'il a versées au titre de l'article 40, paragraphe 2, qu'à la date et dans les conditions où l'Organisation rembourse les contributions financières exceptionnelles qui lui ont été versées par d'autres Etats au cours du même exercice budgétaire.

(2) Les sommes dont le montant correspond au pourcentage des taxes perçues pour le maintien en vigueur des brevets européens dans l'Etat visé au paragraphe 1, telles qu'elles sont définies à l'article 39, sont dues par cet Etat, alors même qu'il a cessé d'être partie à la présente convention ; le montant de ces sommes est celui qui devait être versé par l'Etat en cause à la date à laquelle il a cessé d'être partie à la présente convention.

Article 177

Langues de la convention

(1) La présente convention est rédigée en un exemplaire en langues allemande, anglaise et française, qui est déposé aux archives du gouvernement de la République fédérale d'Allemagne, les trois textes faisant également foi.

(2) Les textes de la présente convention établis dans des langues officielles des Etats contractants autres que celles visées au paragraphe 1 et agréés par le Conseil d'administration sont considérés comme textes officiels. En cas de contestation sur l'interprétation des divers textes, les textes visés au paragraphe 1 font foi.

Artikel 178

Übermittlungen und Notifikationen

(1) Die Regierung der Bundesrepublik Deutschland stellt beglaubigte Abschriften des Übereinkommens her und übermittelt sie den Regierungen aller anderen Staaten, die das Übereinkommen unterzeichnet haben oder ihm beigetreten sind.

(2) Die Regierung der Bundesrepublik Deutschland notifiziert den in Absatz 1 genannten Regierungen:

- a) jede Unterzeichnung;
- b) die Hinterlegung jeder Ratifikations- oder Beitrittsurkunde;
- c) Vorbehalte und Zurücknahmen von Vorbehalten nach Artikel 167;
- d) Erklärungen und Notifikationen nach Artikel 168;
- e) den Zeitpunkt des Inkrafttretens dieses Übereinkommens;
- f) Kündigungen nach Artikel 174 und jeden Zeitpunkt des Inkrafttretens dieser Kündigungen.

(3) Die Regierung der Bundesrepublik Deutschland lässt dieses Übereinkommen beim Sekretariat der Vereinten Nationen registrieren.

ZU URKUND DESSEN haben die hierzu ernannten Bevollmächtigten nach Vorlage ihrer in guter und gehöriger Form befundenen Vollmachten dieses Übereinkommen unterschrieben.

Geschehen zu München am fünften Oktober neunzehnhundertdreundsiebzig

Article 178

Transmission and notifications

(1) The Government of the Federal Republic of Germany shall draw up certified true copies of this Convention and shall transmit them to the Governments of all signatory or acceding States.

(2) The Government of the Federal Republic of Germany shall notify to the Governments of the States referred to in paragraph 1:

- (a) any signature;
- (b) the deposit of any instrument of ratification or accession;
- (c) any reservation or withdrawal of reservation pursuant to the provisions of Article 167;
- (d) any declaration or notification received pursuant to the provisions of Article 168;
- (e) the date of entry into force of this Convention;
- (f) any denunciation received pursuant to the provisions of Article 174 and the date on which such denunciation comes into force.

(3) The Government of the Federal Republic of Germany shall register this Convention with the Secretariat of the United Nations.

IN WITNESS WHEREOF, the Plenipotentiaries authorised thereto, having presented their Full Powers, found to be in good and due form, have signed this Convention.

Done at Munich this fifth day of October one thousand nine hundred and seventy-three

Transmissions et notifications

Art. 165, 166, 169

(1) Le gouvernement de la République fédérale d'Allemagne établit des copies certifiées conformes de la présente convention et les transmet aux gouvernements des Etats signataires ou adhérents.

(2) Le gouvernement de la République fédérale d'Allemagne notifie aux gouvernements des Etats visés au paragraphe 1 :

- a) les signatures ;
- b) le dépôt de tout instrument de ratification ou d'adhésion ;
- c) toute réserve et tout retrait de réserve en application des dispositions de l'article 167 ;
- d) toute déclaration ou notification reçue en application des dispositions de l'article 168 ;
- e) la date d'entrée en vigueur de la présente convention ;
- f) toute dénonciation reçue en application des dispositions de l'article 174 et la date à laquelle la dénonciation prend effet.

(3) Le gouvernement de la République fédérale d'Allemagne fait enregistrer la présente convention auprès du Secrétariat de l'Organisation des Nations Unies.

EN FOI DE QUOI les plénipotentiaires désignés à cette fin, après avoir présenté leurs pleins pouvoirs, reconnus en bonne et due forme, ont signé la présente convention.

Fait à Munich, le cinq octobre mil neuf cent soixante-treize

**AUSFÜHRUNGSORDNUNG
ZUM ÜBEREINKOMMEN
ÜBER DIE ERTEILUNG EUROPÄISCHER PATENTE**

vom 5. Oktober 1973
zuletzt geändert durch den Beschluss des Verwaltungsrats der Europäischen Patentorganisation
vom 9. Dezember 2004

**IMPLEMENTING REGULATIONS
TO THE CONVENTION ON THE GRANT
OF EUROPEAN PATENTS**

of 5 October 1973
as last amended by Decision of the Administrative Council of the European Patent Organisation
of 9 December 2004

**RÈGLEMENT D'EXÉCUTION
DE LA CONVENTION
SUR LA DÉLIVRANCE DE BREVETS EUROPÉENS**

du 5 octobre 1973
tel que modifié en dernier lieu par décision du Conseil d'administration de l'Organisation
européenne des brevets
en date du 9 décembre 2004

GLIEDERUNG

ERSTER TEIL

AUSFÜHRUNGSVORSCHRIFTEN ZUM ERSTEN TEIL DES ÜBEREINKOMMENS

Kapitel I

Sprachen des Europäischen Patentamts

- R. 1* Ausnahmen von den Vorschriften über die Verfahrenssprache im schriftlichen Verfahren
R. 2 Ausnahmen von den Vorschriften über die Verfahrenssprache im mündlichen Verfahren
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Kapitel I

Sprachen des Europäischen Patentamts

Regel 1¹

Ausnahmen von den Vorschriften über die
Verfahrenssprache im schriftlichen Verfahren

(1) Im schriftlichen Verfahren vor dem Europäischen Patentamt kann jeder Beteiligte sich jeder Amtssprache des Europäischen Patentamts bedienen. Die in Artikel 14 Absatz 4 vorgesehene Übersetzung kann in jeder Amtssprache des Europäischen Patentamts eingereicht werden.

(2) Änderungen der europäischen Patentanmeldung oder des europäischen Patents müssen in der Verfahrenssprache eingereicht werden.

(3) Schriftstücke, die als Beweismittel vor dem Europäischen Patentamt verwendet werden sollen, insbesondere Veröffentlichungen, können in jeder Sprache eingereicht werden. Das Europäische Patentamt kann jedoch verlangen, dass innerhalb einer von ihm zu bestimmenden Frist, die nicht kürzer als ein Monat sein darf, eine Übersetzung in einer seiner Amtssprachen eingereicht wird.

Regel 2

Ausnahmen von den Vorschriften über die
Verfahrenssprache im mündlichen Verfahren

(1)² Jeder an einem mündlichen Verfahren vor dem Europäischen Patentamt Beteiligte kann sich anstelle der Verfahrenssprache einer anderen Amtssprache des Europäischen Patentamts bedienen, sofern er dies entweder dem Europäischen Patentamt spätestens einen Monat vor dem angesetzten Termin mitgeteilt hat oder selbst für die Übersetzung in die Verfahrenssprache sorgt. Jeder Beteiligte kann sich auch einer Amtssprache eines der Vertragsstaaten bedienen, sofern er selbst für die Übersetzung in die Verfahrenssprache sorgt. Von den Vorschriften dieses Absatzes kann das Europäische Patentamt Ausnahmen zulassen.

(2) Die Bediensteten des Europäischen Patentamts können sich im mündlichen Verfahren anstelle der Verfahrenssprache einer anderen Amtssprache des Europäischen Patentamts bedienen.

PART I

IMPLEMENTING REGULATIONS TO PART I OF THE CONVENTION

Chapter I

Languages of the European Patent Office

Rule 1¹

Derogations from the provisions concerning the
language of the proceedings in written proceedings

(1) In written proceedings before the European Patent Office any party may use any official language of the European Patent Office. The translation referred to in Article 14, paragraph 4, may be filed in any official language of the European Patent Office.

(2) Amendments to a European patent application or European patent must be filed in the language of the proceedings.

(3) Documents to be used for purposes of evidence before the European Patent Office, and particularly publications, may be filed in any language. The European Patent Office may, however, require that a translation be filed, within a given time limit of not less than one month, in one of its official languages.

Rule 2

Derogations from the provisions concerning the
language of the proceedings in oral proceedings

(1)² Any party to oral proceedings before the European Patent Office may, in lieu of the language of the proceedings, use one of the other official languages of the European Patent Office, on condition either that such party gives notice to the European Patent Office at least one month before the date laid down for such oral proceedings or makes provision for interpreting into the language of the proceedings. Any party may likewise use one of the official languages of the Contracting States, on condition that he makes provision for interpretation into the language of the proceedings. The European Patent Office may permit derogations from the provisions of this paragraph.

(2) In the course of oral proceedings, the employees of the European Patent Office may, in lieu of the language of the proceedings, use one of the other official languages of the European Patent Office.

¹ Geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.). Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/99 (Anhang I).

² Geändert durch Beschluss des Verwaltungsrats vom 10.06.1988, in Kraft getreten am 01.10.1988 (ABI. EPA 1988, 290).

¹ Amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff). See decision of the Enlarged Board of Appeal G 3/99 (Annex I).

² Amended by decision of the Administrative Council of 10.06.1988 which entered into force on 01.10.1988 (OJ EPO 1988, 290).

PREMIÈRE PARTIE

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DISPOSITIONS D'APPLICATION DE LA PREMIÈRE PARTIE DE LA CONVENTION

Chapitre I

Langues de l'Office européen des brevets

*Règle 1*¹

Dérogations aux dispositions relatives à la langue de la procédure dans la procédure écrite

Art. 99, 105
R. 56, 65

(1) Dans toute procédure écrite devant l'Office européen des brevets, toute partie peut utiliser l'une des langues officielles de l'Office européen des brevets. La traduction visée à l'article 14, paragraphe 4 peut être déposée dans l'une des langues officielles de l'Office européen des brevets.

(2) Les modifications de la demande de brevet européen ou du brevet européen doivent être déposées dans la langue de la procédure.

(3) Les documents utilisés comme moyens de preuve devant l'Office européen des brevets, notamment les publications, peuvent être produits en toute langue. Toutefois, l'Office européen des brevets peut exiger que, dans un délai qu'il impartit et qui ne doit pas être inférieur à un mois, une traduction soit produite dans l'une de ses langues officielles.

Règle 2

Dérogations aux dispositions relatives à l'utilisation de la langue de la procédure au cours de la procédure orale

Art. 14, 116, 117, 123

(1)² Toute partie à une procédure orale devant l'Office européen des brevets peut, au lieu et place de la langue de la procédure, utiliser l'une des autres langues officielles de cet Office, à condition soit d'en aviser ledit Office un mois au moins avant la date fixée pour l'audience, soit d'assurer l'interprétation dans la langue de la procédure. Toute partie peut également utiliser l'une des langues officielles de l'un des Etats contractants à condition d'assurer l'interprétation dans la langue de la procédure. L'Office européen des brevets peut autoriser des dérogations aux dispositions du présent paragraphe.

(2) Au cours de la procédure orale, les agents de l'Office européen des brevets peuvent utiliser l'une des autres langues officielles de cet Office au lieu et place de la langue de la procédure.

¹ Modifiée par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.). Cf. la décision de la Grande Chambre de recours G 3/99 (Annexe I).

² Modifié par décision du Conseil d'administration en date du 10.06.1988, entrée en vigueur le 01.10.1988 (JO OEB 1988, 290).

(3) In der Beweisaufnahme können sich die zu vernehmenden Beteiligten, Zeugen oder Sachverständigen, die sich in einer der Amtssprachen des Europäischen Patentamts oder der Vertragsstaaten nicht hinlänglich ausdrücken können, einer anderen Sprache bedienen. Ist die Beweisaufnahme auf Antrag eines Beteiligten angeordnet worden, so werden die zu vernehmenden Beteiligten, Zeugen oder Sachverständigen mit Erklärungen, die sie in anderen Sprachen als den Amtssprachen des Europäischen Patentamts abgeben, nur gehört, sofern der antragstellende Beteiligte selbst für die Übersetzung in die Verfahrenssprache sorgt; das Europäische Patentamt kann jedoch die Übersetzung in eine seiner anderen Amtssprachen zulassen.

(4) Mit Einverständnis aller Beteiligten und des Europäischen Patentamts kann in einem mündlichen Verfahren jede Sprache verwendet werden.

(5) Das Europäische Patentamt übernimmt, soweit erforderlich, auf seine Kosten die Übersetzung in die Verfahrenssprache und gegebenenfalls in seine anderen Amtssprachen, sofern ein Beteiligter nicht selbst für die Übersetzung zu sorgen hat.

(6)³ Erklärungen der Bediensteten des Europäischen Patentamts, der Beteiligten, Zeugen und Sachverständigen in einem mündlichen Verfahren, die in einer Amtssprache des Europäischen Patentamts abgegeben werden, werden in dieser Sprache in die Niederschrift aufgenommen. Erklärungen in einer anderen Sprache werden in der Amtssprache aufgenommen, in die sie übersetzt worden sind. Änderungen des Textes der Beschreibung und der Patentansprüche der europäischen Patentanmeldung oder des europäischen Patents werden in der Verfahrenssprache in die Niederschrift aufgenommen.

Regel 3

(gestrichen)⁴

*Regel 4*⁵

Sprache der europäischen Teilanmeldung

Eine europäische Teilanmeldung oder, im Fall des Artikels 14 Absatz 2, ihre Übersetzung muss in der Verfahrenssprache der früheren europäischen Patentanmeldung eingereicht werden.

(3) In the case of taking of evidence, any party to be heard, witness or expert who is unable to express himself adequately in one of the official languages of the European Patent Office or the Contracting States may use another language. Should the taking of evidence be decided upon following a request by a party to the proceedings, parties to be heard, witnesses or experts who express themselves in languages other than the official languages of the European Patent Office may be heard only if the party who made the request makes provision for interpretation into the language of the proceedings; the European Patent Office may, however, authorise interpretation into one of its other official languages.

(4) If the parties and the European Patent Office agree, any language may be used in oral proceedings.

(5) The European Patent Office shall, if necessary, make provision at its own expense for interpretation into the language of the proceedings, or, where appropriate, into its other official languages, unless this interpretation is the responsibility of one of the parties to the proceedings.

(6)³ Statements by employees of the European Patent Office, by parties to the proceedings and by witnesses and experts, made in one of the official languages of the European Patent Office during oral proceedings shall be entered in the minutes in the language employed. Statements made in any other language shall be entered in the official language into which they are translated. Amendments to the text of the description or claims of a European patent application or European patent shall be entered in the minutes in the language of the proceedings.

Rule 3

(deleted)⁴

*Rule 4*⁵

Language of a European divisional application

European divisional applications or, in the case referred to in Article 14, paragraph 2, the translations thereof, must be filed in the language of the proceedings for the earlier European patent application.

³ Geändert durch Beschluss des Verwaltungsrats vom 05.07.1991, in Kraft getreten am 01.10.1991 (ABI. EPA 1991, 421).

⁴ Gestrichen durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.).

⁵ Geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.).

³ Amended by decision of the Administrative Council of 05.07.1991 which entered into force on 01.10.1991 (OJ EPO 1991, 421).

⁴ Deleted by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff.).

⁵ Amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff.).

(3) Au cours de la procédure d'instruction, toute partie à l'audition de laquelle il doit être procédé, les témoins ou experts appelés à participer à la procédure, qui ne possèdent pas une maîtrise suffisante de l'une des langues officielles de l'Office européen des brevets ou de l'un des Etats contractants, peuvent utiliser une autre langue. Si l'instruction est décidée sur requête d'une partie à la procédure, les parties, témoins ou experts appelés à participer à cette instruction, qui s'expriment dans des langues autres que les langues officielles de l'Office européen des brevets, ne peuvent être entendus que si la partie ayant formulé la requête assure l'interprétation dans la langue de la procédure; l'Office européen des brevets peut toutefois autoriser l'interprétation dans l'une de ses autres langues officielles.

(4) Sous réserve de l'accord des parties et de l'Office européen des brevets, toute langue peut être utilisée dans la procédure orale.

(5) L'Office européen des brevets assure à ses frais, en tant que de besoin, l'interprétation dans la langue de la procédure, ou, le cas échéant, dans l'une de ses autres langues officielles, à moins que cette interprétation ne doive être assurée par l'une des parties à la procédure.

(6)³ Les interventions des agents de l'Office européen des brevets, des parties à la procédure, des témoins et experts, faites au cours d'une procédure orale dans l'une des langues officielles de cet Office, sont consignées au procès-verbal dans la langue utilisée. Les interventions faites dans une autre langue sont consignées dans la langue officielle dans laquelle elles sont traduites. Les modifications du texte de la description ou des revendications de la demande de brevet européen ou du brevet européen sont consignées au procès-verbal dans la langue de la procédure.

Règle 3

(supprimée)⁴

*Règle 4*⁵

Langue des demandes divisionnaires européennes Art. 76

Toute demande divisionnaire européenne ou, dans le cas visé à l'article 14, paragraphe 2, sa traduction, doit être déposée dans la langue de la procédure de la demande antérieure de brevet européen.

³ Modifié par décision du Conseil d'administration en date du 05.07.1991, entrée en vigueur le 01.10.1991 (JO OEB 1991, 421).

⁴ Supprimée par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.).

⁵ Modifiée par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.).

Regel 5

Beglaubigung von Übersetzungen

Ist die Übersetzung eines Schriftstücks einzureichen, so kann das Europäische Patentamt innerhalb einer von ihm zu bestimmenden Frist die Einreichung einer Beglaubigung darüber verlangen, dass die Übersetzung mit dem Urtext übereinstimmt. Wird die Beglaubigung nicht rechtzeitig eingereicht, so gilt das Schriftstück als nicht eingegangen, sofern im Übereinkommen nichts anderes bestimmt ist.

Regel 6

Fristen und Gebührenermäßigung

(1)⁶ Die in Artikel 14 Absatz 2 vorgeschriebene Übersetzung ist innerhalb von drei Monaten nach Einreichung der europäischen Patentanmeldung einzureichen, jedoch nicht später als dreizehn Monate nach dem Prioritätstag. Betrifft die Übersetzung jedoch eine europäische Teilanmeldung oder die in Artikel 61 Absatz 1 Buchstabe b vorgesehene neue europäische Patentanmeldung, so darf sie innerhalb eines Monats nach Einreichung dieser Anmeldung vorgelegt werden.

(2) Die in Artikel 14 Absatz 4 vorgeschriebene Übersetzung ist innerhalb eines Monats nach Einreichung des Schriftstücks einzureichen. Ist das Schriftstück ein Einspruch oder eine Beschwerde, so verlängert sich die genannte Frist gegebenenfalls bis zum Ablauf der Einspruchs- oder Beschwerdefrist.

(3)⁷ Macht ein Anmelder, Patentinhaber oder Einsprechender von den durch Artikel 14 Absätze 2 und 4 eröffneten Möglichkeiten Gebrauch, so werden dementsprechend die Anmeldegebühr, die Prüfungsgebühr, die Einspruchsgebühr und die Beschwerdegebühr ermäßigt. Die Ermäßigung wird in der Gebührenordnung in Höhe eines Prozentsatzes der Gebühren festgelegt.

Regel 7

Rechtliche Bedeutung der Übersetzung der europäischen Patentanmeldung

Das Europäische Patentamt kann, soweit nicht der Gegenbeweis erbracht wird, für die Bestimmung, ob der Gegenstand der europäischen Patentanmeldung oder des europäischen Patents nicht über den Inhalt der Anmeldung in der ursprünglich eingereichten Fassung hinausgeht, davon ausgehen, dass die in Artikel 14 Absatz 2 genannte Übersetzung mit dem ursprünglichen Text der Anmeldung übereinstimmt.

Rule 5

Certification of translations

When a translation of any document must be filed, the European Patent Office may require the filing of a certificate that the translation corresponds to the original text within a period to be determined by it. Failure to file the certificate in due time shall lead to the document being deemed not to have been received unless the Convention provides otherwise.

Rule 6

Time limits and reduction of fees

(1)⁶ The translation referred to in Article 14, paragraph 2, must be filed within three months after the filing of the European patent application, but no later than thirteen months after the date of priority. Nevertheless, if the translation concerns a European divisional application or a new European patent application under Article 61, paragraph 1(b), the translation may be filed at any time within one month of the filing of such application.

(2) The translation referred to in Article 14, paragraph 4, must be filed within one month of the filing of the document. Where the document is a notice of opposition or an appeal, this period shall be extended where appropriate to the end of the opposition period or appeal period.

(3)⁷ A reduction in the filing fee, examination fee, opposition fee or appeal fee shall be allowed an applicant, proprietor or opponent, as the case may be, who avails himself of the options provided in Article 14, paragraphs 2 and 4. The reduction shall be fixed in the Rules relating to Fees at a percentage of the total of the fees.

Rule 7

Legal authenticity of the translation of the European patent application

Saving proof to the contrary, the European Patent Office may, for the purposes of determining whether the subject-matter of the European patent application or European patent extends beyond the content of the European patent application as filed, assume that the translation referred to in Article 14, paragraph 2, is in conformity with the original text of the application.

⁶ Geändert durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABI. EPA 1978, 12 ff.).

⁷ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 6/91 (Anhang I).

⁶ Amended by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff.).

⁷ See decision of the Enlarged Board of Appeal G 6/91 (Annex I).

Règle 5

Certification de traductions

Si la traduction d'un document doit être produite, l'Office européen des brevets peut exiger, dans un délai qu'il impartit, la production d'une attestation, certifiant que la traduction est une traduction correcte du texte original. Si l'attestation n'est pas produite dans les délais, le document est réputé n'avoir pas été reçu, sauf dispositions contraires de la convention.

Verweisungen / References / Références

Art. 14, 88

Règle 6

Délais et réduction des taxes

(1)⁶ La traduction visée à l'article 14, paragraphe 2 doit être produite dans un délai de trois mois à compter du dépôt de la demande de brevet européen et, en tout état de cause, avant l'expiration d'un délai de treize mois à compter de la date de priorité. Cependant, lorsque la traduction concerne une demande divisionnaire européenne ou la nouvelle demande de brevet européen prévue à l'article 61, paragraphe 1, lettre b), elle peut être produite dans un délai d'un mois à compter du dépôt de cette demande.

Art. 76, 78, 88, 94, 99, 108

(2) La traduction visée à l'article 14, paragraphe 4, doit être produite dans un délai d'un mois à compter du dépôt de la pièce; si cette dernière est un acte d'opposition ou un recours, le délai est prorogé, s'il y a lieu, jusqu'au terme du délai d'opposition ou de recours.

(3)⁷ Une réduction du montant des taxes de dépôt, d'examen, d'opposition ou de recours est accordée, selon le cas, au demandeur, au titulaire ou à l'opposant qui use des facultés ouvertes par les dispositions de l'article 14, paragraphes 2 et 4. Cette réduction est fixée à un pourcentage du montant desdites taxes, dans le règlement relatif aux taxes.

Règle 7

Valeur juridique de la traduction de la demande de brevet européen

Art. 70, 123

Sauf preuve contraire, l'Office européen des brevets peut, pour déterminer si l'objet de la demande de brevet européen ou du brevet européen ne s'étend pas au-delà du contenu de la demande telle qu'elle a été déposée, présumer que la traduction visée à l'article 14, paragraphe 2 est une traduction exacte du texte original de la demande.

⁶ Modifié par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.).

⁷ Cf. la décision de la Grande Chambre de recours G 6/91 (Annexe I).

Organisation des Europäischen Patentamts*Regel 8*

Patentklassifikation

- (1) Das Europäische Patentamt benutzt
- a) bis zum Inkrafttreten des Straßburger Abkommens über die Internationale Patentklassifikation vom 24. März 1971 die Patentklassifikation, die in Artikel 1 der Europäischen Übereinkunft über die Internationale Patentklassifikation vom 19. Dezember 1954 vorgesehen ist;
- b) nach Inkrafttreten des genannten Straßburger Abkommens die in Artikel 1 dieses Abkommens vorgesehene Patentklassifikation.
- (2) Die Klassifikation nach Absatz 1 wird nachstehend als Internationale Klassifikation bezeichnet.

Regel 9⁸

Geschäftsverteilung für die erste Instanz

- (1) Der Präsident des Europäischen Patentamts bestimmt die Zahl der Recherchenabteilungen, der Prüfungsabteilungen und der Einspruchsabteilungen. Er verteilt die Geschäfte auf diese Abteilungen in Anwendung der Internationalen Klassifikation und entscheidet gegebenenfalls über die Klassifikation einer europäischen Patentanmeldung oder eines europäischen Patents nach Maßgabe der Internationalen Klassifikation.
- (2)⁹ Der Präsident des Europäischen Patentamts kann der Eingangsstelle, den Recherchenabteilungen, den Prüfungsabteilungen, den Einspruchsabteilungen und der Rechtsabteilung über die Zuständigkeit hinaus, die ihnen durch das Übereinkommen zugewiesen ist, weitere Aufgaben übertragen.
- (3)¹⁰ Der Präsident des Europäischen Patentamts kann mit der Wahrnehmung einzelner den Prüfungsabteilungen oder Einspruchsabteilungen obliegender Geschäfte, die technisch oder rechtlich keine Schwierigkeiten bereiten, auch Bedienstete betrauen, die keine technisch vorgebildeten oder rechtskundigen Prüfer sind.
- (4) Der Präsident des Europäischen Patentamts kann bestimmen, dass nur eine der Geschäftsstellen der Einspruchsabteilungen für die Kostenfestsetzung nach Artikel 104 Absatz 2 zuständig ist.

Organisation of the European Patent Office*Rule 8*

Patent classification

- (1) The European Patent Office shall use:
- (a) the classification referred to in Article 1 of the European Convention on the International Classification of Patents for Invention of 19 December 1954 until the entry into force of the Strasbourg Agreement concerning the International Patent Classification of 24 March 1971;
- (b) the classification referred to in Article 1 of the aforementioned Strasbourg Agreement, after the entry into force of that Agreement.
- (2) The classification referred to in paragraph 1 is hereinafter referred to as the international classification.

Rule 9⁸

Allocation of duties to the departments of the first instance

- (1) The President of the European Patent Office shall determine the number of Search Divisions, Examining Divisions and Opposition Divisions. He shall allocate duties to these departments by reference to the international classification and shall decide where necessary on the classification of a European patent application or a European patent in accordance with that classification.
- (2)⁹ In addition to the responsibilities vested in them under the Convention, the President of the European Patent Office may allocate further duties to the Receiving Section, Search Divisions, Examining Divisions, Opposition Divisions and the Legal Division.
- (3)¹⁰ The President of the European Patent Office may entrust to employees who are not technically or legally qualified examiners the execution of individual duties falling to the Examining Divisions or Opposition Divisions and involving no technical or legal difficulties.
- (4) The President of the European Patent Office may grant exclusive responsibilities to one of the registries of the Opposition Divisions for fixing the amount of costs as provided for in Article 104, paragraph 2.

⁸ Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 1/02 (Anhang I).

⁹ Siehe hierzu den Beschluss des Präsidenten des EPA vom 10.03.1989 über die Zuständigkeit der Rechtsabteilung (ABI. EPA 1989, 177 ff.).

¹⁰ Siehe hierzu Mitteilungen vom 28.04.1999 über die Wahrnehmung einzelner den Prüfungs- oder Einspruchsabteilungen obliegender Geschäfte durch Bedienstete, die keine Prüfer sind (ABI. EPA 1999, 503 ff.) und Entscheidung der Großen Beschwerdekammer G 2/90 (Anhang I).

⁸ See opinion of the Enlarged Board of Appeal G 1/02 (Annex I).

⁹ See decision of the President of the EPO dated 10.03.1989 concerning the responsibilities of the Legal Division (OJ EPO 1989, 177 ff.).

¹⁰ See notice of 28.04.1999 concerning the entrustment to non-examining staff of certain duties normally the responsibility of the Examining or Opposition Divisions (OJ EPO 1999, 503 ff) and decision of the Enlarged Board of Appeal G 2/90 (Annex I).

Organisation de l'Office européen des brevets*Règle 8*

Classification des brevets

R. 9, 44

- (1) L'Office européen des brevets utilise :
- a) jusqu'à l'entrée en vigueur de l'Arrangement de Strasbourg du 24 mars 1971, concernant la classification internationale des brevets, la classification prévue à l'article premier de la Convention européenne du 19 décembre 1954 sur la classification internationale des brevets d'invention,
 - b) après l'entrée en vigueur dudit Arrangement, la classification prévue à l'article premier de celui-ci.
- (2) La classification visée au paragraphe 1 est ci-après dénommée classification internationale.

*Règle 9*⁸

Répartition d'attributions entre les instances du premier degré

Art. 15-20
R. 8

- (1) Le Président de l'Office européen des brevets fixe le nombre des divisions de la recherche, des divisions d'examen et des divisions d'opposition. Il répartit les attributions entre ces instances par référence à la classification internationale et décide, le cas échéant, du classement d'une demande de brevet européen ou d'un brevet européen selon cette classification.
- (2)⁹ Outre les compétences qui leur sont dévolues par la convention, le Président de l'Office européen des brevets peut confier d'autres attributions à la section de dépôt, aux divisions de la recherche, aux divisions d'examen, aux divisions d'opposition et à la division juridique.
- (3)¹⁰ Le Président de l'Office européen des brevets peut confier certaines tâches, incombant normalement aux divisions d'examen ou aux divisions d'opposition et ne présentant aucune difficulté technique ou juridique particulière, à des agents qui ne sont pas des examinateurs qualifiés sur le plan technique ou juridique.
- (4) Le Président de l'Office européen des brevets peut attribuer une compétence exclusive à l'un des greffes des divisions d'opposition pour la fixation du montant des frais de procédure prévue à l'article 104, paragraphe 2.

⁸ Cf. l'avis de la Grande Chambre de recours G 1/02 (Annexe I).

⁹ Cf. la décision du Président de l'OEB du 10.03.1989 relative à la compétence de la division juridique (JO OEB 1989, 177 s.).

¹⁰ Cf. les communiqués du 28.04.1999 visant à confier à des agents qui ne sont pas des examinateurs certaines tâches incombant normalement aux divisions d'examen ou d'opposition (JO OEB 1999, 503 s.) et la décision de la Grande Chambre de recours G 2/90 (Annexe I).

Präsidium der Beschwerdekammern

(1) Das autonome Organ innerhalb der die Beschwerdekammern umfassenden Organisationseinheit (das "Präsidium der Beschwerdekammern") setzt sich zusammen aus dem für die Beschwerdekammern zuständigen Vizepräsidenten als Vorsitzendem und zwölf Mitgliedern der Beschwerdekammern, von denen sechs Vorsitzende und sechs weitere Mitglieder sind.

(2) Alle Mitglieder des Präsidiums werden von den Vorsitzenden und den Mitgliedern der Beschwerdekammern für die Dauer eines Geschäftsjahres gewählt. Kann das Präsidium nicht vollzählig zusammengesetzt werden, so werden die vakanten Stellen durch Bestimmung der dienstältesten Vorsitzenden bzw. Mitglieder besetzt.

(3) Das Präsidium erlässt die Verfahrensordnung der Beschwerdekammern und die Verfahrensordnung für die Wahl und die Bestimmung seiner Mitglieder. Ferner berät das Präsidium den für die Beschwerdekammern zuständigen Vizepräsidenten in die Funktionsweise der Beschwerdekammern allgemein betreffenden Angelegenheiten.

(4) Vor Beginn eines jeden Geschäftsjahrs verteilt das um alle Vorsitzenden erweiterte Präsidium die Geschäfte auf die Beschwerdekammern. In derselben Zusammensetzung entscheidet es bei Meinungsverschiedenheiten zwischen mehreren Beschwerdekammern über ihre Zuständigkeit. Das erweiterte Präsidium bestimmt die ständigen Mitglieder der einzelnen Beschwerdekammern sowie ihre Vertreter. Jedes Mitglied einer Beschwerdekammer kann zum Mitglied mehrerer Beschwerdekammern bestimmt werden. Falls erforderlich, können diese Anordnungen im Laufe des Geschäftsjahrs geändert werden.

(5) Zur Beschlussfähigkeit des Präsidiums ist die Anwesenheit von mindestens fünf Mitgliedern erforderlich, unter denen sich der für die Beschwerdekammern zuständige Vizepräsident oder sein Vertreter und die Vorsitzenden von zwei Beschwerdekammern befinden müssen. Handelt es sich um die in Absatz 4 genannten Aufgaben, so ist die Anwesenheit von neun Mitgliedern erforderlich, unter denen sich der für die Beschwerdekammern zuständige Vizepräsident oder sein Vertreter und die Vorsitzenden von drei Beschwerdekammern befinden müssen. Das Präsidium entscheidet mit Stimmenmehrheit; bei Stimmgleichheit gibt die Stimme des Vorsitzenden oder seines Vertreters den Ausschlag. Stimmenthaltung gilt nicht als Stimmabgabe.

(6) Der Verwaltungsrat kann den Beschwerdekammern Aufgaben nach Artikel 134 Absatz 8 Buchstabe c übertragen.

Presidium of the Boards of Appeal

(1) The autonomous authority within the organisational unit comprising the Boards of Appeal (the "Presidium of the Boards of Appeal") shall consist of the Vice-President in charge of the Boards of Appeal, who shall act as chairman, and twelve members of the Boards of Appeal, six being Chairmen and six being other members.

(2) All members of the Presidium shall be elected by the Chairmen and members of the Boards of Appeal for one working year. If the full composition of the Presidium cannot be reached, the vacancies shall be filled by designating the most senior Chairmen and members.

(3) The Presidium shall adopt the Rules of Procedure of the Boards of Appeal and the Rules of Procedure for the election and designation of its members. The Presidium shall further advise the Vice-President in charge of the Boards of Appeal with regard to matters concerning the functioning of the Boards of Appeal in general.

(4) Before the beginning of each working year the Presidium, extended to include all Chairmen, shall allocate duties to the Boards of Appeal. In the same composition, it shall decide on conflicts regarding the allocation of duties between two or more Boards of Appeal. The extended Presidium shall designate the regular and alternate members of the various Boards of Appeal. Any member of a Board of Appeal may be designated as a member of more than one Board of Appeal. These measures may, where necessary, be amended during the course of the working year in question.

(5) The Presidium may only take a decision if at least five of its members are present; these must include the Vice-President in charge of the Boards of Appeal or his deputy, and the Chairmen of two Boards of Appeal. Where the tasks mentioned in paragraph 4 are concerned, nine members must be present, including the Vice-President in charge of the Boards of Appeal or his deputy, and the Chairmen of three Boards of Appeal. Decisions shall be taken by a majority vote; in the event of parity of votes, the Chairman or his deputy shall have the casting vote. Abstentions shall not be considered as votes.

(6) The Administrative Council may allocate duties under Article 134, paragraph 8(c), to the Boards of Appeal.

¹¹ Geändert durch Beschluss des Verwaltungsrats vom 18.10.2001, in Kraft getreten am 02.01.2002 (ABI. EPA 2001, 485 ff.). Siehe hierzu die Entscheidungen der Großen Beschwerdekammer G 6/95, G 1/97 (Anhang I).

¹¹ Amended by decision of the Administrative Council of 18.10.2001 which entered into force on 02.01.2002 (OJ EPO 2001, 485 ff). See decisions of the Enlarged Board of Appeal G 6/95, G 1/97 (Annex I).

Praesidium des chambres de recours

Art. 15, 21, 22

R. 11

- (1) L'instance autonome au sein de l'unité organisationnelle comprenant les chambres de recours (le "Praesidium des chambres de recours") se compose du Vice-Président en charge des chambres de recours, président, et de douze membres des chambres de recours, parmi lesquels six sont présidents et six sont membres.
- (2) Tous les membres du Praesidium sont élus par les présidents et les membres des chambres de recours pour une année d'activité donnée. Si la composition du Praesidium n'est pas complète, il est pourvu aux vacances en désignant les présidents et les membres qui ont le plus d'ancienneté.
- (3) Le Praesidium arrête le règlement de procédure des chambres de recours ainsi que le règlement de procédure relatif à l'élection et à la désignation de ses membres. Le Praesidium conseille également le Vice-Président en charge des chambres de recours sur des questions concernant le fonctionnement des chambres de recours en général.
- (4) Avant le début de chaque année d'activité, le Praesidium, élargi de façon à comprendre tous les présidents, répartit les attributions entre les chambres de recours. Il décide, dans la même composition, sur les conflits d'attribution entre plusieurs chambres de recours. Le Praesidium élargi désigne les membres titulaires et les membres suppléants des différentes chambres de recours. Tout membre d'une chambre de recours peut être désigné membre de plusieurs chambres de recours. Ces mesures peuvent être modifiées, en tant que de besoin, au cours de l'année d'activité considérée.
- (5) Le Praesidium ne peut valablement délibérer que si cinq au moins de ses membres sont présents, parmi lesquels doivent figurer le Vice-Président en charge des chambres de recours ou son suppléant et deux présidents de chambres de recours. S'agissant des tâches mentionnées au paragraphe 4, neuf membres doivent être présents, parmi lesquels doivent figurer le Vice-Président en charge des chambres de recours ou son suppléant et trois présidents de chambres de recours. Les décisions sont prises à la majorité des voix; en cas de partage égal des voix, la voix du président ou de son suppléant est prépondérante. L'abstention n'est pas considérée comme un vote.
- (6) Le Conseil d'administration peut confier aux chambres de recours des compétences en vertu de l'article 134, paragraphe 8, lettre c).

¹¹ Modifiée par décision du Conseil d'administration en date du 18.10.2001, entrée en vigueur le 02.01.2002 (JO OEB 2001, 485 s.). Cf. les décisions de la Grande Chambre de recours G 6/95, G 1/97 (Annexe I).

*Regel 11*¹²

Geschäftsverteilungsplan für die Große Beschwerdekammer und Erlass ihrer Verfahrensordnung

- (1) Vor Beginn eines jeden Geschäftsjahrs bestimmen die nicht nach Artikel 160 Absatz 2 ernannten Mitglieder der Großen Beschwerdekammer die ständigen Mitglieder der Großen Beschwerdekammer sowie ihre Vertreter.
- (2) Die nicht nach Artikel 160 Absatz 2 ernannten Mitglieder der Großen Beschwerdekammer erlassen die Verfahrensordnung der Großen Beschwerdekammer.
- (3) Zur Beschlussfähigkeit in den in den Absätzen 1 und 2 genannten Angelegenheiten ist die Anwesenheit von mindestens fünf Mitgliedern erforderlich, unter denen sich der Vorsitzende der Großen Beschwerdekammer oder sein Vertreter befinden muss; bei Stimmgleichheit gibt die Stimme des Vorsitzenden oder seines Vertreters den Ausschlag. Stimmenthaltung gilt nicht als Stimmabgabe.

Regel 12

Verwaltungsmäßige Gliederung des Europäischen Patentamts

- (1) Die Prüfungsabteilungen und Einspruchsabteilungen werden verwaltungsmäßig zu Direktionen zusammengefasst, deren Zahl vom Präsidenten des Europäischen Patentamts bestimmt wird.
- (2) Die Direktionen, die Rechtsabteilung, die Beschwerdekammern und die Große Beschwerdekammer sowie die Dienststellen für die innere Verwaltung des Europäischen Patentamts werden verwaltungsmäßig zu Generaldirektionen zusammengefasst. Die Eingangsstelle und die Recherchenabteilungen werden verwaltungsmäßig zu einer Generaldirektion zusammengefasst.
- (3) Jede Generaldirektion wird von einem Vizepräsidenten geleitet. Der Verwaltungsrat entscheidet nach Anhörung des Präsidenten des Europäischen Patentamts über die Zuweisung der Vizepräsidenten an die Generaldirektionen.

*Rule 11*¹²

Business distribution scheme for the Enlarged Board of Appeal and adoption of its Rules of Procedure

- (1) Before the beginning of each working year, the members of the Enlarged Board of Appeal who have not been appointed under Article 160, paragraph 2, shall designate the regular and alternate members of the Enlarged Board of Appeal.
- (2) The members of the Enlarged Board of Appeal who have not been appointed under Article 160, paragraph 2, shall adopt the Rules of Procedure of the Enlarged Board of Appeal.
- (3) Decisions on matters mentioned in paragraphs 1 and 2 may only be taken if at least five members are present, including the Chairman of the Enlarged Board of Appeal or his deputy; in the event of parity of votes, the Chairman or his deputy shall have the casting vote. Abstentions shall not be considered as votes.

Rule 12

Administrative structure of the European Patent Office

- (1) The Examining Divisions and the Opposition Divisions shall be grouped together administratively so as to form Directorates, the number of which shall be laid down by the President of the European Patent Office.
- (2) The Directorates, the Legal Division, the Boards of Appeal and the Enlarged Board of Appeal, and the administrative services of the European Patent Office shall be grouped together administratively so as to form Directorates-General. The Receiving Section and the Search Divisions shall be grouped together administratively so as to form a Directorate-General.
- (3) Each Directorate-General shall be directed by a Vice-President. The appointment of a Vice-President to a Directorate-General shall be decided upon by the Administrative Council, after the President of the European Patent Office has been consulted.

¹² Geändert durch Beschluss des Verwaltungsrats vom 18.10.2001, in Kraft getreten am 02.01.2002 (ABl. EPA 2001, 485 ff.). Siehe hierzu die Entscheidungen der Großen Beschwerdekammer G 6/95, G 1/97 (Anhang I).

¹² Amended by decision of the Administrative Council of 18.10.2001 which entered into force on 02.01.2002 (OJ EPO 2001, 485 ff). See decisions of the Enlarged Board of Appeal G 6/95, G 1/97 (Annex I).

Règle 11¹²

Verweisungen / References / Références

Répartition des attributions au sein de la Grande
Chambre de recours et adoption de son règlement de
procédure

Art. 22, 23

- (1) Avant le début de chaque année d'activité, les membres de la Grande Chambre de recours qui n'ont pas été nommés en vertu de l'article 160, paragraphe 2, désignent les membres titulaires et les membres suppléants de la Grande Chambre de recours.
- (2) Les membres de la Grande Chambre de recours qui n'ont pas été nommés en vertu de l'article 160, paragraphe 2, arrêtent le règlement de procédure de la Grande Chambre de recours.
- (3) Les décisions relatives aux questions mentionnées aux paragraphes 1 et 2 ne peuvent être prises que si au moins cinq membres sont présents, parmi lesquels doit figurer le Président de la Grande Chambre de recours ou son suppléant; en cas de partage égal des voix, la voix du Président ou de son suppléant est prépondérante. L'abstention n'est pas considérée comme un vote.

Règle 12

Structure administrative de l'Office européen des
brevets

Art. 10, 15

- (1) Les divisions d'examen et les divisions d'opposition sont groupées sur le plan administratif en directions dont le nombre est fixé par le Président de l'Office européen des brevets.
- (2) Les directions, la division juridique, les chambres de recours et la Grande Chambre de recours, ainsi que les services administratifs de l'Office européen des brevets, sont groupés sur le plan administratif en directions générales. La section de dépôt et les divisions de la recherche sont groupées sur le plan administratif en une direction générale.
- (3) Chaque direction générale est dirigée par un Vice-Président. La nomination d'un Vice-Président à la tête d'une direction générale est décidée par le Conseil d'administration, le Président de l'Office européen des brevets entendu.

¹² Modifiée par décision du Conseil d'administration en date du 18.10.2001, entrée en vigueur le 02.01.2002 (JO OEB 2001, 485 s.). Cf les décisions de la Grande Chambre de recours G 6/95, G 1/97 (Annexe I).

ZWEITER TEIL

AUSFÜHRUNGSVORSCHRIFTEN ZUM ZWEITEN TEIL DES ÜBEREINKOMMENS

Kapitel I

Verfahren bei mangelnder Berechtigung des Anmelders oder Patentinhabers

Regel 13^{13/14}

Aussetzung des Verfahrens

(1) Weist ein Dritter dem Europäischen Patentamt nach, dass er ein Verfahren gegen den Anmelder eingeleitet hat, in dem der Anspruch auf Erteilung des europäischen Patents ihm zugesprochen werden soll, so setzt das Europäische Patentamt das Erteilungsverfahren aus, es sei denn, dass der Dritte der Fortsetzung des Verfahrens zustimmt. Diese Zustimmung ist dem Europäischen Patentamt schriftlich zu erklären; sie ist unwiderruflich. Das Erteilungsverfahren kann jedoch nicht vor der Veröffentlichung der europäischen Patentanmeldung ausgesetzt werden.

(2) Wird dem Europäischen Patentamt nachgewiesen, dass in dem Verfahren zur Geltendmachung des Anspruchs auf Erteilung des europäischen Patents eine rechtskräftige Entscheidung ergangen ist, so teilt das Europäische Patentamt dem Anmelder und gegebenenfalls den Beteiligten mit, dass das Erteilungsverfahren von einem in der Mitteilung genannten Tag an fortgesetzt wird, es sei denn, dass nach Artikel 61 Absatz 1 Buchstabe b eine neue europäische Patentanmeldung für alle benannten Vertragsstaaten eingereicht worden ist. Ist die Entscheidung zu Gunsten des Dritten ergangen, so darf das Verfahren erst nach Ablauf von drei Monaten nach Eintritt der Rechtskraft dieser Entscheidung fortgesetzt werden, es sei denn, dass der Dritte die Fortsetzung des Erteilungsverfahrens beantragt.

(3) Mit der Entscheidung über die Aussetzung des Verfahrens oder später kann das Europäische Patentamt einen Zeitpunkt festsetzen, zu dem es beabsichtigt, das vor ihm anhängige Verfahren ohne Rücksicht auf den Stand des in Absatz 1 genannten, gegen den Anmelder eingeleiteten Verfahrens fortzusetzen. Der Zeitpunkt ist dem Dritten, dem Anmelder und gegebenenfalls den Beteiligten mitzuteilen. Wird bis zu diesem Zeitpunkt nicht nachgewiesen, dass eine rechtskräftige Entscheidung ergangen ist, so kann das Europäische Patentamt das Verfahren fortsetzen.

PART II

IMPLEMENTING REGULATIONS TO PART II OF THE CONVENTION

Chapter I

Procedure where the applicant or proprietor is not entitled

Rule 13^{13/14}

Suspension of proceedings

(1) If a third party provides proof to the European Patent Office that he has opened proceedings against the applicant for the purpose of seeking a judgment that he is entitled to the grant of the European patent, the European Patent Office shall stay the proceedings for grant unless the third party consents to the continuation of such proceedings. Such consent must be communicated in writing to the European Patent Office; it shall be irrevocable. However, proceedings for grant may not be stayed before the publication of the European patent application.

(2) Where proof is provided to the European Patent Office that a decision which has become final has been given in the proceedings concerning entitlement to the grant of the European patent, the European Patent Office shall communicate to the applicant and any other party that the proceedings for grant shall be resumed as from the date stated in the communication unless a new European patent application pursuant to Article 61, paragraph 1(b), has been filed for all the designated Contracting States. If the decision is in favour of the third party, the proceedings may only be resumed after a period of three months of that decision becoming final unless the third party requests the resumption of the proceedings for grant.

(3) When giving a decision on the suspension of proceedings or thereafter the European Patent Office may set a date on which it intends to continue the proceedings pending before it regardless of the stage reached in the proceedings referred to in paragraph 1 opened against the applicant. The date is to be communicated to the third party, the applicant and any other party. If no proof has been provided by that date that a decision which has become final has been given, the European Patent Office may continue proceedings.

¹³ Siehe hierzu den Beschluss des Präsidenten des EPA vom 10.03.1989 über die Zuständigkeit der Rechtsabteilung (ABI. EPA 1989, 177 f.) und die Mitteilung des Vizepräsidenten Generaldirektion des EPA vom 05.07.1990 über den Schriftverkehr mit der Rechtsabteilung (ABI. EPA 1990, 404 f.).

¹⁴ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/92 (Anhang I).

¹³ See decision of the President of the EPO dated 10.03.1989 concerning the responsibilities of the Legal Division (OJ EPO 1989, 177 f) and the notice of the Vice-President DG 5 of the EPO dated 05.07.1990 concerning correspondence with the Legal Division (OJ EPO 1990, 404 f.).

¹⁴ See decision of the Enlarged Board of Appeal G 3/92 (Annex I).

DEUXIÈME PARTIE

Verweisungen / References / Références

DISPOSITIONS D'APPLICATION DE LA SECONDE PARTIE DE LA CONVENTION

Chapitre I

Procédures prévues lorsque le demandeur ou le titulaire du brevet n'est pas une personne habilitée

Règle 13^{13/14}

Suspension de la procédure

*Art. 86, 93, 99
R. 92*

(1) Si un tiers apporte à l'Office européen des brevets la preuve qu'il a introduit une procédure contre le demandeur à l'effet d'établir que le droit à l'obtention du brevet européen lui appartient, l'Office suspend la procédure de délivrance, à moins que ce tiers ne consente à la poursuite de cette procédure. Ce consentement doit être déclaré par écrit à l'Office européen des brevets; il est irrévocable. La suspension de la procédure ne peut toutefois intervenir avant la publication de la demande de brevet européen.

(2) Si la preuve est apportée à l'Office européen des brevets qu'une décision passée en force de chose jugée est intervenue dans la procédure en revendication du droit à l'obtention du brevet européen, l'Office européen des brevets notifie au demandeur ou, selon le cas, aux autres parties intéressées que la procédure de délivrance est reprise à compter de la date fixée par la notification, à moins que, conformément à l'article 61, paragraphe 1, lettre b), une nouvelle demande de brevet européen n'ait été déposée pour l'ensemble des Etats contractants désignés. Si la décision est prononcée en faveur du tiers, la procédure ne peut être reprise qu'après l'expiration d'un délai de trois mois après que la décision est passée en force de chose jugée, à moins que le tiers n'ait demandé la poursuite de la procédure de délivrance.

(3) L'Office européen des brevets peut, simultanément ou à une date ultérieure, prendre la décision de suspendre la procédure et fixer la date à laquelle il envisage de reprendre la procédure en instance devant lui, sans tenir compte de l'état de la procédure engagée contre le demandeur visée au paragraphe 1. Cette date doit être notifiée au tiers ainsi qu'au demandeur et, le cas échéant, aux autres parties intéressées. Si, avant cette date, la preuve n'est pas apportée qu'une décision passée en force de chose jugée est intervenue, l'Office européen des brevets peut reprendre la procédure.

¹³ Cf. la décision du Président de l'OEB, en date du 10.03.1989, relative à la compétence de la division juridique (JO OEB 1989, 177 s.) et le communiqué du Vice-Président chargé de la DG 5 de l'OEB, en date du 05.07.1990, relatif à la correspondance avec la division juridique (JO OEB 1990, 404 s.).

¹⁴ Cf. la décision de la Grande Chambre de recours G 3/92 (Annexe I).

(4) Weist ein Dritter dem Europäischen Patentamt während eines Einspruchsverfahrens oder während der Einspruchsfrist nach, dass er gegen den Inhaber des europäischen Patents ein Verfahren eingeleitet hat, in dem das europäische Patent ihm zugesprochen werden soll, so setzt das Europäische Patentamt das Einspruchsverfahren aus, es sei denn, dass der Dritte der Fortsetzung des Verfahrens zustimmt. Diese Zustimmung ist dem Europäischen Patentamt schriftlich zu erklären; sie ist unwiderruflich. Die Aussetzung darf jedoch erst angeordnet werden, wenn die Einspruchsabteilung den Einspruch für zulässig hält. Die Absätze 2 und 3 sind entsprechend anzuwenden.

(5) Die am Tag der Aussetzung laufenden Fristen mit Ausnahme der Fristen zur Zahlung der Jahresgebühren werden durch die Aussetzung gehemmt. An dem Tag der Fortsetzung des Verfahrens beginnt der noch nicht verstrichene Teil einer Frist zu laufen; die nach Fortsetzung des Verfahrens verbleibende Frist beträgt jedoch mindestens zwei Monate.

Regel 14¹⁵

Beschränkung der Zurücknahme der europäischen Patentanmeldung

Von dem Tag an, an dem ein Dritter dem Europäischen Patentamt nachweist, dass er ein Verfahren zur Geltendmachung des Anspruchs auf Erteilung des europäischen Patents eingeleitet hat, bis zu dem Tag, an dem das Europäische Patentamt das Erteilungsverfahren fortsetzt, darf weder die europäische Patentanmeldung noch die Benennung eines Vertragsstaats zurückgenommen werden.

Regel 15¹⁶

Einreichung einer neuen europäischen Patentanmeldung durch den Berechtigten

(1) Reicht die Person, der durch rechtskräftige Entscheidung der Anspruch auf Erteilung des europäischen Patents zugesprochen worden ist, nach Artikel 61 Absatz 1 Buchstabe b eine neue europäische Patentanmeldung ein, so gilt die frühere europäische Patentanmeldung für die in ihr benannten Vertragsstaaten, in denen die Entscheidung ergangen oder anerkannt worden ist, mit dem Tag der Einreichung der neuen europäischen Patentanmeldung als zurückgenommen.

(2)¹⁷ Für die neue europäische Patentanmeldung sind innerhalb eines Monats nach ihrer Einreichung die Anmeldegebühr und die Recherchegebühr zu entrichten. Die Benennungsgebühren sind innerhalb von sechs Monaten nach dem Tag zu entrichten, an dem im Europäischen Patentblatt auf die Veröffentlichung des europäischen Recherchenberichts zu der neuen europäischen Patentanmeldung hingewiesen worden ist.

¹⁵ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/92 (Anhang I).

¹⁶ Siehe hierzu Entscheidung/Stellungnahme der Großen Beschwerdekammer G 3/92, G 4/98 (Anhang I).

¹⁷ Geändert durch Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABI. EPA 1999, 660 ff.).

(4) If a third party provides proof to the European Patent Office during opposition proceedings or during the opposition period that he has opened proceedings against the proprietor of the European patent for the purpose of seeking a judgment that he is entitled to the European patent, the European Patent Office shall stay the opposition proceedings unless the third party consents to the continuation of such proceedings. Such comment must be communicated in writing to the European Patent Office; it shall be irrevocable. However, the suspension of the proceedings may not be ordered until the Opposition Division has deemed the opposition admissible. Paragraphs 2 and 3 shall apply *mutatis mutandis*.

(5) The time limits in force at the date of suspension other than time limits for payment of renewal fees shall be interrupted by such suspension. The time which has not yet elapsed shall begin to run as from the date on which proceedings are resumed; however, the time still to run after the resumption of the proceedings shall not be less than two months.

Rule 14¹⁵

Limitation of the option to withdraw the European patent application

As from the time when a third party proves to the European Patent Office that he has initiated proceedings concerning entitlement and up to the date on which the European Patent Office resumes the proceedings for grant, neither the European patent application nor the designation of any Contracting State may be withdrawn.

Rule 15¹⁶

Filing of a new European patent application by the person entitled to apply

(1) Where the person adjudged by a final decision to be entitled to the grant of the European patent files a new European patent application pursuant to Article 61, paragraph 1(b), the original European patent application shall be deemed to be withdrawn on the date of filing of the new application for the Contracting States designated therein in which the decision has been taken or recognised.

(2)¹⁷ The filing fee and search fee shall be payable in respect of the new European patent application within one month after the filing thereof. The designation fees shall be payable within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the new European patent application.

¹⁵ See decision of the Enlarged Board of Appeal G 3/92 (Annex I).

¹⁶ See decision/opinion of the Enlarged Board of Appeal G 3/92, G 4/98 (Annex I).

¹⁷ Amended by decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.).

(4) Si, lors d'une procédure d'opposition ou au cours du délai d'opposition, un tiers apporte à l'Office européen des brevets la preuve qu'il a introduit une procédure contre le titulaire du brevet européen à l'effet d'établir que le droit au brevet européen lui appartient, l'Office suspend la procédure d'opposition, à moins que ce tiers ne consente à la poursuite de la procédure. Ce consentement doit être déclaré par écrit à l'Office européen des brevets; il est irrévocable. Toutefois, la suspension ne doit être décidée que lorsque la division d'opposition considère l'opposition recevable. Les paragraphes 2 et 3 sont applicables.

(5) La suspension de la procédure entraîne celle des délais qui courent, à l'exception de ceux qui s'appliquent au paiement des taxes annuelles. La partie du délai non encore expirée commence à courir à la date de la reprise de la procédure; toutefois, le délai restant à courir après la reprise de la procédure ne peut être inférieur à deux mois.

*Règle 14*¹⁵

Limitation de la faculté de retirer la demande de brevet européen

Verweisungen / References / Références

Art. 61, 79

A compter du jour où un tiers apporte la preuve à l'Office européen des brevets qu'il a introduit une procédure portant sur le droit à l'obtention du brevet, et jusqu'au jour où l'Office européen des brevets reprend la procédure de délivrance, ni la demande de brevet européen ni la désignation de tout Etat contractant ne peuvent être retirées.

*Règle 15*¹⁶

Dépôt d'une nouvelle demande de brevet européen par la personne habilitée

Art. 78
R. 16, 85a/bis

(1) Si la personne à laquelle a été reconnu le droit à l'obtention du brevet européen en vertu d'une décision passée en force de chose jugée dépose une nouvelle demande de brevet européen, en application de l'article 61, paragraphe 1, lettre b), la demande de brevet européen initiale est réputée retirée à compter du dépôt de la nouvelle demande, en ce qui concerne les Etats contractants désignés pour lesquels la décision a été rendue ou reconnue.

(2)¹⁷ La taxe de dépôt et la taxe de recherche doivent être acquittées pour la nouvelle demande de brevet européen dans le délai d'un mois à compter de son dépôt. Les taxes de désignation doivent être acquittées dans un délai de six mois à compter de la date à laquelle le Bulletin européen des brevets a mentionné la publication du rapport de recherche européenne établi pour la nouvelle demande de brevet européen.

¹⁵ Cf. la décision de la Grande Chambre de recours G 3/92 (Annexe I).

¹⁶ Cf. la décision/l'avis de la Grande Chambre de recours G 3/92, G 4/98 (Annexe I).

¹⁷ Modifié par décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

(3) Die in Artikel 77 Absätze 3 und 5 vorgeschriebenen Fristen für die Weiterleitung europäischer Patentanmeldungen betragen für die neue europäische Patentanmeldung vier Monate nach Einreichung dieser Anmeldung.

*Regel 16*¹⁸

Teilweiser Rechtsübergang auf Grund einer Entscheidung

(1) Ergibt sich aus einer rechtskräftigen Entscheidung, dass einem Dritten der Anspruch auf Erteilung eines europäischen Patents nur für einen Teil des in der europäischen Patentanmeldung offenbarten Gegenstands zugesprochen worden ist, so sind für diesen Teil Artikel 61 und Regel 15 entsprechend anzuwenden.

(2) Erforderlichenfalls hat die frühere europäische Patentanmeldung für die benannten Vertragsstaaten, in denen die Entscheidung ergangen oder anerkannt worden ist, und für die übrigen benannten Vertragsstaaten unterschiedliche Patentansprüche, Beschreibungen und Zeichnungen zu enthalten.

(3) Ist ein Dritter nach Artikel 99 Absatz 5 in Bezug auf einen oder mehrere Vertragsstaaten an die Stelle des bisherigen Patentinhabers getreten, so kann das im Einspruchsverfahren aufrechterhaltene europäische Patent für diesen Staat oder diese Staaten unterschiedliche Patentansprüche, Beschreibungen und Zeichnungen enthalten.

Kapitel II

Erfindernennung

Regel 17

Einreichung der Erfindernennung

(1) Die Erfindernennung hat in dem Antrag auf Erteilung eines europäischen Patents zu erfolgen. Ist jedoch der Anmelder nicht oder nicht allein der Erfinder, so ist die Erfindernennung in einem gesonderten Schriftstück einzureichen; sie muss den Namen, die Vornamen und die vollständige Anschrift des Erfinders, die in Artikel 81 genannte Erklärung und die Unterschrift des Anmelders oder Vertreters enthalten.

(2) Die Richtigkeit der Erfindernennung wird vom Europäischen Patentamt nicht geprüft.

(3)¹⁹ Ist der Anmelder nicht oder nicht allein der Erfinder, so teilt das Europäische Patentamt dem genannten Erfinder die in der Erfindernennung enthaltenen und die weiteren in Artikel 128 Absatz 5 vorgesehenen Angaben mit.

¹⁸ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/92 (Anhang I).

¹⁹ Geändert durch Beschluss des Verwaltungsrats vom 08.12.1988, in Kraft getreten am 01.04.1989 (ABI. EPA 1989, 1).

(3) The time limits for forwarding European patent applications provided for in Article 77, paragraphs 3 and 5, shall, for the new European patent application, be four months as from the actual filing date of that application.

*Rule 16*¹⁸

Partial transfer of right by virtue of a final decision

(1) If by a final decision it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, Article 61 and Rule 15 shall apply *mutatis mutandis* to such part.

(2) Where appropriate, the original European patent application shall contain, for the designated Contracting States in which the decision was taken or recognised, claims, a description and drawings which are different from those for the other designated Contracting States.

(3) Where a third party has, in accordance with Article 99, paragraph 5, replaced the previous proprietor for one or some of the designated Contracting States, the patent as maintained in opposition proceedings may contain for these States claims, a description and drawings which are different from those for the other designated Contracting States.

Chapter II

Mention of the inventor

Rule 17

Designation of the inventor

(1) The designation of the inventor shall be filed in the request for the grant of a European patent. However, if the applicant is not the inventor or is not the sole inventor, the designation shall be filed in a separate document; the designation must state the family name, given names and full address of the inventor and the statement referred to in Article 81 and shall bear the signature of the applicant or his representative.

(2) The European Patent Office shall not verify the accuracy of the designation of the inventor.

(3)¹⁹ If the applicant is not the inventor or is not the sole inventor, the European Patent Office shall inform the designated inventor of the data in the document designating him and the further data mentioned in Article 128, paragraph 5.

¹⁸ See decision of the Enlarged Board of Appeal G 3/92 (Annex I).

¹⁹ Amended by decision of the Administrative Council of 08.12.1988 which entered into force on 01.04.1989 (OJ EPO 1989, 1).

(3) Les délais pour la transmission des demandes de brevet européen prescrits à l'article 77, paragraphes 3 et 5, sont de quatre mois à compter de la date de dépôt effective de la nouvelle demande.

Verweisungen / References / Références

*Règle 16*¹⁸

Transfert partiel du droit au brevet européen en vertu d'un jugement

Art. 102, 123

(1) Si une décision passée en force de chose jugée a reconnu le droit à l'obtention du brevet européen à un tiers pour une partie seulement de l'objet de la demande de brevet européen, l'article 61 ainsi que la règle 15 sont applicables en ce qui concerne la partie en cause.

(2) S'il y a lieu, la demande de brevet européen initiale comporte, pour les Etats contractants désignés dans lesquels le jugement a été rendu ou est reconnu, des revendications, une description et des dessins différents de ceux que la demande comporte pour d'autres Etats contractants désignés.

(3) Si un tiers a été substitué, en vertu de l'article 99, paragraphe 5, au titulaire précédent pour un ou plusieurs Etats contractants désignés, le brevet européen maintenu dans la procédure d'opposition peut contenir pour ces Etats contractants des revendications, une description et des dessins différents de ceux que le brevet comporte pour d'autres Etats contractants désignés.

Chapitre II

Mention de l'inventeur

Règle 17

Désignation de l'inventeur

Art. 62, 81

R. 19, 42, 111

(1) La désignation de l'inventeur doit être effectuée dans la requête en délivrance du brevet européen. Toutefois, si le demandeur n'est pas l'inventeur ou l'unique inventeur, cette désignation doit être effectuée dans un document produit séparément; elle doit comporter le nom, les prénoms et l'adresse complète de l'inventeur, la déclaration mentionnée à l'article 81 et la signature du demandeur ou celle de son mandataire.

(2) L'Office européen des brevets ne contrôle pas l'exactitude de la désignation de l'inventeur.

(3)¹⁹ Si le demandeur n'est pas l'inventeur ou l'unique inventeur, l'Office européen des brevets informe l'inventeur désigné des indications contenues dans la désignation et des autres indications prévues à l'article 128, paragraphe 5.

¹⁸ Cf. la décision de la Grande Chambre de recours G 3/92 (Annexe I).

¹⁹ Modifié par décision du Conseil d'administration en date du 08.12.1988, entrée en vigueur le 01.04.1989 (JO OEB 1989, 1).

(4) Der Anmelder und der Erfinder können aus der Unterlassung der Mitteilung nach Absatz 3 und aus in ihr enthaltenen Fehlern keine Ansprüche herleiten.

*Regel 18*²⁰

Bekanntmachung der Erfindernennung

(1) Die als Erfinder genannte Person wird auf der veröffentlichten europäischen Patentanmeldung und auf der europäischen Patentschrift als Erfinder vermerkt, sofern sie dem Europäischen Patentamt gegenüber nicht schriftlich auf das Recht verzichtet, als Erfinder bekannt gemacht zu werden.

(2) Reicht ein Dritter beim Europäischen Patentamt eine rechtskräftige Entscheidung ein, aus der hervorgeht, dass der Anmelder oder Patentinhaber verpflichtet ist, ihn als Erfinder zu nennen, so ist Absatz 1 entsprechend anzuwenden.

Regel 19

Berichtigung der Erfindernennung

(1) Eine unrichtige Erfindernennung kann nur auf Antrag berichtigt werden; mit dem Antrag ist die Zustimmungserklärung des zu Unrecht als Erfinder Genannten und, wenn der Antrag nicht vom Anmelder oder Patentinhaber eingereicht wird, dessen Zustimmungserklärung einzureichen. Regel 17 ist entsprechend anzuwenden.

(2)²¹ Ist eine unrichtige Erfindernennung im europäischen Patentregister vermerkt oder im Europäischen Patentblatt bekannt gemacht, so wird diese Eintragung oder diese Bekanntmachung berichtigt.

(3) Absatz 2 ist auf den Widerruf einer unrichtigen Erfindernennung entsprechend anzuwenden.

(4) The applicant and the inventor may invoke neither the omission of the notification under paragraph 3 nor any errors contained therein.

*Rule 18*²⁰

Publication of the mention of the inventor

(1) The person designated as the inventor shall be mentioned as such in the published European patent application and the European patent specification, unless the said person informs the European Patent Office in writing that he waives his right to be thus mentioned.

(2) In the event of a third party filing with the European Patent Office a final decision whereby the applicant for or proprietor of a patent is required to designate him as the inventor, the provisions of paragraph 1 shall apply.

Rule 19

Rectification of the designation of an inventor

(1) An incorrect designation of an inventor may not be rectified save upon request, accompanied by the consent of the wrongly designated person and, in the event of such request not being filed by the applicant for or proprietor of the European patent, by the consent of that party. The provisions of Rule 17 shall apply mutatis mutandis.

(2)²¹ In the event of an incorrect mention of the inventor having been entered in the Register of European Patents or published in the European Patent Bulletin such entry or publication shall be corrected.

(3) Paragraph 2 shall apply mutatis mutandis to the cancellation of an incorrect designation of the inventor.

²⁰ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.).

²¹ Geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABl. EPA 1991, 4 ff.).

²⁰ Last amended by decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff).

²¹ Amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff).

(4) Le demandeur ou l'inventeur ne peuvent se prévaloir ni de l'omission de la notification visée au paragraphe 3 ni des erreurs dont elle pourrait être entachée.

Verweisungen / References / Références

*Règle 18*²⁰

Publication de la désignation de l'inventeur

Art. 62, 81, 93, 98, 103

R. 93

(1) La personne désignée comme inventeur est mentionnée en cette qualité dans les publications de la demande de brevet européen et dans les fascicules du brevet européen, à moins qu'elle ne déclare par écrit à l'Office européen des brevets qu'elle renonce au droit d'être mentionnée en tant qu'inventeur.

(2) Lorsqu'un tiers produit à l'Office européen des brevets une décision passée en force de chose jugée en vertu de laquelle le demandeur ou le titulaire du brevet est tenu de le désigner comme inventeur, les dispositions du paragraphe 1 sont applicables.

Règle 19

Rectification de la désignation de l'inventeur

Art. 62, 81, 93, 98, 103, 127, 129

(1) Une désignation erronée de l'inventeur ne peut être rectifiée que sur requête accompagnée du consentement de la personne désignée à tort, et, si la requête n'est pas présentée par le demandeur ou le titulaire du brevet européen, du consentement de l'un ou de l'autre. Les dispositions de la règle 17 sont applicables.

(2)²¹ Si une désignation erronée de l'inventeur a été inscrite au Registre européen des brevets ou publiée au Bulletin européen des brevets, cette inscription ou publication est rectifiée.

(3) Les dispositions du paragraphe 2 sont applicables à l'annulation d'une désignation erronée de l'inventeur.

²⁰ Modifiée en dernier lieu par décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

²¹ Modifié par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.).

Eintragung von Rechtsübergängen sowie von Lizenzen und anderen Rechten*Regel 20*^{22/23}

Eintragung von Rechtsübergängen

(1) Ein Rechtsübergang der europäischen Patentanmeldung wird auf Antrag eines Beteiligten in das europäische Patentregister eingetragen, wenn er dem Europäischen Patentamt durch Vorlage von Urkunden nachgewiesen wird.

(2) Der Eintragungsantrag gilt erst als gestellt, wenn eine Verwaltungsgebühr entrichtet worden ist. Er kann nur zurückgewiesen werden, wenn die in Absatz 1 vorgeschriebenen Voraussetzungen nicht erfüllt sind.

(3) Ein Rechtsübergang wird dem Europäischen Patentamt gegenüber erst und nur insoweit wirksam, als er ihm durch Vorlage von Urkunden nach Absatz 1 nachgewiesen wird.

*Regel 21*²⁴

Eintragung von Lizenzen und anderen Rechten

(1) Regel 20 Absätze 1 und 2 ist auf die Eintragung der Erteilung oder des Übergangs einer Lizenz sowie auf die Eintragung der Begründung oder des Übergangs eines dinglichen Rechts an einer europäischen Patentanmeldung und auf die Eintragung von Zwangsvollstreckungsmaßnahmen in eine solche Anmeldung entsprechend anzuwenden.

(2) Die in Absatz 1 genannten Eintragungen werden auf Antrag gelöscht; der Antrag gilt erst als gestellt, wenn eine Verwaltungsgebühr entrichtet worden ist. Dem Antrag sind Urkunden, aus denen sich ergibt, dass das Recht nicht mehr besteht, oder eine Erklärung des Rechtsinhabers darüber beizufügen, dass er in die Löschung der Eintragung einwilligt; der Antrag darf nur zurückgewiesen werden, wenn diese Voraussetzungen nicht erfüllt sind.

²² Geändert durch Beschluss des Verwaltungsrats vom 13.12.1994, in Kraft getreten am 01.06.1995 (ABI. EPA 1995, 9 ff.).

²³ Siehe hierzu den Beschluss des Präsidenten des EPA vom 10.03.1989 über die Zuständigkeit der Rechtsabteilung (ABI. EPA 1989, 177 f.) und die Mitteilung des Vizepräsidenten Generaldirektion 5 des EPA vom 05.07.1990 über den Schriftverkehr mit der Rechtsabteilung (ABI. EPA 1990, 404 f.).

²⁴ Siehe hierzu den Beschluss des Präsidenten des EPA vom 10.03.1989 über die Zuständigkeit der Rechtsabteilung (ABI. EPA 1989, 177 f.) und die Mitteilung des Vizepräsidenten Generaldirektion 5 des EPA vom 05.07.1990 über den Schriftverkehr mit der Rechtsabteilung (ABI. EPA 1990, 404 f.).

Registering transfers, licences and other rights*Rule 20*^{22/23}

Registering a transfer

(1) A transfer of a European patent application shall be recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the European Patent Office that the transfer has taken place.

(2) The request shall not be deemed to have been filed until such time as an administrative fee has been paid. It may be rejected only in the event of failure to comply with the conditions laid down in paragraph 1.

(3) A transfer shall have effect vis-à-vis the European Patent Office only when and to the extent that the documents referred to in paragraph 1 have been produced.

*Rule 21*²⁴

Registering of licences and other rights

(1) Rule 20, paragraphs 1 and 2, shall apply mutatis mutandis to the registration of the grant or transfer of a licence, the establishment or transfer of a right in rem in respect of a European patent application and any legal means of execution of such an application.

(2) The registration referred to in paragraph 1 shall be cancelled upon request, which shall not be deemed to have been filed until an administrative fee has been paid. Such request shall be supported either by documents establishing that the right has lapsed, or by a declaration whereby the proprietor of the right consents to the cancellation of the registration; it may be rejected only if these conditions are not fulfilled.

²² Amended by decision of the Administrative Council of 13.12.1994 which entered into force on 01.06.1995 (OJ EPO 1995, 9 ff.).

²³ See decision of the President of the EPO dated 10.03.1989 concerning the responsibilities of the Legal Division (OJ EPO 1989, 177 f) and the notice of the Vice-President, DG 5 of the EPO dated 05.07.1990 concerning correspondence with the Legal Division (OJ EPO 1990, 404 f.).

²⁴ See decision of the President of the EPO dated 10.03.1989 concerning the responsibilities of the Legal Division (OJ EPO 1989, 177 f) and the notice of the Vice-President, DG 5 of the EPO dated 05.07.1990 concerning correspondence with the Legal Division (OJ EPO 1990, 404 f.).

Inscription au Registre des transferts, licences et autres droits

Règle 20^{22/23}

Inscription des transferts

(1) Un transfert de demande de brevet européen est inscrit au Registre européen des brevets à la requête de toute partie intéressée, si des documents prouvant ce transfert ont été fournis à l'Office européen des brevets.

(2) La requête n'est réputée présentée qu'après le paiement d'une taxe d'administration. Elle ne peut être rejetée que si les conditions prescrites au paragraphe 1 ne sont pas remplies.

(3) Un transfert n'a d'effet à l'égard de l'Office européen des brevets qu'à partir du moment et dans la mesure où les documents visés au paragraphe 1 lui ont été fournis.

Art. 71, 127
R. 21, 61

Règle 21²⁴

Inscription de licences et d'autres droits

(1) Les dispositions de la règle 20, paragraphes 1 et 2 sont applicables à l'inscription de la concession ou du transfert d'une licence ainsi qu'à l'inscription de la constitution ou du transfert d'un droit réel sur une demande de brevet européen et de l'exécution forcée sur une telle demande.

(2) Les inscriptions visées au paragraphe 1 sont radiées sur requête; elle n'est réputée déposée qu'après paiement d'une taxe d'administration. La requête doit être accompagnée, soit des documents établissant que le droit s'est éteint, soit d'une déclaration par laquelle le titulaire du droit consent à la radiation de l'inscription; elle ne peut être rejetée que si ces conditions ne sont pas remplies.

Art. 71, 73, 127

²² Modifiée par décision du Conseil d'administration en date du 13.12.1994, entrée en vigueur le 01.06.1995 (JO OEB 1995, 9 s.).

²³ Cf. la décision du Président de l'OEB, en date du 10.03.1989, relative à la compétence de la division juridique (JO OEB 1989, 177 s.) et le communiqué du Vice-Président chargé de la DG 5 de l'OEB, en date du 05.07.1990, relatif à la correspondance avec la division juridique (JO OEB 1990, 404 s.).

²⁴ Cf. la décision du Président de l'OEB, en date du 10.03.1989, relative à la compétence de la division juridique (JO OEB 1989, 177 s.) et le communiqué du Vice-Président chargé de la DG 5 de l'OEB, en date du 05.07.1990, relatif à la correspondance avec la division juridique (JO OEB 1990, 404 s.).

*Regel 22*²⁵

Besondere Angaben bei der Eintragung von Lizenzen

(1) Eine Lizenz an einer europäischen Patentanmeldung wird im europäischen Patentregister als ausschließliche Lizenz bezeichnet, wenn der Anmelder und der Lizenznehmer dies beantragen.

(2) Eine Lizenz an einer europäischen Patentanmeldung wird im europäischen Patentregister als Unterlizenz bezeichnet, wenn sie von einem Lizenznehmer erteilt wird, dessen Lizenz im europäischen Patentregister eingetragen ist.

Kapitel IV

Ausstellungsbescheinigung

*Regel 23*²⁶

Ausstellungsbescheinigung

Der Anmelder muss innerhalb von vier Monaten nach Einreichung der europäischen Patentanmeldung die in Artikel 55 Absatz 2 genannte Bescheinigung einreichen, die während der Ausstellung von der Stelle erteilt wird, die für den Schutz des gewerblichen Eigentums auf dieser Ausstellung zuständig ist, und in der bestätigt wird, dass die Erfindung dort tatsächlich ausgestellt worden ist. In dieser Bescheinigung ist ferner der Tag der Eröffnung der Ausstellung und, wenn die erstmalige Offenbarung der Erfindung nicht mit dem Eröffnungstag der Ausstellung zusammenfällt, der Tag der erstmaligen Offenbarung anzugeben. Der Bescheinigung muss eine Darstellung der Erfindung beigelegt sein, die mit einem Beglaubigungsvermerk der vorstehend genannten Stelle versehen ist.

Kapitel V²⁷

Frühere europäische Anmeldungen

Regel 23a

Frühere Anmeldung als Stand der Technik

Eine europäische Patentanmeldung gilt nur dann als Stand der Technik nach Artikel 54 Absätze 3 und 4, wenn die Benennungsgebühren nach Artikel 79 Absatz 2 wirksam entrichtet worden sind.

*Rule 22*²⁵

Special indications for the registration of a licence

(1) A licence in respect of a European patent application shall be recorded in the Register of European Patents as an exclusive licence if the applicant and the licensee so require.

(2) A licence in respect of a European patent application shall be recorded in the Register of European Patents as a sub-licence where it is granted by a licensee whose licence is recorded in the said Register.

Chapter IV

Certification of exhibition

*Rule 23*²⁶

Certificate of exhibition

The applicant must, within four months of the filing of the European patent application, file the certificate referred to in Article 55, paragraph 2, issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition, and stating that the invention was in fact exhibited there. This certificate shall also state the opening date of the exhibition and, where the first disclosure of the invention did not coincide with the opening date of the exhibition, the date of the first disclosure. This certificate must be accompanied by an identification of the invention, duly authenticated by the above-mentioned authority.

Chapter V²⁷

Prior European applications

Rule 23a

Prior application as state of the art

A European patent application shall be considered as comprised in the state of the art under Article 54, paragraphs 3 and 4, only if the designation fees under Article 79, paragraph 2, have been validly paid.

²⁵ Siehe hierzu den Beschluss des Präsidenten des EPA vom 10.03.1989 über die Zuständigkeit der Rechtsabteilung (ABI. EPA 1989, 177 f.) und die Mitteilung des Vizepräsidenten Generaldirektion 5 des EPA vom 05.07.1990 über den Schriftverkehr mit der Rechtsabteilung (ABI. EPA 1990, 404 f.).

²⁶ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 3/98, G 2/99 (Anhang I).

²⁷ Eingefügt durch Beschluss des Verwaltungsrats vom 05.12.1996, in Kraft getreten am 01.07.1997 (ABI. EPA 1997, 13 f.).

²⁵ See decision of the President of the EPO dated 10.03.1989 concerning the responsibilities of the Legal Division (OJ EPO 1989, 177 f) and the notice of the Vice-President DG 5 of the EPO dated 05.07.1990 concerning correspondence with the Legal Division (OJ EPO 1990, 404 f.).

²⁶ See decisions of the Enlarged Board of Appeal G 3/98, G 2/99 (Annex I).

²⁷ Inserted by decision of the Administrative Council of 05.12.1996, which entered into force on 01.07.1997 (OJ EPO 1997, 13 f.).

Indications spéciales pour l'inscription d'une licence

Art. 73, 127

(1) Une licence d'une demande de brevet européen est inscrite au Registre européen des brevets en tant que licence exclusive si le demandeur et le licencié le requièrent.

(2) Une licence d'une demande de brevet européen est inscrite au Registre européen des brevets en tant que sous-licence, lorsqu'elle est concédée par le titulaire d'une licence inscrite audit registre.

Chapitre IV

Attestations d'exposition

Règle 23²⁶

Attestation d'exposition

R. 107

Le demandeur doit, dans un délai de quatre mois à compter du dépôt de la demande de brevet européen, produire l'attestation visée à l'article 55, paragraphe 2, délivrée au cours de l'exposition par l'autorité chargée d'assurer la protection de la propriété industrielle dans cette exposition et constatant que l'invention y a été réellement exposée. Cette attestation doit, en outre, mentionner la date d'ouverture de l'exposition et, le cas échéant, celle de la première divulgation de l'invention si ces deux dates ne coïncident pas. L'attestation doit être accompagnée des pièces permettant d'identifier l'invention, revêtues d'une mention d'authenticité par l'autorité susvisée.

Chapitre V²⁷

Demandes européennes antérieures

Règle 23bis

Demande antérieure en tant qu'état de la technique

Une demande de brevet européen n'est considérée comme comprise dans l'état de la technique au sens de l'article 54, paragraphes 3 et 4, que si les taxes de désignation visées à l'article 79, paragraphe 2 ont été valablement acquittées.

²⁵ Cf. la décision du Président de l'OEB, en date du 10.03.1989, relative à la compétence de la division juridique (JO OEB 1989, 177 s.) et le communiqué du Vice-Président chargé de la DG 5 de l'OEB, en date du 05.07.1990, relatif à la correspondance avec la division juridique (JO OEB 1990, 404 s.).

²⁶ Cf. les décisions de la Grande Chambre de recours G 3/98, G 2/99 (Annexe I).

²⁷ Inséré par décision du Conseil d'administration en date du 05.12.1996, entrée en vigueur le 01.07.1997 (JO OEB 1997, 13 s.).

Biotechnologische Erfindungen*Regel 23b* ²⁹

Allgemeines und Begriffsbestimmungen

(1) Für europäische Patentanmeldungen und Patente, die biotechnologische Erfindungen zum Gegenstand haben, sind die maßgebenden Bestimmungen des Übereinkommens in Übereinstimmung mit den Vorschriften dieses Kapitels anzuwenden und auszulegen. Die Richtlinie 98/44/EG vom 6. Juli 1998³⁰ über den rechtlichen Schutz biotechnologischer Erfindungen ist hierfür ergänzend heranzuziehen.

(2) "Biotechnologische Erfindungen" sind Erfindungen, die ein Erzeugnis, das aus biologischem Material besteht oder dieses enthält, oder ein Verfahren, mit dem biologisches Material hergestellt, bearbeitet oder verwendet wird, zum Gegenstand haben.

(3) "Biologisches Material" ist jedes Material, das genetische Informationen enthält und sich selbst reproduzieren oder in einem biologischen System reproduziert werden kann.

(4) "Pflanzensorte" ist jede pflanzliche Gesamtheit innerhalb eines einzigen botanischen Taxons der untersten bekannten Rangstufe, die unabhängig davon, ob die Bedingungen für die Erteilung des Sortenschutzes vollständig erfüllt sind,

a) durch die sich aus einem bestimmten Genotyp oder einer bestimmten Kombination von Genotypen ergebende Ausprägung der Merkmale definiert,

b) zumindest durch die Ausprägung eines der erwähnten Merkmale von jeder anderen pflanzlichen Gesamtheit unterschieden und

c) in Anbetracht ihrer Eignung, unverändert vermehrt zu werden, als Einheit angesehen werden kann.

(5) Ein Verfahren zur Züchtung von Pflanzen oder Tieren ist im Wesentlichen biologisch, wenn es vollständig auf natürlichen Phänomenen wie Kreuzung oder Selektion beruht.

(6) "Mikrobiologisches Verfahren" ist jedes Verfahren, bei dem mikrobiologisches Material verwendet, ein Eingriff in mikrobiologisches Material durchgeführt oder mikrobiologisches Material hervorgebracht wird.

Biotechnological inventions*Rule 23b* ²⁹

General and definitions

(1) For European patent applications and patents concerning biotechnological inventions, the relevant provisions of the Convention shall be applied and interpreted in accordance with the provisions of this chapter. Directive 98/44/EC of 6 July 1998³⁰ on the legal protection of biotechnological inventions shall be used as a supplementary means of interpretation.

(2) "Biotechnological inventions" are inventions which concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used.

(3) "Biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system.

(4) "Plant variety" means any plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a plant variety right are fully met, can be:

(a) defined by the expression of the characteristics that results from a given genotype or combination of genotypes,

(b) distinguished from any other plant grouping by the expression of at least one of the said characteristics, and

(c) considered as a unit with regard to its suitability for being propagated unchanged.

(5) A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection.

(6) "Microbiological process" means any process involving or performed upon or resulting in microbiological material.

²⁸ Eingefügt durch Beschluss des Verwaltungsrats vom 16.06.1999, in Kraft getreten am 01.09.1999 (ABl. EPA 1999, 437 f.).

²⁹ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 1/98 (Anhang I).

³⁰ Siehe ABl. EPA 1999, 101.

²⁸ Inserted by decision of the Administrative Council of 16.06.1999, which entered into force on 01.09.1999 (OJ EPO 1999, 437 ff).

²⁹ See decision of the Enlarged Board of Appeal G 1/98 (Annex I).

³⁰ See OJ EPO 1999, 101.

Inventions biotechnologiques*Règle 23ter* ²⁹

Généralités et définitions

Art. 52, 53

R. 28

(1) Pour les demandes de brevet européen et les brevets européens qui ont pour objet des inventions biotechnologiques, les dispositions pertinentes de la convention sont appliquées et interprétées conformément aux prescriptions du présent chapitre. La directive 98/44/CE du 6 juillet 1998³⁰ relative à la protection juridique des inventions biotechnologiques constitue un moyen complémentaire d'interprétation.

(2) Les "inventions biotechnologiques" sont des inventions qui portent sur un produit composé de matière biologique ou en contenant, ou sur un procédé permettant de produire, de traiter ou d'utiliser de la matière biologique.

(3) On entend par "matière biologique" toute matière contenant des informations génétiques et qui est auto-reproductible ou reproductible dans un système biologique.

(4) On entend par "variété végétale" tout ensemble végétal d'un seul taxon botanique du rang le plus bas connu qui, qu'il réponde ou non pleinement aux conditions d'octroi d'une protection des obtentions végétales, peut :

a) être défini par l'expression des caractères résultant d'un certain génotype ou d'une certaine combinaison de génotypes,

b) être distingué de tout autre ensemble végétal par l'expression d'au moins un desdits caractères et

c) être considéré comme une entité eu égard à son aptitude à être reproduit sans changement.

(5) Un procédé d'obtention de végétaux ou d'animaux est essentiellement biologique s'il consiste intégralement en des phénomènes naturels tels que le croisement ou la sélection.

(6) On entend par "procédé microbiologique" tout procédé utilisant une matière microbiologique, comportant une intervention sur une matière microbiologique ou produisant une matière microbiologique.

²⁸ Inséré par décision du Conseil d'administration en date du 16.06.1999, entrée en vigueur le 01.09.1999 (JO OEB 1999, 437s.).

²⁹ Cf. la décision de la Grande Chambre de recours G 1/98 (Annexe I).

³⁰ Cf. JO OEB 1999, 101.

Regel 23c

Patentierbare biotechnologische Erfindungen

Biotechnologische Erfindungen sind auch dann patentierbar, wenn sie zum Gegenstand haben:

- a) biologisches Material, das mit Hilfe eines technischen Verfahrens aus seiner natürlichen Umgebung isoliert oder hergestellt wird, auch wenn es in der Natur schon vorhanden war;
- b) Pflanzen oder Tiere, wenn die Ausführung der Erfindung technisch nicht auf eine bestimmte Pflanzensorte oder Tierrasse beschränkt ist;
- c) ein mikrobiologisches oder sonstiges technisches Verfahren oder ein durch diese Verfahren gewonnenes Erzeugnis, sofern es sich dabei nicht um eine Pflanzensorte oder Tierrasse handelt.

Regel 23d

Ausnahmen von der Patentierbarkeit

Nach Artikel 53 Buchstabe a werden europäische Patente insbesondere nicht erteilt für biotechnologische Erfindungen, die zum Gegenstand haben:

- a) Verfahren zum Klonen von menschlichen Lebewesen;
- b) Verfahren zur Veränderung der genetischen Identität der Keimbahn des menschlichen Lebewesens;
- c) die Verwendung von menschlichen Embryonen zu industriellen oder kommerziellen Zwecken;
- d) Verfahren zur Veränderung der genetischen Identität von Tieren, die geeignet sind, Leiden dieser Tiere ohne wesentlichen medizinischen Nutzen für den Menschen oder das Tier zu verursachen, sowie die mit Hilfe solcher Verfahren erzeugten Tiere.

Regel 23e

Der menschliche Körper und seine Bestandteile

(1) Der menschliche Körper in den einzelnen Phasen seiner Entstehung und Entwicklung sowie die bloße Entdeckung eines seiner Bestandteile, einschließlich der Sequenz oder Teilsequenz eines Gens, können keine patentierbaren Erfindungen darstellen.

(2) Ein isolierter Bestandteil des menschlichen Körpers oder ein auf andere Weise durch ein technisches Verfahren gewonnener Bestandteil, einschließlich der Sequenz oder Teilsequenz eines Gens, kann eine patentierbare Erfindung sein, selbst wenn der Aufbau dieses Bestandteils mit dem Aufbau eines natürlichen Bestandteils identisch ist.

(3) Die gewerbliche Anwendbarkeit einer Sequenz oder Teilsequenz eines Gens muss in der Patentanmeldung konkret beschrieben werden.

Rule 23c

Patentable biotechnological inventions

Biotechnological inventions shall also be patentable if they concern:

- (a) biological material which is isolated from its natural environment or produced by means of a technical process even if it previously occurred in nature;
- (b) plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety;
- (c) a microbiological or other technical process, or a product obtained by means of such a process other than a plant or animal variety.

Rule 23d

Exceptions to patentability

Under Article 53(a), European patents shall not be granted in respect of biotechnological inventions which, in particular, concern the following:

- (a) processes for cloning human beings;
- (b) processes for modifying the germ line genetic identity of human beings;
- (c) uses of human embryos for industrial or commercial purposes;
- (d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

Rule 23e

The human body and its elements

(1) The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.

(2) An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.

(3) The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.

Règle 23quater

Inventions biotechnologiques brevetables

Les inventions biotechnologiques sont également brevetables lorsqu'elles ont pour objet :

- a) une matière biologique isolée de son environnement naturel ou produite à l'aide d'un procédé technique, même lorsqu'elle préexistait à l'état naturel ;
- b) des végétaux ou des animaux si la faisabilité technique de l'invention n'est pas limitée à une variété végétale ou à une race animale déterminée ;
- c) un procédé microbiologique, ou d'autres procédés techniques, ou un produit obtenu par ces procédés, dans la mesure où il ne s'agit pas d'une variété végétale ou d'une race animale.

Règle 23quinquies

Exceptions à la brevetabilité

Conformément à l'article 53, lettre a), les brevets européens ne sont pas délivrés notamment pour les inventions biotechnologiques qui ont pour objet :

- a) des procédés de clonage des êtres humains ;
- b) des procédés de modification de l'identité génétique germinale de l'être humain ;
- c) des utilisations d'embryons humains à des fins industrielles ou commerciales ;
- d) des procédés de modification de l'identité génétique des animaux de nature à provoquer chez eux des souffrances sans utilité médicale substantielle pour l'homme ou l'animal, ainsi que les animaux issus de tels procédés.

Règle 23sexies

Le corps humain et ses éléments

(1) Le corps humain, aux différents stades de sa constitution et de son développement, ainsi que la simple découverte d'un de ses éléments, y compris la séquence ou la séquence partielle d'un gène, ne peuvent constituer des inventions brevetables.

(2) Un élément isolé du corps humain ou autrement produit par un procédé technique, y compris la séquence ou la séquence partielle d'un gène, peut constituer une invention brevetable, même si la structure de cet élément est identique à celle d'un élément naturel.

(3) L'application industrielle d'une séquence ou d'une séquence partielle d'un gène doit être concrètement exposée dans la demande de brevet.

Verweisungen / References / Références

Art. 52

Art. 53
R. 27

DRITTER TEIL

AUSFÜHRUNGSVORSCHRIFTEN ZUM DRITTEN TEIL DES ÜBEREINKOMMENS

Kapitel I

Einreichung der europäischen Patentanmeldung

Regel 24

Allgemeine Vorschriften

(1)³¹ Europäische Patentanmeldungen können schriftlich bei den in Artikel 75 genannten Behörden unmittelbar oder durch die Post eingereicht werden. Der Präsident des Europäischen Patentamts kann bestimmen, dass europäische Patentanmeldungen auf andere Weise mittels technischer Einrichtungen zur Nachrichtenübermittlung eingereicht werden können, und die Bedingungen für deren Benutzung festlegen. Er kann insbesondere bestimmen, dass innerhalb einer vom Europäischen Patentamt festzusetzenden Frist schriftliche Unterlagen nachzureichen sind, die den Inhalt der auf diese Weise eingereichten Anmeldungen wiedergeben und dieser Ausführungsordnung entsprechen.

(2) Die Behörde, bei der die europäische Patentanmeldung eingereicht wird, vermerkt auf den Unterlagen der Anmeldung den Tag des Eingangs dieser Unterlagen. Sie erteilt dem Anmelder unverzüglich eine Empfangsbescheinigung, die zumindest die Nummer der Anmeldung, die Art und Zahl der Unterlagen und den Tag ihres Eingangs enthält.

(3) Wird die europäische Patentanmeldung bei einer in Artikel 75 Absatz 1 Buchstabe b genannten Behörde eingereicht, so unterrichtet diese Behörde das Europäische Patentamt unverzüglich vom Eingang der Unterlagen der Anmeldung. Sie teilt dem Europäischen Patentamt die Art und den Tag des Eingangs dieser Unterlagen, die Nummer der Anmeldung und gegebenenfalls den Prioritätstag mit.

(4) Hat das Europäische Patentamt eine europäische Patentanmeldung durch Vermittlung einer Zentralbehörde für den gewerblichen Rechtsschutz eines Vertragsstaats erhalten, so teilt es dies dem Anmelder unter Angabe des Tages ihres Eingangs beim Europäischen Patentamt mit.

PART III

IMPLEMENTING REGULATIONS TO PART III OF THE CONVENTION

Chapter I

Filing of the European patent application

Rule 24

General provisions

(1)³¹ European patent applications may be filed in writing with the authorities referred to in Article 75 either directly or by post. The President of the European Patent Office may permit European patent applications to be filed by other means of communication and lay down conditions governing their use. He may, in particular, require that within such period as the European Patent Office shall specify written confirmation be supplied reproducing the contents of applications so filed and complying with the requirements of these Implementing Regulations.

(2) The authority with which the European patent application is filed shall mark the documents making up the application with the date of their receipt. It shall issue without delay a receipt to the applicant which shall include at least the application number, the nature and number of the documents and the date of their receipt.

(3) If the European patent application is filed with an authority mentioned in Article 75, paragraph 1(b), it shall without delay inform the European Patent Office of receipt of the documents making up the application. It shall inform the European Patent Office of the nature and date of receipt of the documents, the application number and any priority date claimed.

(4) When the European Patent Office has received a European patent application which has been forwarded by a central industrial property office of a Contracting State, it shall inform the applicant accordingly, indicating the date of its receipt at the European Patent Office.

³¹ Geändert durch Beschluss des Verwaltungsrats vom 05.06.1987, in Kraft getreten am 01.10.1987 (ABI. EPA 1987, 274). Siehe hierzu die Beschlüsse des Präsidenten des EPA vom 29.10.2002 über die elektronische Einreichung von europäischen Patentanmeldungen und anderen Unterlagen (ABI. EPA 2002, 543 ff.), vom 06.12.2004 über die Einreichung von Patentanmeldungen und anderen Unterlagen durch Telefax (ABI. EPA 2005, 41 ff.) und die Mitteilungen des EPA vom 29.10.2002 über die elektronische Einreichung von Patentanmeldungen und anderen Unterlagen (ABI. EPA 2002, 545 ff.) und vom 06.12.2004 über die Einreichung von Patentanmeldungen und anderen Unterlagen (ABI. EPA 2005, 44 ff.).

³¹ Amended by decision of the Administrative Council of 05.06.1987 which entered into force on 01.10.1987 (OJ EPO 1987, 274). See decisions of the President of the EPO dated 29.10.2002 on the electronic filing of European patent applications and subsequent documents (OJ EPO 2002, 543 ff), dated 06.12.2004 on the use of facsimile for filing patent applications and other documents (OJ EPO 2005, 41 ff), and the notices from the EPO dated 29.10.2002 concerning the electronic filing of patent applications and other documents (OJ EPO 2002, 545 ff) and dated 06.12.2004 concerning the filing of patent applications and other documents (OJ EPO 2005, 44 ff).

DISPOSITIONS D'APPLICATION DE LA TROISIÈME PARTIE DE LA CONVENTION

Chapitre I

Dépôt de la demande de brevet européen

Règle 24

Dispositions générales

(1)³¹ Les demandes de brevet européen peuvent être déposées par écrit, directement ou par la voie postale, auprès des autorités visées à l'article 75. Le Président de l'Office européen des brevets peut décider que les demandes de brevet européen peuvent être déposées également par des moyens techniques de communication, dont il arrête les conditions d'utilisation. Il peut notamment décider que des documents reproduisant par écrit le contenu des demandes ainsi déposées et répondant aux prescriptions du présent règlement doivent être produits dans un délai imparti par l'Office européen des brevets.

(2) L'administration auprès de laquelle la demande de brevet européen est déposée appose la date de leur réception sur les pièces de cette demande. Elle délivre sans délai au demandeur un récépissé indiquant au moins le numéro de la demande, la nature et le nombre des pièces ainsi que la date de leur réception.

(3) Si l'administration auprès de laquelle la demande de brevet européen est déposée est celle visée à l'article 75, paragraphe 1, lettre b), elle informe sans délai l'Office européen des brevets de la réception des pièces de la demande. Elle indique à l'Office européen des brevets la nature de ces pièces, le jour de leur réception, le numéro donné à la demande et, le cas échéant, la date de priorité.

(4) Lorsque l'Office européen des brevets a reçu une demande de brevet européen par l'intermédiaire du service central de la propriété industrielle d'un Etat contractant, il en informe le demandeur en lui indiquant la date à laquelle il a reçu la demande.

³¹ Modifié par décision du Conseil d'administration en date du 05.06.1987, entrée en vigueur le 01.10.1987 (JO OEB 1987, 274). Cf. la décision du Président de l'OEB en date du 29.10.2002, relative au dépôt électronique de demandes de brevet européen et de documents produits ultérieurement (JO OEB 2002, 543 s.), la décision du Président de l'OEB, en date du 06.12.2004, relative au dépôt de demandes de brevet et d'autres pièces par téléfax (JO OEB 2005, 41 s.), et les communiqués de l'OEB, en date du 29.10.2002, relatif au dépôt électronique de demandes de brevet et de documents produits ultérieurement (JO OEB 2002, 545 s.) et en date du 06.12.2004, relatif au dépôt de demandes de brevet et d'autres pièces (JO OEB 2005, 44 s.).

Regel 25

Vorschriften für europäische Teilanmeldungen

(1)³² Der Anmelder kann eine Teilanmeldung zu jeder anhängigen früheren europäischen Patentanmeldung einreichen.

(2)³³ Die Anmeldegebühr und die Recherchegebühr sind für eine europäische Teilanmeldung innerhalb eines Monats nach ihrer Einreichung zu entrichten. Die Benennungsgebühren sind innerhalb von sechs Monaten nach dem Tag zu entrichten, an dem im Europäischen Patentblatt auf die Veröffentlichung des europäischen Recherchenberichts zu der europäischen Teilanmeldung hingewiesen worden ist.

Kapitel II

Anmeldebestimmungen

Regel 26

Erteilungsantrag

(1)³⁴ Der Antrag auf Erteilung eines europäischen Patents ist schriftlich auf einem vom Europäischen Patentamt vorgeschriebenen Formblatt einzureichen. Vordruckte Formblätter werden von den in Artikel 75 Absatz 1 genannten Behörden gebührenfrei zur Verfügung gestellt.

(2) Der Antrag muss enthalten:

a) ein Ersuchen auf Erteilung eines europäischen Patents;

b)³⁵ die Bezeichnung der Erfindung, die eine kurz und genau gefasste technische Bezeichnung der Erfindung wiedergibt und keine Fantasiebezeichnung enthalten darf;

Rule 25

Provisions for European divisional applications

(1)³² The applicant may file a divisional application relating to any pending earlier European patent application.

(2)³³ The filing fee and search fee shall be payable in respect of a European divisional application within one month after the filing thereof. The designation fees shall be payable within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application.

Chapter II

Provisions governing the application

Rule 26

Request for grant

(1)³⁴ The request for the grant of a European patent shall be filed on a form drawn up by the European Patent Office. Printed forms shall be made available to applicants free of charge by the authorities referred to in Article 75, paragraph 1.

(2) The request shall contain:

(a) a petition for the grant of a European patent;

(b)³⁵ the title of the invention, which shall clearly and concisely state the technical designation of the invention and shall exclude all fancy names;

³² Zuletzt geändert durch Beschluss des Verwaltungsrats vom 18.10.2001, in Kraft getreten am 02.01.2002 (ABl. EPA 2001, 488 ff.).

³³ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.).

³⁴ Siehe hierzu die Mitteilung des EPA vom 04.07.2002 über die Neufassung des Formblatts für den Erteilungsantrag (ABl. EPA 2002, 375 ff.).

³⁵ Geändert durch Beschluss des Verwaltungsrats vom 11.12.1980, in Kraft getreten am 31.01.1981 (ABl. EPA 1981, 3 ff.).

³² Last amended by decision of the Administrative Council of 18.10.2001 which entered into force on 02.01.2002 (OJ EPO 2001, 488 ff.).

³³ Last amended by decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.).

³⁴ See notice from the EPO dated 04.07.2002 concerning the revised Request for Grant form (OJ EPO 2002, 375 ff.).

³⁵ Amended by decision of the Administrative Council of 11.12.1980 which entered into force on 31.01.1981 (OJ EPO 1981, 3 ff.).

Règle 25

Dépôt et conditions de la demande divisionnaire européenne

Verweisungen / References / Références

Art. 76, 78
R. 85a/bis

(1)³² Le demandeur peut déposer une demande divisionnaire relative à toute demande de brevet européen antérieure encore en instance.

(2)³³ La taxe de dépôt et la taxe de recherche doivent être acquittées pour une demande divisionnaire européenne dans le délai d'un mois à compter de son dépôt. Les taxes de désignation doivent être acquittées dans un délai de six mois à compter de la date à laquelle le Bulletin européen des brevets a mentionné la publication du rapport de recherche européenne établi pour la demande divisionnaire européenne.

Chapitre II

Dispositions régissant les demandes

Règle 26

Requête en délivrance

Art. 59, 76, 78, 79, 81, 88, 133
R. 55, 64, 75

(1)³⁴ La requête en délivrance d'un brevet européen doit être présentée sur une formule établie par l'Office européen des brevets. Des formules imprimées sont mises gratuitement à la disposition des déposants par les administrations visées à l'article 75, paragraphe 1.

(2) La requête doit contenir :

a) une pétition en vue de la délivrance d'un brevet européen ;

b)³⁵ le titre de l'invention, qui doit faire apparaître de manière claire et concise la désignation technique de l'invention et ne comporter aucune dénomination de fantaisie ;

³² Modifié en dernier lieu par décision du Conseil d'administration en date du 18.10.2001, entrée en vigueur le 02.01.2002 (JO OEB 2001, 488 s.).

³³ Modifié en dernier lieu par décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

³⁴ Cf. le communiqué de l'OEB, en date du 04.07.2002, relatif à la nouvelle version du formulaire de requête en délivrance (JO OEB 2002, 375 s.).

³⁵ Modifiée par décision du Conseil d'administration en date du 11.12.1980, entrée en vigueur le 31.01.1981 (JO OEB 1981, 3 s.).

c)³⁶ den Namen, die Anschrift, die Staatsangehörigkeit und den Staat des Wohnsitzes oder Sitzes des Anmelders. Bei natürlichen Personen sind Familienname und Vorname anzugeben, wobei der Familienname vor dem Vornamen zu stehen hat. Bei juristischen Personen und juristischen Personen gemäß dem für sie maßgebenden Recht gleichgestellten Gesellschaften ist die amtliche Bezeichnung anzugeben. Anschriften sind in der Weise anzugeben, dass die üblichen Anforderungen für eine schnelle Postzustellung an die angegebene Anschrift erfüllt sind. Sie müssen in jedem Fall alle maßgeblichen Verwaltungseinheiten, gegebenenfalls bis zur Hausnummer einschließlich, enthalten. Gegebenenfalls sollen Telegramm- und Telexanschriften und Telefonnummern angegeben werden;

d) falls ein Vertreter bestellt ist, seinen Namen und seine Geschäftsanschrift nach Maßgabe von Buchstabe c;

e) gegebenenfalls eine Erklärung, dass es sich um eine europäische Teilanmeldung handelt, und die Nummer der früheren europäischen Patentanmeldung;

f) im Fall des Artikels 61 Absatz 1 Buchstabe b die Nummer der früheren europäischen Patentanmeldung;

g) falls die Priorität einer früheren Anmeldung in Anspruch genommen wird, eine entsprechende Erklärung, in der der Tag dieser Anmeldung und der Staat angegeben sind, in dem oder für den sie eingereicht worden ist;

h) die Benennung des Vertragsstaats oder der Vertragsstaaten, in denen für die Erfindung Schutz begehrt wird;

i) die Unterschrift des Anmelders oder Vertreters;

j) eine Liste über die dem Antrag beigefügten Anlagen. In dieser Liste ist die Blattzahl der Beschreibung, der Patentansprüche, der Zeichnungen und der Zusammenfassung anzugeben, die mit dem Antrag eingereicht werden;

k) die Erfindernennung, wenn der Anmelder der Erfinder ist.

(3)³⁷ Im Fall mehrerer Anmelder soll der Antrag die Bezeichnung eines Anmelders oder Vertreters als gemeinsamer Vertreter enthalten.

(c)³⁶ the name, address and nationality of the applicant and the State in which his residence or principal place of business is located. Names of natural persons shall be indicated by the person's family name and given name(s), the family name being indicated before the given name(s). Names of legal entities, as well as companies considered to be legal entities by reason of the legislation to which they are subject, shall be indicated by their official designations. Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address. They shall in any case comprise all the relevant administrative units, including the house number, if any. It is recommended that the telegraphic and telex address and telephone number be indicated;

(d) if the applicant has appointed a representative, his name and the address of his place of business under the conditions contained in sub-paragraph (c);

(e) where appropriate, indication that the application constitutes a European divisional application and the number of the earlier European patent application;

(f) in cases covered by Article 61, paragraph 1(b), the number of the original European patent application;

(g) where applicable, a declaration claiming the priority of an earlier application and indicating the date on which and the country in or for which the earlier application was filed;

(h) designation of the Contracting State or States in which protection of the invention is desired;

(i) the signature of the applicant or his representative;

(j) a list of the documents accompanying the request. This list shall also indicate the number of sheets of the description, claims, drawings and abstract filed with the request;

(k) the designation of the inventor where the applicant is the inventor.

(3)³⁷ If there is more than one applicant, the request shall preferably contain the appointment of one applicant or representative as common representative.

³⁶ Mit Beschluss des Verwaltungsrats vom 21.12.1978 (ABI. EPA 1979, 5 ff.) wurde nur die englische und französische Fassung geändert. Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/99 (Anhang I).

³⁷ Mit Beschluss des Verwaltungsrats vom 11.12.1980, in Kraft getreten am 31.01.1981 (ABI. EPA 1981, 3 ff.), wurde nur die französische Fassung geändert.

³⁶ Amended by decision of the Administrative Council of 21.12.1978 which entered into force on 01.05.1979 (OJ EPO 1979, 5 ff). See decision of the Enlarged Board of Appeal G 3/99 (Annex I).

³⁷ Only the French version was amended by decision of the Administrative Council of 11.12.1980 which entered into force on 31.01.1981 (OJ EPO 1981, 3 ff).

c)³⁶ l'indication du nom, de l'adresse, de la nationalité, de l'Etat du domicile ou du siège du demandeur. Les personnes physiques doivent être désignées par leurs noms et prénoms, les noms précédant les prénoms. Les personnes morales et les sociétés assimilées aux personnes morales en vertu de la législation qui les régit doivent figurer sous leur désignation officielle. Les adresses doivent être indiquées selon les exigences usuelles en vue d'une distribution postale rapide à l'adresse indiquée. Elles doivent en tout état de cause comporter toutes les indications administratives pertinentes, y compris, le cas échéant, le numéro de la maison. Il est recommandé d'indiquer l'adresse télégraphique et de télex ainsi que le numéro de téléphone ;

d) l'indication, dans les conditions prévues sous c), du nom et de l'adresse professionnelle du mandataire du demandeur, s'il en a été constitué un ;

e) le cas échéant, l'indication que la demande constitue une demande divisionnaire européenne et le numéro de la demande initiale de brevet européen ;

f) dans le cas prévu à l'article 61, paragraphe 1, lettre b), le numéro de la demande initiale de brevet européen ;

g) si la priorité d'une demande antérieure est revendiquée, une déclaration à cet effet qui mentionne la date de cette demande et l'Etat dans lequel ou pour lequel elle a été déposée ;

h) la désignation de l'Etat contractant ou des Etats contractants dans lesquels la protection de l'invention est demandée ;

i) la signature du demandeur ou celle de son mandataire ;

j) la liste des pièces jointes à la requête. Cette liste indique également le nombre des feuilles de la description, des revendications, des dessins et de l'abrégé qui doivent être joints à la requête ;

k) la désignation de l'inventeur, si celui-ci est le demandeur.

(3)³⁷ En cas de pluralité de demandeurs, la requête contient, de préférence, la désignation d'un demandeur ou d'un mandataire comme représentant commun.

³⁶ Modifiée par décision du Conseil d'administration en date du 21.12.1978, entrée en vigueur le 01.05.1979 (JO OEB 1979, 5 s.). Cf. la décision de la Grande Chambre de recours G 3/99 (Annexe I).

³⁷ Modifié par décision du Conseil d'administration en date du 11.12.1980, entrée en vigueur le 31.01.1981 (JO OEB 1981, 3 s.).

Regel 27

Inhalt der Beschreibung

(1)³⁸ In der Beschreibung

- a) ist das technische Gebiet, auf das sich die Erfindung bezieht, anzugeben;
- b)³⁹ ist der bisherige Stand der Technik anzugeben, soweit er nach der Kenntnis des Anmelders für das Verständnis der Erfindung, die Erstellung des europäischen Recherchenberichts und die Prüfung als nützlich angesehen werden kann; es sollen auch die Fundstellen angegeben werden, aus denen sich dieser Stand der Technik ergibt;
- c) ist die Erfindung, wie sie in den Patentansprüchen gekennzeichnet ist, so darzustellen, dass danach die technische Aufgabe, auch wenn sie nicht ausdrücklich als solche genannt ist, und deren Lösung verstanden werden können; außerdem sind gegebenenfalls vorteilhafte Wirkungen der Erfindung unter Bezugnahme auf den bisherigen Stand der Technik anzugeben;
- d) sind die Abbildungen der Zeichnungen, falls solche vorhanden sind, kurz zu beschreiben;
- e) ist wenigstens ein Weg zur Ausführung der beanspruchten Erfindung im Einzelnen anzugeben; dies soll, wo es angebracht ist, durch Beispiele und gegebenenfalls unter Bezugnahme auf Zeichnungen geschehen;
- f) ist, wenn es sich aus der Beschreibung oder der Art der Erfindung nicht offensichtlich ergibt, ausdrücklich anzugeben, in welcher Weise der Gegenstand der Erfindung gewerblich anwendbar ist.

(2) Die Beschreibung ist in der in Absatz 1 angegebenen Art und Weise sowie Reihenfolge einzureichen, sofern nicht wegen der Art der Erfindung eine abweichende Form oder Reihenfolge zu einem besseren Verständnis oder zu einer knapperen Darstellung führen würde.

Rule 27

Content of the description

(1)³⁸ The description shall:

- (a) specify the technical field to which the invention relates;
 - (b)³⁹ indicate the background art which, as far as known to the applicant, can be regarded as useful for understanding the invention, for drawing up the European search report and for the examination, and, preferably, cite the documents reflecting such art;
 - (c) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effects of the invention with reference to the background art;
 - (d) briefly describe the figures in the drawings, if any;
 - (e) describe in detail at least one way of carrying out the invention claimed using examples where appropriate and referring to the drawings, if any;
 - (f) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry.
- (2) The description shall be presented in the manner and order specified in paragraph 1, unless because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation.

³⁸ Geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.).

³⁹ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 1/03, G 2/03 (Anhang I).

³⁸ Amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff.).

³⁹ See decisions of the Enlarged Board of Appeal G 1/03, G 2/03 (Annex I).

Contenu de la description

Art. 54, 56, 57, 78, 83
R. 23e/sexies, 27a/bis, 36

(1)³⁸ La description doit :

- a) préciser le domaine technique auquel se rapporte l'invention ;
- b)³⁹ indiquer l'état de la technique antérieure qui, dans la mesure où le demandeur le connaît, peut être considéré comme utile pour l'intelligence de l'invention, pour l'établissement du rapport de recherche européenne et pour l'examen; les documents servant à refléter l'état de la technique antérieure doivent être cités de préférence ;
- c) exposer l'invention, telle qu'elle est caractérisée dans les revendications, en des termes permettant la compréhension du problème technique, même s'il n'est pas expressément désigné comme tel, et celle de la solution de ce problème; indiquer en outre, le cas échéant, les avantages apportés par l'invention par rapport à l'état de la technique antérieure ;
- d) décrire brièvement les figures des dessins s'il en existe ;
- e) indiquer en détail au moins un mode de réalisation de l'invention dont la protection est demandée, qui, en principe, doit comporter des exemples, s'il y a lieu, et des références aux dessins, s'il en existe ;
- f) expliciter, dans le cas où elle ne résulte pas à l'évidence de la description ou de la nature de l'invention, la manière dont celle-ci est susceptible d'application industrielle.

(2) La description doit être présentée de la manière et suivant l'ordre indiqués au paragraphe 1, à moins qu'en raison de la nature de l'invention une manière ou un ordre différent ne permette une meilleure intelligence et une présentation plus concise.

³⁸ Modifié par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.).

³⁹ Cf. les décisions de la Grande Chambre de recours G 1/03, G 2/03 (Annexe I).

Regel 27a^{40/41}

Erfordernisse europäischer Patentanmeldungen betreffend Nucleotid- und Aminosäuresequenzen

- (1) Sind in der europäischen Patentanmeldung Nucleotid- oder Aminosäuresequenzen offenbart, so hat die Beschreibung ein Sequenzprotokoll zu enthalten, das den vom Präsidenten des Europäischen Patentamts erlassenen Vorschriften für die standardisierte Darstellung von Nucleotid- und Aminosäuresequenzen entspricht.
- (2) Der Präsident des Europäischen Patentamts kann bestimmen, dass zusätzlich zu den schriftlichen Anmeldeunterlagen ein Sequenzprotokoll gemäß Absatz 1 auf einem von ihm vorgeschriebenen Datenträger einzureichen und eine Erklärung beizufügen ist, dass die auf dem Datenträger gespeicherte Information mit dem schriftlichen Sequenzprotokoll übereinstimmt.
- (3) Wird ein Sequenzprotokoll nach dem Anmeldetag eingereicht oder berichtigt, so hat der Anmelder eine Erklärung beizufügen, dass das nachgereichte oder berichtigte Sequenzprotokoll nicht über den Inhalt der Anmeldung in der ursprünglich eingereichten Fassung hinausgeht.
- (4) Ein nach dem Anmeldetag eingereichtes Sequenzprotokoll ist nicht Bestandteil der Beschreibung.

*Regel 28*⁴²

Hinterlegung von biologischem Material

- (1) Wird bei einer Erfindung biologisches Material verwendet oder bezieht sie sich auf biologisches Material, das der Öffentlichkeit nicht zugänglich ist und in der europäischen Patentanmeldung nicht so beschrieben werden kann, dass ein Fachmann die Erfindung danach ausführen kann, so gilt die Erfindung nur dann als gemäß Artikel 83 offenbart, wenn
 - a) eine Probe des biologischen Materials spätestens am Anmeldetag bei einer anerkannten Hinterlegungsstelle hinterlegt worden ist,
 - b) die Anmeldung in ihrer ursprünglich eingereichten Fassung die dem Anmelder zur Verfügung stehenden maßgeblichen Angaben über die Merkmale des biologischen Materials enthält,

Rule 27a^{40/41}

Requirements of European patent applications relating to nucleotide and amino acid sequences

- (1) If nucleotide or amino acid sequences are disclosed in the European patent application the description shall contain a sequence listing conforming to the rules laid down by the President of the European Patent Office for the standardised representation of nucleotide and amino acid sequences.
- (2) The President of the European Patent Office may require that, in addition to the written application documents, a sequence listing in accordance with paragraph 1 be submitted on a data carrier prescribed by him accompanied by a statement that the information recorded on the data carrier is identical to the written sequence listing.
- (3) If a sequence listing is filed or corrected after the date of filing, the applicant shall submit a statement that the sequence listing so filed or corrected does not include matter which goes beyond the content of the application as filed.
- (4) A sequence listing filed after the date of filing shall not form part of the description.

*Rule 28*⁴²

Deposit of biological material

- (1) If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed as prescribed in Article 83 if:
 - (a) a sample of the biological material has been deposited with a recognised depository institution not later than the date of filing of the application;
 - (b) the application as filed gives such relevant information as is available to the applicant on the characteristics of the biological material;

⁴⁰ Eingefügt durch Beschluss des Verwaltungsrats vom 05.06.1992, in Kraft getreten am 01.01.1993 (ABI. EPA 1992, 342 ff.).

⁴¹ Siehe hierzu den Beschluss des Präsidenten des EPA vom 02.10.1998 über die Darstellung von Nucleotid- und Aminosäuresequenzen in Patentanmeldungen und die Einreichung von Sequenzprotokollen (Beilage Nr. 2 zum ABI. EPA 11/1998).

⁴² Zuletzt geändert durch Beschluss des Verwaltungsrats vom 14.06.1996, in Kraft getreten am 01.10.1996 (ABI. EPA 1996, 390).

⁴⁰ Inserted by decision of the Administrative Council of 05.06.1992 which entered into force on 01.01.1993 (OJ EPO 1992, 342 ff.).

⁴¹ See decision of the President of the EPO dated 02.10.1998 concerning the representation of nucleotide and amino acid sequences in patent applications and the filing of sequence listings (Suppl. No. 2 to OJ EPO 11/1998).

⁴² Last amended by decision of the Administrative Council of 14.06.1996 which entered into force on 01.10.1996 (OJ EPO 1996, 390).

Prescriptions régissant les demandes de brevet européen portant sur des séquences de nucléotides et d'acides aminés

R. 27

(1) Si des séquences de nucléotides ou d'acides aminés sont exposées dans la demande de brevet européen, la description doit contenir une liste de séquences établie conformément aux règles arrêtées par le Président de l'Office européen des brevets pour la représentation normalisée de séquences de nucléotides et d'acides aminés.

(2) Le Président de l'Office européen des brevets peut exiger qu'en plus des pièces écrites de la demande, une liste de séquences établie conformément aux dispositions du paragraphe 1 soit produite sur un support de données qu'il prescrit et qu'elle soit accompagnée d'une déclaration selon laquelle l'information figurant sur ce support est identique à celle que contient la liste écrite.

(3) Si une liste de séquences est déposée ou rectifiée après la date de dépôt, le demandeur doit produire une déclaration selon laquelle la liste de séquences ainsi déposée ou rectifiée ne contient pas d'éléments s'étendant au-delà du contenu de la demande telle qu'elle a été déposée.

(4) Une liste de séquences produite après la date de dépôt ne fait pas partie de la description.

Règle 28⁴²

Dépôt de matière biologique

Art. 78, 129

R. 23b/ter, 28a/bis, 48

(1) Lorsqu'une invention comporte l'utilisation d'une matière biologique ou qu'elle concerne une matière biologique, à laquelle le public n'a pas accès et qui ne peut être décrite dans la demande de brevet européen de façon à permettre à un homme du métier d'exécuter l'invention, celle-ci n'est considérée comme exposée conformément aux dispositions de l'article 83 que si :

- a) un échantillon de la matière biologique a été déposé, au plus tard à la date de dépôt de la demande, auprès d'une autorité de dépôt habilitée ;
- b) la demande telle que déposée contient les informations pertinentes dont dispose le demandeur sur les caractéristiques de la matière biologique ;

⁴⁰ Insérée par décision du Conseil d'administration en date du 05.06.1992, entrée en vigueur le 01.01.1993 (JO OEB 1992, 342 s.).

⁴¹ Cf. la décision du Président de l'Office européen des brevets, en date du 02.10.1998, relative à la représentation de séquences de nucléotides et d'acides aminés dans les demandes de brevet et au dépôt de listes de séquences (Suppl. n° 2 au JO OEB 11/1998).

⁴² Modifiée en dernier lieu par décision du Conseil d'administration en date du 14.06.1996, entrée en vigueur le 01.10.1996 (JO OEB 1996, 390).

c)⁴³ die Hinterlegungsstelle und die Eingangsnummer des hinterlegten biologischen Materials in der Anmeldung angegeben sind und

d) falls das biologische Material nicht vom Anmelder hinterlegt wurde - Name und Anschrift des Hinterlegers in der Anmeldung angegeben sind und dem Europäischen Patentamt durch Vorlage von Urkunden nachgewiesen wird, dass der Hinterleger den Anmelder ermächtigt hat, in der Anmeldung auf das hinterlegte biologische Material Bezug zu nehmen, und vorbehaltlos und unwiderruflich seine Zustimmung erteilt hat, dass das von ihm hinterlegte Material nach Maßgabe dieser Regel der Öffentlichkeit zugänglich gemacht wird.

(2) Die in Absatz 1 Buchstaben c und gegebenenfalls d genannten Angaben können nachgereicht werden

a) innerhalb von sechzehn Monaten nach dem Anmeldetag oder, wenn eine Priorität in Anspruch genommen worden ist, nach dem Prioritätstag; die Frist gilt als eingehalten, wenn die Angaben bis zum Abschluss der technischen Vorbereitungen für die Veröffentlichung der europäischen Patentanmeldung mitgeteilt werden,

b) bis zum Tag der Einreichung eines Antrags auf vorzeitige Veröffentlichung der Anmeldung,

c) innerhalb eines Monats, nachdem das Europäische Patentamt dem Anmelder mitgeteilt hat, dass ein Recht auf Akteneinsicht nach Artikel 128 Absatz 2 besteht.

Maßgebend ist die Frist, die zuerst abläuft. Die Mitteilung dieser Angaben gilt vorbehaltlos und unwiderruflich als Zustimmung des Anmelders, dass das von ihm hinterlegte biologische Material nach Maßgabe dieser Regel der Öffentlichkeit zugänglich gemacht wird.

(3) Vom Tag der Veröffentlichung der europäischen Patentanmeldung an ist das hinterlegte biologische Material jedermann und vor diesem Tag demjenigen, der das Recht auf Akteneinsicht nach Artikel 128 Absatz 2 hat, auf Antrag zugänglich. Vorbehaltlich Absatz 4 wird der Zugang durch Herausgabe einer Probe des hinterlegten biologischen Materials an den Antragsteller hergestellt.

Die Herausgabe erfolgt nur, wenn der Antragsteller sich gegenüber dem Anmelder oder Patentinhaber verpflichtet hat, das biologische Material oder davon abgeleitetes biologisches Material Dritten nicht zugänglich zu machen und es lediglich zu Versuchszwecken zu verwenden, bis die Patentanmeldung zurückgewiesen oder zurückgenommen wird oder als zurückgenommen gilt oder das europäische Patent in allen benannten Vertragsstaaten erloschen ist, sofern der Anmelder oder Patentinhaber nicht ausdrücklich darauf verzichtet.

(c)⁴³ the depositary institution and the accession number of the deposited biological material are stated in the application, and

(d) where the biological material has been deposited by a person other than the applicant, the name and address of the depositor are stated in the application and a document is submitted satisfying the European Patent Office that the latter has authorised the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable consent to the deposited material being made available to the public in accordance with this Rule.

(2) The information referred to in paragraph 1(c) and, where applicable, (d) may be submitted

(a) within a period of sixteen months after the date of filing of the application or, if priority is claimed, after the priority date, this time limit being deemed to have been met if the information is communicated before completion of the technical preparations for publication of the European patent application;

(b) up to the date of submission of a request for early publication of the application;

(c) within one month after the European Patent Office has communicated to the applicant that a right to inspect the files pursuant to Article 128, paragraph 2, exists.

The ruling period shall be the one which is the first to expire. The communication of this information shall be considered as constituting the unreserved and irrevocable consent of the applicant to the deposited biological material being made available to the public in accordance with this Rule.

(3) The deposited biological material shall be available upon request to any person from the date of publication of the European patent application and to any person having the right to inspect the files pursuant to Article 128, paragraph 2, prior to that date. Subject to paragraph 4, such availability shall be effected by the issue of a sample of the biological material to the person making the request (hereinafter referred to as "the requester").

Said issue shall be made only if the requester has undertaken vis-à-vis the applicant for or proprietor of the patent not to make the biological material or any biological material derived therefrom available to any third party and to use that material for experimental purposes only, until such time as the patent application is refused or withdrawn or deemed to be withdrawn, or before the expiry of the patent in the designated State in which it last expires, unless the applicant for or proprietor of the patent expressly waives such an undertaking.

⁴³ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 2/93 (Anhang I).

⁴³ See decision of the Enlarged Board of Appeal G 2/93 (Annex I).

c)⁴³ la demande comporte l'indication de l'autorité de dépôt et le numéro d'ordre de la matière biologique déposée, et

d) lorsque la matière biologique a été déposée par une personne autre que le demandeur, le nom et l'adresse du déposant sont mentionnés dans la demande et est fourni à l'Office européen des brevets un document prouvant que le déposant a autorisé le demandeur à se référer dans la demande à la matière biologique déposée et a consenti sans réserve et de manière irrévocable à mettre la matière déposée à la disposition du public, conformément à la présente règle.

(2) Les indications mentionnées au paragraphe 1, lettre c) et, le cas échéant, lettre d) peuvent être communiquées

a) dans un délai de seize mois à compter de la date de dépôt ou, si une priorité est revendiquée, à compter de la date de priorité, le délai étant réputé observé si les indications sont communiquées jusqu'à la fin des préparatifs techniques en vue de la publication de la demande de brevet européen,

b) jusqu'à la date de présentation d'une requête tendant à avancer la publication de la demande,

c) dans un délai d'un mois après la notification, faite par l'Office européen des brevets au demandeur, qu'il existe un droit de consulter le dossier en vertu de l'article 128, paragraphe 2.

Est applicable celui des délais qui expire le premier. Du fait de la communication de ces indications, le demandeur est considéré comme consentant sans réserve et de manière irrévocable à mettre la matière biologique déposée à la disposition du public, conformément aux dispositions de la présente règle.

(3) A compter du jour de la publication de la demande de brevet européen, la matière biologique déposée est accessible à toute personne qui en fait la requête et, avant cette date, à toute personne ayant le droit de consulter le dossier en vertu de l'article 128, paragraphe 2. Sous réserve du paragraphe 4, cette accessibilité est réalisée par la remise au requérant d'un échantillon de la matière biologique déposée.

Cette remise n'a lieu que si le requérant s'est engagé à l'égard du demandeur ou du titulaire du brevet à ne pas communiquer à des tiers la matière biologique ou une matière biologique qui en est dérivée et à n'utiliser cette matière qu'à des fins expérimentales jusqu'à la date à laquelle la demande de brevet est rejetée ou retirée ou réputée retirée, ou le brevet européen s'éteint dans tous les Etats contractants désignés, à moins que le demandeur ou le titulaire du brevet ne renonce expressément à un tel engagement.

⁴³ Cf. la décision de la Grande Chambre de recours G 2/93 (Annexe I).

Die Verpflichtung, das biologische Material nur zu Versuchszwecken zu verwenden, ist hinfällig, soweit der Antragsteller dieses Material auf Grund einer Zwangslizenz verwendet. Unter Zwangslizenzen sind auch Amtslizenzen und Rechte zur Benutzung einer patentierten Erfindung im öffentlichen Interesse zu verstehen.

(4)⁴⁴ Bis zum Abschluss der technischen Vorbereitungen für die Veröffentlichung der Anmeldung kann der Anmelder dem Europäischen Patentamt mitteilen, dass der in Absatz 3 bezeichnete Zugang

a) bis zu dem Tag, an dem der Hinweis auf die Erteilung des europäischen Patents bekannt gemacht wird, oder gegebenenfalls

b) für die Dauer von zwanzig Jahren ab dem Anmeldetag der Patentanmeldung, falls diese zurückgewiesen oder zurückgenommen worden ist oder als zurückgenommen gilt,

nur durch Herausgabe einer Probe an einen vom Antragsteller benannten Sachverständigen hergestellt wird.

(5) Als Sachverständiger kann benannt werden:

a) jede natürliche Person, sofern der Antragsteller bei der Einreichung des Antrags nachweist, dass die Benennung mit Zustimmung des Anmelders erfolgt,

b)⁴⁵ jede natürliche Person, die vom Präsidenten des Europäischen Patentamts als Sachverständiger anerkannt ist.

Zusammen mit der Benennung ist eine Erklärung des Sachverständigen einzureichen, in der er die in Absatz 3 vorgesehenen Verpflichtungen gegenüber dem Anmelder bis zum Erlöschen des europäischen Patents in allen benannten Vertragsstaaten oder - falls die Patentanmeldung zurückgewiesen oder zurückgenommen wird oder als zurückgenommen gilt - bis zu dem in Absatz 4 Buchstabe b vorgesehenen Zeitpunkt eingeht, wobei der Antragsteller als Dritter anzusehen ist.

(6)⁴⁶ Abgeleitetes biologisches Material im Sinne des Absatzes 3 ist jedes Material, das noch die für die Ausführung der Erfindung wesentlichen Merkmale des hinterlegten Materials aufweist. Die in Absatz 3 vorgesehenen Verpflichtungen stehen einer für die Zwecke von Patentverfahren erforderlichen Hinterlegung eines abgeleiteten biologischen Materials nicht entgegen.

The undertaking to use the biological material for experimental purposes only shall not apply in so far as the requester is using that material under a compulsory licence. The term "compulsory licence" shall be construed as including ex officio licences and the right to use patented inventions in the public interest.

(4)⁴⁴ Until completion of the technical preparations for publication of the application, the applicant may inform the European Patent Office that

(a) until the publication of the mention of the grant of the European patent or, where applicable,

(b) for twenty years from the date of filing if the application has been refused or withdrawn or deemed to be withdrawn,

the availability referred to in paragraph 3 shall be effected only by the issue of a sample to an expert nominated by the requester.

(5) The following may be nominated as an expert:

(a) any natural person provided that the requester furnishes evidence, when filing the request, that the nomination has the approval of the applicant;

(b)⁴⁵ any natural person recognised as an expert by the President of the European Patent Office.

The nomination shall be accompanied by a declaration from the expert vis-à-vis the applicant in which he enters into the undertaking given pursuant to paragraph 3 until either the date on which the patent expires in all the designated States or, where the application has been refused, withdrawn or deemed to be withdrawn, until the date referred to in paragraph 4(b), the requester being regarded as a third party.

(6)⁴⁶ For the purposes of paragraph 3, derived biological material shall mean any material which still exhibits those characteristics of the deposited material which are essential to carrying out the invention. The undertaking referred to in paragraph 3 shall not impede any deposit of derived biological material necessary for the purpose of patent procedure.

⁴⁴ Siehe hierzu Mitteilung des Präsidenten des EPA vom 28.07.1981 über die Mitteilung der Wahl der Sachverständigenlösung an das EPA und ihre Bekanntmachung (ABl. EPA 1981, 358).

⁴⁵ Siehe hierzu die Allgemeinen Bedingungen des Präsidenten des EPA für die Anerkennung von Sachverständigen und das Verzeichnis der für die Zwecke von Regel 28 EPÜ anerkannten Sachverständigen (ABl. EPA 1981, 359 ff.; 1992, 470).

⁴⁶ Geändert durch Beschluss des Verwaltungsrats vom 16.06.1999, in Kraft getreten am 01.09.1999 (ABl. EPA 1999, 437 ff.).

⁴⁴ See notice of the President of the EPO of 28.07.1981 concerning the procedure for informing the EPO that the „expert“ option has been chosen, and the publication of that fact (OJ EPO 1981, 358).

⁴⁵ See General Conditions set by the President of the EPO for the recognition of experts and the list of experts recognised for the purpose of Rule 28 EPC (OJ EPO 1981, 359 ff; 1992, 470).

⁴⁶ Amended by decision of the Administrative Council of 16.06.1999 which entered into force on 01.09.1999 (OJ EPO 1999, 437 ff).

L'engagement de n'utiliser la matière biologique qu'à des fins expérimentales n'est pas applicable dans la mesure où le requérant utilise cette matière pour une exploitation résultant d'une licence obligatoire. L'expression "licence obligatoire" est entendue comme couvrant les licences d'office et tout droit d'utilisation dans l'intérêt public d'une invention brevetée.

(4)⁴⁴ Jusqu'à la fin des préparatifs techniques en vue de la publication de la demande, le demandeur peut informer l'Office européen des brevets que,

- a) jusqu'à la publication de la mention de la délivrance du brevet européen ou, le cas échéant,
- b) pendant vingt ans à compter de la date du dépôt de la demande, si cette dernière est rejetée, retirée ou réputée retirée,

l'accessibilité prévue au paragraphe 3 ne peut être réalisée que par la remise d'un échantillon à un expert désigné par le requérant.

(5) Peut être désignée comme expert :

- a) toute personne physique, à condition que le requérant fournisse la preuve, lors du dépôt de la requête, que le demandeur a donné son accord à cette désignation;
- b)⁴⁵ toute personne physique qui a la qualité d'expert agréé par le Président de l'Office européen des brevets.

La désignation est accompagnée d'une déclaration de l'expert par laquelle il assume à l'égard du demandeur l'engagement visé au paragraphe 3, et ce, soit jusqu'à la date à laquelle le brevet européen s'éteint dans tous les Etats désignés, soit jusqu'à la date visée au paragraphe 4, lettre b), dans le cas où la demande a été rejetée, retirée ou est réputée retirée, le requérant étant considéré comme un tiers.

(6)⁴⁶ On entend par matière biologique dérivée aux fins du paragraphe 3 toute matière qui présente encore les caractéristiques de la matière déposée essentielles à la mise en oeuvre de l'invention. Les engagements visés au paragraphe 3 ne font pas obstacle à un dépôt d'une matière biologique dérivée, nécessaire aux fins de la procédure en matière de brevets.

⁴⁴ Cf. le communiqué du Président de l'OEB du 28.07.1981 relatif à la communication à l'OEB du choix de la solution de l'expert et à la publication de ce choix (JO OEB 1981, 358).

⁴⁵ Cf. les Conditions générales fixées par le Président de l'OEB aux fins de la reconnaissance de la qualité d'expert agréé et la liste des experts agréés aux fins de la règle 28 CBE (JO OEB 1981, 359 s.; 1992, 470 s.).

⁴⁶ Modifié par décision du Conseil d'administration en date du 16.06.1999, entrée en vigueur le 01.09.1999 (JO OEB 1999, 437s.).

(7) Der in Absatz 3 vorgesehene Antrag ist beim Europäischen Patentamt auf einem von diesem Amt anerkannten Formblatt einzureichen. Das Europäische Patentamt bestätigt auf dem Formblatt, dass eine europäische Patentanmeldung eingereicht worden ist, die auf die Hinterlegung des biologischen Materials Bezug nimmt, und dass der Antragsteller oder der von ihm benannte Sachverständige Anspruch auf Herausgabe einer Probe dieses Materials hat. Der Antrag ist auch nach Erteilung des europäischen Patents beim Europäischen Patentamt einzureichen.

(8) Das Europäische Patentamt übermittelt der Hinterlegungsstelle und dem Anmelder oder Patentinhaber eine Kopie des Antrags mit der in Absatz 7 vorgesehenen Bestätigung.

(9) Der Präsident des Europäischen Patentamts veröffentlicht im Amtsblatt des Europäischen Patentamts das Verzeichnis der Hinterlegungsstellen und Sachverständigen, die für die Anwendung dieser Regel anerkannt sind.

*Regel 28a*⁴⁷

Erneute Hinterlegung von biologischem Material

(1) Ist nach Regel 28 Absatz 1 hinterlegtes biologisches Material bei der Stelle, bei der es hinterlegt worden ist, nicht mehr zugänglich, weil

- a) das biologische Material nicht mehr lebensfähig ist oder
- b) die Hinterlegungsstelle aus anderen Gründen zur Abgabe von Proben nicht in der Lage ist,

und ist keine Probe des biologischen Materials an eine andere für die Anwendung der Regel 28 anerkannte Hinterlegungsstelle weitergeleitet worden, bei der dieses Material weiterhin zugänglich ist, so gilt die Unterbrechung der Zugänglichkeit als nicht eingetreten, wenn das ursprünglich hinterlegte biologische Material innerhalb von drei Monaten nach dem Tag erneut hinterlegt wird, an dem dem Hinterleger von der Hinterlegungsstelle diese Unterbrechung mitgeteilt wurde, und dem Europäischen Patentamt innerhalb von vier Monaten nach dem Tag der erneuten Hinterlegung eine Kopie der von der Hinterlegungsstelle ausgestellten Empfangsbescheinigung unter Angabe der Nummer der europäischen Patentanmeldung oder des europäischen Patents übermittelt wird.

(7) The request provided for in paragraph 3 shall be submitted to the European Patent Office on a form recognised by that Office. The European Patent Office shall certify on the form that a European patent application referring to the deposit of the biological material has been filed, and that the requester or the expert nominated by him is entitled to the issue of a sample of that material. After grant of the European patent, the request shall also be submitted to the European Patent Office.

(8) The European Patent Office shall transmit a copy of the request, with the certification provided for in paragraph 7, to the depositary institution as well as to the applicant for or the proprietor of the patent.

(9) The President of the European Patent Office shall publish in the Official Journal of the European Patent Office the list of depositary institutions and experts recognised for the purpose of this Rule.

*Rule 28a*⁴⁷

New deposit of biological material

(1) If biological material deposited in accordance with Rule 28, paragraph 1, ceases to be available from the institution with which it was deposited because:

- (a) the biological material is no longer viable, or
- (b) for any other reason the depositary institution is unable to supply samples,

and if no sample of the biological material has been transferred to another depositary institution recognised for the purposes of Rule 28, from which it continues to be available, an interruption in availability shall be deemed not to have occurred if a new deposit of the biological material originally deposited is made within a period of three months from the date on which the depositor was notified of the interruption by the depositary institution and if a copy of the receipt of the deposit issued by the institution is forwarded to the European Patent Office within four months from the date of the new deposit stating the number of the application or of the European patent.

⁴⁷ Eingefügt durch Beschluss des Verwaltungsrats vom 30.11.1979, in Kraft getreten am 01.06.1980 (ABI. EPA 1979, 449); geändert durch Beschluss des Verwaltungsrats vom 14.06.1996, in Kraft getreten am 01.10.1996 (ABI. EPA 1996, 390).

⁴⁷ Inserted by decision of the Administrative Council of 30.11.1979 which entered into force on 01.06.1980 (OJ EPO 1979, 449); amended by decision of the Administrative Council of 14.06.1996 which entered into force on 01.10.1996 (OJ EPO 1996, 390).

(7) La requête mentionnée au paragraphe 3 est adressée à l'Office européen des brevets au moyen d'une formule agréée par cet office. L'Office européen des brevets certifie sur cette formule qu'une demande de brevet européen faisant état du dépôt de la matière biologique a été déposée et que le requérant ou l'expert qu'il a désigné a droit à la remise d'un échantillon de cette matière. La requête est également adressée à l'Office européen des brevets après la délivrance du brevet européen.

(8) L'Office européen des brevets transmet à l'autorité de dépôt, ainsi qu'au demandeur ou au titulaire du brevet, une copie de la requête assortie de la certification prévue au paragraphe 7.

(9) Le Président de l'Office européen des brevets publie au Journal officiel de l'Office européen des brevets la liste des autorités de dépôt habilitées et des experts agréés aux fins de l'application de la présente règle.

*Règle 28bis*⁴⁷

Nouveau dépôt de matière biologique

Art. 83, 129

(1) Si de la matière biologique déposée conformément à la règle 28, paragraphe 1, cesse d'être accessible auprès de l'autorité qui a reçu ce dépôt :

- a) parce que cette matière biologique n'est plus viable,
- b) ou que, pour d'autres raisons, l'autorité de dépôt n'est pas à même d'en fournir des échantillons,

et si aucun échantillon de la matière biologique n'a été transféré à une autre autorité de dépôt, habilitée aux fins de la règle 28, auprès de laquelle la matière biologique reste accessible, l'interruption de l'accessibilité est réputée non avenue à condition qu'un nouveau dépôt de la matière biologique initialement déposée ait été effectué dans un délai de trois mois à compter de la date à laquelle cette interruption a été notifiée au déposant de la matière biologique par l'autorité de dépôt et qu'une copie du récépissé de dépôt délivré par l'autorité de dépôt, accompagnée de l'indication du numéro de la demande de brevet européen ou du brevet européen, ait été communiquée à l'Office européen des brevets dans un délai de quatre mois à compter de la date du nouveau dépôt.

⁴⁷ Insérée par décision du Conseil d'administration en date du 30.11.1979, entrée en vigueur le 01.06.1980 (JO OEB 1979, 449) ; modifiée par décision du Conseil d'administration en date du 14.06.1996, entrée en vigueur le 01.10.1996 (JO OEB 1996, 390).

(2) Die erneute Hinterlegung ist im Fall von Absatz 1 Buchstabe a bei der Hinterlegungsstelle vorzunehmen, bei der die ursprüngliche Hinterlegung vorgenommen wurde; sie kann in den Fällen des Absatzes 1 Buchstabe b bei einer anderen für die Anwendung der Regel 28 anerkannten Hinterlegungsstelle vorgenommen werden.

(3) Ist die Hinterlegungsstelle, bei der die ursprüngliche Hinterlegung vorgenommen wurde, für die Anwendung der Regel 28 entweder insgesamt oder für die Art des biologischen Materials, zu der die hinterlegte Probe gehört, nicht mehr anerkannt oder hat sie die Erfüllung ihrer Aufgaben in Bezug auf hinterlegtes biologisches Material vorübergehend oder endgültig eingestellt und erfolgt die in Absatz 1 genannte Mitteilung der Hinterlegungsstelle nicht innerhalb von sechs Monaten nach dem Eintritt dieses Ereignisses, so beginnt die in Absatz 1 genannte Dreimonatsfrist zu dem Zeitpunkt, in dem der Eintritt dieses Ereignisses im Amtsblatt des Europäischen Patentamts veröffentlicht wurde.

(4) Jeder erneuten Hinterlegung ist eine vom Hinterleger unterzeichnete Erklärung beizufügen, in der bestätigt wird, dass das erneut hinterlegte biologische Material dasselbe wie das ursprünglich hinterlegte ist.

(5) Wird die erneute Hinterlegung nach dem Budapestervertrag über die internationale Anerkennung der Hinterlegung von Mikroorganismen für die Zwecke von Patentverfahren vom 28. April 1977 vorgenommen, so gehen die Vorschriften dieses Vertrages vor.

Regel 29

Form und Inhalt der Patentansprüche

(1)⁴⁸ Der Gegenstand des Schutzbegehrens ist in den Patentansprüchen durch Angabe der technischen Merkmale der Erfindung anzugeben. Wo es zweckdienlich ist, haben die Patentansprüche zu enthalten:

a) Die Bezeichnung des Gegenstands der Erfindung und die technischen Merkmale, die zur Festlegung des beanspruchten Gegenstands der Erfindung notwendig sind, jedoch in Verbindung miteinander zum Stand der Technik gehören;

b) einen kennzeichnenden Teil, der durch die Worte "dadurch gekennzeichnet" oder "gekennzeichnet durch" eingeleitet wird und die technischen Merkmale bezeichnet, für die in Verbindung mit den unter Buchstabe a angegebenen Merkmalen Schutz begehrt wird.

(2) In the case provided for in paragraph 1(a), the new deposit shall be made with the depositary institution with which the original deposit was made; in the cases provided for in paragraph 1(b), it may be made with another depositary institution recognised for the purposes of Rule 28.

(3) Where the institution with which the original deposit was made ceases to be recognised for the purposes of Rule 28, either entirely or for the kind of biological material to which the deposited sample belongs, or where that institution discontinues, temporarily or definitively, the performance of its functions as regards deposited biological material, and the notification referred to in paragraph 1 from the depositary institution is not received within six months from the date of such event, the three-month period referred to in paragraph 1 shall begin on the date on which this event is announced in the Official Journal of the European Patent Office.

(4) Any new deposit shall be accompanied by a statement signed by the depositor certifying that the newly deposited biological material is the same as that originally deposited.

(5) If the new deposit has been made under the provisions of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 28 April 1977, the provisions of that Treaty shall prevail.

Rule 29

Form and content of claims

(1)⁴⁸ The claims shall define the matter for which protection is sought in terms of the technical features of the invention. Wherever appropriate claims shall contain:

(a) a statement indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art;

(b) a characterising portion - preceded by the expression "characterised in that" or "characterised by" - stating the technical features which, in combination with the features stated in sub-paragraph (a), it is desired to protect.

⁴⁸ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 1/03, G 2/03 (Anhang I).

⁴⁸ See decisions of the Enlarged Board of Appeal G 1/03, G 2/03 (Annex I).

(2) Dans le cas prévu au paragraphe 1, lettre a), le nouveau dépôt est effectué auprès de l'autorité de dépôt qui a reçu le dépôt initial; dans les cas prévus au paragraphe 1, lettre b), il peut être effectué auprès d'une autre autorité de dépôt habilitée aux fins de la règle 28.

(3) Si l'autorité de dépôt auprès de laquelle a été effectué le dépôt initial n'est plus habilitée aux fins de la règle 28, soit totalement, soit à l'égard du type de matière biologique auquel l'échantillon déposé appartient, ou si cette autorité de dépôt a cessé, temporairement ou définitivement, d'exercer ses fonctions en ce qui concerne la matière biologique déposée, et si la notification mentionnée au paragraphe 1 n'est pas faite dans les six mois suivant cet événement, le délai de trois mois défini au paragraphe 1 commence à courir à la date à laquelle le Journal officiel de l'Office européen des brevets a mentionné cet événement.

(4) Tout nouveau dépôt est accompagné d'une déclaration signée par le déposant, certifiant que la matière biologique qui fait l'objet du nouveau dépôt est la même que celle qui faisait l'objet du dépôt initial.

(5) Si le nouveau dépôt a été fait conformément au Traité de Budapest sur la reconnaissance internationale du dépôt des micro-organismes aux fins de la procédure en matière de brevets du 28 avril 1977, les dispositions de ce traité prévalent.

Règle 29

Forme et contenu des revendications

*Art. 78, 84
R. 36*

(1)⁴⁸ Les revendications doivent définir, en indiquant les caractéristiques techniques de l'invention, l'objet de la demande pour lequel la protection est recherchée. Si le cas d'espèce le justifie, les revendications doivent contenir :

a) un préambule mentionnant la désignation de l'objet de l'invention et les caractéristiques techniques qui sont nécessaires à la définition des éléments revendiqués mais qui, combinées entre elles, font partie de l'état de la technique ;

b) une partie caractérisante précédée des expressions « caractérisé en » ou « caractérisé par » et exposant les caractéristiques techniques qui, en liaison avec les caractéristiques indiquées sous a), sont celles pour lesquelles la protection est recherchée.

⁴⁸ Cf. les décisions de la Grande Chambre de recours G 1/03, G 2/03 (Annexe I).

(2)⁴⁹ Unbeschadet Artikel 82 darf eine europäische Patentanmeldung nur dann mehr als einen unabhängigen Patentanspruch in der gleichen Kategorie (Erzeugnis, Verfahren, Vorrichtung oder Verwendung) enthalten, wenn sich der Gegenstand der Anmeldung auf einen der folgenden Sachverhalte bezieht:

- a) mehrere miteinander in Beziehung stehende Erzeugnisse,
- b) verschiedene Verwendungen eines Erzeugnisses oder einer Vorrichtung,
- c) Alternativlösungen für eine bestimmte Aufgabe, sofern es nicht zweckmäßig ist, diese Alternativen in einem einzigen Anspruch wiederzugeben.

(3) Zu jedem Patentanspruch, der die wesentlichen Merkmale der Erfindung wiedergibt, können ein oder mehrere Patentansprüche aufgestellt werden, die sich auf besondere Ausführungsarten dieser Erfindung beziehen.

(4) Jeder Patentanspruch, der alle Merkmale eines anderen Patentanspruchs enthält (abhängiger Patentanspruch), hat, wenn möglich in seiner Einleitung, eine Bezugnahme auf den anderen Patentanspruch zu enthalten und nachfolgend die zusätzlichen Merkmale anzugeben, für die Schutz begehrt wird. Ein abhängiger Patentanspruch ist auch zulässig, wenn der Patentanspruch, auf den er sich unmittelbar bezieht, selbst ein abhängiger Patentanspruch ist. Alle abhängigen Patentansprüche, die sich auf einen oder mehrere vorangehende Patentansprüche beziehen, sind soweit wie möglich und auf die zweckmäßigste Weise zusammenzufassen.

(5) Die Anzahl der Patentansprüche hat sich bei Berücksichtigung der Art der beanspruchten Erfindung in vertretbaren Grenzen zu halten. Mehrere Patentansprüche sind fortlaufend mit arabischen Zahlen zu nummerieren.

(6) Die Patentansprüche dürfen sich, wenn dies nicht unbedingt erforderlich ist, im Hinblick auf die technischen Merkmale der Erfindung nicht auf Bezugnahmen auf die Beschreibung oder die Zeichnungen stützen. Sie dürfen sich insbesondere nicht auf Hinweise stützen wie: "wie beschrieben in Teil ... der Beschreibung" oder "wie in Abbildung ... der Zeichnung dargestellt".

(7) Sind der europäischen Patentanmeldung Zeichnungen beigelegt, so sollen die in den Patentansprüchen genannten technischen Merkmale mit Bezugszeichen, die auf diese Merkmale hinweisen, versehen werden, wenn dies das Verständnis des Patentanspruchs erleichtert; die Bezugszeichen sind in Klammern zu setzen. Die Bezugszeichen dürfen nicht zu einer einschränkenden Auslegung des Patentanspruchs herangezogen werden.

(2)⁴⁹ Without prejudice to Article 82, a European patent application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter of the application involves one of the following:

- (a) a plurality of inter-related products;
 - (b) different uses of a product or apparatus;
 - (c) alternative solutions to a particular problem, where it is not appropriate to cover these alternatives by a single claim.
- (3) Any claim stating the essential features of an invention may be followed by one or more claims concerning particular embodiments of that invention.

(4) Any claim which includes all the features of any other claim (dependent claim) shall contain, if possible at the beginning, a reference to the other claim and then state the additional features which it is desired to protect. A dependent claim shall also be admissible where the claim it directly refers to is itself a dependent claim. All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most appropriate way possible.

(5) The number of the claims shall be reasonable in consideration of the nature of the invention claimed. If there are several claims, they shall be numbered consecutively in Arabic numerals.

(6) Claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description or drawings. In particular, they shall not rely on such references as: "as described in part ... of the description", or "as illustrated in figure ... of the drawings".

(7) If the European patent application contains drawings, the technical features mentioned in the claims shall preferably, if the intelligibility of the claim can thereby be increased, be followed by reference signs relating to these features and placed between parentheses. These reference signs shall not be construed as limiting the claim.

⁴⁹ Geändert durch Beschluss des Verwaltungsrats vom 13.12.2001, in Kraft getreten am 02.01.2002 (ABI. EPA 2002, 2 f.).

⁴⁹ Amended by decision of the Administrative Council of 13.12.2001 which entered into force on 02.01.2002 (OJ EPO 2002, 2 ff).

(2)⁴⁹ Sans préjudice des dispositions de l'article 82, une demande de brevet européen ne peut contenir plus d'une revendication indépendante de la même catégorie (produit, procédé, dispositif ou utilisation) que si l'objet de la demande implique :

- a) plusieurs produits ayant un lien entre eux,
- b) différentes utilisations d'un produit ou d'un dispositif,
- c) des solutions alternatives à un problème particulier dans la mesure où il n'est pas approprié de rédiger une seule revendication couvrant ces alternatives.

(3) Toute revendication énonçant les caractéristiques essentielles de l'invention peut être suivie d'une ou de plusieurs revendications concernant des modes particuliers de réalisation de cette invention.

(4) Toute revendication qui contient toutes les caractéristiques d'une autre revendication (revendication dépendante) doit comporter, si possible dans le préambule, une référence à cette autre revendication et préciser les caractéristiques additionnelles pour lesquelles la protection est recherchée. Une revendication dépendante est également autorisée lorsque la revendication à laquelle elle se réfère directement est elle-même une revendication dépendante. Toutes les revendications dépendantes qui se réfèrent à une revendication antérieure unique ou à plusieurs revendications antérieures doivent, dans toute la mesure du possible, être groupées de la façon la plus appropriée.

(5) Le nombre des revendications doit être raisonnable, compte tenu de la nature de l'invention dont la protection est recherchée. S'il existe plusieurs revendications, elles doivent être numérotées de façon continue en chiffres arabes.

(6) Les revendications ne doivent pas, sauf en cas d'absolue nécessité, se fonder, pour ce qui concerne les caractéristiques techniques de l'invention, sur des références à la description ou aux dessins; en particulier, elles ne doivent pas se fonder sur des références telles que : «... comme décrit dans la partie... de la description» ou «comme illustré dans la figure... des dessins».

(7) Si la demande de brevet européen contient des dessins, les caractéristiques techniques mentionnées dans les revendications doivent, en principe, si la compréhension de la revendication s'en trouve facilitée, être suivies de signes de référence à ces caractéristiques, mis entre parenthèses. Les signes de référence ne sauraient être interprétés comme une limitation de la revendication.

⁴⁹ Modifié par décision du Conseil d'administration en date du 13.12.2001, entrée en vigueur le 02.01.2002 (JO OEB 2002, 2 s.).

*Regel 30*⁵⁰

Einheitlichkeit der Erfindung

(1) Wird in einer europäischen Patentanmeldung eine Gruppe von Erfindungen beansprucht, so ist das Erfordernis der Einheitlichkeit der Erfindung nach Artikel 82 nur erfüllt, wenn zwischen diesen Erfindungen ein technischer Zusammenhang besteht, der in einem oder mehreren gleichen oder entsprechenden besonderen technischen Merkmalen zum Ausdruck kommt. Unter dem Begriff "besondere technische Merkmale" sind diejenigen technischen Merkmale zu verstehen, die einen Beitrag jeder beanspruchten Erfindung als Ganzes zum Stand der Technik bestimmen.

(2) Die Entscheidung, ob die Erfindungen einer Gruppe untereinander in der Weise verbunden sind, dass sie eine einzige allgemeine erfinderische Idee verwirklichen, hat ohne Rücksicht darauf zu erfolgen, ob die Erfindungen in gesonderten Patentansprüchen oder als Alternativen innerhalb eines einzigen Patentanspruchs beansprucht werden.

*Regel 31*⁵¹

Gebührenpflichtige Patentansprüche

(1) Enthält eine europäische Patentanmeldung bei der Einreichung mehr als zehn Patentansprüche, so ist für jeden weiteren Patentanspruch eine Anspruchsgebühr zu entrichten. Die Anspruchsgebühren sind bis zum Ablauf eines Monats nach Einreichung der Anmeldung zu entrichten. Werden die Anspruchsgebühren nicht rechtzeitig entrichtet, so können sie noch innerhalb einer Nachfrist von einem Monat nach Zustellung einer Mitteilung, in der auf die Fristversäumung hingewiesen wird, wirksam entrichtet werden.

(2) Wird eine Anspruchsgebühr nicht innerhalb der in Absatz 1 genannten Frist entrichtet, so gilt dies als Verzicht auf den entsprechenden Patentanspruch. Eine fällig gewordene Anspruchsgebühr, die entrichtet worden ist, wird nur im Fall des Artikels 77 Absatz 5 zurückgezahlt.

Regel 32

Form der Zeichnungen

(1) Auf Blättern, die Zeichnungen enthalten, darf die benutzte Fläche 26,2 cm mal 17 cm nicht überschreiten. Die Blätter dürfen keine Umrahmungen um die benutzbare oder benutzte Fläche aufweisen. Die Mindest-ränder sind folgende:

Oberer Rand: 2,5 cm
Linker Seitenrand: 2,5 cm

⁵⁰ Geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991; anwendbar auf ab 01.06.1991 eingereichte Patentanmeldungen (ABl. EPA 1991, 4 ff.).

⁵¹ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABl. EPA 1991, 4 ff.). Siehe hierzu Rechtsauskunft Nr. 3/85 rev.

*Rule 30*⁵⁰

Unity of invention

(1) Where a group of inventions is claimed in one and the same European patent application, the requirement of unity of invention referred to in Article 82 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those features which define a contribution which each of the claimed inventions considered as a whole makes over the prior art.

(2) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

*Rule 31*⁵¹

Claims incurring fees

(1) Any European patent application comprising more than ten claims at the time of filing shall, in respect of each claim over and above that number, incur payment of a claims fee. The claims fee shall be payable within one month after the filing of the application. If the claims fees have not been paid in due time they may still be validly paid within a period of grace of one month of notification of a communication pointing out the failure to observe the time limit.

(2) If a claims fee is not paid within the period referred to in paragraph 1, the claim concerned shall be deemed to be abandoned. Any claims fee duly paid shall be refunded only in the case referred to in Article 77, paragraph 5.

Rule 32

Form of the drawings

(1) On sheets containing drawings, the usable surface area shall not exceed 26.2 cm x 17 cm. These sheets shall not contain frames round the usable or used surface. The minimum margins shall be as follows:

top 2.5 cm
left side 2.5 cm

⁵⁰ Amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991; applicable to those patent applications which have been filed on or after 01.06.1991 (OJ EPO 1991, 4 ff.).

⁵¹ Last amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff.). See Legal advice No. 3/85 rev.

Règle 30⁵⁰

Unité de l'invention

(1) Lorsqu'une pluralité d'inventions est revendiquée dans une même demande de brevet européen, la règle de l'unité de l'invention visée à l'article 82 n'est observée que s'il existe une relation technique entre ces inventions, portant sur un ou plusieurs éléments techniques particuliers identiques ou correspondants. L'expression «éléments techniques particuliers» s'entend des éléments techniques qui déterminent une contribution de chacune des inventions telles que revendiquées, considérée comme un tout, par rapport à l'état de la technique.

(2) Pour déterminer si plusieurs inventions sont liées entre elles de telle sorte qu'elles ne forment qu'un seul concept inventif général, il est indifférent que les inventions fassent l'objet de revendications distinctes ou soient présentées comme des variantes dans le cadre d'une seule et même revendication.

Règle 31⁵¹

Revendications donnant lieu au paiement de taxes

(1) Si une demande de brevet européen comporte plus de dix revendications lorsqu'elle est déposée, une taxe de revendication doit être acquittée pour toute revendication en sus de la dixième. Les taxes de revendication doivent être acquittées au plus tard à l'expiration d'un délai d'un mois à compter du dépôt de la demande. Si les taxes de revendication ne sont pas acquittées dans les délais, elles peuvent encore l'être valablement dans un délai supplémentaire d'un mois à compter de la signification d'une notification signalant que le délai prévu n'a pas été observé.

(2) En cas de défaut de paiement dans le délai prévu au paragraphe 1 d'une taxe de revendication, le demandeur est réputé avoir abandonné la revendication correspondante. Toute taxe de revendication exigible et acquittée n'est pas remboursée, sauf dans le cas visé à l'article 77, paragraphe 5.

Règle 32

Forme des dessins

(1) La surface utile des feuilles contenant les dessins ne doit pas excéder 26,2 cm x 17 cm. Il ne doit pas être laissé de cadre autour de la surface utile de ces feuilles ou autour de leur surface utilisée. Les marges minimales sont les suivantes :

marge du haut : 2,5 cm

marge de gauche : 2,5 cm

⁵⁰ Modifiée par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991; s'applique aux demandes de brevet déposées à compter du 01.06.1991 (JO OEB 1991, 4 s.).

⁵¹ Modifiée en dernier lieu par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.). Cf. le renseignement juridique n° 3/85 rév.

Rechter Seitenrand: 1,5 cm

Unterer Rand: 1 cm

(2) Die Zeichnungen sind wie folgt auszuführen:

a)⁵² Die Zeichnungen sind in widerstandsfähigen, schwarzen, ausreichend festen und dunklen, in sich gleichmäßig starken und klaren Linien oder Strichen ohne Farben oder Tönungen auszuführen.

b) Querschnitte sind durch Schraffierungen kenntlich zu machen, die die Erkennbarkeit der Bezugszeichen und Führungslinien nicht beeinträchtigen dürfen.

c)⁵³ Der Maßstab der Zeichnungen und die Klarheit der zeichnerischen Ausführung müssen gewährleisten, dass eine elektronische oder fotografische Wiedergabe auch bei Verkleinerungen auf zwei Drittel alle Einzelheiten noch ohne Schwierigkeiten erkennen lässt. Wird der Maßstab in Ausnahmefällen auf der Zeichnung angegeben, so ist er zeichnerisch darzustellen.

d) Alle Zahlen, Buchstaben und Bezugszeichen in den Zeichnungen müssen einfach und eindeutig sein. Klammern, Kreise oder Anführungszeichen dürfen bei Zahlen und Buchstaben nicht verwendet werden.

e) Alle Linien in den Zeichnungen sollen mit Zeichengeräten gezogen werden.

f) Jeder Teil der Abbildung muss im richtigen Verhältnis zu jedem anderen Teil der Abbildung stehen, sofern nicht die Verwendung eines anderen Verhältnisses für die Klarheit der Abbildung unerlässlich ist.

g) Die Ziffern und Buchstaben müssen mindestens 0,32 cm hoch sein. Für die Beschriftung der Zeichnungen sind lateinische und, soweit üblich, griechische Buchstaben zu verwenden.

h)⁵⁴ Ein Zeichnungsblatt kann mehrere Abbildungen enthalten. Sollen Abbildungen auf zwei oder mehr Blättern nur eine einzige vollständige Abbildung darstellen, so sind die Abbildungen auf den einzelnen Blättern so anzuordnen, dass die vollständige Abbildung zusammengesetzt werden kann, ohne dass ein Teil der Abbildungen auf den einzelnen Blättern verdeckt wird. Die einzelnen Abbildungen sind auf einem Blatt oder auf mehreren Blättern ohne Platzverschwendung anzuordnen, eindeutig voneinander getrennt und vorzugsweise im Hochformat; sind die Abbildungen nicht im Hochformat dargestellt, so sind sie im Querformat mit dem Kopf der Abbildungen auf der linken Seite des Blattes anzuordnen. Sie sind durch arabische Zahlen fortlaufend und unabhängig von den Zeichnungsblättern zu nummerieren.

right side 1.5 cm

bottom 1 cm

(2) Drawings shall be executed as follows:

(a)⁵² Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined, lines and strokes without colourings.

(b) Cross-sections shall be indicated by hatching which should not impede the clear reading of the reference signs and leading lines.

(c)⁵³ The scale of the drawings and the distinctness of their graphical execution shall be such that reproduction, obtained electronically or photographically, with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty. If, as an exception, the scale is given on a drawing, it shall be represented graphically.

(d) All numbers, letters, and reference signs, appearing on the drawings, shall be simple and clear. Brackets, circles or inverted commas shall not be used in association with numbers and letters.

(e) All lines in the drawings shall, ordinarily, be drawn with the aid of drafting instruments.

(f) Elements of the same figure shall be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure.

(g) The height of the numbers and letters shall not be less than 0.32 cm. For the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used.

(h)⁵⁴ The same sheet of drawings may contain several figures. Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures. The different figures shall be arranged without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not arranged in an upright position, they shall be presented sideways with the top of the figures at the left side of the sheet. The different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets.

⁵² Geändert durch Beschluss des Verwaltungsrats vom 21.12.1978, in Kraft getreten am 01.05.1979 (ABI. EPA 1979, 5, 6).

⁵³ Geändert durch Beschluss des Verwaltungsrats vom 10.12.1998, in Kraft getreten am 01.01.1999 (ABI. EPA 1999, 1 ff.).

⁵⁴ Geändert durch Beschluss des Verwaltungsrats vom 11.12.1980, in Kraft getreten am 31.01.1981 (ABI. EPA 1981, 3).

⁵² Amended by decision of the Administrative Council of 21.12.1978 which entered into force on 01.05.1979 (OJ EPO 1979, 5, 6).

⁵³ Amended by decision of the Administrative Council of 10.12.1998 which entered into force on 01.01.1999 (OJ EPO 1999, 1 ff.).

⁵⁴ Amended by decision of the Administrative Council of 11.12.1980 which entered into force on 31.01.1981 (OJ EPO 1981, 3).

marge de droite : 1,5 cm

marge du bas : 1 cm

(2) Les dessins sont exécutés comme suit :

a)⁵² Les dessins doivent être exécutés en lignes et traits durables, noirs, suffisamment denses et foncés, uniformément épais et bien délimités, sans couleurs ni lavis.

b) Les coupes sont indiquées par des hachures qui ne doivent pas nuire à une lecture facile des signes de référence et des lignes directrices.

c)⁵³ L'échelle des dessins et la clarté de leur exécution graphique doivent être telles qu'une reproduction électronique ou photographique effectuée avec réduction linéaire aux deux tiers permette d'en distinguer sans peine tous les détails. Si, par exception, l'échelle figure sur un dessin, elle doit être représentée graphiquement.

d) Tous les chiffres, lettres et signes de référence figurant dans les dessins doivent être simples et clairs. L'utilisation de parenthèses, cercles ou guillemets, en combinaison avec des chiffres et des lettres, n'est pas autorisée.

e) Toutes les lignes des dessins doivent en principe être tracées à l'aide d'instruments de dessin technique.

f) Les éléments d'une même figure doivent être en proportion les uns des autres à moins qu'une différence de proportion ne soit indispensable pour la clarté de la figure.

g) La hauteur des chiffres et lettres ne doit pas être inférieure à 0,32 cm. L'alphabet latin et, si telle est la pratique usuelle, l'alphabet grec, doivent être utilisés lorsque des lettres figurent sur les dessins.

h)⁵⁴ Une même feuille de dessin peut contenir plusieurs figures. Lorsque des figures dessinées sur plusieurs feuilles sont destinées à constituer une figure d'ensemble, elles doivent être présentées de sorte que la figure d'ensemble puisse être composée sans que soit cachée aucune partie des figures qui se trouvent sur les différentes feuilles. Les différentes figures doivent être disposées, de préférence verticalement, sur une ou plusieurs feuilles, chacune étant clairement séparée des autres mais sans place perdue; lorsque les figures ne sont pas disposées verticalement, elles doivent être présentées horizontalement, la partie supérieure des figures étant orientée du côté gauche de la feuille; elles doivent être numérotées consécutivement en chiffres arabes, indépendamment de la numérotation des feuilles.

⁵² Modifié par décision du Conseil d'administration en date du 21.12.1978, entrée en vigueur le 01.05.1979 (JO OEB 1979, 5 et 6).

⁵³ Modifiée par décision du Conseil d'administration en date du 10.12.1998, entrée en vigueur le 01.01.1999 (JO OEB 1999, 1 s.).

⁵⁴ Modifiée par décision du Conseil d'administration en date du 11.12.1980, entrée en vigueur le 31.01.1981 (JO OEB 1981, 3).

i) Bezugszeichen dürfen in den Zeichnungen nur insoweit verwendet werden, als sie in der Beschreibung und in den Patentansprüchen aufgeführt sind; das Gleiche gilt für den umgekehrten Fall. Gleiche mit Bezugszeichen gekennzeichnete Teile müssen in der ganzen Anmeldung die gleichen Zahlen erhalten.

j) Die Zeichnungen dürfen keine Erläuterungen enthalten; ausgenommen sind kurze unentbehrliche Angaben wie "Wasser", "Dampf", "Offen", "Zu", "Schnitt nach A-B" sowie in elektrischen Schaltplänen und Blockschaltbildern oder Flussdiagrammen kurze Stichworte, die für das Verständnis unentbehrlich sind. Diese Erläuterungen sind so anzubringen, dass sie im Fall der Übersetzung überklebt werden können, ohne dass die Linien der Zeichnungen verdeckt werden.

(3) Flussdiagramme und Diagramme gelten als Zeichnungen.

Regel 33

Form und Inhalt der Zusammenfassung

(1) Die Zusammenfassung muss die Bezeichnung der Erfindung enthalten.

(2) Die Zusammenfassung muss eine Kurzfassung der in der Beschreibung, den Patentansprüchen und Zeichnungen enthaltenen Offenbarung enthalten; die Kurzfassung soll das technische Gebiet der Erfindung angeben und so gefasst sein, dass sie ein klares Verständnis des technischen Problems, des entscheidenden Punkts der Lösung der Erfindung und der hauptsächlichsten Verwendungsmöglichkeiten ermöglicht. In der Zusammenfassung ist gegebenenfalls die chemische Formel anzugeben, die unter den in der europäischen Patentanmeldung enthaltenen Formeln die Erfindung am besten kennzeichnet. Sie darf keine Behauptungen über angebliche Vorzüge oder den angeblichen Wert der Erfindung oder über deren theoretische Anwendungsmöglichkeiten enthalten.

(3) Die Zusammenfassung soll aus nicht mehr als 150 Worten bestehen.

(4) Enthält die europäische Patentanmeldung Zeichnungen, so hat der Anmelder diejenigen Abbildung oder in Ausnahmefällen diejenigen Abbildungen anzugeben, die er zur Veröffentlichung mit der Zusammenfassung vorschlägt. Das Europäische Patentamt kann eine oder mehrere andere Abbildungen veröffentlichen, wenn es der Auffassung ist, dass diese die Erfindung besser kennzeichnen. Hinter jedem wesentlichen Merkmal, das in der Zusammenfassung erwähnt und durch die Zeichnung veranschaulicht ist, hat in Klammern ein Bezugszeichen zu stehen.

(5) Die Zusammenfassung ist so zu formulieren, dass sie eine wirksame Handhabe zur Sichtung des jeweiligen technischen Gebiets gibt und insbesondere eine Beurteilung der Frage ermöglicht, ob es notwendig ist, die europäische Patentanmeldung selbst einzusehen.

(i) Reference signs not mentioned in the description and claims shall not appear in the drawings, and vice versa. The same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs.

(j) The drawings shall not contain text matter, except, when absolutely indispensable, a single word or words such as "water", "steam", "open", "closed", "section on AB", and, in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords indispensable for understanding. Any such words shall be placed in such a way that, if required, they can be replaced by their translations without interfering with any lines of the drawings.

(3) Flow sheets and diagrams are considered drawings.

Rule 33

Form and content of the abstract

(1) The abstract shall indicate the title of the invention.

(2) The abstract shall contain a concise summary of the disclosure as contained in the description, the claims and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principal use or uses of the invention. The abstract shall, where applicable, contain the chemical formula which, among those contained in the application, best characterises the invention. It shall not contain statements on the alleged merits or value of the invention or on its speculative application.

(3) The abstract shall preferably not contain more than one hundred and fifty words.

(4) If the European patent application contains drawings, the applicant shall indicate the figure or, exceptionally, the figures of the drawings which he suggests should accompany the abstract when the abstract is published. The European Patent Office may decide to publish one or more other figures if it considers that they better characterise the invention. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by a reference sign, placed between parentheses.

(5) The abstract shall be so drafted that it constitutes an efficient instrument for purposes of searching in the particular technical field particularly by making it possible to assess whether there is a need for consulting the European patent application itself.

i) Des signes de référence ne peuvent être utilisés pour les dessins que s'ils figurent dans la description et dans les revendications et vice-versa. Les signes de référence des mêmes éléments doivent être identiques dans toute la demande.

j) Les dessins ne doivent pas contenir de texte, à l'exception de courtes indications indispensables telles que «eau», «vapeur», «ouvert», «fermé», «coupe suivant AB» et, dans le cas de schémas de circuits électriques, de diagrammes d'installation schématiques et de diagrammes schématisant les étapes d'un processus, à l'exception de mots clés indispensables à leur intelligence. Ces mots doivent être placés de manière telle que leur traduction éventuelle puisse leur être substituée sans que soit cachée aucune ligne des dessins.

(3) Les schémas d'étapes de processus et les diagrammes sont considérés comme des dessins.

Règle 33

Forme et contenu de l'abrégé

(1) L'abrégé doit mentionner le titre de l'invention.

(2) L'abrégé doit comprendre un résumé concis de ce qui est exposé dans la description, les revendications et les dessins; le résumé doit indiquer le domaine technique auquel appartient l'invention et doit être rédigé de manière à permettre une claire compréhension du problème technique, de l'essence de la solution de ce problème par le moyen de l'invention et de l'usage principal ou des usages principaux de l'invention. L'abrégé comporte, le cas échéant, la formule chimique qui, parmi celles qui figurent dans la demande de brevet, caractérise le mieux l'invention. Il ne doit pas contenir de déclarations relatives aux mérites ou à la valeur allégués de l'invention ou à ses applications supputées.

(3) L'abrégé ne peut, de préférence, comporter plus de cent cinquante mots.

(4) Si la demande de brevet européen comporte des dessins, le demandeur doit indiquer la figure du dessin ou, exceptionnellement, les figures des dessins qu'il propose de faire publier avec l'abrégé. L'Office européen des brevets peut décider de publier une autre figure ou plusieurs autres figures s'il estime qu'elle caractérise ou qu'elles caractérisent mieux l'invention. Chacune des caractéristiques principales mentionnées dans l'abrégé et illustrées par le dessin doit être suivie d'un signe de référence entre parenthèses.

(5) L'abrégé doit être rédigé de façon à constituer un instrument efficace de sélection dans le domaine technique en cause, notamment en permettant d'apprécier s'il y a lieu de consulter la demande de brevet elle-même.

Regel 34

Unzulässige Angaben

(1) Die europäische Patentanmeldung darf nicht enthalten:

a) Angaben oder Zeichnungen, die gegen die öffentliche Ordnung oder die guten Sitten verstoßen;

b) herabsetzende Äußerungen über Erzeugnisse oder Verfahren Dritter oder den Wert oder die Gültigkeit von Anmeldungen oder Patenten Dritter. Reine Vergleiche mit dem Stand der Technik allein gelten nicht als herabsetzend;

c) Angaben, die den Umständen nach offensichtlich belanglos oder unnötig sind.

(2) Enthält eine europäische Patentanmeldung Angaben oder Zeichnungen im Sinn des Absatzes 1 Buchstabe a, so schließt das Europäische Patentamt diese Angaben bei der Veröffentlichung aus und gibt dabei die Stelle der Auslassung sowie die Zahl der ausgelassenen Wörter und Zeichnungen an.

(3) Enthält eine europäische Patentanmeldung Äußerungen im Sinn des Absatzes 1 Buchstabe b, so kann das Europäische Patentamt diese Angaben bei der Veröffentlichung der Anmeldung ausschließen. Dabei gibt es die Stelle der Auslassung und die Zahl der ausgelassenen Wörter an und stellt auf Antrag eine Abschrift der ausgelassenen Stellen zur Verfügung.

Regel 35⁵⁵

Allgemeine Bestimmungen über die Form der Anmeldungsunterlagen

(1) Die in Artikel 14 Absatz 2 genannten Übersetzungen gelten als Unterlagen der europäischen Patentanmeldung.

(2)⁵⁶ Die Unterlagen der europäischen Patentanmeldung sind in drei Stücken einzureichen. Der Präsident des Europäischen Patentamts kann jedoch bestimmen, dass die Unterlagen in weniger als drei Stücken einzureichen sind.

Rule 34

Prohibited matter

(1) The European patent application shall not contain:

(a) statements or other matter contrary to "ordre public" or morality;

(b) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person. Mere comparisons with the prior art shall not be considered disparaging per se;

(c) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

(2) If a European patent application contains prohibited matter within the meaning of paragraph 1(a), the European Patent Office shall omit it when publishing the application, indicating the place and number of words or drawings omitted.

(3) If a European patent application contains statements within the meaning of paragraph 1(b), the European Patent Office may omit them when publishing the application. It shall indicate the place and number of words omitted, and shall furnish, upon request, a copy of the passages omitted.

Rule 35⁵⁵

General provisions governing the presentation of the application documents

(1) Translations mentioned in Article 14, paragraph 2, shall be considered to be included in the term "documents making up the European patent application".

(2)⁵⁶ The documents making up the European patent application shall be filed in three copies. The President of the European Patent Office may, however, determine that the documents shall be filed in fewer than three copies.

⁵⁵ Geändert durch Beschlüsse des Verwaltungsrats vom 21.12.1978, in Kraft getreten am 01.05.1979 (ABI. EPA 1979, 5, 6), vom 11.12.1980, in Kraft getreten am 31.01.1981 (ABI. EPA 1981, 3 u. 4), vom 08.12.1988, in Kraft getreten am 01.04.1989 (ABI. EPA 1989, 1), vom 13.12.1994, in Kraft getreten am 01.06.1995 (ABI. EPA 1995, 9 ff.), und vom 10.12.1998, in Kraft getreten am 01.01.1999 (ABI. EPA 1999, 1 ff.).

⁵⁶ Siehe Beschluss des Präsidenten des EPA vom 15.11.2001 über die Stückzahl, in der die Unterlagen der europäischen Patentanmeldung einzureichen sind (ABI. EPA 2001, 563).

⁵⁵ Amended by decisions of the Administrative Council of 21.12.1978 which entered into force on 01.05.1979 (OJ EPO 1979, 5, 6), of 11.12.1980 which entered into force on 31.01.1981 (OJ EPO 1981, 3, 4), of 08.12.1988 which entered into force on 01.04.1989 (OJ EPO 1989, 1), of 13.12.1994 which entered into force on 01.06.1995 (OJ EPO 1995, 9 ff) and of 10.12.1998 which entered into force on 01.01.1999 (OJ EPO 1999, 1 ff).

⁵⁶ See decision of the President of the EPO dated 15.11.2001 concerning the number of copies to be filed of the documents making up the European patent application (OJ EPO 2001, 563).

Règle 34

Eléments prohibés

Art. 78, 93

R. 36

(1) La demande de brevet européen ne doit pas contenir :

a) des éléments ou dessins contraires à l'ordre public ou aux bonnes mœurs ;

b) des déclarations dénigrantes concernant des produits ou procédés de tiers ou le mérite ou la validité de demandes de brevet ou de brevets de tiers. De simples comparaisons avec l'état de la technique ne sont pas considérées comme dénigrantes en elles-mêmes ;

c) des éléments manifestement étrangers au sujet ou superflus.

(2) Lorsqu'une demande de brevet européen contient des éléments et dessins visés au paragraphe 1, lettre a), l'Office européen des brevets les omet lors de la publication en indiquant la place et le nombre des mots et des dessins omis.

(3) Lorsqu'une demande de brevet européen contient des déclarations visées au paragraphe 1, lettre b), l'Office européen des brevets peut les omettre lors de la publication de la demande. Dans ce cas, il indique la place et le nombre des mots omis, et fournit, sur demande, une copie des passages ayant fait l'objet de l'omission.

*Règle 35*⁵⁵

Dispositions générales relatives à la présentation de pièces de la demande

Art. 78, 84, 85

R. 36, 40

(1) Les traductions visées à l'article 14, paragraphe 2, sont considérées comme des pièces de la demande.

(2)⁵⁶ Les pièces de la demande de brevet européen doivent être produites en trois exemplaires. Toutefois, le Président de l'Office européen des brevets peut décider que les pièces doivent être produites en moins de trois exemplaires.

⁵⁵ Modifiée par les décisions suivantes du Conseil d'administration: décision en date du 21.12.1978, entrée en vigueur le 01.05.1979 (JO OEB 1979, 5 et 6), décision du 11.12.1980, entrée en vigueur le 31.01.1981 (JO OEB 1981, 3 et 4), décision du 08.12.1988, entrée en vigueur le 01.04.1989 (JO OEB 1989, 1), décision du 13.12.1994, entrée en vigueur le 01.06.1995 (JO OEB 1995, 9 s.) et décision du 10.12.1998, entrée en vigueur le 01.01.1999 (JO OEB 1999, 1 s.).

⁵⁶ Cf. la décision du Président de l'OEB, en date du 15.11.2001, concernant le nombre d'exemplaires à produire des pièces de la demande de brevet européen (JO OEB 2001, 563).

(3) Die Unterlagen der europäischen Patentanmeldung sind in einer Form einzureichen, die gewährleistet, dass eine elektronische sowie eine unmittelbare Vervielfältigung, insbesondere durch Scanning, Fotografie, elektrostatisches Verfahren, FotoOffsetdruck und Mikroverfilmung, in einer unbeschränkten Stückzahl vorgenommen werden kann. Die Blätter müssen glatt und knitterfrei sein. Sie dürfen nicht gefaltet sein und sind einseitig zu beschriften.

(4) Die Unterlagen der europäischen Patentanmeldung sind auf biegsamem, festem, weißem, glattem, mattem und widerstandsfähigem Papier im Format A 4 (29,7 cm mal 21 cm) einzureichen. Vorbehaltlich Regel 32 Absatz 2 Buchstabe h sowie des Absatzes 1 ist jedes Blatt in der Weise zu verwenden, dass die kurzen Seiten oben und unten erscheinen (Hochformat).

(5) Jeder Bestandteil der europäischen Patentanmeldung (Antrag, Beschreibung, Patentansprüche, Zeichnungen und Zusammenfassung) muss auf einem neuen Blatt beginnen. Alle Blätter müssen so miteinander verbunden sein, dass sie leicht gewendet sowie leicht entfernt und wieder miteinander verbunden werden können.

(6) Vorbehaltlich der Regel 32 Absatz 1 sind auf den Blättern als Mindestränder folgende Flächen unbeschriftet zu lassen:

Oberer Rand: 2 cm
Linker Seitenrand: 2,5 cm
Rechter Seitenrand: 2 cm
Unterer Rand: 2 cm

Die empfohlenen Höchstmaße für die vorstehenden Ränder sind folgende:

Oberer Rand: 4 cm
Linker Seitenrand: 4 cm
Rechter Seitenrand: 3 cm
Unterer Rand: 3 cm

(7) Die Ränder der Blätter müssen bei der Einreichung der europäischen Patentanmeldung vollständig unbenutzt sein.

(8) Alle Blätter der europäischen Patentanmeldung sind fortlaufend mit arabischen Zahlen zu nummerieren. Die Blattzahlen sind oben in der Mitte, aber nicht auf dem oberen Rand anzubringen.

(9) Auf jedem Blatt der Beschreibung und der Patentansprüche soll jede fünfte Zeile nummeriert sein. Die Zahlen sind an der linken Seite, rechts vom Rand anzubringen.

(3) The documents making up the European patent application shall be so presented as to admit of electronic as well as of direct reproduction, in particular by scanning, photography, electrostatic processes, photo offset and micro filming, in an unlimited number of copies. All sheets shall be free from cracks, creases and folds. Only one side of the sheet shall be used.

(4) The documents making up the European patent application shall be on A 4 paper (29.7 cm x 21 cm) which shall be pliable, strong, white, smooth, matt and durable. Subject to the provisions of Rule 32, paragraph 2(h), and paragraph 11 of this Rule, each sheet shall be used with its short sides at the top and bottom (upright position).

(5) Each of the documents making up the European patent application (request, description, claims, drawings and abstract) shall commence on a new sheet. The sheets shall be connected in such a way that they can easily be turned over, separated and joined together again.

(6) Subject to Rule 32, paragraph 1, the minimum margins shall be as follows:

top: 2 cm
left side: 2.5 cm
right side: 2 cm
bottom: 2 cm

The recommended maximum for the margins quoted above is as follows:

top: 4 cm
left side: 4 cm
right side: 3 cm
bottom: 3 cm

(7) The margins of the documents making up the European patent application, when submitted, must be completely blank.

(8) All the sheets contained in the European patent application shall be numbered in consecutive Arabic numerals. These shall be placed at the top of the sheet, in the middle, but not in the top margin.

(9) The lines of each sheet of the description and of the claims shall preferably be numbered in sets of five, the numbers appearing on the left side, to the right of the margin.

(3) Les pièces de la demande de brevet européen doivent être présentées de manière à permettre leur reproduction tant électronique que directe, en particulier par le moyen de la numérisation, de la photographie, de procédés électriques, de l'offset et du microfilm en un nombre illimité d'exemplaires. Les feuilles ne doivent pas être déchirées, froissées ou pliées. Un seul côté des feuilles doit être utilisé.

(4) Les pièces de la demande de brevet européen doivent être remises sur papier souple, fort, blanc, lisse, mat et durable, de format A4 (29,7 cm x 21 cm). Sous réserve de la règle 32, paragraphe 2, lettre h) et de la présente règle, paragraphe 11, chaque feuille doit être utilisée de façon à ce que les petits côtés se trouvent en haut et en bas (sens vertical).

(5) Le début de chaque pièce de la demande de brevet européen (requête, description, revendications, dessins, abrégé) doit figurer sur une nouvelle feuille. Toutes les feuilles doivent être réunies de façon à pouvoir être facilement feuilletées et aisément séparées et réunies à nouveau.

(6) Sous réserve de la règle 32, paragraphe 1, les marges minimales doivent être les suivantes :

marge du haut : 2 cm

marge de gauche : 2,5 cm

marge de droite : 2 cm

marge du bas : 2 cm

Le maximum recommandé des marges citées ci-dessus est le suivant :

marge du haut : 4 cm

marge de gauche : 4 cm

marge de droite : 3 cm

marge du bas : 3 cm

(7) Les marges des feuilles doivent être totalement vierges lors du dépôt de la demande de brevet européen.

(8) Toutes les feuilles de la demande de brevet européen doivent être numérotées consécutivement en chiffres arabes. Les numéros des feuilles doivent être inscrits en haut des feuilles au milieu, mais non dans la marge du haut.

(9) Les lignes de chaque feuille de la description et des revendications doivent en principe être numérotées de cinq en cinq, les numéros étant portés sur le côté gauche, à droite de la marge.

(10) Der Antrag auf Erteilung eines europäischen Patents, die Beschreibung, die Patentansprüche und die Zusammenfassung müssen mit Maschine geschrieben oder gedruckt sein. Nur grafische Symbole und Schriftzeichen, chemische oder mathematische Formeln können, falls notwendig, handgeschrieben oder gezeichnet sein. Der Zeilenabstand hat 1 1/2zeilig zu sein. Alle Texte müssen in Buchstaben, deren Großbuchstaben eine Mindesthöhe von 0,21 cm besitzen, und mit dunkler unauslöschlicher Farbe geschrieben sein.

(11) Der Antrag auf Erteilung eines europäischen Patents, die Beschreibung, die Patentansprüche und die Zusammenfassung dürfen keine Zeichnungen enthalten. Die Beschreibung, die Patentansprüche und die Zusammenfassung können chemische oder mathematische Formeln enthalten. Die Beschreibung und die Zusammenfassung können Tabellen enthalten. Ein Patentanspruch darf dies nur dann, wenn sein Gegenstand die Verwendung von Tabellen wünschenswert erscheinen lässt. Tabellen sowie chemische oder mathematische Formeln können im Querformat wiedergegeben werden, wenn sie im Hochformat nicht befriedigend dargestellt werden können; Blätter, auf denen Tabellen oder chemische oder mathematische Formeln im Querformat wiedergegeben werden, sind so anzuordnen, dass der Kopf der Tabellen oder Formeln auf der linken Seite des Blattes erscheint.

(12) Physikalische Größen sind in den in der internationalen Praxis anerkannten Einheiten anzugeben, soweit zweckdienlich nach dem metrischen System unter Verwendung der SI-Einheiten. Soweit Angaben diesem Erfordernis nicht genügen, sind die in der internationalen Praxis anerkannten Einheiten zusätzlich anzugeben. Für mathematische Formeln sind die allgemein üblichen Schreibweisen und für chemische Formeln die allgemein üblichen Symbole, Atomgewichte und Molekularformeln zu verwenden. Grundsätzlich sind nur solche technische Bezeichnungen, Zeichen und Symbole zu verwenden, die auf dem Fachgebiet allgemein anerkannt sind.

(13) Terminologie und Zeichen sind in der gesamten europäischen Patentanmeldung einheitlich zu verwenden.

(14) Jedes Blatt muss weitgehend frei von Radierstellen und frei von Änderungen, Überschreibungen und Zwischenbeschriftungen sein. Von diesem Erfordernis kann abgesehen werden, wenn der verbindliche Text dadurch nicht in Frage gestellt wird und die Voraussetzungen für eine gute Vervielfältigung nicht gefährdet sind.

(10) The request for the grant of a European patent, the description, the claims and the abstract shall be typed or printed. Only graphic symbols and characters and chemical or mathematical formulae may, if necessary, be written by hand or drawn. The typing shall be 1 ½ spaced. All text matter shall be in characters, the capital letters of which are not less than 0.21 cm high, and shall be in a dark, indelible colour.

(11) The request for the grant of a European patent, the description, the claims and the abstract shall not contain drawings. The description, the claims and the abstract may contain chemical or mathematical formulae. The description and the abstract may contain tables. The claims may contain tables only if their subject-matter makes the use of tables desirable. Tables and chemical or mathematical formulae may be placed sideways on the sheet if they cannot be presented satisfactorily in an upright position thereon; sheets on which tables or chemical or mathematical formulae are presented sideways shall be so presented that the tops of the tables or formulae are at the left side of the sheet.

(12) Physical values shall be expressed in the units recognised in international practice, wherever appropriate in terms of the metric system using SI units. Any data not meeting this requirement must also be expressed in the units recognised in international practice. For mathematical formulae the symbols in general use shall be employed. For chemical formulae the symbols, atomic weights and molecular formulae in general use shall be employed. In general, use should be made of the technical terms, signs and symbols generally accepted in the field in question.

(13) The terminology and the signs shall be consistent throughout the European patent application.

(14) Each sheet shall be reasonably free from erasures and shall be free from alterations, overwritings and interlineations. Non-compliance with this rule may be authorised if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

(10) La requête en délivrance du brevet européen, la description, les revendications et l'abrégé doivent être dactylographiés ou imprimés. Seuls les symboles et caractères graphiques, les formules chimiques ou mathématiques peuvent être manuscrits ou dessinés, en cas de nécessité. Pour les textes dactylographiés, l'interligne doit être de 1 1/2. Tous les textes doivent être écrits en caractères dont les majuscules ont au moins 0,21 cm de haut, dans une couleur noire et indélébile.

(11) La requête en délivrance du brevet européen, la description, les revendications et l'abrégé ne doivent pas comporter de dessins. La description, les revendications et l'abrégé peuvent comporter des formules chimiques ou mathématiques. La description et l'abrégé peuvent comporter des tableaux. Les revendications ne peuvent comporter des tableaux que si l'objet desdites revendications en fait apparaître l'intérêt. Les tableaux et les formules mathématiques ou chimiques peuvent être disposés horizontalement sur la feuille s'ils ne peuvent être présentés convenablement verticalement; les feuilles sur lesquelles les tableaux ou les formules mathématiques ou chimiques sont présentés horizontalement, le sont de telle sorte que les parties supérieures des tableaux ou des formules soient orientées du côté gauche de la feuille.

(12) Les indications physiques doivent être exprimées en unités de la pratique internationale, et, si le cas d'espèce le justifie, selon le système métrique en utilisant les unités SI. Toute indication ne répondant pas à cette exigence devra en outre être exprimée en unités de la pratique internationale. Doivent être utilisés, pour les formules mathématiques, les symboles généralement en usage et pour les formules chimiques, les symboles, poids atomiques et formules moléculaires généralement en usage. En règle générale, seuls les termes, signes et symboles techniques généralement acceptés dans le domaine considéré doivent être utilisés.

(13) La terminologie et les signes de la demande de brevet européen doivent être uniformes.

(14) Aucune feuille ne doit être gommée plus qu'il n'est raisonnable ni comporter de corrections, de surcharges ni d'interlinéations. Des dérogations à cette règle peuvent être autorisées si l'authenticité du contenu n'est pas en cause et si elles ne nuisent pas aux conditions nécessaires à une bonne reproduction.

Regel 36

Unterlagen nach Einreichung der europäischen Patentanmeldung

(1)⁵⁷ Die Regeln 27, 29 und 32 bis 35 sind auf Schriftstücke, die die Unterlagen der europäischen Patentanmeldung ersetzen, anzuwenden. Regel 35 Absätze 2 bis 14 ist ferner auf die in Regel 51 genannten Übersetzungen der Patentansprüche anzuwenden.

(2)⁵⁸ Alle anderen als die in Absatz 1 Satz 1 genannten Schriftstücke sollen mit Maschine geschrieben oder gedruckt sein. Auf jedem Blatt ist links ein etwa 2,5 cm breiter Rand freizulassen.

(3)⁵⁹ Die nach Einreichung der europäischen Patentanmeldung einzureichenden Schriftstücke sind zu unterzeichnen, soweit es sich nicht um Anlagen handelt. Ist ein Schriftstück nicht unterzeichnet worden, so fordert das Europäische Patentamt den Beteiligten auf, das Schriftstück innerhalb einer vom Europäischen Patentamt zu bestimmenden Frist zu unterzeichnen. Wird das Schriftstück rechtzeitig unterzeichnet, so behält es den ursprünglichen Tag des Eingangs, anderenfalls gilt das Schriftstück als nicht eingegangen.

(4) Schriftstücke, die anderen Personen mitzuteilen sind oder die mehrere europäische Patentanmeldungen oder europäische Patente betreffen, sind in der entsprechenden Stückzahl einzureichen. Kommt ein Beteiligter dieser Verpflichtung trotz Aufforderung des Europäischen Patentamts nicht nach, so werden die fehlenden Stücke auf Kosten des Beteiligten angefertigt.

Rule 36

Documents filed subsequently

(1)⁵⁷ Rules 27, 29 and 32 to 35 shall apply to documents replacing documents making up the European patent application. Rule 35, paragraphs 2 to 14, shall also apply to the translation of the claims referred to in Rule 51.

(2)⁵⁸ All documents other than those referred to in the first sentence of paragraph 1 shall normally be typewritten or printed. There must be a margin of about 2.5 cm on the left-hand side of each page.

(3)⁵⁹ All documents, with the exception of annexed documents, filed after filing of the European patent application must be signed. If a document has not been signed, the European Patent Office shall invite the party concerned to do so within a time limit to be laid down by that Office. If signed in due time, the document shall retain its original date of receipt; otherwise it shall be deemed not to have been received.

(4) Such documents as must be communicated to other persons or as relate to two or more European patent applications or European patents, must be filed in a sufficient number of copies. If the party concerned does not comply with this obligation in spite of a request by the European Patent Office, the missing copies shall be provided at the expense of the party concerned.

⁵⁷ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 18.10.2001, in Kraft getreten am 01.07.2002 (ABl. EPA 2001, 488 ff.).

⁵⁸ Geändert durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABl. EPA 1978, 12 ff.), und vom 10.06.1988, in Kraft getreten am 01.10.1988 (ABl. EPA 1988, 290 ff.).

⁵⁹ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/99 (Anhang I).

⁵⁷ Last amended by decision of the Administrative Council of 18.10.2001 which entered into force on 01.07.2002 (OJ EPO 2001, 488 ff).

⁵⁸ Amended by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff) and of 10.06.1988 which entered into force on 01.10.1988 (OJ EPO 1988, 290 ff).

⁵⁹ See decision of the Enlarged Board of Appeal G 3/99 (Annex I).

Documents produits ultérieurement

Art. 78

R. 40

(1)⁵⁷ Les règles 27, 29 et 32 à 35 s'appliquent aux documents remplaçant des pièces de la demande de brevet européen. La règle 35, paragraphes 2 à 14, s'applique en outre aux traductions des revendications visées à la règle 51.

(2)⁵⁸ Tous documents autres que ceux visés au paragraphe 1, première phrase, doivent, en principe, être dactylographiés ou imprimés. Une marge d'environ 2,5 cm doit être réservée sur le côté gauche de la feuille.

(3)⁵⁹ A l'exclusion des pièces annexes, les documents postérieurs au dépôt de la demande de brevet européen doivent être signés. Si un document n'est pas signé, l'Office européen des brevets invite l'intéressé, dans un délai qu'il lui impartit, à remédier à cette irrégularité. Si le document est signé dans les délais, il garde le bénéfice de sa date. Dans le cas contraire, le document est réputé n'avoir pas été reçu.

(4) Les documents qui doivent être communiqués à d'autres personnes, ou qui concernent plusieurs demandes de brevet européen ou plusieurs brevets européens, doivent être produits en un nombre suffisant d'exemplaires. Les exemplaires manquants sont établis aux frais de l'intéressé, si celui-ci ne se conforme pas à cette obligation malgré l'injonction de l'Office européen des brevets.

⁵⁷ Modifié en dernier lieu par décision du Conseil d'administration en date du 18.10.2001, entrée en vigueur le 01.07.2002 (JO OEB 2001, 488 s.)

⁵⁸ Modifié par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.) et celle en date du 10.06.1988, entrée en vigueur le 01.10.1988 (JO OEB 1988, 290 s.).

⁵⁹ Cf. la décision de la Grande Chambre de recours G 3/99 (Annexe I).

(5)⁶⁰ Der Präsident des Europäischen Patentamts kann bestimmen, dass nach Einreichung der europäischen Patentanmeldung Unterlagen abweichend von den Absätzen 2 bis 4 beim Europäischen Patentamt auf andere Weise mittels technischer Einrichtungen zur Nachrichtenübermittlung eingereicht werden können, und die Bedingungen für deren Benutzung festlegen. Er kann insbesondere bestimmen, dass innerhalb einer von ihm festgesetzten Frist ein Schriftstück nachzureichen ist, das den Inhalt der auf diese Weise eingereichten Unterlagen wiedergibt und dieser Ausführungsordnung entspricht; wird dieses Schriftstück nicht rechtzeitig eingereicht, so gelten die Unterlagen als nicht eingegangen.

Kapitel III

Jahresgebühren

Regel 37

Fälligkeit

(1) Die Jahresgebühren für die europäische Patentanmeldung sind jeweils für das kommende Jahr am letzten Tag des Monats fällig, der durch seine Benennung dem Monat entspricht, in den der Anmeldetag für diese Anmeldung fällt. Die Jahresgebühr kann frühestens ein Jahr vor ihrer Fälligkeit wirksam entrichtet werden.⁶¹

(2)⁶² Die Zuschlagsgebühr gilt im Sinn des Artikels 86 Absatz 2 als gleichzeitig mit der Jahresgebühr entrichtet, wenn sie innerhalb der in dieser Vorschrift vorgeschriebenen Frist entrichtet wird.

(5)⁶⁰ Notwithstanding paragraphs 2 to 4 the President of the European Patent Office may permit documents filed after filing of the European patent application to be transmitted to the European Patent Office by other means of communication and lay down conditions governing their use. He may, in particular, require that within a period laid down by him written confirmation be supplied reproducing the contents of documents so filed and complying with the requirements of these Implementing Regulations; if such confirmation is not supplied in due time, the documents shall be deemed not to have been received.

Chapter III

Renewal fees

Rule 37

Payment of renewal fees

(1) Renewal fees for the European patent application in respect of the coming year shall be due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees may not be validly paid more than one year before they fall due⁶¹.

(2)⁶² An additional fee shall be deemed to have been paid at the same time as the renewal fee within the meaning of Article 86, paragraph 2, if it is paid within the period laid down in that provision.

⁶⁰ Geändert durch Beschluss des Verwaltungsrats vom 05.06.1987, in Kraft getreten am 01.10.1987 (ABl. EPA 1987, 274). Siehe hierzu die Beschlüsse des Präsidenten des EPA vom 29.10.2002 über die elektronische Einreichung von europäischen Patentanmeldungen und anderen Unterlagen (ABl. EPA 2002, 543 ff.), vom 06.12.2004 über die Einreichung von Patentanmeldungen und anderen Unterlagen durch Telefax (ABl. EPA 2005, 41 ff.) und die Mitteilungen des EPA vom 29.10.2002 über die elektronische Einreichung von Patentanmeldungen und anderen Unterlagen (ABl. EPA 2002, 545 ff.) und vom 06.12.2004 über die Einreichung von Patentanmeldungen und anderen Unterlagen (ABl. EPA 2005, 44 ff.).

⁶¹ Absatz 1 Satz 3 und Absatz 2 aufgehoben durch Beschluss des Verwaltungsrats vom 05.12.1986, in Kraft getreten am 05.12.1986 (ABl. EPA 1987, 4).

⁶² Eingefügt durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABl. EPA 1978, 12 ff.) - früher Absatz (2a).

⁶⁰ Amended by decision of the Administrative Council of 05.06.1987 which entered into force on 01.10.1987 (OJ EPO 1987, 274). See decisions of the President of the EPO dated 29.10.2002 on the electronic filing of European patent applications and subsequent documents (OJ EPO 2002, 543 ff), dated 06.12.2004 on the use of facsimile for filing patent applications and other documents (OJ EPO 2005, 41 ff), and the notices from the EPO dated 29.10.2002 concerning the electronic filing of patent applications and other documents (OJ EPO 2002, 545 ff) and dated 06.12.2004 concerning the filing of patent applications and other documents (OJ EPO 2005, 44 ff).

⁶¹ Third sentence of paragraph 1 and paragraph 2 deleted by decision of the Administrative Council of 05.12.1986 which entered into force on 05.12.1986 (OJ EPO 1987, 4).

⁶² Inserted by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff) - formerly paragraph (2a).

(5)⁶⁰ Le Président de l'Office européen des brevets peut décider que, par dérogation aux dispositions des paragraphes 2, 3 et 4, les documents postérieurs au dépôt de la demande de brevet européen peuvent être adressés à l'Office européen des brevets également par des moyens techniques de communication, dont il arrête les conditions d'utilisation. Il peut notamment décider qu'une pièce reproduisant par écrit le contenu des documents ainsi adressés et répondant aux prescriptions du présent règlement doit être produite dans un délai fixé par lui. Si cette pièce n'est pas produite dans les délais, les documents sont réputés non reçus.

Verweisungen / References / Références

Chapitre III

Taxes annuelles

Règle 37

Paiement des taxes annuelles

(1) Le paiement pour une demande de brevet européen des taxes annuelles au titre de l'année à venir vient à échéance le dernier jour du mois de la date anniversaire du dépôt de la demande de brevet européen. La taxe annuelle ne peut être valablement acquittée plus d'une année avant son échéance⁶¹.

(2)⁶² Au sens de l'article 86, paragraphe 2, la surtaxe est considérée comme ayant fait l'objet d'un paiement simultané lorsqu'elle est acquittée dans le délai prévu par ladite disposition.

R. 107

Remarque : En ce qui concerne les mots «la date anniversaire du dépôt» figurant dans la règle 37, paragraphe 1, première phrase, voir la remarque relative à l'article 86(1) de la Convention.

⁶⁰ Modifié par décision du Conseil d'administration en date du 05.06.1987, entrée en vigueur le 01.10.1987 (JO OEB 1987, 274). Cf. la décision du Président de l'OEB en date du 29.10.2002, relative au dépôt électronique de demandes de brevet européen et de documents produits ultérieurement (JO OEB 2002, 543 s.) et la décision du Président de l'OEB, en date du 06.12.2004, relative au dépôt de demandes de brevet et d'autres pièces par téléfax (JO OEB 2005, 41 s.), et les communiqués de l'OEB, en date du 29.10.2002, relatif au dépôt électronique de demandes de brevet et de documents produits ultérieurement (JO OEB 2002, 545 s.) et en date du 06.12.2004, relatif au dépôt de demandes de brevet et d'autres pièces (JO OEB 2005, 44 s.).

⁶¹ La troisième phrase du paragraphe 1 et le paragraphe 2 ont été supprimés par décision du Conseil d'administration en date du 05.12.1986, entrée en vigueur le 05.12.1986 (JO OEB 1987, 4).

⁶² Inséré par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur, le 01.02.1978 (JO OEB 1978, 12 s.) - ancien paragraphe (2bis).

(3)⁶³ Jahresgebühren, die für eine frühere Patentanmeldung bis zu dem Tag der Einreichung einer europäischen Teilanmeldung fällig geworden sind, sind auch für die Teilanmeldung zu entrichten und werden mit Einreichung der Teilanmeldung fällig. Diese Gebühren und eine Jahresgebühr, die bis zum Ablauf von vier Monaten nach Einreichung der Teilanmeldung fällig wird, können innerhalb dieser Frist ohne Zuschlagsgebühr entrichtet werden. Erfolgt die Zahlung nicht rechtzeitig, so können die Jahresgebühren noch innerhalb von sechs Monaten nach Fälligkeit wirksam entrichtet werden, sofern gleichzeitig die Zuschlagsgebühr nach Artikel 86 Absatz 2 entrichtet wird.

(4) Für eine nach Artikel 61 Absatz 1 Buchstabe b eingereichte neue europäische Patentanmeldung sind Jahresgebühren für das Jahr, in dem diese Anmeldung eingereicht worden ist, und für vorhergehende Jahre nicht zu entrichten.

Kapitel IV

Priorität

Regel 38⁶⁴

Prioritätserklärung und Prioritätsunterlagen

(1) Die in Artikel 88 Absatz 1 genannte Prioritätserklärung besteht aus einer Erklärung über den Tag der früheren Anmeldung und den Staat, in dem oder für den sie eingereicht worden ist, sowie aus der Angabe des Aktenzeichens.

(2) Die Erklärung über den Tag und den Staat der früheren Anmeldung ist bei Einreichung der europäischen Patentanmeldung anzugeben; das Aktenzeichen ist vor Ablauf des sechzehnten Monats nach dem Prioritätstag zu nennen.

(3) Die Abschrift der früheren Anmeldung ist vor Ablauf des sechzehnten Monats nach dem Prioritätstag einzureichen. Die Abschrift muss von der Behörde, bei der die frühere Anmeldung eingereicht worden ist, als mit der früheren Anmeldung übereinstimmend bescheinigt sein; der Abschrift ist eine Bescheinigung dieser Behörde über den Tag der Einreichung der früheren Anmeldung beizufügen.

(4)⁶⁵ Die Abschrift der früheren Anmeldung gilt als ordnungsgemäß eingereicht, wenn eine dem Europäischen Patentamt zugängliche Abschrift dieser Anmeldung unter den vom Präsidenten des Europäischen Patentamts festgelegten Bedingungen in die Akte der europäischen Patentanmeldung aufzunehmen ist.

⁶³ Geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.).

⁶⁴ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 18.10.2001, in Kraft getreten am 01.07.2002 (ABI. EPA 2001, 488 ff.).

⁶⁵ Siehe hierzu den Beschluss des Präsidenten des EPA vom 22.12.1998 (ABI. EPA 1999, 80).

(3)⁶³ Renewal fees already due in respect of an earlier application up to the date on which a European divisional application is filed must also be paid for the divisional application and fall due when the latter is filed. These fees and any renewal fee falling due within a period of four months from the filing of the divisional application may be paid without an additional fee within that period. If payment is not made in due time, the renewal fees may still be validly paid within six months of the due date, provided that the additional fee under Article 86, paragraph 2, is paid at the same time.

(4) Renewal fees shall not be payable for a new European patent application filed pursuant to Article 61, paragraph 1(b), in respect of the year in which it was actually filed and any preceding year.

Chapter IV

Priority

Rule 38⁶⁴

Declaration of priority and priority documents

(1) The declaration of priority referred to in Article 88, paragraph 1, shall state the date of the previous filing and the State in or for which it was made and shall indicate the file number.

(2) The date and State of the previous filing must be stated on filing the European patent application; the file number shall be indicated before the end of the sixteenth month after the date of priority.

(3) The copy of the previous application must be filed before the end of the sixteenth month after the date of priority. The copy must be certified as an exact copy of the previous application by the authority which received the previous application and must be accompanied by a certificate issued by that authority stating the date of filing of the previous application.

(4)⁶⁵ The copy of the previous application shall be deemed duly filed if a copy of that application available to the European Patent Office is to be included in the file of the European patent application under the conditions laid down by the President of the European Patent Office.

⁶³ Amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff.).

⁶⁴ Last amended by decision of the Administrative Council of 18.10.2001 which entered into force on 01.07.2002 (OJ EPO 2001, 488 ff.).

⁶⁵ See decision of the President of the EPO dated 22.12.1998 (OJ EPO 1999, 80).

(3)⁶³ Les taxes annuelles exigibles pour une demande initiale jusqu'à la date à laquelle une demande divisionnaire de brevet européen est déposée doivent également être acquittées pour la demande divisionnaire et elles sont exigibles lorsque cette dernière est déposée. Ces taxes ainsi que toute taxe annuelle exigible dans un délai de quatre mois à compter du dépôt de la demande divisionnaire peuvent être acquittées sans surtaxe dans ledit délai. Si le paiement n'est pas effectué dans les délais, les taxes annuelles peuvent encore être valablement acquittées dans un délai de six mois à compter de l'échéance, sous réserve du paiement simultané de la surtaxe visée à l'article 86, paragraphe 2.

(4) La taxe annuelle pour une nouvelle demande de brevet européen déposée en application de l'article 61, paragraphe 1, lettre b), n'est pas exigible au titre de l'année au cours de laquelle cette demande a été déposée et de toute année antérieure.

Chapitre IV

Priorité

*Règle 38*⁶⁴

Déclaration de priorité et documents de priorité

*Art. 93, 98
R. 41, 49, 111*

(1) La déclaration de priorité visée à l'article 88, paragraphe 1 indique la date du dépôt antérieur, l'Etat dans lequel ou pour lequel celui-ci a été effectué et le numéro de ce dépôt.

(2) La date et l'Etat du dépôt antérieur doivent être indiqués lors du dépôt de la demande de brevet européen; le numéro de dépôt doit être indiqué avant l'expiration du seizième mois suivant la date de priorité.

(3) La copie de la demande antérieure doit être produite avant l'expiration du seizième mois suivant la date de priorité. La copie doit être certifiée conforme par l'administration qui a reçu la demande antérieure et doit être accompagnée d'une attestation de cette administration indiquant la date de dépôt de la demande antérieure.

(4)⁶⁵ La copie de la demande antérieure est réputée régulièrement produite si une copie de cette demande, qui est à la disposition de l'Office européen des brevets, doit être versée au dossier de la demande de brevet européen selon les modalités fixées par le Président de l'Office européen des brevets.

⁶³ Modifié par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.).

⁶⁴ Modifiée en dernier lieu par décision du Conseil d'administration en date du 18.10.2001, entrée en vigueur le 01.07.2002 (JO OEB 2001, 488 s.).

⁶⁵ Cf. la décision du Président de l'OEB en date du 22.12.1998 (JO OEB 1999, 80).

(5) Die nach Artikel 88 Absatz 1 erforderliche Übersetzung der früheren Anmeldung ist innerhalb einer vom Europäischen Patentamt zu bestimmenden Frist, spätestens jedoch innerhalb der Frist nach Regel 51 Absatz 4 einzureichen. Statt der Übersetzung kann eine Erklärung vorgelegt werden, dass die europäische Patentanmeldung eine vollständige Übersetzung der früheren Anmeldung ist. Absatz 4 ist entsprechend anzuwenden.

(6) Die Angaben der Prioritätserklärung sind in der veröffentlichten europäischen Patentanmeldung und auf der europäischen Patentschrift zu vermerken.

*Regel 38a*⁶⁶

Ausstellung von Prioritätsunterlagen

Auf Antrag stellt das Europäische Patentamt für den Anmelder eine beglaubigte Kopie der europäischen Patentanmeldung (Prioritätsunterlage) aus. Der Präsident des Europäischen Patentamts bestimmt die erforderlichen Bedingungen einschließlich der Form der Prioritätsunterlage und der Fälle, in denen eine Verwaltungsgebühr zu entrichten ist.

(5) The translation of the previous application required under Article 88, paragraph 1, must be filed within a time limit to be set by the European Patent Office, but at the latest within the time limit under Rule 51, paragraph 4. Alternatively, a declaration may be submitted that the European patent application is a complete translation of the previous application. Paragraph 4 shall apply *mutatis mutandis*.

(6) The particulars stated in the declaration of priority shall appear in the published European patent application and also on the European patent specification.

*Rule 38a*⁶⁶

Issuing priority documents

On request, the European Patent Office shall issue a certified copy of the European patent application (priority document) to the applicant. The President of the European Patent Office shall determine all necessary arrangements, including the form of the priority document and the circumstances in which an administrative fee is payable.

⁶⁶ Eingefügt durch Beschluss des Verwaltungsrats vom 11.10.2000, in Kraft getreten am 02.11.2000 (ABI. EPA 2000, 473).

⁶⁶ Inserted by decision of the Administrative Council of 11.10.2000 which entered into force on 02.11.2000 (OJ EPO 2000, 473).

(5) La traduction de la demande antérieure requise en vertu de l'article 88, paragraphe 1 doit être produite dans un délai imparti par l'Office européen des brevets et, au plus tard, dans le délai prévu à la règle 51, paragraphe 4. Au lieu de cette traduction, une déclaration peut être présentée selon laquelle la demande de brevet européen est une traduction intégrale de la demande antérieure. Le paragraphe 4 est applicable.

(6) Les indications contenues dans la déclaration de priorité sont mentionnées dans la demande de brevet européen publiée et sont portées sur le fascicule du brevet européen.

*Règle 38bis*⁶⁶

Délivrance de documents de priorité

Sur requête, l'Office européen des brevets délivre au demandeur une copie certifiée conforme de la demande de brevet européen (document de priorité). Le Président de l'Office européen des brevets arrête toutes les modalités nécessaires, y compris la forme du document de priorité et les conditions dans lesquelles il y a lieu d'acquitter une taxe d'administration.

⁶⁶ Insérée par décision du Conseil d'administration en date du 11.10.2000, entrée en vigueur le 02.11.2000 (JO OEB 2000, 473).

VIERTER TEIL

AUSFÜHRUNGSVORSCHRIFTEN ZUM VIERTEN TEIL DES ÜBEREINKOMMENS

Kapitel I

Prüfung durch die Eingangsstelle

Regel 39

Mitteilung auf Grund der Eingangsprüfung

Genügt die europäische Patentanmeldung nicht den Erfordernissen des Artikels 80, so teilt die Eingangsstelle die festgestellten Mängel dem Anmelder mit und weist ihn darauf hin, dass die Anmeldung nicht als europäische Patentanmeldung behandelt wird, wenn er die festgestellten Mängel nicht innerhalb eines Monats beseitigt. Beseitigt der Anmelder rechtzeitig die festgestellten Mängel, so teilt ihm die Eingangsstelle den Anmeldetag mit.

Regel 40⁶⁷

Prüfung bestimmter Formerfordernisse

Die Formerfordernisse, denen eine europäische Patentanmeldung nach Artikel 91 Absatz 1 Buchstabe b genügen muss, sind die in Regel 27a Absätze 1 bis 3, Regel 32 Absätze 1 und 2, Regel 35 Absätze 2 bis 11 und 14 und Regel 36 Absätze 2 und 4 vorgeschriebenen Erfordernisse.

Regel 41

Beseitigung von Mängeln in den Anmeldungsunterlagen

(1)⁶⁸ Werden auf Grund der in Artikel 91 Absatz 1 Buchstaben a bis d vorgeschriebenen Prüfung Mängel der europäischen Patentanmeldung festgestellt, so teilt die Eingangsstelle dies dem Anmelder mit und fordert ihn auf, die Mängel innerhalb einer von ihr zu bestimmenden Frist zu beseitigen. Die Beschreibung, die Patentansprüche und die Zeichnungen können nur insoweit geändert werden, als es erforderlich ist, um die festgestellten Mängel gemäß den Bemerkungen der Eingangsstelle zu beseitigen.

(2) Absatz 1 ist nicht anzuwenden, wenn der Anmelder, der eine Priorität in Anspruch nimmt, bei Einreichung der europäischen Patentanmeldung den Tag oder Staat der früheren Anmeldung nicht angegeben hat.

PART IV

IMPLEMENTING REGULATIONS TO PART IV OF THE CONVENTION

Chapter I

Examination by the Receiving Section

Rule 39

Communication following the examination on filing

If the European patent application fails to meet the requirements laid down in Article 80, the Receiving Section shall communicate the disclosed deficiencies to the applicant and inform him that the application will not be dealt with as a European patent application unless he remedies the disclosed deficiencies within one month. If he does so, he shall be informed of the date of filing.

Rule 40⁶⁷

Examination for certain physical requirements

The physical requirements which a European patent application must satisfy pursuant to Article 91, paragraph 1(b), shall be those prescribed in Rule 27a, paragraphs 1 to 3, Rule 32, paragraphs 1 and 2, Rule 35, paragraphs 2 to 11 and 14, and Rule 36, paragraphs 2 and 4.

Rule 41

Rectification of deficiencies in the application documents

(1)⁶⁸ If the examination provided for in Article 91, paragraph 1(a) to (d), reveals deficiencies in the European patent application, the Receiving Section shall inform the applicant accordingly and invite him to remedy the deficiencies within such period as it shall specify. The description, claims and drawings may be amended only to an extent sufficient to remedy the disclosed deficiencies in accordance with the observations of the Receiving Section.

(2) Paragraph 1 shall not apply where the applicant, while claiming priority, has omitted to indicate on filing the European patent application the date or State of first filing.

⁶⁷ Geändert durch Beschluss des Verwaltungsrats vom 05.06.1992, in Kraft getreten am 01.01.1993 (ABI. EPA 1992, 342 ff.).

⁶⁸ Geändert durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABI. EPA 1978, 12 ff.).

⁶⁷ Amended by decision of the Administrative Council of 05.06.1992, which entered into force on 01.01.1993 (OJ EPO 1992, 342 ff.).

⁶⁸ Amended by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff.).

QUATRIÈME PARTIE

Verweisungen / References / Références

DISPOSITIONS D'APPLICATION DE LA QUATRIÈME PARTIE DE LA CONVENTION

Chapitre I

Examen par la section de dépôt

Règle 39

Notifications faisant suite à l'examen lors du dépôt

Art. 90

Si la demande de brevet européen ne satisfait pas aux exigences de l'article 80, la section de dépôt notifie au demandeur les irrégularités constatées et l'informe que s'il n'y remédie pas dans un délai d'un mois, la demande ne sera pas traitée en tant que demande de brevet européen. Si le demandeur remédie dans le délai aux irrégularités constatées, la section de dépôt lui notifie la date de dépôt.

Règle 40⁶⁷

Examen de certaines conditions de forme

Les conditions de forme auxquelles doit satisfaire toute demande de brevet européen, en vertu de l'article 91, paragraphe 1, lettre b), sont celles prévues à la règle 27bis, paragraphes 1 à 3, à la règle 32, paragraphes 1 et 2, à la règle 35, paragraphes 2 à 11 et 14 et à la règle 36, paragraphes 2 et 4.

Règle 41

Correction d'irrégularités dans les pièces de la demande

*Art. 87, 88, 123
R. 38, 86*

(1)⁶⁸ Si l'examen prévu à l'article 91, paragraphe 1, lettres a) à d), fait apparaître des irrégularités dans la demande de brevet européen, la section de dépôt le signale au demandeur et l'invite à remédier à ces irrégularités dans le délai qu'elle lui impartit. La description, les revendications et les dessins ne peuvent être modifiés que dans la mesure nécessaire pour remédier aux irrégularités constatées et conformément aux observations de la section de dépôt.

(2) Les dispositions du paragraphe 1 ne sont pas applicables si le demandeur qui revendique la priorité a omis d'indiquer lors du dépôt de la demande de brevet européen la date ou le pays du premier dépôt.

⁶⁷ Modifiée par décision du Conseil d'administration en date du 05.06.1992, entrée en vigueur le 01.01.1993 (JO OEB 1992, 342 s.).

⁶⁸ Modifié par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.).

(3) Absatz 1 ist auch nicht anzuwenden, wenn die Prüfung ergeben hat, dass der bei Einreichung der europäischen Patentanmeldung genannte erste Anmeldetag um mehr als ein Jahr vor dem Anmeldetag der europäischen Patentanmeldung liegt. In diesem Fall teilt die Eingangsstelle dem Anmelder mit, dass kein Prioritätsanspruch besteht, wenn der Anmelder nicht innerhalb eines Monats einen berechtigten Prioritätstag angibt, der in das Jahr fällt, das vor dem Anmeldetag der europäischen Patentanmeldung liegt.

Regel 42

Nachholung der Erfindernennung

(1) Ergibt die in Artikel 91 Absatz 1 Buchstabe f vorgeschriebene Prüfung, dass die Erfindernennung nicht nach Regel 17 erfolgt ist, so teilt die Eingangsstelle dem Anmelder mit, dass die europäische Patentanmeldung als zurückgenommen gilt, wenn der Mangel nicht innerhalb der in Artikel 91 Absatz 5 vorgeschriebenen Frist beseitigt wird.

(2) Handelt es sich um eine europäische Teilanmeldung oder um eine nach Artikel 61 Absatz 1 Buchstabe b eingereichte neue europäische Patentanmeldung, so endet die Frist für die Erfindernennung nicht vor Ablauf von zwei Monaten nach der in Absatz 1 genannten Mitteilung; auf diese Frist wird in der Mitteilung hingewiesen.

Regel 43

Verspätet oder nicht eingereichte Zeichnungen

(1) Ergibt die in Artikel 91 Absatz 1 Buchstabe g vorgeschriebene Prüfung, dass die Zeichnungen nach dem Anmeldetag eingereicht worden sind, so teilt die Eingangsstelle dem Anmelder mit, dass die Zeichnungen und die Bezugnahmen auf die Zeichnungen in der europäischen Patentanmeldung als gestrichen gelten, wenn der Anmelder nicht innerhalb eines Monats beantragt, den Anmeldetag neu auf den Tag der Einreichung der Zeichnungen festzusetzen.

(2) Ergibt die in Absatz 1 genannte Prüfung, dass die Zeichnungen nicht eingereicht worden sind, so fordert die Eingangsstelle den Anmelder auf, die Zeichnungen innerhalb eines Monats einzureichen, und teilt dem Anmelder mit, dass der Anmeldetag neu auf den Tag der Einreichung der Zeichnungen festgesetzt wird oder, wenn die Zeichnungen nicht rechtzeitig eingereicht werden, die Bezugnahmen auf die Zeichnungen in der europäischen Patentanmeldung als gestrichen gelten.

(3) Jeder neu festgesetzte Anmeldetag wird dem Anmelder mitgeteilt.

(3) Paragraph 1 shall not apply where the examination reveals that the date of the first filing given on filing the European patent application precedes the date of filing of the European patent application by more than one year. In this event the Receiving Section shall inform the applicant that there will be no right of priority for the application unless, within one month, the applicant indicates a corrected date, lying within the year preceding the date of filing of the European patent application.

Rule 42

Subsequent identification of the inventor

(1) If the examination provided for in Article 91, paragraph 1(f), reveals that the inventor has not been identified in accordance with the provisions of Rule 17, the Receiving Section shall inform the applicant that the European patent application shall be deemed to be withdrawn unless this deficiency is corrected within the period prescribed by Article 91, paragraph 5.

(2) In the case of a European divisional application or a new European patent application filed pursuant to Article 61, paragraph 1(b), the time limit for identifying the inventor may in no case expire before two months after the communication referred to in paragraph 1, which shall state the time limit.

Rule 43

Late-filed or missing drawings

(1) If the examination provided for in Article 91, paragraph 1(g), reveals that the drawings were filed later than the date of filing of the European patent application, the Receiving Section shall inform the applicant that the drawings and the references to the drawings in the European patent application shall be deemed to be deleted unless the applicant requests within a period of one month that the application be re-dated to the date on which the drawings were filed.

(2) If the examination reveals that the drawings were not filed, the Receiving Section shall invite him to file them within one month and inform him that the application will be re-dated to the date on which they are filed, or, if they are not filed in due time, any reference to them in the application shall be deemed to be deleted.

(3) The applicant shall be informed of any new date of filing of the application.

(3) Les dispositions du paragraphe 1 ne sont pas davantage applicables si l'examen fait apparaître que la date du premier dépôt indiquée lors du dépôt de la demande de brevet européen est antérieure de plus d'un an à la date de dépôt de la demande de brevet européen. Dans un tel cas, la section de dépôt signale au demandeur qu'il n'existe pas de droit de priorité à moins que, dans un délai d'un mois, il n'indique une date rectifiée qui se situe au cours de l'année précédant la date de dépôt de la demande de brevet européen.

Verweisungen / References / Références

Règle 42

Désignation ultérieure de l'inventeur

Art. 76, 81

(1) S'il résulte de l'examen prescrit à l'article 91, paragraphe 1, lettre f) que la désignation de l'inventeur n'a pas été effectuée conformément à la règle 17, la section de dépôt notifie au demandeur que s'il n'a pas été remédié à cette irrégularité dans les délais prévus à l'article 91, paragraphe 5, la demande de brevet européen est réputée retirée.

(2) Dans le cas d'une demande divisionnaire européenne ou dans celui d'une nouvelle demande de brevet européen au sens de l'article 61, paragraphe 1, lettre b), le délai pendant lequel l'inventeur peut encore être désigné ne peut en aucun cas être inférieur à deux mois à compter de la notification visée au paragraphe 1, qui doit mentionner la date d'expiration de ce délai.

Règle 43

Dessins omis ou déposés tardivement

Art. 80

(1) S'il résulte de l'examen prescrit à l'article 91, paragraphe 1, lettre g), que les dessins ont été déposés postérieurement à la date de dépôt de la demande de brevet européen, la section de dépôt notifie au demandeur que les dessins et les références aux dessins figurant dans la demande de brevet européen sont réputés supprimés à moins que le demandeur ne présente, dans un délai d'un mois, une requête aux fins d'obtenir une demande dont la date sera la date à laquelle les dessins ont été déposés.

(2) S'il résulte de l'examen que les dessins n'ont pas été déposés, la section de dépôt invite le demandeur à les déposer dans un délai d'un mois et l'informe que la date de la demande sera celle à laquelle les dessins auront été déposés ou que, si les dessins ne sont pas déposés dans le délai, les références aux dessins figurant dans la demande seront réputées supprimées.

(3) Toute nouvelle date de dépôt de la demande est notifiée au demandeur.

Inhalt des europäischen Recherchenberichts

(1)⁶⁹ Im europäischen Recherchenbericht werden die dem Europäischen Patentamt zum Zeitpunkt der Erstellung des Berichts zur Verfügung stehenden Schriftstücke genannt, die zur Beurteilung der Neuheit der europäischen Patentanmeldung zu Grunde liegenden Erfindung und der erfinderischen Tätigkeit, auf der die Erfindung beruht, in Betracht gezogen werden können.

(2) Die Schriftstücke werden im Zusammenhang mit den Patentansprüchen aufgeführt, auf die sie sich beziehen. Soweit erforderlich, werden die maßgeblichen Teile jedes Schriftstücks näher gekennzeichnet (beispielsweise durch Angabe der Seite, der Spalte und der Zeilen oder der Abbildungen).

(3) Im europäischen Recherchenbericht ist zu unterscheiden zwischen Schriftstücken, die vor dem beanspruchten Prioritätstag, zwischen dem Prioritätstag und dem Anmeldetag und an oder nach dem Anmeldetag veröffentlicht worden sind.

(4) Schriftstücke, die sich auf eine vor dem Anmeldetag der europäischen Patentanmeldung der Öffentlichkeit zugänglich gemachte mündliche Beschreibung, Benutzung oder sonstige Offenbarung beziehen, werden in dem europäischen Recherchenbericht unter Angabe des Tags einer etwaigen Veröffentlichung des Schriftstücks und einer nichtschriftlichen Offenbarung genannt.

(5)⁷⁰ Der europäische Recherchenbericht wird in der Verfahrenssprache abgefasst.

(6) Auf dem europäischen Recherchenbericht ist die Klassifikation des Gegenstands der europäischen Patentanmeldung nach der Internationalen Klassifikation anzugeben.

*Regel 44a*⁷¹

Erweiterter europäischer Recherchenbericht

(1) Zusammen mit dem europäischen Recherchenbericht ergeht eine Stellungnahme dazu, ob die Anmeldung und die Erfindung, die sie zum Gegenstand hat, die Erfordernisse dieses Übereinkommens zu erfüllen scheinen, sofern nicht eine Mitteilung nach Regel 51 Absatz 2 oder Absatz 4 erlassen werden kann.

(2) Die Stellungnahme nach Absatz 1 wird nicht zusammen mit dem Recherchenbericht veröffentlicht.

⁶⁹ Siehe hierzu die Mitteilungen des EPA über den Anhang zum europäischen Recherchenbericht (ABI. EPA 1982, 448 ff.; 1984, 381; 1999, 90).

⁷⁰ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.).

⁷¹ Eingefügt durch Beschluss des Verwaltungsrats vom 09.12.2004, in Kraft getreten am 01.07.2005 (ABI. EPA 2005, 5 ff.).

Content of the European search report

(1)⁶⁹ The European search report shall mention those documents, available to the European Patent Office at the time of drawing up the report, which may be taken into consideration in deciding whether the invention to which the European patent application relates is new and involves an inventive step.

(2) Each citation shall be referred to the claims to which it relates. If necessary, the relevant parts of the documents cited shall be identified (for example, by indicating the page, column and lines or the diagrams).

(3) The European search report shall distinguish between cited documents published before the date of priority claimed, between such date of priority and the date of filing, and on or after the date of filing.

(4) Any document which refers to an oral disclosure, a use or any other means of disclosure which took place prior to the date of filing of the European patent application shall be mentioned in the European search report, together with an indication of the date of publication, if any, of the document and the date of the non-written disclosure.

(5)⁷⁰ The European search report shall be drawn up in the language of the proceedings.

(6) The European search report shall contain the classification of the subject-matter of the European patent application in accordance with the international classification.

*Rule 44a*⁷¹

Extended European search report

(1) The European search report shall be accompanied by an opinion on whether the application and the invention to which it relates seem to meet the requirements of this Convention, unless a communication under Rule 51, paragraph 2 or paragraph 4, can be issued.

(2) The opinion under paragraph 1 shall not be published together with the search report.

⁶⁹ See information from the EPO concerning the annex to the European search report (OJ EPO 1982, 448 ff; 1984, 381; 1999, 90).

⁷⁰ Last amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff).

⁷¹ Inserted by decision of the Administrative Council of 09.12.2004 which entered into force on 01.07.2005 (OJ EPO 2005, 5 ff).

Rapport de recherche européenne*Règle 44*

Contenu du rapport de recherche européenne

Art. 14, 54, 56, 92

R. 8

- (1)⁶⁹ Le rapport de recherche européenne cite les documents dont dispose l'Office européen des brevets à la date d'établissement du rapport, qui peuvent être pris en considération pour apprécier la nouveauté de l'invention, objet de la demande de brevet européen, et l'activité inventive.
- (2) Chaque citation est faite en relation avec les revendications qu'elle concerne. Si nécessaire, les parties pertinentes du document cité sont identifiées (par exemple en indiquant la page, la colonne et les lignes ou les figures).
- (3) Le rapport de recherche européenne doit distinguer entre les documents cités qui ont été publiés avant la date de priorité, entre la date de priorité et la date de dépôt et à la date de dépôt et postérieurement.
- (4) Tout document se référant à une divulgation orale, à un usage ou à toute autre divulgation ayant eu lieu antérieurement à la date de dépôt de la demande de brevet européen, est cité dans le rapport de recherche européenne en précisant la date de publication du document, si elle existe, et celle de la divulgation non écrite.
- (5)⁷⁰ Le rapport de recherche européenne est rédigé dans la langue de la procédure.
- (6) Le rapport de recherche européenne mentionne le classement de la demande de brevet européen selon la classification internationale.

*Règle 44bis*⁷¹

Rapport de recherche européenne élargi

- (1) Le rapport de recherche européenne est accompagné d'un avis sur la question de savoir si la demande et l'invention qui en fait l'objet semblent satisfaire aux exigences de la présente convention, à moins qu'une notification ne puisse être émise au titre de la règle 51, paragraphe 2 ou paragraphe 4.
- (2) L'avis visé au paragraphe 1 n'est pas publié avec le rapport de recherche.

⁶⁹ Cf. les communications de l'OEB relatives à l'annexe au rapport de recherche européenne (JO OEB 1982, 448 s.; 1984, 381; 1999, 90).

⁷⁰ Modifié en dernier lieu par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.).

⁷¹ Insérée par décision du Conseil d'administration en date du 09.12.2004, entrée en vigueur le 01.07.2005 (JO OEB 2005, 5 s.).

Regel 45

Unvollständige Recherche

Ist die Recherchenabteilung der Auffassung, dass die europäische Patentanmeldung den Vorschriften dieses Übereinkommens so wenig entspricht, dass es nicht möglich ist, auf der Grundlage aller oder einiger Patentansprüche sinnvolle Ermittlungen über den Stand der Technik durchzuführen, so stellt sie entweder in einer Erklärung fest, dass Ermittlungen nicht möglich sind, oder erstellt, soweit dies durchführbar ist, für einen Teil der Anmeldung einen europäischen Recherchenbericht. Diese Erklärung und dieser Bericht gelten für das weitere Verfahren als europäischer Recherchenbericht.

Regel 46⁷²

Europäischer Recherchenbericht bei mangelnder Einheitlichkeit

(1)⁷³ Entspricht die europäische Patentanmeldung nach Auffassung der Recherchenabteilung nicht den Anforderungen an die Einheitlichkeit der Erfindung, so erstellt sie einen teilweisen europäischen Recherchenbericht für die Teile der Anmeldung, die sich auf die zuerst in den Patentansprüchen erwähnte Erfindung oder Gruppe von Erfindungen im Sinn des Artikels 82 beziehen. Sie teilt dem Anmelder mit, dass für jede weitere Erfindung innerhalb einer von der Recherchenabteilung zu bestimmenden Frist, die nicht kürzer als zwei Wochen sein und sechs Wochen nicht übersteigen darf, eine weitere Recherchegebühr zu entrichten ist, wenn der europäische Recherchenbericht diese Erfindung erfassen soll. Die Recherchenabteilung erstellt den europäischen Recherchenbericht für die Teile der Anmeldung, die sich auf die Erfindungen beziehen, für die Recherchegebühren entrichtet worden sind.

(2) Eine nach Absatz 1 gezahlte Recherchegebühr wird zurückgezahlt, wenn der Anmelder im Verlauf der Prüfung der europäischen Patentanmeldung durch die Prüfungsabteilung einen Erstattungsantrag stellt und die Prüfungsabteilung feststellt, dass die in Absatz 1 genannte Mitteilung nicht gerechtfertigt war.

Regel 47

Endgültiger Inhalt der Zusammenfassung

(1) Gleichzeitig mit der Erstellung des europäischen Recherchenberichts bestimmt die Recherchenabteilung den endgültigen Inhalt der Zusammenfassung.

(2) Der endgültige Inhalt der Zusammenfassung wird dem Anmelder zusammen mit dem europäischen Recherchenbericht übersandt.

Rule 45

Incomplete search

If the Search Division considers that the European patent application does not comply with the provisions of the Convention to such an extent that it is not possible to carry out a meaningful search into the state of the art on the basis of all or some of the claims, it shall either declare that search is not possible or shall, so far as is practicable, draw up a partial European search report. The declaration and the partial report referred to shall be considered, for the purposes of subsequent proceedings, as the European search report.

Rule 46⁷²

European search report where the invention lacks unity

(1)⁷³ If the Search Division considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial European search report on those parts of the European patent application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims. It shall inform the applicant that if the European search report is to cover the other inventions, a further search fee must be paid, for each invention involved, within a period to be fixed by the Search Division which must not be shorter than two weeks and must not exceed six weeks. The Search Division shall draw up the European search report for those parts of the European patent application which relate to inventions in respect of which search fees have been paid.

(2) Any fee which has been paid under paragraph 1 shall be refunded if, during the examination of the European patent application by the Examining Division, the applicant requests a refund and the Examining Division finds that the communication referred to in the said paragraph was not justified.

Rule 47

Definitive content of the abstract

(1) At the same time as drawing up the European search report, the Search Division shall determine the definitive content of the abstract.

(2) The definitive content of the abstract shall be transmitted to the applicant together with the European search report.

⁷² Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 2/92 (Anhang I).

⁷³ Geändert durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABI. EPA 1978, 12 ff.).

⁷² See opinion of the Enlarged Board of Appeal G 2/92 (Annex I).

⁷³ Amended by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff.).

Règle 45

Verweisungen / References / Références

Recherche incomplète

Art. 92

Si la division de la recherche estime que la demande de brevet européen n'est pas conforme aux dispositions de la convention, au point qu'une recherche significative sur l'état de la technique ne peut être effectuée au regard de tout ou partie des revendications, elle déclare qu'une telle recherche est impossible ou elle établit, dans la mesure du possible, un rapport partiel de recherche européenne. La déclaration et le rapport partiel sont considérés, aux fins de la procédure ultérieure, comme le rapport de recherche européenne.

*Règle 46*⁷²

Rapport de recherche européenne en cas d'absence d'unité d'invention

Art. 92
R. 112

(1)⁷³ Si la division de la recherche estime que la demande de brevet européen ne satisfait pas à l'exigence concernant l'unité d'invention, elle établit un rapport partiel de recherche européenne pour les parties de la demande de brevet européen qui se rapportent à l'invention, ou à la pluralité d'inventions au sens de l'article 82, mentionnée en premier lieu dans les revendications. Elle notifie au demandeur que si le rapport de recherche européenne doit couvrir les autres inventions, une nouvelle taxe de recherche doit être acquittée pour chaque invention concernée dans un délai qu'elle lui impartit et qui ne peut être inférieur à deux semaines ni supérieur à six semaines. La division de la recherche établit le rapport de recherche européenne pour les parties de la demande de brevet européen qui se rapportent aux inventions pour lesquelles les taxes de recherche ont été acquittées.

(2) Toute taxe acquittée en vertu du paragraphe 1 est remboursée si, au cours de l'examen de la demande de brevet européen par la division d'examen, le demandeur le requiert et si la division d'examen constate que la communication visée audit paragraphe n'était pas justifiée.

Règle 47

Contenu définitif de l'abrégé

Art. 85, 92
R. 33, 49

(1) La division de la recherche établit le rapport de recherche européenne et arrête simultanément le contenu définitif de l'abrégé.

(2) Le contenu définitif de l'abrégé est notifié au demandeur avec le rapport de recherche européenne.

⁷² Cf. l'avis de la Grande Chambre de recours G 2/92 (Annexe I).

⁷³ Modifié par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.).

Veröffentlichung der europäischen Patentanmeldung

Regel 48

Technische Vorbereitungen für die Veröffentlichung

(1)⁷⁴ Der Präsident des Europäischen Patentamts bestimmt, wann die technischen Vorbereitungen für die Veröffentlichung der europäischen Patentanmeldung als abgeschlossen gelten.

(2) Die europäische Patentanmeldung wird nicht veröffentlicht, wenn sie vor Abschluss der technischen Vorbereitungen für die Veröffentlichung rechtskräftig zurückgewiesen oder zurückgenommen worden ist oder als zurückgenommen gilt.

Regel 49

Form der Veröffentlichung der europäischen Patentanmeldungen und europäischen Recherchenberichte

(1)⁷⁵ Der Präsident des Europäischen Patentamts bestimmt, in welcher Form die europäischen Patentanmeldungen veröffentlicht werden und welche Angaben sie enthalten. Das Gleiche gilt, wenn der europäische Recherchenbericht und die Zusammenfassung gesondert veröffentlicht werden. Der Präsident des Europäischen Patentamts kann für die Veröffentlichung der Zusammenfassung besondere Vorschriften erlassen.

(2) In der veröffentlichten europäischen Patentanmeldung werden die benannten Vertragsstaaten angegeben.

(3) Sind vor Abschluss der technischen Vorbereitungen für die Veröffentlichung der europäischen Patentanmeldung die Patentansprüche nach Regel 86 Absatz 2 geändert worden, so werden in der Veröffentlichung außer den ursprünglichen Patentansprüchen auch die neuen oder geänderten Patentansprüche aufgeführt.

Regel 50

Mitteilungen über die Veröffentlichung

(1)⁷⁶ Das Europäische Patentamt hat dem Anmelder den Tag mitzuteilen, an dem im Europäischen Patentblatt auf die Veröffentlichung des europäischen Recherchenberichts hingewiesen worden ist, und ihn in dieser Mitteilung auf Artikel 94 Absätze 2 und 3 hinzuweisen.

Publication of the European patent application

Rule 48

Technical preparations for publication

(1)⁷⁴ The President of the European Patent Office shall determine when the technical preparations for publication of the European patent application are to be deemed to have been completed.

(2) The European patent application shall not be published if it has been finally refused or withdrawn or deemed to be withdrawn before the termination of the technical preparations for publication.

Rule 49

Form of the publication of European patent applications and European search reports

(1)⁷⁵ The President of the European Patent Office shall prescribe the form of the publication of the European patent application and the data which are to be included. The same shall apply where the European search report and the abstract are published separately. The President of the European Patent Office may lay down special conditions for the publication of the abstract.

(2) The designated Contracting States shall be specified in the published European patent application.

(3) If, before the termination of the technical preparations for publication of the European patent application, the claims have been amended pursuant to Rule 86, paragraph 2, the new or amended claims shall be included in the publication in addition to the original claims.

Rule 50

Information about publication

(1)⁷⁶ The European Patent Office shall communicate to the applicant the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention in this communication to the provisions of Article 94, paragraphs 2 and 3.

⁷⁴ Siehe Beschluss des Präsidenten des EPA vom 14.12.1992 über den Abschluss der technischen Vorbereitungen für die Veröffentlichung der europäischen Patentanmeldung (ABI. EPA 1993, 55).

⁷⁵ Siehe Beschluss des Präsidenten des EPA vom 09.06.2000 über die Veröffentlichung von europäischen Patentanmeldungen (ABI. EPA 2000, 367).

⁷⁶ Geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.).

⁷⁴ See decision of the President of the EPO dated 14.12.1992 concerning the completion of the technical preparations for the publication of the European patent application (OJ EPO 1993, 55).

⁷⁵ See decision of the President of the EPO dated 09.06.2000 concerning the publication of European patent applications (OJ EPO 2000, 367).

⁷⁶ Amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff.).

Publication de la demande de brevet européen*Règle 48*

Préparatifs techniques en vue de la publication

Art. 93
R. 28, 53

(1)⁷⁴ Le Président de l'Office européen des brevets détermine quand les préparatifs techniques entrepris en vue de la publication de la demande de brevet européen sont réputés achevés.

(2) La demande de brevet européen n'est pas publiée lorsque la demande a été rejetée définitivement ou a été retirée ou est réputée retirée avant la fin des préparatifs techniques entrepris en vue de la publication.

Règle 49

Forme de la publication des demandes de brevet européen et des rapports de recherche européenne

Art. 85, 93
R. 38, 47, 53, 62, 96

(1)⁷⁵ Le Président de l'Office européen des brevets détermine la forme de la publication des demandes de brevet européen ainsi que les indications qui doivent y figurer. Les mêmes dispositions sont applicables lorsque le rapport de recherche européenne et l'abrégeé sont publiés séparément. Le Président de l'Office européen des brevets peut déterminer des modalités particulières de publication de l'abrégeé.

(2) Les Etats contractants désignés doivent figurer dans la demande de brevet européen publiée.

(3) Si, avant la fin des préparatifs techniques entrepris en vue de la publication de la demande de brevet européen, les revendications ont été modifiées conformément à la règle 86, paragraphe 2, les revendications nouvelles ou modifiées figurent dans la publication à côté des revendications initiales.

Règle 50

Renseignements concernant la publication

Art. 93, 129

(1)⁷⁶ L'Office européen des brevets est tenu de notifier au demandeur la date à laquelle le Bulletin européen des brevets a mentionné la publication du rapport de recherche européenne et d'appeler, dans cette notification, son attention sur les dispositions de l'article 94, paragraphes 2 et 3.

⁷⁴ Cf. la décision du Président de l'OEB du 14.12.1992 concernant l'achèvement des préparatifs techniques entrepris en vue de la publication de la demande de brevet européen (JO OEB 1993, 55).

⁷⁵ Cf. la décision du Président de l'OEB du 09.06.2000 relative à la publication de demandes de brevet européen (JO OEB 2000, 367).

⁷⁶ Modifié par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.).

(2) Der Anmelder kann aus der Unterlassung der Mitteilung nach Absatz 1 keine Ansprüche herleiten. Ist in der Mitteilung ein späterer Tag der Veröffentlichung angegeben, so ist für die Frist zur Stellung des Prüfungsantrags der spätere Tag als der Tag des Hinweises auf die Veröffentlichung maßgebend, wenn der Fehler nicht ohne Weiteres erkennbar war.

Kapitel IV

Prüfung durch die Prüfungsabteilung

Regel 51⁷⁷

Prüfungsverfahren

(1) In der Mitteilung nach Artikel 96 Absatz 1 gibt das Europäische Patentamt dem Anmelder Gelegenheit, zu dem europäischen Recherchenbericht Stellung zu nehmen und gegebenenfalls die Beschreibung, die Patentansprüche und die Zeichnungen zu ändern.

(2) In den Mitteilungen nach Artikel 96 Absatz 2 fordert die Prüfungsabteilung den Anmelder gegebenenfalls auf, die festgestellten Mängel zu beseitigen und die Beschreibung, die Patentansprüche und die Zeichnungen zu ändern.

(3) Die Mitteilungen nach Artikel 96 Absatz 2 sind zu begründen; dabei sollen alle Gründe zusammengefasst werden, die der Erteilung des europäischen Patents entgegenstehen.

(4)⁷⁸ Bevor die Prüfungsabteilung die Erteilung des europäischen Patents beschließt, teilt sie dem Anmelder mit, in welcher Fassung sie das europäische Patent zu erteilen beabsichtigt, und fordert ihn auf, innerhalb einer zu bestimmenden nicht verlängerbaren Frist, die nicht kürzer als zwei Monate sein und vier Monate nicht übersteigen darf, die Erteilungsgebühr und die Druckkostengebühr zu entrichten sowie eine Übersetzung der Patentansprüche in den beiden Amtssprachen des Europäischen Patentamts einzureichen, die nicht die Verfahrenssprache sind. Wenn der Anmelder innerhalb dieser Frist die Gebühren entrichtet und die Übersetzung einreicht, gilt dies als Einverständnis mit der für die Erteilung vorgesehenen Fassung.

(5) Beantragt der Anmelder innerhalb der in Absatz 4 vorgesehenen Frist Änderungen nach Regel 86 Absatz 3 oder die Berichtigung von Fehlern nach Regel 88, so hat er, soweit die Patentansprüche geändert oder berichtigt werden, eine Übersetzung der geänderten oder berichtigten Patentansprüche einzureichen. Wenn der Anmelder innerhalb dieser Frist die Gebühren entrichtet und die Übersetzung einreicht, gilt dies als Einverständnis mit der Erteilung des Patents in der geänderten oder berichtigten Fassung.

⁷⁷ Siehe hierzu Entscheidung/Stellungnahme der Großen Beschwerdekammer G 7/93, G 1/02 (Anhang I).

⁷⁸ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 09.12.2004, in Kraft getreten am 01.04.2005 (ABl. EPA 2005, 8 f.)

(2) The applicant may not invoke the omission of the communication provided for in paragraph 1. If a later date than the date of the mention of the publication is specified in the communication, the later date shall be the decisive date as regards the time limit for filing the request for examination unless the error is apparent.

Chapter IV

Examination by the Examining Division

Rule 51⁷⁷

Examination procedure

(1) In the communication under Article 96, paragraph 1, the European Patent Office shall give the applicant an opportunity to comment on the European search report and to amend, where appropriate, the description, claims and drawings.

(2) In any communication under Article 96, paragraph 2, the Examining Division shall, where appropriate, invite the applicant to correct the deficiencies noted and to amend the description, claims and drawings.

(3) Any communication under Article 96, paragraph 2, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.

(4)⁷⁸ Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it, and shall invite him to pay the fees for grant and printing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within a non-extendable period to be specified, which may not be less than two months or more than four months. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the text intended for grant.

(5) If the applicant, within the period laid down in paragraph 4, requests amendments under Rule 86, paragraph 3, or the correction of errors under Rule 88, he shall, where the claims are amended or corrected, file a translation of the claims as amended or corrected. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the grant of the patent as amended or corrected.

⁷⁷ See decision/opinion of the Enlarged Board of Appeal G 7/93, G 1/02 (Annex I).

⁷⁸ Last amended by decision of the Administrative Council of 09.12.2004 which entered into force on 01.04.2005 (OJ EPO 2005, 8 f.)

(2) Le demandeur ne peut se prévaloir de l'omission de la notification visée au paragraphe 1. Si la notification indique par erreur une date postérieure à celle de la mention de la publication, la date postérieure est considérée comme déterminante pour le délai de présentation de la requête en examen, à moins que l'erreur ne soit évidente.

Verweisungen / References / Références

Chapitre IV

Examen par la division d'examen

Règle 51⁷⁷

Procédure d'examen

Art. 79, 97, 123

R. 36, 37, 38

(1) Dans la notification prévue à l'article 96, paragraphe 1, l'Office européen des brevets donne au demandeur la possibilité de prendre position au sujet du rapport de recherche européenne et de modifier, s'il y a lieu, la description, les revendications et les dessins.

(2) Dans toute notification prévue à l'article 96, paragraphe 2, la division d'examen invite le demandeur, s'il y a lieu, à remédier aux irrégularités constatées et à modifier la description, les revendications et les dessins.

(3) Toute notification prévue à l'article 96, paragraphe 2, doit être motivée et indiquer, s'il y a lieu, l'ensemble des motifs qui s'opposent à la délivrance du brevet européen.

(4)⁷⁸ Avant de prendre la décision de délivrer le brevet européen, la division d'examen notifie au demandeur le texte dans lequel elle envisage de délivrer le brevet européen et l'invite, dans un délai non prorogeable à fixer et qui ne peut être inférieur à deux mois ni supérieur à quatre mois, à acquitter les taxes de délivrance et d'impression, ainsi qu'à produire une traduction des revendications dans les deux langues officielles de l'Office européen des brevets autres que la langue de la procédure. Si le demandeur acquitte les taxes et produit les traductions dans ce délai, il est réputé avoir donné son accord sur le texte dans lequel il est envisagé de délivrer le brevet.

(5) Si, dans le délai prévu au paragraphe 4, le demandeur requiert des modifications au titre de la règle 86, paragraphe 3, ou la correction d'erreurs au titre de la règle 88, il produit, si les revendications sont modifiées ou corrigées, une traduction des revendications telles que modifiées ou corrigées. Si le demandeur acquitte les taxes et produit les traductions dans ce délai, il est réputé avoir donné son accord sur la délivrance du brevet tel que modifié ou corrigé.

⁷⁷ Cf. la décision/l'avis de la Grande Chambre de recours G 7/93, G 1/02 (Annexe I).

⁷⁸ Modifié en dernier lieu par décision du Conseil d'administration en date du 09.12.2004, entrée en vigueur le 01.04.2005 (JO OEB 2005, 8 s.).

(6) Stimmt die Prüfungsabteilung einer nach Absatz 5 beantragten Änderung oder Berichtigung nicht zu, so gibt sie, bevor sie eine Entscheidung trifft, dem Anmelder Gelegenheit, innerhalb einer zu bestimmenden Frist Stellung zu nehmen und von der Prüfungsabteilung für erforderlich gehaltene Änderungen und, soweit die Patentansprüche geändert werden, eine Übersetzung der geänderten Patentansprüche einzureichen. Reicht der Anmelder solche Änderungen ein, so gilt dies als Einverständnis mit der Erteilung des Patents in der geänderten Fassung. Wird die europäische Patentanmeldung zurückgewiesen oder zurückgenommen oder gilt sie als zurückgenommen, so werden die Erteilungsgebühr und die Druckkostengebühr sowie nach Absatz 7 entrichtete Anspruchsgebühren zurückerstattet.

(7) Enthält die europäische Patentanmeldung in der für die Erteilung vorgesehenen Fassung mehr als zehn Patentansprüche, so fordert die Prüfungsabteilung den Anmelder auf, innerhalb der in Absatz 4 vorgesehenen Frist für jeden weiteren Patentanspruch Anspruchsgebühren zu entrichten, soweit diese nicht bereits gemäß Regel 31 Absatz 1 entrichtet worden sind.

(8) Werden die Erteilungsgebühr und die Druckkostengebühr oder die Anspruchsgebühren nicht rechtzeitig entrichtet oder wird die Übersetzung nicht rechtzeitig eingereicht, so gilt die europäische Patentanmeldung als zurückgenommen.

(8a) Werden die Benennungsgebühren nach Zustellung der Mitteilung nach Absatz 4 fällig, so wird der Hinweis auf die Erteilung des europäischen Patents erst bekannt gemacht, wenn die Benennungsgebühren entrichtet sind. Der Anmelder wird hiervon unterrichtet.

(9) Wird eine Jahresgebühr nach Zustellung der Mitteilung nach Absatz 4 und vor dem Tag der frühestmöglichen Bekanntmachung des Hinweises auf die Erteilung des europäischen Patents fällig, so wird der Hinweis erst bekannt gemacht, wenn die Jahresgebühr entrichtet ist. Der Anmelder wird hiervon unterrichtet.

(10) In der Mitteilung nach Absatz 4 werden die benannten Vertragsstaaten angegeben, die eine Übersetzung nach Artikel 65 Absatz 1 verlangen.

(11) In der Entscheidung, durch die das europäische Patent erteilt wird, ist die der Patenterteilung zu Grunde liegende Fassung der europäischen Patentanmeldung anzugeben.

Regel 52

Erteilung des europäischen Patents an verschiedene Anmelder

Sind als Anmelder für verschiedene Vertragsstaaten verschiedene Personen in das europäische Patentregister eingetragen, so erteilt die Prüfungsabteilung das europäische Patent den verschiedenen Anmeldern jeweils für die sie betreffenden Vertragsstaaten.

(6) If the Examining Division does not consent to an amendment or correction requested under paragraph 5, it shall, before taking a decision, give the applicant an opportunity to submit, within a period to be specified, his observations and any amendments considered necessary by the Examining Division, and, where the claims are amended, a translation of the claims as amended. If the applicant submits such amendments, he shall be deemed to have approved the grant of the patent as amended. If the European patent application is refused, withdrawn or deemed to be withdrawn, the fees for grant and printing, and any claims fees paid under paragraph 7, shall be refunded.

(7) If the European patent application in the text intended for grant comprises more than ten claims, the Examining Division shall invite the applicant to pay claims fees in respect of each additional claim within the period laid down in paragraph 4 unless these fees have already been paid under Rule 31, paragraph 1.

(8) If the fees for grant and printing or the claims fees are not paid in due time or if the translation is not filed in due time, the European patent application shall be deemed to be withdrawn.

(8a) If the designation fees become due after the communication under paragraph 4 has been notified, the mention of the grant of the European patent shall not be published until the designation fees have been paid. The applicant shall be informed accordingly.

(9) If a renewal fee becomes due after the communication under paragraph 4 has been notified and before the next possible date for publication of the mention of the grant of the European patent, the mention shall not be published until the renewal fee has been paid. The applicant shall be informed accordingly.

(10) The communication under paragraph 4 shall indicate the designated Contracting States which require a translation pursuant to Article 65, paragraph 1.

(11) The decision to grant the European patent shall state which text of the European patent application forms the basis for the grant of the European patent.

Rule 52

Grant of the European patent to different applicants

Where different persons are entered in the Register of European Patents as applicants in respect of different Contracting States, the Examining Division shall grant the European patent for each Contracting State to the applicant or applicants registered in respect of that State.

(6) Si la division d'examen n'approuve pas une modification ou une correction demandée conformément au paragraphe 5, elle donne au demandeur, avant de prendre une décision, la possibilité de présenter dans un délai à fixer, ses observations et toutes modifications qu'elle juge nécessaires et, si les revendications sont modifiées, de produire une traduction des revendications telles que modifiées. Si le demandeur présente de telles modifications, il est réputé avoir donné son accord sur la délivrance du brevet tel que modifié. Si la demande de brevet européen est rejetée, retirée ou réputée retirée, les taxes de délivrance et d'impression ainsi que toute taxe de revendication acquittée conformément au paragraphe 7 sont remboursées.

(7) Si le texte dans lequel il est envisagé de délivrer le brevet européen comporte plus de dix revendications, la division d'examen invite le demandeur à acquitter dans le délai prévu au paragraphe 4 des taxes de revendication pour toutes les revendications en sus de la dixième, dans la mesure où ces taxes n'ont pas déjà été acquittées en vertu de la règle 31, paragraphe 1.

(8) Si les taxes de délivrance et d'impression, ou les taxes de revendication ne sont pas acquittées en temps utile, ou si la traduction n'est pas produite dans les délais, la demande de brevet européen est réputée retirée.

(8bis) Si les taxes de désignation viennent à échéance après la signification de la notification visée au paragraphe 4, la mention de la délivrance du brevet européen n'est publiée que lorsque les taxes de désignation sont acquittées. Le demandeur en est informé.

(9) Si une taxe annuelle vient à échéance après la signification de la notification visée au paragraphe 4 et avant la date la plus proche possible de publication de la mention de délivrance du brevet européen, cette mention n'est publiée que lorsque la taxe annuelle est acquittée. Le demandeur en est informé.

(10) La notification visée au paragraphe 4 doit indiquer les Etats contractants désignés qui exigent une traduction en vertu de l'article 65, paragraphe 1.

(11) La décision de délivrance du brevet européen indique celui des textes de la demande de brevet européen qui a donné lieu à la délivrance du brevet européen.

Règle 52

Délivrance du brevet européen à plusieurs demandeurs

Art. 59, 97

Si des personnes différentes sont inscrites au Registre européen des brevets en tant que titulaires de la demande de brevet dans différents Etats contractants, la division d'examen délivre le brevet européen, pour chacun desdits Etats contractants, à celui des demandeurs qui figure ou à ceux des demandeurs qui figurent au registre comme titulaires des droits pour cet Etat.

Europäische Patentschrift

*Regel 53*⁷⁹

Technische Vorbereitungen für die Veröffentlichung und Form der europäischen Patentschrift

Die Regeln 48 und 49 Absätze 1 und 2 sind auf die europäische Patentschrift entsprechend anzuwenden. Außerdem wird in der Patentschrift die Frist angegeben, innerhalb deren Einspruch gegen das europäische Patent eingelegt werden kann.

*Regel 54*⁸⁰

Urkunde über das europäische Patent

Sobald die europäische Patentschrift herausgegeben worden ist, stellt das Europäische Patentamt dem Patentinhaber die Urkunde über das europäische Patent aus. Der Präsident des Europäischen Patentamts bestimmt den Inhalt und die Form der Urkunde sowie die Art und Weise, wie sie übermittelt wird, und legt fest, in welchen Fällen eine Verwaltungsgebühr zu entrichten ist.

The European patent specification

*Rule 53*⁷⁹

Technical preparations for publication and form of the specification of the European patent

Rules 48 and 49, paragraphs 1 and 2, shall apply *mutatis mutandis* to the specification of the European patent. The specification shall also contain an indication of the time limit for opposing the European patent.

*Rule 54*⁸⁰

Certificate for a European patent

As soon as the specification of the European patent has been published, the European Patent Office shall issue to the proprietor of the patent a certificate for a European patent. The President of the European Patent Office shall prescribe the content, form and means of communication of the certificate and determine the circumstances in which an administrative fee is payable.

⁷⁹ Geändert durch Beschluss des Verwaltungsrats vom 10.06.1988, in Kraft getreten am 01.10.1988 (ABl. EPA 1988, 290 ff.). Siehe Mitteilung des Präsidenten des EPA vom 10.01.1984 über die Form der europäischen Patentschriften (ABl. EPA 1984, 88).

⁸⁰ Geändert durch Beschluss des Verwaltungsrats vom 09.12.2004, in Kraft getreten am 01.04.2005 (ABl. EPA 2005, 11 f.).

⁷⁹ Amended by decision of the Administrative Council of 10.06.1988 which entered into force on 01.10.1988 (OJ EPO 1988, 290 ff). See notice of the President of the EPO of 10.01.1984 concerning the form of European patent specifications (OJ EPO 1984, 88).

⁸⁰ Amended by decision of the Administrative Council of 09.12.2004 which entered into force on 01.04.2005 (OJ EPO 2005, 11 f).

Fascicule du brevet européen*Règle 53*⁷⁹

Préparatifs techniques en vue de la publication et
forme du fascicule du brevet européen

Art. 98, 99

Les dispositions des règles 48 et 49, paragraphes 1 et 2 s'appliquent au fascicule du brevet européen. Le fascicule mentionne également le délai pendant lequel le brevet européen délivré peut faire l'objet d'une opposition.

*Règle 54*⁸⁰

Certificat de brevet européen

Art. 98
R. 62a/bis

Dès que le fascicule du brevet européen a été publié, l'Office européen des brevets délivre au titulaire du brevet un certificat de brevet européen. Le Président de l'Office européen des brevets arrête le contenu, la forme et les moyens de communication du certificat et détermine les cas dans lesquels il y a lieu d'acquitter une taxe d'administration.

⁷⁹ Modifiée par décision du Conseil d'administration en date du 10.06.1988, entrée en vigueur le 01.10.1988 (JO OEB 1988, 290 s.). Cf. le communiqué du Président de l'OEB du 10.01.1984 concernant la forme des fascicules de brevet européen (JO OEB 1984, 88).

⁸⁰ Modifiée par décision du Conseil d'administration en date du 09.12.2004, entrée en vigueur le 01.04.2005 (JO OEB 2005, 11 s.).

FÜNFTER TEIL

AUSFÜHRUNGSVORSCHRIFTEN ZUM FÜNFTEN TEIL DES ÜBEREINKOMMENS

*Regel 55*⁸¹

Inhalt der Einspruchsschrift

Die Einspruchsschrift muss enthalten:

- a) den Namen, die Anschrift und den Staat des Wohnsitzes oder Sitzes des Einsprechenden nach Maßgabe der Regel 26 Absatz 2 Buchstabe c;
- b) die Nummer des europäischen Patents, gegen das der Einspruch eingelegt wird, sowie die Bezeichnung des Inhabers dieses Patents und der Erfindung;
- c) eine Erklärung darüber, in welchem Umfang gegen das europäische Patent Einspruch eingelegt und auf welche Einspruchsgründe der Einspruch gestützt wird, sowie die Angabe der zur Begründung vorgebrachten Tatsachen und Beweismittel;
- d) falls ein Vertreter des Einsprechenden bestellt ist, seinen Namen und seine Geschäftsanschrift nach Maßgabe der Regel 26 Absatz 2 Buchstabe c.

*Regel 56*⁸²

Verwerfung des Einspruchs als unzulässig

(1) Stellt die Einspruchsabteilung fest, dass der Einspruch Artikel 99 Absatz 1 sowie Regel 1 Absatz 1 und Regel 55 Buchstabe c nicht entspricht oder dass das europäische Patent, gegen das der Einspruch eingelegt wird, nicht hinreichend bezeichnet ist, so verwirft sie den Einspruch als unzulässig, sofern die Mängel nicht bis zum Ablauf der Einspruchsfrist beseitigt worden sind.

(2)⁸³ Stellt die Einspruchsabteilung fest, dass der Einspruch anderen als den in Absatz 1 bezeichneten Vorschriften nicht entspricht, so teilt sie dies dem Antragsteller mit und fordert ihn auf, innerhalb einer von ihr zu bestimmenden Frist die festgestellten Mängel zu beseitigen. Werden die Mängel nicht rechtzeitig beseitigt, so verwirft die Einspruchsabteilung den Einspruch als unzulässig.

PART V

IMPLEMENTING REGULATIONS TO PART V OF THE CONVENTION

*Rule 55*⁸¹

Content of the notice of opposition

The notice of opposition shall contain:

- (a) the name and address of the opponent and the State in which his residence or principal place of business is located, in accordance with the provisions of Rule 26, paragraph 2(c);
- (b) the number of the European patent against which opposition is filed, and the name of the proprietor and title of the invention;
- (c) a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds;
- (d) if the opponent has appointed a representative, his name and the address of his place of business, in accordance with the provisions of Rule 26, paragraph 2(c).

*Rule 56*⁸²

Rejection of the notice of opposition as inadmissible

(1) If the Opposition Division notes that the notice of opposition does not comply with the provisions of Article 99, paragraph 1, Rule 1, paragraph 1, and Rule 55, sub-paragraph (c), or does not provide sufficient identification of the patent against which opposition has been filed, it shall reject the notice of opposition as inadmissible unless these deficiencies have been remedied before expiry of the opposition period.

(2)⁸³ If the Opposition Division notes that the notice of opposition does not comply with provisions other than those mentioned in paragraph 1, it shall communicate this to the opponent and shall invite him to remedy the deficiencies noted within such period as it may specify. If the notice of opposition is not corrected in good time the Opposition Division shall reject it as inadmissible.

⁸¹ Siehe hierzu Entscheidungen/Stellnahmen der Großen Beschwerdekammer G 9/91, G 10/91, G 1/95, G 7/95, G 3/97, G 4/97, G 3/99, G 1/02 (Anhang I).

⁸² Siehe hierzu Entscheidungen/Stellnahmen der Großen Beschwerdekammer G 9/91, G 10/91, G 1/95, G 7/95, G 3/99, G 1/02 (Anhang I).

⁸³ Geändert durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABI. EPA 1978, 12 ff.).

⁸¹ See decisions/opinions of the Enlarged Board of Appeal G 9/91, G 10/91, G 1/95, G 7/95, G 3/97, G 4/97, G 3/99, G 1/02 (Annex I).

⁸² See decisions/opinions of the Enlarged Board of Appeal G 9/91, G 10/91, G 1/95, G 7/95, G 3/99, G 1/02 (Annex I).

⁸³ Amended by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff.).

CINQUIÈME PARTIE

Verweisungen / References / Références

DISPOSITIONS D'APPLICATION DE LA CINQUIÈME PARTIE DE LA CONVENTION

*Règle 55*⁸¹

Contenu de l'acte d'opposition

Art. 99, 100, 105, 133
R. 56

L'acte d'opposition doit comporter :

- a) l'indication du nom, de l'adresse et de l'Etat du domicile ou du siège de l'opposant, dans les conditions prévues à la règle 26, paragraphe 2, lettre c) ;
- b) le numéro du brevet européen contre lequel l'opposition est formée, ainsi que la désignation de son titulaire et le titre de l'invention ;
- c) une déclaration précisant la mesure dans laquelle le brevet européen est mis en cause par l'opposition, les motifs sur lesquels l'opposition se fonde ainsi que les faits et justifications invoqués à l'appui de ces motifs ;
- d) l'indication du nom et de l'adresse professionnelle du mandataire de l'opposant, s'il en a été constitué un, dans les conditions prévues à la règle 26, paragraphe 2, lettre c).

*Règle 56*⁸²

Rejet de l'opposition pour irrecevabilité

Art. 101, 105

(1) Si la division d'opposition constate que l'opposition n'est pas conforme aux dispositions de l'article 99, paragraphe 1, de la règle 1, paragraphe 1 et de la règle 55, lettre c), ou ne désigne pas le brevet en cause de manière suffisante, elle rejette ladite opposition comme irrecevable, à moins qu'il n'ait été remédié à ces irrégularités avant l'expiration du délai d'opposition.

(2)⁸³ Si la division d'opposition constate que l'opposition n'est pas conforme aux dispositions autres que celles prévues au paragraphe 1, elle le notifie à l'opposant et l'invite à remédier aux irrégularités constatées, dans un délai qu'elle lui impartit. Si l'acte d'opposition n'est pas régularisé dans les délais, la division d'opposition rejette l'opposition comme irrecevable.

⁸¹ Cf. les décisions/avis de la Grande Chambre de recours G 9/91, G 10/91, G 1/95, G 7/95, G 3/97, G 4/97, G 3/99, G 1/02 (Annexe I).

⁸² Cf. les décisions/avis de la Grande Chambre de recours G 9/91, G 10/91, G 1/95, G 7/95, G 3/99, G 1/02 (Annexe I).

⁸³ Modifié par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.).

(3) Jede Entscheidung, durch die ein Einspruch als unzulässig verworfen wird, wird dem Patentinhaber mit einer Abschrift des Einspruchs mitgeteilt.

Regel 57

Vorbereitung der Einspruchsprüfung

(1)⁸⁴ Die Einspruchsabteilung teilt dem Patentinhaber den Einspruch mit und fordert ihn auf, innerhalb einer von ihr zu bestimmenden Frist eine Stellungnahme und gegebenenfalls Änderungen der Beschreibung, der Patentansprüche und der Zeichnungen einzureichen.

(2) Sind mehrere Einsprüche eingelegt worden, so teilt die Einspruchsabteilung gleichzeitig mit der Mitteilung nach Absatz 1 die Einsprüche den übrigen Einsprechenden mit.

(3) Die Einspruchsabteilung teilt die Stellungnahme des Patentinhabers und gegebenenfalls die Änderungen den übrigen Beteiligten mit und fordert sie auf, wenn sie dies für sachdienlich erachtet, sich innerhalb einer von ihr zu bestimmenden Frist hierzu zu äußern.

(4) Im Fall eines Antrags auf Beitritt zum Einspruchsverfahren kann die Einspruchsabteilung von der Anwendung der Absätze 1 bis 3 absehen.

*Regel 57a*⁸⁵

Änderung des europäischen Patents

Unbeschadet Regel 87 können die Beschreibung, die Patentansprüche und die Zeichnungen geändert werden, soweit die Änderungen durch Einspruchsgründe nach Artikel 100 veranlasst sind, auch wenn der betreffende Grund vom Einsprechenden nicht geltend gemacht worden ist.

Regel 58

Prüfung des Einspruchs

(1) Alle Bescheide nach Artikel 101 Absatz 2 und alle hierzu eingehenden Stellungnahmen werden den Beteiligten übersandt.

(2)⁸⁶ In den Bescheiden, die nach Artikel 101 Absatz 2 an den Patentinhaber ergehen, wird dieser gegebenenfalls aufgefordert, soweit erforderlich die Beschreibung, die Patentansprüche und die Zeichnungen in geänderter Form einzureichen.

⁸⁴ Geändert durch Beschluss des Verwaltungsrats vom 10.06.1988, in Kraft getreten am 01.10.1988 (ABl. EPA 1988, 290 ff.). Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 1/02 (Anhang I).

⁸⁵ Eingefügt durch Beschluss des Verwaltungsrats vom 13.12.1994, in Kraft getreten am 01.06.1995 (ABl. EPA 1995, 9 ff.). Siehe hierzu Entscheidung der Großen Beschwerdekammer G 1/99 (Anhang I).

⁸⁶ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 9/92, G 1/99 (Anhang I).

(3) Any decision to reject a notice of opposition as inadmissible shall be communicated to the proprietor of the patent, together with a copy of the notice.

Rule 57

Preparation of the examination of the opposition

(1)⁸⁴ The Opposition Division shall communicate the opposition to the proprietor of the patent and shall invite him to file his observations and to file amendments, where appropriate, to the description, claims and drawings within a period to be fixed by the Opposition Division.

(2) If several notices of opposition have been filed, the Opposition Division shall communicate them to the other opponents at the same time as the communication provided for under paragraph 1.

(3) The observations and any amendments filed by the proprietor of the patent shall be communicated to the other parties concerned who shall be invited by the Opposition Division, if it considers it expedient, to reply within a period to be fixed by the Opposition Division.

(4) In the case of a notice of intervention in opposition proceedings the Opposition Division may dispense with the application of paragraphs 1 to 3.

*Rule 57a*⁸⁵

Amendment of the European patent

Without prejudice to Rule 87, the description, claims and drawings may be amended, provided that the amendments are occasioned by grounds for opposition specified in Article 100, even if the respective ground has not been invoked by the opponent.

Rule 58

Examination of opposition

(1) All communications issued pursuant to Article 101, paragraph 2, and all replies thereto shall be communicated to all parties.

(2)⁸⁶ In any communication to the proprietor of the European patent pursuant to Article 101, paragraph 2, he shall, where appropriate, be invited to file, where necessary, the description, claims and drawings in amended form.

⁸⁴ Amended by decision of the Administrative Council of 10.06.1988 which entered into force on 01.10.1988 (OJ EPO 1988, 290 ff). See opinion of the Enlarged Board of Appeal G 1/02 (Annex I).

⁸⁵ Inserted by decision of the Administrative Council of 13.12.1994 which entered into force on 01.06.1995 (OJ EPO 1995, 9 ff). See decision of the Enlarged Board of Appeal G 1/99 (Annex I).

⁸⁶ See decisions of the Enlarged Board of Appeal G 9/92, G 1/99 (Annex I).

(3) Toute décision par laquelle une opposition est rejetée pour irrecevabilité est notifiée, avec une copie de l'acte d'opposition, au titulaire du brevet.

Verweisungen / References / Références

Règle 57

Mesures préparatoires à l'examen de l'opposition

Art. 101, 105, 123

(1)⁸⁴ La division d'opposition notifiée au titulaire du brevet l'opposition formée et l'invite, dans un délai qu'elle lui impartit, à présenter ses observations et à soumettre, s'il y a lieu, des modifications à la description, aux revendications et aux dessins.

(2) Si plusieurs oppositions ont été formées, ces oppositions sont notifiées en même temps que la notification visée au paragraphe 1 par la division d'opposition aux différents opposants.

(3) Les observations du titulaire du brevet ainsi que toutes modifications qu'il a soumises sont notifiées aux autres parties intéressées par la division d'opposition qui invite les parties, si elle le juge opportun, à répliquer dans un délai qu'elle leur impartit.

(4) En cas de demande d'intervention dans la procédure d'opposition, la division d'opposition peut s'abstenir d'appliquer les dispositions des paragraphes 1, 2 et 3.

*Règle 57bis*⁸⁵

Modification du brevet européen

Art. 123

R. 86

Sans préjudice de la règle 87, la description, les revendications et les dessins peuvent être modifiés, dans la mesure où ces modifications sont apportées pour pouvoir répondre à des motifs d'opposition visés à l'article 100, même si le motif en cause n'a pas été invoqué par l'opposant.

Règle 58

Examen de l'opposition

Art. 102, 105, 123

(1) Toute notification faite en vertu de l'article 101, paragraphe 2, ainsi que toute réponse sont notifiées à toutes les parties.

(2)⁸⁶ Dans toute notification faite au titulaire du brevet européen en application de l'article 101, paragraphe 2, celui-ci est invité, s'il y a lieu, à déposer, en tant que de besoin, une description, des revendications et des dessins modifiés.

⁸⁴ Modifié par décision du Conseil d'administration en date du 10.06.1988, entrée en vigueur le 01.10.1988 (JO OEB 1988, 290 s.). Cf. l'avis de la Grande Chambre de recours G 1/02 (Annexe I).

⁸⁵ Insérée par décision du Conseil d'administration en date du 13.12.1994, entrée en vigueur le 01.06.1995 (JO OEB 1995, 9 s.). Cf. la décision de la Grande Chambre de recours G 1/99 (Annexe I).

⁸⁶ Cf. les décisions de la Grande Chambre de recours G 9/92, G 1/99 (Annexe I).

(3) Die Bescheide, die nach Artikel 101 Absatz 2 an den Patentinhaber ergehen, sind soweit erforderlich zu begründen; dabei sollen alle Gründe zusammengefasst werden, die der Aufrechterhaltung des europäischen Patents entgegenstehen.

(4)⁸⁷ Bevor die Einspruchsabteilung die Aufrechterhaltung des europäischen Patents in geändertem Umfang beschließt, teilt sie den Beteiligten mit, in welchem Umfang sie das Patent aufrechtzuerhalten beabsichtigt, und fordert sie auf, innerhalb von zwei Monaten Stellung zu nehmen, wenn sie mit der Fassung, in der das Patent aufrechterhalten werden soll, nicht einverstanden sind.

(5)⁸⁸ Ist ein Beteiligter mit der von der Einspruchsabteilung mitgeteilten Fassung nicht einverstanden, so kann das Einspruchsverfahren fortgesetzt werden; andernfalls fordert die Einspruchsabteilung den Patentinhaber nach Ablauf der in Absatz 4 genannten Frist auf, innerhalb von drei Monaten die Druckkostengebühr für eine neue europäische Patentschrift zu entrichten und eine Übersetzung der geänderten Patentansprüche in den beiden Amtssprachen des Europäischen Patentamts einzureichen, die nicht die Verfahrenssprache sind.

(6)⁸⁹ Werden die nach Absatz 5 erforderlichen Handlungen nicht rechtzeitig vorgenommen, so können sie noch innerhalb einer Frist von zwei Monaten nach Zustellung einer Mitteilung, in der auf die Fristversäumung hingewiesen wird, wirksam vorgenommen werden, sofern innerhalb dieser Frist eine Zuschlagsgebühr in Höhe der zweifachen Druckkostengebühr für eine neue europäische Patentschrift entrichtet wird.

(7) In der Mitteilung der Einspruchsabteilung nach Absatz 5 werden die benannten Vertragsstaaten angegeben, die eine Übersetzung nach Artikel 65 Absatz 1 verlangen.

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

(3) Where necessary, any communication to the proprietor of the European patent pursuant to Article 101, paragraph 2, shall contain a reasoned statement. Where appropriate, this statement shall cover all the grounds against the maintenance of the European patent.

(4)⁸⁷ Before the Opposition Division decides on the maintenance of the European patent in the amended form, it shall inform the parties that it intends to maintain the patent as amended and shall invite them to state their observations within a period of two months if they disapprove of the text in which it is intended to maintain the patent.

(5)⁸⁸ If disapproval of the text communicated by the Opposition Division is expressed, examination of the opposition may be continued; otherwise, the Opposition Division shall, on expiry of the period referred to in paragraph 4, request the proprietor of the patent to pay, within three months, the fee for the printing of a new specification of the European patent and to file a translation of any amended claims in the two official languages of the European Patent Office other than the language of the proceedings.

(6)⁸⁹ If the acts requested under paragraph 5 are not performed in due time they may still be validly performed within two months of notification of a communication pointing out the failure to observe the time limit, provided that within this two-month period a surcharge equal to twice the fee for printing a new specification of the European patent is paid.

(7) The communication of the Opposition Division under paragraph 5 shall indicate the designated Contracting States which require a translation pursuant to Article 65, paragraph 1.

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

⁸⁷ Geändert durch Beschluss des Verwaltungsrats vom 10.06.1988, in Kraft getreten am 01.10.1988 (ABI. EPA 1988, 290 ff.). Siehe hierzu Entscheidung der Großen Beschwerdekammer G 1/88 (Anhang I).

⁸⁸ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.). Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 1/90 (Anhang I).

⁸⁹ Eingefügt durch Beschluss des Verwaltungsrats vom 08.12.1988, in Kraft getreten am 01.04.1989 (ABI. EPA 1989, 1).

⁸⁷ Amended by decision of the Administrative Council of 10.06.1988 which entered into force on 01.10.1988 (OJ EPO 1988, 290 ff). See decision of the Enlarged Board of Appeal G 1/88 (Annex I).

⁸⁸ Last amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff). See decision of the Enlarged Board of Appeal G 1/90 (Annex I).

⁸⁹ Inserted by decision of the Administrative Council of 08.12.1988 which entered into force on 01.04.1989 (OJ EPO 1989, 1).

(3) En tant que de besoin, toute notification faite au titulaire du brevet européen en application de l'article 101, paragraphe 2, est motivée. S'il y a lieu, la notification indique l'ensemble des motifs qui s'opposent au maintien du brevet européen.

(4)⁸⁷ Avant de prendre la décision de maintenir le brevet européen dans sa forme modifiée, la division d'opposition notifie aux parties qu'elle envisage le maintien du brevet ainsi modifié et les invite à présenter leurs observations dans le délai de deux mois si elles ne sont pas d'accord sur le texte dans lequel elle a l'intention de maintenir le brevet.

(5)⁸⁸ En cas de désaccord sur le texte notifié par la division d'opposition, l'examen de l'opposition peut être poursuivi; dans le cas contraire, la division d'opposition, à l'expiration du délai visé au paragraphe 4, invite le titulaire du brevet européen à acquitter dans un délai de trois mois la taxe d'impression d'un nouveau fascicule du brevet européen et à produire une traduction des revendications modifiées dans les deux langues officielles de l'Office européen des brevets autres que celle de la procédure.

(6)⁸⁹ Si les actes requis au paragraphe 5 ne sont pas accomplis dans les délais, ils peuvent l'être encore valablement dans un délai de deux mois à compter de la signification d'une notification signalant que le délai prévu n'a pas été observé, à condition qu'une surtaxe d'un montant égal à deux fois celui de la taxe d'impression d'un nouveau fascicule du brevet européen soit acquittée dans ce délai de deux mois.

(7) La notification de la division d'opposition à laquelle fait référence le paragraphe 5 doit indiquer les Etats contractants désignés qui exigent une traduction en application des dispositions de l'article 65, paragraphe 1.

(8) La décision de maintenir le brevet européen dans sa forme modifiée indique celui des textes du brevet européen sur la base duquel le brevet a été maintenu.

⁸⁷ Modifié par décision du Conseil d'administration en date du 10.06.1988, entrée en vigueur le 01.10.1988 (JO OEB 1988, 290 s.). Cf. la décision de la Grande Chambre de recours G 1/88 (Annexe I).

⁸⁸ Modifié en dernier lieu par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.). Cf. la décision de la Grande Chambre de recours G 1/90 (Annexe I).

⁸⁹ Inséré par décision du Conseil d'administration en date du 08.12.1988, entrée en vigueur le 01.04.1989 (JO OEB 1989, 1).

*Regel 59*⁹⁰

Anforderung von Unterlagen

Unterlagen, die von einem am Einspruchsverfahren Beteiligten genannt werden, sind zusammen mit dem Einspruch oder dem schriftlichen Vorbringen in zwei Stücken einzureichen. Sind solche Unterlagen nicht beigelegt und werden sie nach Aufforderung durch das Europäische Patentamt nicht rechtzeitig nachgereicht, so braucht das Europäische Patentamt das darauf gestützte Vorbringen nicht zu berücksichtigen.

Regel 60

Fortsetzung des Einspruchsverfahrens von Amts wegen

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

(2)⁹¹ Stirbt ein Einsprechender oder verliert er seine Geschäftsfähigkeit, so kann das Einspruchsverfahren auch ohne die Beteiligung seiner Erben oder gesetzlichen Vertreter von Amts wegen fortgesetzt werden. Das Verfahren kann auch fortgesetzt werden, wenn der Einspruch zurückgenommen wird.

Regel 61

Rechtsübergang des europäischen Patents

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

*Regel 61a*⁹²

Unterlagen im Einspruchsverfahren

Die Vorschriften von Kapitel II des Dritten Teils der Ausführungsordnung sind auf die im Einspruchsverfahren eingereichten Unterlagen entsprechend anzuwenden.

*Rule 59*⁹⁰

Requests for documents

Documents referred to by a party to opposition proceedings shall be filed together with the notice of opposition or the written submissions in two copies. If such documents are neither enclosed nor filed in due time upon invitation by the European Patent Office, it may decide not to take into account any arguments based on them.

Rule 60

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

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

(2)⁹¹ In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued by the European Patent Office of its own motion, even without the participation of the heirs or legal representatives. The same shall apply when the opposition is withdrawn.

Rule 61

Transfer of the European patent

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

*Rule 61a*⁹²

Documents in opposition proceedings

Part III, Chapter II, of the Implementing Regulations shall apply mutatis mutandis to documents filed in opposition proceedings.

⁹⁰ Geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.).

⁹¹ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 4/88, G 7/91, G 8/91, G 8/93, G 3/99 (Anhang I).

⁹² Eingefügt durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABI. EPA 1978, 12 ff.). Siehe hierzu Entscheidung der Großen Beschwerdekammer G 1/91 (Anhang I).

⁹⁰ Amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff.).

⁹¹ See decisions of the Enlarged Board of Appeal G 4/88, G 7/91, G 8/91, G 8/93, G 3/99 (Annex I).

⁹² Inserted by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff.). See decision of the Enlarged Board of Appeal G 1/91 (Annex I).

*Règle 59*⁹⁰

Demande de documents

Verweisungen / References / Références

Art. 101, 105

Les documents mentionnés par une partie à la procédure d'opposition doivent être déposés en deux exemplaires avec l'acte d'opposition ou les conclusions écrites. Si ces documents ne sont pas joints audit acte ou auxdites conclusions ou déposés en temps utile à l'invitation de l'Office européen des brevets, celui-ci peut ne pas tenir compte des arguments à l'appui desquels ils sont invoqués.

Règle 60

Poursuite d'office de la procédure d'opposition

Art. 99, 101, 105

(1) Si le titulaire a renoncé au brevet européen pour tous les Etats désignés ou si celui-ci s'est éteint pour tous ces Etats, la procédure d'opposition peut être poursuivie sur requête de l'opposant; cette requête doit être présentée dans un délai de deux mois à compter de la signification faite à l'opposant par l'Office européen des brevets de la renonciation ou de l'extinction.

(2)⁹¹ Si un opposant décède ou devient incapable, la procédure d'opposition peut être poursuivie d'office, même sans la participation de ses héritiers ou représentants légaux. Il en va de même en cas de retrait de l'opposition.

Règle 61

Transfert du brevet européen

Art. 2, 99

Les dispositions de la règle 20 sont applicables au transfert du brevet européen pendant le délai d'opposition ou pendant la procédure d'opposition.

*Règle 61bis*⁹²

Documents présentés au cours de la procédure d'opposition

Art. 99, 101, 105

Les dispositions du chapitre II de la Troisième Partie du règlement d'exécution s'appliquent aux documents présentés au cours de la procédure d'opposition.

⁹⁰ Modifiée par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.).

⁹¹ Cf. les décisions de la Grande Chambre de recours G 4/88, G 7/91, G 8/91, G 8/93, G 3/99 (Annexe I).

⁹² Insérée par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.). Cf. la décision de la Grande Chambre de recours G 1/91 (Annexe I).

Regel 62

Form der neuen europäischen Patentschrift im
Einspruchsverfahren

Regel 49 Absätze 1 und 2 ist auf die neue europäische Patentschrift entsprechend anzuwenden.

*Regel 62a*⁹³

Neue Urkunde über das europäische Patent

Regel 54 ist auf die neue europäische Patentschrift entsprechend anzuwenden.

Regel 63

Kosten

(1) Die Kostenverteilung wird in der Entscheidung über den Einspruch angeordnet. Es können nur die Kosten berücksichtigt werden, die zur zweckentsprechenden Wahrung der Rechte notwendig waren. Zu den Kosten gehört die Vergütung für die Vertreter der Beteiligten.

(2) Dem Antrag auf Kostenfestsetzung sind eine Kostenberechnung und die Belege beizufügen. Der Antrag ist erst zulässig, wenn die Entscheidung, für die die Kostenfestsetzung beantragt wird, rechtskräftig ist. Zur Festsetzung der Kosten genügt es, dass sie glaubhaft gemacht werden.

(3) Der Antrag auf Entscheidung der Einspruchsabteilung über die Kostenfestsetzung der Geschäftsstelle ist innerhalb eines Monats nach Zustellung der Kostenfestsetzung schriftlich beim Europäischen Patentamt einzureichen und zu begründen. Der Antrag gilt erst als gestellt, wenn die Kostenfestsetzungsgebühr entrichtet worden ist.

(4) Die Einspruchsabteilung entscheidet über den in Absatz 3 genannten Antrag ohne mündliche Verhandlung.

Rule 62

Form of the new specification of the European patent
in opposition proceedings

Rule 49, paragraphs 1 and 2, shall apply *mutatis mutandis* to the new specification of the European patent.

*Rule 62a*⁹³

New certificate for a European patent

Rule 54 shall apply *mutatis mutandis* to the new specification of the European patent.

Rule 63

Costs

(1) Apportionment of costs shall be dealt with in the decision on the opposition. Such apportionment shall only take into consideration the expenses necessary to assure proper protection of the rights involved. The costs shall include the remuneration of the representatives of the parties.

(2) A bill of costs, with supporting evidence, shall be attached to the request for the fixing of costs. The request shall only be admissible if the decision in respect of which the fixing of costs is required has become final. Costs may be fixed once their credibility is established.

(3) The request for a decision by the Opposition Division on the awarding of costs by the registry, stating the reasons on which it is based, must be filed in writing to the European Patent Office within one month after the date of notification of the awarding of costs. It shall not be deemed to be filed until the fee for the awarding of costs has been paid.

(4) The Opposition Division shall take a decision on the request referred to in paragraph 3 without oral proceedings.

⁹³ Eingefügt durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABI. EPA 1978, 12 ff.).

⁹³ Inserted by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff.).

Règle 62

Forme du nouveau fascicule du brevet européen
dans la procédure d'opposition

Verweisungen / References / Références

Art. 103

Les dispositions de la règle 49, paragraphes 1 et 2, s'appliquent au nouveau fascicule du brevet européen.

*Règle 62bis*⁹³

Nouveau certificat de brevet européen

Art. 103

Les dispositions de la règle 54 s'appliquent au nouveau fascicule du brevet européen.

Règle 63

Frais

Art. 104, 106

(1) La répartition des frais est prescrite dans la décision rendue sur l'opposition. La répartition ne peut prendre en considération que les dépenses nécessaires pour assurer une défense adéquate des droits en cause. Les frais incluent la rémunération des représentants des parties.

(2) Le décompte des frais et les pièces justificatives doivent être annexés à la requête de fixation des frais. Celle-ci n'est recevable que si la décision pour laquelle est requise la fixation des frais est passée en force de chose jugée. Pour la fixation des frais, il suffit que leur présomption soit établie.

(3) La requête motivée en vue d'une décision de la division d'opposition sur la fixation des frais par le greffe doit être présentée par écrit à l'Office européen des brevets, dans le délai d'un mois après la signification de la fixation des frais. Elle n'est réputée présentée qu'après paiement de la taxe de fixation des frais.

(4) La division d'opposition statue sur la requête visée au paragraphe 3 sans procédure orale.

⁹³ Insérée par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.).

SECHSTER TEIL

AUSFÜHRUNGSVORSCHRIFTEN ZUM SECHSTEN TEIL DES ÜBEREINKOMMENS

Regel 64

Inhalt der Beschwerdeschrift

Die Beschwerdeschrift muss enthalten:

- a) den Namen und die Anschrift des Beschwerdeführers nach Maßgabe der Regel 26 Absatz 2 Buchstabe c;
- b)⁹⁴ einen Antrag, der die angefochtene Entscheidung und den Umfang anzugeben hat, in dem ihre Änderung oder Aufhebung begehrt wird.

Regel 65⁹⁵

Verwerfung der Beschwerde als unzulässig

(1) Entspricht die Beschwerde nicht den Artikeln 106 bis 108 sowie Regel 1 Absatz 1 und Regel 64 Buchstabe b, so verwirft die Beschwerdekammer sie als unzulässig, sofern die Mängel nicht bis zum Ablauf der nach Artikel 108 maßgebenden Fristen beseitigt worden sind.

(2) Stellt die Beschwerdekammer fest, dass die Beschwerde der Regel 64 Buchstabe a nicht entspricht, so teilt sie dies dem Beschwerdeführer mit und fordert ihn auf, innerhalb einer von ihr zu bestimmenden Frist die festgestellten Mängel zu beseitigen. Werden die Mängel nicht rechtzeitig beseitigt, so verwirft die Beschwerdekammer die Beschwerde als unzulässig.

Regel 66⁹⁶

Prüfung der Beschwerde

(1) Die Vorschriften für das Verfahren vor der Stelle, die die mit der Beschwerde angefochtene Entscheidung erlassen hat, sind im Beschwerdeverfahren entsprechend anzuwenden, soweit nichts anderes bestimmt ist.

(2)⁹⁷ Die Entscheidung ist von dem Vorsitzenden der Beschwerdekammer und dem dafür zuständigen Bediensteten der Geschäftsstelle der Beschwerdekammer durch ihre Unterschrift oder andere geeignete Mittel als authentisch zu bestätigen. Die Entscheidung enthält:

- a) die Feststellung, dass sie von der Beschwerdekammer erlassen ist;

⁹⁴ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 9/92, G 1/99 (Anhang I).

⁹⁵ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 9/92, G 1/97 (Anhang I).

⁹⁶ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 7/91, G 8/91, G 10/91, G 9/92, G 8/93, G 6/95, G 1/97, G 1/99, G 3/99 (Anhang I).

⁹⁷ Geändert durch Beschluss des Verwaltungsrats vom 10.12.1998, in Kraft getreten am 01.01.1999 (ABI. EPA 1999, 1 ff.).

PART VI

IMPLEMENTING REGULATIONS TO PART VI OF THE CONVENTION

Rule 64

Content of the notice of appeal

The notice of appeal shall contain:

- (a) the name and address of the appellant in accordance with the provisions of Rule 26, paragraph 2(c);
- (b)⁹⁴ a statement identifying the decision which is impugned and the extent to which amendment or cancellation of the decision is requested.

Rule 65⁹⁵

Rejection of the appeal as inadmissible

(1) If the appeal does not comply with Articles 106 to 108 and with Rule 1, paragraph 1, and Rule 64, subparagraph (b), the Board of Appeal shall reject it as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 108 has expired.

(2) If the Board of Appeal notes that the appeal does not comply with the provisions of Rule 64, subparagraph (a), it shall communicate this to the appellant and shall invite him to remedy the deficiencies noted within such period as it may specify. If the appeal is not corrected in good time, the Board of Appeal shall reject it as inadmissible.

Rule 66⁹⁶

Examination of appeals

(1) Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision from which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.

(2)⁹⁷ The decision shall be authenticated by the Chairman of the Board of Appeal and by the competent employee of the registry of the Board of Appeal, either by their signature or by any other appropriate means. The decision shall contain:

- (a) a statement that it is delivered by the Board of Appeal;

⁹⁴ See decisions of the Enlarged Board of Appeal G 9/92, G 1/99 (Annex I).

⁹⁵ See decisions of the Enlarged Board of Appeal G 9/92, G 1/97 (Annex I).

⁹⁶ See decisions/opinions of the Enlarged Board of Appeal G 7/91, G 8/91, G 10/91, G 9/92, G 8/93, G 6/95, G 1/97, G 1/99, G 3/99 (Annex I).

⁹⁷ Amended by decision of the Administrative Council of 10.12.1998 which entered into force on 01.01.1999 (OJ EPO 1999, 1 ff.).

SIXIÈME PARTIE

Verweisungen / References / Références

DISPOSITIONS D'APPLICATION DE LA SIXIÈME PARTIE DE LA CONVENTION

Règle 64

Contenu de l'acte de recours

Art. 108
R. 65

L'acte de recours doit comporter :

- a) le nom et l'adresse du requérant, dans les conditions prévues à la règle 26, paragraphe 2, lettre c) ;
- b)⁹⁴ une requête identifiant la décision attaquée et indiquant la mesure dans laquelle sa modification ou sa révocation est demandée.

*Règle 65*⁹⁵

Rejet du recours pour irrecevabilité

(1) Si le recours n'est pas conforme aux exigences des articles 106 à 108 et à celles de la règle 1, paragraphe 1 et de la règle 64, lettre b), la chambre de recours le rejette comme irrecevable, à moins qu'il n'ait été remédié aux irrégularités avant l'expiration, selon le cas, de l'un ou l'autre des délais fixés à l'article 108.

(2) Si la chambre de recours constate que le recours n'est pas conforme aux dispositions de la règle 64, lettre a), elle le notifie au requérant et l'invite à remédier aux irrégularités constatées dans un délai qu'elle lui impartit. Si le recours n'est pas régularisé dans les délais, la chambre de recours le rejette comme irrecevable.

*Règle 66*⁹⁶

Examen du recours

Art. 110, 111

(1) A moins qu'il n'en soit disposé autrement, les dispositions relatives à la procédure devant l'instance qui a rendu la décision faisant l'objet du recours sont applicables à la procédure de recours.

(2)⁹⁷ La décision est authentifiée par le président de la chambre de recours et l'agent du greffe de ladite chambre habilité à cet effet, soit par leur signature, soit par tout autre moyen approprié. La décision contient :

- a) l'indication qu'elle a été rendue par la chambre de recours ;

⁹⁴ Cf. les décisions de la Grande Chambre de recours G 9/92, G 1/99 (Annexe I).

⁹⁵ Cf. les décisions de la Grande Chambre de recours G 9/92, G 1/97 (Annexe I).

⁹⁶ Cf. les décisions/avis de la Grande Chambre de recours G 7/91, G 8/91, G 10/91, G 9/92, G 8/93, G 6/95, G 1/97, G 1/99, G 3/99 (Annexe I).

⁹⁷ Modifié par décision du Conseil d'administration en date du 10.12.1998, entrée en vigueur le 01.01.1999 (JO OEB 1999, 1 s.).

- b) den Tag, an dem die Entscheidung erlassen worden ist;
- c) die Namen des Vorsitzenden und der übrigen Mitglieder der Beschwerdekammer, die bei der Entscheidung mitgewirkt haben;
- d) die Bezeichnung der Beteiligten und ihrer Vertreter;
- e) die Anträge der Beteiligten;
- f) eine kurze Darstellung des Sachverhalts;
- g) die Entscheidungsgründe;
- h) die Formel der Entscheidung, gegebenenfalls einschließlich der Entscheidung über die Kosten.

Regel 67⁹⁸

Rückzahlung der Beschwerdegebühr

Die Rückzahlung der Beschwerdegebühr wird angeordnet, wenn der Beschwerde abgeholfen oder ihr durch die Beschwerdekammer stattgegeben wird und die Rückzahlung wegen eines wesentlichen Verfahrensmangels der Billigkeit entspricht. Die Rückzahlung wird, falls der Beschwerde abgeholfen wird, von dem Organ, dessen Entscheidung angefochten wurde, und in den übrigen Fällen von der Beschwerdekammer angeordnet.

- (b) the date when the decision was taken;
- (c) the names of the Chairman and of the other members of the Board of Appeal taking part;
- (d) the names of the parties and their representatives;
- (e) a statement of the issues to be decided;
- (f) a summary of the facts;
- (g) the reasons;
- (h) the order of the Board of Appeal, including, where appropriate, a decision on costs.

Rule 67⁹⁸

Reimbursement of appeal fees

The reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. In the event of interlocutory revision, reimbursement shall be ordered by the department whose decision has been impugned and, in other cases, by the Board of Appeal.

⁹⁸ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 1/97, G 3/03 (Anhang I).

⁹⁸ See decisions of the Enlarged Board of Appeal G 1/97, G 3/03 (Annex I).

- b) la date à laquelle elle a été rendue ;
- c) les noms du président et des autres membres de la chambre de recours qui y ont pris part ;
- d) la désignation des parties et de leurs représentants ;
- e) les conclusions des parties ;
- f) l'exposé sommaire des faits ;
- g) les motifs ;
- h) le dispositif, y compris, le cas échéant, la décision relative aux frais de procédure.

Verweisungen / References / Références

*Règle 67*⁹⁸

Remboursement de la taxe de recours

Art. 109, 111

Le remboursement de la taxe de recours est ordonné en cas de révision préjudicielle ou lorsqu'il est fait droit au recours par la chambre de recours, si le remboursement est équitable en raison d'un vice substantiel de procédure. Le remboursement est ordonné, en cas de révision préjudicielle, par l'instance dont la décision a été attaquée et, dans les autres cas, par la chambre de recours.

⁹⁸ Cf. les décisions de la Grande Chambre de recours G 1/97, G 3/03 (Annexe I).

SIEBENTER TEIL

AUSFÜHRUNGSVORSCHRIFTEN ZUM SIEBENTEN TEIL DES ÜBEREINKOMMENS

Kapitel I

Entscheidungen, Bescheide und Mitteilungen des Europäischen Patentamts

*Regel 68*⁹⁹

Form der Entscheidungen

(1) Findet eine mündliche Verhandlung vor dem Europäischen Patentamt statt, so können die Entscheidungen verkündet werden. Später sind die Entscheidungen schriftlich abzufassen und den Beteiligten zuzustellen.

(2) Die Entscheidungen des Europäischen Patentamts, die mit der Beschwerde angefochten werden können, sind zu begründen und mit einer schriftlichen Belehrung darüber zu versehen, dass gegen die Entscheidung die Beschwerde statthaft ist. In der Belehrung sind die Beteiligten auch auf die Artikel 106 bis 108 aufmerksam zu machen, deren Wortlaut beizufügen ist. Die Beteiligten können aus der Unterlassung der Rechtsmittelbelehrung keine Ansprüche herleiten.

*Regel 69*¹⁰⁰

Feststellung eines Rechtsverlusts

(1) Stellt das Europäische Patentamt fest, dass ein Rechtsverlust auf Grund des Übereinkommens eingetreten ist, ohne dass eine Entscheidung über die Zurückweisung der europäischen Patentanmeldung oder über die Erteilung, den Widerruf oder die Aufrechterhaltung des europäischen Patents oder über die Beweisaufnahme ergangen ist, so teilt es dies dem Betroffenen nach Artikel 119 mit.

(2) Ist der Betroffene der Auffassung, dass die Feststellung des Europäischen Patentamts nicht zutrifft, so kann er innerhalb von zwei Monaten nach Zustellung der Mitteilung nach Absatz 1 eine Entscheidung des Europäischen Patentamts beantragen. Eine solche Entscheidung wird nur dann getroffen, wenn das Europäische Patentamt die Auffassung des Antragstellers nicht teilt; andernfalls unterrichtet das Europäische Patentamt den Antragsteller.

⁹⁹ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 12/91 (Anhang I).

¹⁰⁰ Siehe hierzu Rechtsauskunft Nr. 16/85 (Anhang II) und Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 1/90, G 2/97, G 1/02 (Anhang I).

PART VII

IMPLEMENTING REGULATIONS TO PART VII OF THE CONVENTION

Chapter I

Decisions and communications of the European Patent Office

*Rule 68*⁹⁹

Form of decisions

(1) Where oral proceedings are held before the European Patent Office, the decision may be given orally. Subsequently the decision in writing shall be notified to the parties.

(2) Decisions of the European Patent Office which are open to appeal shall be reasoned and shall be accompanied by a written communication of the possibility of appeal. The communication shall also draw the attention of the parties to the provisions laid down in Articles 106 to 108, the text of which shall be attached. The parties may not invoke the omission of the communication.

*Rule 69*¹⁰⁰

Noting of loss of rights

(1) If the European Patent Office notes that the loss of any right results from the Convention, without any decision concerning the refusal of the European patent application or the grant, revocation or maintenance of the European patent, or the taking of evidence, it shall communicate this to the person concerned in accordance with the provisions of Article 119.

(2) If the person concerned considers that the finding of the European Patent Office is inaccurate, he may, within two months after notification of the communication referred to in paragraph 1, apply for a decision on the matter by the European Patent Office. Such decision shall be given only if the European Patent Office does not share the opinion of the person requesting it; otherwise the European Patent Office shall inform the person requesting the decision.

⁹⁹ See decision of the Enlarged Board of Appeal G 12/91 (Annex I).

¹⁰⁰ See Legal advice No. 16/85 (Annex II) and decisions/opinions of the Enlarged Board of Appeal G 1/90, G 2/97, G 1/02 (Annex I).

SEPTIÈME PARTIE

Verweisungen / References / Références

DISPOSITIONS D'APPLICATION DE LA SEPTIÈME PARTIE DE LA CONVENTION

Chapitre I

Décisions et notifications de l'Office européen des brevets

*Règle 68*⁹⁹

Forme des décisions

Art. 91, 97, 102, 104, 111, 112

(1) Les décisions prises dans le cadre d'une procédure orale devant l'Office européen des brevets peuvent être prononcées à l'audience. Elles sont ensuite formulées par écrit et signifiées aux parties.

(2) Les décisions de l'Office européen des brevets contre lesquelles un recours est ouvert doivent être motivées et être accompagnées d'un avertissement selon lequel la décision en cause peut faire l'objet d'un recours. L'avertissement appelle également l'attention des parties sur les dispositions des articles 106 à 108 dont le texte est annexé. Les parties ne peuvent se prévaloir de l'omission de cet avertissement.

*Règle 69*¹⁰⁰

Constatation de la perte d'un droit

Art. 14, 77, 79, 86, 90, 91, 94, 96, 97, 99, 105, 110, 121, 122, 124, 135, 136, 157, 162
R. 90, 101, 108

(1) Si l'Office européen des brevets constate que la perte d'un droit, quel qu'il soit, découle de la convention sans qu'une décision de rejet de la demande de brevet européen, qu'une décision de délivrance, de révocation ou de maintien du brevet européen ou qu'une décision concernant une mesure d'instruction ait été prise, il le notifie à la personne intéressée, conformément aux dispositions de l'article 119.

(2) Si la personne intéressée estime que les conclusions de l'Office européen des brevets ne sont pas fondées, elle peut, dans un délai de deux mois à compter de la notification visée au paragraphe 1, requérir une décision en l'espèce de l'Office européen des brevets. Une telle décision n'est prise que dans le cas où l'Office européen des brevets ne partage pas le point de vue du requérant ; dans le cas contraire, l'Office européen des brevets en avise le requérant.

⁹⁹ Cf. la décision de la Grande Chambre de recours G 12/91 (Annexe I).

¹⁰⁰ Cf. le renseignement juridique n° 16/85 (Annexe II) et les décisions/avis de la Grande Chambre de recours G 1/90, G 2/97, G 1/02 (Annexe I).

Regel 70¹⁰¹

Unterschrift, Name, Dienstsiegel

(1) Entscheidungen, Bescheide und Mitteilungen des Europäischen Patentamts sind mit der Unterschrift und dem Namen des zuständigen Bediensteten zu versehen.

(2) Werden die in Absatz 1 genannten Schriftstücke von dem zuständigen Bediensteten mit Hilfe einer Datenverarbeitungsanlage erstellt, so kann die Unterschrift durch ein Dienstsiegel ersetzt werden. Werden diese Schriftstücke automatisch durch eine Datenverarbeitungsanlage erstellt, so kann auch die Namensangabe des zuständigen Bediensteten entfallen. Dies gilt auch für vorgedruckte Bescheide und Mitteilungen.

Kapitel II

Mündliche Verhandlung und Beweisaufnahme

Regel 71¹⁰²

Ladung zur mündlichen Verhandlung

(1)¹⁰³ Zur mündlichen Verhandlung nach Artikel 116 werden die Beteiligten unter Hinweis auf Absatz 2 geladen. Die Ladungsfrist beträgt mindestens zwei Monate, sofern die Beteiligten nicht mit einer kürzeren Frist einverstanden sind.

(2)¹⁰⁴ Ist ein zu einer mündlichen Verhandlung ordnungsgemäß geladener Beteiligter vor dem Europäischen Patentamt nicht erschienen, so kann das Verfahren ohne ihn fortgesetzt werden.

Regel 71a¹⁰⁵

Vorbereitung der mündlichen Verhandlung

(1)¹⁰⁶ Mit der Ladung weist das Europäische Patentamt auf die Fragen hin, die es für die zu treffende Entscheidung als erörterungsbedürftig ansieht. Gleichzeitig wird ein Zeitpunkt bestimmt, bis zu dem Schriftsätze zur Vorbereitung der mündlichen Verhandlung eingereicht werden können. Regel 84 ist nicht anzuwenden. Nach diesem Zeitpunkt vorgebrachte neue Tatsachen und Beweismittel brauchen nicht berücksichtigt zu werden, soweit sie nicht wegen einer Änderung des dem Verfahren zu Grunde liegenden Sachverhalts zuzulassen sind.

Rule 70¹⁰¹

Signature, name, seal

(1) Any decision, communication and notice from the European Patent Office is to be signed by and to state the name of the employee responsible.

(2) Where the documents mentioned in paragraph 1 are produced by the employee responsible using a computer, a seal may replace the signature. Where the documents are produced automatically by a computer the employee's name may also be dispensed with. The same applies to pre-printed notices and communications.

Chapter II

Oral proceedings and taking of evidence

Rule 71¹⁰²

Summons to oral proceedings

(1)¹⁰³ The parties shall be summoned to oral proceedings provided for in Article 116 and their attention shall be drawn to paragraph 2 of this Rule. At least two months' notice of the summons shall be given unless the parties agree to a shorter period.

(2)¹⁰⁴ If a party who has been duly summoned to oral proceedings before the European Patent Office does not appear as summoned, the proceedings may continue without him.

Rule 71a¹⁰⁵

Preparation of oral proceedings

(1)¹⁰⁶ When issuing the summons, the European Patent Office shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings shall be fixed. Rule 84 shall not apply. New facts and evidence presented after that date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed.

¹⁰¹ Geändert durch Beschluss des Verwaltungsrats vom 10.06.1988, in Kraft getreten am 01.10.1988 (ABI. EPA 1988, 290 ff.).

¹⁰² Siehe hierzu Entscheidung der Großen Beschwerdekammer G 6/95 (Anhang I).

¹⁰³ Geändert durch Beschluss des Verwaltungsrats vom 10.06.1988, in Kraft getreten am 01.10.1988 (ABI. EPA 1988, 290 ff.).

¹⁰⁴ Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 4/92 (Anhang I).

¹⁰⁵ Eingefügt durch Beschluss des Verwaltungsrats vom 13.12.1994, in Kraft getreten am 01.06.1995 (ABI. EPA 1995, 9 ff.).

¹⁰⁶ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 6/95 (Anhang I).

¹⁰¹ Amended by decision of the Administrative Council of 10.06.1988 which entered into force on 01.10.1988 (OJ EPO 1988, 290 ff.).

¹⁰² See decision of the Enlarged Board of Appeal G 6/95 (Annex I).

¹⁰³ Amended by decision of the Administrative Council of 10.06.1988 which entered into force on 01.10.1988 (OJ EPO 1988, 290 ff.).

¹⁰⁴ See opinion of the Enlarged Board of Appeal G 4/92 (Annex I).

¹⁰⁵ Inserted by decision of the Administrative Council of 13.12.1994 which entered into force on 01.06.1995 (OJ EPO 1995, 9 ff.).

¹⁰⁶ See decision of the Enlarged Board of Appeal G 6/95 (Annex I).

Règle 70¹⁰¹

Signature, nom, sceau

(1) Toute décision, notification et communication de l'Office européen des brevets doit être revêtue de la signature et de l'indication du nom de l'agent responsable.

(2) Si les documents mentionnés au paragraphe 1 sont produits par l'agent responsable à l'aide d'un ordinateur, un sceau peut remplacer la signature. Si ces documents sont produits automatiquement par ordinateur, il n'est pas non plus nécessaire d'indiquer le nom de l'agent responsable. Ceci vaut également pour des notifications et communications préimprimées.

Chapitre II

Procédure orale et instruction

Règle 71¹⁰²

Citation à une procédure orale

(1)¹⁰³ La citation des parties à une procédure orale conformément à l'article 116 fait mention de la disposition figurant au paragraphe 2 de la présente règle. Elle comporte un délai minimum de deux mois à moins que les parties ne conviennent d'un délai plus bref.

(2)¹⁰⁴ Si une partie régulièrement citée devant l'Office européen des brevets à une procédure orale n'a pas comparu, la procédure peut être poursuivie en son absence.

Règle 71bis¹⁰⁵

Préparation de la procédure orale

(1)¹⁰⁶ Dans la citation, l'Office européen des brevets signale les questions qu'il juge nécessaire d'examiner aux fins de la décision à rendre. En même temps il fixe une date jusqu'à laquelle des documents peuvent être produits en vue de la préparation de la procédure orale. La règle 84 n'est pas applicable. De nouveaux faits ou preuves présentés après cette date peuvent ne pas être pris en considération, à moins qu'il ne convienne de les admettre en raison d'un changement intervenu dans les faits de la cause.

Verweisungen / References / Références

Art. 90, 91, 96, 97, 101, 102, 110, 115, 124, 128, 162

Art. 114, 116

¹⁰¹ Modifiée par décision du Conseil d'administration en date du 10.06.1988, entrée en vigueur le 01.10.1988 (JO OEB 1988, 290 s.).

¹⁰² Cf. la décision de la Grande Chambre de recours G 6/95 (Annexe I).

¹⁰³ Modifié par décision du Conseil d'administration en date du 10.06.1988, entrée en vigueur le 01.10.1988 (JO OEB 1988, 290 s.).

¹⁰⁴ Cf. l'avis de la Grande Chambre de recours G 4/92 (Annexe I).

¹⁰⁵ Insérée par décision du Conseil d'administration en date du 13.12.1994, entrée en vigueur le 01.06.1995 (JO OEB 1995, 9 s.).

¹⁰⁶ Cf. la décision de la Grande Chambre de recours G 6/95 (Annexe I).

(2) Sind dem Anmelder oder Patentinhaber die Gründe mitgeteilt worden, die der Erteilung oder Aufrechterhaltung des Patents entgegenstehen, so kann er aufgefördert werden, bis zu dem in Absatz 1 Satz 2 genannten Zeitpunkt Unterlagen einzureichen, die den Erfordernissen des Übereinkommens genügen. Absatz 1 Sätze 3 und 4 sind entsprechend anzuwenden.

Regel 72

Beweisaufnahme durch das Europäische Patentamt

(1) Hält das Europäische Patentamt die Vernehmung von Beteiligten, Zeugen oder Sachverständigen oder eine Augenscheinseinnahme für erforderlich, so erlässt es eine entsprechende Entscheidung, in der das betreffende Beweismittel, die rechtserheblichen Tatsachen sowie Tag, Uhrzeit und Ort angegeben werden. Hat ein Beteiligter die Vernehmung von Zeugen oder Sachverständigen beantragt, so wird in der Entscheidung des Europäischen Patentamts die Frist festgesetzt, in der der antragstellende Beteiligte dem Europäischen Patentamt Name und Anschrift der Zeugen und Sachverständigen mitteilen muss, die er vernehmen zu lassen wünscht.

(2)¹⁰⁷ Die Frist zur Ladung von Beteiligten, Zeugen und Sachverständigen zur Beweisaufnahme beträgt mindestens zwei Monate, sofern diese nicht mit einer kürzeren Frist einverstanden sind. Die Ladung muss enthalten:

a) einen Auszug aus der in Absatz 1 genannten Entscheidung, aus der insbesondere Tag, Uhrzeit und Ort der angeordneten Beweisaufnahme sowie die Tatsachen hervorgehen, über die die Beteiligten, Zeugen und Sachverständigen vernommen werden sollen;

b) die Namen der am Verfahren Beteiligten sowie die Ansprüche, die den Zeugen und Sachverständigen nach Regel 74 Absätze 2 bis 4 zustehen;

c) einen Hinweis darauf, dass der Beteiligte, Zeuge oder Sachverständige seine Vernehmung durch das zuständige Gericht seines Wohnsitzstaats verlangen kann, sowie eine Aufforderung, dem Europäischen Patentamt innerhalb einer von diesem festgesetzten Frist mitzuteilen, ob er bereit ist, vor dem Europäischen Patentamt zu erscheinen.

(3) Beteiligte, Zeugen und Sachverständige werden vor ihrer Vernehmung darauf hingewiesen, dass das Europäische Patentamt das zuständige Gericht in ihrem Wohnsitzstaat um Wiederholung der Vernehmung unter Eid oder in gleichermaßen verbindlicher Form ersuchen kann.

(4) Die Beteiligten können an der Beweisaufnahme teilnehmen und sachdienliche Fragen an die vernommenen Beteiligten, Zeugen und Sachverständigen richten.

(2) If the applicant or patent proprietor has been notified of the grounds prejudicing the grant or maintenance of the patent, he may be invited to submit, by the date specified in paragraph 1, second sentence, documents which meet the requirements of the Convention. Paragraph 1, third and fourth sentences, shall apply mutatis mutandis.

Rule 72

Taking of evidence by the European Patent Office

(1) Where the European Patent Office considers it necessary to hear the oral evidence of parties, witnesses or experts or to carry out an inspection, it shall make a decision to this end, setting out the investigation which it intends to carry out, relevant facts to be proved and the date, time and place of the investigation. If oral evidence of witnesses and experts is requested by a party, the decision of the European Patent Office shall determine the period of time within which the party filing the request must make known to the European Patent Office the names and addresses of the witnesses and experts whom it wishes to be heard.

(2)¹⁰⁷ At least two months' notice of a summons issued to a party, witness or expert to give evidence shall be given unless they agree to a shorter period. The summons shall contain:

(a) an extract from the decision mentioned in paragraph 1, indicating in particular the date, time and place of the investigation ordered and stating the facts regarding which parties, witnesses and experts are to be heard;

(b) the names of the parties to the proceedings and particulars of the rights which the witnesses or experts may invoke under the provisions of Rule 74, paragraphs 2 to 4;

(c) an indication that the party, witness or expert may request to be heard by the competent court of his country of residence and a requirement that he inform the European Patent Office within a time limit to be fixed by the Office whether he is prepared to appear before it.

(3) Before a party, witness or expert may be heard, he shall be informed that the European Patent Office may request the competent court in the country of residence of the person concerned to re-examine his evidence on oath or in an equally binding form.

(4) The parties may attend an investigation and may put relevant questions to the testifying parties, witnesses and experts.

¹⁰⁷ Geändert durch Beschluss des Verwaltungsrats vom 10.06.1988, in Kraft getreten am 01.10.1988 (ABI. EPA 1988, 290 ff.).

¹⁰⁷ Amended by decision of the Administrative Council of 10.06.1988 which entered into force on 01.10.1988 (OJ EPO 1988, 290 ff.).

(2) Si le demandeur ou le titulaire du brevet a reçu communication des motifs s'opposant à la délivrance ou au maintien du brevet, il peut être invité à fournir au plus tard à la date visée au paragraphe 1, deuxième phrase, des pièces satisfaisant aux conditions requises par la convention. Le paragraphe 1, troisième et quatrième phrases, est applicable.

Verweisungen / References / Références

Règle 72

Instruction par l'Office européen des brevets

Art. 117, 131

(1) Lorsque l'Office européen des brevets estime nécessaire d'entendre des parties, des témoins ou des experts ou de procéder à la descente sur les lieux, il rend à cet effet une décision qui énonce la mesure d'instruction envisagée, les faits pertinents à prouver, les jour, heure et lieu où il sera procédé à ladite mesure d'instruction. Si l'audition de témoins ou d'experts a été demandée par une partie, la décision de l'Office européen des brevets fixe le délai dans lequel la partie requérante doit déclarer à cet Office les noms et adresses des témoins et experts qu'elle désire faire entendre.

(2)¹⁰⁷ La citation des parties, des témoins ou des experts doit comporter un délai minimum de deux mois, à moins que les intéressés ne conviennent d'un délai plus bref. La citation doit contenir :

a) un extrait de la décision mentionnée au paragraphe 1, précisant notamment les jour, heure et lieu où il sera procédé à la mesure d'instruction ordonnée ainsi que les faits sur lesquels les parties, témoins et experts seront entendus ;

b) la désignation des parties à la procédure et l'indication des droits auxquels les témoins et experts peuvent prétendre en vertu des dispositions de la règle 74, paragraphes 2 à 4 ;

c) une indication selon laquelle toute partie, tout témoin ou tout expert peut demander à être entendu par les autorités judiciaires compétentes de l'Etat sur le territoire duquel il réside et une invitation à faire savoir à l'Office européen des brevets, dans le délai qui lui a été imparti par cet Office, s'il est disposé à comparaître devant ledit Office.

(3) Avant que la partie, le témoin ou l'expert ne soit entendu, il est averti que l'Office européen des brevets peut demander aux autorités judiciaires compétentes de l'Etat sur le territoire duquel il réside de l'entendre à nouveau sous la foi du serment ou sous une autre forme également contraignante.

(4) Les parties peuvent assister à l'instruction et poser toute question pertinente aux parties, témoins et experts entendus.

¹⁰⁷ Modifié par décision du Conseil d'administration en date du 10.06.1988, entrée en vigueur le 01.10.1988 (JO OEB 1988, 290 s.).

Regel 73

Beauftragung von Sachverständigen

- (1) Das Europäische Patentamt entscheidet, in welcher Form das Gutachten des von ihm beauftragten Sachverständigen zu erstatten ist.
- (2) Der Auftrag an den Sachverständigen muss enthalten:
 - a) die genaue Umschreibung des Auftrags;
 - b) die Frist für die Erstattung des Gutachtens;
 - c) die Bezeichnung der am Verfahren Beteiligten;
 - d) einen Hinweis auf die Rechte, die ihm nach Regel 74 Absätze 2 bis 4 zustehen.
- (3) Die Beteiligten erhalten eine Abschrift des schriftlichen Gutachtens.
- (4) Die Beteiligten können den Sachverständigen ablehnen. Über die Ablehnung entscheidet das Organ des Europäischen Patentamts, das für die Beauftragung des Sachverständigen zuständig ist.

Regel 74

Kosten der Beweisaufnahme

- (1) Das Europäische Patentamt kann die Beweisaufnahme davon abhängig machen, dass der Beteiligte, der sie beantragt hat, beim Europäischen Patentamt einen Vorschuss hinterlegt, dessen Höhe im Wege einer Schätzung der voraussichtlichen Kosten bestimmt wird.
- (2) Zeugen und Sachverständige, die vom Europäischen Patentamt geladen worden sind und vor diesem erscheinen, haben Anspruch auf Erstattung angemessener Reise- und Aufenthaltskosten. Es kann ihnen ein Vorschuss auf diese Kosten gewährt werden. Satz 1 ist auch auf Zeugen und Sachverständige anzuwenden, die ohne Ladung vor dem Europäischen Patentamt erscheinen und als Zeugen oder Sachverständige vernommen werden.
- (3) Zeugen, denen nach Absatz 2 ein Erstattungsanspruch zusteht, haben Anspruch auf eine angemessene Entschädigung für Verdienstausschlag; Sachverständige haben Anspruch auf Vergütung ihrer Tätigkeit. Diese Entschädigung oder Vergütung wird den Zeugen und Sachverständigen gezahlt, nachdem sie ihrer Pflicht oder ihrem Auftrag genügt haben.
- (4)¹⁰⁸ Der Verwaltungsrat legt die Einzelheiten der Anwendung der Absätze 2 und 3 fest. Das Europäische Patentamt zahlt die nach den Absätzen 2 und 3 fälligen Beträge aus.

Rule 73

Commissioning of experts

- (1) The European Patent Office shall decide in what form the report made by an expert whom it appoints shall be submitted.
- (2) The terms of reference of the expert shall include:
 - (a) a precise description of his task;
 - (b) the time limit laid down for the submission of the expert report;
 - (c) the names of the parties to the proceedings;
 - (d) particulars of the rights which he may invoke under the provisions of Rule 74, paragraphs 2 to 4.
- (3) A copy of any written report shall be submitted to the parties.
- (4) The parties may object to an expert. The department of the European Patent Office concerned shall decide on the objection.

Rule 74

Costs of taking of evidence

- (1) The taking of evidence by the European Patent Office may be made conditional upon deposit with it, by the party who requested the evidence to be taken, of a sum the amount of which shall be fixed by reference to an estimate of the costs.
- (2) Witnesses and experts who are summoned by and appear before the European Patent Office shall be entitled to appropriate reimbursement of expenses for travel and subsistence. An advance for these expenses may be granted to them. The first sentence shall apply to witnesses and experts who appear before the European Patent Office without being summoned by it and are heard as witnesses or experts.
- (3) Witnesses entitled to reimbursement under paragraph 2 shall also be entitled to appropriate compensation for loss of earnings, and experts to fees for their work. These payments shall be made to the witnesses and experts after they have fulfilled their duties or tasks.
- (4)¹⁰⁸ The Administrative Council shall lay down the details governing the implementation of the provisions of paragraphs 2 and 3. Payment of amounts due pursuant to these paragraphs shall be made by the European Patent Office.

¹⁰⁸ Siehe hierzu die Verordnung des Verwaltungsrats vom 21.10.1977 über Entschädigungen und Vergütungen für Zeugen und Sachverständige (ABI. EPA 1983, 102 f.).

¹⁰⁸ See the Regulation of the Administrative Council of 21.10.1977 on compensation and fees payable to witnesses and experts (OJ EPO 1983, 102 f.).

Règle 73

Commission d'experts

(1) L'Office européen des brevets décide de la forme dans laquelle sont soumis les rapports des experts qu'il désigne.

(2) Le mandat de l'expert doit contenir :

- a) une description précise de sa mission ;
- b) le délai qui lui est imparti pour la présentation du rapport d'expertise ;
- c) la désignation des parties à la procédure ;
- d) l'indication des droits auxquels il peut prétendre en vertu des dispositions de la règle 74, paragraphes 2 à 4.

(3) Une copie du rapport écrit est remise aux parties.

(4) Les parties peuvent faire valoir des moyens de récusation à l'égard des experts. L'instance concernée de l'Office européen des brevets statue sur la récusation.

Règle 74

Frais de l'instruction

(1) L'Office européen des brevets peut subordonner l'exécution de l'instruction au dépôt auprès dudit Office, par la partie qui a demandé cette instruction, d'une provision dont il fixe le montant par référence à une estimation des frais.

(2) Les témoins et les experts qui ont été cités par l'Office européen des brevets et comparaissent devant lui ont droit à un remboursement adéquat de leurs frais de déplacement et de séjour. Une avance peut leur être accordée sur ces frais. La première phrase du présent paragraphe est applicable aux témoins et aux experts qui comparaissent devant l'Office européen des brevets sans qu'il les ait cités et sont entendus comme tels.

(3) Les témoins qui ont droit à un remboursement en application du paragraphe 2 ont en outre droit à une indemnité adéquate pour manque à gagner; les experts ont droit à des honoraires pour la rémunération de leurs travaux. Ces indemnités ou honoraires sont payés aux témoins ou experts après l'accomplissement de leurs devoirs ou de leur mission.

(4)¹⁰⁸ Le Conseil d'administration détermine les modalités d'application des dispositions des paragraphes 2 et 3. Le paiement des sommes dues en vertu desdits paragraphes est effectué par l'Office européen des brevets.

Verweisungen / References / Références

Art. 117

Art. 117
R. 72, 73

¹⁰⁸ Cf. le Règlement du Conseil d'administration en date du 21.10.1977 relatif aux indemnités et honoraires alloués aux témoins et experts (JO OEB 1983, 102 s.).

Regel 75

Beweissicherung

(1) Das Europäische Patentamt kann auf Antrag zur Sicherung eines Beweises unverzüglich eine Beweisaufnahme über Tatsachen vornehmen, die für eine Entscheidung von Bedeutung sein können, die das Europäische Patentamt hinsichtlich einer europäischen Patentanmeldung oder eines europäischen Patents wahrscheinlich zu treffen hat, wenn zu besorgen ist, dass die Beweisaufnahme zu einem späteren Zeitpunkt erschwert oder unmöglich sein wird. Der Zeitpunkt der Beweisaufnahme ist dem Anmelder oder Patentinhaber so rechtzeitig mitzuteilen, dass er daran teilnehmen kann. Er kann sachdienliche Fragen stellen.

(2) Der Antrag muss enthalten:

a) den Namen, die Anschrift und den Staat des Wohnsitzes oder Sitzes des Antragstellers nach Maßgabe der Regel 26 Absatz 2 Buchstabe c;

b) eine ausreichende Bezeichnung der europäischen Patentanmeldung oder des europäischen Patents;

c) die Bezeichnung der Tatsachen, über die Beweis erhoben werden soll;

d) die Bezeichnung der Beweismittel;

e) die Darlegung und die Glaubhaftmachung des Grunds, der die Besorgnis rechtfertigt, dass die Beweisaufnahme zu einem späteren Zeitpunkt erschwert oder unmöglich sein wird.

(3) Der Antrag gilt erst als gestellt, wenn die Beweissicherungsgebühr entrichtet worden ist.

(4) Für die Entscheidung über den Antrag und für eine daraufhin erfolgende Beweisaufnahme ist das Organ des Europäischen Patentamts zuständig, das die Entscheidung zu treffen hatte, für die die zu beweisenden Tatsachen von Bedeutung sein können. Die Vorschriften des Übereinkommens über die Beweisaufnahme in den Verfahren vor dem Europäischen Patentamt sind entsprechend anzuwenden.

Regel 76

Niederschrift über mündliche Verhandlungen und Beweisaufnahmen

(1) Über eine mündliche Verhandlung oder Beweisaufnahme wird eine Niederschrift aufgenommen, die den wesentlichen Gang der mündlichen Verhandlung oder Beweisaufnahme, die rechtserheblichen Erklärungen der Beteiligten und die Aussagen der Beteiligten, Zeugen oder Sachverständigen sowie das Ergebnis eines Augenscheins enthalten soll.

Rule 75

Conservation of evidence

(1) On request, the European Patent Office may, without delay, hear oral evidence or conduct inspections, with a view to conserving evidence of facts liable to affect a decision which it may be called upon to take with regard to an existing European patent application or a European patent, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence. The date on which the measures are to be taken shall be communicated to the applicant for or proprietor of the patent in sufficient time to allow him to attend. He may ask relevant questions.

(2) The request shall contain:

(a) the name and address of the person filing the request and the State in which his residence or principal place of business is located, in accordance with the provisions of Rule 26, paragraph 2(c);

(b) sufficient identification of the European patent application or European patent in question;

(c) the designation of the facts in respect of which evidence is to be taken;

(d) particulars of the way in which evidence is to be taken;

(e) a statement establishing a prima facie case for fearing that it might subsequently become more difficult or impossible to take evidence.

(3) The request shall not be deemed to have been filed until the fee for conservation of evidence has been paid.

(4) The decision on the request and any resulting taking of evidence shall be incumbent upon the department of the European Patent Office required to take the decision liable to be affected by the facts to be established. The provisions of the Convention with regard to the taking of evidence in proceedings before the European Patent Office shall be applicable.

Rule 76

Minutes of oral proceedings and of taking of evidence

(1) Minutes of oral proceedings and of the taking of evidence shall be drawn up containing the essentials of the oral proceedings or of the taking of evidence, the relevant statements made by the parties, the testimony of the parties, witnesses or experts and the result of any inspection.

Règle 75

Conservation de la preuve

Verweisungen / References / Références

Art. 117

(1) L'Office européen des brevets peut, sur requête, procéder sans délai à une mesure d'instruction, en vue de conserver la preuve de faits qui peuvent affecter une décision qu'il sera vraisemblablement appelé à prendre au sujet d'une demande de brevet européen ou d'un brevet européen, lorsqu'il y a lieu d'appréhender que l'instruction ne devienne ultérieurement plus difficile ou même impossible. La date de la mesure d'instruction doit être notifiée au demandeur ou au titulaire du brevet en temps utile pour lui permettre de participer à l'instruction. Il peut poser toutes questions pertinentes.

(2) La requête doit contenir :

a) l'indication du nom, de l'adresse et de l'Etat du domicile ou du siège du requérant, dans les conditions prévues à la règle 26, paragraphe 2, lettre c) ;

b) des indications suffisantes pour permettre l'identification de la demande de brevet européen ou du brevet européen en cause ;

c) l'indication des faits qui nécessitent la mesure d'instruction ;

d) l'indication de la mesure d'instruction ;

e) un exposé du motif justifiant la présomption selon laquelle l'instruction pourra être ultérieurement plus difficile ou même impossible.

(3) La requête n'est réputée présentée qu'après paiement de la taxe de conservation de la preuve.

(4) La décision sur la requête ainsi que toute mesure d'instruction sont prises par l'instance de l'Office européen des brevets qui aurait été appelée à prendre la décision pouvant être affectée par les faits dont la preuve doit être apportée. Les dispositions de la convention relatives à l'instruction dans les procédures devant l'Office européen des brevets sont applicables.

Règle 76

Procès-verbal des procédures orales et des instructions

Art. 116, 117

(1) Les procédures orales et les instructions donnent lieu à l'établissement d'un procès-verbal contenant l'essentiel de la procédure orale ou de l'instruction, les déclarations pertinentes des parties et les dépositions des parties, des témoins ou des experts ainsi que le résultat de la descente sur les lieux.

(2) Die Niederschrift über die Aussage eines Zeugen, Sachverständigen oder Beteiligten wird diesem vorgelesen oder zur Durchsicht vorgelegt. In der Niederschrift wird vermerkt, dass dies geschehen und die Niederschrift von der Person genehmigt ist, die ausgesagt hat. Wird die Niederschrift nicht genehmigt, so werden die Einwendungen vermerkt.

(3)¹⁰⁹ Die Niederschrift wird von dem Bediensteten, der sie aufnimmt, und dem Bediensteten, der die mündliche Verhandlung oder Beweisaufnahme leitet, durch ihre Unterschrift oder andere geeignete Mittel als authentisch bestätigt.

(4) Die Beteiligten erhalten eine Abschrift der Niederschrift.

Kapitel III
Zustellungen
Regel 77

Allgemeine Vorschriften über Zustellungen

(1)¹¹⁰ In den Verfahren vor dem Europäischen Patentamt wird entweder das Originalschriftstück, eine vom Europäischen Patentamt beglaubigte oder mit Dienstsiegel versehene Abschrift dieses Schriftstücks oder ein mit Dienstsiegel versehener Computerausdruck zugestellt. Abschriften von Schriftstücken, die von Beteiligten eingereicht werden, bedürfen keiner solchen Beglaubigung.

(2)¹¹¹ Die Zustellung wird bewirkt:

- a) durch die Post gemäß Regel 78;
- b) durch Übergabe im Europäischen Patentamt gemäß Regel 79;
- c) durch öffentliche Bekanntmachung gemäß Regel 80;
- d) durch technische Einrichtungen zur Nachrichtenübermittlung, die der Präsident des Europäischen Patentamts unter Festlegung der Bedingungen für ihre Benutzung bestimmt.

(3) Die Zustellung durch Vermittlung der Zentralbehörde für den gewerblichen Rechtsschutz eines Vertragsstaats erfolgt nach den Vorschriften, die von dieser Behörde in nationalen Verfahren anzuwenden sind.

(2) The minutes of the testimony of a witness, expert or party shall be read out or submitted to him so that he may examine them. It shall be noted in the minutes that this formality has been carried out and that the person who gave the testimony approved the minutes. If his approval is not given, his objections shall be noted.

(3)¹⁰⁹ The minutes shall be authenticated by the employee who drew them up and by the employee who conducted the oral proceedings or taking of evidence, either by their signature or by any other appropriate means.

(4) The parties shall be provided with a copy of the minutes.

Chapter III
Notifications
Rule 77

General provisions on notifications

(1)¹¹⁰ In proceedings before the European Patent Office, any notification to be made shall take the form either of the original document, a copy thereof certified by, or bearing the seal of, the European Patent Office or a computer print-out bearing such seal. Copies of documents emanating from the parties themselves shall not require such certification.

(2)¹¹¹ Notification shall be made:

- (a) by post in accordance with Rule 78;
- (b) by delivery on the premises of the European Patent Office in accordance with Rule 79;
- (c) by public notice in accordance with Rule 80, or
- (d) by such technical means of communication as determined by the President of the European Patent Office and under the conditions laid down by him governing their use.

(3) Notification through the central industrial property office of a Contracting State shall be made in accordance with the provisions applicable to the said office in national proceedings.

¹⁰⁹ Geändert durch Beschluss des Verwaltungsrats vom 10.12.1998, in Kraft getreten am 01.01.1999 (ABI. EPA 1999, 1 ff.).

¹¹⁰ Geändert durch Beschluss des Verwaltungsrats vom 10.06.1988, in Kraft getreten am 01.10.1988 (ABI. EPA 1988, 290 ff.).

¹¹¹ Geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.).

¹⁰⁹ Amended by decision of the Administrative Council of 10.12.1998 which entered into force on 01.01.1999 (OJ EPO 1999, 1 ff.).

¹¹⁰ Amended by decision of the Administrative Council of 10.06.1988 which entered into force on 01.10.1988 (OJ EPO 1988, 290 ff.).

¹¹¹ Amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff.).

(2) Le procès-verbal de la déposition d'un témoin, d'un expert ou d'une partie lui est lu ou lui est soumis pour qu'il en prenne connaissance. Mention est portée au procès-verbal que cette formalité a été accomplie et que le procès-verbal a été approuvé par l'auteur de la déposition. Lorsque le procès-verbal n'est pas approuvé, les objections formulées sont mentionnées.

Verweisungen / References / Références

(3)¹⁰⁹ Le procès-verbal est authentifié par l'agent qui l'a établi et par l'agent qui a dirigé la procédure orale ou l'instruction, soit par leur signature, soit par tout autre moyen approprié.

(4) Une copie du procès-verbal est remise aux parties.

Chapitre III

Significations

Règle 77

Dispositions générales sur les significations

Art. 119

(1)¹¹⁰ Les significations prévues dans les procédures devant l'Office européen des brevets portent soit sur l'original de la pièce, soit sur une copie de cette pièce certifiée conforme ou portant le sceau de l'Office européen des brevets, soit sur un imprimé établi par ordinateur et portant un tel sceau. Les copies de pièces produites par les parties elles-mêmes ne requièrent pas une telle certification.

(2)¹¹¹ La signification directe est faite, soit :

- a) par la poste conformément à la règle 78 ;
- b) par remise dans les locaux de l'Office européen des brevets conformément à la règle 79 ;
- c) par publication conformément à la règle 80 ;
- d) par des moyens techniques de communication que détermine le Président de l'Office européen des brevets et dont il arrête les conditions d'utilisation.

(3) La signification par l'intermédiaire du service central de la propriété industrielle d'un Etat contractant est faite conformément aux dispositions applicables audit service dans les procédures nationales.

¹⁰⁹ Modifié par décision du Conseil d'administration en date du 10.12.1998, entrée en vigueur le 01.01.1999 (JO OEB 1999, 1 s.).

¹¹⁰ Modifié par décision du Conseil d'administration en date du 10.06.1988, entrée en vigueur le 01.10.1988 (JO OEB 1988, 290 s.).

¹¹¹ Modifié par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.).

Regel 78^{112/113}

Zustellung durch die Post

(1) Entscheidungen, durch die eine Beschwerdefrist in Lauf gesetzt wird, Ladungen und andere vom Präsidenten des Europäischen Patentamts bestimmte Schriftstücke werden durch eingeschriebenen Brief mit Rückschein zugestellt. Alle anderen Zustellungen durch die Post erfolgen mittels eingeschriebenen Briefs.

(2) Bei der Zustellung mittels eingeschriebenen Briefs mit oder ohne Rückschein gilt dieser mit dem zehnten Tag nach der Abgabe zur Post als zugestellt, es sei denn, dass das zuzustellende Schriftstück nicht oder an einem späteren Tag zugegangen ist; im Zweifel hat das Europäische Patentamt den Zugang des Schriftstücks und gegebenenfalls den Tag des Zugangs nachzuweisen.

(3) Die Zustellung mittels eingeschriebenen Briefs mit oder ohne Rückschein gilt auch dann als bewirkt, wenn die Annahme des Briefs verweigert wird.

(4) Soweit die Zustellung durch die Post durch die Absätze 1 bis 3 nicht geregelt ist, ist das Recht des Staats anzuwenden, in dessen Hoheitsgebiet die Zustellung erfolgt.

Regel 79

Zustellung durch unmittelbare Übergabe

Die Zustellung kann in den Dienstgebäuden des Europäischen Patentamts durch unmittelbare Übergabe des Schriftstücks an den Empfänger bewirkt werden, der dabei den Empfang zu bescheinigen hat. Die Zustellung gilt auch dann als bewirkt, wenn der Empfänger die Annahme des Schriftstücks oder die Bescheinigung des Empfangs verweigert.

Regel 80

Öffentliche Zustellung

(1)¹¹⁴ Kann der Aufenthaltsort des Empfängers nicht festgestellt werden oder war die Zustellung nach Regel 78 Absatz 1 auch nach einem zweiten Versuch des Europäischen Patentamts unmöglich, so wird durch öffentliche Bekanntmachung zugestellt.

Rule 78^{112/113}

Notification by post

(1) Decisions incurring a time limit for appeal, summonses and other documents as decided on by the President of the European Patent Office shall be notified by registered letter with advice of delivery. All other notifications by post shall be by registered letter.

(2) Where notification is effected by registered letter, whether or not with advice of delivery, this shall be deemed to be delivered to the addressee on the tenth day following its posting, unless the letter has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it shall be incumbent on the European Patent Office to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be.

(3) Notification by registered letter, whether or not with advice of delivery, shall be deemed to have been effected even if acceptance of the letter has been refused.

(4) To the extent that notification by post is not covered by paragraphs 1 to 3, the law of the State on the territory of which the notification is made shall apply.

Rule 79

Notification by delivery by hand

Notification may be effected on the premises of the European Patent Office by delivery by hand of the document to the addressee, who shall on delivery acknowledge its receipt. Notification shall be deemed to have taken place even if the addressee refuses to accept the document or to acknowledge receipt thereof.

Rule 80

Public notification

(1)¹¹⁴ If the address of the addressee cannot be established, or if notification in accordance with Rule 78, paragraph 1, has proved to be impossible even after a second attempt by the European Patent Office, notification shall be effected by public notice.

¹¹² Geändert durch Beschluss des Verwaltungsrats vom 10.12.1998, in Kraft getreten am 01.01.1999 (ABI. EPA 1999, 1 ff.).

¹¹³ Siehe hierzu Mitteilung des Präsidenten des EPA vom 23.10.1980 über die Verwendung von Zustellanschriften durch Anmelder ohne Vertreter (ABI. EPA 1980, 397 f.).

¹¹⁴ Geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 01.06.1991 (ABI. EPA 1991, 4 ff.).

¹¹² Amended by decision of the Administrative Council of 10.12.1998 which entered into force on 01.01.1999 (OJ EPO 1999, 1 ff.).

¹¹³ See announcement by the President of the EPO of 23.10.1980 concerning the use of an address for correspondence by applicants acting without a representative (OJ EPO 1980, 397 ff.).

¹¹⁴ Amended by decision of the Administrative Council of 07.12.1990 which entered into force on 01.06.1991 (OJ EPO 1991, 4 ff.).

Règle 78^{112/113}

Signification par la poste

Verweisungen / References / Références

Art. 119

(1) Les décisions qui font courir un délai de recours, les citations et toutes autres pièces pour lesquelles le Président de l'Office européen des brevets prescrit qu'il sera fait usage de ce mode de signification sont signifiées par lettre recommandée avec demande d'avis de réception. Les autres significations par la poste sont faites par lettre recommandée.

(2) Lorsque la signification est faite par lettre recommandée avec ou sans demande d'avis de réception, celle-ci est réputée remise à son destinataire le dixième jour après la remise à la poste, à moins que la pièce à signifier ne lui soit pas parvenue ou ne lui soit parvenue qu'à une date ultérieure ; en cas de contestation, il incombe à l'Office européen des brevets d'établir que la lettre est parvenue à destination ou d'établir, le cas échéant, la date de sa remise au destinataire.

(3) La signification par lettre recommandée avec ou sans demande d'avis de réception est réputée faite même si la lettre a été refusée.

(4) Pour autant que la signification par la poste n'est pas entièrement réglée par les paragraphes 1 à 3, le droit applicable en matière de signification par la poste est celui de l'Etat sur le territoire duquel la signification est faite.

Règle 79

Signification par remise directe

Art. 119

La signification peut être effectuée dans les locaux de l'Office européen des brevets par remise directe de la pièce à signifier au destinataire qui en accuse réception. La signification est réputée faite même si le destinataire refuse d'accepter la pièce à signifier ou d'en accuser réception.

Règle 80

Signification publique

Art. 119

(1)¹¹⁴ S'il n'est pas possible de connaître l'adresse du destinataire ou si la signification prévue à la règle 78, paragraphe 1 s'est révélée impossible même après une seconde tentative de la part de l'Office européen des brevets, la signification est faite sous forme de publication.

¹¹² Modifiée par décision du Conseil d'administration en date du 10.12.1998, entrée en vigueur le 01.01.1999 (JO OEB 1999, 1 s.).

¹¹³ Cf. la communication du Président de l'OEB du 23.10.1980 relative à l'utilisation par les demandeurs non représentés par des mandataires d'une adresse pour la correspondance (JO OEB 1980, 397 s.).

¹¹⁴ Modifié par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 01.06.1991 (JO OEB 1991, 4 s.).

(2)¹¹⁵ Der Präsident des Europäischen Patentamts bestimmt, in welcher Weise die öffentliche Bekanntmachung erfolgt und wann die Frist von einem Monat zu laufen beginnt, nach deren Ablauf das Schriftstück als zugestellt gilt.

Regel 81

Zustellung an Vertreter

- (1) Ist ein Vertreter bestellt worden, so werden die Zustellungen an den Vertreter gerichtet.
- (2) Sind mehrere Vertreter für einen Beteiligten bestellt, so genügt die Zustellung an einen von ihnen.
- (3) Haben mehrere Beteiligte einen gemeinsamen Vertreter, so genügt die Zustellung nur eines Schriftstücks an den gemeinsamen Vertreter.

Regel 82

Heilung von Zustellungsmängeln

Kann das Europäische Patentamt die formgerechte Zustellung eines Schriftstücks nicht nachweisen oder ist das Schriftstück unter Verletzung von Zustellungs Vorschriften zugegangen, so gilt das Schriftstück als an dem Tag zugestellt, den das Europäische Patentamt als Tag des Zugangs nachweist.

Kapitel IV

Fristen

Regel 83

Berechnung der Fristen

- (1) Die Fristen werden nach vollen Tagen, Wochen, Monaten oder Jahren berechnet.
- (2) Bei der Fristberechnung wird mit dem Tag begonnen, der auf den Tag folgt, an dem das Ereignis eingetreten ist, auf Grund dessen der Fristbeginn festgelegt wird; dieses Ereignis kann eine Handlung oder der Ablauf einer früheren Frist sein. Besteht die Handlung in einer Zustellung, so ist das maßgebliche Ereignis der Zugang des zugestellten Schriftstücks, sofern nichts anderes bestimmt ist.
- (3) Ist als Frist ein Jahr oder eine Anzahl von Jahren bestimmt, so endet die Frist in dem maßgeblichen folgenden Jahr in dem Monat und an dem Tag, die durch ihre Benennung oder Zahl dem Monat und Tag entsprechen, an denen das Ereignis eingetreten ist; hat der betreffende nachfolgende Monat keinen Tag mit der entsprechenden Zahl, so läuft die Frist am letzten Tag dieses Monats ab.

¹¹⁵ Siehe Mitteilung des Präsidenten des EPA vom 11.01.1980 über die öffentliche Zustellung nach Regel 80 EPÜ (ABl. EPA 1980, 36).

(2)¹¹⁵ The President of the European Patent Office shall determine how the public notice is to be given and the beginning of the period of one month on the expiry of which the document shall be deemed to have been notified.

Rule 81

Notification to representatives

- (1) If a representative has been appointed, notifications shall be addressed to him.
- (2) If several such representatives have been appointed for a single interested party, notification to any one of them shall be sufficient.
- (3) If several interested parties have a common representative, notification of a single document to the common representative shall be sufficient.

Rule 82

Irregularities in the notification

Where a document has reached the addressee, if the European Patent Office is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document shall be deemed to have been notified on the date established by the European Patent Office as the date of receipt.

Chapter IV

Time limits

Rule 83

Calculation of time limits

- (1) Periods shall be laid down in terms of full years, months, weeks or days.
- (2) Computation shall start on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another period. Where the procedural step is a notification, the event considered shall be the receipt of the document notified, unless otherwise provided.
- (3) When a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

¹¹⁵ See announcement by the President of the EPO of 11.01.1980 concerning public notification under Rule 80 EPC (OJ EPO 1980, 36).

(2)¹¹⁵ Le Président de l'Office européen des brevets détermine les modalités de la publication ainsi que le point de départ du délai d'un mois à l'expiration duquel le document est réputé significatif.

Verweisungen / References / Références

Règle 81

Signification au mandataire ou au représentant

Art. 119

- (1) Si un mandataire a été désigné, les significations lui sont faites.
- (2) Si plusieurs mandataires ont été désignés pour une seule partie, il suffit que la signification soit faite à l'un d'entre eux.
- (3) Si plusieurs parties ont un représentant commun, il suffit que la signification d'une pièce en un seul exemplaire soit faite au représentant commun.

Règle 82

Vices de la signification

Art. 119

Si, une pièce étant parvenue à son destinataire, l'Office européen des brevets n'est pas en mesure de prouver qu'elle a été régulièrement signifiée, ou si les dispositions relatives à la signification n'ont pas été observées, la pièce est réputée signifiée à la date à laquelle l'Office européen des brevets prouve qu'elle a été reçue.

Chapitre IV

Délais

Règle 83

Calcul des délais

Art. 120

- (1) Les délais sont fixés en années, mois, semaines ou jours entiers.
- (2) Le délai part du jour suivant celui où a eu lieu l'événement par référence auquel son point de départ est fixé, cet événement pouvant être soit un acte, soit l'expiration d'un délai antérieur. Sauf dispositions contraires, lorsque l'acte est une signification, l'événement considéré est la réception de la pièce signifiée.
- (3) Lorsqu'un délai est exprimé en une ou plusieurs années, il expire, dans l'année ultérieure à prendre en considération, le mois portant le même nom et le jour ayant le même quantième que le mois et le jour où ledit événement a eu lieu ; toutefois, si le mois ultérieur à prendre en considération n'a pas de jour ayant le même quantième, le délai considéré expire le dernier jour de ce mois.

¹¹⁵ Cf. la communication du Président de l'OEB du 11.01.1980 concernant la signification publique conformément à la règle 80 CBE (JO OEB 1980, 36).

(4)¹¹⁶ Ist als Frist ein Monat oder eine Anzahl von Monaten bestimmt, so endet die Frist in dem maßgeblichen folgenden Monat an dem Tag, der durch seine Zahl dem Tag entspricht, an dem das Ereignis eingetreten ist; hat der betreffende nachfolgende Monat keinen Tag mit der entsprechenden Zahl, so läuft die Frist am letzten Tag dieses Monats ab.

(5) Ist als Frist eine Woche oder eine Anzahl von Wochen bestimmt, so endet die Frist in der maßgeblichen Woche an dem Tag, der durch seine Benennung dem Tag entspricht, an dem das Ereignis eingetreten ist.

Regel 84

Dauer der Fristen

Ist im Übereinkommen oder in dieser Ausführungsordnung eine Frist vorgesehen, die vom Europäischen Patentamt zu bestimmen ist, so darf diese Frist auf nicht weniger als zwei Monate und auf nicht mehr als vier Monate sowie, wenn besondere Umstände vorliegen, auf nicht mehr als sechs Monate festgesetzt werden. In besonders gelagerten Fällen kann die Frist vor Ablauf auf Antrag verlängert werden.

*Regel 84a*¹¹⁷

Verspäteter Zugang von Schriftstücken

(1) Ein beim Europäischen Patentamt verspätet eingegangenes Schriftstück gilt als rechtzeitig eingegangen, wenn es nach Maßgabe der vom Präsidenten des Europäischen Patentamts festgelegten Bedingungen rechtzeitig vor Ablauf der Frist bei der Post oder einem anerkannten Übermittlungsdienst aufgegeben wurde, es sei denn, das Schriftstück ist später als drei Monate nach Ablauf der Frist eingegangen.

(2) Absatz 1 ist auf die im Übereinkommen vorgesehenen Fristen entsprechend anzuwenden, falls Handlungen bei der zuständigen Behörde nach Artikel 75 Absatz 1 Buchstabe b oder Absatz 2 Buchstabe b vorgenommen werden.

(4)¹¹⁶ When a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

(5) When a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the said event occurred.

Rule 84

Duration of time limits

Where the Convention or these Implementing Regulations specify a period to be determined by the European Patent Office, such period shall be not less than two months nor more than four months; in certain special circumstances it may be up to six months. In certain special cases, the period may be extended upon request, presented before the expiry of such period.

*Rule 84a*¹¹⁷

Late receipt of documents

(1) A document received late at the European Patent Office shall be deemed to have been received in due time if it was posted, or delivered to a recognised delivery service, in due time before the expiry of the time limit in accordance with the conditions laid down by the President of the European Patent Office, unless the document was received later than three months after expiry of the time limit.

(2) Paragraph 1 shall apply *mutatis mutandis* to the time limits provided for in the Convention where transactions are carried out with the competent authority in accordance with Article 75, paragraph 1(b) or paragraph 2(b).

¹¹⁶ Siehe Rechtsauskunft Nr. 5/93 rev. (Anhang II).

¹¹⁷ Eingefügt durch Beschluss des Verwaltungsrats vom 10.12.1998, in Kraft getreten am 01.01.1999 (ABI. EPA 1999, 1 ff.). Siehe hierzu den Beschluss des Präsidenten des EPA vom 31.3.2003 zur Anwendung von Regel 84a EPÜ über den verspäteten Zugang von Schriftstücken (ABI. EPA 2003, 283 ff.).

¹¹⁶ See Legal advice No. 5/93 rev. (Annex II).

¹¹⁷ Inserted by decision of the Administrative Council of 10.12.1998 which entered into force on 01.01.1999 (OJ EPO 1999, 1 ff). See the decision of the President of the EPO dated 31.03.2003 concerning the application of Rule 84a EPC on the late receipt of documents (OJ EPO 2003, 283 ff).

(4)¹¹⁶ Lorsqu'un délai est exprimé en un ou plusieurs mois, il expire, dans le mois ultérieur à prendre en considération, le jour ayant le même quantième que le jour où ledit événement a eu lieu; toutefois, si le mois ultérieur à prendre en considération n'a pas de jour ayant le même quantième, le délai considéré expire le dernier jour de ce mois.

(5) Lorsqu'un délai est exprimé en une ou plusieurs semaines, il expire, dans la semaine à prendre en considération, le jour portant le même nom que celui où ledit événement a eu lieu.

Verweisungen / References / Références

Règle 84

Durée des délais

Lorsque la convention ou le présent règlement d'exécution prévoit un délai qui doit être imparti par l'Office européen des brevets, ce délai ne peut ni être inférieur à deux mois ni supérieur à quatre mois; dans des circonstances particulières, il peut être porté jusqu'à six mois. Dans certains cas d'espèce, le délai peut être prorogé sur requête présentée avant son expiration.

Art. 120
R. 71a/bis

*Règle 84bis*¹¹⁷

Pièces reçues tardivement

(1) Une pièce reçue en retard par l'Office européen des brevets est réputée avoir été reçue dans les délais lorsque, avant l'expiration du délai et conformément aux conditions fixées par le Président de l'Office européen des brevets, ladite pièce a, en temps utile, été postée ou remise à une entreprise d'acheminement reconnue, sauf si elle a été reçue plus de trois mois après l'expiration du délai.

(2) Le paragraphe 1 s'applique aux délais prévus par la convention lorsqu'il s'agit d'actes accomplis auprès de l'administration compétente visée à l'article 75, paragraphe 1, lettre b) ou au paragraphe 2, lettre b).

¹¹⁶ Cf. le renseignement juridique n° 5/93 rév. (Annexe II).

¹¹⁷ Insérée par décision du Conseil d'administration en date du 10.12.1998, entrée en vigueur le 01.01.1999 (JO OEB 1999, 1 s.). Cf. la décision du Président de l'OEB, en date du 31.3.2003, relative à l'application de la règle 84bis CBE (JO OEB 2003, 283 s.).

Verlängerung von Fristen

(1) Läuft eine Frist an einem Tag ab, an dem eine Annahmestelle des Europäischen Patentamts im Sinne von Artikel 75 Absatz 1 Buchstabe a zur Entgegennahme von Schriftstücken nicht geöffnet ist oder an dem gewöhnliche Postsendungen aus anderen als den in Absatz 2 genannten Gründen dort nicht zugestellt werden, so erstreckt sich die Frist auf den nächstfolgenden Tag, an dem alle Annahmestellen zur Entgegennahme von Schriftstücken geöffnet sind und an dem gewöhnliche Postsendungen zugestellt werden.

(2) Läuft eine Frist an einem Tag ab, an dem die Postzustellung in einem Vertragsstaat oder zwischen einem Vertragsstaat und dem Europäischen Patentamt allgemein unterbrochen oder im Anschluss an eine solche Unterbrechung gestört ist, so erstreckt sich die Frist für Beteiligte, die in diesem Staat ihren Wohnsitz oder Sitz haben oder einen Vertreter mit Geschäftssitz in diesem Staat bestellt haben, auf den ersten Tag nach Beendigung der Unterbrechung oder Störung. Satz 1 ist auf die in Artikel 77 Absatz 5 genannte Frist entsprechend anzuwenden. Ist der betreffende Staat der Sitzstaat des Europäischen Patentamts, so gilt diese Vorschrift für alle Beteiligten. Die Dauer der Unterbrechung oder Störung der Postzustellung wird in einer Mitteilung des Präsidenten des Europäischen Patentamts bekannt gegeben.

(3) Die Absätze 1 und 2 sind auf Fristen, die im Übereinkommen vorgesehen sind, in Fällen entsprechend anzuwenden, in denen Handlungen bei der zuständigen Behörde nach Artikel 75 Absatz 1 Buchstabe b oder Absatz 2 Buchstabe b vorgenommen werden.

(4)¹²⁰ Ist der ordnungsgemäße Dienstbetrieb des Europäischen Patentamts durch ein außerordentliches Ereignis, zum Beispiel eine Naturkatastrophe oder einen Streik, unterbrochen oder gestört und verzögern sich dadurch amtliche Benachrichtigungen über den Ablauf von Fristen, so können die innerhalb dieser Fristen vorzunehmenden Handlungen noch innerhalb eines Monats nach Zustellung der verzögerten Benachrichtigung wirksam vorgenommen werden. Der Beginn und das Ende einer solchen Unterbrechung oder Störung werden in einer Mitteilung des Präsidenten des Europäischen Patentamts bekannt gegeben.

Extension of time limits

(1) If a time limit expires on a day on which one of the filing offices of the European Patent Office in the sense of Article 75, paragraph 1(a) is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, ordinary mail is not delivered there, the time limit shall extend until the first day thereafter on which all the filing offices are open for receipt of documents and on which ordinary mail is delivered.

(2) If a time limit expires on a day on which there is a general interruption or subsequent dislocation in the delivery of mail in a Contracting State or between a Contracting State and the European Patent Office, the time limit shall extend to the first day following the end of the period of interruption or dislocation for parties resident in the State concerned or who have appointed representatives with a place of business in that State. The first sentence shall apply mutatis mutandis to the period referred to in Article 77, paragraph 5. In the case where the State concerned is the State in which the European Patent Office is located, this provision shall apply to all parties. The duration of the above-mentioned period shall be as stated by the President of the European Patent Office.

(3) Paragraphs 1 and 2 shall apply mutatis mutandis to the time limits provided for in the Convention in the case of transactions carried out with the competent authority in accordance with Article 75, paragraph 1(b) or paragraph 2(b).

(4)¹²⁰ If an exceptional occurrence such as a natural disaster or strike interrupts or dislocates the proper functioning of the European Patent Office so that any communication from the Office to parties concerning the expiry of a time limit is delayed, acts to be completed within such a time limit may still be validly completed within one month after the notification of the delayed communication. The date of commencement and the end of any such interruption or dislocation shall be as stated by the President of the European Patent Office.

¹¹⁸ Siehe Rechtsauskunft Nr. 5/93 rev. (Anhang II).

¹¹⁹ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 13.12.1994, in Kraft getreten am 01.06.1995 (ABI. EPA 1995, 9 ff.).

¹²⁰ Eingefügt durch Beschluss des Verwaltungsrats vom 14.02.1985, in Kraft getreten am 10.12.1984 (ABI. EPA 1985, 33).

¹¹⁸ See Legal advice No. 5/93 rev. (Annex II).

¹¹⁹ Last amended by decision of the Administrative Council of 13.12.1994 which entered into force on 01.06.1995 (OJ EPO 1995, 9 ff).

¹²⁰ Inserted by decision of the Administrative Council of 14.02.1985 which entered into force on 10.12.1984 (OJ EPO 1985, 33).

Prorogation des délais

Art. 120

(1) Si un délai expire soit un jour où l'un des bureaux de réception de l'Office européen des brevets au sens de l'article 75, paragraphe 1, lettre a) n'est pas ouvert pour recevoir le dépôt des pièces, soit un jour où le courrier normal n'y est pas distribué, pour des raisons autres que celles indiquées au paragraphe 2, le délai est prorogé jusqu'au premier jour suivant où tous les bureaux de réception sont ouverts pour recevoir ce dépôt et où le courrier normal est distribué.

(2) Si un délai expire soit un jour où se produit une interruption générale de la distribution du courrier, soit un jour de perturbation résultant de cette interruption dans un Etat contractant ou entre un Etat contractant et l'Office européen des brevets, le délai est prorogé jusqu'au premier jour suivant la fin de cette période d'interruption ou de perturbation pour les parties qui ont leur domicile ou leur siège dans cet Etat ou qui ont désigné des mandataires ayant leur domicile professionnel dans ledit Etat. La première phrase s'applique au délai prévu à l'article 77, paragraphe 5. Au cas où l'Etat concerné est l'Etat où l'Office européen des brevets a son siège, la présente disposition est applicable à toutes les parties. La durée de cette période est indiquée par le Président de l'Office européen des brevets.

(3) Les paragraphes 1 et 2 s'appliquent aux délais prévus par la convention lorsqu'il s'agit d'actes accomplis auprès de l'administration compétente visée à l'article 75, paragraphe 1, lettre b) ou au paragraphe 2, lettre b).

(4)¹²⁰ En cas de retard dans les notifications de l'Office européen des brevets portant indication de l'expiration de délais, par suite de circonstances exceptionnelles telles que catastrophe naturelle ou grève ayant interrompu ou perturbé le fonctionnement normal de l'Office, les actes devant être accomplis dans ces délais peuvent être valablement accomplis dans un délai d'un mois à compter de la signification de la notification effectuée avec retard. Le début et la fin de l'interruption ou de la perturbation sont indiqués par le Président de l'Office européen des brevets.

¹¹⁸ Cf. le renseignement juridique n° 5/93 rév. (Annexe II).

¹¹⁹ Modifié en dernier lieu par décision du Conseil d'administration en date du 13.12.1994, entrée en vigueur le 01.06.1995 (JO OEB 1995, 9 s.).

¹²⁰ Inséré par décision du Conseil d'administration en date du 14.02.1985, entrée en vigueur le 10.12.1984 (JO OEB 1985, 33).

(5)¹²¹ Unbeschadet der Absätze 1 bis 4 kann der Beweis angeboten werden, dass an einem der letzten zehn Tage vor Ablauf einer Frist der Postdienst als Folge eines Kriegs, einer Revolution, einer Störung der öffentlichen Ordnung, eines Streiks, einer Naturkatastrophe oder ähnlicher Ursachen an dem Sitz oder Wohnsitz, dem Ort der Geschäftstätigkeit oder dem gewöhnlichen Aufenthaltsort des Beteiligten oder seines Vertreters unterbrochen oder im Anschluss an eine solche Unterbrechung gestört war. Sind solche Umstände dem Europäischen Patentamt nachgewiesen worden, so gilt ein verspätet eingegangenes Schriftstück als rechtzeitig eingegangen, sofern der Versand innerhalb von fünf Tagen nach der Wiederherstellung des Postdienstes vorgenommen wurde.

Regel 85a^{122/123}

Nachfrist für Gebührenzahlungen

(1) Wird die Anmeldegebühr, die Recherchegebühr oder eine Benennungsgebühr nicht innerhalb der in Artikel 78 Absatz 2, Artikel 79 Absatz 2, Regel 15 Absatz 2 oder Regel 25 Absatz 2 vorgesehenen Fristen entrichtet, so kann sie noch innerhalb einer Nachfrist von einem Monat nach Zustellung einer Mitteilung, in der auf die Fristversäumung hingewiesen wird, wirksam entrichtet werden, sofern innerhalb dieser Frist eine Zuschlagsgebühr entrichtet wird.

(2) Benennungsgebühren, für die der Anmelder auf einen Hinweis nach Absatz 1 verzichtet hat, können noch innerhalb einer Nachfrist von zwei Monaten nach Ablauf der in Absatz 1 genannten Grundfristen wirksam entrichtet werden, sofern innerhalb dieser Frist eine Zuschlagsgebühr entrichtet wird.

*Regel 85b*¹²⁴

Nachfrist für die Stellung des Prüfungsantrags

Wird der Prüfungsantrag nicht innerhalb der in Artikel 94 Absatz 2 vorgesehenen Frist gestellt, so kann er noch innerhalb einer Nachfrist von einem Monat nach Zustellung einer Mitteilung, in der auf die Fristversäumung hingewiesen wird, wirksam gestellt werden, sofern innerhalb dieser Frist eine Zuschlagsgebühr entrichtet wird.

(5)¹²¹ Without prejudice to paragraphs 1 to 4, evidence may be offered that on any of the ten days preceding the day of expiration of a time limit the mail service was interrupted or subsequently dislocated on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the party or his representative resides or has his place of business or is staying. If such circumstances are proven to the satisfaction of the European Patent Office, a document received late shall be deemed to have been received in due time provided that the mailing has been effected within five days after the mail service was resumed.

Rule 85a^{122/123}

Period of grace for payment of fees

(1) If the filing fee, the search fee or a designation fee has not been paid within the time limits provided for in Article 78, paragraph 2, Article 79, paragraph 2, Rule 15, paragraph 2, or Rule 25, paragraph 2, it may still be validly paid within a period of grace of one month from notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid.

(2) Designation fees in respect of which the applicant has dispensed with notification under paragraph 1 may still be validly paid within a period of grace of two months of expiry of the normal time limits referred to in paragraph 1, provided that within this period a surcharge is paid.

*Rule 85b*¹²⁴

Period of grace for the filing of the request for examination

If the request for examination has not been filed within the time limit provided for in Article 94, paragraph 2, it may still be validly filed within a period of grace of one month from notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid.

¹²¹ Eingefügt durch Beschluss des Verwaltungsrats vom 18.10.2001, in Kraft getreten am 11.09.2001 (ABl. EPA 2001, 491 ff.).

¹²² Zuletzt geändert durch Beschluss des Verwaltungsrats vom 28.06.2001, in Kraft getreten am 02.01.2002 (ABl. EPA 2001, 374 ff.).

¹²³ Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 4/98 (Anhang I) und Rechtsauskunft Nr. 5/93 rev. (Anhang II).

¹²⁴ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 28.06.2001, in Kraft getreten am 02.01.2002 (ABl. EPA 2001, 374 ff.).

¹²¹ Inserted by decision of the Administrative Council of 18.10.2001 which entered into force on 11.09.2001 (OJ EPO 2001, 491 ff.).

¹²² Last amended by decision of the Administrative Council of 28.06.2001 which entered into force on 02.01.2002 (OJ EPO 2001, 374 ff.).

¹²³ See opinion of the Enlarged Board of Appeal G 4/98 (Annex I) and Legal advice No. 5/93 rev. (Annex II).

¹²⁴ Last amended by decision of the Administrative Council of 28.06.2001 which entered into force on 02.01.2002 (OJ EPO 2001, 374 ff.).

(5)¹²¹ Sans préjudice des paragraphes 1 à 4, la preuve peut être apportée que, lors de l'un quelconque des dix jours qui ont précédé la date d'expiration d'un délai, le service postal a été interrompu, ou perturbé par suite de cette interruption, en raison d'une guerre, d'une révolution, d'un désordre civil, d'une grève, d'une calamité naturelle ou pour d'autres raisons semblables, dans la localité où une partie ou son mandataire a son domicile, son siège ou sa résidence. Si, au vu de la preuve produite, l'Office européen des brevets est convaincu que de telles circonstances ont existé, la pièce reçue tardivement sera réputée avoir été reçue dans les délais, à condition que l'expédition postale ait été effectuée dans les cinq jours suivant la reprise du service postal.

Verweisungen / References / Références

Règle 85bis^{122/123}

Délai supplémentaire pour le paiement des taxes

Art. 90, 91, 120

(1) Si la taxe de dépôt, la taxe de recherche ou une taxe de désignation n'est pas acquittée dans les délais fixés à l'article 78, paragraphe 2, à l'article 79, paragraphe 2, à la règle 15, paragraphe 2 ou à la règle 25, paragraphe 2, elle peut être acquittée dans un délai supplémentaire d'un mois à compter de la signification d'une notification signalant que le délai prévu n'a pas été observé, moyennant versement d'une surtaxe dans ce délai.

(2) Les taxes de désignation pour lesquelles le demandeur a renoncé à la notification prévue au paragraphe 1 peuvent encore être acquittées dans un délai supplémentaire de deux mois à compter de l'expiration des délais normaux visés au paragraphe 1, moyennant versement d'une surtaxe dans ce délai.

*Règle 85ter*¹²⁴

Délai supplémentaire pour la requête en examen

Art. 120

Si la requête en examen n'a pas été formulée dans le délai fixé à l'article 94, paragraphe 2, elle peut être formulée dans un délai supplémentaire d'un mois à compter de la signification d'une notification signalant que le délai prévu n'a pas été observé, moyennant versement d'une surtaxe dans ce délai.

¹²¹ Inséré par décision du Conseil d'administration en date du 18.10.2001, entrée en vigueur le 11.09.2001 (JO OEB 2001, 491 s.).

¹²² Modifiée en dernier lieu par décision du Conseil d'administration en date du 28.06.2001, entrée en vigueur le 02.01.2002 (JO OEB 2001, 374 s.).

¹²³ Cf. l'avis de la Grande Chambre de recours G 4/98 (Annexe I) et le renseignement juridique n° 5/93 rév. (Annexe II).

¹²⁴ Modifiée en dernier lieu par décision du Conseil d'administration en date du 28.06.2001, entrée en vigueur le 02.01.2002 (JO OEB 2001, 374 s.).

Änderungen und Berichtigungen*Regel 86*¹²⁵

Änderung der europäischen Patentanmeldung

(1) Vor Erhalt des europäischen Recherchenberichts darf der Anmelder die Beschreibung, die Patentansprüche oder die Zeichnungen der europäischen Patentanmeldung nicht ändern, soweit nichts anderes vorgeschrieben ist.

(2) Nach Erhalt des europäischen Recherchenberichts und vor Erhalt des ersten Bescheids der Prüfungsabteilung kann der Anmelder von sich aus die Beschreibung, die Patentansprüche und die Zeichnungen ändern.

(3) Nach Erhalt des ersten Bescheids der Prüfungsabteilung kann der Anmelder von sich aus die Beschreibung, die Patentansprüche und die Zeichnungen einmal ändern, sofern die Änderung gleichzeitig mit der Erwiderung auf den Bescheid eingereicht wird. Weitere Änderungen können nur mit Zustimmung der Prüfungsabteilung vorgenommen werden.

(4)¹²⁶ Geänderte Patentansprüche dürfen sich nicht auf nicht recherchierte Gegenstände beziehen, die mit der ursprünglich beanspruchten Erfindung oder Gruppe von Erfindungen nicht durch eine einzige allgemeine erfinderische Idee verbunden sind.

*Regel 87*¹²⁷

Unterschiedliche Patentansprüche, Beschreibungen und Zeichnungen für verschiedene Staaten

Stellt das Europäische Patentamt fest, dass für einen oder mehrere der benannten Vertragsstaaten der Inhalt einer früheren europäischen Patentanmeldung nach Artikel 54 Absätze 3 und 4 zum Stand der Technik gehört, oder wird ihm das Bestehen eines älteren Rechts nach Artikel 139 Absatz 2 mitgeteilt, so kann die europäische Patentanmeldung oder das europäische Patent für diesen Staat oder diese Staaten unterschiedliche Patentansprüche und, wenn es das Europäische Patentamt für erforderlich hält, unterschiedliche Beschreibungen und Zeichnungen enthalten.

Amendments and corrections*Rule 86*¹²⁵

Amendment of the European patent application

(1) Before receiving the European search report the applicant may not amend the description, claims or drawings of a European patent application except where otherwise provided.

(2) After receiving the European search report and before receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend the description, claims and drawings.

(3) After receipt of the first communication from the Examining Division the applicant may, of his own volition, amend once the description, claims and drawings provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the Examining Division.

(4)¹²⁶ Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.

*Rule 87*¹²⁷

Different claims, description and drawings for different States

If the European Patent Office notes that, in respect of one or some of the designated Contracting States, the content of an earlier European patent application forms part of the state of the art pursuant to Article 54, paragraphs 3 and 4, or if it is informed of the existence of a prior right under Article 139, paragraph 2, the European patent application or European patent may contain for such State or States claims and, if the European Patent Office considers it necessary, a description and drawings which are different from those for the other designated Contracting States.

¹²⁵ Siehe Rechtsauskunft Nr. 4/80 (Anhang II) und Entscheidungen/Stellnahmen der Großen Beschwerdekammer G 3/89, G 11/91, G 7/93 (Anhang I).

¹²⁶ Eingefügt durch Beschluss des Verwaltungsrats vom 13.12.1994, in Kraft getreten am 01.06.1995 (ABI. EPA 1995, 9 ff.).

¹²⁷ Geändert durch Beschluss des Verwaltungsrats vom 13.12.1994, in Kraft getreten am 01.06.1995 (ABI. EPA 1995, 9 ff.). Siehe hierzu Entscheidung der Großen Beschwerdekammer G 1/99 (Anhang I).

¹²⁵ See Legal advice No. 4/80. (Annex II) and decisions/opinions of the Enlarged Board of Appeal G 3/89, G 11/91, G 7/93 (Annex I).

¹²⁶ Inserted by decision of the Administrative Council of 13.12.1994 which entered into force on 01.06.1995 (OJ EPO 1995, 9 ff.).

¹²⁷ Amended by decision of the Administrative Council of 13.12.1994 which entered into force on 01.06.1995 (OJ EPO 1995, 9 ff). See decision of the Enlarged Board of Appeal G 1/99 (Annex I).

Modifications et corrections*Règle 86*¹²⁵

Modification de la demande de brevet européen

Art. 92, 96, 123

R. 41, 49, 51, 57a/bis, 109

(1) A moins qu'il n'en soit disposé autrement, le demandeur ne peut modifier la description, les revendications ou les dessins d'une demande de brevet européen avant d'avoir reçu le rapport de recherche européenne.

(2) Après avoir reçu le rapport de recherche européenne et avant d'avoir reçu la première notification de la division d'examen, le demandeur peut, de sa propre initiative, modifier la description, les revendications et les dessins.

(3) Après avoir reçu la première notification de la division d'examen, le demandeur peut, de sa propre initiative, modifier une seule fois la description, les revendications et les dessins à la condition que la modification et la réponse à la notification soient concomitantes. Toutes autres modifications ultérieures sont subordonnées à l'autorisation de la division d'examen.

(4)¹²⁶ Les revendications modifiées ne doivent pas porter sur des éléments qui n'ont pas fait l'objet de la recherche et qui ne sont pas liés à l'invention ou à la pluralité d'inventions initialement revendiquées de manière à former un seul concept inventif général.

*Règle 87*¹²⁷

Revendications, descriptions et dessins différents pour des États différents

Art. 96, 98, 101, 103, 123

R. 57a/bis

Si l'Office européen des brevets constate que, en ce qui concerne un ou plusieurs des États contractants désignés, le contenu d'une demande de brevet européen antérieure est compris dans l'état de la technique en vertu des dispositions de l'article 54, paragraphes 3 et 4, ou s'il est informé de l'existence d'un droit antérieur au sens de l'article 139, paragraphe 2, la demande de brevet européen ou le brevet européen peut comporter des revendications qui diffèrent, accompagnées, si l'Office européen des brevets l'estime nécessaire, d'une description et de dessins qui diffèrent également, selon qu'il s'agit de l'État ou des États en cause ou d'autres États contractants désignés.

¹²⁵ Cf. le renseignement juridique n° 4/80. (Annexe II) et les décisions/avis de la Grande Chambre de recours G 3/89, G 11/91, G 7/93 (Annexe I).

¹²⁶ Insérée par décision du Conseil d'administration en date du 13.12.1994, entrée en vigueur le 01.06.1995 (JO OEB 1995, 9 s.).

¹²⁷ Modifiée par décision du Conseil d'administration en date du 13.12.1994, entrée en vigueur le 01.06.1995 (JO OEB 1995, 9 s.). Cf. la décision de la Grande Chambre de recours G 1/99 (Annexe I).

*Regel 88*¹²⁸

Berichtigung von Mängeln in den beim Europäischen Patentamt eingereichten Unterlagen

Sprachliche Fehler, Schreibfehler und Unrichtigkeiten in den beim Europäischen Patentamt eingereichten Unterlagen können auf Antrag berichtigt werden. Betrifft jedoch der Antrag auf Berichtigung die Beschreibung, die Patentansprüche oder die Zeichnungen, so muss die Berichtigung derart offensichtlich sein, dass sofort erkennbar ist, dass nichts anderes beabsichtigt sein konnte als das, was als Berichtigung vorgeschlagen wird.

*Regel 89*¹²⁹

Berichtigung von Fehlern in Entscheidungen

In Entscheidungen des Europäischen Patentamts können nur sprachliche Fehler, Schreibfehler und offensichtbare Unrichtigkeiten berichtigt werden.

Kapitel VI

Unterbrechung des Verfahrens

*Regel 90*¹³⁰

Unterbrechung des Verfahrens

(1) Das Verfahren vor dem Europäischen Patentamt wird unterbrochen:

a) im Fall des Todes oder der fehlenden Geschäftsfähigkeit des Anmelders oder Patentinhabers oder der Person, die nach dem Heimatrecht des Anmelders oder Patentinhabers zu dessen Vertretung berechtigt ist. Solange die genannten Ereignisse die Vertretungsbefugnis eines nach Artikel 134 bestellten Vertreters nicht berühren, tritt eine Unterbrechung des Verfahrens jedoch nur auf Antrag dieses Vertreters ein;

b) wenn der Anmelder oder Patentinhaber auf Grund eines gegen sein Vermögen gerichteten Verfahrens aus rechtlichen Gründen verhindert ist, das Verfahren vor dem Europäischen Patentamt fortzusetzen;

c)¹³¹ wenn der Vertreter des Anmelders oder Patentinhabers stirbt, seine Geschäftsfähigkeit verliert oder auf Grund eines gegen sein Vermögen gerichteten Verfahrens aus rechtlichen Gründen verhindert ist, das Verfahren vor dem Europäischen Patentamt fortzusetzen.

*Rule 88*¹²⁸

Correction of errors in documents filed with the European Patent Office

Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns a description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

*Rule 89*¹²⁹

Correction of errors in decisions

In decisions of the European Patent Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected.

Chapter VI

Interruption of proceedings

*Rule 90*¹³⁰

Interruption of proceedings

(1) Proceedings before the European Patent Office shall be interrupted:

(a) in the event of the death or legal incapacity of the applicant for or proprietor of a European patent or of the person authorised by national law to act on his behalf. To the extent that the above events do not affect the authorisation of a representative appointed under Article 134, proceedings shall be interrupted only on application by such representative;

(b) in the event of the applicant for or proprietor of a European patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the European Patent Office;

(c)¹³¹ in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a European patent or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the European Patent Office.

¹²⁸ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 3/89, G 11/91, G 2/95 (Anhang I).

¹²⁹ Siehe hierzu Entscheidungen der Großen Beschwerdekammer G 8/95, G 1/97 (Anhang I).

¹³⁰ Siehe hierzu den Beschluss des Präsidenten des EPA vom 10.03.1989 über die Zuständigkeit der Rechtsabteilung (ABI. EPA 1989, 177 f.), die Mitteilung des Vizepräsidenten Generaldirektion 5 des EPA vom 05.07.1990 über den Schriftverkehr mit der Rechtsabteilung (ABI. EPA 1990, 404 f.) und die Entscheidung der Großen Beschwerdekammer G 1/97 (Anhang I).

¹³¹ Geändert durch Beschluss des Verwaltungsrats vom 05.06.1987, in Kraft getreten am 05.06.1987 (ABI. EPA 1987, 279).

¹²⁸ See decisions/opinions of the Enlarged Board of Appeal G 3/89, G 11/91, G 2/95 (Annex I).

¹²⁹ See decisions of the Enlarged Board of Appeal G 8/95, G 1/97 (Annex I).

¹³⁰ See decision of the President of the EPO dated 10.03.1989 concerning the responsibilities of the Legal Division (OJ EPO 1989, 177 ff), the notice of the Vice-President, DG 5 of the EPO dated 05.07.1990 concerning correspondence with the Legal Division (OJ EPO 1990, 404 f) and the decision of the Enlarged Board of Appeal G 1/97 (Annex I).

¹³¹ Amended by decision of the Administrative Council of 05.06.1987 which entered into force on 05.06.1987 (OJ EPO 1987, 279).

Règle 88¹²⁸

Correction d'erreurs dans les pièces soumises à l'Office européen des brevets

Les fautes d'expression ou de transcription et les erreurs contenues dans toute pièce soumise à l'Office européen des brevets peuvent être rectifiées sur requête. Toutefois, si la requête en rectification porte sur la description, les revendications ou les dessins, la rectification doit s'imposer à l'évidence, en ce sens qu'il apparaît immédiatement qu'aucun texte autre que celui résultant de la rectification n'a pu être envisagé par le demandeur.

Règle 89¹²⁹

Rectification d'erreurs dans les décisions

Dans les décisions de l'Office européen des brevets, seules les fautes d'expression, de transcription et les erreurs manifestes peuvent être rectifiées.

Chapitre VI

Interruption de la procédure

Règle 90¹³⁰

Interruption de la procédure

(1) La procédure devant l'Office européen des brevets est interrompue :

- a) en cas de décès ou d'incapacité, soit du demandeur ou du titulaire du brevet européen, soit de la personne qui est habilitée, en vertu du droit national du demandeur ou du titulaire du brevet européen, à représenter l'un ou l'autre. Toutefois, si ces événements n'affectent pas le pouvoir du mandataire désigné en application de l'article 134, la procédure n'est interrompue qu'à la demande du mandataire ;
- b) si le demandeur ou le titulaire du brevet européen se trouve dans l'impossibilité juridique de poursuivre la procédure devant l'Office européen des brevets à raison d'une action engagée contre ses biens ;
- c)¹³¹ en cas de décès ou d'incapacité du mandataire du demandeur ou du mandataire du titulaire du brevet européen, ou si le mandataire se trouve dans l'impossibilité juridique de poursuivre la procédure devant l'Office européen des brevets à raison d'une action engagée contre ses biens.

Verweisungen / References / Références

Art. 78, 88, 91
R. 51

Art. 91, 97, 102, 104, 111, 112

Art. 86, 90, 91, 94, 99, 106
R. 69, 92

¹²⁸ Cf. les décisions/avis de la Grande Chambre de recours G 3/89, G 11/91, G 2/95 (Annexe I).

¹²⁹ Cf. les décisions de la Grande Chambre de recours G 8/95, G 1/97 (Annexe I).

¹³⁰ Cf. la décision du Président de l'OEB, en date du 10.03.1989, relative à la compétence de la division juridique (JO OEB 1989, 177 s.), le communiqué du Vice-Président chargé de la DG 5 de l'OEB, en date du 05.07.1990, relatif à la correspondance avec la division juridique (JO OEB 1990, 404 s.) et la décision de la Grande Chambre de recours G 1/97 (Annexe I).

¹³¹ Modifiée par décision du Conseil d'administration en date du 05.6.1987, entrée en vigueur le 05.06.1987 (JO OEB 1987, 279).

(2) Wird dem Europäischen Patentamt bekannt, wer in den Fällen des Absatzes 1 Buchstaben a und b die Berechtigung erlangt hat, das Verfahren vor dem Europäischen Patentamt fortzusetzen, so teilt es dieser Person und gegebenenfalls den übrigen Beteiligten mit, dass das Verfahren nach Ablauf einer von ihm zu bestimmenden Frist wiederaufgenommen wird.

(3) Im Fall des Absatzes 1 Buchstabe c wird das Verfahren wiederaufgenommen, wenn dem Europäischen Patentamt die Bestellung eines neuen Vertreters des Anmelders angezeigt wird oder das Europäische Patentamt die Anzeige über die Bestellung eines neuen Vertreters des Patentinhabers den übrigen Beteiligten zugestellt hat. Hat das Europäische Patentamt drei Monate nach dem Beginn der Unterbrechung des Verfahrens noch keine Anzeige über die Bestellung eines neuen Vertreters erhalten, so teilt es dem Anmelder oder Patentinhaber mit:

a) im Fall des Artikels 133 Absatz 2, dass die europäische Patentanmeldung als zurückgenommen gilt oder das europäische Patent widerrufen wird, wenn die Anzeige nicht innerhalb von zwei Monaten nach Zustellung dieser Mitteilung erfolgt, oder,

b) wenn der Fall des Artikels 133 Absatz 2 nicht vorliegt, dass das Verfahren vom Tag der Zustellung dieser Mitteilung an mit dem Anmelder oder Patentinhaber wiederaufgenommen wird.

(4) Die am Tag der Unterbrechung für den Anmelder oder Patentinhaber laufenden Fristen, mit Ausnahme der Frist zur Stellung des Prüfungsantrags und der Frist für die Entrichtung der Jahresgebühren, beginnen an dem Tag von Neuem zu laufen, an dem das Verfahren wiederaufgenommen wird. Liegt dieser Tag später als zwei Monate vor Ablauf der Frist zur Stellung des Prüfungsantrags, so kann ein Prüfungsantrag noch bis zum Ablauf von zwei Monaten nach diesem Tag gestellt werden.

(2) When, in the cases referred to in paragraph 1(a) and (b), the European Patent Office has been informed of the identity of the person authorised to continue the proceedings before the European Patent Office, the European Patent Office shall communicate to such person and to any interested third party that the proceedings shall be resumed as from a date to be fixed by the European Patent Office.

(3) In the case referred to in paragraph 1(c), the proceedings shall be resumed when the European Patent Office has been informed of the appointment of a new representative of the applicant or when the European Patent Office has notified to the other parties the communication of the appointment of a new representative of the proprietor of the patent. If, three months after the beginning of the interruption of the proceedings, the European Patent Office has not been informed of the appointment of a new representative, it shall communicate to the applicant for or proprietor of the patent:

(a) where Article 133, paragraph 2, is applicable, that the European patent application will be deemed to be withdrawn or the European patent will be revoked if the information is not submitted within two months after this communication is notified, or

(b) where Article 133, paragraph 2, is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the date on which this communication is notified.

(4) The time limits, other than the time limit for making a request for examination and the time limit for paying the renewal fees, in force as regards the applicant for or proprietor of the patent at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed. If such date is less than two months before the end of the period within which the request for examination must be filed, such a request may be filed up to the end of two months after such date.

Kapitel VII

Verzicht auf Beitreibung

Regel 91

Verzicht auf Beitreibung

Der Präsident des Europäischen Patentamts kann davon absehen, geschuldete Geldbeträge beizutreiben, wenn der beizutreibende Betrag geringfügig oder die Beitreibung zu ungewiss ist.

Chapter VII

Waiving of enforced recovery procedures

Rule 91

Waiving of enforced recovery procedures

The President of the European Patent Office may waive action for the enforced recovery of any sum due if the sum to be recovered is minimal or if such recovery is too uncertain.

(2) Si l'Office européen des brevets a connaissance de l'identité de la personne habilitée à poursuivre devant lui la procédure dans les cas visés au paragraphe 1, sous les lettres a) et b), il adresse à cette personne et, le cas échéant, à tout tiers participant, une notification dans laquelle il est indiqué que la procédure sera reprise à l'expiration du délai qu'il a imparti.

(3) Dans le cas visé au paragraphe 1, sous la lettre c), la procédure est reprise lorsque l'Office européen des brevets est avisé de la constitution d'un nouveau mandataire du demandeur ou lorsque cet Office a signifié aux tiers participants l'avis relatif à la constitution d'un nouveau mandataire du titulaire du brevet européen. Si, dans un délai de trois mois à compter du début de l'interruption de la procédure, l'Office européen des brevets n'a pas reçu d'avis relatif à la constitution d'un nouveau mandataire, il adresse au demandeur ou au titulaire du brevet européen une notification dans laquelle il est indiqué que :

a) dans le cas visé à l'article 133, paragraphe 2, la demande de brevet européen est réputée retirée, ou le brevet européen est révoqué, si l'avis n'est pas produit dans les deux mois suivant la signification de cette notification, ou que

b) dans les cas autres que celui visé à l'article 133, paragraphe 2, la procédure est reprise avec le demandeur ou avec le titulaire du brevet européen à compter du jour de la signification de cette notification.

(4) Les délais en cours à l'égard du demandeur ou du titulaire du brevet européen à la date d'interruption de la procédure, à l'exception du délai de présentation de la requête en examen et du délai de paiement des taxes annuelles, recommencent à courir dans leur intégralité à compter du jour de la reprise de la procédure. Si ce jour se situe dans les deux mois qui précèdent l'expiration du délai prévu pour la présentation de la requête en examen, cette requête peut encore être présentée jusqu'à l'expiration d'un délai de deux mois à compter dudit jour.

Chapitre VII

Renonciation au recouvrement par contrainte

Règle 91

Renonciation au recouvrement par contrainte

Art. 126

Le Président de l'Office européen des brevets peut renoncer à procéder au recouvrement par contrainte de toute somme due si celle-ci est minime ou si le recouvrement est trop aléatoire.

Unterrichtung der Öffentlichkeit*Regel 92*^{132/133}

Eintragungen in das europäische Patentregister

(1) Im europäischen Patentregister müssen folgende Angaben eingetragen werden:

- a) Nummer der europäischen Patentanmeldung;
- b) Anmeldetag der europäischen Patentanmeldung;
- c) Bezeichnung der Erfindung;
- d) Symbole der Klassifikation der europäischen Patentanmeldung;
- e) die benannten Vertragsstaaten;
- f) Name, Vornamen, Anschrift, Staat des Wohnsitzes oder Sitzes des Anmelders oder Patentinhabers;
- g) Name, Vornamen und Anschrift des vom Anmelder oder Patentinhaber genannten Erfinders, sofern er nicht nach Regel 18 Absatz 1 auf das Recht verzichtet hat, als Erfinder bekannt zu werden;
- h) Name, Vornamen und Geschäftsanschrift des in Artikel 134 bezeichneten Vertreters des Anmelders oder Patentinhabers; im Fall mehrerer Vertreter werden nur Name, Vornamen und Geschäftsanschrift des zuerst genannten Vertreters, gefolgt von den Worten "und Partner", eingetragen; im Fall eines Zusammenschlusses von Vertretern nach Regel 101 Absatz 9 werden nur Name und Anschrift des Zusammenschlusses eingetragen;
- i) Prioritätsangaben (Tag, Staat und Aktenzeichen der früheren Anmeldung);
- j) im Fall der Teilung der europäischen Patentanmeldung die Nummern der europäischen Teilanmeldungen;
- k) bei europäischen Teilanmeldungen und bei den nach Artikel 61 Absatz 1 Buchstabe b eingereichten neuen europäischen Patentanmeldungen die unter den Buchstaben a, b und i vorgesehenen Angaben für die frühere europäische Patentanmeldung;

Information to the public*Rule 92*^{132/133}

Entries in the Register of European Patents

(1) The Register of European Patents shall contain the following entries:

- (a) number of the European patent application;
- (b) date of filing of the European patent application;
- (c) title of the invention;
- (d) classification code given to the European patent application;
- (e) the Contracting States designated;
- (f) family name, given names, address and the State in which the residence or principal place of business of the applicant for or proprietor of the European patent is located;
- (g) family name, given names and address of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 18, paragraph 1;
- (h) family name, given names and address of the place of business of the representative of the applicant for or proprietor of the patent referred to in Article 134; in the case of several representatives only the family name, given names and address of the place of business of the representative first named, followed by the words "and others", shall be entered; however, in the case of an association referred to in Rule 101, paragraph 9, only the name and address of the association shall be entered;
- (i) priority data (date, State and file number of the previous application);
- (j) in the event of a division of the European patent application, the numbers of the European divisional applications;
- (k) in the case of European divisional applications and a new European patent application under Article 61, paragraph 1(b), the information referred to under subparagraphs (a), (b) and (i) with regard to the earlier European patent application;

¹³² Siehe hierzu Entscheidung der Großen Beschwerdekammer G 1/97 (Anhang I).

¹³³ Geändert durch Beschlüsse des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABl. EPA 1978, 12 ff.), und vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.).

¹³² See decision of the Enlarged Board of Appeal G 1/97 (Annex I).

¹³³ Amended by decisions of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff) and of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff).

Information du public*Règle 92*^{132/133}

Inscriptions au Registre européen des brevets

Art. 127

(1) Les mentions suivantes sont inscrites au Registre européen des brevets :

- a) le numéro de la demande de brevet européen ;
- b) la date de dépôt de la demande de brevet européen ;
- c) le titre de l'invention ;
- d) le symbole de la classification attribué à la demande de brevet européen ;
- e) la mention des Etats contractants désignés ;
- f) les nom, prénoms et adresse ainsi que l'Etat du domicile ou siège du demandeur ou du titulaire du brevet européen ;
- g) les nom, prénoms et adresse de l'inventeur désigné par le demandeur ou par le titulaire du brevet européen, pour autant que l'inventeur n'ait pas renoncé au droit d'être mentionné en tant que tel, ainsi que le prévoit la règle 18, paragraphe 1 ;
- h) les nom, prénoms et adresse professionnelle du mandataire du demandeur ou du titulaire du brevet européen, visé à l'article 134 ; en cas de pluralité de mandataires, seuls les nom, prénoms et adresse professionnelle du premier mandataire cité, suivis de la mention «et autres», sont inscrits au registre ; toutefois, pour les groupements visés à la règle 101, paragraphe 9, seules sont inscrites au registre leurs dénomination et adresse ;
- i) les indications relatives à la priorité (date, Etat et numéro de dépôt de la demande antérieure) ;
- j) dans le cas de division de la demande de brevet européen, les numéros des demandes divisionnaires européennes ;
- k) lorsqu'il s'agit soit de demandes divisionnaires européennes, soit de nouvelles demandes de brevet européen dans le cas visé à l'article 61, paragraphe 1, lettre b), les indications mentionnées sous les lettres a), b) et i) du présent paragraphe pour ce qui est de la demande de brevet européen initiale ;

¹³² Cf. la décision de la Grande Chambre de recours G 1/97 (Annexe I).

¹³³ Modifiée par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.) et celle en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

l) Tag der Veröffentlichung der europäischen Patentanmeldung und gegebenenfalls Tag der gesonderten Veröffentlichung des europäischen Recherchenberichts;

m) Tag der Stellung eines Prüfungsantrags;

n) Tag, an dem die europäische Patentanmeldung zurückgewiesen oder zurückgenommen worden ist oder als zurückgenommen gilt;

o) Tag der Bekanntmachung des Hinweises auf die Erteilung des europäischen Patents;

p) Tag des Erlöschens des europäischen Patents in einem Vertragsstaat während der Einspruchsfrist und gegebenenfalls bis zur rechtskräftigen Entscheidung über den Einspruch;

q) Tag der Einlegung des Einspruchs;

r) Tag und Art der Entscheidung über den Einspruch;

s) Tag der Aussetzung und der Fortsetzung des Verfahrens im Fall der Regel 13;

t) Tag der Unterbrechung und der Wiederaufnahme des Verfahrens im Fall der Regel 90;

u) Tag der Wiedereinsetzung in den vorigen Stand, sofern eine Eintragung nach den Buchstaben n oder r erfolgt ist;

v) die Einreichung eines Antrags nach Artikel 135 beim Europäischen Patentamt;

w) Rechte an der europäischen Patentanmeldung oder am europäischen Patent und Rechte an diesen Rechten, soweit ihre Eintragung in Anwendung dieser Ausführungsordnung vorgenommen wird.

(2)¹³⁴ Der Präsident des Europäischen Patentamts kann bestimmen, dass in das europäische Patentregister andere als die in Absatz 1 vorgesehenen Angaben eingetragen werden.

(3) Auf Antrag werden Auszüge aus dem europäischen Patentregister nach Entrichtung einer Verwaltungsgebühr erteilt.

(l) date of publication of the European patent application and where appropriate date of the separate publication of the European search report;

(m) date of filing of the request for examination;

(n) date on which the European patent application is refused, withdrawn or deemed to be withdrawn;

(o) date of publication of the mention of the grant of the European patent;

(p) date of lapse of the European patent in a Contracting State during the opposition period and, where appropriate, pending a final decision on opposition;

(q) date of filing opposition;

(r) date and purport of the decision on opposition;

(s) dates of suspension and resumption of proceedings in the cases referred to in Rule 13;

(t) dates of interruption and resumption of proceedings in the case referred to in Rule 90;

(u) date of re-establishment of rights provided that an entry has been made in accordance with subparagraph (n) or sub-paragraph (r);

(v) the filing of a request to the European Patent Office pursuant to Article 135;

(w) rights and transfer of such rights over a European patent application or European patent where these are recorded pursuant to these Implementing Regulations.

(2)¹³⁴ The President of the European Patent Office may decide that entries other than those referred to in paragraph 1 shall be made in the Register of European Patents.

(3) Extracts from the Register of European Patents shall be delivered on request on payment of an administrative fee.

¹³⁴ Siehe hierzu die Mitteilungen des Präsidenten des EPA vom 14.10.1983, 22.01.1986 und 30.07.1986 über die Eintragung bestimmter Angaben in das europäische Patentregister (ABl. EPA 1983, 458; 1986, 61 und 327).

¹³⁴ See notices of the President of the EPO of 14.10.1983, 22.01.1986 and 30.07.1986 concerning the recording of certain information in the Register of European Patents (OJ EPO 1983, 458; 1986, 61 and 327).

- l) la date de la publication de la demande de brevet européen et, le cas échéant, la date de la publication du rapport de recherche européenne ;
- m) la date de la présentation de la requête en examen ;
- n) la date à laquelle la demande de brevet européen est rejetée, retirée ou réputée retirée ;
- o) la date de la publication de la mention de la délivrance du brevet européen ;
- p) la date de la déchéance du brevet européen dans un Etat contractant pendant le délai d'opposition et, le cas échéant, pendant la période ayant pour terme la date à laquelle la décision relative à l'opposition est passée en force de chose jugée ;
- q) la date du dépôt de l'acte d'opposition ;
- r) la date et le sens de la décision relative à l'opposition ;
- s) les dates de la suspension et de la reprise de la procédure dans les cas visés à la règle 13 ;
- t) les dates de l'interruption et de la reprise de la procédure dans le cas visé à la règle 90 ;
- u) la date du rétablissement dans un droit, pour autant qu'une mention a été inscrite ainsi qu'il est prévu sous les lettres n) ou r) du présent paragraphe ;
- v) la présentation d'une requête à l'Office européen des brevets, en application de l'article 135 ;
- w) la constitution de droits sur la demande de brevet européen ou sur le brevet européen et le transfert de ces droits pour autant que l'inscription de ces mentions est effectuée en application des dispositions du présent règlement d'exécution.

(2)¹³⁴ Le Président de l'Office européen des brevets peut prescrire que des mentions autres que celles prévues au paragraphe 1 seront inscrites au Registre européen des brevets.

(3) Des extraits du Registre européen des brevets sont délivrés sur requête après paiement d'une taxe d'administration.

¹³⁴ Cf. les communiqués du Président de l'OEB du 14.10.1983, du 22.01.1986 et du 30.07.1986 relatifs à l'inscription de certaines mentions dans le Registre européen des brevets (JO OEB 1983, 458; 1986, 61, 327 et 381).

Regel 93

Von der Einsicht ausgeschlossene Aktenteile

Von der Akteneinsicht sind nach Artikel 128 Absatz 4 folgende Aktenteile ausgeschlossen:

- a) Vorgänge über die Frage der Ausschließung oder Ablehnung von Mitgliedern der Beschwerdekammern oder der Großen Beschwerdekammer;
- b) Entwürfe zu Entscheidungen und Bescheiden sowie sonstige Schriftstücke, die der Vorbereitung von Entscheidungen und Bescheiden dienen und den Beteiligten nicht mitgeteilt werden;
- c)¹³⁵ die Erfindernennung, wenn der Erfinder nach Regel 18 Absatz 1 auf das Recht verzichtet hat, als Erfinder bekannt gemacht zu werden;
- d)¹³⁶ andere Schriftstücke, die vom Präsidenten des Europäischen Patentamts von der Einsicht ausgeschlossen werden, weil die Einsicht in diese Schriftstücke nicht dem Zweck dient, die Öffentlichkeit über die europäische Patentanmeldung oder das darauf erteilte europäische Patent zu unterrichten.

Regel 94¹³⁷

Durchführung der Akteneinsicht

- (1) Die Einsicht in die Akten europäischer Patentanmeldungen und Patente wird in das Original oder in eine Kopie oder, wenn die Akten mittels anderer Medien gespeichert sind, in diese Medien gewährt.
- (2) Der Präsident des Europäischen Patentamts bestimmt die Bedingungen der Einsichtnahme einschließlich der Fälle, in denen eine Verwaltungsgebühr zu entrichten ist.

Regel 95

Auskunft aus den Akten

Das Europäische Patentamt kann vorbehaltlich der in Artikel 128 Absätze 1 bis 4 und Regel 93 vorgesehenen Beschränkungen auf Antrag und gegen Entrichtung einer Verwaltungsgebühr Auskünfte aus den Akten europäischer Patentanmeldungen oder europäischer Patente erteilen. Das Europäische Patentamt kann jedoch verlangen, dass von der Möglichkeit der Akteneinsicht Gebrauch gemacht wird, wenn dies im Hinblick auf den Umfang der zu erteilenden Auskünfte zweckmäßig erscheint.

Rule 93

Parts of the file not for inspection

The parts of the file which shall be excluded from inspection pursuant to Article 128, paragraph 4, shall be:

- (a) the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Enlarged Board of Appeal;
- (b) draft decisions and opinions, and all other documents, used for the preparation of decisions and opinions, which are not communicated to the parties;
- (c)¹³⁵ the designation of the inventor, if he has waived his right to be mentioned under Rule 18, paragraph 1;
- (d)¹³⁶ any other document excluded from inspection by the President of the European Patent Office on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the resulting patent.

Rule 94¹³⁷

Procedures for the inspection of files

- (1) Inspection of the files of European patent applications and patents shall either be of the original document, or of copies thereof, or of technical means of storage if the files are stored in this way.
- (2) The President of the European Patent Office shall determine all file-inspection arrangements, including the circumstances in which an administrative fee is payable.

Rule 95

Communication of information contained in the files

Subject to the restrictions provided for in Article 128, paragraphs 1 to 4, and in Rule 93, the European Patent Office may, upon request, communicate information concerning any file of a European patent application or European patent subject to the payment of an administrative fee. However, the European Patent Office may require the exercise of the option to obtain inspection of the file itself should it deem this to be appropriate in view of the quantity of information to be supplied.

¹³⁵ Geändert durch Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABI. EPA 1999, 660 ff.).

¹³⁶ Siehe hierzu den Beschluss des Präsidenten des EPA vom 07.09.2001 über von der Akteneinsicht ausgeschlossene Unterlagen (ABI. EPA 2001, 458 ff.).

¹³⁷ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 11.10.2000, in Kraft getreten am 02.11.2000 (ABI. EPA 2000, 473 f.).

¹³⁵ Amended by decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.).

¹³⁶ See decision of the President of the EPO dated 07.09.2001 concerning documents excluded from file inspection (OJ EPO 2001, 458 ff.).

¹³⁷ Last amended by decision of the Administrative Council of 11.10.2000 which entered into force on 02.11.2000 (OJ EPO 2000, 473 ff.).

Règle 93

Pièces du dossier exclues de l'inspection publique

En vertu des dispositions de l'article 128, paragraphe 4, les pièces du dossier exclues de l'inspection publique sont :

- a) les pièces concernant l'exclusion ou la récusation de membres des chambres de recours ou de la Grande Chambre de recours ;
- b) les projets de décisions et d'avis, ainsi que toutes autres pièces qui servent à la préparation de décisions et d'avis et ne sont pas communiquées aux parties ;
- c)¹³⁵ les pièces concernant la désignation de l'inventeur s'il a renoncé au droit d'être mentionné en tant que tel, en vertu de la règle 18, paragraphe 1 ;
- d)¹³⁶ toute autre pièce exclue de l'inspection publique par le Président de l'Office européen des brevets au motif que sa consultation ne répondrait pas aux fins d'information du public en ce qui concerne la demande de brevet européen ou le brevet européen auquel elle a donné lieu.

Règle 94¹³⁷

Modalités de l'inspection publique

(1) L'inspection publique des dossiers de demandes de brevet européen et de brevets européens porte soit sur les pièces originales, soit sur des copies de ces pièces, soit sur des moyens techniques de stockage de données si les dossiers sont conservés sous cette forme.

(2) Le Président de l'Office européen des brevets arrête toutes les modalités de l'inspection publique, y compris les conditions dans lesquelles il y a lieu d'acquitter une taxe d'administration.

Règle 95

Communication d'informations contenues dans les dossiers

Sous réserve des restrictions prévues à l'article 128, paragraphes 1 à 4 et à la règle 93, l'Office européen des brevets peut, sur requête, communiquer des informations contenues dans les dossiers de demandes de brevet européen ou de brevets européens moyennant le paiement d'une taxe d'administration. Toutefois, l'Office européen des brevets peut exiger qu'il soit fait usage de la possibilité du recours à l'inspection publique du dossier, s'il l'estime opportun en raison de la quantité des informations à fournir.

Verweisungen / References / Références

Art. 24

R. 95

Art. 128

R. 98

¹³⁵ Modifiée par décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

¹³⁶ Cf. la décision du Président de l'OEB du 07.09.2001 concernant les pièces exclues de l'inspection publique (JO OEB 2001, 458 s.).

¹³⁷ Modifiée en dernier lieu par décision du Conseil d'administration en date du 11.10.2000, entrée en vigueur le 02.11.2000 (JO OEB 2000, 473 s.).

Anlage, Führung und Aufbewahrung von Akten

- (1) Zu allen europäischen Patentanmeldungen und Patenten werden vom Europäischen Patentamt Akten angelegt, geführt und aufbewahrt.
- (2) Der Präsident des Europäischen Patentamts bestimmt, in welcher Form die Akten europäischer Patentanmeldungen und Patente angelegt, geführt und aufbewahrt werden.
- (3) In eine elektronische Akte aufgenommene Unterlagen gelten als Originale.
- (4) Die Akten der europäischen Patentanmeldungen und Patente werden für eine Zeitdauer von mindestens fünf Jahren ab dem Ende des Jahres aufbewahrt, in dem
- a) die Anmeldung zurückgewiesen oder zurückgenommen worden ist oder als zurückgenommen gilt oder
 - b) das Patent im Einspruchsverfahren widerrufen worden ist oder
 - c) die Geltungsdauer des Patents oder die verlängerte Laufzeit oder der entsprechende Schutz nach Artikel 63 Absatz 2 im letzten der benannten Staaten abgelaufen ist.
- (5) Unbeschadet Absatz 4 werden die Akten der europäischen Patentanmeldungen, welche Gegenstand von Teilanmeldungen nach Artikel 76 oder einer neuen Anmeldung nach Artikel 61 Absatz 1 Buchstabe b waren, zumindest für dieselbe Zeitdauer wie irgendeine der Akten einer der letztgenannten Anmeldungen aufbewahrt. Das Gleiche gilt für die Akten von europäischen Patenten, die auf Grund dieser Anmeldungen erteilt worden sind.

Regel 96

Weitere Veröffentlichungen des Europäischen Patentamts

- (1) Der Präsident des Europäischen Patentamts kann bestimmen, dass und in welcher Form die in Artikel 128 Absatz 5 vorgesehenen Angaben Dritten mitgeteilt oder veröffentlicht werden.
- (2) Der Präsident des Europäischen Patentamts kann bestimmen, dass und in welcher Form neue oder geänderte Patentansprüche, die nach dem in Regel 49 Absatz 3 genannten Zeitpunkt eingegangen sind, veröffentlicht werden und dass ein Hinweis auf Einzelheiten solcher Ansprüche im Europäischen Patentblatt bekannt gemacht wird.

Constitution, maintenance and preservation of files

- (1) The European Patent Office shall constitute, maintain and preserve files relating to all European patent applications and patents.
- (2) The President of the European Patent Office shall determine the form in which the files relating to European patent applications and patents shall be constituted, maintained and preserved.
- (3) Documents incorporated in an electronic file shall be considered to be originals.
- (4) Files relating to European patent applications and patents shall be preserved for at least five years from the end of the year in which:
- (a) the application is refused or withdrawn or is deemed to be withdrawn;
 - (b) the patent is revoked pursuant to opposition proceedings; or
 - (c) the patent or the extended term or corresponding protection under Article 63, paragraph 2, lapses in the last of the designated States.
- (5) Without prejudice to paragraph 4, files relating to European patent applications which have given rise to divisional applications under Article 76 or new applications under Article 61, paragraph 1(b), shall be preserved for at least the same period as the files relating to any one of these last applications. The same shall apply to files relating to any resulting European patents.

Rule 96

Additional publications by the European Patent Office

- (1) The President of the European Patent Office may provide that, and in what form, the data referred to in Article 128, paragraph 5, shall be communicated to third parties or published.
- (2) The President of the European Patent Office may provide for the publication of new or amended claims received after the time mentioned in Rule 49, paragraph 3, the form of such publication and the entry in the European Patent Bulletin of particulars concerning such claims.

¹³⁸ Geändert durch Beschluss des Verwaltungsrats vom 10.12.1998, in Kraft getreten am 01.01.1999 (ABI. EPA 1999, 1 ff.).

¹³⁸ Amended by decision of the Administrative Council of 10.12.1998 which entered into force on 01.01.1999 (OJ EPO 1999, 1 ff.).

Constitution, tenue et conservation des dossiers

(1) L'Office européen des brevets constitue, tient et conserve des dossiers pour toutes les demandes de brevet européen et tous les brevets européens.

(2) Le Président de l'Office européen des brevets détermine la forme dans laquelle les dossiers de demandes de brevet européen et de brevets européens sont constitués, tenus et conservés.

(3) Les documents incorporés dans un dossier électronique sont considérés comme des originaux.

(4) Les dossiers de demandes de brevet européen et de brevets européens sont conservés pendant cinq années au moins après l'expiration de l'année au cours de laquelle, selon le cas :

a) la demande a été rejetée, retirée ou réputée retirée ;

b) le brevet a été révoqué à la suite d'une procédure d'opposition ;

c) le brevet ou la prolongation de sa durée ou la protection correspondante visée à l'article 63, paragraphe 2 est venu à expiration dans le dernier des Etats désignés.

(5) Sans préjudice des dispositions du paragraphe 4, les dossiers relatifs aux demandes de brevet européen ayant donné lieu au dépôt de demandes divisionnaires au sens de l'article 76, ou à de nouvelles demandes au sens de l'article 61, paragraphe 1, lettre b) sont conservés pendant au moins la même durée que le dossier correspondant à l'une quelconque de ces dernières. Cette disposition est également applicable aux dossiers de brevets européens auxquels les demandes ont pu donner lieu.

Règle 96

Autres publications de l'Office européen des brevets

Art. 129

(1) Le Président de l'Office européen des brevets peut prescrire la communication à des tiers ou la publication des indications visées à l'article 128, paragraphe 5, ainsi que la forme sous laquelle cette communication ou cette publication est faite.

(2) Le Président de l'Office européen des brevets peut prescrire la publication de revendications nouvelles ou modifiées, qui ont été déposées après l'expiration du délai visé à la règle 49, paragraphe 3, et la forme de cette publication, ainsi que la publication au Bulletin européen des brevets d'un avis concernant certains points particuliers de telles revendications.

¹³⁸ Modifiée par décision du Conseil d'administration en date du 10.12.1998, entrée en vigueur le 01.01.1999 (JO OEB 1999, 1 s.).

Verkehr des Europäischen Patentamts mit Behörden der Vertragsstaaten

(1) Bei Mitteilungen, die sich aus der Anwendung des Übereinkommens ergeben, verkehren das Europäische Patentamt und die Zentralbehörden für den gewerblichen Rechtsschutz der Vertragsstaaten unmittelbar miteinander. Das Europäische Patentamt und die Gerichte sowie die übrigen Behörden der Vertragsstaaten können miteinander durch Vermittlung der Zentralbehörde für den gewerblichen Rechtsschutz verkehren.

(2) Die Kosten, die durch die in Absatz 1 genannten Mitteilungen entstehen, sind von der Behörde zu tragen, die die Mitteilungen gemacht hat; diese Mitteilungen sind gebührenfrei.

Akteneinsicht durch Gerichte und Behörden der Vertragsstaaten oder durch deren Vermittlung

(1) Die Einsicht in die Akten einer europäischen Patentanmeldung oder eines europäischen Patents durch Gerichte und Behörden der Vertragsstaaten wird in das Original oder in eine Kopie gewährt; Regel 94 ist nicht anzuwenden.

(2) Gerichte und Staatsanwaltschaften der Vertragsstaaten können in Verfahren, die bei ihnen anhängig sind, Dritten Einsicht in die vom Europäischen Patentamt übermittelten Akten oder Kopien der Akten gewähren. Die Akteneinsicht wird nach Maßgabe des Artikels 128 gewährt; die Verwaltungsgebühr für die Akteneinsicht wird nicht erhoben.

(3) Das Europäische Patentamt weist die Gerichte und Staatsanwaltschaften der Vertragsstaaten bei der Übermittlung der Akten oder Kopien der Akten auf die Beschränkungen hin, denen die Gewährung der Einsicht in die Akten einer europäischen Patentanmeldung oder eines europäischen Patents an Dritte nach Artikel 128 Absätze 1 und 4 unterworfen ist.

Verfahren bei Rechtshilfeersuchen

(1) Jeder Vertragsstaat bestimmt eine zentrale Behörde, die vom Europäischen Patentamt ausgehende Rechtshilfeersuchen entgegenzunehmen und dem zuständigen Gericht oder der zuständigen Behörde zur Erledigung zuzuleiten hat.

Communications between the European Patent Office and the authorities of the Contracting States

(1) Communications between the European Patent Office and the central industrial property offices of the Contracting States which arise out of the application of the Convention shall be effected directly between these authorities. Communications between the European Patent Office and the courts or other authorities of the Contracting States may be effected through the intermediary of the above central industrial property offices.

(2) Expenditure in respect of communications under paragraph 1 shall be chargeable to the authority making the communications, which shall be exempt from fees.

Inspection of files by or via courts or authorities of the Contracting States

(1) Inspection of the files of European patent applications or of European patents by courts or authorities of the Contracting States shall be of the original documents or of copies thereof; Rule 94 shall not apply.

(2) Courts or Public Prosecutors' Offices of the Contracting States may, in the course of their proceedings, communicate to third parties files or copies thereof transmitted to them by the European Patent Office. Such communications shall be effected in accordance with the conditions laid down in Article 128; they shall not incur the payment of the administrative fee.

(3) The European Patent Office shall, at the time of transmission of the files or copies thereof to the courts or Public Prosecutors' Offices of the Contracting States, indicate such restrictions as may, under Article 128, paragraphs 1 and 4, be applicable to the communication to third parties of files concerning a European patent application or a European patent.

Procedure for letters rogatory

(1) Each Contracting State shall designate a central authority which will undertake to receive letters rogatory issued by the European Patent Office and to transmit them to the authority competent to execute them.

Assistance judiciaire et administrative*Règle 97*

Communications entre l'Office européen des brevets et les administrations des Etats contractants

Art. 130, 131

(1) L'Office européen des brevets et les services centraux de la propriété industrielle des Etats contractants correspondent directement lorsque les communications qu'ils échangent découlent de l'application des dispositions de la convention. L'Office européen des brevets et les juridictions ou les autres administrations des Etats contractants peuvent correspondre par l'intermédiaire des services centraux de la propriété industrielle des Etats contractants.

(2) Les frais résultant de toute communication au titre du paragraphe 1 sont à la charge de l'administration qui a fait la communication ; ces communications ne donnent lieu à la perception d'aucune taxe.

Règle 98

Communication de dossiers aux tribunaux et administrations des Etats contractants ou par leur intermédiaire

Art. 131

(1) La communication des dossiers de demandes de brevet européen ou de brevets européens aux tribunaux et administrations des Etats contractants porte soit sur les pièces originales, soit sur des copies de ces pièces ; la règle 94 n'est pas applicable.

(2) Les juridictions et ministères publics des Etats contractants peuvent, au cours de procédures en instance devant eux, communiquer à des tiers les dossiers ou copies de dossiers qui leur sont transmis par l'Office européen des brevets. Ces communications sont faites dans les conditions prévues à l'article 128 ; il n'est pas perçu de taxe d'administration.

(3) L'Office européen des brevets signale aux juridictions et ministères publics des Etats contractants, lorsqu'il leur transmet les dossiers ou copies de ces dossiers, les restrictions auxquelles est soumise, en application de l'article 128, paragraphes 1 et 4, la communication à des tiers du dossier d'une demande de brevet européen ou d'un brevet européen.

Règle 99

Procédure des commissions rogatoires

Art. 117, 131

(1) Chaque Etat contractant désigne une autorité centrale qui assume la charge de recevoir les commissions rogatoires émanant de l'Office européen des brevets et de les transmettre à l'autorité compétente aux fins d'exécution.

(2) Das Europäische Patentamt fasst Rechtshilfeersuchen in der Sprache des zuständigen Gerichts oder der zuständigen Behörde ab oder fügt den Rechtshilfeersuchen eine Übersetzung in dieser Sprache bei.

(3) Vorbehaltlich der Absätze 5 und 6 hat das zuständige Gericht oder die zuständige Behörde bei der Erledigung eines Ersuchens in den Formen zu verfahren, die ihr Recht vorsieht. Sie hat insbesondere geeignete Zwangsmittel nach Maßgabe ihrer Rechtsvorschriften anzuwenden.

(4) Ist das ersuchte Gericht oder die ersuchte Behörde nicht zuständig, so ist das Rechtshilfeersuchen von Amts wegen unverzüglich an die in Absatz 1 genannte zentrale Behörde zurückzusenden. Die zentrale Behörde übermittelt das Rechtshilfeersuchen, wenn ein anderes Gericht oder eine andere Behörde in diesem Staat zuständig ist, diesem Gericht oder dieser Behörde oder, wenn kein Gericht oder keine Behörde in diesem Staat zuständig ist, dem Europäischen Patentamt.

(5) Das Europäische Patentamt ist von Zeit und Ort der durchzuführenden Beweisaufnahme oder der anderen vorzunehmenden gerichtlichen Handlungen zu benachrichtigen und unterrichtet seinerseits die betreffenden Beteiligten, Zeugen und Sachverständigen.

(6) Auf Ersuchen des Europäischen Patentamts gestattet das zuständige Gericht oder die zuständige Behörde die Teilnahme von Mitgliedern des betreffenden Organs und erlaubt diesen, an vernommene Personen über das Gericht oder die Behörde oder unmittelbar Fragen zu richten.

(7) Für die Erledigung von Rechtshilfeersuchen dürfen Gebühren und Auslagen irgendwelcher Art nicht erhoben werden. Der ersuchte Staat ist jedoch berechtigt, von der Organisation die Erstattung der an Sachverständige und an Dolmetscher gezahlten Entschädigung sowie der Auslagen zu verlangen, die durch das Verfahren nach Absatz 6 entstanden sind.

(8) Haben nach dem von dem zuständigen Gericht oder der zuständigen Behörde angewendeten Recht die Beteiligten selbst für die Aufnahme der Beweise zu sorgen und ist das Gericht oder die Behörde zur Erledigung des Rechtshilfeersuchens außer Stande, so kann das Gericht oder die Behörde mit Einverständnis des Europäischen Patentamts eine geeignete Person mit der Erledigung beauftragen. Bei der Einholung des Einverständnisses des Europäischen Patentamts gibt das zuständige Gericht oder die zuständige Behörde die ungefähre Höhe der Kosten an, die durch dieses Verfahren entstehen. Durch das Einverständnis des Europäischen Patentamts wird die Organisation verpflichtet, die entstehenden Kosten zu erstatten; ohne ein solches Einverständnis ist die Organisation zur Zahlung der Kosten nicht verpflichtet.

(2) The European Patent Office shall draw up letters rogatory in the language of the competent authority or shall attach to such letters rogatory a translation into the language of that authority.

(3) Subject to the provisions of paragraphs 5 and 6, the competent authority shall apply its own law as to the procedures to be followed in executing such requests. In particular, it shall apply appropriate measures of compulsion in accordance with its own law.

(4) If the authority to which the letters rogatory are transmitted is not competent to execute them, the letters rogatory shall be sent forthwith to the central authority referred to in paragraph 1. That authority shall transmit the letters rogatory either to the competent authority in that State, or to the European Patent Office where no authority is competent in that State.

(5) The European Patent Office shall be informed of the time when, and the place where, the enquiry or other legal measure is to take place and shall inform the parties, witnesses and experts concerned.

(6) If so requested by the European Patent Office, the competent authority shall permit the attendance of members of the department concerned and allow them to question any person giving evidence either directly or through the competent authority.

(7) The execution of letters rogatory shall not give rise to any reimbursement of fees or costs of any nature. Nevertheless, the State in which letters rogatory are executed has the right to require the Organisation to reimburse any fees paid to experts and interpreters and the costs incurred by the procedure of paragraph 6.

(8) If the law applied by the competent authority obliges the parties to secure evidence and the authority is not able itself to execute the letters rogatory, that authority may, with the consent of the European Patent Office, appoint a suitable person to do so. When seeking the consent of the European Patent Office, the competent authority shall indicate the approximate costs which would result from this procedure. If the European Patent Office gives its consent, the Organisation shall reimburse any costs incurred; without such consent, the Organisation shall not be liable for such costs.

(2) L'Office européen des brevets rédige les commissions rogatoires dans la langue de l'autorité compétente ou joint à ces commissions une traduction dans la langue de ladite autorité.

(3) Sans préjudice des dispositions des paragraphes 5 et 6, l'autorité compétente applique les lois de son pays en ce qui concerne la procédure à suivre pour l'exécution desdites commissions rogatoires. Elle applique notamment les moyens de contrainte appropriés conformément aux lois de son pays.

(4) En cas d'incompétence de l'autorité requise, les commissions rogatoires sont transmises d'office et sans retard à l'autorité centrale prévue au paragraphe 1. Celle-ci transmet les commissions rogatoires, selon le cas, à une autre autorité compétente de cet Etat, ou à l'Office européen des brevets si aucune autorité n'est compétente dans ledit Etat.

(5) L'Office européen des brevets est informé de la date et du lieu où il sera procédé à l'instruction ou à toute autre mesure judiciaire, et il en informe les parties, témoins et experts intéressés.

(6) A la demande de l'Office européen des brevets, l'autorité compétente autorise les membres de l'organisme intéressé à assister à l'exécution et à interroger toute personne faisant une déposition soit directement, soit par l'intermédiaire de ladite autorité.

(7) L'exécution de commissions rogatoires ne peut donner lieu au remboursement de taxes ou de frais de quelque nature que ce soit. Toutefois, l'Etat dans lequel les commissions rogatoires sont exécutées a le droit d'exiger de l'Organisation le remboursement des indemnités payées aux experts et aux interprètes et des frais résultant de l'application de la procédure prévue au paragraphe 6.

(8) Si la loi appliquée par l'autorité compétente laisse aux parties le soin de réunir les preuves, et si ladite autorité n'est pas en mesure d'exécuter elle-même les commissions rogatoires, elle peut, avec le consentement de l'Office européen des brevets, en charger une personne habilitée à cet effet. En demandant le consentement de l'Office européen des brevets, l'autorité compétente indique le montant approximatif des frais qui résulteraient de cette intervention. Le consentement de l'Office européen des brevets implique pour l'Organisation l'obligation de rembourser ces frais ; s'il n'a pas donné son consentement, l'Organisation n'est pas redevable de ces frais.

Bestellung eines gemeinsamen Vertreters

(1) Wird eine europäische Patentanmeldung von mehreren Personen eingereicht und ist im Antrag auf Erteilung eines europäischen Patents kein gemeinsamer Vertreter bezeichnet, so gilt der Anmelder, der im Antrag als Erster genannt ist, als gemeinsamer Vertreter. Ist einer der Anmelder jedoch verpflichtet, einen zugelassenen Vertreter zu bestellen, so gilt dieser Vertreter als gemeinsamer Vertreter, sofern nicht der im Antrag als Erster genannte Anmelder einen zugelassenen Vertreter bestellt hat. Entsprechendes gilt für gemeinsame Patentinhaber und mehrere Personen, die gemeinsam einen Einspruch oder einen Antrag auf Beitritt einreichen.

(2) Erfolgt im Laufe des Verfahrens ein Rechtsübergang auf mehrere Personen und haben diese Personen keinen gemeinsamen Vertreter bezeichnet, so ist Absatz 1 entsprechend anzuwenden. Ist eine entsprechende Anwendung nicht möglich, so fordert das Europäische Patentamt die genannten Personen auf, innerhalb von zwei Monaten einen gemeinsamen Vertreter zu bestellen. Wird dieser Aufforderung nicht entsprochen, so bestimmt das Europäische Patentamt den gemeinsamen Vertreter.

Regel 101

Vollmacht

(1)¹⁴⁰ Die Vertreter vor dem Europäischen Patentamt haben auf Verlangen innerhalb einer vom Europäischen Patentamt zu bestimmenden Frist eine unterzeichnete Vollmacht einzureichen. Der Präsident des Europäischen Patentamts bestimmt, in welchen Fällen zur Einreichung einer Vollmacht aufzufordern ist.¹⁴¹ Die Vollmacht kann sich auf eine oder mehrere europäische Patentanmeldungen oder europäische Patente erstrecken und ist in der entsprechenden Stückzahl einzureichen. Ist den Erfordernissen des Artikels 133 Absatz 2 nicht entsprochen, so wird für die Anzeige über die Bestellung eines Vertreters und die Einreichung der Vollmacht dieselbe Frist gesetzt.

(2) Die Beteiligten können allgemeine Vollmachten einreichen, die einen Vertreter zur Vertretung in allen ihren Patentangelegenheiten bevollmächtigen. Die allgemeine Vollmacht braucht nur in einem Stück eingereicht zu werden.

Appointment of a common representative

(1) If there is more than one applicant and the request for the grant of a European patent does not name a common representative, the applicant first named in the request shall be considered to be the common representative. However, if one of the applicants is obliged to appoint a professional representative this representative shall be considered to be the common representative unless the first named applicant has appointed a professional representative. The same shall apply mutatis mutandis to third parties acting in common in filing notice of opposition or intervention and to joint proprietors of a European patent.

(2) If, during the course of proceedings, transfer is made to more than one person, and such persons have not appointed a common representative, paragraph 1 shall apply. If such application is not possible, the European Patent Office shall require such persons to appoint a common representative within two months. If this request is not complied with, the European Patent Office shall appoint the common representative.

Rule 101

Authorisations

(1)¹⁴⁰ Representatives acting before the European Patent Office shall upon request file a signed authorisation within a period to be specified by the European Patent Office. The President of the European Patent Office shall determine the cases where an authorisation is to be filed.¹⁴¹ The authorisation may cover one or more European patent applications or European patents and shall be filed in the corresponding number of copies. Where the requirements of Article 133, paragraph 2, have not been satisfied, the same period shall be specified for the notification of the appointment of a representative and for the filing of the authorisation.

(2) A general authorisation enabling a representative to act in respect of all the patent transactions of the party making the authorisation may be filed. A single copy shall be sufficient.

¹³⁹ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/99 (Anhang I).

¹⁴⁰ Geändert durch Beschluss des Verwaltungsrats vom 05.07.1991, in Kraft getreten am 01.10.1991 (ABI. EPA 1991, 421 f.).

¹⁴¹ Siehe Beschluss des Präsidenten des EPA vom 19.07.1991 über die Einreichung von Vollmachten (ABI. EPA 1991, 489).

¹³⁹ See decision of the Enlarged Board of Appeal G 3/99 (Annex I).

¹⁴⁰ Amended by decision of the Administrative Council of 05.07.1991 which entered into force on 01.10.1991 (OJ EPO 1991, 421 ff).

¹⁴¹ See decision of the President of 19.07.1991 pursuant to paragraph 1, second sentence (OJ EPO 1991, 489).

Représentation*Règle 100*¹³⁹

Désignation d'un représentant commun

Art. 59, 133

(1) Si une demande est déposée par plusieurs personnes et si la requête en délivrance du brevet européen ne désigne pas de représentant commun, le demandeur cité en premier lieu dans la requête est réputé être le représentant commun. Toutefois, si un des demandeurs est soumis à l'obligation de désigner un mandataire agréé, ce mandataire est considéré comme le représentant commun, à moins que le demandeur cité en premier lieu n'ait lui-même désigné un mandataire agréé. Ces dispositions sont applicables à des tiers intervenant conjointement pour former une opposition ou une requête en intervention ainsi qu'à des cotitulaires d'un brevet européen.

(2) Si, au cours de la procédure, un transfert de droits intervient au profit de plusieurs personnes et si ces personnes n'ont pas désigné de représentant commun, le paragraphe 1 est applicable. Si son application est impossible, l'Office européen des brevets invite les ayants droit à désigner ce représentant commun dans un délai de deux mois. S'il n'est pas déféré à cette invitation, l'Office européen des brevets désigne lui-même le représentant commun.

Règle 101

Pouvoir

Art. 134, 163

(1)¹⁴⁰ Les mandataires agissant devant l'Office européen des brevets déposent auprès de cet Office, sur sa requête et dans un délai imparti par lui, un pouvoir signé. Le Président de l'Office européen des brevets détermine les cas dans lesquels il y a lieu d'exiger le dépôt d'un pouvoir.¹⁴¹ Le pouvoir est donné soit pour une ou plusieurs demandes de brevet européen, soit pour un ou plusieurs brevets européens. Si le pouvoir est donné pour plusieurs demandes de brevets, ou pour plusieurs brevets, il doit en être fourni un nombre correspondant d'exemplaires. Si les exigences de l'article 133, paragraphe 2 ne sont pas remplies, le même délai est imparti pour l'avis de la constitution d'un mandataire et pour le dépôt du pouvoir.

(2) Toute personne peut donner un pouvoir général autorisant un mandataire à la représenter pour toutes les affaires de brevet la concernant. Ce pouvoir peut n'être déposé qu'en un exemplaire.

¹³⁹ Cf. la décision de la Grande Chambre de recours G 3/99 (Annexe I).

¹⁴⁰ Modifié par décision du Conseil d'administration en date du 05.07.1991, entrée en vigueur le 01.10.1991 (JO OEB 1991, 421 s.).

¹⁴¹ Cf. la décision du Président de l'OEB du 19.07.1991 relative au dépôt de pouvoirs (JO OEB 1991, 489).

(3) Der Präsident des Europäischen Patentamts kann Form und Inhalt

a) einer Vollmacht, die die Vertretung von Personen im Sinn des Artikels 133 Absatz 2 betrifft, und

b) einer allgemeinen Vollmacht bestimmen und im Amtsblatt des Europäischen Patentamts bekannt machen.

(4)¹⁴² Wird die Vollmacht nicht rechtzeitig eingereicht, so gelten unbeschadet anderer im Übereinkommen vorgesehener Rechtsfolgen die Handlungen des Vertreters mit Ausnahme der Einreichung einer europäischen Patentanmeldung als nicht erfolgt.

(5) Die Absätze 1 und 2 sind auf Schriftstücke über den Widerruf von Vollmachten entsprechend anzuwenden.

(6) Der Vertreter, dessen Vertretungsmacht erloschen ist, wird weiter als Vertreter angesehen, bis das Erlöschen der Vertretungsmacht dem Europäischen Patentamt angezeigt worden ist.

(7) Sofern die Vollmacht nichts anderes bestimmt, erlischt sie gegenüber dem Europäischen Patentamt nicht mit dem Tod des Vollmachtgebers.

(8)¹⁴³ Hat ein Beteiligter mehrere Vertreter bestellt, so sind diese ungeachtet einer abweichenden Bestimmung in der Anzeige über ihre Bestellung oder in der Vollmacht berechtigt, sowohl gemeinschaftlich als auch einzeln zu handeln.

(9)¹⁴⁴ Die Bevollmächtigung eines Zusammenschlusses von Vertretern gilt als Bevollmächtigung für jeden Vertreter, der den Nachweis erbringt, dass er in diesem Zusammenschluss tätig ist.

(3) The President of the European Patent Office may determine and publish in the Official Journal of the European Patent Office the form and content of:

(a) an authorisation in so far as it relates to the representation of persons as defined in Article 133, paragraph 2;

(b) a general authorisation.

(4)¹⁴² If the authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application shall, without prejudice to any other legal consequences provided for in the Convention, be deemed not to have been taken.

(5) The provisions of paragraphs 1 and 2 shall apply mutatis mutandis to a document withdrawing an authorisation.

(6) Any representative who has ceased to be authorised shall continue to be regarded as the representative until the termination of his authorisation has been communicated to the European Patent Office.

(7) Subject to any provisions to the contrary contained therein, an authorisation shall not terminate vis-à-vis the European Patent Office upon the death of the person who gave it.

(8)¹⁴³ If several representatives are appointed by a party, they may, notwithstanding any provisions to the contrary in the notification of their appointment or in the authorisation, act either jointly or singly.

(9)¹⁴⁴ The authorisation of an association of representatives shall be deemed to be authorisation of any representative who can establish that he practises within that association.

¹⁴² Zuletzt geändert durch Beschluss des Verwaltungsrats vom 05.07.1991, in Kraft getreten am 01.10.1991 (ABI. EPA 1991, 421 f.).

¹⁴³ Geändert durch Beschluss des Verwaltungsrats vom 05.07.1991, in Kraft getreten am 01.10.1991 (ABI. EPA 1991, 421 f.).

¹⁴⁴ Eingefügt durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABI. EPA 1978, 12 ff.). Siehe hierzu die Mitteilung in ABI. EPA 1979, 92.

¹⁴² Last amended by decision of the Administrative Council of 05.07.1991 which entered into force on 01.10.1991 (OJ EPO 1991, 421 ff).

¹⁴³ Amended by decision of the Administrative Council of 05.07.1991 which entered into force on 01.10.1991 (OJ EPO 1991, 421 ff).

¹⁴⁴ Inserted by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff). See communication in OJ EPO 1979, 92.

(3) Le Président de l'Office européen des brevets peut prescrire, par un avis publié au Journal officiel de l'Office européen des brevets, la forme et le contenu :

Verweisungen / References / Références

a) du pouvoir, dans la mesure où il est déposé pour représenter une des personnes visées à l'article 133, paragraphe 2, et

b) du pouvoir général.

(4)¹⁴² Si le pouvoir n'est pas déposé dans les délais, les actes accomplis par le mandataire, à l'exception du dépôt d'une demande de brevet européen, sont réputés non avendus, sans préjudice d'autres conséquences juridiques prévues dans la convention.

(5) Les dispositions des paragraphes 1 et 2 sont applicables à la révocation du pouvoir.

(6) Tout représentant qui a cessé d'être mandaté continue à être considéré comme l'étant, aussi longtemps que la cessation du mandat n'a pas été notifiée à l'Office européen des brevets.

(7) Sauf disposition contraire du pouvoir, celui-ci ne prend pas fin, à l'égard de l'Office européen des brevets, au décès du mandant.

(8)¹⁴³ Si une partie désigne plusieurs mandataires, ceux-ci, nonobstant toute disposition contraire de l'avis de leur constitution ou du pouvoir, peuvent agir soit en commun, soit séparément.

(9)¹⁴⁴ La désignation d'un groupement de mandataires est réputée conférer pouvoir d'agir à tout mandataire qui peut justifier qu'il exerce au sein du groupement.

¹⁴² Modifié en dernier lieu par décision du Conseil d'administration en date du 05.07.1991, entrée en vigueur le 01.10.1991 (JO OEB 1991, 421 s.).

¹⁴³ Modifié par décision du Conseil d'administration en date du 05.07.1991, entrée en vigueur le 01.10.1991 (JO OEB 1991, 421 s.).

¹⁴⁴ Inséré par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.). Cf. la communication publiée au JO OEB 1979, 92.

Änderungen in der Liste der Vertreter

Amendment of the list of professional representatives

(1)¹⁴⁵ Die Eintragung des zugelassenen Vertreters in der Liste der zugelassenen Vertreter wird gelöscht, wenn der zugelassene Vertreter dies beantragt oder trotz wiederholter Mahnung den Jahresbeitrag an das Institut der beim Europäischen Patentamt zugelassenen Vertreter bis zum Ende des Jahres, für das der Beitrag fällig ist, nicht entrichtet hat.

(2)¹⁴⁶ Nach Ablauf der in Artikel 163 Absatz 1 genannten Übergangszeit wird die Eintragung des zugelassenen Vertreters unbeschadet der in Anwendung von Artikel 134 Absatz 8 Buchstabe c getroffenen Disziplinarmaßnahmen von Amts wegen nur gelöscht:

- a) im Fall des Todes oder der fehlenden Geschäftsfähigkeit des zugelassenen Vertreters;
- b) wenn der zugelassene Vertreter nicht mehr die Staatsangehörigkeit eines Vertragsstaats besitzt, sofern er nicht während der Übergangszeit in die Liste eingetragen worden ist oder der Präsident des Europäischen Patentamts nicht eine Befreiung nach Artikel 134 Absatz 6 erteilt hat;
- c) wenn der zugelassene Vertreter seinen Geschäfts- oder Arbeitsplatz nicht mehr in einem Vertragsstaat hat.

(3) Eine Person, deren Eintragung gelöscht worden ist, wird auf Antrag in die Liste der zugelassenen Vertreter wieder eingetragen, wenn die Voraussetzungen für die Löschung entfallen sind.

(1)¹⁴⁵ The entry of a professional representative shall be deleted from the list of professional representatives if he so requests or if, despite repeated reminders, he fails to pay the annual subscription to the Institute of Professional Representatives before the European Patent Office before the end of the year for which the subscription is due.

(2)¹⁴⁶ After the expiry of the transitional period provided for in Article 163, paragraph 1, and without prejudice to any disciplinary measures taken under Article 134, paragraph 8(c), the entry of any professional representative may be deleted automatically in the following cases only:

- (a) in the event of the death or legal incapacity of the professional representative;
- (b) in the event of the professional representative no longer being a national of one of the Contracting States, unless he was entered on the list during the transitional period or was granted exemption by the President of the European Patent Office in accordance with Article 134, paragraph 6;
- (c) in the event of the professional representative no longer having his place of business or employment within the territory of one of the Contracting States.

(3) A person whose entry has been deleted shall, upon request, be re-entered in the list of professional representatives if the conditions for deletion no longer exist.

¹⁴⁵ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 09.12.1993, in Kraft getreten am 09.12.1993 (ABI. EPA 1994, 18 f.).

¹⁴⁶ Geändert durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABI. EPA 1978, 12 ff.).

¹⁴⁵ Last amended by decision of the Administrative Council of 09.12.1993 which entered into force on 09.12.1993 (OJ EPO 1994, 18 ff).

¹⁴⁶ Amended by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff).

Modification de la liste des mandataires agréés

(1)¹⁴⁵ Tout mandataire agréé est radié de la liste des mandataires agréés sur sa requête ou si, en dépit de rappels répétés, il n'a pas acquitté la cotisation annuelle à l'Institut des mandataires agréés près l'Office européen des brevets avant la fin de l'année pour laquelle la cotisation était due.

(2)¹⁴⁶ Après l'expiration de la période transitoire prévue à l'article 163, paragraphe 1, et sans préjudice des mesures disciplinaires prises en application de l'article 134, paragraphe 8, lettre c), tout mandataire agréé ne peut être radié d'office que :

- a) en cas de décès ou d'incapacité ;
- b) s'il ne possède plus la nationalité d'un Etat contractant, à moins qu'il n'ait été inscrit pendant la période transitoire, ou que le Président de l'Office européen des brevets n'ait accordé une dérogation en vertu de l'article 134, paragraphe 6 ;
- c) s'il n'a plus son domicile professionnel ou le lieu de son emploi sur le territoire de l'un des Etats contractants.

(3) Sur sa requête, toute personne radiée fait l'objet d'une nouvelle inscription sur la liste des mandataires agréés si les motifs qui ont conduit à sa radiation n'existent plus.

¹⁴⁵ Modifié en dernier lieu par décision du Conseil d'administration en date du 09.12.1993, entrée en vigueur le 09.12.1993 (JO OEB 1994, 18 s.).

¹⁴⁶ Modifié par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.).

ACHTER TEIL

AUSFÜHRUNGSVORSCHRIFTEN ZUM ACHTEN TEIL DES ÜBEREINKOMMENS ¹⁴⁷

Regel 103

Unterrichtung der Öffentlichkeit bei Umwandlungen

(1) Die Unterlagen, die dem Umwandlungsantrag nach Artikel 136 beizufügen sind, sind der Öffentlichkeit von der Zentralbehörde für den gewerblichen Rechtsschutz unter den gleichen Voraussetzungen und im gleichen Umfang wie die Unterlagen eines nationalen Verfahrens zugänglich zu machen.

(2) Auf den Patentschriften der nationalen Patente, die aus der Umwandlung einer europäischen Patentanmeldung hervorgehen, ist diese Anmeldung anzugeben.

PART VIII

IMPLEMENTING REGULATIONS TO PART VIII OF THE CONVENTION ¹⁴⁷

Rule 103

Information to the public in the event of conversion

(1) The documents which, in accordance with Article 136, accompany the request for conversion shall be communicated to the public by the central industrial property office under the same conditions and to the same extent as documents relating to national proceedings.

(2) The printed specifications of the national patent resulting from the conversion of a European patent application must mention that application.

¹⁴⁷ Überschrift geändert durch Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.).

¹⁴⁷ Heading amended by decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff).

HUITIÈME PARTIE

Verweisungen / References / Références

DISPOSITIONS D'APPLICATION DE LA HUITIÈME PARTIE DE LA CONVENTION ¹⁴⁷

Règle 103

Information du public en cas de transformation

- (1) Les pièces jointes à la requête en transformation, en application de l'article 136, sont mises à la disposition du public par le service central national de la propriété industrielle dans les mêmes conditions et dans les mêmes limites que les pièces relatives à la procédure nationale.
- (2) Le fascicule du brevet national résultant de la transformation d'une demande de brevet européen doit faire mention de cette demande.

¹⁴⁷ Le titre a été modifié par décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

AUSFÜHRUNGSVORSCHRIFTEN ZUM
ZEHNTE TEIL DES ÜBEREINKOMMENS*Regel 104*

Das Europäische Patentamt als Anmeldeamt

(1)¹⁴⁹ Wird das Europäische Patentamt als Anmeldeamt nach dem Zusammenarbeitsvertrag tätig, so ist die internationale Anmeldung in deutscher, englischer oder französischer Sprache einzureichen. Die internationale Anmeldung ist in drei Stücken einzureichen. Das Gleiche gilt für alle Unterlagen, die in der in Regel 3.3a Ziffer ii der Ausführungsordnung zum Zusammenarbeitsvertrag vorgesehenen Kontrollliste genannt sind, mit Ausnahme der Gebührenquittung oder des Schecks für die Gebührenzahlung. Der Präsident des Europäischen Patentamts kann jedoch bestimmen, dass die internationale Anmeldung und alle dazugehörigen Unterlagen in weniger als drei Stücken einzureichen sind.

(2) Wird Absatz 1 Satz 2 nicht entsprochen, so werden die fehlenden Stücke vom Europäischen Patentamt auf Kosten des Anmelders angefertigt.

(3) Wird eine internationale Anmeldung bei einer Behörde eines Vertragsstaats zur Weiterleitung an das Europäische Patentamt als Anmeldeamt eingereicht, so hat der Vertragsstaat dafür zu sorgen, dass die Anmeldung beim Europäischen Patentamt spätestens zwei Wochen vor Ablauf des dreizehnten Monats nach ihrer Einreichung oder, wenn eine Priorität in Anspruch genommen wird, nach dem Prioritätstag eingeht.

Regel 105 ¹⁵⁰Das Europäische Patentamt als Internationale
Recherchenbehörde oder als mit der internationalen
vorläufigen Prüfung beauftragte Behörde

(1) Im Fall des Artikels 17 Absatz 3 Buchstabe a des Zusammenarbeitsvertrags ist für jede weitere Erfindung, für die eine internationale Recherche durchzuführen ist, eine zusätzliche Gebühr in Höhe der Recherchegebühr zu entrichten.

(2) Im Fall des Artikels 34 Absatz 3 Buchstabe a des Zusammenarbeitsvertrags ist für jede weitere Erfindung, für die eine internationale vorläufige Prüfung durchzuführen ist, eine zusätzliche Gebühr in Höhe der Gebühr für die vorläufige Prüfung zu entrichten.

¹⁴⁸ Eingefügt durch Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABI. EPA 1999, 660 ff.).

¹⁴⁹ Geändert durch Beschluss des Verwaltungsrats vom 10.12.1998, in Kraft getreten am 01.01.1999 (ABI. EPA 1999, 1 ff.).

¹⁵⁰ Eingefügt durch Beschluss des Verwaltungsrats vom 20.10.1977, in Kraft getreten am 01.02.1978 (ABI. EPA 1978, 12 ff.). Nummerierung geändert durch Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABI. EPA 1999, 660 ff.).

IMPLEMENTING REGULATIONS TO PART X
OF THE CONVENTION*Rule 104*

The European Patent Office as a receiving Office

(1)¹⁴⁹ When the European Patent Office acts as a receiving Office under the Cooperation Treaty, the international application shall be filed in English, French or German. It shall be filed in three copies; the same applies to any of the documents referred to in the check list provided for in Rule 3.3(a)(ii) of the Regulations under the Cooperation Treaty except the receipt for the fees paid or the cheque for the payment of fees. The President of the European Patent Office may, however, decide that the international application and any related item shall be filed in fewer than three copies.

(2) If the provisions of paragraph 1, second sentence, are not complied with, the missing copies shall be prepared by the European Patent Office at the expense of the applicant.

(3) If an international application is filed with an authority of a Contracting State for transmittal to the European Patent Office as the receiving Office, the Contracting State must ensure that the application reaches the European Patent Office not later than two weeks before the end of the thirteenth month after filing or, if priority is claimed, after the date of priority.

Rule 105 ¹⁵⁰The European Patent Office as an International
Searching Authority or International Preliminary
Examining Authority

(1) In the case of Article 17, paragraph 3(a), of the Cooperation Treaty, an additional fee equal to the amount of the search fee shall be payable for each further invention for which an international search is to be carried out.

(2) In the case of Article 34, paragraph 3(a), of the Cooperation Treaty, an additional fee equal to the amount of the preliminary examination fee shall be payable for each further invention for which the international preliminary examination is to be carried out.

¹⁴⁸ Inserted by decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.).

¹⁴⁹ Amended by decision of the Administrative Council of 10.12.1998 which entered into force on 01.01.1999 (OJ EPO 1999, 1 ff.).

¹⁵⁰ Inserted by decision of the Administrative Council of 20.10.1977 which entered into force on 01.02.1978 (OJ EPO 1978, 12 ff.). The number of this rule was changed by decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.).

**DISPOSITIONS D'APPLICATION DE LA
DIXIÈME PARTIE DE LA CONVENTION***Règle 104*

L'Office européen des brevets agissant en qualité
d'Office récepteur

Art. 151, 152

(1)¹⁴⁹ Lorsque l'Office européen des brevets agit en qualité d'Office récepteur au sens du Traité de Coopération, la demande internationale est déposée en allemand, en anglais ou en français. Elle est déposée en trois exemplaires ; il en est de même pour tout document mentionné dans le bordereau prévu à la règle 3.3a)(ii) du règlement d'exécution du Traité de Coopération, à l'exclusion du reçu pour les taxes payées ou du chèque destiné au paiement des taxes. Toutefois, le Président de l'Office européen des brevets peut décider que la demande internationale et toute pièce y afférente doivent être déposées en moins de trois exemplaires.

(2) S'il n'est pas satisfait aux dispositions du paragraphe 1, deuxième phrase, les exemplaires manquants sont préparés par l'Office européen des brevets aux frais du demandeur.

(3) Si une demande internationale est déposée auprès de l'administration d'un Etat contractant en vue de sa transmission à l'Office européen des brevets agissant en qualité d'Office récepteur, l'Etat contractant doit prendre les dispositions utiles pour que la demande parvienne à l'Office européen des brevets au plus tard deux semaines avant l'expiration du treizième mois suivant son dépôt ou, si une priorité est revendiquée, suivant la date de priorité.

Règle 105 ¹⁵⁰

L'Office européen des brevets agissant en qualité
d'administration chargée de la recherche
internationale ou d'administration chargée de
l'examen préliminaire international

Art. 154, 155

(1) Dans le cas visé à l'article 17, paragraphe 3, lettre a) du Traité de Coopération, une taxe additionnelle égale au montant de la taxe de recherche est due pour chacune des autres inventions devant faire l'objet d'une recherche internationale.

(2) Dans le cas visé à l'article 34, paragraphe 3, lettre a) du Traité de Coopération, une taxe additionnelle égale au montant de la taxe d'examen préliminaire est due pour chacune des autres inventions devant faire l'objet d'un examen préliminaire international.

¹⁴⁸ Insérée par décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

¹⁴⁹ Modifié par décision du Conseil d'administration en date du 10.12.1998, entrée en vigueur le 01.01.1999 (JO OEB 1999, 1 s.).

¹⁵⁰ Insérée par décision du Conseil d'administration en date du 20.10.1977, entrée en vigueur le 01.02.1978 (JO OEB 1978, 12 s.). La numérotation de la règle a été modifiée par décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

(3)¹⁵¹ Ist eine zusätzliche Gebühr unter Widerspruch entrichtet worden, so überprüft das Europäische Patentamt unbeschadet der Regeln 40.2 Absatz e und 68.3 Absatz e der Ausführungsordnung zum Zusammenarbeitsvertrag, ob die Aufforderung zur Zahlung der zusätzlichen Gebühr berechtigt war, und erstattet die zusätzliche Gebühr zurück, wenn dies nach seiner Auffassung nicht der Fall war. Ist das Europäische Patentamt nach dieser Überprüfung der Auffassung, dass die Aufforderung berechtigt war, so unterrichtet es den Anmelder hiervon und fordert ihn zur Entrichtung einer Gebühr für die Prüfung des Widerspruchs ("Widerspruchsgebühr") auf. Wird die Widerspruchsgebühr rechtzeitig entrichtet, so wird der Widerspruch der Beschwerdekammer zur Entscheidung vorgelegt.

*Regel 106*¹⁵²

Die nationale Gebühr

Die nationale Gebühr nach Artikel 158 Absatz 2 setzt sich aus folgenden Gebühren zusammen:

- a) einer der Anmeldegebühr nach Artikel 78 Absatz 2 entsprechenden nationalen Grundgebühr und
- b) den Benennungsgebühren nach Artikel 79 Absatz 2.

Regel 107^{153/154}

Das Europäische Patentamt als Bestimmungsamt oder ausgewähltes Amt - Erfordernisse für den Eintritt in die europäische Phase

(1) Für eine internationale Anmeldung nach Artikel 150 Absatz 3 hat der Anmelder innerhalb von einunddreißig Monaten nach dem Anmeldetag oder, wenn eine Priorität in Anspruch genommen worden ist, nach dem Prioritätstag die folgenden Handlungen vorzunehmen:

- a) die gegebenenfalls nach Artikel 158 Absatz 2 erforderliche Übersetzung der internationalen Anmeldung einzureichen;
- b) die Anmeldungsunterlagen anzugeben, die dem europäischen Erteilungsverfahren in der ursprünglich eingereichten oder in geänderter Fassung zu Grunde zu legen sind;
- c) die nationale Grundgebühr nach Regel 106 Buchstabe a zu entrichten;

¹⁵¹ Eingefügt durch Beschluss des Verwaltungsrats vom 05.06.1992, in Kraft getreten am 01.10.1992 (ABl. EPA 1992, 342 f.).

¹⁵² Die bisherigen Regeln 104b bis 106a wurden durch die neuen Regeln 106 bis 112 ersetzt. Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.).

¹⁵³ Die bisherigen Regeln 104b bis 106a wurden durch die neuen Regeln 106 bis 112 ersetzt. Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.). Regel 107 zuletzt geändert durch Beschluss des Verwaltungsrats vom 28.06.2001, in Kraft getreten am 02.01.2002 (ABl. EPA 2001, 373 f.).

¹⁵⁴ Siehe hierzu Entscheidungen/Stellungnahmen der Großen Beschwerdekammer G 3/91, G 5/93, G 4/98 (Anhang I) und Rechtsauskunft Nr. 5/93 rev. (Anhang II).

(3)¹⁵¹ Without prejudice to Rules 40.2(e) and 68.3(e) of the Regulations under the Cooperation Treaty, where an additional fee has been paid under protest, the European Patent Office shall review whether the invitation to pay the additional fee was justified and, if it does not so find, shall refund the additional fee. If the European Patent Office after such a review considers the invitation to be justified, it shall inform the applicant accordingly and shall invite him to pay a fee for the examination of the protest ("protest fee"). If the protest fee is paid in due time, the protest shall be referred to the Board of Appeal for a decision.

*Rule 106*¹⁵²

The national fee

The national fee provided for in Article 158, paragraph 2, shall comprise the following fees:

- (a) a national basic fee equal to the filing fee provided for in Article 78, paragraph 2, and
- (b) the designation fees provided for in Article 79, paragraph 2.

Rule 107^{153/154}

The European Patent Office as a designated or elected Office - Requirements for entry into the European phase

(1) In the case of an international application as referred to in Article 150, paragraph 3, the applicant must perform the following acts within a period of thirty-one months from the date of filing of the application or, if priority has been claimed, from the priority date:

- (a) supply, where applicable, the translation of the international application required under Article 158, paragraph 2;
- (b) specify the application documents, as originally filed or in amended form, on which the European grant procedure is to be based;
- (c) pay the national basic fee provided for in Rule 106(a);

¹⁵¹ Inserted by decision of the Administrative Council of 05.06.1992 which entered into force on 01.10.1992 (OJ EPO 1992, 342 f.).

¹⁵² Existing Rules 104b to 106a were replaced by new Rules 106 to 112. Decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.).

¹⁵³ Existing Rules 104b to 106a were replaced by new Rules 106 to 112. Decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.). Rule 107 last amended by decision of the Administrative Council of 28.06.2001 which entered into force on 02.01.2002 (OJ EPO 2001, 373 f.).

¹⁵⁴ See decisions/opinions of the Enlarged Board of Appeal G 3/91, G 5/93, G 4/98 (Annex I) and Legal advice No. 5/93 rev. (Annex II).

(3)¹⁵¹ Sans préjudice des règles 40.2e) et 68.3e) du règlement d'exécution du Traité de Coopération, lorsqu'une taxe additionnelle a été acquittée sous réserve, l'Office européen des brevets réexamine si l'invitation à payer la taxe additionnelle était justifiée et, s'il estime que ce n'est pas le cas, rembourse ladite taxe. Si l'Office européen des brevets considère, après un tel réexamen, que l'invitation était justifiée, il en informe le déposant et l'invite à acquitter une taxe pour l'examen de la réserve ("taxe de réserve"). Si la taxe de réserve est acquittée en temps utile, la réserve est soumise à la chambre de recours pour décision.

*Règle 106*¹⁵²

Taxe nationale

La taxe nationale prévue à l'article 158, paragraphe 2 comprend les taxes suivantes :

- a) une taxe nationale de base égale à la taxe de dépôt prévue à l'article 78, paragraphe 2, et
- b) les taxes de désignation prévues à l'article 79, paragraphe 2.

Règle 107^{153/154}

L'Office européen des brevets agissant en qualité d'Office désigné ou élu - Exigences à satisfaire pour l'entrée dans la phase européenne

Verweisungen / References / Références

R. 107

Art. 153, 156
R. 108, 110, 111

(1) Dans le cas d'une demande internationale visée à l'article 150, paragraphe 3, le demandeur doit effectuer les actes énumérés ci-après dans un délai de trente et un mois à compter de la date de dépôt de la demande ou, si une priorité a été revendiquée, de la date de priorité :

- a) remettre, le cas échéant, la traduction de la demande internationale, requise en vertu de l'article 158, paragraphe 2 ;
- b) préciser les pièces de la demande, telles que déposées initialement ou telles que modifiées, sur lesquelles la procédure de délivrance européenne doit se fonder ;
- c) payer la taxe nationale de base prévue à la règle 106, lettre a) ;

¹⁵¹ Inséré par décision du Conseil d'administration en date du 05.06.1992, entrée en vigueur le 01.10.1992 (JO OEB 1992, 342 s.).

¹⁵² Les règles 104ter à 106bis ont été remplacées par les nouvelles règles 106 à 112. Décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

¹⁵³ Les règles 104ter à 106bis ont été remplacées par les nouvelles règles 106 à 112. Décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.). Règle 107 modifiée en dernier lieu par décision du Conseil d'administration en date du 28.06.2001, entrée en vigueur le 02.01.2002 (JO OEB 2001, 373 s.).

¹⁵⁴ Cf. les décisions/avis de la Grande Chambre de recours G 3/91, G 5/93, G 4/98 (Annexe I) et le renseignement juridique n° 5/93 rév. (Annexe II).

d) die Benennungsgebühren zu entrichten, wenn die Frist nach Artikel 79 Absatz 2 früher abläuft;

e) die Recherchegebühr nach Artikel 157 Absatz 2 Buchstabe b zu entrichten, wenn ein ergänzender europäischer Recherchenbericht erstellt werden muss;

f) den Prüfungsantrag nach Artikel 94 zu stellen, wenn die in Artikel 94 Absatz 2 angegebene Frist früher abläuft;

g) die Jahresgebühr für das dritte Jahr nach Artikel 86 Absatz 1 zu entrichten, wenn diese Gebühr nach Regel 37 Absatz 1 früher fällig wird;

h) gegebenenfalls die Ausstellungbescheinigung nach Artikel 55 Absatz 2 und Regel 23 einzureichen.

(2) Hat das Europäische Patentamt einen internationalen vorläufigen Prüfungsbericht erstellt, so wird die Prüfungsgebühr nach Maßgabe der Gebührenordnung ermäßigt. Wurde der Bericht nach Artikel 34 Absatz 3 Buchstabe c des Zusammenarbeitsvertrags für bestimmte Teile der internationalen Anmeldung erstellt, so wird die Ermäßigung nur gewährt, wenn die Prüfung für den im Bericht behandelten Gegenstand durchgeführt werden soll.

Regel 108^{155/156}

Folgen der Nichterfüllung bestimmter Erfordernisse

(1) Wird die Übersetzung der internationalen Anmeldung nicht rechtzeitig eingereicht oder der Prüfungsantrag nicht rechtzeitig gestellt oder wird die nationale Grundgebühr oder die Recherchegebühr nicht rechtzeitig entrichtet oder wird keine Benennungsgebühr rechtzeitig entrichtet, so gilt die europäische Patentanmeldung als zurückgenommen.

(2) Die Benennung eines Vertragsstaats, für den die Benennungsgebühr nicht rechtzeitig entrichtet worden ist, gilt als zurückgenommen.

(3) Stellt das Europäische Patentamt fest, dass die Anmeldung oder die Benennung eines Vertragsstaats nach Absatz 1 oder 2 als zurückgenommen gilt, so teilt es dies dem Anmelder mit. Regel 69 Absatz 2 ist entsprechend anzuwenden. Der Rechtsverlust gilt als nicht eingetreten, wenn innerhalb von zwei Monaten nach Zustellung der Mitteilung nach Satz 1 die versäumte Handlung nachgeholt und eine Zuschlagsgebühr entrichtet wird.

(4)¹⁵⁷ Benennungsgebühren, für die der Anmelder auf Zustellung einer Mitteilung nach Absatz 3 verzichtet hat, können noch innerhalb von zwei Monaten nach Ablauf der betreffenden Frist wirksam entrichtet werden, sofern innerhalb dieser Frist eine Zuschlagsgebühr entrichtet wird.

¹⁵⁵ Die bisherigen Regeln 104b bis 106a wurden durch die neuen Regeln 106 bis 112 ersetzt. Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.), Regel 108 zuletzt geändert durch Beschluss des Verwaltungsrats vom 28.06.2001, in Kraft getreten am 02.01.2002 (ABl. EPA 2001, 374 ff.).

¹⁵⁶ Siehe hierzu Stellungnahme der Großen Beschwerdekammer G 4/98 (Anhang I).

¹⁵⁷ Eingefügt durch Beschluss des Verwaltungsrats vom 09.12.2004, in Kraft getreten am 01.04.2005 (ABl. EPA 2005, 11 f.).

(d) pay the designation fees if the time limit specified in Article 79, paragraph 2, has expired earlier;

(e) pay the search fee provided for in Article 157, paragraph 2(b), where a supplementary European search report has to be drawn up;

(f) file the request for examination provided for in Article 94, if the time limit specified in Article 94, paragraph 2, has expired earlier;

(g) pay the renewal fee in respect of the third year provided for in Article 86, paragraph 1, if the fee has fallen due earlier under Rule 37, paragraph 1;

(h) file, where applicable, the certificate of exhibition referred to in Article 55, paragraph 2, and Rule 23.

(2) Where the European Patent Office has drawn up an international preliminary examination report the examination fee shall be reduced as laid down in the Rules relating to Fees. If the report was established on certain parts of the international application in accordance with Article 34, paragraph 3(c), of the Cooperation Treaty, the reduction shall be allowed only if examination is to be performed on the subject-matter covered by the report.

Rule 108^{155/156}

Consequences of non-fulfilment of certain requirements

(1) If either the translation of the international application or the request for examination is not filed in due time, or if the national basic fee or the search fee is not paid in due time, or if no designation fee is paid in due time, the European patent application shall be deemed to be withdrawn.

(2) The designation of any Contracting State in respect of which the designation fee has not been paid in due time shall be deemed to be withdrawn.

(3) If the European Patent Office notes that the application or the designation of a Contracting State is deemed to be withdrawn under paragraph 1 or 2, it shall communicate this to the applicant. Rule 69, paragraph 2, shall apply *mutatis mutandis*. The loss of rights shall be deemed not to have occurred if, within two months of notification of the communication under sentence 1, the omitted act is completed and a surcharge is paid.

(4)¹⁵⁷ Designation fees in respect of which the applicant has dispensed with notification of the communication under paragraph 3 may still be validly paid within two months of expiry of the applicable time limit, provided that within this period a surcharge is paid.

¹⁵⁵ Existing Rules 104b to 106a were replaced by new Rules 106 to 112. Decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff), Rule 108 last amended by decision of the Administrative Council of 28.06.2001 which entered into force on 02.01.2002 (OJ EPO 2001, 374 ff).

¹⁵⁶ See opinion of the Enlarged Board of Appeal G 4/98 (Annex I).

¹⁵⁷ Inserted by decision of the Administrative Council of 09.12.2004 which entered into force on 01.04.2005 (OJ EPO 2005, 11 f).

d) payer les taxes de désignation si le délai prévu à l'article 79, paragraphe 2 a expiré plus tôt ;

e) payer la taxe de recherche prévue à l'article 157, paragraphe 2, lettre b) lorsqu'un rapport complémentaire de recherche européenne doit être établi ;

f) présenter la requête en examen prévue à l'article 94 si le délai mentionné à l'article 94, paragraphe 2 a expiré plus tôt ;

g) payer la taxe annuelle due pour la troisième année, prévue à l'article 86, paragraphe 1, si cette taxe est exigible plus tôt conformément à la règle 37, paragraphe 1 ;

h) produire, le cas échéant, l'attestation d'exposition visée à l'article 55, paragraphe 2 et à la règle 23.

(2) Lorsque l'Office européen des brevets a établi un rapport d'examen préliminaire international, la taxe d'examen est réduite conformément au règlement relatif aux taxes. Si le rapport a été établi sur certaines parties de la demande internationale, conformément à l'article 34, paragraphe 3), lettre c) du Traité de Coopération, la réduction n'est accordée que si l'examen doit porter sur l'objet couvert par le rapport.

Règle 108^{155/156}

Conséquences de l'inobservation de certaines conditions

Verweisungen / References / Références

R. 106, 107

(1) Si la traduction de la demande internationale n'est pas produite dans les délais, si la requête en examen n'est pas formulée dans les délais, si la taxe nationale de base ou la taxe de recherche n'est pas acquittée dans les délais ou si l'on n'est pas acquitté de taxe de désignation dans les délais, la demande de brevet européen est réputée retirée.

(2) La désignation de tout Etat contractant pour lequel la taxe de désignation n'a pas été acquittée dans les délais est réputée retirée.

(3) Si l'Office européen des brevets constate que la demande ou la désignation d'un Etat contractant est réputée retirée en vertu du paragraphe 1 ou 2, il le notifie au demandeur. La règle 69, paragraphe 2 est applicable. La perte de droits est réputée ne pas s'être produite si, dans un délai de deux mois à compter de la signification de la notification faite conformément à la première phrase, l'acte non accompli l'est et une surtaxe est acquittée.

(4)¹⁵⁷ Les taxes de désignation pour lesquelles le demandeur a renoncé à la signification de la notification prévue au paragraphe 3 peuvent encore être acquittées dans un délai de deux mois à compter de l'expiration du délai applicable, moyennant versement d'une surtaxe dans ce délai.

¹⁵⁵ Les règles 104ter à 106bis ont été remplacées par les nouvelles règles 106 à 112. Décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.). Règle 108 modifiée en dernier lieu par décision du Conseil d'administration en date du 28.06.2001, entrée en vigueur le 02.01.2002 (JO OEB 2001, 374 s.).

¹⁵⁶ Cf. l'avis de la Grande Chambre de recours G 4/98 (Annexe I).

¹⁵⁷ Insérée par décision du Conseil d'administration en date du 09.12.2004, entrée en vigueur le 01.04.2005 (JO OEB 2005, 11 s.).

Änderung der Anmeldung

Unbeschadet Regel 86 Absätze 2 bis 4 kann die Anmeldung innerhalb einer nicht verlängerbaren Frist von einem Monat nach Zustellung einer entsprechenden Mitteilung an den Anmelder einmal geändert werden. Die geänderte Anmeldung wird einer nach Artikel 157 Absatz 2 erforderlichen ergänzenden Recherche zu Grunde gelegt.

Gebührenpflichtige Patentansprüche
Folgen bei Nichtzahlung

(1) Enthalten die Anmeldungsunterlagen, die dem europäischen Erteilungsverfahren zu Grunde zu legen sind, mehr als zehn Ansprüche, so ist für den elften und jeden weiteren Anspruch innerhalb der Frist nach Regel 107 Absatz 1 eine Anspruchsgebühr zu entrichten.

(2) Nicht rechtzeitig entrichtete Anspruchsgebühren können noch innerhalb einer nicht verlängerbaren Nachfrist von einem Monat nach Zustellung einer Mitteilung, in der auf die Nichtzahlung hingewiesen wird, wirksam entrichtet werden. Werden innerhalb dieser Nachfrist geänderte Ansprüche eingereicht, so werden die Anspruchsgebühren auf der Grundlage der geänderten Ansprüche berechnet.

(3) Anspruchsgebühren, die innerhalb der in Absatz 1 genannten Frist entrichtet werden und die nach Absatz 2 Satz 2 fälligen Gebühren übersteigen, werden zurückerstattet.

(4) Wird eine Anspruchsgebühr nicht rechtzeitig entrichtet, so gilt dies als Verzicht auf den entsprechenden Patentanspruch.

Prüfung bestimmter Formerfordernisse durch das
Europäische Patentamt

(1) Sind die in Regel 17 Absatz 1 vorgeschriebenen Angaben über den Erfinder bei Ablauf der in Regel 107 Absatz 1 genannten Frist noch nicht mitgeteilt worden, so wird der Anmelder aufgefordert, die Angaben innerhalb einer vom Europäischen Patentamt zu bestimmenden Frist zu machen.

¹⁵⁸ Die bisherigen Regeln 104b bis 106a wurden durch die neuen Regeln 106 bis 112 ersetzt. Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.).

¹⁵⁹ Die bisherigen Regeln 104b bis 106a wurden durch die neuen Regeln 106 bis 112 ersetzt. Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.).

¹⁶⁰ Die bisherigen Regeln 104b bis 106a wurden durch die neuen Regeln 106 bis 112 ersetzt. Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.).

Amendment of the application

Without prejudice to Rule 86, paragraphs 2 to 4, the application may be amended once, within a non-extendable period of one month as from notification of a communication informing the applicant accordingly. The application as amended shall serve as the basis for any supplementary search which has to be performed under Article 157, paragraph 2.

Claims incurring fees
Consequence of non-payment

(1) If the application documents on which the European grant procedure is to be based comprise more than ten claims, a claims fee shall be payable for the eleventh and each subsequent claim within the period provided for in Rule 107, paragraph 1.

(2) Any claims fees not paid in due time may still be validly paid within a non-extendable period of grace of one month as from notification of a communication pointing out the failure to pay. If within this period amended claims are filed, the claims fees due shall be computed on the basis of such amended claims.

(3) Any claims fees paid within the period provided for in paragraph 1 and which are in excess of those due under paragraph 2, second sentence, shall be refunded.

(4) Where a claims fee is not paid in due time, the claim concerned shall be deemed to be abandoned.

Examination of certain formal requirements by the
European Patent Office

(1) If the data concerning the inventor prescribed in Rule 17, paragraph 1, have not yet been submitted at the expiry of the period provided for in Rule 107, paragraph 1, the European Patent Office shall invite the applicant to furnish the data within such period as it shall specify.

¹⁵⁸ Existing Rules 104b to 106a were replaced by new Rules 106 to 112. Decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.).

¹⁵⁹ Existing Rules 104b to 106a were replaced by new Rules 106 to 112. Decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.).

¹⁶⁰ Existing Rules 104b to 106a were replaced by new Rules 106 to 112. Decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.).

Modification de la demande

Sans préjudice de la règle 86, paragraphes 2 à 4, la demande peut être modifiée une seule fois, dans un délai non reconductible d'un mois à compter de la signification d'une notification en informant le demandeur. La demande modifiée sert de base à toute recherche complémentaire devant être effectuée conformément à l'article 157, paragraphe 2.

Règle 110¹⁵⁹

Revendications donnant lieu au paiement de taxes
Conséquence du non-paiement

(1) Si les pièces de la demande sur lesquelles la procédure de délivrance européenne doit se fonder comportent plus de dix revendications, une taxe de revendication doit être acquittée pour toute revendication en sus de la dixième dans le délai prévu à la règle 107, paragraphe 1.

(2) Les taxes de revendication qui n'ont pas été acquittées dans les délais peuvent encore être valablement acquittées dans un délai supplémentaire non reconductible d'un mois à compter de la signification d'une notification signalant le défaut de paiement. Si des revendications modifiées sont produites dans ce délai, les taxes de revendication exigibles sont calculées sur la base de ces revendications modifiées.

(3) Les taxes de revendication acquittées dans le délai prévu au paragraphe 1 en sus de celles exigibles conformément au paragraphe 2, deuxième phrase sont remboursées.

(4) En cas de défaut de paiement dans les délais d'une taxe de revendication, le demandeur est réputé avoir abandonné la revendication correspondante.

Règle 111¹⁶⁰

Examen de certaines conditions de forme par l'Office
européen des brevets

Art. 62, 81

(1) Si, à l'expiration du délai fixé à la règle 107, paragraphe 1, les renseignements concernant l'inventeur, prévus à la règle 17, paragraphe 1, n'ont pas encore été donnés, l'Office européen des brevets invite le demandeur à lui fournir ces renseignements dans un délai qu'il lui impartit.

¹⁵⁸ Les règles 104ter à 106bis ont été remplacées par les nouvelles règles 106 à 112. Décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

¹⁵⁹ Les règles 104ter à 106bis ont été remplacées par les nouvelles règles 106 à 112. Décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

¹⁶⁰ Les règles 104ter à 106bis ont été remplacées par les nouvelles règles 106 à 112. Décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

(2) Wird die Priorität einer früheren Anmeldung in Anspruch genommen und ist das Aktenzeichen oder die Abschrift nach Artikel 88 Absatz 1 und Regel 38 Absätze 1 bis 3 bei Ablauf der in Regel 107 Absatz 1 genannten Frist noch nicht eingereicht worden, so wird der Anmelder aufgefordert, das Aktenzeichen oder die Abschrift der früheren Anmeldung innerhalb einer vom Europäischen Patentamt zu bestimmenden Frist einzureichen. Regel 38 Absatz 4 ist anzuwenden.

(3) Liegt bei Ablauf der in Regel 107 Absatz 1 genannten Frist ein nach Regel 5.2 der Ausführungsordnung zum Zusammenarbeitsvertrag vorgeschriebenes Sequenzprotokoll dem Europäischen Patentamt nicht vor oder entspricht es nicht dem vorgeschriebenen Standard oder ist es nicht auf dem vorgeschriebenen Datenträger eingereicht worden, so wird der Anmelder aufgefordert, ein dem vorgeschriebenen Standard entsprechendes Sequenzprotokoll oder ein Sequenzprotokoll auf dem vorgeschriebenen Datenträger innerhalb einer vom Europäischen Patentamt zu bestimmenden Frist einzureichen.

*Regel 112*¹⁶¹

Prüfung der Einheitlichkeit durch das Europäische Patentamt

Ist nur für einen Teil der internationalen Anmeldung von der Internationalen Recherchenbehörde eine Recherche durchgeführt worden, weil diese Behörde der Auffassung war, dass die internationale Anmeldung nicht den Anforderungen an die Einheitlichkeit der Erfindung entspricht, und hat der Anmelder nicht alle zusätzlichen Gebühren nach Artikel 17 Absatz 3 Buchstabe a des Zusammenarbeitsvertrags innerhalb der vorgeschriebenen Frist entrichtet, so prüft das Europäische Patentamt, ob die Anmeldung den Anforderungen an die Einheitlichkeit der Erfindung entspricht. Ist das Europäische Patentamt der Auffassung, dass dies nicht der Fall ist, so teilt es dem Anmelder mit, dass für die Teile der internationalen Anmeldung, für die keine Recherche durchgeführt worden ist, ein europäischer Recherchenbericht erstellt werden kann, wenn für jede weitere Erfindung innerhalb einer vom Europäischen Patentamt bestimmten Frist, die nicht kürzer als zwei Wochen sein und sechs Wochen nicht übersteigen darf, eine Recherchengebühr entrichtet wird. Die Recherchenabteilung erstellt einen europäischen Recherchenbericht für die Teile der internationalen Anmeldung, die sich auf die Erfindungen beziehen, für die Recherchengebühren entrichtet worden sind. Regel 46 Absatz 2 ist entsprechend anzuwenden.

(2) Where the priority of an earlier application is claimed and the file number or copy provided for in Article 88, paragraph 1, and Rule 38, paragraphs 1 to 3, have not yet been submitted at the expiry of the period provided for in Rule 107, paragraph 1, the European Patent Office shall invite the applicant to furnish the number or copy of the earlier application within such period as it shall specify. Rule 38, paragraph 4, shall apply.

(3) If at the expiry of the period provided for in Rule 107, paragraph 1, a sequence listing as prescribed in Rule 5.2 of the Regulations under the Cooperation Treaty is not available to the European Patent Office, or does not conform to the prescribed standard, or has not been filed on the prescribed data carrier, the applicant shall be invited to file a sequence listing conforming to the prescribed standard or on the prescribed data carrier within such period as the European Patent Office shall specify.

*Rule 112*¹⁶¹

Consideration of unity by the European Patent Office

If only a part of the international application has been searched by the International Searching Authority because that Authority considered that the application did not comply with the requirement of unity of invention, and the applicant did not pay all additional fees according to Article 17, paragraph 3(a), of the Cooperation Treaty within the prescribed time limit, the European Patent Office shall consider whether the application complies with the requirement of unity of invention. If the European Patent Office considers that this is not the case, it shall inform the applicant that a European search report can be obtained in respect of those parts of the international application which have not been searched if a search fee is paid for each invention involved within a period specified by the European Patent Office which may not be shorter than two weeks and may not exceed six weeks. The Search Division shall draw up a European search report for those parts of the international application which relate to inventions in respect of which search fees have been paid. Rule 46, paragraph 2, shall apply *mutatis mutandis*.

¹⁶¹ Die bisherigen Regeln 104b bis 106a wurden durch die neuen Regeln 106 bis 112 ersetzt. Beschluss des Verwaltungsrats vom 13.10.1999, in Kraft getreten am 01.03.2000 (ABl. EPA 1999, 660 ff.).

¹⁶¹ Existing Rules 104b to 106a were replaced by new Rules 106 to 112. Decision of the Administrative Council of 13.10.1999 which entered into force on 01.03.2000 (OJ EPO 1999, 660 ff.).

(2) Si la priorité d'une demande antérieure est revendiquée et que le numéro de dépôt ou la copie de la demande antérieure prévus à l'article 88, paragraphe 1 et à la règle 38, paragraphes 1, 2 et 3 n'ont pas encore été produits à l'expiration du délai fixé à la règle 107, paragraphe 1, l'Office européen des brevets invite le demandeur à produire le numéro de dépôt ou la copie de la demande antérieure dans un délai qu'il lui impartit. La règle 38, paragraphe 4 est applicable.

(3) Si, à l'expiration du délai fixé à la règle 107, paragraphe 1, une liste de séquences telle que visée à la règle 5.2 du règlement d'exécution du Traité de Coopération n'est pas parvenue à l'Office européen des brevets, ou si elle n'a pas été établie conformément à la norme prescrite, ou si elle n'a pas été déposée sur le support de données prescrit, le demandeur est invité à déposer une liste de séquences établie conformément à la norme prescrite ou sur le support de données prescrit dans un délai que l'Office européen des brevets lui impartit.

*Règle 112*¹⁶¹

Examen de l'unité par l'Office européen des brevets

Art. 82

Lorsqu'une partie seulement de la demande internationale a fait l'objet d'une recherche de la part de l'administration chargée de la recherche internationale, celle-ci ayant estimé que la demande ne satisfait pas à l'exigence d'unité d'invention et que le demandeur n'a pas payé toutes les taxes additionnelles visées à l'article 17, paragraphe 3), lettre a) du Traité de Coopération dans le délai prescrit, l'Office européen des brevets examine si la demande satisfait à l'exigence d'unité d'invention. Dans la négative, l'Office européen des brevets informe le demandeur qu'il peut obtenir un rapport de recherche européenne pour les parties de la demande internationale n'ayant pas fait l'objet d'une recherche en acquittant une taxe de recherche pour chaque invention concernée dans un délai qu'il lui impartit et qui ne peut être inférieur à deux semaines ni supérieur à six semaines. La division de la recherche établit le rapport de recherche européenne pour les parties de la demande internationale qui se rapportent aux inventions pour lesquelles les taxes de recherche ont été acquittées. La règle 46, paragraphe 2 est applicable mutatis mutandis.

¹⁶¹ Les règles 104ter à 106bis ont été remplacées par les nouvelles règles 106 à 112. Décision du Conseil d'administration en date du 13.10.1999, entrée en vigueur le 01.03.2000 (JO OEB 1999, 660 s.).

**PROTOKOLL
ÜBER DIE ZENTRALISIERUNG DES
EUROPÄISCHEN PATENTSYSTEMS UND SEINE EINFÜHRUNG
(ZENTRALISIERUNGSPROTOKOLL)**

vom 5. Oktober 1973

**PROTOCOL
ON THE CENTRALISATION OF THE EUROPEAN PATENT SYSTEM
AND ON ITS INTRODUCTION
(PROTOCOL ON CENTRALISATION)**

of 5 October 1973

**PROTOCOLE
SUR LA CENTRALISATION ET L'INTRODUCTION
DU SYSTÈME EUROPÉEN DES BREVETS
(PROTOCOLE SUR LA CENTRALISATION)**

du 5 octobre 1973

(1)(a) Bei Inkrafttreten des Übereinkommens treffen die Vertragsstaaten des Übereinkommens, die gleichzeitig Mitgliedstaaten des durch das Haager Abkommen vom 6. Juni 1947 errichteten Internationalen Patentinstituts sind, die notwendigen Maßnahmen, um sicherzustellen, dass alle Aktiva und Passiva sowie das gesamte Personal des Internationalen Patentinstituts spätestens zu dem in Artikel 162 Absatz 1 des Übereinkommens vorgesehenen Zeitpunkt auf das Europäische Patentamt übertragen werden. Diese Übertragung erfolgt im Wege eines Vertrags zwischen dem Internationalen Patentinstitut und der Europäischen Patentorganisation. Die oben erwähnten Staaten und die anderen Vertragsstaaten des Übereinkommens treffen die notwendigen Maßnahmen, um sicherzustellen, dass dieser Vertrag spätestens zu dem in Artikel 162 Absatz 1 des Übereinkommens vorgesehenen Zeitpunkt angewendet wird. Die Mitgliedstaaten des Internationalen Patentinstituts, die gleichzeitig Vertragsstaaten des Übereinkommens sind, verpflichten sich ferner, ihre Mitgliedschaft am Haager Abkommen zum Zeitpunkt der Anwendung des Vertrags zu beenden.

(b) Die Vertragsstaaten des Übereinkommens treffen die notwendigen Maßnahmen, um sicherzustellen, dass die Aktiva und Passiva sowie das gesamte Personal des Internationalen Patentinstituts in das Europäische Patentamt nach Maßgabe des unter Buchstabe a erwähnten Vertrags übernommen werden. Das Europäische Patentamt übernimmt von der Anwendung dieses Vertrags an einerseits die Aufgaben, die dem Internationalen Patentinstitut am Tag der Auflage des Übereinkommens zur Unterzeichnung obliegen, insbesondere diejenigen, die es zu diesem Zeitpunkt gegenüber seinen Mitgliedstaaten wahrnimmt, wobei es unerheblich ist, ob diese Staaten Vertragsstaaten des Übereinkommens werden oder nicht, und andererseits die Aufgaben, zu deren Wahrnehmung es sich bei Inkrafttreten des Übereinkommens gegenüber Staaten verpflichtet hat, die in diesem Zeitpunkt sowohl Mitgliedstaaten des Internationalen Patentinstituts als auch Vertragsstaaten des Übereinkommens sind. Außerdem kann der Verwaltungsrat der Europäischen Patentorganisation dem Europäischen Patentamt weitere Aufgaben auf dem Gebiet der Recherche übertragen.

(c) Die oben genannten Verpflichtungen beziehen sich sinngemäß auch auf die gemäß dem Haager Abkommen geschaffene Dienststelle unter den im Abkommen zwischen dem Internationalen Patentinstitut und der Regierung des beteiligten Vertragsstaats vorgesehenen Bedingungen. Diese Regierung verpflichtet sich, mit der Europäischen Patentorganisation ein neues Abkommen, das das bereits bestehende Abkommen mit dem Internationalen Patentinstitut ablöst, zu schließen, um die Bestimmungen über die Organisation, die Tätigkeit und die Finanzierung der Dienststelle mit diesem Protokoll in Einklang zu bringen.

(1)(a) Upon entry into force of the Convention, States parties thereto which are also members of the International Patent Institute set up by the Hague Agreement of 6 June 1947 shall take all necessary steps to ensure the transfer to the European Patent Office no later than the date referred to in Article 162, paragraph 1, of the Convention of all assets and liabilities and all staff members of the International Patent Institute. Such transfer shall be effected by an agreement between the International Patent Institute and the European Patent Organisation. The above States and the other States parties to the Convention shall take all necessary steps to ensure that that agreement shall be implemented no later than the date referred to in Article 162, paragraph 1, of the Convention. Upon implementation of the agreement, those Member States of the International Patent Institute which are also parties to the Convention further undertake to terminate their participation in the Hague Agreement.

(b) The States parties to the Convention shall take all necessary steps to ensure that all the assets and liabilities and all the staff members of the International Patent Institute are taken into the European Patent Office in accordance with the agreement referred to in subparagraph (a). After the implementation of that agreement the tasks incumbent upon the International Patent Institute at the date on which the Convention is opened for signature, and in particular those carried out vis-à-vis its Member States, whether or not they become parties to the Convention, and such tasks as it has undertaken at the time of the entry into force of the Convention to carry out vis-à-vis States which, at that date, are both members of the International Patent Institute and parties to the Convention, shall be assumed by the *European Patent Office*. In addition, the Administrative Council of the European Patent Organisation may allocate further duties in the field of searching to the *European Patent Office*.

(c) The above obligations shall also apply mutatis mutandis to the sub-office set up under the Hague Agreement under the conditions set out in the agreement between the International Patent Institute and the Government of the Contracting State concerned. This Government hereby undertakes to make a new agreement with the European Patent Organisation in place of the one already made with the International Patent Institute to harmonise the clauses concerning the organisation, operation and financing of the sub-office with the provisions of this Protocol.

¹ Geändert durch die Akte zur Revision des Europäischen Patentübereinkommens vom 29.11.2000, vorläufig anwendbar ab 29.11.2000 (ABI. EPA 2001, Sonderausgabe Nr. 4).

¹ Amended by the Act revising the European Patent Convention of 29.11.2000, provisionally applicable as of 29.11.2000 (OJ EPO 2001, Special edition No. 4).

*Section I*¹

(1)(a) A la date d'entrée en vigueur de la convention, les Etats parties à la convention qui sont également membres de l'Institut International des Brevets créé par l'Accord de La Haye du 6 juin 1947, prennent toutes les mesures nécessaires pour que le transfert à l'Office européen des brevets de tout l'actif et de tout le passif ainsi que de tout le personnel de l'Institut International des Brevets s'effectue au plus tard à la date visée à l'article 162, paragraphe 1, de la convention. Les modalités de ce transfert seront fixées par un accord entre l'Institut International des Brevets et l'Organisation européenne des brevets. Les Etats susvisés ainsi que les autres Etats parties à la convention prennent toutes les mesures nécessaires pour que cet accord soit mis en application au plus tard à la date visée à l'article 162, paragraphe 1, de la convention. A la date de cette mise en application, les Etats membres de l'Institut International des Brevets qui sont également parties à la convention s'engagent en outre à mettre fin à leur participation à l'Accord de La Haye.

(b) Les Etats parties à la convention prennent toutes les mesures nécessaires pour que, conformément à l'accord visé à la lettre (a), tout l'actif et tout le passif ainsi que tout le personnel de l'Institut International des Brevets soient incorporés dans l'Office européen des brevets. Dès la mise en application de cet accord, seront accomplies par l'*Office européen des brevets*, d'une part, les tâches assumées par l'Institut International des Brevets à la date de l'ouverture à la signature de la convention, en particulier celles qu'il assume à l'égard de ses Etats membres, qu'ils deviennent ou non parties à la convention, d'autre part, les tâches qu'il se sera engagé à assumer lors de l'entrée en vigueur de la convention à l'égard d'Etats qui seront à cette date à la fois membres de l'Institut International des Brevets et parties à la convention. En outre, le Conseil d'administration de l'Organisation européenne des brevets peut charger l'*Office européen des brevets* d'autres tâches dans le domaine de la recherche.

(c) Les engagements visés ci-dessus s'appliquent également à l'agence créée en vertu de l'Accord de La Haye et selon les conditions fixées dans l'accord conclu entre l'Institut International des Brevets et le gouvernement de l'Etat contractant concerné. Ce gouvernement s'engage à conclure avec l'Organisation européenne des brevets un nouvel accord remplaçant celui déjà conclu avec l'Institut International des Brevets pour harmoniser les clauses relatives à l'organisation, au fonctionnement et au financement de l'agence avec les dispositions du présent protocole.

ZENTRALISIERUNGSPROTOKOLL
Abschnitt I

PROTOCOL ON CENTRALISATION
Section I

PROTOCOLE SUR LA CENTRALISATION
Section I

¹ Modifié par l'acte portant révision de la Convention sur le brevet européen en date du 29.11.2000, applicable à titre provisoire à partir du 29.11.2000 (JO OEB 2001, édition spéciale n° 4).

(2) Die Vertragsstaaten des Übereinkommens verzichten zu dem in Artikel 162 Absatz 1 des Übereinkommens genannten Zeitpunkt vorbehaltlich des Abschnitts III für ihre Zentralbehörden für den gewerblichen Rechtsschutz zu Gunsten des Europäischen Patentamts auf die Tätigkeit als Internationale Recherchenbehörde nach dem Zusammenarbeitsvertrag.

(3)(a) Zu dem in Artikel 162 Absatz 1 des Übereinkommens genannten Zeitpunkt wird in Berlin [...] eine Dienststelle des Europäischen Patentamts errichtet. Diese Dienststelle untersteht der Zweigstelle in Den Haag.

(b) Der Verwaltungsrat legt die Befugnisse der Dienststelle Berlin unter Berücksichtigung allgemeiner Erwägungen und der Bedürfnisse des Europäischen Patentamts [...] fest.

(c) Zumindest am Anfang des Zeitabschnitts nach der stufenweisen Ausdehnung des Tätigkeitsbereichs des Europäischen Patentamts muss der Umfang der dieser Dienststelle übertragenen Arbeiten eine volle Auslastung des im Zeitpunkt der Auflage des Übereinkommens zur Unterzeichnung bei der Dienststelle Berlin des Deutschen Patentamts beschäftigten Prüferpersonals ermöglichen.

(d) Die Bundesrepublik Deutschland übernimmt die zusätzlichen Kosten, die der Europäischen Patentorganisation aus der Errichtung und dem Betrieb der Dienststelle Berlin entstehen.

Abschnitt II

Die Vertragsstaaten des Übereinkommens verzichten vorbehaltlich der Abschnitte III und IV für ihre Zentralbehörden für den gewerblichen Rechtsschutz zu Gunsten des Europäischen Patentamts auf die Tätigkeit als mit der internationalen vorläufigen Prüfung beauftragte Behörde nach dem Zusammenarbeitsvertrag. Diese Verpflichtung wird nur in dem Umfang, in dem das Europäische Patentamt nach Artikel 162 Absatz 2 des Übereinkommens die Prüfung europäischer Patentanmeldungen durchführen kann, wirksam; diese Wirkung tritt zwei Jahre nach dem Zeitpunkt ein, zu dem das Europäische Patentamt nach einem Fünfjahresplan, der die Zuständigkeit des Amts stufenweise auf alle Gebiete der Technik ausdehnt und nur durch einen Beschluss des Verwaltungsrats geändert werden kann, seine Prüfungstätigkeit auf die betreffenden Gebiete der Technik ausgedehnt hat. Die Einzelheiten der Erfüllung der genannten Verpflichtung werden durch Beschluss des Verwaltungsrats festgelegt.

(2) Subject to the provisions of Section III, the States parties to the Convention shall, on behalf of their central industrial property offices, renounce in favour of the European Patent Office any activities as International Searching Authorities under the Patent Cooperation Treaty as from the date referred to in Article 162, paragraph 1, of the Convention.

(3)(a) A sub-office of the European Patent Office [...] shall be set up in Berlin [...] as from the date referred to in Article 162, paragraph 1, of the Convention. It shall operate under the direction of the branch at The Hague.

(b) The Administrative Council shall determine the duties to be allocated to the sub-office in Berlin in the light of general considerations and of the requirements of the European Patent Office [...].

(c) At least at the beginning of the period following the progressive expansion of the field of activity of the European Patent Office, the amount of work assigned to that sub-office shall be sufficient to enable the examining staff of the Berlin Annex of the German Patent Office, as it stands at the date on which the Convention is opened for signature, to be fully employed.

(d) The Federal Republic of Germany shall bear any additional costs incurred by the European Patent Organisation in setting up and maintaining the sub-office in Berlin.

Section II

Subject to the provisions of Sections III and IV, the States parties to the Convention shall, on behalf of their central industrial property offices, renounce in favour of the European Patent Office any activities as International Preliminary Examining Authorities under the Patent Cooperation Treaty. This obligation shall apply only to the extent to which the European Patent Office may examine European patent applications in accordance with Article 162, paragraph 2, of the Convention and shall not apply until two years after the date on which the European Patent Office has begun examining activities in the areas of technology concerned, on the basis of a five-year plan which shall progressively extend the activities of the European Patent Office to all areas of technology and which may be amended only by decision of the Administrative Council. The procedures for implementing this obligation shall be determined by decision of the Administrative Council.

(2) Sous réserve des dispositions de la section III, les Etats parties à la convention renoncent, pour leurs services centraux de la propriété industrielle et au profit de l'Office européen des brevets, à toute activité qu'ils seraient susceptibles d'exercer en qualité d'administration chargée de la recherche au sens du Traité de Coopération en matière de brevets, dès la date visée à l'article 162, paragraphe 1 de la convention.

(3)(a) Une agence de l'Office européen des brevets est créée à Berlin [...], à compter de la date visée à l'article 162, paragraphe 1, de la convention [...]. Elle relève du département de La Haye.

(b) Le Conseil d'administration fixe la répartition des tâches de l'agence de Berlin, compte tenu de considérations générales et des besoins de l'Office européen des brevets [...].

(c) Au moins au début de la période suivant l'extension progressive du champ d'activité de l'Office européen des brevets, le volume des travaux confiés à cette agence doit permettre d'occuper pleinement le personnel examinateur de l'annexe de Berlin de l'Office allemand des brevets en fonction à la date d'ouverture à la signature de la convention.

(d) La République fédérale d'Allemagne supporte tous les frais supplémentaires résultant, pour l'Organisation européenne des brevets, de la création et du fonctionnement de l'agence de Berlin.

Section II

Sous réserve des dispositions des sections III et IV, les Etats parties à la convention renoncent, pour ce qui concerne leurs services centraux de la propriété industrielle et au profit de l'Office européen des brevets, à toute activité en qualité d'administration chargée de l'examen préliminaire international au sens du Traité de Coopération. Cette obligation ne prendra effet que dans la mesure où l'Office européen des brevets pourra entreprendre l'examen des demandes de brevet européen en vertu de l'article 162, paragraphe 2, de la convention ; cet effet intervient deux années après le jour où l'Office européen des brevets a commencé son activité d'examen sur les domaines de la technique en question, d'après un plan de cinq ans, étendant progressivement la compétence de l'Office à tous les secteurs de la technique et qui ne peut être modifié que par décision du Conseil d'administration. Les modalités de mise en application de ladite obligation sont déterminées par décision du Conseil d'administration.

ZENTRALISIERUNGSPROTOKOLL *Abschnitt II*

PROTOCOL ON CENTRALISATION *Section II*

PROTOCOLE SUR LA CENTRALISATION *Section II*

(1) Die Zentralbehörde für den gewerblichen Rechtsschutz jedes Vertragsstaats des Übereinkommens, dessen Amtssprache nicht eine der Amtssprachen des Europäischen Patentamts ist, ist berechtigt, eine Tätigkeit als Internationale Recherchenbehörde und als mit der internationalen vorläufigen Prüfung beauftragte Behörde nach dem Zusammenarbeitsvertrag auszuüben. Die Inanspruchnahme dieses Rechts setzt die Verpflichtung des betreffenden Staats voraus, diese Tätigkeit auf internationale Anmeldungen zu beschränken, die von Staatsangehörigen des betreffenden Staats, von Personen mit Wohnsitz oder Sitz im Hoheitsgebiet dieses Staats, von Staatsangehörigen eines diesem Übereinkommen angehörenden Nachbarstaats dieses Staats oder von Personen, die in einem solchen Nachbarstaat ihren Wohnsitz oder Sitz haben, eingereicht werden. Der Verwaltungsrat kann der Zentralbehörde für den gewerblichen Rechtsschutz eines Vertragsstaats durch Beschluss gestatten, die genannte Tätigkeit auf solche internationale Anmeldungen auszudehnen, die von Staatsangehörigen oder von Personen mit Wohnsitz oder Sitz im Hoheitsgebiet eines Nichtvertragsstaats, der die gleiche Amtssprache wie der betreffende Vertragsstaat hat, eingereicht werden und die in dieser Sprache abgefasst sind.

(2) Im Hinblick auf eine Harmonisierung der nach dem Zusammenarbeitsvertrag vorgesehenen Recherchertätigkeiten im Rahmen des europäischen Patenterteilungssystems wird eine Zusammenarbeit zwischen dem Europäischen Patentamt und den nach diesem Abschnitt zugelassenen Zentralbehörden für den gewerblichen Rechtsschutz hergestellt. Diese Zusammenarbeit erfolgt auf Grund einer besonderen Vereinbarung, die sich zum Beispiel erstrecken kann auf Rechercheverfahren und -methoden, die Anforderungen für die Einstellung und Ausbildung von Prüfern, Richtlinien für den Austausch von Recherchen und anderen Diensten zwischen den Behörden sowie andere, zur Sicherstellung der erforderlichen Kontrolle und Überwachung notwendige Maßnahmen.

Abschnitt IV

Section IV

(1)(a) Um den nationalen Patentämtern der Vertragsstaaten des Übereinkommens die Anpassung an das europäische Patentsystem zu erleichtern, kann der Verwaltungsrat, wenn er es für wünschenswert hält, unter den nachstehend festgelegten Bedingungen den Zentralbehörden für den gewerblichen Rechtsschutz dieser Staaten, in denen das Verfahren in einer der Amtssprachen des Europäischen Patentamts durchgeführt werden kann, die Bearbeitung der europäischen Patentanmeldungen, die in der betreffenden Sprache abgefasst sind, übertragen, soweit nach Artikel 18 Absatz 2 des Übereinkommens in der Regel ein Prüfer der Prüfungsabteilung beauftragt wird. Diese Aufgaben sind im Rahmen des im Übereinkommen vorgesehenen Erteilungsverfahrens durchzuführen; die Entscheidung über diese Anmeldungen trifft die Prüfungsabteilung in ihrer nach Artikel 18 Absatz 2 vorgesehenen Zusammensetzung.

(1) The central industrial property office of any State party to the Convention in which the official language is not one of the official languages of the European Patent Office, shall be authorised to act as an International Searching Authority and as an International Preliminary Examining Authority under the Patent Cooperation Treaty. Such authorisation shall be subject to an undertaking by the State concerned to restrict such activities to international applications filed by nationals or residents of such State and by nationals or residents of States parties to the Convention which are adjacent to that State. The Administrative Council may decide to authorise the central industrial property office of any State party to the Convention to extend such activities to cover such international applications as may be filed by nationals or residents of any non-Contracting State having the same official language as the Contracting State in question and drawn up in that language.

(2) For the purpose of harmonising search activities under the Patent Cooperation Treaty within the framework of the European system for the grant of patents, co-operation shall be established between the European Patent Office and any central industrial property office authorised under this Section. Such co-operation shall be based on a special agreement which may cover e.g. search procedures and methods, qualifications required for the recruitment and training of examiners, guidelines for the exchange of search and other services between the offices as well as other measures needed to establish the required control and supervision.

(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.

Section III

(1) Le service central de la propriété industrielle de tout Etat partie à la convention, dont la langue officielle n'est pas l'une des langues officielles de l'Office européen des brevets, est autorisé à exercer une activité en qualité d'administration chargée de la recherche et en qualité d'administration chargée de l'examen préliminaire au sens du Traité de Coopération. Cette autorisation est subordonnée à l'engagement de l'Etat en cause de limiter cette activité aux demandes internationales déposées par les nationaux dudit Etat ou par les personnes domiciliées sur son territoire ainsi que par les nationaux ou les personnes domiciliées sur le territoire d'Etats parties à la convention et qui sont limitrophes de cet Etat. Le Conseil d'administration peut décider d'autoriser le service central de la propriété industrielle d'un Etat partie à la convention à étendre cette activité aux demandes internationales qui sont déposées par des nationaux ou des personnes ayant leur domicile ou leur siège sur le territoire d'un Etat non contractant ayant la même langue officielle que l'Etat partie en cause et qui sont rédigées dans cette langue.

(2) En vue d'harmoniser les activités de recherche au titre du Traité de Coopération dans le cadre du système européen de délivrance de brevets, il est établi une coopération entre l'Office européen des brevets et tout service central de la propriété industrielle autorisé à exercer une telle activité en vertu de la présente section. Cette coopération est fondée sur un accord spécial qui peut s'étendre, par exemple, aux procédures et méthodes de recherche, aux qualifications requises en ce qui concerne le recrutement et la formation des examinateurs, aux directives relatives aux échanges de recherche et d'autres services entre les offices, ainsi qu'aux autres mesures nécessaires au contrôle et à la surveillance.

Section IV

(1)(a) En vue de faciliter l'adaptation des offices nationaux des Etats parties à la convention au système du brevet européen, le Conseil d'administration peut, s'il le juge souhaitable, et dans les conditions définies ci-après, confier aux services centraux de la propriété industrielle de ces mêmes Etats, où l'on est en mesure de conduire la procédure dans une des langues officielles de l'Office européen des brevets, des tâches d'instruction des demandes de brevet européen rédigées dans cette même langue qui, conformément à l'article 18, paragraphe 2, de la convention, sont confiées en règle générale à l'un des examinateurs de la division d'examen. Ces travaux sont effectués dans le cadre de la procédure de délivrance prévue dans la convention; la décision relative à ces demandes est prise par la division d'examen dans sa composition prévue à l'article 18, paragraphe 2.

ZENTRALISIERUNGSPROTOKOLL *Abschnitt III*

PROTOCOL ON CENTRALISATION *Section III*

PROTOCOLE SUR LA CENTRALISATION *Section III*

(b) Die nach Maßgabe des Buchstabens a übertragenen Arbeiten dürfen nicht mehr als 40 % der Gesamtzahl der eingereichten europäischen Patentanmeldungen betragen; die einem einzelnen Staat übertragenen Arbeiten dürfen nicht mehr als ein Drittel der Gesamtzahl der eingereichten europäischen Patentanmeldungen betragen. Diese Arbeiten werden für einen Zeitraum übertragen, der von der Aufnahme der Tätigkeit des Europäischen Patentamts an gerechnet 15 Jahre beträgt, und werden während der letzten 5 Jahre schrittweise (um grundsätzlich 20 % jährlich) bis auf Null verringert.

(c) Auf Grund des Buchstabens b beschließt der Verwaltungsrat über die Art, den Ursprung und die Anzahl der europäischen Patentanmeldungen, mit deren Bearbeitung die Zentralbehörde für den gewerblichen Rechtsschutz eines der genannten Vertragsstaaten beauftragt werden kann.

(d) Die vorstehenden Durchführungsbestimmungen werden in ein besonderes Abkommen aufgenommen, das zwischen der Zentralbehörde für den gewerblichen Rechtsschutz des betreffenden Vertragsstaats und der Europäischen Patentorganisation geschlossen wird.

(e) Ein Patentamt, mit dem ein solches besonderes Abkommen geschlossen worden ist, kann bis zum Ablauf des Zeitraums von 15 Jahren eine Tätigkeit als eine mit der internationalen vorläufigen Prüfung beauftragte Behörde nach dem Zusammenarbeitsvertrag ausüben.

(2)(a) Ist der Verwaltungsrat der Auffassung, dass dies mit dem guten Funktionieren des Europäischen Patentamts vereinbar ist, so kann er, um Schwierigkeiten abzuwehren, die für bestimmte Vertragsstaaten aus der Anwendung von Abschnitt I Nummer 2 erwachsen können, den Zentralbehörden für den gewerblichen Rechtsschutz dieser Staaten die Aufgabe übertragen, Recherchen für europäische Patentanmeldungen durchzuführen, sofern deren Amtssprache eine der Amtssprachen des Europäischen Patentamts ist und diese Behörden die Voraussetzungen erfüllen, um gemäß den im Zusammenarbeitsvertrag vorgesehenen Bedingungen als internationale Recherchenbehörde ernannt zu werden.

(b) Bei diesen Arbeiten, die unter der Verantwortung des Europäischen Patentamts durchgeführt werden, hat sich die betreffende Zentralbehörde an die für die Erstellung des europäischen Recherchenberichts geltenden Richtlinien zu halten.

(c) Nummer 1 Buchstabe b Satz 2 und Buchstabe d ist entsprechend anzuwenden.

(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 5 years of the period.

(c) The Administrative Council shall decide, while taking into account the provisions of sub-paragraph (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.

(d) The above implementing procedures shall be set out in a special agreement between the central industrial property office of the Contracting State concerned and the European Patent Organisation.

(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.

(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.

(c) The provisions of paragraph 1(b), second sentence, and sub-paragraph (d) of this Section shall apply to this paragraph.

(b) Les travaux confiés en vertu de la lettre (a) ne porteront pas sur plus de quarante pour cent du total des demandes de brevet européen déposées ; les travaux confiés à un Etat ne devront pas excéder un tiers du total des demandes de brevet européen déposées. Ces tâches seront confiées pour une période de quinze ans à compter de l'ouverture de l'Office européen des brevets et seront réduites progressivement (en principe de vingt pour cent par an) jusqu'à devenir nulles au cours des cinq dernières années de ladite période.

(c) Compte tenu de la lettre (b), le Conseil d'administration décidera de la nature, de l'origine et du nombre des demandes de brevet européen dont l'instruction pourra être confiée au service central de la propriété industrielle de l'un des Etats parties susvisés.

(d) Les modalités d'application ci-dessus feront l'objet d'un accord spécial entre le service central de la propriété industrielle de l'Etat partie en cause et l'Organisation européenne des brevets.

(e) Un office avec lequel un tel accord spécial a été conclu pourra exercer une activité en qualité d'administration chargée de l'examen préliminaire international, au sens du Traité de Coopération, jusqu'à expiration de la période de quinze ans.

(2)(a) Si le Conseil d'administration estime que cela est compatible avec le bon fonctionnement de l'Office européen des brevets et en vue de pallier les difficultés pouvant résulter pour certains Etats contractants de l'application de la section I, paragraphe 2, il peut confier des travaux de recherche relatifs à des demandes de brevet européen aux services centraux de la propriété industrielle de ces Etats dont la langue officielle est l'une des langues officielles de l'Office européen des brevets, à condition que ces services possèdent la qualification requise pour être nommés administration de recherche internationale dans les conditions prévues au Traité de Coopération.

(b) En procédant à ces travaux, effectués sous la responsabilité de l'Office européen des brevets, les services centraux concernés doivent s'en tenir aux directives applicables en matière d'établissement du rapport de recherche européenne.

(c) Les dispositions de la présente section, paragraphe 1, lettre (b), deuxième phrase, s'appliquent au présent paragraphe.

ZENTRALISIERUNGSPROTOKOLL
Abschnitt IV

PROTOCOL ON CENTRALISATION
Section IV

PROTOCOLE SUR LA CENTRALISATION
Section IV

Abschnitt V

(1) Die in Abschnitt I Nummer 1 Buchstabe c genannte Dienststelle ist berechtigt, für europäische Patentanmeldungen, die von Angehörigen des Staats, in dem die Dienststelle ihren Sitz hat, und von Personen mit Wohnsitz oder Sitz in diesem Staat eingereicht werden, eine Recherche in der ihr zur Verfügung stehenden Dokumentation durchzuführen, soweit diese in der Amtssprache dieses Staates abgefasst ist. Hierdurch darf jedoch weder das Europäische Patenterteilungsverfahren verzögert werden, noch dürfen der Europäischen Patentorganisation zusätzliche Kosten entstehen.

(2) Die in Nummer 1 genannte Dienststelle ist berechtigt, auf Antrag und auf Kosten des Anmelders eines europäischen Patents eine Recherche für die von ihm eingereichte Patentanmeldung in der unter Nummer 1 vorgesehenen Dokumentation durchzuführen. Die Berechtigung gilt, solange die in Artikel 92 des Übereinkommens vorgesehene Recherche nicht gemäß Abschnitt VI auf diese Dokumentation ausgedehnt worden ist; doch darf dadurch das europäische Patenterteilungsverfahren nicht verzögert werden.

(3) Der Verwaltungsrat kann die in den Nummern 1 und 2 vorgesehenen Berechtigungen unter den in den genannten Nummern vorgesehenen Voraussetzungen auch auf Zentralbehörden für den gewerblichen Rechtsschutz der Vertragsstaaten ausdehnen, die als Amtssprache keine der Amtssprachen des Europäischen Patentamts haben.

Abschnitt VI

Die in Artikel 92 des Übereinkommens vorgesehene Recherche wird grundsätzlich für alle europäischen Patentanmeldungen auf Patentschriften und veröffentlichte Patentanmeldungen sowie weitere einschlägige Dokumente von Vertragsstaaten ausgedehnt, die zu dem in Artikel 162 Absatz 1 des Übereinkommens erwähnten Zeitpunkt nicht im Prüfstoff des Europäischen Patentamts enthalten sind. Der Verwaltungsrat legt auf Grund der Ergebnisse einer Studie, die sich insbesondere mit den technischen und finanziellen Aspekten zu befassen hat, den Umfang, die näheren Bedingungen und den Zeitplan der Ausdehnung fest.

Abschnitt VII

Dieses Protokoll geht entgegenstehenden Vorschriften des Übereinkommens vor.

Abschnitt VIII

Die in diesem Protokoll vorgesehenen Beschlüsse des Verwaltungsrats werden mit Dreiviertelmehrheit getroffen (Artikel 35 Absatz 2 des Übereinkommens). Die Vorschriften über Stimmenwägung (Artikel 36 des Übereinkommens) sind anzuwenden.

Section V

(1) The sub-office referred to in Section I, paragraph 1(c), shall be authorised to carry out searches, among the documentation which is at its disposal and which is in the official language of the State in which the sub-office is located, in respect of European patent applications filed by nationals and residents of that State. This authorisation shall be on the understanding that the procedure for the grant of European patents will not be delayed and that additional costs will not be incurred for the European Patent Organisation.

(2) The sub-office referred to in paragraph 1 shall be authorised to carry out, at the option of an applicant for a European patent and at his expense, a search on his patent application among the documentation referred to in paragraph 1. This authorisation shall be effective until the search provided for in Article 92 of the Convention has been extended, in accordance with Section VI, to cover such documentation and shall be on the understanding that the procedure for the grant of European patents will not be delayed.

(3) The Administrative Council may also extend the authorisations provided for in paragraphs 1 and 2, under the conditions of those paragraphs, to the central industrial property office of a Contracting State which does not have as an official language one of the official languages of the European Patent Office.

Section VI

The search provided for in Article 92 of the Convention shall, in principle, be extended, in respect of all European patent applications, to published patents, published patent applications and other relevant documents of Contracting States not included in the search documentation of the European Patent Office on the date referred to in Article 162, paragraph 1, of the Convention. The extent, conditions and timing of any such extension shall be determined by the Administrative Council on the basis of a study concerning particularly the technical and financial aspects.

Section VII

The provisions of this Protocol shall prevail over any contradictory provisions of the Convention.

Section VIII

The decisions of the Administrative Council provided for in this Protocol shall require a three-quarters majority (Article 35, paragraph 2, of the Convention). The provisions governing the weighting of votes (Article 36 of the Convention) shall apply.

Section V

(1) L'agence visée à la section I, paragraphe 1, lettre (c), est autorisée à effectuer, pour les demandes de brevet européen déposées par les nationaux de l'Etat où est située cette agence et par les personnes domiciliées sur le territoire dudit Etat, des recherches dans la documentation dont elle dispose dans la langue officielle de cet Etat. Cette autorisation ne doit toutefois pas entraîner, d'une part, un retard dans le déroulement de la procédure européenne et, d'autre part, des frais supplémentaires pour l'Organisation européenne des brevets.

(2) L'agence visée au paragraphe 1 est autorisée, si le demandeur d'un brevet européen le requiert et en supporte les frais, à effectuer une recherche portant sur sa demande de brevet dans la documentation visée au paragraphe 1. Cette autorisation prendra fin lorsque la recherche visée à l'article 92 de la convention aura été étendue afin d'y inclure cette documentation, conformément à la section VI, étant entendu qu'il n'en résultera pas un retard dans le déroulement de la procédure de délivrance des brevets européens.

(3) Le Conseil d'administration peut étendre le bénéfice des autorisations prévues aux paragraphes 1 et 2, dans les conditions prévues auxdits paragraphes, aux services centraux de la propriété industrielle des Etats contractants qui n'ont pas comme langue officielle l'une des langues officielles de l'Office européen des brevets.

Section VI

La recherche prévue à l'article 92 de la convention est étendue, en principe, pour toutes les demandes de brevet européen, aux brevets et aux demandes de brevet publiées ainsi qu'à d'autres documents pertinents d'Etats contractants qui ne sont pas compris dans la documentation pour la recherche de l'Office européen des brevets à la date visée à l'article 162, paragraphe 1, de la convention. L'étendue, les conditions et le plan de mise en application de telles extensions sont fixés par le Conseil d'administration sur la base d'études qui doivent porter notamment sur les aspects techniques et financiers.

Section VII

Les dispositions du présent protocole prévalent sur celles de la convention qui s'y opposeraient.

Section VIII

Les décisions du Conseil d'administration prévues dans le présent protocole sont prises à la majorité des trois quarts (article 35, paragraphe 2, de la convention). Les dispositions concernant la pondération des voix (article 36 de la convention) sont applicables.

ZENTRALISIERUNGSPROTOKOLL *Abschnitt V*

PROTOCOL ON CENTRALISATION *Section V*

PROTOCOLE SUR LA CENTRALISATION *Section V*

**PROTOKOLL
ÜBER DIE GERICHTLICHE ZUSTÄNDIGKEIT UND
DIE ANERKENNUNG VON ENTSCHEIDUNGEN
ÜBER DEN ANSPRUCH AUF ERTEILUNG EINES EUROPÄISCHEN PATENTS
(ANERKENNUNGSPROTOKOLL)**

vom 5. Oktober 1973

**PROTOCOL
ON JURISDICTION AND THE RECOGNITION OF DECISIONS
IN RESPECT OF THE RIGHT TO THE GRANT OF A EUROPEAN PATENT
(PROTOCOL ON RECOGNITION)**

of 5 October 1973

**PROTOCOLE
SUR LA COMPÉTENCE JUDICIAIRE ET
LA RECONNAISSANCE DE DÉCISIONS
PORTANT SUR LE DROIT À L'OBTENTION DU BREVET EUROPÉEN
(PROTOCOLE SUR LA RECONNAISSANCE)**

du 5 octobre 1973

Abschnitt I
Zuständigkeit

Artikel 1¹

(1) Für Klagen gegen den Anmelder, mit denen der Anspruch auf Erteilung eines europäischen Patents für einen oder mehrere der in der europäischen Patentanmeldung benannten Vertragsstaaten geltend gemacht wird, bestimmt sich die Zuständigkeit der Gerichte der Vertragsstaaten nach den Artikeln 2 bis 6.

(2) Den Gerichten im Sinn dieses Protokolls sind Behörden gleichgestellt, die nach dem nationalen Recht eines Vertragsstaats für die Entscheidung über die in Absatz 1 genannten Klagen zuständig sind. Die Vertragsstaaten teilen dem Europäischen Patentamt die Behörden mit, denen eine solche Zuständigkeit zugewiesen ist; das Europäische Patentamt unterrichtet die übrigen Vertragsstaaten hiervon.

(3) Als Vertragsstaaten im Sinn dieses Protokolls sind nur die Vertragsstaaten zu verstehen, die die Anwendung dieses Protokolls nach Artikel 167 des Übereinkommens nicht ausgeschlossen haben.

Artikel 2

Der Anmelder, der seinen Wohnsitz oder Sitz in einem Vertragsstaat hat, ist vorbehaltlich der Artikel 4 und 5 vor den Gerichten dieses Vertragsstaats zu verklagen.

Artikel 3

Wenn der Anmelder seinen Wohnsitz oder Sitz außerhalb der Vertragsstaaten hat und die Person, die den Anspruch auf Erteilung des europäischen Patents geltend macht, ihren Wohnsitz oder Sitz in einem Vertragsstaat hat, sind vorbehaltlich der Artikel 4 und 5 die Gerichte des letztgenannten Staats ausschließlich zuständig.

Artikel 4

Ist der Gegenstand der europäischen Patentanmeldung eine Erfindung eines Arbeitnehmers, so sind vorbehaltlich Artikel 5 für einen Rechtsstreit zwischen dem Arbeitnehmer und dem Arbeitgeber ausschließlich die Gerichte des Vertragsstaats zuständig, nach dessen Recht sich das Recht auf das europäische Patent gemäß Artikel 60 Absatz 1 Satz 2 des Übereinkommens bestimmt.

Section I
Jurisdiction

Article 1¹

(1) The courts of the Contracting States shall, in accordance with Articles 2 to 6, have jurisdiction to decide claims, against the applicant, to the right to the grant of a European patent in respect of one or more of the Contracting States designated in the European patent application.

(2) For the purposes of this Protocol, the term “courts” shall include authorities which, under the national law of a Contracting State, have jurisdiction to decide the claims referred to in paragraph 1. Any Contracting State shall notify the European Patent Office of the identity of any authority on which such a jurisdiction is conferred, and the European Patent Office shall inform the other Contracting States accordingly.

(3) For the purposes of this Protocol, the term “Contracting State” refers to a Contracting State which has not excluded application of this Protocol pursuant to Article 167 of the Convention.

Article 2

Subject to Articles 4 and 5, if an applicant for a European patent has his residence or principal place of business within one of the Contracting States, proceedings shall be brought against him in the courts of that Contracting State.

Article 3

Subject to Articles 4 and 5, if an applicant for a European patent has his residence or principal place of business outside the Contracting States, and if the party claiming the right to the grant of the European patent has his residence or principal place of business within one of the Contracting States, the courts of the latter State shall have exclusive jurisdiction.

Article 4

Subject to Article 5, if the subject-matter of a European patent application is the invention of an employee, the courts of the Contracting State, if any, whose law determines the right to the European patent pursuant to Article 60, paragraph 1, second sentence, of the Convention, shall have exclusive jurisdiction over proceedings between the employee and the employer.

¹ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/92 (Anhang I).

¹ See decision of the Enlarged Board of Appeal G 3/92 (Annex I).

Section I
Compétence

*Article premier*¹

(1) Pour les actions intentées contre le titulaire d'une demande de brevet européen visant à faire valoir le droit à l'obtention du brevet européen pour un ou plusieurs des Etats contractants désignés dans la demande de brevet européen, la compétence des tribunaux des Etats contractants est déterminée conformément aux articles 2 à 6.

(2) Sont assimilées aux tribunaux, au sens du présent protocole, les autorités qui, selon la loi nationale d'un Etat contractant, sont compétentes pour statuer sur les actions visées au paragraphe 1. Les Etats contractants donnent connaissance à l'Office européen des brevets des autorités auxquelles est conférée une telle compétence ; l'Office européen des brevets en avise les autres Etats contractants.

(3) Au sens du présent protocole, on entend par Etats contractants ceux des Etats parties à la convention qui n'ont pas exclu l'application de ce protocole en vertu de l'article 167 de la convention.

Article 2

Sous réserve des articles 4 et 5, le titulaire d'une demande de brevet européen ayant son domicile ou son siège dans l'un des Etats contractants est attrait devant les juridictions dudit Etat contractant.

Article 3

Sous réserve des articles 4 et 5, lorsque le titulaire d'une demande de brevet européen n'a ni domicile ni siège dans aucun des Etats contractants, et lorsque la personne qui fait valoir le droit à l'obtention du brevet européen a son domicile ou son siège dans l'un des Etats contractants, les juridictions de ce dernier Etat sont seules compétentes.

Article 4

Si l'objet de la demande de brevet européen est une invention d'un employé, sont seules compétentes pour connaître des actions opposant l'employeur et l'employé, sous réserve de l'article 5, les juridictions de l'Etat contractant selon le droit duquel est déterminé le droit au brevet européen conformément à l'article 60, paragraphe 1, deuxième phrase de la convention.

ANERKENNUNGSPROTOKOLL
Artikel 1

PROTOCOL ON RECOGNITION
Article 1

PROTOCOLE SUR LA RECONNAISSANCE
Article premier

¹ Cf. la décision de la Grande Chambre de recours G 3/92 (Annexe I).

Artikel 5

(1) Haben die an einem Rechtsstreit über den Anspruch auf Erteilung eines europäischen Patents beteiligten Parteien durch eine schriftliche oder durch eine mündliche, schriftlich bestätigte Vereinbarung bestimmt, dass ein Gericht oder die Gerichte eines bestimmten Vertragsstaats über diesen Rechtsstreit entscheiden sollen, so sind dieses Gericht oder die Gerichte dieses Staats ausschließlich zuständig.

(2) Handelt es sich bei den Parteien um einen Arbeitnehmer und seinen Arbeitgeber, so ist Absatz 1 jedoch nur anzuwenden, soweit das für den Arbeitsvertrag maßgebliche nationale Recht eine solche Vereinbarung zulässt.

Artikel 6

In den nicht in den Artikeln 2 bis 4 und in Artikel 5 Absatz 1 geregelten Fällen sind die Gerichte der Bundesrepublik Deutschland ausschließlich zuständig.

Artikel 7

Die Gerichte der Vertragsstaaten, die mit Klagen nach Artikel 1 befasst werden, prüfen ihre Zuständigkeit nach den Artikeln 2 bis 6 von Amts wegen.

Artikel 8

(1) Werden bei Gerichten verschiedener Vertragsstaaten Klagen wegen desselben Anspruchs zwischen denselben Parteien anhängig gemacht, so hat sich das später angerufene Gericht von Amts wegen zu Gunsten des zuvor angerufenen Gerichts für unzuständig zu erklären.

(2) Das Gericht, das sich nach Absatz 1 für unzuständig zu erklären hätte, hat die Entscheidung bis zur rechtskräftigen Entscheidung des zuvor angerufenen Gerichts auszusetzen, wenn der Mangel der Zuständigkeit des anderen Gerichts geltend gemacht wird.

Abschnitt II

Anerkennung

Artikel 9²

(1) Die in einem Vertragsstaat ergangenen rechtskräftigen Entscheidungen über den Anspruch auf Erteilung eines europäischen Patents für einzelne oder alle in der europäischen Patentanmeldung benannte Vertragsstaaten werden vorbehaltlich Artikel 11 Absatz 2 in den anderen Vertragsstaaten anerkannt, ohne dass es hierfür eines besonderen Verfahrens bedarf.

Article 5

(1) If the parties to a dispute concerning the right to the grant of a European patent have concluded an agreement, either in writing or verbally with written confirmation, to the effect that a court or the courts of a particular Contracting State shall decide on such a dispute, the court or courts of that State shall have exclusive jurisdiction.

(2) However, if the parties are an employee and his employer, paragraph 1 shall only apply in so far as the national law governing the contract of employment allows the agreement in question.

Article 6

In cases where neither Articles 2 to 4 nor Article 5, paragraph 1, apply, the courts of the Federal Republic of Germany shall have exclusive jurisdiction.

Article 7

The courts of Contracting States before which claims referred to in Article 1 are brought shall of their own motion decide whether or not they have jurisdiction pursuant to Articles 2 to 6.

Article 8

(1) In the event of proceedings based on the same claim and between the same parties being brought before courts of different Contracting States, the court to which a later application is made shall of its own motion decline jurisdiction in favour of the court to which an earlier application was made.

(2) In the event of the jurisdiction of the court to which an earlier application is made being challenged, the court to which a later application is made shall stay the proceedings until the other court takes a final decision.

Section II

Recognition

Article 9²

(1) Subject to the provisions of Article 11, paragraph 2, final decisions given in any Contracting State on the right to the grant of a European patent in respect of one or more of the Contracting States designated in the European patent application shall be recognised without requiring a special procedure in the other Contracting States.

² Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/92 (Anhang I).

² See decision of the Enlarged Board of Appeal G 3/92 (Annex I).

Article 5

(1) Si, par une convention écrite ou par une convention verbale confirmée par écrit, les parties à un différend relatif au droit à l'obtention du brevet européen ont désigné un tribunal ou les tribunaux d'un Etat contractant particulier pour connaître de ce différend, le tribunal ou les tribunaux de cet Etat sont seuls compétents.

(2) Toutefois, si les parties sont un employé et son employeur, le paragraphe 1 n'est applicable que dans la mesure où le droit national qui régit le contrat de travail autorise une telle convention.

Article 6

Pour les cas où les articles 2 à 4 et l'article 5, paragraphe 1 ne s'appliquent pas, les juridictions de la République fédérale d'Allemagne sont seules compétentes.

Article 7

Les juridictions des Etats contractants saisies de l'une des actions visées à l'article premier vérifient d'office si elles sont compétentes conformément aux articles 2 à 6.

Article 8

(1) Lorsque des demandes ayant le même objet et la même cause sont formées entre les mêmes parties devant des juridictions d'Etats contractants différents, la juridiction saisie ultérieurement doit, même d'office, se dessaisir en faveur du tribunal premier saisi.

(2) La juridiction qui devrait se dessaisir en vertu du paragraphe 1 surseoit à statuer jusqu'à ce que la décision du tribunal premier saisi soit passée en force de chose jugée, si la compétence de ce dernier tribunal est contestée.

Section II

Reconnaissance

*Article 9*²

(1) Sous réserve des dispositions de l'article 11, paragraphe 2, les décisions passées en force de chose jugée rendues dans un Etat contractant, en ce qui concerne le droit à l'obtention du brevet européen pour un ou plusieurs Etats désignés dans la demande de brevet européen, sont reconnues dans les autres Etats contractants, sans qu'il soit nécessaire de recourir à aucune procédure.

² Cf. la décision de la Grande Chambre de recours G 3/92 (Annexe I).

ANERKENNUNGSPROTOKOLL

Artikel 5

PROTOCOL ON RECOGNITION

Article 5

PROTOCOLE SUR LA RECONNAISSANCE

Article 5

(2) Die Zuständigkeit des Gerichts, dessen Entscheidung anerkannt werden soll, und die Gesetzmäßigkeit dieser Entscheidung dürfen nicht nachgeprüft werden.

Artikel 10

Artikel 9 Absatz 1 ist nicht anzuwenden, wenn:

- a) der Anmelder, der sich auf die Klage nicht eingelassen hat, nachweist, dass ihm das diesen Rechtsstreit einleitende Schriftstück nicht ordnungsgemäß und nicht so rechtzeitig zugestellt worden ist, dass er sich verteidigen konnte;
- b) der Anmelder nachweist, dass die Entscheidung mit einer anderen Entscheidung unvereinbar ist, die zwischen denselben Parteien in einem Vertragsstaat auf eine Klage hin ergangen ist, die früher eingereicht wurde als die Klage, die zu der anzuerkennenden Entscheidung geführt hat.

Artikel 11

(1) Im Verhältnis der Vertragsstaaten zueinander haben die Vorschriften dieses Protokolls Vorrang vor widersprechenden Vorschriften anderer Abkommen, die die gerichtliche Zuständigkeit oder die Anerkennung von Entscheidungen regeln.

(2) Dieses Protokoll steht der Anwendung von Abkommen zwischen Vertragsstaaten und einem nicht durch das Protokoll gebundenen Staat nicht entgegen.

(2) The jurisdiction of the court whose decision is to be recognised and the validity of such decision may not be reviewed.

Article 10

Article 9, paragraph 1, shall not be applicable where:

- (a) an applicant for a European patent who has not contested a claim proves that the document initiating the proceedings was not notified to him regularly and sufficiently early for him to defend himself; or
- (b) an applicant proves that the decision is incompatible with another decision given in a Contracting State in proceedings between the same parties which were started before those in which the decision to be recognised was given.

Article 11

(1) In relations between any Contracting States the provisions of this Protocol shall prevail over any conflicting provisions of other agreements on jurisdiction or the recognition of judgments.

(2) This Protocol shall not affect the implementation of any agreement between a Contracting State and a State which is not bound by the Protocol.

(2) Il ne peut être procédé ni au contrôle de la compétence de la juridiction dont la décision doit être reconnue ni à la révision au fond de cette décision.

Article 10

L'article 9, paragraphe 1 n'est pas applicable lorsque :

a) le titulaire d'une demande de brevet européen qui a été attrait devant une juridiction et n'a pas comparu établit que l'acte introductif d'instance ne lui a pas été signifié régulièrement et en temps utile pour lui permettre de se défendre, ou

b) le titulaire d'une demande de brevet européen établit qu'une décision rendue dans un Etat contractant au terme d'une procédure opposant les mêmes parties et introduite antérieurement à celle qui a conduit à la décision dont la reconnaissance est demandée, est inconciliable avec cette dernière décision.

Article 11

(1) Dans les rapports entre Etats contractants, les dispositions du présent protocole priment les dispositions contraires d'autres conventions relatives à la compétence judiciaire ou à la reconnaissance des décisions.

(2) Le présent protocole ne fait pas obstacle à l'application d'un autre accord entre un Etat contractant et un Etat qui n'est pas lié par ce protocole.

ANERKENNUNGSPROTOKOLL
Artikel 10

PROTOCOL ON RECOGNITION
Article 10

PROTOCOLE SUR LA RECONNAISSANCE
Article 10

**PROTOKOLL
ÜBER DIE VORRECHTE UND IMMUNITÄTEN
DER EUROPÄISCHEN PATENTORGANISATION
(PROTOKOLL ÜBER VORRECHTE UND IMMUNITÄTEN)**

vom 5. Oktober 1973

**PROTOCOL
ON PRIVILEGES AND IMMUNITIES
OF THE EUROPEAN PATENT ORGANISATION
(PROTOCOL ON PRIVILEGES AND IMMUNITIES)**

of 5 October 1973

**PROTOCOLE
SUR LES PRIVILÈGES ET IMMUNITÉS
DE L'ORGANISATION EUROPÉENNE DES BREVETS
(PROTOCOLE SUR LES PRIVILÈGES ET IMMUNITÉS)**

du 5 octobre 1973

Artikel 1

(1) Die Räumlichkeiten der Organisation sind unverletzlich.

(2) Die Behörden der Staaten, in denen die Organisation Räumlichkeiten hat, dürfen diese Räumlichkeiten nur mit Zustimmung des Präsidenten des Europäischen Patentamts betreten. Bei Feuer oder einem anderen Unglück, das sofortige Schutzmaßnahmen erfordert, wird diese Zustimmung vermutet.

(3) Die Zustellung einer Klageschrift oder sonstiger Schriftstücke, die sich auf ein gegen die Organisation gerichtetes Verfahren beziehen, in den Räumlichkeiten der Organisation stellt keinen Bruch der Unverletzlichkeit dar.

Artikel 2

Die Archive der Organisation und alle Dokumente, die ihr gehören oder sich in ihrem Besitz befinden, sind unverletzlich.

Artikel 3

(1) Die Organisation genießt im Rahmen ihrer amtlichen Tätigkeit Immunität von der Gerichtsbarkeit und Vollstreckung mit Ausnahme folgender Fälle:

a) soweit die Organisation im Einzelfall ausdrücklich hierauf verzichtet;

b) im Fall eines von einem Dritten angestregten Zivilverfahrens wegen Schäden auf Grund eines Unfalls, der durch ein der Organisation gehörendes oder für sie betriebenes Motorfahrzeug verursacht wurde, oder im Fall eines Verstoßes gegen die Vorschriften über den Straßenverkehr, an dem dieses Fahrzeug beteiligt ist;

c) im Fall der Vollstreckung eines nach Artikel 23 ergangenen Schiedsspruchs.

(2) Das Eigentum und die sonstigen Vermögenswerte der Organisation genießen ohne Rücksicht darauf, wo sie sich befinden, Immunität von jeder Form der Beschlagnahme, Einziehung, Enteignung und Zwangsverwaltung.

(3) Das Eigentum und die sonstigen Vermögenswerte der Organisation genießen ebenfalls Immunität von jedem behördlichen Zwang oder jeder Maßnahme, die einem Urteil vorausgehen, es sei denn, dass dies im Zusammenhang mit der Verhinderung und gegebenenfalls der Untersuchung von Unfällen, an denen der Organisation gehörende oder für sie betriebene Motorfahrzeuge beteiligt sind, vorübergehend notwendig ist.

(4) Unter amtlicher Tätigkeit der Organisation im Sinn dieses Protokolls sind alle Tätigkeiten zu verstehen, die für ihre im Übereinkommen vorgesehene Verwaltungsarbeit und technische Arbeit unbedingt erforderlich sind.

Article 1

(1) The premises of the Organisation shall be inviolable.

(2) The authorities of the States in which the Organisation has its premises shall not enter those premises, except with the consent of the President of the European Patent Office. Such consent shall be assumed in case of fire or other disaster requiring prompt protective action.

(3) Service of process at the premises of the Organisation and of any other procedural instruments relating to a cause of action against the Organisation shall not constitute breach of inviolability.

Article 2

The archives of the Organisation and any documents belonging to or held by it shall be inviolable.

Article 3

(1) Within the scope of its official activities the Organisation shall have immunity from jurisdiction and execution, except

(a) to the extent that the Organisation shall have expressly waived such immunity in a particular case;

(b) in the case of a civil action brought by a third party for damage resulting from an accident caused by a motor vehicle belonging to, or operated on behalf of, the Organisation, or in respect of a motor traffic offence involving such a vehicle;

(c) in respect of the enforcement of an arbitration award made under Article 23.

(2) The property and assets of the Organisation, wherever situated, shall be immune from any form of requisition, confiscation, expropriation and sequestration.

(3) The property and assets of the Organisation shall also be immune from any form of administrative or provisional judicial constraint, except in so far as may be temporarily necessary in connection with the prevention of, and investigation into, accidents involving motor vehicles belonging to or operated on behalf of the Organisation.

(4) The official activities of the Organisation shall, for the purposes of this Protocol, be such as are strictly necessary for its administrative and technical operation, as set out in the Convention.

Article premier

- (1) Les locaux de l'Organisation sont inviolables.
- (2) Les autorités des Etats où l'Organisation a ses locaux ne peuvent pénétrer dans ces locaux qu'avec le consentement du Président de l'Office européen des brevets. Ce consentement est présumé acquis en cas d'incendie ou autre sinistre exigeant des mesures de protection immédiates.
- (3) La remise dans les locaux de l'Organisation de tous actes de procédure nécessités par une instance en justice concernant l'Organisation ne constitue pas une infraction à l'inviolabilité.

Article 2

Les archives de l'Organisation ainsi que tout document lui appartenant ou détenu par elle sont inviolables.

Article 3

- (1) Dans le cadre de ses activités officielles, l'Organisation bénéficie de l'immunité de juridiction et d'exécution sauf :
 - a) dans la mesure où l'Organisation aurait expressément renoncé à une telle immunité dans un cas particulier ;
 - b) en cas d'action civile intentée par un tiers pour les dommages résultant d'un accident causé par un véhicule automoteur appartenant à l'Organisation ou circulant pour son compte ou en cas d'infraction à la réglementation de la circulation automobile intéressant le véhicule précité ;
 - c) en cas d'exécution d'une sentence arbitrale rendue en application de l'article 23.
- (2) Les propriétés et biens de l'Organisation, quel que soit le lieu où ils se trouvent, bénéficient de l'immunité à l'égard de toute forme de réquisition, confiscation, expropriation et séquestre.
- (3) Les propriétés et biens de l'Organisation bénéficient également de l'immunité à l'égard de toute forme de contrainte administrative ou de mesure préalable à un jugement, sauf dans la mesure où le nécessitent temporairement la prévention des accidents mettant en cause des véhicules automoteurs appartenant à l'Organisation ou circulant pour le compte de celle-ci et les enquêtes auxquelles peuvent donner lieu lesdits accidents.
- (4) Au sens du présent protocole, les activités officielles de l'Organisation sont celles qui sont strictement nécessaires à son fonctionnement administratif et technique telles qu'elles résultent de la convention.

PROTOKOLL ÜBER VORRECHTE
UND IMMUNITÄTEN
Artikel 1

PROTOCOL ON PRIVILEGES AND IMMUNITIES
Article 1

PROTOCOLE SUR LES PRIVILÈGES
ET IMMUNITÉS
Article premier

Artikel 4

(1) Im Rahmen ihrer amtlichen Tätigkeit sind die Organisation, ihr Vermögen und ihre Einkünfte von jeder direkten Besteuerung befreit.

(2) Sind bei größeren Einkäufen, die von der Organisation getätigt werden und die für ihre amtliche Tätigkeit erforderlich sind, Steuern oder sonstige Abgaben im Preis enthalten, so werden in jedem Fall, in dem dies möglich ist, von den Vertragsstaaten geeignete Maßnahmen getroffen, um der Organisation den Betrag der Steuern oder sonstigen Abgaben dieser Art zu erlassen oder zu erstatten.

(3) Von Abgaben, die lediglich die Vergütung für Leistungen öffentlicher Versorgungsbetriebe darstellen, wird keine Befreiung gewährt.

Artikel 5

Die von der Organisation ein- oder ausgeführten Waren, die für deren amtliche Tätigkeit erforderlich sind, werden von Zöllen und sonstigen Abgaben bei der Ein- oder Ausfuhr - mit Ausnahme der Abgaben für Dienstleistungen - befreit sowie von allen Ein- und Ausfuhrverboten und -beschränkungen ausgenommen.

Artikel 6

Für Waren, die für den persönlichen Bedarf der Bediensteten des Europäischen Patentamts gekauft oder eingeführt werden, wird keine Befreiung nach den Artikeln 4 und 5 gewährt.

Artikel 7

(1) Die in den Artikeln 4 und 5 angeführten, der Organisation gehörenden Waren dürfen nur zu den Bedingungen verkauft oder veräußert werden, die von den Vertragsstaaten, welche die Befreiung gewährt haben, genehmigt sind.

(2) Der Waren- und Dienstleistungsverkehr zwischen den verschiedenen Dienstgebäuden der Organisation ist von Abgaben und Beschränkungen jeder Art befreit; gegebenenfalls treffen die Vertragsstaaten geeignete Maßnahmen, um solche Abgaben zu erlassen oder zu erstatten oder um solche Beschränkungen aufzuheben.

Artikel 8

Der Versand von Veröffentlichungen und sonstigem Informationsmaterial durch oder an die Organisation unterliegt keinen Beschränkungen.

Artikel 9

Die Vertragsstaaten räumen der Organisation die devisa-rechtlichen Befreiungen ein, die zur Ausübung ihrer amtlichen Tätigkeit erforderlich sind.

Article 4

(1) Within the scope of its official activities the Organisation and its property and income shall be exempt from all direct taxes.

(2) Where substantial purchases for the exercise of its official activities, and in the price of which taxes or duties are included, are made by the Organisation, appropriate measures shall, whenever possible, be taken by the Contracting States to remit or reimburse to the Organisation the amount of such taxes or duties.

(3) No exemption shall be accorded in respect of duties and taxes which are no more than charges for public utility services.

Article 5

Goods imported or exported by the Organisation for the exercise of its official activities shall be exempt from duties and charges on import or export other than fees or taxes representing services rendered, and from all prohibitions and restrictions on import or export.

Article 6

No exemption shall be granted under Articles 4 and 5 in respect of goods purchased or imported for the personal benefit of the employees of the European Patent Office.

Article 7

(1) Goods belonging to the Organisation which have been acquired or imported under Article 4 or Article 5 shall not be sold or given away except in accordance with conditions laid down by the Contracting States which have granted the exemptions.

(2) The transfer of goods and provision of services between the various buildings of the Organisation shall be exempt from charges or restrictions of any kind; where appropriate, the Contracting States shall take all the necessary measures to remit or reimburse the amount of such charges or to lift such restrictions.

Article 8

The transmission of publications and other information material by or to the Organisation shall not be restricted in any way.

Article 9

The Contracting States shall accord the Organisation the currency exemptions which are necessary for the exercise of its official activities.

Article 4

(1) Dans le cadre de ses activités officielles, l'Organisation, ses biens et revenus sont exonérés des impôts directs.

(2) Lorsque des achats importants sont faits par l'Organisation pour l'exercice de ses activités officielles, et dont le prix comprend des droits ou des taxes, des dispositions appropriées sont prises par les Etats contractants, chaque fois qu'il est possible, en vue de la remise ou du remboursement à l'Organisation du montant des droits et taxes de cette nature.

(3) Aucune exonération n'est accordée en ce qui concerne les impôts, taxes et droits qui ne constituent que la simple rémunération de services d'utilité publique.

Article 5

Les produits importés ou exportés par l'Organisation pour l'exercice de ses activités officielles sont exonérés des droits et taxes à l'importation ou à l'exportation, autres que les redevances ou impositions représentatives de services rendus, et exemptés de toutes prohibitions et restrictions à l'importation ou à l'exportation.

Article 6

Aucune exonération n'est accordée en vertu des articles 4 et 5 en ce qui concerne les achats ou importations de biens destinés aux besoins personnels des agents de l'Office européen des brevets.

Article 7

(1) Les biens appartenant à l'Organisation, acquis ou importés conformément à l'article 4 ou à l'article 5, ne peuvent être vendus ou cédés qu'aux conditions agréées par les Etats contractants qui ont accordé les exemptions.

(2) Les transferts de biens ou les prestations de services, réalisés entre les différents bâtiments de l'Organisation, ne sont soumis à aucune imposition ni restriction ; le cas échéant, les Etats contractants prennent les mesures appropriées en vue de la remise ou du remboursement du montant de telles impositions ou en vue de la levée de telles restrictions.

Article 8

La transmission de publications et d'autres matériels d'information par l'Organisation ou à celle-ci, n'est soumise à aucune restriction.

Article 9

Les Etats contractants accordent à l'Organisation les dispenses en matière de réglementation des changes qui seraient nécessaires pour l'exercice de ses activités officielles.

PROTOKOLL ÜBER VORRECHTE UND IMMUNITÄTEN

Artikel 4

PROTOCOL ON PRIVILEGES AND IMMUNITIES

Article 4

PROTOCOLE SUR LES PRIVILÈGES ET IMMUNITÉS

Article 4

Artikel 10

(1) Bei ihrem amtlichen Nachrichtenverkehr und bei der Übermittlung aller ihrer Schriftstücke genießt die Organisation in jedem Vertragsstaat die günstigste Behandlung, die dieser Staat einer anderen internationalen Organisation gewährt.

(2) Der amtliche Nachrichtenverkehr der Organisation, gleichviel mit welchem Nachrichtenmittel, unterliegt nicht der Zensur.

Artikel 11

Die Vertragsstaaten treffen geeignete Maßnahmen, um Einreise, Aufenthalt und Ausreise der Bediensteten des Europäischen Patentamts zu erleichtern.

Artikel 12

(1) Die Vertreter der Vertragsstaaten, deren Stellvertreter, Berater oder Sachverständige genießen während der Tagungen des Verwaltungsrats oder der Tagungen anderer vom Verwaltungsrat eingesetzter Organe sowie während der Reise zum und vom Tagungs-ort folgende Vorrechte und Immunitäten:

- a) Immunität von Festnahme oder Haft sowie von der Beschlagnahme ihres persönlichen Gepäcks, außer wenn sie auf frischer Tat erlappt werden;
- b) Immunität von der Gerichtsbarkeit, auch nach Beendigung ihres Auftrags, bezüglich der von ihnen in Ausübung ihres Amtes vorgenommenen Handlungen einschließlich ihrer schriftlichen und mündlichen Äußerungen; diese Immunität gilt jedoch nicht im Fall eines Verstoßes gegen die Vorschriften über den Straßenverkehr durch eine der genannten Personen und im Fall von Schäden, die durch ein Motorfahrzeug verursacht wurden, das einer dieser Personen gehört oder von einer solchen Person gesteuert wurde;
- c) Unverletzlichkeit aller ihrer amtlichen Schriftstücke und Urkunden;
- d) das Recht, Verschlüsselungen zu verwenden sowie Urkunden oder sonstige Schriftstücke durch Sonderkurier oder in versiegelten Behältern zu empfangen;
- e) Befreiung für sich und ihre Ehegatten von allen Einreisebeschränkungen und von der Meldepflicht für Ausländer;

Article 10

(1) With regard to its official communications and the transfer of all its documents, the Organisation shall in each Contracting State enjoy the most favourable treatment accorded by that State to any other international organisation.

(2) No censorship shall be applied to official communications of the Organisation by whatever means of communication.

Article 11

The Contracting States shall take all appropriate measures to facilitate the entry, stay and departure of the employees of the European Patent Office.

Article 12

(1) Representatives of Contracting States, alternate Representatives and their advisers or experts, if any, shall enjoy, while attending meetings of the Administrative Council and of any body established by it, and in the course of their journeys to and from the place of meeting, the following privileges and immunities:

- (a) immunity from arrest or detention and from seizure of their personal luggage, except when found committing, attempting to commit, or just having committed an offence;
- (b) immunity from jurisdiction, even after the termination of their mission, in respect of acts, including words written and spoken, done by them in the exercise of their functions; this immunity shall not apply, however, in the case of a motor traffic offence committed by one of the persons referred to above, nor in the case of damage caused by a motor vehicle belonging to or driven by such a person;
- (c) inviolability for all their official papers and documents;
- (d) the right to use codes and to receive documents or correspondence by special courier or sealed bag;
- (e) exemption for themselves and their spouses from all measures restricting entry and from aliens' registration formalities;

Article 10

(1) Pour ses communications officielles et le transfert de tous ses documents, l'Organisation bénéficie, dans chaque Etat contractant, du traitement le plus favorable accordé à toute autre organisation internationale par cet Etat.

(2) Aucune censure ne peut être exercée à l'égard des communications officielles de l'Organisation, quelle que soit la voie de communication utilisée.

Article 11

Les Etats contractants prennent les mesures utiles pour faciliter l'entrée, le séjour et le départ des agents de l'Office européen des brevets.

Article 12

(1) Les représentants des Etats contractants, leurs suppléants, leurs conseillers ou experts jouissent, lors des réunions du Conseil d'administration ou de tout organe institué par ledit Conseil ainsi qu'au cours de leurs voyages à destination ou en provenance du lieu de la réunion des privilèges et immunités suivants :

a) immunité d'arrestation ou de détention, ainsi que de saisie de leurs bagages personnels, sauf en cas de flagrant délit ;

b) immunité de juridiction, même après la fin de leur mission, pour les actes, y compris leurs écrits et leurs paroles, accomplis dans l'exercice de leurs fonctions ; cette immunité ne joue cependant pas dans le cas d'une infraction à la réglementation de la circulation des véhicules automoteurs, commise par une des personnes visées ci-dessus, ou dans le cas de dommages causés par un véhicule automoteur lui appartenant ou qu'elle conduit ;

c) inviolabilité pour tous leurs papiers et documents officiels ;

d) droit de faire usage de codes et de recevoir des documents ou de la correspondance par courrier spécial ou par valises scellées ;

e) exemption pour eux-mêmes et pour leurs conjoints de toute mesure limitant l'entrée et de toutes formalités d'enregistrement d'étrangers ;

PROTOKOLL ÜBER VORRECHTE
UND IMMUNITÄTEN

Artikel 10

PROTOCOL ON PRIVILEGES AND IMMUNITIES
Article 10

PROTOCOLE SUR LES PRIVILÈGES
ET IMMUNITÉS

Article 10

f) die gleichen Erleichterungen hinsichtlich der Währungs- und Devisenvorschriften wie die Vertreter ausländischer Regierungen mit vorübergehendem amtlichen Auftrag.

(2) Die Vorrechte und Immunitäten werden den in Absatz 1 genannten Personen nicht zu ihrem persönlichen Vorteil gewährt, sondern um ihre vollständige Unabhängigkeit bei der Ausübung ihres Amtes im Zusammenhang mit der Organisation zu gewährleisten. Ein Vertragsstaat hat deshalb die Pflicht, die Immunität in allen Fällen aufzuheben, in denen sie nach Auffassung dieses Staats verhindern würde, dass der Gerechtigkeit Genüge geschieht, und in denen sie ohne Beeinträchtigung der Zwecke aufgehoben werden kann, für die sie gewährt wurde.

Artikel 13

(1) Vorbehaltlich Artikel 6 steht der Präsident des Europäischen Patentamts im Genuss der Vorrechte und Immunitäten, die Diplomaten nach dem Wiener Übereinkommen über diplomatische Beziehungen vom 18. April 1961 eingeräumt werden.

(2) Die Immunität von der Gerichtsbarkeit gilt jedoch nicht im Fall eines Verstoßes des Präsidenten des Europäischen Patentamts gegen die Vorschriften über den Straßenverkehr oder im Fall eines Schadens, der durch ein ihm gehörendes oder von ihm gesteuertes Motorfahrzeug verursacht wurde.

Artikel 14

Die Bediensteten des Europäischen Patentamts

a) genießen auch nach ihrem Ausscheiden aus dem Dienst Immunität von der Gerichtsbarkeit hinsichtlich der von ihnen in Ausübung ihres Amtes vorgenommenen Handlungen einschließlich ihrer mündlichen und schriftlichen Äußerungen; diese Immunität gilt jedoch nicht im Fall eines Verstoßes gegen die Vorschriften über den Straßenverkehr durch einen Bediensteten des Europäischen Patentamts oder eines Schadens, der durch ein ihm gehörendes oder von ihm geführtes Motorfahrzeug verursacht wurde;

b) sind von jeder Verpflichtung zum Wehrdienst befreit;

c) genießen Unverletzlichkeit aller ihrer amtlichen Schriftstücke und Urkunden;

d) genießen in Bezug auf Einwanderungsbeschränkungen und die Meldepflicht der Ausländer dieselbe Erleichterung, die allgemein den Mitgliedern des Personals internationaler Organisationen gewährt wird; das Gleiche gilt für die in ihrem Haushalt lebenden Familienangehörigen;

e) genießen in Bezug auf Devisenvorschriften dieselben Vorrechte, die allgemein den Mitgliedern des Personals internationaler Organisationen gewährt werden;

(f) the same facilities in the matter of currency and exchange control as are accorded to the representatives of foreign Governments on temporary official missions.

(2) Privileges and immunities are accorded to the persons referred to in paragraph 1, not for their personal advantage but in order to ensure complete independence in the exercise of their functions in connection with the Organisation. Consequently, a Contracting State has the duty to waive the immunity in all cases where, in the opinion of that State, such immunity would impede the course of justice and where it can be waived without prejudicing the purposes for which it was accorded.

Article 13

(1) Subject to the provisions of Article 6, the President of the European Patent Office shall enjoy the privileges and immunities accorded to diplomatic agents under the Vienna Convention on Diplomatic Relations of 18 April 1961.

(2) However, immunity from jurisdiction shall not apply in the case of a motor traffic offence committed by the President of the European Patent Office or damage caused by a motor vehicle belonging to or driven by him.

Article 14

The employees of the European Patent Office:

(a) shall, even after their service has terminated, have immunity from jurisdiction in respect of acts, including words written and spoken, done in the exercise of their functions; this immunity shall not apply, however, in the case of a motor traffic offence committed by an employee of the European Patent Office, nor in the case of damage caused by a motor vehicle belonging to or driven by an employee;

(b) shall be exempt from all obligations in respect of military service;

(c) shall enjoy inviolability for all their official papers and documents;

(d) shall enjoy the same facilities as regards exemption from all measures restricting immigration and governing aliens' registration as are normally accorded to staff members of international organisations, as shall members of their families forming part of their household;

(e) shall enjoy the same privileges in respect of exchange regulations as are normally accorded to the staff members of international organisations;

f) mêmes facilités, en ce qui concerne les réglementations monétaires ou de change, que celles accordées aux représentants de gouvernements étrangers en mission officielle temporaire.

(2) Les privilèges et immunités sont accordés aux personnes visées au paragraphe premier, non à leur avantage personnel, mais dans le but d'assurer en toute indépendance l'exercice de leurs fonctions en rapport avec l'Organisation. Par conséquent, un Etat contractant a le devoir de lever l'immunité dans tous les cas où, à son avis, l'immunité entraverait l'action de la justice et où elle peut être levée sans compromettre les fins pour lesquelles elle a été accordée.

Article 13

(1) Sous réserve des dispositions de l'article 6, le Président de l'Office européen des brevets jouit des privilèges et immunités reconnus aux agents diplomatiques en vertu de la Convention de Vienne sur les relations diplomatiques du 18 avril 1961.

(2) Toutefois, l'immunité de juridiction ne joue pas dans le cas d'infraction à la réglementation en matière de circulation des véhicules automoteurs commise par le Président de l'Office européen des brevets ou de dommage causé par un véhicule automoteur lui appartenant ou qu'il conduit.

Article 14

Les agents de l'Office européen des brevets :

a) jouissent, même lorsqu'ils ont cessé d'exercer leurs fonctions, de l'immunité de juridiction pour les actes, y compris les paroles et écrits, accomplis dans l'exercice de leurs fonctions ; cette immunité ne joue cependant pas dans le cas d'infraction à la réglementation de la circulation des véhicules automoteurs, commise par un agent de l'Office, ou de dommage causé par un véhicule automoteur lui appartenant ou qu'il conduit ;

b) sont exempts de toute obligation relative au service militaire ;

c) jouissent de l'inviolabilité pour tous leurs papiers et documents officiels ;

d) jouissent, avec les membres de leur famille vivant à leur foyer, des mêmes exceptions aux dispositions limitant l'immigration et réglant l'enregistrement des étrangers, que celles généralement reconnues aux membres du personnel des organisations internationales ;

e) jouissent, en ce qui concerne les réglementations de change, des mêmes privilèges que ceux généralement reconnus aux membres du personnel des organisations internationales ;

PROTOKOLL ÜBER VORRECHTE UND IMMUNITÄTEN *Artikel 13*

PROTOCOL ON PRIVILEGES AND IMMUNITIES *Article 13*

PROTOCOLE SUR LES PRIVILÈGES ET IMMUNITÉS *Article 13*

f) genießen im Fall einer internationalen Krise dieselben Erleichterungen bei der Rückführung in ihren Heimatstaat wie die Diplomaten; das Gleiche gilt für die in ihrem Haushalt lebenden Familienangehörigen;

g) haben das Recht, ihre Wohnungseinrichtung und ihre persönlichen Gebrauchsgegenstände bei Antritt ihres Dienstes in dem betreffenden Staat zollfrei einzuführen und bei Beendigung ihres Dienstes in diesem Staat zollfrei wieder auszuführen, vorbehaltlich der Bedingungen, welche die Regierung des Staats, in dem dieses Recht ausgeübt wird, jeweils für erforderlich hält, und mit Ausnahme der Güter, die in diesem Staat erworben wurden und dort einem Ausfuhrverbot unterliegen.

Artikel 15

Sachverständige genießen bei der Ausübung ihrer Tätigkeit für die Organisation oder bei der Ausführung von Aufträgen für diese die nachstehenden Vorrechte und Immunitäten, soweit sie für die Ausübung ihrer Tätigkeiten notwendig sind, und zwar auch während der Reisen, die in Ausübung ihrer Tätigkeit oder zur Durchführung ihres Auftrags ausgeführt werden:

a) Immunität von der Gerichtsbarkeit hinsichtlich der von ihnen in Ausübung ihres Amtes vorgenommenen Handlungen einschließlich ihrer mündlichen und schriftlichen Äußerungen, außer im Fall eines Verstoßes gegen die Vorschriften über den Straßenverkehr durch einen Sachverständigen oder im Fall eines Schadens, der durch ein ihm gehörendes oder von ihm geführtes Motorfahrzeug verursacht wurde; die Sachverständigen genießen diese Immunität auch nach Beendigung ihrer Tätigkeit bei der Organisation;

b) Unverletzlichkeit aller ihrer amtlichen Schriftstücke und Urkunden;

c) die zur Überweisung ihrer Bezüge erforderlichen devisarechtlichen Befreiungen.

Artikel 16

(1) Die in den Artikeln 13 und 14 genannten Personen sind für die von der Organisation gezahlten Gehälter und Bezüge nach Maßgabe der Bedingungen und Regeln, die der Verwaltungsrat innerhalb eines Jahres nach Inkrafttreten des Übereinkommens festlegt, zu Gunsten der Organisation steuerpflichtig. Von diesem Zeitpunkt an sind diese Gehälter und Bezüge von der staatlichen Einkommensteuer befreit. Die Vertragsstaaten können jedoch die befreiten Gehälter und Bezüge bei der Festsetzung des auf Einkommen aus anderen Quellen zu erhebenden Steuerbetrags berücksichtigen.

(2) Absatz 1 ist auf Renten und Ruhegehälter, die von der Organisation an ehemalige Bedienstete des Europäischen Patentamts gezahlt werden, nicht anzuwenden.

(f) shall enjoy the same facilities as to repatriation as diplomatic agents in time of international crises, as shall the members of their families forming part of their household;

(g) shall have the right to import duty-free their furniture and personal effects at the time of first taking up their post in the State concerned and the right on the termination of their functions in that State to export free of duty their furniture and personal effects, subject to the conditions considered necessary by the Government of the State in whose territory the right is exercised and with the exception of property acquired in that State which is subject to an export prohibition therein.

Article 15

Experts performing functions on behalf of, or carrying out missions for, the Organisation shall enjoy the following privileges and immunities, to the extent that they are necessary for the carrying out of their functions, including during journeys made in carrying out their functions and in the course of such missions:

(a) immunity from jurisdiction in respect of acts done by them in the exercise of their functions, including words written or spoken, except in the case of a motor traffic offence committed by an expert or in the case of damage caused by a motor vehicle belonging to or driven by him; experts shall continue to enjoy this immunity after they have ceased to be employed by the Organisation;

(b) inviolability for all their official papers and documents;

(c) the exchange facilities necessary for the transfer of their remuneration.

Article 16

(1) The persons referred to in Articles 13 and 14 shall be subject to a tax for the benefit of the Organisation on salaries and emoluments paid by the Organisation, subject to the conditions and rules laid down by the Administrative Council within a period of one year from the date of the entry into force of the Convention. From the date on which this tax is applied, such salaries and emoluments shall be exempt from national income tax. The Contracting States may, however, take into account the salaries and emoluments thus exempt when assessing the amount of tax to be applied to income from other sources.

(2) Paragraph 1 shall not apply to pensions and annuities paid by the Organisation to the former employees of the European Patent Office.

f) jouissent, en période de crise internationale, ainsi que les membres de leur famille vivant à leur foyer, des mêmes facilités de rapatriement que les agents diplomatiques ;

g) jouissent du droit d'importer en franchise de douane leur mobilier et leurs effets personnels, à l'occasion de leur première installation dans l'Etat intéressé, et du droit, à la cessation de leurs fonctions dans ledit Etat, d'exporter en franchise leur mobilier et leurs effets personnels, sous réserve des conditions jugées nécessaires par le gouvernement de l'Etat sur le territoire duquel le droit est exercé et à l'exception des biens acquis dans cet Etat qui font l'objet, dans celui-ci, d'une prohibition d'exportation.

Article 15

Les experts exerçant des fonctions pour le compte de l'Organisation ou accomplissant des missions pour celle-ci, jouissent des privilèges et immunités ci-après dans la mesure où ils leur sont nécessaires pour l'exercice de leurs fonctions, y compris durant les voyages effectués dans l'exercice de leurs fonctions ou au cours de ces missions :

a) immunité de juridiction pour les actes accomplis dans l'exercice de leurs fonctions, y compris leurs paroles et écrits, sauf dans le cas d'infraction à la réglementation de la circulation des véhicules automoteurs commise par un expert ou de dommage causé par un véhicule automobile lui appartenant ou qu'il conduit ; les experts continueront à bénéficier de cette immunité après la cessation de leurs fonctions auprès de l'Organisation ;

b) inviolabilité pour tous leurs papiers et documents officiels ;

c) facilités de change nécessaires au transfert de leurs rémunérations.

Article 16

(1) Dans les conditions et selon les modalités que le Conseil d'administration fixe dans un délai d'un an à compter de l'entrée en vigueur de la convention, les personnes visées aux articles 13 et 14 seront soumises, au profit de l'Organisation, à un impôt sur les traitements et salaires qui leur sont versés par l'Organisation. A compter de cette date, ces traitements et salaires sont exempts de l'impôt national sur le revenu. Toutefois, les Etats contractants peuvent tenir compte de ces traitements et salaires pour le calcul de l'impôt payable sur les revenus provenant d'autres sources.

(2) Les dispositions du paragraphe premier ne s'appliquent pas aux pensions et retraites payées par l'Organisation aux anciens agents de l'Office européen des brevets.

PROTOKOLL ÜBER VORRECHTE UND IMMUNITÄTEN *Artikel 15*

PROTOCOL ON PRIVILEGES AND IMMUNITIES *Article 15*

PROTOCOLE SUR LES PRIVILÈGES ET IMMUNITÉS *Article 15*

Artikel 17

Der Verwaltungsrat bestimmt die Gruppen von Bediensteten, auf die Artikel 14 ganz oder teilweise und Artikel 16 anzuwenden sind, sowie die Gruppen von Sachverständigen, auf die Artikel 15 anzuwenden ist. Die Namen, Dienstbezeichnungen und Anschriften der zu diesen Gruppen gehörenden Bediensteten und Sachverständigen werden den Vertragsstaaten von Zeit zu Zeit mitgeteilt.

Artikel 18

Vorbehaltlich von Abkommen, die nach Artikel 25 mit den Vertragsstaaten geschlossen werden, sind die Organisation und die Bediensteten des Europäischen Patentamts von sämtlichen Pflichtbeiträgen an staatliche Sozialversicherungsträger befreit, sofern die Organisation ein eigenes Sozialversicherungssystem errichtet.

Artikel 19

(1) Die in diesem Protokoll vorgesehenen Vorrechte und Immunitäten sind nicht dazu bestimmt, den Bediensteten des Europäischen Patentamts oder den Sachverständigen, die für die Organisation oder in deren Auftrag tätig sind, persönliche Vorteile zu verschaffen. Sie sind lediglich zu dem Zweck vorgesehen, unter allen Umständen die ungehinderte Tätigkeit der Organisation und die vollständige Unabhängigkeit der Personen, denen sie gewährt werden, zu gewährleisten.

(2) Der Präsident des Europäischen Patentamts hat die Pflicht, eine Immunität aufzuheben, wenn sie nach seiner Ansicht verhindern würde, dass der Gerechtigkeit Genüge geschieht, und wenn sie ohne Beeinträchtigung der Interessen der Organisation aufgehoben werden kann. Aus den gleichen Gründen kann der Verwaltungsrat eine Immunität des Präsidenten aufheben.

Artikel 20

(1) Die Organisation wird jederzeit mit den zuständigen Behörden der Vertragsstaaten zusammenarbeiten, um die Rechtspflege zu erleichtern, die Einhaltung der Vorschriften über Sicherheit und Ordnung sowie über den Gesundheits- und Arbeitsschutz und ähnlicher staatlicher Rechtsvorschriften zu gewährleisten und jeden Missbrauch der in diesem Protokoll vorgesehenen Vorrechte, Immunitäten und Erleichterungen zu verhindern.

(2) Die Einzelheiten der in Absatz 1 genannten Zusammenarbeit können in den in Artikel 25 genannten Ergänzungsabkommen festgelegt werden.

Artikel 21

Jeder Vertragsstaat behält das Recht, alle im Interesse seiner Sicherheit notwendigen Vorsichtsmaßnahmen zu ergreifen.

Article 17

The Administrative Council shall decide the categories of employees to whom the provisions of Article 14, in whole or in part, and Article 16 shall apply and the categories of experts to whom the provisions of Article 15 shall apply. The names, titles and addresses of the employees and experts included in such categories shall be communicated from time to time to the Contracting States.

Article 18

In the event of the Organisation establishing its own social security scheme, the Organisation and the employees of the European Patent Office shall be exempt from all compulsory contributions to national social security schemes, subject to the agreements made with the Contracting States in accordance with the provisions of Article 25.

Article 19

(1) The privileges and immunities provided for in this Protocol are not designed to give to employees of the European Patent Office or experts performing functions for or on behalf of the Organisation personal advantage. They are provided solely to ensure, in all circumstances, the unimpeded functioning of the Organisation and the complete independence of the persons to whom they are accorded.

(2) The President of the European Patent Office has the duty to waive immunity where he considers that such immunity prevents the normal course of justice and that it is possible to dispense with such immunity without prejudicing the interests of the Organisation. The Administrative Council may waive immunity of the President for the same reasons.

Article 20

(1) The Organisation shall co-operate at all times with the competent authorities of the Contracting States in order to facilitate the proper administration of justice, to ensure the observance of police regulations and regulations concerning public health, labour inspection or other similar national legislation, and to prevent any abuse of the privileges, immunities and facilities provided for in this Protocol.

(2) The procedure of co-operation mentioned in paragraph 1 may be laid down in the complementary agreements referred to in Article 25.

Article 21

Each Contracting State retains the right to take all precautions necessary in the interests of its security.

Article 17

Le Conseil d'administration détermine les catégories d'agents auxquels s'appliquent les dispositions de l'article 14, en tout ou en partie, ainsi que les dispositions de l'article 16 et les catégories d'experts auxquels s'appliquent les dispositions de l'article 15. Les noms, qualités et adresses des agents et experts compris dans ces catégories sont communiquées périodiquement aux Etats contractants.

Article 18

L'Organisation et les agents de l'Office européen des brevets sont exempts de toutes contributions obligatoires à des organismes nationaux de prévoyance sociale, au cas où l'Organisation établirait son propre système de prévoyance sociale, sous réserve des accords à passer avec les Etats contractants, conformément aux dispositions de l'article 25.

Article 19

(1) Les privilèges et immunités prévus par le présent protocole ne sont pas établis en vue d'accorder aux agents de l'Office européen des brevets ou aux experts exerçant des fonctions au profit ou pour le compte de l'Organisation des avantages personnels. Ils sont institués uniquement afin d'assurer, en toutes circonstances, le libre fonctionnement de l'Organisation et la complète indépendance des personnes auxquelles ils sont accordés.

(2) Le Président de l'Office européen des brevets a le devoir de lever l'immunité lorsqu'il estime qu'elle empêche le jeu normal de la justice et qu'il est possible d'y renoncer sans porter atteinte aux intérêts de l'Organisation. Le Conseil d'administration peut, pour les mêmes raisons, lever l'une des immunités accordées au Président.

Article 20

(1) L'Organisation coopère en tout temps avec les autorités compétentes des Etats contractants, en vue de faciliter une bonne administration de la justice, d'assurer l'observation des règlements de police et de ceux concernant la santé publique et l'inspection du travail, ou autres lois nationales de nature analogue, et empêcher tout abus des privilèges, immunités et facilités prévus par le présent protocole.

(2) La procédure de coopération mentionnée au paragraphe premier pourra être précisée dans les accords complémentaires visés à l'article 25.

Article 21

Chaque Etat contractant conserve le droit de prendre toutes les mesures nécessaires dans l'intérêt de sa sécurité.

PROTOKOLL ÜBER VORRECHTE
UND IMMUNITÄTEN

Artikel 17

PROTOCOL ON PRIVILEGES AND IMMUNITIES
Article 17

PROTOCOLE SUR LES PRIVILÈGES
ET IMMUNITÉS

Article 17

Artikel 22

Ein Vertragsstaat ist nicht verpflichtet, die in den Artikeln 12, 13, 14 Buchstaben b, e und g sowie in Artikel 15 Buchstabe c bezeichneten Vorrechte und Immunitäten zu gewähren:

- a) seinen eigenen Staatsangehörigen;
- b) Personen, die bei Aufnahme ihrer Tätigkeit bei der Organisation ihren ständigen Wohnsitz in diesem Staat haben und nicht Bedienstete einer anderen zwischenstaatlichen Organisation sind, deren Personal in die Organisation übernommen wird.

Artikel 23

(1) Jeder Vertragsstaat kann einem internationalen Schiedsgericht jede Streitigkeit unterbreiten, die sich auf die Organisation oder einen Bediensteten oder Sachverständigen, der für die Organisation oder in deren Auftrag tätig ist, bezieht, soweit die Organisation oder die Bediensteten und Sachverständigen ein Vorrecht oder eine Immunität nach diesem Protokoll in Anspruch genommen haben und diese Immunität nicht aufgehoben worden ist.

(2) Hat ein Vertragsstaat die Absicht, eine Streitigkeit einem Schiedsgericht zu unterbreiten, so notifiziert er dies dem Präsidenten des Verwaltungsrats; dieser unterrichtet sofort jeden Vertragsstaat von der Notifikation.

(3) Das Verfahren nach Absatz 1 ist auf Streitigkeiten zwischen der Organisation und den Bediensteten oder Sachverständigen über das Statut oder die Beschäftigungsbedingungen oder, was die Bediensteten anbelangt, über die Versorgungsordnung nicht anzuwenden.

(4) Gegen den Spruch des Schiedsgerichts, der endgültig und für die Parteien bindend ist, kann ein Rechtsmittel nicht eingelegt werden. Im Fall einer Streitigkeit über Sinn und Tragweite des Schiedsspruchs obliegt es dem Schiedsgericht, den Spruch auf Antrag einer Partei auszulegen.

Artikel 24

(1) Das in Artikel 23 genannte Schiedsgericht besteht aus drei Mitgliedern; ein Schiedsrichter wird von dem Staat oder den Staaten, die Parteien des Schiedsverfahrens sind, ein weiterer vom Verwaltungsrat ernannt; diese beiden Schiedsrichter ernennen einen dritten Schiedsrichter, der als Obmann tätig wird.

(2) Die Schiedsrichter werden aus einem Verzeichnis ausgewählt, das höchstens sechs von jedem Vertragsstaat und sechs vom Verwaltungsrat benannte Schiedsrichter umfasst. Dieses Verzeichnis wird so bald wie möglich nach Inkrafttreten dieses Protokolls erstellt und in der Folge je nach Bedarf geändert.

Article 22

No Contracting State is obliged to extend the privileges and immunities referred to in Article 12, Article 13, Article 14, sub-paragraphs (b), (e) and (g), and Article 15, sub-paragraph (c), to:

- (a) its own nationals;
- (b) any person who at the time of taking up his functions with the Organisation has his permanent residence in that State and is not an employee of any other inter-governmental organisation whose staff is incorporated into the Organisation.

Article 23

(1) Any Contracting State may submit to an international arbitration tribunal any dispute concerning the Organisation or an employee of the European Patent Office or an expert performing functions for or on its behalf, in so far as the Organisation or the employees and experts have claimed a privilege or an immunity under this Protocol in circumstances where that immunity has not been waived.

(2) If a Contracting State intends to submit a dispute to arbitration, it shall notify the Chairman of the Administrative Council, who shall forthwith inform each Contracting State of such notification.

(3) The procedure laid down in paragraph 1 of this Article shall not apply to disputes between the Organisation and the employees or experts in respect of the Service Regulations or conditions of employment or, with regard to the employees, the Pension Scheme Regulations.

(4) No appeal shall lie against the award of the arbitration tribunal, which shall be final; it shall be binding on the parties. In case of dispute concerning the import or scope of the award, it shall be incumbent upon the arbitration tribunal to interpret it on request by either party.

Article 24

(1) The arbitration tribunal referred to in Article 23 shall consist of three members, one arbitrator nominated by the State or States party to the arbitration, one arbitrator nominated by the Administrative Council and a third arbitrator, who shall be the chairman, nominated by the said two arbitrators.

(2) The arbitrators shall be nominated from a panel comprising no more than six arbitrators appointed by each Contracting State and six arbitrators appointed by the Administrative Council. This panel shall be established as soon as possible after the Protocol enters into force and shall be revised each time this proves necessary.

Article 22

Aucun Etat contractant n'est tenu d'accorder les privilèges et immunités mentionnés aux articles 12, 13, 14 lettres b), e) et g), et 15 lettre c)

- a) à ses propres nationaux ;
- b) aux personnes qui, lors de leur entrée en fonctions auprès de l'Organisation, ont leur résidence permanente dans cet Etat et ne sont pas agents d'une autre organisation intergouvernementale dont le personnel est incorporé à l'Organisation.

Article 23

(1) Chaque Etat contractant peut soumettre à un Tribunal d'arbitrage international tout différend mettant en cause l'Organisation, ou les agents ou experts exerçant des fonctions au profit ou pour le compte de l'Organisation, dans la mesure où celle-ci, ces agents ou experts ont revendiqué un privilège ou une immunité en vertu du présent protocole, dans les cas où il n'a pas été renoncé à cette immunité.

(2) Si un Etat contractant a l'intention de soumettre un différend à l'arbitrage, il le notifie au président du Conseil d'administration qui informe immédiatement chaque Etat contractant de cette notification.

(3) La procédure prévue au paragraphe premier n'est pas applicable aux différends entre l'Organisation et les agents ou experts au sujet du statut ou des conditions d'emploi ainsi que, pour les agents, au sujet du règlement des pensions.

(4) La sentence du Tribunal d'arbitrage est définitive et sans recours ; les parties s'y conformeront. En cas de contestation sur le sens et la portée de la sentence, il appartient au Tribunal d'arbitrage de l'interpréter à la demande de toute partie.

Article 24

(1) Le Tribunal d'arbitrage prévu à l'article 23 est composé de trois membres, un arbitre nommé par l'Etat, ou les Etats, partie à l'arbitrage, un arbitre nommé par le Conseil d'administration et un troisième arbitre, qui assume la présidence, nommé par les deux premiers.

(2) Ces arbitres sont choisis sur une liste comprenant six arbitres au plus désignés par chaque Etat contractant et six arbitres désignés par le Conseil d'administration. Cette liste est établie dès que possible après l'entrée en vigueur du présent protocole et, par la suite, complétée, le cas échéant, en tant que de besoin.

PROTOKOLL ÜBER VORRECHTE
UND IMMUNITÄTEN

Artikel 22

PROTOCOL ON PRIVILEGES AND IMMUNITIES
Article 22

PROTOCOLE SUR LES PRIVILÈGES
ET IMMUNITÉS

Article 22

(3) Nimmt eine Partei innerhalb von drei Monaten nach der in Artikel 23 Absatz 2 genannten Notifizierung die in Absatz 1 vorgesehene Ernennung nicht vor, so wird der Schiedsrichter auf Antrag der anderen Partei vom Präsidenten des Internationalen Gerichtshofs aus dem Kreis der in dem Verzeichnis aufgeführten Personen bestimmt. Das Gleiche geschieht auf Antrag der zuerst handelnden Partei, wenn innerhalb eines Monats nach der Ernennung des zweiten Schiedsrichters die beiden ersten Schiedsrichter sich nicht über die Ernennung des dritten einigen können. Ist jedoch in diesen beiden Fällen der Präsident des Internationalen Gerichtshofs verhindert, die Wahl zu treffen, oder ist er Angehöriger eines an der Streitigkeit beteiligten Staats, so nimmt der Vizepräsident des Internationalen Gerichtshofs die erwähnten Ernennungen vor, sofern er nicht selbst Angehöriger eines an der Streitigkeit beteiligten Staats ist; im letztgenannten Fall obliegt es dem Mitglied des Internationalen Gerichtshofs, das nicht selbst Angehöriger eines an der Streitigkeit beteiligten Staats ist und das vom Präsidenten oder Vizepräsidenten ausgewählt worden ist, die Ernennung vorzunehmen. Ein Angehöriger des antragstellenden Staats kann nicht für den Posten des Schiedsrichters gewählt werden, dessen Ernennung dem Verwaltungsrat oblag, und eine auf Vorschlag des Verwaltungsrats in das Verzeichnis aufgenommene Person kann nicht für den Posten des Schiedsrichters gewählt werden, dessen Ernennung dem antragstellenden Staat oblag. Die diesen beiden Gruppen angehörenden Personen können auch nicht zum Obmann des Schiedsgerichts gewählt werden.

(4) Das Schiedsgericht gibt sich eine Verfahrensordnung.

Artikel 25

Die Organisation kann auf Beschluss des Verwaltungsrats mit einem oder mehreren Vertragsstaaten Ergänzungsabkommen zur Durchführung dieses Protokolls in ihren Beziehungen mit diesem Staat oder diesen Staaten sowie sonstige Vereinbarungen schließen, um eine wirksame Tätigkeit der Organisation und den Schutz ihrer Interessen zu gewährleisten.

(3) If, within three months from the date of the notification referred to in Article 23, paragraph 2, either party fails to make the nomination referred to in paragraph 1 above, the choice of the arbitrator shall, on request of the other party, be made by the President of the International Court of Justice from the persons included in the said panel. This shall also apply, when so requested by either party, if within one month from the date of appointment of the second arbitrator, the first two arbitrators are unable to agree on the nomination of the third arbitrator. However, if, in these two cases, the President of the International Court of Justice is prevented from making the choice, or if he is a national of one of the States parties to the dispute, the Vice-President of the International Court of Justice shall make the aforementioned appointments, provided that he himself is not a national of one of the States parties to the dispute; if such is the case, the member of the International Court of Justice who is not a national of one of the States parties to the dispute and who has been chosen by the President or Vice-President shall make the appointments. A national of the State applying for arbitration may not be chosen to fill the post of the arbitrator whose appointment devolves on the Administrative Council nor may a person included in the panel and appointed by the Administrative Council be chosen to fill the post of an arbitrator whose appointment devolves on the State which is the claimant. Nor may a person of either of these categories be chosen as chairman of the Tribunal.

(4) The arbitration tribunal shall draw up its own rules of procedure.

Article 25

The Organisation may, on a decision of the Administrative Council, conclude with one or more Contracting States complementary agreements to give effect to the provisions of this Protocol as regards such State or States, and other arrangements to ensure the efficient functioning of the Organisation and the safeguarding of its interests.

(3) Si, dans un délai de trois mois après la notification mentionnée à l'article 23, paragraphe 2, l'une des parties s'abstient de procéder à la nomination prévue au paragraphe premier, le choix de l'arbitre est effectué, sur la requête de l'autre partie, par le Président de la Cour Internationale de Justice parmi les personnes figurant sur ladite liste. Il en est de même, à la requête de la partie la plus diligente, lorsque, dans un délai d'un mois à compter de la nomination du deuxième arbitre, les deux premiers arbitres ne parviennent pas à s'entendre sur la nomination du troisième. Toutefois, dans ces deux cas, si le Président de la Cour Internationale de Justice est empêché d'effectuer le choix ou s'il est ressortissant de l'un des Etats parties au différend, le Vice-Président de la Cour Internationale procède aux nominations susvisées, à moins qu'il ne soit lui-même ressortissant de l'un des Etats parties au différend : dans cette dernière hypothèse il appartient au membre de la Cour Internationale, qui n'est pas lui-même ressortissant de l'un des Etats parties au différend et qui a été choisi par le Président ou le Vice-Président, de procéder aux nominations. Un ressortissant de l'Etat demandeur ne peut être choisi pour occuper le siège de l'arbitre dont la nomination incombait au Conseil d'administration, ni une personne inscrite sur la liste par désignation du Conseil d'administration choisie pour occuper le siège de l'arbitre dont la nomination incombait à l'Etat demandeur. Les personnes appartenant à ces deux catégories ne peuvent pas davantage être choisies pour assumer la présidence du Tribunal.

(4) Le Tribunal d'arbitrage établit ses règles de procédure.

Article 25

L'Organisation peut, sur décision du Conseil d'administration conclure, avec un ou plusieurs Etats contractants, des accords complémentaires en vue de l'exécution des dispositions du présent protocole, en ce qui concerne ce ou ces Etats, ainsi que d'autres arrangements en vue d'assurer le bon fonctionnement de l'Organisation et la sauvegarde de ses intérêts.

PROTOKOLL ÜBER VORRECHTE UND IMMUNITÄTEN *Artikel 25*

PROTOCOL ON PRIVILEGES AND IMMUNITIES *Article 25*

PROTOCOLE SUR LES PRIVILÈGES ET IMMUNITÉS *Article 25*

**PROTOKOLL ÜBER DEN PERSONALBESTAND DES
EUROPÄISCHEN PATENTAMTS IN DEN HAAG
(PERSONALSTANDSPROTOKOLL)**

vom 29. November 2000

**PROTOCOL ON THE STAFF COMPLEMENT
OF THE EUROPEAN PATENT OFFICE AT THE HAGUE
(PROTOCOL ON THE STAFF COMPLEMENT)**

of 29 November 2000

**PROTOCOLE SUR LES EFFECTIFS
DE L'OFFICE EUROPEEN DES BREVETS A LA HAYE
(PROTOCOLE SUR LES EFFECTIFS)**

du 29 novembre 2000

Die Europäische Patentorganisation gewährleistet, dass der Anteil der Planstellen des Europäischen Patentamts, der nach dem Organisations- und Stellenplan für das Jahr 2000 auf den Dienstort Den Haag entfällt, im Wesentlichen unverändert bleibt. Eine Änderung der Zahl der auf den Dienstort Den Haag entfallenden Planstellen, die im Interesse des guten Funktionierens des Europäischen Patentamts erforderlich wird und eine Abweichung von dem oben genannten Anteil um mehr als zehn Prozent zur Folge hat, bedarf eines Beschlusses des Verwaltungsrats der Organisation auf Vorschlag des Präsidenten des Europäischen Patentamts nach Konsultation mit den Regierungen der Bundesrepublik Deutschland und des Königreichs der Niederlande.¹

The European Patent Organisation shall ensure that the proportion of European Patent Office posts assigned to the duty station at The Hague as defined under the 2000 establishment plan and table of posts remains substantially unchanged. Any change in the number of posts assigned to the duty station at The Hague resulting in a deviation of more than ten per cent of that proportion, which proves necessary for the proper functioning of the European Patent Office, shall be subject to a decision by the Administrative Council of the Organisation on a proposal from the President of the European Patent Office after consultation with the Governments of the Federal Republic of Germany and the Kingdom of the Netherlands.¹

¹ In das Europäische Patentübereinkommen als dessen Bestandteil aufgenommen durch die Akte zur Revision des Europäischen Patentübereinkommens vom 29.11.2000 und vorläufig anwendbar ab 29.11.2000 (ABI. EPA 2001, Sonderausgabe Nr. 4).

¹ Annexed to the European Patent Convention as an integral part thereof by the Act revising the European Patent Convention of 29.11.2000 and provisionally applicable as of 29.11.2000 (OJ EPO 2001, Special edition No. 4).

L'Organisation européenne des brevets garantit que la proportion des emplois de l'Office européen des brevets assignée au département de La Haye, telle que définie dans l'organigramme des emplois et le tableau des effectifs pour l'an 2000, demeure pour l'essentiel inchangée. Toute modification du nombre des emplois assignés au département de La Haye se traduisant par un écart de plus de dix pour cent par rapport à cette proportion, qui se révèle nécessaire pour assurer le bon fonctionnement de l'Office européen des brevets, requiert une décision du Conseil d'administration de l'Organisation, prise sur proposition du Président de l'Office européen des brevets, après consultation des gouvernements de la République fédérale d'Allemagne et du Royaume des Pays-Bas.¹

PERSONALSTANDSPROTOKOLL
PROTOCOL ON THE STAFF COMPLEMENT
PROTOCOLE SUR LES EFFECTIFS

¹ Inséré dans la Convention sur le brevet européen comme partie intégrante de celle-ci par l'acte portant révision de la Convention sur le brevet européen en date du 29.11.2000 et applicable à titre provisoire à partir du 29.11.2000 (JO OEB 2001, édition spéciale n° 4).

GEBÜHRENORDNUNG

vom 20. Oktober 1977

zuletzt geändert durch Beschluss des Verwaltungsrats der Europäischen Patentorganisation
vom 15. Dezember 2005

RULES RELATING TO FEES

of 20 October 1977

as last amended by decision of the Administrative Council of the European Patent Organisation
of 15 December 2005

RÈGLEMENT RELATIF AUX TAXES

du 20 octobre 1977

tel que modifié en dernier lieu par décision du Conseil d'administration de l'Organisation
européenne des brevets en date du 15 décembre 2005

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DER VERWALTUNGSRAT DER EUROPÄISCHEN
PATENTORGANISATION -

GESTÜTZT auf das Europäische Patentübereinkommen, insbesondere auf Artikel 33 Absatz 2 Buchstabe d -

GIBT SICH HIERMIT FOLGENDE GEBÜHREN-
ORDNUNG:

Artikel 1

Allgemeines

Nach den Vorschriften dieser Gebührenordnung werden erhoben:

a) die gemäß dem Übereinkommen und seiner Ausführungsordnung an das Europäische Patentamt (nachstehend Amt genannt) zu entrichtenden Gebühren sowie die Gebühren und Auslagen, die der Präsident des Amts auf Grund des Artikels 3 Absatz 1 festsetzt;

b) die Gebühren und Auslagen nach dem Vertrag über die internationale Zusammenarbeit auf dem Gebiet des Patentwesens (PCT), deren Höhe vom Amt festgesetzt werden kann.

Artikel 2¹

Im Übereinkommen und seiner Ausführungsordnung vorgesehene Gebühren

Die nach Artikel 1 an das Amt zu entrichtenden Gebühren werden wie folgt festgesetzt:

EUR

- | | |
|--|-----|
| 1. Anmeldegebühr (Artikel 78 Absatz 2), nationale Grundgebühr (Regel 106 Buchstabe a), wenn | |
| - die europäische Patentanmeldung oder, im Falle einer internationalen Anmeldung, das Formblatt für den Eintritt in die europäische Phase (E-PA Form 1200) online eingereicht wird | 95 |
| - die europäische Patentanmeldung oder, im Falle einer internationalen Anmeldung, das Formblatt für den Eintritt in die europäische Phase (E-PA Form 1200) auf Papier eingereicht wird | 170 |

THE ADMINISTRATIVE COUNCIL OF THE
EUROPEAN PATENT ORGANISATION,

HAVING REGARD to the European Patent Convention and in particular Article 33, paragraph 2(d), thereof,

HAS ADOPTED THE FOLLOWING RULES RELATING
TO FEES:

Article 1

General

The following shall be levied in accordance with the provisions contained in these Rules:

(a) fees due to be paid to the European Patent Office (hereinafter referred to as the Office) as provided for in the Convention and in the Implementing Regulations and the fees and costs which the President of the Office lays down pursuant to Article 3, paragraph 1;

(b) fees and costs pursuant to the Patent Cooperation Treaty (hereinafter referred to as the PCT), the amounts of which may be fixed by the Office.

Article 2¹

Fees provided for in the Convention and in the Implementing Regulations

The fees due to be paid to the Office under Article 1 shall be as follows:

EUR

- | | |
|---|-----|
| 1. Filing fee (Article 78, paragraph 2); national basic fee (Rule 106(a)) where | |
| - the European patent application or, in the case of an international application, the form for entry into the European phase (EPO Form 1200) is filed online | 95 |
| - the European patent application or, in the case of an international application, the form for entry into the European phase (EPO Form 1200) is filed on paper | 170 |

¹ Zuletzt geändert durch den Beschluss des Verwaltungsrats vom 15.12.2005, Tag des Inkrafttretens: 01.04.2006 (ABI. EPA 2006, 8 ff.).

¹ Last amended by decision of the Administrative Council of 15.12.2005, date of entry into force: 01.04.2006 (OJ EPO 2006, 8 ff.).

LE CONSEIL D'ADMINISTRATION DE L'ORGANISATION EUROPÉENNE DES BREVETS,

VU la Convention sur le brevet européen et notamment son article 33, paragraphe 2, lettre d),

ARRÊTE LE RÈGLEMENT RELATIF AUX TAXES SUIVANT :

Article premier

Disposition générale

Sont perçues conformément aux dispositions du présent règlement :

- a) les taxes à payer à l'Office européen des brevets, ci-après dénommé l'Office, en vertu de la Convention et de son règlement d'exécution, ainsi que les taxes et frais que le Président de l'Office fixe en vertu de l'article 3, paragraphe 1,
- b) les taxes et frais au titre du Traité de coopération en matière de brevets (PCT) dont l'Office peut fixer le montant.

Article 2¹

Taxes prévues dans la Convention et dans son règlement d'exécution

Les taxes à payer à l'Office en vertu de l'article premier sont fixées comme suit :

EUR

- | | |
|---|-----|
| 1. Taxe de dépôt (article 78, paragraphe 2) ; taxe nationale de base (règle 106, lettre a)) lorsque | |
| - la demande de brevet européen ou, dans le cas d'une demande internationale, le formulaire d'entrée dans la phase européenne (formulaire OEB 1200) est déposé en ligne | 95 |
| - la demande de brevet européen ou, dans le cas d'une demande internationale, le formulaire d'entrée dans la phase européenne (formulaire OEB 1200) est déposé sur papier | 170 |

¹ Modifié en dernier lieu par la décision du Conseil d'administration en date du 15.12.2005, date d'entrée en vigueur : 01.04.2006 (JO OEB 2006, 8 s.).

GEBÜHRENORDNUNG
Artikel 1

RULES RELATING TO FEES
Article 1

RÈGLEMENT RELATIF AUX TAXES
Article premier

2. Recherchegebühr		2. Search fee in respect of	
- für eine europäische Recherche oder eine ergänzende europäische Recherche zu einer ab dem 1. Juli 2005 eingereichten Anmeldung (Artikel 78 Absatz 2, Regel 44a, Regel 46 Absatz 1, Regel 112, Artikel 157 Absatz 2 Buchstabe b)	1 000	- a European or supplementary European search on an application filed on or after 1 July 2005 (Article 78, paragraph 2, Rule 44a, Rule 46, paragraph 1, and Rule 112, Article 157, paragraph 2(b))	1 000
- für eine ergänzende europäische Recherche zu einer vor dem 1. Juli 2005 eingereichten Anmeldung (Artikel 157 Absatz 2 Buchstabe b)	720	- a supplementary European search on an application filed before 1 July 2005 (Article 157, paragraph 2(b))	720
- für eine internationale Recherche (Regel 16.1 PCT und Regel 105 Absatz 1)	1 615 ²	- an international search (Rule 16.1 PCT and Rule 105, paragraph 1)	1 615 ²
3. Benennungsgebühr für jeden benannten Vertragsstaat (Artikel 79 Absatz 2) mit der Maßgabe, dass mit der Entrichtung des siebenfachen Betrags dieser Gebühr die Benennungsgebühren für alle Vertragsstaaten als entrichtet gelten	80	3. Designation fee for each contracting state designated (Article 79, paragraph 2), designation fees being deemed paid for all contracting states upon payment of seven times the amount of this fee	80
3a. Gemeinsame Benennungsgebühr für die Schweizerische Eidgenossenschaft und das Fürstentum Liechtenstein	80	3a. Joint designation fee for the Swiss Confederation and the Principality of Liechtenstein	80
3b. Zuschlagsgebühr für die verspätete Entrichtung der Anmeldegebühr, der Recherchegebühr oder der Benennungsgebühren (Regel 85a)	50 % der betreffenden Gebühr oder Gebühren, insgesamt jedoch höchstens 680 EUR	3b. Surcharge for late payment of the filing fee, the search fee or the designation fee (Rule 85a)	50% of the relevant fee or fees, but not to exceed a total of EUR 680
3c. ³ Zuschlagsgebühr für die verspätete Einreichung der Übersetzung der internationalen Anmeldung oder die verspätete Stellung des Prüfungsantrags oder die verspätete Entrichtung der nationalen Grundgebühr, der Recherchegebühr oder der Benennungsgebühren (Regel 108 Absätze 3 und 4 ⁴)	50 % der betreffenden Gebühren, jedoch mindestens 520 EUR bei verspäteter Einreichung der Übersetzung und insgesamt höchstens 1 820 EUR	3c. ³ Surcharge for late filing of either the translation of the international application or the request for examination, or for late payment of the national basic fee, the search fee or the designation fees (Rule 108(3) and (4) ⁴)	50% of the relevant fees, but at least EUR 520 for late filing of the translation up to a maximum of EUR 1 820

² Siehe hierzu Beschluss des Verwaltungsrats vom 11.10.2000 über die Ermäßigung dieser Gebühr zu Gunsten der Staatsangehörigen bestimmter Länder (ABI. EPA 2000, 446).

³ Eingefügt durch Beschluss des Verwaltungsrats vom 28.06.2001, in Kraft getreten am 02.01.2002 (ABI. EPA 2001, 374 ff.).

⁴ Geändert durch Beschluss des Verwaltungsrats vom 09.12.2004, in Kraft getreten am 01.04.2005 (ABI. EPA 2005, 11 f.).

² See the decision of the Administrative Council of 11.10.2000 concerning the reduction of this fee in favour of nationals of certain states (OJ EPO 2000, 446).

³ Inserted by decision of the Administrative Council of 28.06.2001 which entered into force on 02.01.2002 (OJ EPO 2001, 374 ff.).

⁴ Amended by decision of the Administrative Council of 09.12.2004 which entered into force on 01.04.2005 (OJ EPO 2005, 11 f.).

2. Taxe de recherche

- par recherche européenne ou recherche européenne complémentaire effectuée pour une demande déposée à partir du 1^{er} juillet 2005 (article 78, paragraphe 2, règle 44bis, règle 46, paragraphe 1, et règle 112, article 157, paragraphe 2, lettre b)) 1 000

- par recherche européenne complémentaire effectuée pour une demande déposée avant le 1^{er} juillet 2005 (article 157, paragraphe 2, lettre b) 720

- par recherche internationale (règle 16, paragraphe 1 du PCT et règle 105, paragraphe 1) 1 615²

3. Taxe de désignation pour chaque Etat contractant désigné (article 79, paragraphe 2), les taxes de désignation étant réputées acquittées pour tous les Etats contractants dès lors qu'un montant correspondant à sept fois cette taxe a été acquitté 80

3bis. Taxe de désignation conjointe pour la Confédération helvétique et la Principauté du Liechtenstein 80

3ter. Surtaxe pour retard de paiement de la taxe de dépôt, de la taxe de recherche ou des taxes de désignation (règle 85bis) 50 % de la taxe ou des taxes concernées, sans que le montant total puisse dépasser 680 EUR

3quater.³ Surtaxe pour production tardive de la traduction de la demande internationale, pour présentation tardive de la requête en examen ou pour retard de paiement de la taxe nationale de base, de la taxe de recherche ou des taxes de désignation (règle 108, paragraphes 3 et 4⁴) 50 % des taxes concernées, sans que le montant puisse être inférieur à 520 EUR en cas de production tardive de la traduction et sans que le montant total puisse dépasser 1 820 EUR

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Article 2

² Cf. la décision du Conseil d'administration du 11.10.2000 portant réduction de cette taxe pour les ressortissants de certains pays (JO OEB 2000, 446).

³ Inséré par décision du Conseil d'administration en date du 28.06.2001, entrée en vigueur le 02.01.2002 (JO OEB 2001, 374 s.).

⁴ Modifié par décision du Conseil d'administration en date du 09.12.2004, entrée en vigueur le 01.04.2005 (JO OEB 2005, 11 s.).

4.	Jahresgebühren für die europäische Patentanmeldung (Artikel 86 Absatz 1), jeweils gerechnet vom Anmeldetag an		4.	Renewal fees for the European patent applications (Article 86, paragraph 1), calculated in each case from the date of filing of the application	
	- für das 3. Jahr	400		- for the 3rd year	400
	- für das 4. Jahr	425		- for the 4th year	425
	- für das 5. Jahr	450		- for the 5th year	450
	- für das 6. Jahr	745		- for the 6th year	745
	- für das 7. Jahr	770		- for the 7th year	770
	- für das 8. Jahr	800		- for the 8th year	800
	- für das 9. Jahr	1 010		- for the 9th year	1 010
	- für das 10. Jahr und jedes weitere Jahr	1 065		- for the 10th and each subsequent year	1 065
5.	Zuschlagsgebühr für die verspätete Zahlung einer Jahresgebühr für die europäische Patentanmeldung (Artikel 86 Absatz 2)	10 % der verspätet gezahlten Jahresgebühr	5.	Additional fee for belated payment of a renewal fee for the European patent application (Article 86, paragraph 2)	10% of the belated renewal fee
6.	Prüfungsgebühr (Artikel 94 Absatz 2)		6.	Examination fee (Article 94, paragraph 2) in respect of	
	- für eine vor dem 1. Juli 2005 eingereichte Anmeldung	1 490		- an application filed before 1 July 2005	1 490
	- für eine ab dem 1. Juli 2005 eingereichte Anmeldung	1 335		- an application filed on or after 1 July 2005	1 335
	- für eine ab dem 1. Juli 2005 eingereichte internationale Anmeldung, für die kein ergänzender europäischer Recherchenbericht erstellt wird (Artikel 157 Absatz 3 Buchstabe a)	1 490		- an international application filed on or after 1 July 2005 for which no supplementary European search report is drawn up (Article 157, paragraph 3(a))	1 490
7.	Zuschlagsgebühr für die verspätete Stellung des Prüfungsantrags (Regel 85b)	50 % der Prüfungsgebühr	7.	Surcharge for late filing of the request for examination (Rule 85b)	50% of the examination fee
8.	Erteilungsgebühr einschließlich Druckkostengebühr für die europäische Patentschrift (Artikel 97 Absatz 2 Buchstabe b) bei einer Seitenzahl der für den Druck bestimmten Anmeldungsunterlagen von		8.	Fee for grant, including fee for printing the European patent specification (Article 97, paragraph 2(b)), where the application documents to be printed comprise:	
8.1	höchstens 35 Seiten	750	8.1	not more than 35 pages	750
8.2	mehr als 35 Seiten	750 zuzüglich 11 EUR für die 36. und jede weitere Seite	8.2	more than 35 pages	750 plus EUR 11 for the 36 th and each subsequent page

4.	Taxes annuelles pour la demande de brevet européen (article 86, paragraphe 1), chaque année étant calculée à compter de la date de dépôt de la demande	
	- pour la troisième année	400
	- pour la quatrième année	425
	- pour la cinquième année	450
	- pour la sixième année	745
	- pour la septième année	770
	- pour la huitième année	800
	- pour la neuvième année	1 010
	- pour la dixième année et chacune des années suivantes	1 065
5.	Surtaxe pour retard de paiement d'une taxe annuelle pour une demande de brevet européen (article 86, paragraphe 2)	10 % de la taxe annuelle payée en retard
6.	Taxe d'examen (article 94, paragraphe 2)	
	- pour une demande de brevet déposée avant le 1 ^{er} juillet 2005	1 490
	- pour une demande de brevet déposée à compter du 1 ^{er} juillet 2005	1 335
	- pour une demande internationale déposée à compter du 1 ^{er} juillet 2005 pour laquelle il n'est pas établi de rapport complémentaire de recherche européenne (article 157, paragraphe 3, lettre a))	1 490
7.	Surtaxe pour présentation tardive de la requête en examen (règle 85ter)	50 % de la taxe d'examen
8.	Taxe de délivrance du brevet, y compris taxe d'impression du fascicule du brevet européen (article 97, paragraphe 2, lettre b)), lorsque les pièces de la demande destinées à être imprimées comportent	
8.1	35 pages au maximum	750
8.2	plus de 35 pages	750 plus 11 EUR pour chaque page à partir de la 36 ^e

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Article 2

9. Druckkostengebühr für eine neue europäische Patentschrift (Artikel 102 Absatz 3 Buchstabe b)		9. Fee for printing a new specification of the European patent (Article 102, paragraph 3(b))	
- Pauschalgebühr	55	- flat-rate fee	55
10. Einspruchsgebühr (Artikel 99 Absatz 1 und Artikel 105 Absatz 2)	635	10. Opposition fee (Article 99, paragraph 1, and Article 105, paragraph 2)	635
11. Beschwerdegebühr (Artikel 108)	1 065	11. Fee for appeal (Article 108)	1 065
12. Weiterbehandlungsgebühr (Artikel 121 Absatz 2)	210	12. Fee for further processing (Article 121, paragraph 2)	210
13. Wiedereinsetzungsgebühr (Artikel 122 Absatz 3)	365	13. Fee for re-establishment of rights (Article 122, paragraph 3)	365
14. Umwandlungsgebühr (Artikel 136 Absatz 1 und Artikel 140)	55	14. Conversion fee (Article 136, paragraph 1, and Article 140)	55
15. Anspruchsgebühr für den elften und jeden weiteren Patentanspruch (Regel 31 Absatz 1, Regel 51 Absatz 7 und Regel 110 Absatz 1)	45	15. Claims fee for the eleventh and each subsequent claim (Rule 31, paragraph 1, Rule 51, paragraph 7, and Rule 110, paragraph 1)	45
16. Kostenfestsetzungsgebühr (Regel 63 Absatz 3)	55	16. Fee for the awarding of costs (Rule 63, paragraph 3)	55
17. Beweissicherungsgebühr (Regel 75 Absatz 3)	55	17. Fee for the conservation of evidence (Rule 75, paragraph 3)	55
18. Übermittlungsgebühr für eine internationale Anmeldung (Artikel 152 Absatz 3)	105	18. Transmittal fee for an international application (Article 152, paragraph 3)	105
19. Gebühr für die vorläufige Prüfung einer internationalen Anmeldung (Regel 58 PCT und Regel 105 Absatz 2)	1 595 ⁵	19. Fee for the preliminary examination of an international application (Rule 58 PCT and Rule 105, paragraph 2)	1 595 ⁵
20. Gebühr für ein technisches Gutachten (Artikel 25)	3 185	20. Fee for a technical opinion (Article 25)	3 185
21. Widerspruchsgebühr (Regeln 40.2 e) und 68.3 e) PCT, Regel 105 Absatz 3)	1 065	21. Protest fee (Rules 40.2(e) and 68.3(e) PCT, Rule 105, paragraph 3)	1 065

Artikel 3

Vom Präsidenten des Amts festgesetzte Gebühren, Auslagen und Verkaufspreise

(1) Der Präsident des Amts setzt die in der Ausführungsordnung genannten Verwaltungsgebühren und, soweit erforderlich, die Gebühren und Auslagen für andere als in Artikel 2 genannte Amtshandlungen des Amts fest.

Article 3

Fees, costs and prices laid down by the President of the Office

(1) The President of the Office shall lay down the amount of the administrative fees provided for in the Implementing Regulations and, where appropriate, the amount of the fees and costs for any services rendered by the Office other than those specified in Article 2.

⁵ Siehe hierzu Beschluss des Verwaltungsrats vom 11.10.2000 über die Ermäßigung dieser Gebühr zu Gunsten der Staatsangehörigen bestimmter Länder (ABI. EPA 2000, 446).

⁵ See the decision of the Administrative Council of 11.10.2000 concerning the reduction of this fee in favour of nationals of certain states (OJ EPO 2000, 446).

9.	Taxe d'impression d'un nouveau fascicule du brevet européen (article 102, paragraphe 3, lettre b)	
	- taxe forfaitaire	55
10.	Taxe d'opposition (article 99, paragraphe 1 et article 105, paragraphe 2)	635
11.	Taxe de recours (article 108)	1 065
12.	Taxe de poursuite de la procédure (article 121, paragraphe 2)	210
13.	Taxe de restitutio in integrum (article 122, paragraphe 3)	365
14.	Taxe de transformation (article 136, paragraphe 1 et article 140)	55
15.	Taxe pour chaque revendication à partir de la onzième (règle 31, paragraphe 1, règle 51 paragraphe 7 et règle 110, paragraphe 1)	45
16.	Taxe de fixation des frais (règle 63, paragraphe 3)	55
17.	Taxe de conservation de la preuve (règle 75, paragraphe 3)	55
18.	Taxe de transmission pour une demande internationale de brevet (article 152, paragraphe 3)	105
19.	Taxe d'examen préliminaire d'une demande internationale (règle 58 du PCT et règle 105, paragraphe 2)	1 595 ⁵
20.	Redevance pour délivrance d'un avis technique (article 25)	3 185
21.	Taxe de réserve (règle 40, paragraphe 2e) et règle 68, paragraphe 3e) du PCT et règle 105, paragraphe 3)	1 065

GEBÜHRENORDNUNG
Artikel 3

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Article 3

RÈGLEMENT RELATIF AUX TAXES
Article 3

Article 3

Taxes, frais et tarifs fixés par le Président de l'Office

(1) Le Président de l'Office fixe le montant des taxes d'administration prévues dans le règlement d'exécution ainsi que le montant des taxes et frais à payer pour toute prestation de service assurée par l'Office, autre que celles visées à l'article 2.

⁵ Cf. la décision du Conseil d'administration du 11.10.2000 portant réduction de cette taxe pour les ressortissants de certains pays (JO OEB 2000, 446).

(2) Der Präsident des Amtes setzt ferner die Verkaufspreise der in den Artikeln 93, 98, 103 und 129 des Übereinkommens genannten Veröffentlichungen fest.

(3)⁶ Die in Artikel 2 vorgesehenen und die nach Absatz 1 festgesetzten Gebühren und Auslagen werden im Amtsblatt des Europäischen Patentamts veröffentlicht.

Artikel 4

Fälligkeit der Gebühren

(1) Gebühren, deren Fälligkeit sich nicht aus den Vorschriften des Übereinkommens oder des PCT oder der dazugehörigen Ausführungsordnungen ergibt, werden mit dem Eingang des Antrags auf Vornahme der gebührenpflichtigen Amtshandlung fällig.

(2) Der Präsident des Amtes kann davon absehen, Amtshandlungen im Sinn des Absatzes 1 von der vorherigen Zahlung der entsprechenden Gebühr abhängig zu machen.

Artikel 5⁷

Entrichtung der Gebühren

(1) Die an das Amt zu zahlenden Gebühren sind in Euro zu entrichten:

- a) durch Einzahlung oder Überweisung auf ein Bankkonto des Amtes,
- b) durch Einzahlung oder Überweisung auf ein Postscheckkonto des Amtes, oder
- c) durch Übergabe oder Übersendung von Schecks, die an die Order des Amtes lauten.

(2)⁸ Der Präsident des Amtes kann zulassen, dass die Gebühren auf andere Art als in Absatz 1 vorgesehen entrichtet werden.

Artikel 6⁹

(gestrichen)

(2) He shall also lay down the prices of the publications referred to in Articles 93, 98, 103 and 129 of the Convention.

(3)⁶ The amounts of the fees provided for in Article 2 and of the fees and costs laid down in accordance with paragraph 1 shall be published in the Official Journal of the European Patent Office.

Article 4

Due date for fees

(1) Fees in respect of which the due date is not specified in the provisions of the Convention or of the PCT or of the Implementing Regulations thereto shall be due on the date of receipt of the request for the service incurring the fee concerned.

(2) The President of the Office may decide not to make services within the meaning of paragraph 1 dependent upon the advance payment of the corresponding fee.

Article 5⁷

Payment of fees

(1) The fees due to the Office shall be paid in euro:

- (a) by payment or transfer to a bank account held by the Office,
- (b) by payment or transfer to a Giro account held by the Office, or
- (c) by delivery or remittance of cheques made payable to the Office.

(2)⁸ The President of the Office may allow other methods of paying fees than those set out in paragraph 1.

Article 6⁹

(deleted)

⁶ Geändert durch Beschluss des Verwaltungsrats vom 13.12.1994, in Kraft getreten am 01.06.1995 (ABI. EPA 1995, 9 ff.).

⁷ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 28.06.2001, in Kraft getreten am 01.01.2002 (ABI. EPA 2001, 377).

⁸ Siehe hierzu die Vorschriften über das laufende Konto in der ab 1. Januar 2005 geltenden Fassung (Beilage Nr. 2 zum ABI. EPA 1/2005).

⁹ Gestrichen durch Beschluss des Verwaltungsrats vom 28.06.2001, in Kraft getreten am 01.01.2002 (ABI. EPA 2001, 377).

⁶ Amended by decision of the Administrative Council of 13.12.1994 which entered into force on 01.06.1995 (OJ EPO 1995, 9 ff.).

⁷ Last amended by decision of the Administrative Council of 28.06.2001 which entered into force on 01.01.2002 (OJ EPO 2001, 377).

⁸ See the Arrangements for deposit accounts valid as of 1 January 2005 (Suppl. No. 2 to OJ EPO 1/2005).

⁹ Deleted by decision of the Administrative Council of 28.06.2001 which entered into force on 01.01.2002 (OJ EPO 2001, 377).

(2) Il fixe également les tarifs de vente des publications visées aux articles 93, 98, 103 et 129 de la Convention.

(3)⁶ Les montants des taxes prévues à l'article 2 et des taxes et frais visés au paragraphe 1 sont publiés au Journal officiel de l'Office européen des brevets.

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Artikel 4

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Article 4

RÈGLEMENT RELATIF AUX TAXES
Article 4

Article 4

Exigibilité des taxes

(1) Les taxes dont la date d'exigibilité ne découle pas des dispositions de la Convention, du PCT et de leurs règlements d'exécution sont exigibles à compter du dépôt de la demande d'exécution de la prestation de service assujettie à une taxe.

(2) Le Président de l'Office peut ne pas soumettre la prestation de service visée au paragraphe 1 au paiement préalable de la taxe y afférente.

*Article 5*⁷

Paie ment des taxes

(1) Les taxes à payer à l'Office doivent être acquittées en euro :

a) par versement ou virement à un compte bancaire de l'Office,

b) par versement ou virement à un compte de chèques postaux de l'Office, ou

c) par remise ou envoi de chèques établis à l'ordre de l'Office.

(2)⁸ Le Président de l'Office peut autoriser le paiement des taxes par d'autres moyens que ceux prévus au paragraphe 1.

*Article 6*⁹

(supprimé)

⁶ Modifié par décision du Conseil d'administration en date du 13.12.1994, entrée en vigueur le 01.06.1995 (JO OEB 1995, 9 s.).

⁷ Modifié en dernier lieu par décision du Conseil d'administration en date du 28.06.2001, entrée en vigueur le 01.01.2002 (JO OEB 2001, 377).

⁸ Cf. la réglementation applicable aux comptes courants - version applicable à partir du 1^{er} janvier 2005 - (Suppl. n° 2 au JO OEB 1/2005).

⁹ Supprimé par décision du Conseil d'administration en date du 28.06.2001, entrée en vigueur le 01.01.2002 (JO OEB 2001, 377).

Artikel 7

Angaben über die Zahlung

(1)¹⁰ Jede Zahlung muss den Einzahler bezeichnen und die notwendigen Angaben enthalten, die es dem Amt ermöglichen, den Zweck der Zahlung ohne Weiteres zu erkennen.

(2) Ist der Zweck der Zahlung nicht ohne Weiteres erkennbar, so fordert das Amt den Einzahler auf, innerhalb einer vom Amt zu bestimmenden Frist diesen Zweck schriftlich mitzuteilen. Kommt der Einzahler der Aufforderung nicht rechtzeitig nach, so gilt die Zahlung als nicht erfolgt.

Artikel 8¹¹

Maßgebender Zahlungstag

(1) Als Tag des Eingangs einer Zahlung beim Amt gilt:

a) im Fall des Artikels 5 Absatz 1 Buchstaben a und b der Tag, an dem der eingezahlte oder überwiesene Betrag auf einem Bank- oder Postscheckkonto des Amts tatsächlich gutgeschrieben wird;

b) im Fall des Artikels 5 Absatz 1 Buchstabe c der Tag, an dem der Scheck beim Amt eingeht, sofern dieser Scheck eingelöst wird.

(2) Lässt der Präsident des Amts gemäß Artikel 5 Absatz 2 zu, dass die Gebühren auf andere Art als in Artikel 5 Absatz 1 vorgesehen entrichtet werden, so bestimmt er auch den Tag, an dem diese Zahlung als eingegangen gilt.

(3)¹² Gilt eine Gebührenzahlung gemäß den Absätzen 1 und 2 erst nach Ablauf der Frist als eingegangen, innerhalb der sie hätte erfolgen müssen, so gilt diese Frist als eingehalten, wenn dem Amt nachgewiesen wird, dass der Einzahler

a) innerhalb der Frist, in der die Zahlung hätte erfolgen müssen, in einem Vertragsstaat:

i) die Zahlung des Betrags bei einem Bankinstitut oder Postamt veranlasst hat oder

Article 7

Particulars concerning payments

(1)¹⁰ Every payment must indicate the name of the person making the payment and must contain the necessary particulars to enable the Office to establish immediately the purpose of the payment.

(2) If the purpose of the payment cannot immediately be established, the Office shall require the person making the payment to notify it in writing of this purpose within such period as it may specify. If he does not comply with this request in due time the payment shall be considered not to have been made.

Article 8¹¹

Date to be considered as the date on which payment is made

(1) The date on which any payment shall be considered to have been made to the Office shall be as follows:

(a) in the cases referred to in Article 5, paragraph 1(a) and (b): the date on which the amount of the payment or of the transfer is actually entered in a bank account or a Giro account held by the Office;

(b) in the case referred to in Article 5, paragraph 1(c): the date of receipt of the cheque at the Office, provided that the cheque is met.

(2) Where the President of the Office allows, in accordance with the provisions of Article 5, paragraph 2, other methods of paying fees than those set out in Article 5, paragraph 1, he shall also lay down the date on which such payments shall be considered to have been made.

(3)¹² Where, under the provisions of paragraphs 1 and 2, payment of a fee is not considered to have been made until after the expiry of the period in which it should have been made, it shall be considered that this period has been observed if evidence is provided to the Office that the person who made the payment

(a) fulfilled one of the following conditions in a Contracting State within the period within which the payment should have been made:

(i) he effected the payment through a banking establishment or a post office;

¹⁰ Siehe hierzu Rechtsauskunft Nr. 6/91 rev. (Anhang II).

¹¹ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 28.06.2001, in Kraft getreten am 03.01.2002 (ABl. EPA 2001, 378 ff.).

¹² Siehe hierzu Rechtsauskunft Nr. 6/91 rev. (Anhang II).

¹⁰ See Legal advice No. 6/91 rev. (Annex II).

¹¹ Last amended by decision of the Administrative Council of 28.06.2001 which entered into force on 03.01.2002 (OJ EPO 2001, 378 ff.).

¹² See Legal advice No. 6/91 rev. (Annex II).

Article 7

Données concernant le paiement

(1)¹⁰ Tout paiement doit comporter l'indication du nom de la personne qui l'effectue ainsi que les données nécessaires pour permettre à l'Office d'identifier facilement l'objet du paiement.

(2) Si l'objet du paiement n'est pas facilement identifiable, l'Office invite, dans un délai qu'il détermine, la personne qui a effectué le paiement à communiquer cet objet par écrit. Si elle ne donne pas suite à cette invitation en temps utile, le paiement est considéré comme nul et non avenue.

Article 8¹¹

Date à laquelle le paiement est réputé effectué

(1) La date à laquelle tout paiement est réputé effectué auprès de l'Office est fixée comme suit :

a) dans les cas visés à l'article 5, paragraphe 1, lettres a) et b) : date à laquelle le montant du versement ou du virement est effectivement porté au crédit d'un compte bancaire ou d'un compte de chèques postaux de l'Office ;

b) dans le cas visé à l'article 5, paragraphe 1, lettre c) : date de réception du chèque par l'Office sous réserve de l'encaissement de ce chèque.

(2) Lorsque le Président de l'Office autorise, conformément aux dispositions de l'article 5, paragraphe 2, le paiement des taxes par d'autres moyens que ceux prévus au paragraphe 1 dudit article, il fixe également la date à laquelle ce paiement est réputé effectué.

(3)¹² Lorsque, en vertu des dispositions des paragraphes 1 et 2, le paiement d'une taxe n'est réputé effectué qu'après l'expiration du délai dans lequel il aurait dû intervenir, ce délai est considéré comme respecté si la preuve est apportée à l'Office que la personne qui a effectué le paiement

a) a rempli dans un Etat contractant pendant le délai dans lequel le paiement aurait dû intervenir l'une des conditions ci-après :

i) avoir effectué le paiement auprès d'un établissement bancaire ou d'un bureau de poste ;

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RULES RELATING TO FEES

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¹⁰ Cf. le renseignement juridique n° 6/91 rév. (Annexe II).

¹¹ Modifié en dernier lieu par décision du Conseil d'administration en date du 28.06.2001, entrée en vigueur le 03.01.2002 (JO OEB 2001, 378 s.).

¹² Cf. le renseignement juridique n° 6/91 rév. (Annexe II).

ii) einen Auftrag zur Überweisung des zu entrichtenden Betrags einem Bankinstitut oder Postscheckamt formgerecht erteilt hat oder

iii) einem Postamt einen an das Amt gerichteten Brief übergeben hat, in dem ein dem Artikel 5 Absatz 1 Buchstabe c entsprechender Scheck enthalten ist, sofern dieser Scheck eingelöst wird, und

b) eine Zuschlagsgebühr in Höhe von 10 % der betreffenden Gebühr oder Gebühren, höchstens jedoch EUR 150 entrichtet hat; die Zuschlagsgebühr wird nicht erhoben, wenn eine Handlung nach Buchstabe a spätestens zehn Tage vor Ablauf der Zahlungsfrist vorgenommen worden ist.

(4) Das Amt kann den Einzahler auffordern, innerhalb einer vom Amt zu bestimmenden Frist den Nachweis über den Zeitpunkt der Vornahme einer der Handlungen nach Absatz 3 Buchstabe a zu erbringen und gegebenenfalls die Zuschlagsgebühr nach Absatz 3 Buchstabe b zu entrichten. Kommt der Einzahler dieser Aufforderung nicht nach, ist der Nachweis ungenügend oder wird die angeforderte Zuschlagsgebühr nicht rechtzeitig entrichtet, so gilt die Zahlungsfrist als ver säumt.

Artikel 9

Nicht ausreichender Gebührenbetrag

(1) Eine Zahlungsfrist gilt grundsätzlich nur dann als eingehalten, wenn der volle Gebührenbetrag rechtzeitig gezahlt worden ist. Ist nicht die volle Gebühr entrichtet worden, so wird der gezahlte Betrag nach dem Fristablauf zurückerstattet. Das Amt kann jedoch, soweit die laufende Frist es erlaubt, dem Einzahler die Gelegenheit geben, den fehlenden Betrag nachzuzahlen. Es kann ferner, wenn dies der Billigkeit entspricht, geringfügige Fehlbeträge der zu entrichtenden Gebühr ohne Rechtsnachteil für den Einzahler unberücksichtigt lassen.

(2) Wurden im Antrag auf Erteilung des europäischen Patents mehr als ein Vertragsstaat gemäß Artikel 79 Absatz 1 des Übereinkommens benannt und reicht der gezahlte Betrag nicht für alle Benennungsgebühren aus, so wird er entsprechend den Angaben verwendet, die der Anmelder bei der Zahlung macht. Hat er bei der Zahlung keine solchen Angaben gemacht, so gelten diese Gebühren nur für so viele Benennungen als entrichtet, als der gezahlte Betrag entsprechend der Reihenfolge, in der die Vertragsstaaten benannt sind, ausreicht.

(ii) he duly gave an order to a banking establishment or a post office to transfer the amount of the payment;

(iii) he despatched at a post office a letter bearing the address of the Office and containing a cheque within the meaning of Article 5, paragraph 1(c), provided that the cheque is met, and

(b) paid a surcharge of 10% on the relevant fee or fees, but not exceeding EUR 150; no surcharge is payable if a condition according to sub-paragraph (a) has been fulfilled not later than ten days before the expiry of the period for payment.

(4) The Office may request the person who made the payment to produce evidence as to the date on which a condition according to paragraph 3(a) was fulfilled and, where required, pay the surcharge referred to in paragraph 3(b), within a period to be specified by it. If he fails to comply with this request or if the evidence is insufficient, or if the required surcharge is not paid in due time, the period for payment shall be considered not to have been observed.

Article 9

Insufficiency of the amount paid

(1) A time limit for payment shall in principle be deemed to have been observed only if the full amount of the fee has been paid in due time. If the fee is not paid in full, the amount which has been paid shall be refunded after the period for payment has expired. The Office may, however, in so far as this is possible within the time remaining before the end of the period, give the person making the payment the opportunity to pay the amount lacking. It may also, where this is considered justified, overlook any small amounts lacking without prejudice to the rights of the person making the payment.

(2) Where the request for grant of a European patent designates more than one Contracting State in accordance with Article 79, paragraph 1, of the Convention, and the amount paid is insufficient to cover all the designation fees, the amount paid shall be applied according to the specifications made by the applicant at the time of payment. If the applicant makes no such specifications at the time of payment, these fees shall be deemed to be paid only for as many designations as are covered by the amount paid and in the order in which the Contracting States are designated in the request.

ii) avoir donné un ordre de virement, en bonne et due forme, du montant du paiement à un établissement bancaire ou à un bureau de chèques postaux ;

iii) avoir déposé dans un bureau de poste une lettre portant l'adresse de l'Office et contenant un chèque visé à l'article 5, paragraphe 1, lettre c), sous réserve de l'encaissement de ce chèque, et

b) a acquitté une surtaxe d'un montant égal à 10 % de la ou des taxes dues, mais n'excédant pas 150 EUR ; aucune surtaxe n'est due si l'une des conditions visées à la lettre a) a été remplie au plus tard dix jours avant l'expiration du délai de paiement.

(4) L'Office peut inviter la personne qui a effectué le paiement à apporter la preuve de la date à laquelle l'une des conditions visées au paragraphe 3, lettre a) a été remplie et, le cas échéant, à acquitter la surtaxe visée au paragraphe 3, lettre b), dans un délai qu'il lui impartit. S'il n'est pas donné suite à cette invitation ou si la preuve apportée n'est pas suffisante, ou encore si la surtaxe requise n'est pas acquittée en temps utile, le délai de paiement est considéré comme n'ayant pas été respecté.

Article 9

Paiement insuffisant du montant de la taxe

(1) Un délai de paiement n'est, en principe, considéré comme respecté que si la totalité du montant de la taxe a été payée dans le délai prévu. Si la totalité de la taxe n'a pas été payée, le montant déjà versé est remboursé après expiration du délai. Toutefois, l'Office peut, pour autant que le délai en cours le permette, donner à la personne qui a effectué le paiement la possibilité de verser ultérieurement le complément. En outre, si cela paraît justifié, l'Office peut ne pas tenir compte des parties minimales non encore payées de la taxe, sans qu'il en résulte pour autant une perte de droits pour la personne qui a effectué le paiement.

(2) Si, dans la requête en délivrance du brevet européen, il est désigné plus d'un Etat contractant au sens de l'article 79, paragraphe 1 de la Convention, et si le montant payé ne suffit pas à couvrir toutes les taxes de désignation, ce montant est utilisé conformément aux indications données par le demandeur lors du paiement. Si le demandeur n'a pas donné d'indication lors du paiement, ces taxes ne sont considérées comme acquittées que pour le nombre de désignations pour lequel le montant payé est suffisant, et ce dans l'ordre où les Etats contractants sont désignés dans la requête.

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Artikel 9

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Article 9

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Article 9

Artikel 10¹³

Rückerstattung von Recherchegebühren

(1) Die für eine europäische oder eine ergänzende europäische Recherche entrichtete Recherchegebühr wird in voller Höhe zurückerstattet, wenn die europäische Patentanmeldung zu einem Zeitpunkt zurückgenommen oder zurückgewiesen wird oder als zurückgenommen gilt, in dem das Amt mit der Erstellung des Recherchenberichts noch nicht begonnen hat.

(2)¹⁴ Wird der europäische Recherchenbericht auf einen früheren Recherchenbericht gestützt, den das Amt für eine Patentanmeldung, deren Priorität beansprucht wird, oder für eine frühere Anmeldung im Sinn des Artikels 76 oder der Regel 15 des Übereinkommens erstellt hat, so erstattet das Amt gemäß einem Beschluss seines Präsidenten dem Anmelder einen Betrag zurück, dessen Höhe von der Art der früheren Recherche und dem Umfang abhängt, in dem sich das Amt bei der Durchführung der späteren Recherche auf den früheren Recherchenbericht stützen kann.

Artikel 10a¹⁵

Rückerstattung der Gebühr für ein technisches Gutachten

Die Gebühr für ein technisches Gutachten nach Artikel 25 des Übereinkommens wird zu 75 % zurückerstattet, wenn das Ersuchen um das Gutachten zurückgenommen wird, bevor das Amt mit seiner Erstellung begonnen hat.

Artikel 10b¹⁶

Rückerstattung der Prüfungsgebühr

Die Prüfungsgebühr nach Artikel 94 Absatz 2 des Übereinkommens wird

a) in voller Höhe zurückerstattet, wenn die europäische Patentanmeldung zurückgenommen oder zurückgewiesen wird oder als zurückgenommen gilt, bevor die Anmeldung in die Zuständigkeit der Prüfungsabteilungen übergegangen ist;

Article 10¹³

Refund of search fees

(1) The search fee paid for a European or supplementary European search shall be fully refunded if the European patent application is withdrawn or refused or deemed to be withdrawn at a time when the Office has not yet begun to draw up the search report.

(2)¹⁴ Where the European search report is based on an earlier search report prepared by the Office on an application whose priority is claimed or an earlier application within the meaning of Article 76 of the Convention or an original application within the meaning of Rule 15 of the Convention, the Office shall refund to the applicant, in accordance with a decision of its President, an amount which shall depend on the type of earlier search and the extent to which the Office benefits from the earlier search report when carrying out the subsequent search.

Article 10a¹⁵

Refund of the fee for a technical opinion

An amount of 75% of the fee for a technical opinion under Article 25 of the Convention shall be refunded if the request for a technical opinion is withdrawn at a time when the Office has not yet begun to draw up the technical opinion.

Article 10b¹⁶

Refund of examination fee

The examination fee provided for in Article 94, paragraph 2, of the Convention shall be refunded:

(a) in full if the European patent application is withdrawn, refused or deemed to be withdrawn before the Examining Divisions have assumed responsibility;

¹³ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 09.12.2004, in Kraft getreten am 01.07.2005 (ABl. EPA 2005, 5 ff.).

¹⁴ Siehe hierzu den Beschluss des Präsidenten des EPA über die Rückerstattung von Recherchegebühren vom 01.01.2006 (ABl. EPA 2006, 83 f.), spätere im ABl. EPA veröffentlichte Aktualisierungen dieses Beschlusses und die Mitteilung des Präsidenten des EPA vom 01.07.2005 über die Kriterien für die Rückerstattung von Recherchegebühren (ABl. EPA 2005, 433 ff.) und Anhang C, Teil II der Vereinbarung zwischen der EPO und der WIPO nach dem PCT (ABl. EPA 2001, 608 ff.; 2005, 463 ff.).

¹⁵ Eingefügt durch Beschluss des Verwaltungsrats vom 05.06.1986, in Kraft getreten am 01.07.1986 (ABl. EPA 1986, 247).

¹⁶ Eingefügt durch Beschluss des Verwaltungsrats vom 10.06.1988, in Kraft getreten am 01.10.1988 (ABl. EPA 1988, 293 f.). Siehe hierzu die Mitteilung des Präsidenten des EPA vom 15.07.1988 zur Anwendung von Artikel 10b der Gebührenordnung (ABl. EPA 1988, 354).

¹³ Last amended by decision of the Administrative Council of 09.12.2004 which entered into force on 01.07.2005 (OJ EPO 2005, 5 ff.).

¹⁴ See decision of the President of the EPO dated 01.01.2006 concerning the refund of search fees (OJ EPO 2006, 83 f), later updates of this decision published in the OJ EPO and the Notice from the President of the EPO dated 01.07.2005 concerning the criteria for refund of search fees (OJ EPO 2005, 433 ff) and Annex C, Part II of the Agreement between the EPO and WIPO under the PCT (OJ EPO 2001, 608 ff; 2005, 463 ff).

¹⁵ Inserted by decision of the Administrative Council of 05.06.1986 which entered into force on 01.07.1986 (OJ EPO 1986, 247).

¹⁶ Inserted by decision of the Administrative Council of 10.06.1988 which entered into force on 01.10.1988 (OJ EPO 1988, 293 ff). See notice of the President of the EPO dated 15.07.1988 concerning the application of Article 10b of the Rules relating to Fees (OJ EPO 1988, 354).

*Article 10*¹³

Remboursement des taxes de recherche

(1) La taxe de recherche acquittée pour une recherche européenne ou une recherche européenne complémentaire est remboursée intégralement si la demande de brevet européen est retirée ou rejetée ou si elle est réputée retirée avant que l'Office n'ait commencé à établir le rapport de recherche.

(2)¹⁴ Lorsque le rapport de recherche européenne est basé sur un rapport de recherche antérieure établi par l'Office pour une demande de brevet dont la priorité est revendiquée ou pour une demande initiale au sens de l'article 76 ou de la règle 15 de la Convention, l'Office rembourse au demandeur, conformément à une décision du Président de l'Office, un montant qui est déterminé en fonction du type de recherche antérieure et selon le profit que l'Office peut tirer du rapport de recherche antérieure lorsqu'il effectue la recherche ultérieure.

*Article 10bis*¹⁵

Remboursement de la redevance pour la délivrance d'un avis technique

La redevance pour la délivrance d'un avis technique conformément à l'article 25 de la Convention est remboursée à 75 % si la demande d'avis technique est retirée avant que l'Office n'ait commencé à établir cet avis.

*Article 10ter*¹⁶

Remboursement de la taxe d'examen

La taxe d'examen prévue à l'article 94, paragraphe 2 de la Convention est remboursée :

a) intégralement si la demande de brevet européen est retirée ou rejetée ou si elle est réputée retirée avant que les divisions d'examen ne soient devenues compétentes ;

¹³ Modifié en dernier lieu par décision du Conseil d'administration en date du 09.12.2004, entrée en vigueur le 01.07.2005 (JO OEB 2005, 5 s.).

¹⁴ Cf. la décision du Président de l'OEB en date du 01.01.2006 relative au remboursement des taxes de recherche (JO OEB 2006, 83 s.), les mises à jour futures publiées au JO OEB et le communiqué du Président de l'OEB, en date du 01.07.2005, relatif aux critères de remboursement des taxes de recherche (JO OEB 2005, 433 s.) et Annexe C, partie II de l'Accord entre l'OEB et l'OMPI au titre du PCT (JO OEB 2001, 608 s. ; 2005, 463 s.).

¹⁵ Inséré par décision du Conseil d'administration en date du 05.06.1986, entrée en vigueur le 01.07.1986 (JO OEB 1986, 247).

¹⁶ Inséré par décision du Conseil d'administration en date du 10.06.1988, entrée en vigueur le 01.10.1988 (JO OEB 1988, 293 s.). Cf. le communiqué du Président de l'OEB, en date du 15.07.1988 concernant l'application du nouvel article 10ter du règlement relatif aux taxes (JO OEB 1988, 354).

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b) zu 75 % zurückerstattet, wenn die europäische Patentanmeldung zu einem Zeitpunkt zurückgenommen oder zurückgewiesen wird oder als zurückgenommen gilt, zu dem die Anmeldung bereits in die Zuständigkeit der Prüfungsabteilungen übergegangen ist, die Sachprüfung jedoch noch nicht begonnen hat.

*Artikel 10c*¹⁷

Rückerstattung von Bagatellbeträgen

Zu viel gezahlte Gebührenbeträge werden nicht zurückerstattet, wenn es sich um Bagatellbeträge handelt und der Verfahrensbeteiligte eine Rückerstattung nicht ausdrücklich beantragt hat. Der Präsident des Amts bestimmt, bis zu welcher Höhe ein Betrag als Bagatellbetrag anzusehen ist.¹⁸

*Artikel 10d*¹⁹

Rückerstattung der Gebühr für die internationale vorläufige Prüfung

Hat der Anmelder während der internationalen vorläufigen Prüfung weder eine eingehende vorläufige Prüfung verlangt, noch Änderungen nach Artikel 19 oder 34 Absatz 2 PCT eingereicht, noch sonstige Gegenvorstellungen erhoben, so werden zwei Drittel der für die internationale vorläufige Prüfung entrichteten Gebühr zurückerstattet. Der Präsident des Amts bestimmt die Einzelheiten der Rückerstattung.

*Artikel 11*²⁰

Beschwerdefähige Kostenfestsetzungsentscheidungen

Entscheidungen über die Festsetzung des Betrags der Kosten des Einspruchsverfahrens sind gemäß Artikel 106 Absatz 5 des Übereinkommens beschwerdefähig, wenn der Betrag die Beschwerdegebühr übersteigt.

Artikel 12

Gebührenermäßigung

(1) Die in Regel 6 Absatz 3 des Übereinkommens vorgesehene Ermäßigung beträgt 20 % der Anmeldegebühr, der Prüfungsgebühr, der Einspruchsgebühr und der Beschwerdegebühr.

(b) at a rate of 75% if the European patent application is withdrawn, refused or deemed to be withdrawn after the Examining Divisions have assumed responsibility but before substantive examination has begun.

*Article 10c*¹⁷

Refund of insignificant amounts

Where too large a sum is paid to cover a fee, the excess shall not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund. The President of the Office shall determine what constitutes an insignificant amount.¹⁸

*Article 10d*¹⁹

Refund of fee for international preliminary examination

If the applicant, during international preliminary examination, has not asked for a detailed preliminary examination or has not filed any amendments under Article 19 or 34(2) PCT or any other arguments, two thirds of the fee paid for international preliminary examination shall be refunded. The details of the refund shall be determined by the President of the Office.

*Article 11*²⁰

Decisions fixing costs which are subject to appeal

In accordance with Article 106, paragraph 5, of the Convention, decisions fixing the amount of costs of opposition proceedings may be appealed if the amount is in excess of the fee for appeal.

Article 12

Reduction of fees

(1) The reduction laid down in Rule 6, paragraph 3, of the Convention shall be 20% of the filing fee, examination fee, opposition fee and fee for appeal.

¹⁷ Eingefügt durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 03.01.1991 (ABI. EPA 1991, 11 ff.).

¹⁸ Siehe Beschluss des Präsidenten des EPA vom 06.09.2001 zur Ausführung der Gebührenordnung ... (ABI. EPA 2001, 521 ff.).

¹⁹ Eingefügt durch Beschluss des Verwaltungsrats vom 18.10.2001, in Kraft getreten am 03.01.2002 (ABI. EPA 2001, 492 f.).

²⁰ Siehe hierzu Entscheidung der Großen Beschwerdekammer G 3/03 (Anhang I).

¹⁷ Inserted by decision of the Administrative Council of 07.12.1990 which entered into force on 03.01.1991 (OJ EPO 1991, 11 ff.).

¹⁸ See decision of the President of the EPO dated 06.09.2001 implementing the Rules relating to Fees ... (OJ EPO 2001, 521 ff.).

¹⁹ Inserted by decision of the Administrative Council of 18.10.2001 which entered into force on 03.01.2002 (OJ EPO 2001, 492 ff.).

²⁰ See decision of the Enlarged Board of Appeal G 3/03 (Annex I).

b) à 75 % si la demande de brevet européen est retirée ou rejetée ou si elle est réputée retirée après que les divisions d'examen sont devenues compétentes, mais avant que l'examen quant au fond n'ait commencé.

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*Article 10quater*¹⁷

Remboursement de montants insignifiants

Si la somme versée pour une taxe est supérieure au montant de celle-ci, la différence n'est pas remboursée lorsqu'elle est insignifiante et que la partie à la procédure concernée ne demande pas expressément à être remboursée. Le Président de l'Office détermine jusqu'à quel montant la différence constatée est considérée comme insignifiante.¹⁸

*Article 10quinquies*¹⁹

Remboursement de la taxe d'examen préliminaire international

Si le demandeur, au cours de l'examen préliminaire international, n'a pas demandé d'examen préliminaire détaillé ni produit de modifications conformément à l'article 19 ou 34(2) PCT ou tout autre moyen, deux tiers de la taxe acquittée pour l'examen préliminaire international sont remboursés. Le Président de l'Office détermine les modalités du remboursement.

*Article 11*²⁰

Décisions susceptibles de recours en matière de fixation des frais

Les décisions relatives à la fixation des frais de la procédure d'opposition sont susceptibles de recours conformément à l'article 106, paragraphe 5 de la Convention si le montant des frais dépasse le montant de la taxe de recours.

Article 12

Réduction du montant des taxes

(1) La réduction prévue à la règle 6, paragraphe 3 de la Convention s'élève à 20 % de la taxe de dépôt, de la taxe d'examen, de la taxe d'opposition et de la taxe de recours.

¹⁷ Inséré par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 03.01.1991 (JO OEB 1991, 11 s.).

¹⁸ Cf. la décision du Président de l'OEB du 06.09.2001, concernant l'application du règlement relatif aux taxes... (JO OEB 2001, 521 s.).

¹⁹ Inséré par décision du Conseil d'administration en date du 18.10.2001, entrée en vigueur le 03.01.2002 (JO OEB 2001, 492 s.).

²⁰ Cf. la décision de la Grande Chambre de recours G 3/03 (Annexe I).

(2)²¹ Die in Regel 107 Absatz 2 des Übereinkommens vorgesehene Ermäßigung beträgt 50 % der Prüfungsgebühr. Die Ermäßigung wird nicht gewährt, wenn das Amt als mit der internationalen vorläufigen Prüfung beauftragte Behörde die für die vorläufige Prüfung entrichtete Gebühr nach Artikel 10d zurückerstattet hat.

*Artikel 13*²²

Übermittlung der Abschrift

Der Präsident des Europäischen Patentamts übermittelt allen Unterzeichnerstaaten des Übereinkommens sowie den Staaten, die diesem beitreten, eine beglaubigte Abschrift dieser Gebührenordnung.

*Artikel 14*²³

Inkrafttreten

Diese Gebührenordnung tritt am 20. Oktober 1977 in Kraft.

GESCHEHEN zu München am 20. Oktober 1977.

(2)²¹ The reduction laid down in Rule 107, paragraph 2, of the Convention shall be 50% of the examination fee. The reduction shall not be granted if the Office as an International Preliminary Examining Authority has refunded the fee paid for preliminary examination under Article 10d.

*Article 13*²²

Notification

The President of the European Patent Office shall forward a certified copy of these Rules to all the signatory States to the Convention and to the States which accede thereto.

*Article 14*²³

Entry into force

These Rules shall enter into force on 20 October 1977.

DONE at Munich, 20 October 1977.

²¹ Zuletzt geändert durch Beschluss des Verwaltungsrats vom 18.10.2001, in Kraft getreten am 03.01.2002 (ABl. EPA 2001, 492 f.).

²² Die Nummerierung der Artikel 13 und 14 wurde geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 03.01.1991 (ABl. EPA 1991, 11 ff.). Der Text der Artikel 13 und 14 entspricht dem Text der früheren Artikel 14 und 15, da der frühere Artikel 13 gestrichen wurde.

²³ Die Nummerierung der Artikel 13 und 14 wurde geändert durch Beschluss des Verwaltungsrats vom 07.12.1990, in Kraft getreten am 03.01.1991 (ABl. EPA 1991, 11 ff.). Der Text der Artikel 13 und 14 entspricht dem Text der früheren Artikel 14 und 15, da der frühere Artikel 13 gestrichen wurde.

²¹ Last amended by decisions of the Administrative Council of 18.10.2001, which entered into force on 03.01.2002 (OJ EPO 2001, 492 ff).

²² The numbers of Articles 13 and 14 were changed by decision of the Administrative Council of 07.12.1990 which entered into force on 03.01.1991 (OJ EPO 1991, 11 ff). The wording of Articles 13 and 14 corresponds to former Articles 14 and 15 as the former Article 13 has been deleted.

²³ The numbers of Articles 13 and 14 were changed by decision of the Administrative Council of 07.12.1990 which entered into force on 03.01.1991 (OJ EPO 1991, 11 ff). The wording of Articles 13 and 14 corresponds to former Articles 14 and 15 as the former Article 13 has been deleted.

(2)²¹ La réduction prévue à la règle 107, paragraphe 2 de la Convention s'élève à 50 % de la taxe d'examen. Il n'est pas octroyé de réduction lorsque l'Office agissant en qualité d'administration chargée de l'examen préliminaire international a remboursé la taxe acquittée pour l'examen préliminaire conformément à l'article 10quinquies.

*Article 13*²²

Communication

Le Président de l'Office européen des brevets communique à tous les Etats signataires de la Convention ainsi qu'aux Etats qui y adhèrent une copie certifiée conforme du présent règlement.

*Article 14*²³

Entrée en vigueur

Le présent règlement entre en vigueur le 20 octobre 1977.

FAIT A MUNICH, le 20 octobre 1977.

GEBÜHRENORDNUNG

Artikel 13

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Article 13

²¹ Modifié en dernier lieu par décision du Conseil d'administration en date du 18.10.2001, entrée en vigueur le 03.01.2002 (JO OEB 2001, 492 s.).

²² La numérotation des articles 13 et 14 a été modifiée par décision du Conseil d'administration en date du 07.12.1990 (JO OEB 1991, 11 s.). Les articles 13 et 14 remplacent les anciens articles 14 et 15, l'article 13 antérieur ayant été supprimé.

²³ La numérotation des articles 13 et 14 a été modifiée par décision du Conseil d'administration en date du 07.12.1990, entrée en vigueur le 03.01.1991 (JO OEB 1991, 11 s.). Les articles 13 et 14 remplacent les anciens articles 14 et 15, l'article 13 antérieur ayant été supprimé.

Anhang I

Verzeichnis der im Amtsblatt des EPA veröffentlichten Entscheidungen und Stellungnahmen
der Großen Beschwerdekammer

Annex I

Index of decisions and opinions of the Enlarged Board of Appeal
published in the Official Journal of the EPO

Annexe I

Liste des décisions et avis de la Grande Chambre de recours
publiés du Journal officiel de l'OEB

Verzeichnis der im Amtsblatt des EPA veröffentlichten Entscheidungen und Stellungnahmen der Großen Beschwerdekammer

Aktenzeichen, Datum, Fundstelle	Stichwort/Gegenstand	Artikel, Regel
G 1/83 Entscheidung vom 05.12.1984 ABI. EPA 1985, 60	"Zweite medizinische Indikation/BAYER" – Auslegung des EPÜ/Wiener Übereinkommens - therapeutische Verwendungsansprüche	Art.: 52 (1), 52 (4), 54 (5), 57 EPÜ Art.: 31, 32 Wiener Übereinkommen
G 1/86 Entscheidung vom 24.06.1987 ABI. EPA 1987, 447	"Wiedereinsetzung des Einsprechenden/ VOEST ALPINE" – Wiedereinsetzung des Beschwerdeführers, der Einsprechender ist - Frist zur Einreichung der Beschwerdebegründung	Art.: 108 Satz 3, 112 (1), 122 EPÜ
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G 1/89 Décision du 02.05.1990 JO OEB 1991, 155	“Esters polysuccinates” – Compétence de la Grande Chambre de recours dans les affaires relatives à des réserves émises au titre du PCT - Défaut d'unité <i>a posteriori</i>	Art. : 112(1)a) b), 154(3) CBE Art. : 17.3)a) PCT Règle : 13, 33, 40 PCT
G 2/89 Avis du 02.05.1990 JO OEB 1991, 166	“Défaut d'unité <i>a posteriori</i> ” – Compétence de la Grande Chambre de recours dans les affaires relatives à des réserves émises au titre du PCT - Défaut d'unité <i>a posteriori</i>	Art. : 112(1)b), 154(3) CBE Art. : 17.3)a) PCT Règle : 13, 33, 40 PCT
G 3/89 Avis du 19.11.1992 JO OEB 1993, 117	“Correction selon la règle 88, deuxième phrase CBE” – Correction des parties d'une demande de brevet européen ou d'un brevet européen qui concernent la divulgation	Art. : 100c), 117(1), 123(1) et (2), 138(1)c) CBE Règle : 86, 88, deuxième phrase CBE
G 1/90 Avis du 05.03.1991 JO OEB 1991, 275	“Révocation du brevet” – Révocation du brevet par voie de décision - Révocation, non-respect de conditions de forme lors du maintien du brevet sous une forme modifiée - Clôture de la procédure d'opposition - Perte de droits - Fictions juridiques	Art. : 102(4) (5), 106, 112(1)b) CBE Règle : 58(5), 69(1) CBE
G 2/90 Décision du 04.08.1991 JO OEB 1992, 10	“Compétence de la chambre de recours juridique/KOLBENSCHMIDT” – Compétence de la chambre de recours juridique - Recours formés contre des décisions de l'agent des formalités	Art. : 21 CBE Règle : 9(3) CBE
G 1/91 Décision du 09.12.1991 JO OEB 1992, 253	“Unité d'invention/SIEMENS” – Unité d'invention au stade de l'opposition - juridiquement sans importance	Art. : 82, 102(3) CBE Règle : 61bis CBE
G 2/91 Décision du 29.11.1991 JO OEB 1992, 206	“Taxes de recours/KROHNE” – Remboursement des taxes de recours lorsque plusieurs parties ont formé recours	Art. : 107 CBE
G 3/91 Décision du 07.09.1992 JO OEB 1993, 8	“ <i>Restitutio in integrum</i> /FABRITIUS II” – Application des dispositions de l'article 122(5) CBE aux délais prévus par la règle 104ter(1)b) et c) CBE (107(1)c) et e) CBE) en combinaison avec les dispositions des articles 157(2)b) et 158(2) CBE	Art. : 78(2), 79(2), 122(5), 157(2)b), 158(2) CBE Règle : 104ter (1)b) c) CBE (107(1)c) e) CBE (cf. toutefois G 5/93)

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G 4/91 Décision du 03.11.1992 JO OEB 1993, 707	"Intervention/DOLEZYCH II" - Intervention (du contrefacteur présumé dans la procédure d'opposition)	Art. : 105, 107 CBE
G 5/91 Décision du 05.05.1992 JO OEB 1992, 617	"Décision susceptible de recours/DISCOVISION" - Présomption de partialité à l'égard d'un membre d'une division d'opposition - Motif de recours ?	Art. : 19(2), 24 CBE
G 6/91 Décision du 06.03.1992 JO OEB 1992, 491	"Réduction de la taxe/ASULAB II" - Droit à la réduction du montant des taxes	Art. : 14(2) (4) CBE Règle : 6(3) CBE
G 7/91 Décision du 05.11.1992 JO OEB 1993, 356	"Retrait du recours/BASF" - Effet du retrait du recours (par l'unique requérant, qui était l'opposant en première instance)	Art. : 113(2), 114(1) CBE Règle : 60(2), 66(1) CBE
G 8/91 Décision du 05.11.1992 JO OEB 1993, 346	"Retrait du recours/BELL" - Effet du retrait du recours (par l'unique requérant)	Art. : 113(2), 114(1) CBE Règle : 60(2), 66(1) CBE
G 9/91 Décision du 31.03.1993 JO OEB 1993, 408	"Compétence pour examiner/ROHM AND HAAS" - Etendue de la compétence pour examiner l'opposition	Art. : 101, 102, 110, 114 CBE Règle : 55, 56 CBE
G 10/91 Avis du 31.03.1993 JO OEB 1993, 420	"Examen d'oppositions et de recours" - Etendue de l'obligation et de la compétence pour examiner des motifs d'opposition	Art. : 99 à 102, 110, 114 CBE Règle : 55, 56, 66 CBE
G 11/91 Décision du 19.11.1992 JO OEB 1993, 125	"Glu-Gln/CELTRIX" - Correction d'erreurs	Art. : 100c), 117(1), 123(1) et (2), 138(1)c) CBE Règle : 86, 88, deuxième phrase CBE
G 12/91 Décision du 17.12.1993 JO OEB 1994, 285	"Décision définitive/NOVATOME II" - Conclusion de la procédure écrite - Remise de la décision par la section des formalités au service du courrier interne de l'OEB	Règle : 68 CBE
G 1/92 Avis du 18.12.1992 JO OEB 1993, 277	"Accessibilité au public" - Nouveauté - état de la technique - accessibilité - composition du produit - utilisation antérieure connue	Art. : 54(2), 112(1)b) CBE

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G 2/92 Avis du 06.07.1993 JO OEB 1993, 591	“Non-paiement de nouvelles taxes de recherche” – Absence d'unité d'invention - les implications du défaut de paiement de nouvelles taxes de recherche	Art. : 82 CBE Règle : 46 CBE
G 3/92 Décision du 13.06.1994 JO OEB 1994, 607	“Demandeur non habilité/LATCHWAYS” – Opinion dissidente - Décision rendue par un tribunal national et passée en force de chose jugée - Partie autre que le demandeur ayant droit à l'obtention d'un brevet - Intérêts des tiers - Retrait de la demande initiale par le demandeur non habilité - Dépôt d'une nouvelle demande par le demandeur habilité	Art. : 60, 61, 167 CBE Règle : 13, 14, 15, 16 CBE Art. : 1 ^{er} , 9 Protocole sur la reconnaissance Art. : 12bis RPGCR
G 4/92 Avis du 29.10.1993 JO OEB 1994, 149	“Fondement des décisions” – Principe du contradictoire - Partie absente à une procédure orale	Art. : 113(1), 114(1) (2) CBE Règle : 71(2) CBE
G 5/92 Décision du 27.09.1993 JO OEB 1994, 22	“ <i>Restitutio in integrum</i> /HOUPT” – Application des dispositions de l'article 122(5) CBE	Art. : 122(5) CBE
G 6/92 Décision du 27.09.1993 JO OEB 1994, 25	“ <i>Restitutio in integrum</i> /DURIRON” – Application des dispositions de l'article 122(5) CBE	Art. : 122(5) CBE
G 9/92; G 4/93 Décision du 14.07.1994 JO OEB 1994, 875	“Partie non requérante/BMW” – <i>Reformatio in peius</i> - Maintien du brevet dans sa forme modifiée conformément à la requête subsidiaire - Décision n'ayant pas fait droit aux prétentions des deux parties - Recours d'une partie - Requêtes de la partie non requérante dépassant le cadre de l'acte de recours - Opinion de la minorité	Art. : 101(2), 107, 111, 114(1) CBE Règle : 58(2), 64b), 65(1), 66(1) CBE
G 10/92 Avis du 28.04.1994 JO OEB 1994, 633	“Demande divisionnaire” – Date limite de dépôt d'une demande divisionnaire	Règle : 25 CBE
G 1/93 Décision du 02.02.1994 JO OEB 1994, 541	“Caractéristique restrictive/ADVANCED SEMICONDUCTOR PRODUCTS” – Exigences contradictoires des paragraphes 2 et 3 de l'article 123 CBE	Art. : 123(2) (3) CBE

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G 2/93 Décision du 21.12.1994 JO OEB 1995, 275	<p>“Virus de l'hépatite A/ETATS-UNIS D'AMERIQUE II”</p> <p style="text-align: center;">–</p> <p>Exposé suffisamment clair et complet de l'invention - Indication du numéro de dépôt d'une culture</p>	<p>Art. : 83 CBE Règle : 28 CBE</p>
G 3/93 Avis du 16.08.1994 JO OEB 1995, 18	<p>“Délai de priorité”</p> <p style="text-align: center;">–</p> <p>Priorité - document publié pendant le délai de priorité - Etat de la technique - document publié pendant le délai de priorité - Nullité de la priorité - invention différente - Opinion incidente - recevabilité de la saisine</p>	<p>Art. : 54(2), 87 à 89 CBE</p>
G 5/93 Décision du 18.01.1994 JO OEB 1994, 447	<p>“<i>Restitutio in integrum</i>/NELLCOR”</p> <p style="text-align: center;">–</p> <p>Applicabilité de l'article 122(5) CBE</p>	<p>Art. : 122(5), 150, 157(2)b), 158(2) CBE Règle : 104ter(1)b) CBE (107(1)c) CBE</p>
G 7/93 Décision du 13.05.1994 JO OEB 1994, 775	<p>“Modifications tardives/WHITBY II”</p> <p style="text-align: center;">–</p> <p>Recevabilité de modifications après une notification établie conformément à la règle 51(6) - pouvoir discrétionnaire de la division d'examen - Réserves faites au titre de l'article 167(2) CBE</p>	<p>Art. : 96(2), 113(2), 123(1), 167(2) CBE Règle : 51(4) (6), 86(3) CBE</p>
G 8/93 Décision du 13.06.1994 JO OEB 1994, 887	<p>“Retrait de l'opposition/SERWANE II”</p> <p style="text-align: center;">–</p> <p>Retrait de l'opposition sans retrait du recours - Clôture de la procédure de recours</p>	<p>Art. : 114(1) CBE Règle : 60(2), 66(1) CBE</p>
G 9/93 Décision du 06.07.1994 JO OEB 1994, 891	<p>“Opposition par les titulaires du brevet/ PEUGEOT ET CITROEN”</p> <p style="text-align: center;">–</p> <p>Opposition formée par les titulaires du brevet contre leur propre brevet - recevabilité</p>	<p>Art. : 99 CBE</p>
G 10/93 Décision du 30.11.1994 JO OEB 1995, 172	<p>“Portée de l'examen lors d'une procédure ex parte de recours/SIEMENS”</p> <p style="text-align: center;">–</p> <p>Invocation de nouveaux motifs lors d'une procédure ex parte - <i>Reformatio in peius</i></p>	<p>Art. : 96(2), 97(1), 110, 111(1), 114(1) CBE</p>
G 1/94 Décision du 11.05.1994 JO OEB 1994, 787	<p>“Intervention/ALLIED COLLOIDS”</p> <p style="text-align: center;">–</p> <p>Recevabilité d'une intervention dans une procédure de recours</p>	<p>Art. : 105 CBE</p>

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G 2/94 Décision du 19.02.1996 JO OEB 1996, 401	“Représentation/HAUTAU II” – Exposé oral par un assistant dans une procédure <i>ex parte</i> - Exposé oral par un ancien membre d'une chambre dans le cadre d'une procédure <i>ex parte</i> ou <i>inter partes</i>	Art. : 116, 133, 134 CBE
G 1/95 Décision du 19.07.1996 JO OEB 1996, 615	“Nouveaux motifs d'opposition/DE LA RUE” – Pas de compétence pour examiner de nouveaux motifs d'opposition sans le consentement du titulaire du brevet	Art. : 99, 100a) b) c), 114(1) CBE Règle : 55, 56 CBE
G 2/95 Décision du 14.05.1996 JO OEB 1996, 555	“Remplacement des pièces de la demande/ATOTECH” – Remplacement des pièces de la demande par d'autres pièces dans le cadre d'une rectification en vertu de la 88 CBE (non)	Art. : 14(1) (2), 80d), 87(2), 100c), 123(2), 138(1)c), 164(2) CBE Art. : 4A(2) Convention de Paris Règle : 88 CBE Règle : 91.1c) PCT
G 3/95 Avis du 27.11.95 JO OEB 1996, 169	“Saisine irrecevable” – Brevetabilité des variétés végétales et des races animales - Décisions non divergentes - Irrecevabilité de la saisine par le Président de l'OEB	Art. : 53b), 112(1)b) CBE
G 4/95 Décision du 19.02.1996 JO OEB 1996, 412	“Représentation/BOGASKY” – Exposé oral présenté par un assistant lors d'une procédure d'opposition ou d'une procédure de recours sur opposition	Art. : 116, 117, 133, 134 CBE
G 6/95 Décision du 24.07.1996 JO OEB 1996, 649	“Interprétation de la règle 71bis (1) CBE/GE CHEMICALS” – Interprétation de la règle 71bis (1) CBE en ce qui concerne les chambres de recours	Art. : 23, 33(1)b), 112(1)a), 164(2) CBE Art. : 11(2), 18 RPCR Règle : 10(2), 11, 66(1), 71, 71bis (1) CBE
G 7/95 Décision du 19.07.1996 JO OEB 1996, 626	“Nouveaux motifs d'opposition/ETHICON” – Pas de compétence pour examiner de nouveaux motifs d'opposition sans le consentement du titulaire du brevet	Art. : 99, 100a) b) c), 114(1) CBE Règle : 55, 56 CBE
G 8/95 Décision du 16.04.1996 JO OEB 1996, 481	“Rectification d'une décision de délivrance/US GYPSUM II” – Compétence relative des chambres de recours technique et de la chambre de recours juridique - Rejet d'une rectification de la décision de délivrance	Art. : 21(3) CBE Règle : 89 CBE

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G 1/97 Décision du 10.12.1999 JO OEB 2000, 322	<p>“Requête en vue d'une révision/ETA” – Suites administratives ou juridictionnelles à réserver aux requêtes fondées sur la violation alléguée d'un principe fondamental de procédure et qui tendent à la révision d'une décision passée en force de chose jugée prise par une chambre de recours - Inscription au Registre européen des brevets</p>	<p>Art. : 21, 23(1) (3), 24, 106(1), 110(1), 111(1), 113, 114, 116, 121, 122, 125, 127 CBE Règle : 10(2), 11, 65(1), 66(2), 67, 89, 90, 92(1) (2) CBE Art. : 10 RPCR Art. : 11a, 11b RPGCR Art. : 23 RDMA Art. : 31, 32, 62(5) ADPIC (TRIPs) Art. : 31(3) Convention de Vienne sur le droit des traités</p>
G 2/97 Décision du 12.11.1998 JO OEB 1999, 123	<p>“Bonne foi/UNILEVER” – Taxe de recours - Principe de la bonne foi - Principe de la protection de la confiance légitime</p>	<p>Art. : 112(1)a), 108 CBE Règle : 69(1) CBE</p>
G 3/97 Décision du 21.01.1999 JO OEB 1999, 245	<p>“Opposition pour le compte d'un tiers/INDUPACK” – Recevabilité de l'opposition - Opposant agissant pour le compte d'un tiers - Contournement abusif de la loi</p>	<p>Art. : 99 CBE Règle : 55 CBE</p>
G 4/97 Décision du 21.01.1999 JO OEB 1999, 270	<p>“Opposition pour le compte d'un tiers/GENENTECH” – Recevabilité d'une opposition - Opposant agissant pour le compte d'un tiers - Contournement abusif de la loi</p>	<p>Art. : 99 CBE Règle : 55 CBE</p>
G 1/98 Décision du 20.12.1999 JO OEB 2000, 111	<p>“Plante transgénique/NOVARTIS II” – Revendications englobant mais n'identifiant pas des variétés végétales - Variétés végétales en tant que produits obtenus par recombinaison génétique - L'article 64(2) CBE n'est pas pertinent pour ce qui est de l'examen de revendications de produit</p>	<p>Art. : 52, 53b), 54, 64(2) CBE Règle : 23ter CBE Art. : 2b) Convention de Strasbourg Art. : 2 Convention UPOV de 1961 Art. : 1^{er} (vi) Convention UPOV de 1991</p>

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G 2/98 Avis du 31.05.2001 JO OEB 2001, 413	<p>“Condition requise pour qu'il puisse être revendiqué la priorité d'une demande portant sur la “même invention””</p> <p style="text-align: center;">–</p> <p>Interprétation de la notion de “même invention” mentionnée à l'article 87(1) CBE - Compatibilité de l'interprétation avec la Convention de Paris et la CBE - Conformité de l'interprétation avec les principes de l'égalité de traitement et de la sécurité juridique, et avec l'exigence de cohérence dans l'appréciation de la nouveauté et de l'activité inventive</p>	<p>Art. : 54(2) (3), 56, 60(2), 83, 84, 87(1) (4), 88(2) (3) (4), 89, 93, 112(1)b), 123(2) (3) CBE</p> <p>Art. : 4A(1), 4C(4), 4F, 4H, 19 Convention de Paris</p> <p>Art. : 11ter RPGCR</p>
G 3/98 Décision du 12.07.2000 JO OEB 2001, 62	<p>“Délai de six mois/UNIVERSITY PATENTS”</p> <p style="text-align: center;">–</p> <p>Recevabilité de la saisine - importance de la question de droit dans la procédure de recours (oui) - Calcul du délai de six mois selon l'article 55 CBE - date déterminante - date à laquelle la demande a été effectivement déposée</p>	<p>Art. : 54(2) (3), 55(1)a), 56, 89, 112(1)a) CBE</p> <p>Règle : 23 CBE</p> <p>Art. : 17 (2) RPCR</p> <p>Art. : 2, 4 Convention de Paris</p> <p>Art. : 4 Convention de Strasbourg</p> <p>Art. : 6 Convention européenne des Droits de l'Homme</p>
G 4/98 Avis du 27.11.2000 JO OEB 2001, 131	<p>“Taxes de désignation”</p> <p style="text-align: center;">–</p> <p>Défaut de paiement des taxes de désignation - La fiction de retrait n'a pas d'effet rétroactif excepté pour l'article 67 CBE - La fiction du retrait prend effet à l'expiration du délai de paiement des taxes de désignation</p>	<p>Art. : 66, 67, 76, 79, 80, 90, 91, 112 CBE</p> <p>Règle : 5, 25, 85bis, 107, 108 CBE</p> <p>Article 4 Convention de Paris</p>
G 1/99 Décision du 02.04.2001 JO OEB 2001, 381	<p>“Reformatio in pejus/3M”</p> <p style="text-align: center;">–</p> <p>Reformatio in pejus - exception à l'interdiction - Statut du requérant/opposant - Statut du requérant/titulaire du brevet</p>	<p>Art. : 100, 101(1), 102(1) (2) (3), 106(1), 107, 108, 112(1)a), 114(1), 123(2) (3), 125 CBE</p> <p>Règle : 57bis, 58(2), 64b), 66(1), 87 CBE</p>
G 2/99 Décision du 12.07.2000 JO OEB 2001, 83	<p>“Délai de six mois/DEWERT”</p> <p style="text-align: center;">–</p> <p>Recevabilité de la saisine - importance de la question de droit dans la procédure de recours (oui) - Calcul du délai de six mois selon l'article 55 CBE - date déterminante - date à laquelle la demande a été effectivement déposée</p>	<p>Art. : 54(2)(3), 55(1)a), 56, 89, 112(1)a) CBE</p> <p>Règle : 23 CBE</p> <p>Art. : 17 (2) RPCR</p> <p>Art. : 2, 4 Convention de Paris</p> <p>Art. : 4 Convention de Strasbourg</p> <p>Art. : 6 Convention européenne des Droits de l'Homme</p>

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G 3/99 Décision du 18.02.2002 JO OEB 2002, 347	<p>“Recevabilité d’une opposition conjointe ou d’un recours conjoint/HOWARD FLOREY”</p> <p style="text-align: center;">–</p> <p>Recevabilité - Taxe d’opposition - personnes agissant conjointement pour former une opposition - opposition conjointe - Recevabilité - Taxe de recours - personnes agissant conjointement pour former un recours - recours conjoint - Représentant commun</p>	<p>Art. : 58, 99, 99(1), 104, 107, 110(1), 112(1)a), 133, 133(4), 134 CBE</p> <p>Règle : 1, 26(2)c), 36(3), 55, 55a), 56(2), 60(2), 66(1), 100, 100(1) CBE</p>
G 1/02 Avis du 22.01.2003 JO OEB 2003, 165	<p>“Compétences des agents des formalités”</p> <p style="text-align: center;">–</p> <p>Divisions d’opposition - Agents des formalités - Décisions - Compétences</p>	<p>Art. : 10(2)a), 10(2)i), 15, 18(2), 19, 19(1), 19(2), 21, 21(3)a), 21(3)b), 21(3)c), 21(4), 33(3), 90, 91, 91(3), 99(1), 102(5), 106, 112(1)b), 164(2) CBE</p> <p>Règle : 9, 9(3), 51(4), 55c), 56(1), 56(2), 56(3), 57(1), 69(1), 69(2) CBE</p> <p>Communiqué du Vice-Président chargé de la direction générale 2 daté du 28.4.1999, points 4 et 6</p>
G 2/02 et G 3/02 Décision du 26.04.2004 JO OEB 2004, 483	<p>“Priorités de demandes indiennes/ASTRAZENECA”</p> <p style="text-align: center;">–</p> <p>Demandes internationales - priorités de demandes indiennes - Applicabilité de l’article 87(5) CBE - Position au titre du PCT - OEB non partie à l’Accord sur les ADPIC - Interprétation de l’article 87 CBE - selon les principes du droit international public - à la lumière des obligations des Etats contractants au titre de l’Accord sur les ADPIC</p>	<p>Art. : 23(3), 33, 66, 87(1) et (5), 88, 112(1)a), 150(2), 172 CBE</p> <p>Art. : 8 PCT</p> <p>Règle : 4.10 PCT</p> <p>Art. : 1 - 12, 4A(2), 19 Convention de Paris</p> <p>Art. : 5, 26, 34, 38 Convention de Vienne de 1969</p> <p>Art. : 34, 35, 38 Convention de Vienne de 1986</p> <p>Art. : 1, 2 (1) ADPIC (TRIPs)</p> <p>Art. : 38 Statut de la Cour internationale de justice</p> <p>Art. : 27 Déclaration universelle des Droits de l’Homme</p>
G 1/03 Décision du 08.04.2004 JO OEB 2004, 413	<p>“Disclaimer/PPG”</p> <p style="text-align: center;">–</p> <p>Admissibilité des disclaimers - délimitation par rapport à l’état de la technique tel que défini à l’article 54(2) et à l’article 54(3) et (4) - antériorisation fortuite - exclusion d’éléments non susceptibles d’être protégés par brevet Formulation des disclaimers - exigences de clarté et de concision</p>	<p>Art. : 52, 53, 54(2), (3) et (4), 56, 57, 60(2), 84, 87(1), 112(1), 123(2) et (3), 139(2) CBE</p> <p>Règle : 27(1)b), 29(1) CBE</p>

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G 2/03 Décision du 08.04.2004 JO OEB 2004, 448	<p>"Disclaimer/GENETIC SYSTEMS"</p> <p style="text-align: center;">–</p> <p>Admissibilité des disclaimers - délimitation par rapport à l'état de la technique tel que défini à l'article 54(2) et à l'article 54(3) et (4) - antériorisation fortuite - exclusion d'éléments non susceptibles d'être protégés par brevet Formulation des disclaimers - exigences de clarté et de concision</p>	<p>Art. : 52, 53, 54(2), (3) et (4), 56, 57, 60(2), 84, 87(1), 112(1), 123(2) et (3), 139(2) CBE Règle : 27(1)b), 29(1) CBE</p>
G 3/03 Décision du 28.01.2005 JO OEB 2005, 344	<p>"Remboursement de la taxe de recours/HIGHLAND"</p> <p style="text-align: center;">–</p> <p>Révision préjudicielle et requête en remboursement de la taxe de recours - instance du premier degré non compétente pour rejeter la requête pour des raisons d'équité - compétence de la chambre de recours qui aurait été compétente pour statuer sur le recours au fond en l'absence de révision préjudicielle</p>	<p>Art. : 21, 106, 107, 108, 109, 111(1) et 112(1) CBE Règle : 67 CBE Art. : 11 RRT</p>

Anhang II

Übersicht über die Rechtsauskünfte des EPA

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Annexe II

Tableau récapitulatif des renseignements juridiques communiqués par l'OEB

Übersicht über die Rechtsauskünfte des EPA

Nr.	ABI. EPA	Titel	Bemerkungen
1/79			Aufgehoben (siehe ABI. EPA 1998, 359)
2/79			Aufgehoben (siehe ABI. EPA 1998, 359)
3/85 rev.	1985, 347	Anspruchsgebühren - Mehrere Sätze von Patentansprüchen	Die Grundsätze der Rechtsauskunft gelten weiterhin; zu berücksichtigen sind die Änderungen der Regeln 31 und 51 EPÜ (siehe auch Bemerkung zu Rechtsauskunft Nr. 4/80)
4/80	1980, 48	Zeitpunkt der Vorlage eines getrennten Satzes von Patentansprüchen für Österreich	Siehe hierzu die Entscheidung G 7/93 (ABI. EPA 1994, 775: Punkt 2.5 der Gründe)
5/93 rev.	1993, 229	Berechnung von zusammengesetzten Fristen	
6/91 rev.	1991, 573	Entrichtung der Gebühren Rückerstattung von Gebühren oder Geldbeträgen	
7/80			Aufgehoben (siehe ABI. EPA 1998, 359)
8/80	1981, 6	Zurücknahme der europäischen Patentanmeldung	Siehe hierzu u. a. die Entscheidungen J 6/86 (ABI. EPA 1988, 124); J 15/86 (ABI. EPA 1988, 417); J 7/87 (ABI. EPA 1988, 422); J 11/87 (ABI. EPA 1988, 367)
9/81			Aufgehoben (siehe ABI. EPA 1998, 359)
10/92 rev.	1992, 662	Verbindung einer europäischen Patentanmeldung mit einer Euro-PCT-Anmeldung - Rückerstattung der Prüfungsgebühr	Derzeit sind alle EPÜ-Vertragsstaaten auch PCT-Vertragsstaaten; die Grundsätze der Rechtsauskunft gelten für "Altfälle" sowie in Zukunft für Anmeldungen, in denen europäische Vertragsstaaten benannt werden, für die der PCT nicht in Kraft ist
11/82	1982, 57	Widerruf des Patents im Einspruchsverfahren	Betrifft den Widerruf auf Veranlassung des Patentinhabers; siehe auch die Entscheidungen T 73/84 (ABI. EPA 1985, 241) und T 186/84 (ABI. EPA 1986, 79)
12/82			Aufgehoben (siehe ABI. EPA 1998, 359)
13/82	1982, 196	Weiterbehandlung der europäischen Patentanmeldung	
14/83			Aufgehoben (siehe ABI. EPA 2002, 161)
15/05 rev. 2	2005, 357	Hilfsanträge im Prüfungs- und Einspruchsverfahren	

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Nr.	ABI. EPA	Titel	Bemerkungen
16/85	1985, 141	Antrag auf Entscheidung nach Feststellung eines Rechtsverlusts	Betrifft das Prüfungsverfahren; für das Einspruchsverfahren siehe die Entscheidung G 1/90 (ABI. EPA 1991, 275)
17/90	1990, 260	Maßgebliche Fassung des erteilten Patents bei fehlerhaftem Druck der europäischen Patentschrift	
18/92			Aufgehoben (siehe ABI. EPA 2002, 259)
19/99	1999, 296	Einreichung einer Übersetzung der früheren Anmeldung oder einer Erklärung nach Regel 38 (4) EPÜ	Rechtsgrundlage der "Erklärung" ist nunmehr Regel 38 (5) EPÜ (ABI. EPA 1999, 660)

Legal advice from the EPO in brief

No.	OJ EPO	Title	Comments
1/79			Cancelled (see OJ EPO 1998, 359).
2/79			Cancelled (see OJ EPO 1998, 359).
3/85 rev.	1985, 347	Claims fees - multiple sets of claims	The principles remain the same, but the amendments to Rules 31 and 51 EPC should be borne in mind (see also comment re Legal Advice No. 4/80).
4/80	1980, 48	Period for submitting a separate set of claims for Austria	See decision G 7/93 (OJ EPO 1994, 775: point 2.5 Reasons).
5/93 rev.	1993, 229	Calculation of aggregate time limits	
6/91 rev.	1991, 573	Payment of fees Refunds of fees or other sums	
7/80			Cancelled (see OJ EPO 1998, 359).
8/80	1981, 6	Withdrawal of a European patent application	See decisions J 6/86 (OJ EPO 1988, 124); J 15/86 (OJ EPO 1988, 417); J 7/87 (OJ EPO 1988, 422); J 11/87 (OJ EPO 1988, 367).
9/81			Cancelled (see OJ EPO 1998, 359).
10/92 rev.	1992, 662	Consolidation of a European patent application with a Euro-PCT-application - Refund of the examination fee	At present all EPC Contracting States are also PCT Contracting States. The principles apply to cases predating this state of affairs and to future applications designating European Contracting States for which the PCT is not in force.
11/82	1982, 57	Revocation of the European patent during opposition proceedings	Relates to revocation at the request of the patent proprietor. See also decision T 73/84 (OJ EPO 1985, 241) and T 186/84 (OJ EPO 1986, 79).
12/82			Cancelled (see OJ EPO 1998, 359).
13/82	1982, 196	Further processing of the European patent application	
14/83			Cancelled (see OJ EPO 2002, 161).
15/05 rev. 2	2005, 357	Auxiliary requests in examination and opposition proceedings	
16/85	1985, 141	Request for a decision after the noting of loss of rights	Relates to the examination proceedings. For the opposition procedure see decision G 1/90 (OJ EPO 1991, 275).

Legal advice from the EPO in brief

No.	OJ EPO	Title	Comments
17/90	1990, 260	Authentic text of a granted patent when the specification contains misprints	
18/92			Cancelled (see OJ EPO 2002, 259).
19/99	1999, 296	Filing of a translation of the previous application or a declaration under Rule 38(4) EPC	The legal basis of the "declaration" is now Rule 38(5) EPC (OJ EPO 1999, 660).

Tableau récapitulatif des renseignements juridiques communiqués par l'OEB

N°	JO OEB	Titre	Observations
1/79			Annulé (cf. JO OEB 1998, 359).
2/79			Annulé (cf. JO OEB 1998, 359).
3/85 rév.	1985, 347	Taxes de revendication - Plusieurs jeux de revendications	Les principes énoncés dans ce renseignement sont toujours valables. Il y a lieu de tenir compte des modifications apportées aux règles 31 et 51 CBE (voir aussi observations sur le renseignement juridique n° 4/80).
4/80	1980, 48	Moment où doit être présentée la série distincte de revendications pour l'Autriche	Voir à ce propos la décision G 7/93 (JO OEB 1994, 775 : point 2.5 des motifs).
5/93 rév.	1993, 229	Calcul des délais composés	
6/91 rév.	1991, 573	Paiement des taxes Remboursement de taxes ou d'autres montants	
7/80			Annulé (cf. JO OEB 1998, 359).
8/80	1981, 6	Retrait de la demande de brevet européen	Voir aussi les décisions J 6/86 (JO OEB 1988, 124) ; J 15/86 (JO OEB 1988, 417) ; J 7/87 (JO OEB 1988, 422) ; J 11/87 (JO OEB 1988, 367).
9/81			Annulé (cf. JO OEB 1998, 359).
10/92 rév.	1992, 662	Jonction d'une demande de brevet européen et d'une demande euro-PCT - Remboursement de la taxe d'examen	Actuellement, tous les Etats parties à la CBE sont également parties au PCT. Les principes énoncés dans ce renseignement juridique valent pour les « anciens cas » et aussi, à l'avenir, pour les demandes désignant des Etats contractants à l'égard desquels le PCT n'est pas en vigueur.
11/82	1982, 57	Révocation du brevet au cours de la procédure d'opposition	Concerne la révocation du brevet à l'initiative du titulaire du brevet. Voir aussi les décisions T 73/84 (JO OEB 1985, 241) et T 186/84 (JO OEB 1986, 79).
12/82			Annulé (cf. JO OEB 1998, 359).
13/82	1982, 196	Poursuite de la procédure de la demande de brevet	
14/83			Annulé (cf. JO OEB 2002, 161).

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N°	JO OEB	Titre	Observations
15/05 rév. 2	2005, 357	Requêtes subsidiaires dans la procédure d'examen et la procédure d'opposition	
16/85	1985, 141	Requête en décision après constatation de la perte d'un droit	Concerne la procédure d'examen; pour la procédure d'opposition, voir la décision G 1/90 (JO OEB 1991, 275).
17/90	1990, 260	Texte du brevet délivré, faisant foi en cas d'impression défectueuse du fascicule du brevet européen	
18/92			Annulé (cf. JO OEB 2002, 259).
19/99	1999, 296 et 571	Production d'une traduction de la demande antérieure ou présentation d'une déclaration conformément à la règle 38(4) CBE	La règle 38(5) CBE constitue à présent la base juridique de la "déclaration" (JO OEB 1999, 660).

**Alphabetisches
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eP für "europäisches Patent"
ePA für "europäische Patentanmeldung"
EPA für "Europäisches Patentamt"
EPO für "Europäische Patentorganisation"
EPÜ für "Europäisches Patentübereinkommen"
GebO für "Gebührenordnung"
PCT für "Vertrag über die internationale Zusammenarbeit auf dem Gebiet des Patentwesens"
VorImProt für "Protokoll über die Vorrechte und Immunitäten der Europäischen Patentorganisation (Protokoll über Vorrechte und Immunitäten)"
ZentProt für "Protokoll über die Zentralisierung des europäischen Patentsystems und seine Einführung (Zentralisierungsprotokoll)"

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Abbreviations used:

EPC for “European Patent Convention”,
EPOff for “European Patent Office”,
EPOrg for “European Patent Organisation”,
Eur. pat. for “European patent”,
Eur. pat. appl. for “European patent application”,
PCT for “Patent Cooperation Treaty”,
ProCen for “Protocol on the Centralisation of the European Patent System and on its Introduction (Protocol on Centralisation)”,
ProPrIm for “Protocol on Privileges and Immunities of the European Patent Organisation (Protocol on Privileges and Immunities)”,
ProRecog for “Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent (Protocol on Recognition)”
RFees for “Rules relating to Fees”.

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Abréviations utilisées :

brev. eur. : brevet européen
CBE : Convention sur le brevet européen
dem. eur. : demande de brevet européen
OEB (off.) : Office européen des brevets
OEB (org.) : Organisation européenne des brevets
PCT : Traité de coopération en matière de brevets
ProCen : Protocole sur la centralisation et l'introduction du système européen des brevets (Protocole sur la centralisation)
ProPrIm : Protocole sur les privilèges et immunités de l'Organisation européenne des brevets (Protocole sur les privilèges et immunités)
ProRec : Protocole sur la compétence judiciaire et la reconnaissance de décisions portant sur le droit à l'obtention du brevet européen (Protocole sur la reconnaissance)
RRT : Règlement relatif aux taxes

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**Council Regulation (EC) No 40/94
of 20 December 1993
on the Community trade mark**

COUNCIL REGULATION (EC) No 40/94 of 20 December 1993 on the Community trade mark

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 235 thereof,

Having regard to the proposal from the Commission (1),

Having regard to the opinion of the European Parliament (2),

Having regard to the opinion of the Economic and Social Committee (3),

Whereas it is desirable to promote throughout the Community a harmonious development of economic activities and a continuous and balanced expansion by completing an internal market which functions properly and offers conditions which are similar to those obtaining in a national market; whereas in order to create a market of this kind and make it increasingly a single market, not only must be barriers to free movement of goods and services be removed and arrangements be instituted which ensure that competition is not distorted, but, in addition, legal conditions must be created which enable undertakings to adapt their activities to the scale of the Community, whether in manufacturing and distributing goods or in providing services; whereas for those purposes, trade marks enabling the products and services of undertakings to be distinguished by identical means throughout the entire Community, regardless of frontiers, should feature amongst the legal instruments which undertakings have at their disposal;

Whereas action by the Community would appear to be necessary for the purpose of attaining the Community's said objectives; whereas such action involves the creation of Community arrangements for trade marks whereby undertakings can by means of one procedural system obtain Community trade marks to which uniform protection is given and which produce their effects throughout the entire area of the Community; whereas the principle of the unitary character of the Community trade mark thus stated will apply unless otherwise provided for in this Regulation;

Whereas the barrier of territoriality of the rights conferred on proprietors of trade marks by the laws of the Member States cannot be removed by approximation of laws; whereas in order to open up unrestricted economic activity in the whole of the common market for the benefit of undertakings, trade marks need to be created which are governed by a uniform Community law directly applicable in all Member States;

Whereas since the Treaty has not provided the specific powers to establish such a legal instrument, Article 235 of the Treaty should be applied;

Whereas the Community law relating to trade marks nevertheless does not replace the laws of the Member States on trade marks; whereas it would not in fact appear to be justified to require undertakings to apply for registration of their trade marks as Community trade marks; whereas national trade marks continue to be necessary for those undertakings which do not want protection of their trade marks at Community level;

Whereas the rights in a Community trade mark may not be obtained otherwise than by registration, and registration is to be refused in particular if the trade mark is not distinctive, if it is unlawful or if it conflicts with earlier rights;

Whereas the protection afforded by a Community trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, is absolute in the case of identity between

the mark and the sign and the goods or services; whereas the protection applies also in cases of similarity between the mark and the sign and the goods or services; whereas an interpretation should be given of the concept of similarity in relation to the likelihood of confusion; whereas the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for such protection;

Whereas it follows from the principle of free flow of goods that the proprietor of a Community trade mark must not be entitled to prohibit its use by a third party in relation to goods which have been put into circulation in the Community, under the trade mark, by him or with his consent, save where there exist legitimate reasons for the proprietor to oppose further commercialization of the goods;

Whereas there is no justification for protecting Community trade marks or, as against them, any trade mark which has been registered before them, except where the trade marks are actually used;

Whereas a Community trade mark is to be regarded as an object of property which exists separately from the undertakings whose goods or services are designated by it; whereas accordingly, it must be capable of being transferred, subject to the overriding need to prevent the public being misled as a result of the transfer. It must also be capable of being charged as security in favour of a third party and of being the subject matter of licences;

Whereas administrative measures are necessary at Community level for implementing in relation to every trade mark the trade mark law created by this Regulation; whereas it is therefore essential, while retaining the Community's existing institutional structure and balance of powers, to establish an Office for Harmonization in the Internal Market (trade marks and designs) which is independent in relation to technical matters and has legal, administrative and financial autonomy; whereas to this end it is necessary and appropriate that it should be a body of the Community having legal personality and exercising the implementing powers which are conferred on it by this Regulation, and that it should operate within the framework of Community law without detracting from the competencies exercised by the Community institutions;

Whereas it is necessary to ensure that parties who are affected by decisions made by the Office are protected by the law in a manner which is suited to the special character of trade mark law; whereas to that end provision is made for an appeal to lie from decisions of the examiners and of the various divisions of the Office; whereas if the department whose decision is contested does not rectify its decision it is to remit the appeal to a Board of Appeal of the Office, which is to decide on it; whereas decisions of the Boards of Appeal are, in turn, amenable to actions before the Court of Justice of the European Communities, which has jurisdiction to annul or to alter the contested decision;

Whereas under Council Decision 88/591/ECSC, EEC, Euratom of 24 October 1988 establishing a Court of First Instance of the European Communities (4), as amended by Decision 93/350/Euratom, ECSC, EEC of 8 June 1993 (5), that Court shall exercise at the first instance the jurisdiction conferred on the Court of Justice by the Treaties establishing the Communities - with particular regard to appeals lodged under the second subparagraph of Article 173 of the EC Treaty - and by the acts adopted in implementation thereof, save as otherwise provided in an act setting up a body governed by Community law; whereas the jurisdiction which this Regulation confers on the Court of Justice to cancel and reform decisions of the appeal courts shall accordingly be exercised at the first instance by the Court in accordance with the above Decision;

Whereas in order to strengthen the protection of Community trade marks the Member States should

designate, having regard to their own national system, as limited a number as possible of national courts of first and second instance having jurisdiction in matters of infringement and validity of Community trade marks;

Whereas decisions regarding the validity and infringement of Community trade marks must have effect and cover the entire area of the Community, as this is the only way of preventing inconsistent decisions on the part of the courts and the Office and of ensuring that the unitary character of Community trade marks is not undermined; whereas the rules contained in the Brussels Convention of Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters will apply to all actions at law relating to Community trade marks, save where this Regulation derogates from those rules;

Whereas contradictory judgments should be avoided in actions which involve the same acts and the same parties and which are brought on the basis of a Community trade mark and parallel national trade marks; whereas for this purpose, when the actions are brought in the same Member State, the way in which this is to be achieved is a matter for national procedural rules, which are not prejudiced by this Regulation, whilst when the actions are brought in different Member States, provisions modelled on the rules on *lis pendens* and related actions of the abovementioned Brussels Convention appear appropriate;

Whereas in order to guarantee the full autonomy and independence of the Office, it is considered necessary to grant it an autonomous budget whose revenue comes principally from fees paid by the users of the system; whereas however, the Community budgetary procedure remains applicable as far as any subsidies chargeable to general budget of the European Communities are concerned; whereas moreover, the auditing of accounts should be undertaken by the Court of Auditors;

Whereas implementing measures are required for the Regulation's application, particularly as regards the adoption and amendment of fees regulations and an Implementing Regulation; whereas such measures should be adopted by the Commission, assisted by a Committee composed of representatives of the Member States, in accordance with the procedural rules laid down in Article 2, procedure III(b), of Council Decisions 87/373/EEC of 13 July 1987 laying down the procedures for the exercise of implementing powers conferred on the Commission (6),

HAS ADOPTED THIS REGULATION:

TITLE I GENERAL PROVISIONS

Article 1

Community trade mark

1. A trade mark for goods or services which is registered in accordance with the conditions contained in this Regulation and in the manner herein provided is hereinafter referred to as a 'Community trade mark'.
2. A Community trade mark shall have a unitary character. It shall have equal effect throughout the Community: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle shall apply unless otherwise provided in this Regulation.

Article 2

Office

An Office for Harmonization in the Internal Market (trade marks and designs), hereinafter referred to as 'the Office', is hereby established.

Article 3

Capacity to act

For the purpose of implementing this Regulation, companies or firms and other legal bodies shall be regarded as legal persons if, under the terms of the law governing them, they have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued.

TITLE II THE LAW RELATING TO TRADE MARKS

SECTION 1

DEFINITION OF A COMMUNITY TRADE MARK OBTAINING A COMMUNITY TRADE MARK

Article 4

Signs of which a Community trade mark may consist

A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Article 5

Persons who can be proprietors of Community trade marks

1. The following natural or legal persons, including authorities established under public law, may be proprietors of Community trade marks:

- (a) nationals of the Member States; or
- (b) nationals of other States which are parties to the Paris Convention for the protection of industrial property, hereinafter referred to as 'the Paris Convention'; or
- (c) nationals of States which are not parties to the Paris Convention who are domiciled or have their seat or who have real and effective industrial or commercial establishments within the territory of the Community or of a State which is party to the Paris Convention; or
- (d) nationals, other than those referred to under subparagraph (c), of any State which is not party to the Paris Convention and which, according to published findings, accords to nationals of

all the Member States the same protection for trade marks as it accords to its own nationals and, if nationals of the Member States are required to prove registration in the country of origin, recognizes the registration of Community trade marks as such proof.

2. With respect to the application of paragraph 1, stateless persons as defined by Article 1 of the Convention relating to the Status of Stateless Persons signed at New York on 28 September 1954, and refugees as defined by Article 1 of the Convention relating to the Status of Refugees signed at Geneva on 28 July 1951 and modified by the Protocol relating to the Status of Refugees signed at New York on 31 January 1967, shall be regarded as nationals of the country in which they have their habitual residence.

3. Persons who are nationals of a State covered by paragraph 1 (d) must prove that the trade mark for which an application for a Community trade mark has been submitted is registered in the State of origin, unless, according to published findings, the trade marks of nationals of the Member States are registered in the State of origin in question without proof of prior registration as a Community trade mark or as a national trade mark in a Member State.

Article 6

Means whereby a Community trade mark is obtained

A Community trade mark shall be obtained by registration.

Article 7

Absolute grounds for refusal

1. The following shall not be registered:

- (a) signs which do not conform to the requirements of Article 4;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
- (e) signs which consist exclusively of:
 - (i) the shape which results from the nature of the goods themselves; or
 - (ii) the shape of goods which is necessary to obtain a technical result; or
 - (iii) the shape which gives substantial value to the goods;
- (f) trade marks which are contrary to public policy or to accepted principles of morality;
- (g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;
- (h) trade marks which have not been authorized by the competent authorities and are to be refused

pursuant to Article 6ter of the Paris Convention;

(i) trade marks which include badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest, unless the consent of the appropriate authorities to their registration has been given.

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.

3. Paragraph 1 (b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.

Article 8

Relative grounds for refusal

1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

- (a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;
- (b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

2. for the purposes of paragraph 1, 'Earlier trade marks` means:

- (a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the Community trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:
 - (i) Community trade marks;
 - (ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Trade Mark Office;
 - (iii) trade marks registered under international arrangements which have effect in a Member State;
- (b) applications for the trade marks referred to in subparagraph (a), subject to their registration;
- (c) trade marks which, on the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known in a Member State, in the sense in which the words 'well known` are used in Article 6 bis of the Paris Convention.

3. Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.

4. Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the law of the Member State governing that

sign,

- (a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;
- (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

5. Furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

SECTION 2

EFFECTS OF COMMUNITY TRADE MARKS

Article 9

Rights conferred by a Community trade mark

1. A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

- (a) any sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered;
- (b) any sign where, because of its identity with or similarity to the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
- (c) any sign which is identical with or similar to the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the latter has a reputation in the Community and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.

2. The following, inter alia, may be prohibited under paragraph 1:

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under that sign;
- (d) using the sign on business papers and in advertising.

3. The rights conferred by a Community trade mark shall prevail against third parties from the date of publication of registration of the trade mark. Reasonable compensation may, however, be

claimed in respect of matters arising after the date of publication of a Community trade mark application, which matters would, after publication of the registration of the trade mark, be prohibited by virtue of that publication. The court seized of the case may not decide upon the merits of the case until the registration has been published.

Article 10

Reproduction of Community trade marks in dictionaries

If the reproduction of a Community trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work shall, at the request of the proprietor of the Community trade mark, ensure that the reproduction of the trade mark at the latest in the next edition of the publication is accompanied by an indication that it is a registered trade mark.

Article 11

Prohibition on the use of a Community trade mark registered in the name of an agent or representative

Where a Community trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorization, the latter shall be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use, unless the agent or representative justifies his action.

Article 12

Limitation of the effects of a Community trade mark

A Community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

- (a) his own name or address;
- (b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;
- (c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts,

provided he uses them in accordance with honest practices in industrial or commercial matters.

Article 13

Exhaustion of the rights conferred by a Community trade mark

1. A Community trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Community under that trade mark by the proprietor or with

his consent.

2. Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialization of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

Article 14

Complementary application of national law relating to infringement

1. The effects of Community trade marks shall be governed solely by the provisions of this Regulation. In other respects, infringement of a Community trade mark shall be governed by the national law relating to infringement of a national trade mark in accordance with the provisions of Title X.

2. This Regulation shall not prevent actions concerning a Community trade mark being brought under the law of Member States relating in particular to civil liability and unfair competition.

3. The rules of procedure to be applied shall be determined in accordance with the provisions of Title X.

SECTION 3

USE OF COMMUNITY TRADE MARKS

Article 15

Use of Community trade marks

1. If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

2. The following shall also constitute use within the meaning of paragraph 1:

- (a) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;
- (b) affixing of the Community trade mark to goods or to the packaging thereof in the Community solely for export purposes.

3. Use of the Community trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

SECTION 4

COMMUNITY TRADE MARKS AS OBJECTS OF PROPERTY

Article 16

Dealing with Community trade marks as national trade marks

1. Unless Articles 17 to 24 provide otherwise, a Community trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national trade mark registered in the Member State in which, according to the Register of Community trade marks,

- (a) the proprietor has his seat or his domicile on the relevant date; or
- (b) where subparagraph (a) does not apply, the proprietor has an establishment on the relevant date.

2. In cases which are not provided for by paragraph 1, the Member State referred to in that paragraph shall be the Member State in which the seat of the Office is situated.

3. If two or more persons are mentioned in the Register of Community trade marks as joint proprietors, paragraph 1 shall apply to the joint proprietor first mentioned; failing this, it shall apply to the subsequent joint proprietors in the order in which they are mentioned. Where paragraph 1 does not apply to any of the joint proprietors, paragraph 2 shall apply.

Article 17

Transfer

1. A Community trade mark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered.

2. A transfer of the whole of the undertaking shall include the transfer of the Community trade mark except where, in accordance with the law governing the transfer, there is agreement to the contrary or circumstances clearly dictate otherwise. This provision shall apply to the contractual obligation to transfer the undertaking.

3. Without prejudice to paragraph 2, an assignment of the Community trade mark shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgment; otherwise it shall be void.

4. Where it is clear from the transfer documents that because of the transfer the Community trade mark is likely to mislead the public concerning the nature, quality or geographical origin of the goods or services in respect of which it is registered, the Office shall not register the transfer unless the successor agrees to limit registration of the Community trade mark to goods or services in respect of which it is not likely to mislead.

5. On request of one of the parties a transfer shall be entered in the Register and published.

6. As long as the transfer has not been entered in the Register, the successor in title may not invoke the rights arising from the registration of the Community trade mark.

7. Where there are time limits to be observed vis-à-vis the Office, the successor in title may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office.

8. All documents which require notification to the proprietor of the Community trade mark in accordance with Article 77 shall be addressed to the person registered as proprietor.

Article 18

Transfer of a trade mark registered in the name of an agent

Where a Community trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorization, the latter shall be entitled to demand the assignment in his favour of the said registration, unless such agent or representative justifies his action.

Article 19

Rights in rem

1. A Community trade mark may, independently of the undertaking, be given as security or be the subject of rights in rem.
2. On request of one of the parties, rights mentioned in paragraph 1 shall be entered in the Register and published.

Article 20

Levy of execution

1. A Community trade mark may be levied in execution.
2. As regards the procedure for levy of execution in respect of a Community trade mark, the courts and authorities of the Member States determined in accordance with Article 16 shall have exclusive jurisdiction.
3. On request of one the parties, levy of execution shall be entered in the Register and published.

Article 21

Bankruptcy or like proceedings

1. Until such time as common rules for the Member States in this field enter into force, the only Member State in which a Community trade mark may be involved in bankruptcy or like proceedings shall be that in which such proceedings are first brought within the meaning of national law or of conventions applicable in this field.
2. Where a Community trade mark is involved in bankruptcy or like proceedings, on request of the competent national authority an entry to this effect shall be made in the Register and published.

Article 22

Licensing

1. A Community trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Community. A licence may be exclusive or non-exclusive.
2. The proprietor of a Community trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in his licensing contract with regard to its duration,

the form covered by the registration in which the trade mark may be used, the scope of the goods or services for which the licence is granted, the territory in which the trade mark may be affixed, or the quality of the goods manufactured or of the services provided by the licensee.

3. Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a Community trade mark only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the trade mark, after formal notice, does not himself bring infringement proceedings within an appropriate period.

4. A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement proceedings brought by the proprietor of the Community trade mark.

5. On request of one of the parties the grant or transfer of a licence in respect of a Community trade mark shall be entered in the Register and published.

Article 23

Effects vis-à-vis third parties

1. Legal acts referred to in Article 17, 19 and 22 concerning a Community trade mark shall only have effects vis-à-vis third parties in all the Member States after entry in the Register. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights in the trade mark after the date of that act but who knew of the act at the date on which the rights were acquired.

2. Paragraph 1 shall not apply in the case of a person who acquires the Community trade mark or a right concerning the Community trade mark by way of transfer of the whole of the undertaking or by any other universal succession.

3. The effects vis-à-vis third parties of the legal acts referred to in Article 20 shall be governed by the law of the Member State determined in accordance with Article 16.

4. Until such time as common rules for the Member States in the field of bankruptcy enter into force, the effects vis-à-vis third parties of bankruptcy or like proceedings shall be governed by the law of the Member State in which such proceedings are first brought within the meaning of national law or of conventions applicable in this field.

Article 24

The application for a Community trade mark as an object of property

Articles 16 to 23 shall apply to applications for Community trade marks.

TITLE III APPLICATION FOR COMMUNITY TRADE MARKS

SECTION 1

FILING OF APPLICATIONS AND THE CONDITIONS WHICH GOVERN THEM

Article 25

Filing of applications

1. An application for a Community trade mark shall be filed, at the choice of the applicant,
 - (a) at the Office; or
 - (b) at the central industrial property office of a Member State or at the Benelux Trade Mark Office. An application filed in this way shall have the same effect as if it had been filed on the same date at the Office.
2. Where the application is filed at the central industrial property office of a Member State or at the Benelux Trade Mark Office, that office shall take all steps to forward the application to the Office within two weeks after filing. It may charge the applicant a fee which shall not exceed the administrative costs of receiving and forwarding the application.
3. Applications referred to in paragraph 2 which reach the Office more than one month after filing shall be deemed withdrawn.
4. Ten years after the entry into force of this Regulation, the Commission shall draw up a report on the operation of the system of filing applications for Community trade marks, together with any proposals for modifying this system.

Article 26

Conditions with which applications must comply

1. An application for a Community trade mark shall contain:
 - (a) a request for the registration of a Community trade mark;
 - (b) information identifying the applicant;
 - (c) a list of the goods or services in respect of which the registration is requested;
 - (d) a representation of the trade mark.
2. The application for a Community trade mark shall be subject to the payment of the application fee and, when appropriate, of one or more class fees.
3. An application for a Community trade mark must comply with the conditions laid down in the implementing Regulation referred to in Article 140.

Article 27

Date of filing

The date of filing of a Community trade mark application shall be the date on which documents containing the information specified in Article 26 (1) are filed with the Office by the applicant or, if the application has been filed with the central office of a Member State or with the Benelux Trade Mark Office, with that office, subject to payment of the application fee within a period of one month of filing the abovementioned documents.

Article 28

Classification

Goods and services in respect of which Community trade marks are applied for shall be classified in conformity with the system of classification specified in the Implementing Regulation.

SECTION 2

PRIORITY

Article 29

Right of priority

1. A person who has duly filed an application for a trade mark in or for any State party to the Paris Convention, or his successors in title, shall enjoy, for the purpose of filing a Community trade mark application for the same trade mark in respect of goods or services which are identical with or contained within those for which the application has been filed, a right of priority during a period of six months from the date of filing of the first application.
2. Every filing that is equivalent to a regular national filing under the national law of the State where it was made or under bilateral or multilateral agreements shall be recognized as giving rise to a right of priority.
3. By a regular national filing is meant any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application.
4. A subsequent application for a trade mark which was the subject of a previous first application in respect of the same goods or services, and which is filed in or in respect of the same State shall be considered as the first application for the purposes of determining priority, provided that, at the date of filing of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.
5. If the first filing has been made in a State which is not a party to the Paris Convention, paragraphs 1 to 4 shall apply only in so far as that State, according to published findings, grants, on the basis of a first filing made at the Office and subject to conditions equivalent to those laid down in this Regulation, a right of priority having equivalent effect.

Article 30

Claiming priority

An applicant desiring to take advantage of the priority of a previous application shall file a declaration of priority and a copy of the previous application. If the language of the latter is not one of the languages of the Office, the applicant shall file a translation of the previous application in one of those languages.

Article 31

Effect of priority right

The right of priority shall have the effect that the date of priority shall count as the date of filing of the Community trade mark application for the purposes of establishing which rights take precedence.

Article 32

Equivalence of Community filing with national filing

A Community trade mark application which has been accorded a date of filing shall, in the Member States, be equivalent to a regular national filing, where appropriate with the priority claimed for the Community trade mark application.

SECTION 3

EXHIBITION PRIORITY

Article 33

Exhibition priority

1. If an applicant for a Community trade mark has displayed goods or services under the mark applied for, at an official or officially recognized international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 and last revised on 30 November 1972, he may, if he files the application within a period of six months from the date of the first display of the goods or services under the mark applied for, claim a right of priority from that date within the meaning of Article 31.
2. An applicant who wishes to claim priority pursuant to paragraph 1 must file evidence of the display of goods or services under the mark applied for under the conditions laid down in the Implementing Regulation.
3. An exhibition priority granted in a Member State or in a third country does not extend the period of priority laid down in Article 29.

SECTION 4

CLAIMING THE SENIORITY OF A NATIONAL TRADE MARK

Article 34

Claiming the seniority of a national trade mark

1. The proprietor of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, who applies for an identical trade mark for registration as a Community trade

mark for goods or services which are identical with or contained within those for which the earlier trade mark has been registered, may claim for the Community trade mark the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.

2. Seniority shall have the sole effect under this Regulation that, where the proprietor of the Community trade mark surrenders the earlier trade mark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered.

3. The seniority claimed for the Community trade mark shall lapse if the earlier trade mark the seniority of which is claimed is declared to have been revoked or to be invalid or if it is surrendered prior to the registration of the Community trade mark.

Article 35

Claiming seniority after registration of the Community trade mark

1. The proprietor of a Community trade mark who is the proprietor of an earlier identical trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or of a trade mark registered under international arrangements having effect in a Member State, for identical goods or services, may claim the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.

2. Article 34 (2) and (3) shall apply.

TITLE IV REGISTRATION PROCEDURE

SECTION 1

EXAMINATION OF APPLICATIONS

Article 36

Examination of the conditions of filing

1. The Office shall examine whether:

- (a) the Community trade mark application satisfies the requirements for the accordance of a date of filing in accordance with Article 27;
- (b) the Community trade mark application complies with the conditions laid down in the Implementing Regulation;
- (c) where appropriate, the class fees have been paid within the prescribed period.

2. Where the Community trade mark application does not satisfy the requirements referred to in paragraph 1, the Office shall request the applicant to remedy the deficiencies or the default on payment within the prescribed period.

3. If the deficiencies or the default on payment established pursuant to paragraph 1 (a) are not remedied within this period, the application shall not be dealt with as a Community trade mark application. If the applicant complies with the Office's request, the Office shall accord as the date of filing of the application the date on which the deficiencies or the default on payment established are remedied.

4. If the deficiencies established pursuant to paragraph 1 (b) are not remedied within the prescribed period, the Office shall refuse the application.
5. If the default on payment established pursuant to paragraph 1 (c) is not remedied within the prescribed period, the application shall be deemed to be withdrawn unless it is clear which categories of goods or services the amount paid is intended to cover.
6. Failure to satisfy the requirements concerning the claim to priority shall result in loss of the right of priority for the application.
7. Failure to satisfy the requirements concerning the claiming of seniority of a national trade mark shall result in loss of that right for the application.

Article 37

Examination of the conditions relating to the entitlement of the proprietor

1. Where, pursuant to Article 5, the applicant may not be the proprietor of a Community trade mark, the application shall be refused.
2. The application may not be refused before the applicant has been given the opportunity to withdraw his application or submit his observations.

Article 38

Examination as to absolute grounds for refusal

1. Where, under Article 7, a trade mark is ineligible for registration in respect of some or all of the goods or services covered by the Community trade mark application, the application shall be refused as regards those goods or services.
2. Where the trade mark contains an element which is not distinctive, and where the inclusion of said element in the trade mark could give rise to doubts as to the scope of protection of the trade mark, the Office may request, as a condition for registration of said trade mark, that the applicant state that he disclaims any exclusive right to such element. Any disclaimer shall be published together with the application or the registration of the Community trade mark, as the case may be.
3. The application shall not be refused before the applicant has been allowed the opportunity of withdrawing or amending the application or of submitting his observations.

SECTION 2

SEARCH

Article 39

Search

1. Once the Office has accorded a date of filing to a Community trade mark application and has established that the applicant satisfies the conditions referred to in Article 5, it shall draw

up a Community search report citing those earlier Community trade marks or Community trade mark applications discovered which may be invoked under Article 8 against the registration of the Community trade mark applied for.

2. As soon as a Community trade mark application has been accorded a date of filing, the Office shall transmit a copy thereof to the central industrial property office of each Member State which has informed the Office of its decision to operate a search in its own register of trade marks in respect of Community trade mark applications.

3. Each of the central industrial property offices referred to in paragraph 2 shall communicate to the Office within three months as from the date on which it received the Community trade mark application a search report which shall either cite those earlier national trade marks or trade mark applications discovered which may be invoked under Article 8 against the registration of the Community trade mark applied for, or state that the search has revealed no such rights.

4. An amount shall be paid by the Office to each central industrial property office for each search report provided by that office in accordance with paragraph 3. The amount, which shall be the same for each office, shall be fixed by the Budget Committee by means of a decision adopted by a majority of three-quarters of the representatives of the Member States.

5. The Office shall transmit without delay to the applicant for the Community trade mark the Community search report and the national search reports received within the time limit laid down in paragraph 3.

6. Upon publication of the Community trade mark application, which may not take place before the expiry of a period of one month as from the date on which the Office transmits the search reports to the applicant, the Office shall inform the proprietors of any earlier Community trade marks or Community trade mark applications cited in the Community search report of the publication of the Community trade mark application.

7. The Commission shall, five years after the opening of the Office for the filing of applications, submit to the Council a report on the operation of the system of searching resulting from this Article, including the payments made to Member States under paragraph 4, and, if necessary, appropriate proposals for amending this Regulation with a view to adapting the system of searching on the basis of the experience gained and bearing in mind developments in searching techniques.

SECTION 3

PUBLICATION OF THE APPLICATION

Article 40

Publication of the application

1. If the conditions which the application for a Community trade mark must satisfy have been fulfilled and if the period referred to in Article 39 (6) has expired, the application shall be published to the extent that it has not been refused pursuant to Articles 37 and 38.

2. Where, after publication, the application is refused under Articles 37 and 38, the decision that it has been refused shall be published upon becoming final.

SECTION 4

OBSERVATIONS BY THIRD PARTIES AND OPPOSITION

Article 41

Observations by third parties

1. Following the publication of the Community trade mark application, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the Office written observations, explaining on which grounds under Article 7, in particular, the trade mark shall not be registered ex officio. They shall not be parties to the proceedings before the Office.
2. The observations referred to in paragraph 1 shall be communicated to the applicant who may comment on them.

Article 42

Opposition

1. Within a period of three months following the publication of a Community trade mark application, notice of opposition to registration of the trade mark may be given on the grounds that it may not be registered under Article 8:
 - (a) by the proprietors of earlier trade marks referred to in Article 8 (2) as well as licensees authorized by the proprietors of those trade marks, in respect of Article 8 (1) and (5);
 - (b) by the proprietors of trade marks referred to in Article 8 (3);
 - (c) by the proprietors of earlier marks or signs referred to in Article 8 (4) and by persons authorized under the relevant national law to exercise these rights.
2. Notice of opposition to registration of the trade mark may also be given, subject to the conditions laid down in paragraph 1, in the event of the publication of an amended application in accordance with the second sentence of Article 44 (2).
3. Opposition must be expressed in writing and must specify the grounds on which it is made. It shall not be treated as duly entered until the opposition fee has been paid. Within a period fixed by the Office, the opponent may submit in support of his case facts, evidence and arguments.

Article 43

Examination of opposition

1. In the examination of the opposition the Office shall invite the parties, as often as necessary, to file observations, within a period set them by the Office, on communications from the other parties or issued by itself.
2. If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper

reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8 (2) (a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

4. The Office may, if it thinks fit, invite the parties to make a friendly settlement.

5. If examination of the opposition reveals that the trade mark may not be registered in respect of some or all of the goods or services for which the Community trade mark application has been made, the application shall be refused in respect of those goods or services. Otherwise the opposition shall be rejected.

6. The decision refusing the application shall be published upon becoming final.

SECTION 5

WITHDRAWAL, RESTRICTION AND AMENDMENT OF THE APPLICATION

Article 44

Withdrawal, restriction and amendment of the application

1. The applicant may at any time withdraw his Community trade mark application or restrict the list of goods or services contained therein. Where the application has already been published, the withdrawal or restriction shall also be published.

2. In other respects, a Community trade mark application may be amended, upon request of the applicant, only by correcting the name and address of the applicant, errors of wording or of copying, or obvious mistakes, provided that such correction does not substantially change the trade mark or extend the list of goods or services. Where the amendments affect the representation of the trade mark or the list of goods or services and are made after publication of the application, the trade mark application shall be published as amended.

SECTION 6

REGISTRATION

Article 45

Registration

Where an application meets the requirements of this Regulation and where no notice of opposition has been given within the period referred to in Article 42 (1) or where opposition has been rejected by a definitive decision, the trade mark shall be registered as a Community trade mark, provided that the registration fee has been paid within the period prescribed. If the fee is not paid within this period the application shall be deemed to be withdrawn.

TITLE V DURATION, RENEWAL AND ALTERATION OF COMMUNITY TRADE MARKS

Article 46

Duration of registration

Community trade marks shall be registered for a period of ten years from the date of filing of the application. Registration may be renewed in accordance with Article 47 for further periods of ten years.

Article 47

Renewal

1. Registration of the Community trade mark shall be renewed at the request of the proprietor of the trade mark or any person expressly authorized by him, provided that the fees have been paid.
2. The Office shall inform the proprietor of the Community trade mark, and any person having a registered right in respect of the Community trade mark, of the expiry of the registration in good time before the said expiry. Failure to give such information shall not involve the responsibility of the Office.
3. The request for renewal shall be submitted within a period of six months ending on the last day of the month in which protection ends. The fees shall also be paid within this period. Failing this, the request may be submitted and the fees paid within a further period of six months following the day referred to in the first sentence, provided that an additional fee is paid within this further period.
4. Where the request is submitted or the fees paid in respect of only some of the goods or services for which the Community trade mark is registered, registration shall be renewed for those goods or services only.
5. Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be registered.

Article 48

Alteration

1. The Community trade mark shall not be altered in the register during the period of registration or on renewal thereof.
2. Nevertheless, where the Community trade mark includes the name and address of the proprietor, any alteration thereof not substantially affecting the identity of the trade mark as originally registered may be registered at the request of the proprietor.
3. The publication of the registration of the alteration shall contain a representation of the Community trade mark as altered. Third parties whose rights may be affected by the alteration may challenge the registration thereof within a period of three months following publication.

TITLE VI SURRENDER, REVOCATION AND INVALIDITY

SECTION 1

SURRENDER

Article 49

Surrender

1. A Community trade mark may be surrendered in respect of some or all of the goods or services for which it is registered.
2. The surrender shall be declared to the Office in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register.
3. Surrender shall be entered only with the agreement of the proprietor of a right entered in the Register. If a licence has been registered, surrender shall only be entered in the Register if the proprietor of the trade mark proves that he has informed the licensee of his intention to surrender; this entry shall be made on expiry of the period prescribed by the Implementing Regulation.

SECTION 2

GROUNDS FOR REVOCATION

Article 50

Grounds for revocation

1. The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings:
 - (a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor's rights in a Community trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;
 - (b) if, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered;
 - (c) if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services;
 - (d) if the proprietor of the trade mark no longer satisfies the conditions laid down by Article 5.
2. Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the Community trade mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.

SECTION 3

GROUNDS FOR INVALIDITY

Article 51

Absolute grounds for invalidity

1. A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings,

- (a) where the Community trade mark has been registered in breach of the provisions of Article 5 or of Article 7;
- (b) where the applicant was acting in bad faith when he filed the application for the trade mark.

2. Where the Community trade mark has been registered in breach of the provisions of Article 7 (1) (b), (c) or (d), it may nevertheless not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

3. Where the ground for invalidity exists in respect of only some of the goods or services for which the Community trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

Article 52

Relative grounds for invalidity

1. A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

- (a) where there is an earlier trade mark as referred to in Article 8 (2) and the conditions set out in paragraph 1 or paragraph 5 of that Article are fulfilled;
- (b) where there is a trade mark as referred to in Article 8 (3) and the conditions set out in that paragraph are fulfilled;
- (c) where there is an earlier right as referred to in Article 8 (4) and the conditions set out in that paragraph are fulfilled.

2. A Community trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to the national law governing the protection of any other earlier right in particular:

- (a) a right to a name;
- (b) a right of personal portrayal;
- (c) a copyright;
- (d) an industrial property right.

3. A Community trade mark may not be declared invalid where the proprietor of a right referred to in paragraphs 1 or 2 consents expressly to the registration of the Community trade mark before

submission of the application for a declaration of invalidity or the counterclaim.

4. Where the proprietor of one of the rights referred to in paragraphs 1 or 2 has previously applied for a declaration that a Community trade mark is invalid or made a counterclaim in infringement proceedings, he may not submit a new application for a declaration of invalidity or lodge a counterclaim on the basis of another of the said rights which he could have invoked in support of his first application or counterclaim.

5. Article 51 (3) shall apply.

Article 53

Limitation in consequence of acquiescence

1. Where the proprietor of a Community trade mark has acquiesced, for a period of five successive years, in the use of a later Community trade mark in the Community while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later Community trade mark was applied for in bad faith.

2. Where the proprietor of an earlier national trade mark as referred to in Article 8 (2) or of another earlier sign referred to in Article 8 (4) has acquiesced, for a period of five successive years, in the use of a later Community trade mark in the Member State in which the earlier trade mark or the other earlier sign is protected while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark or of the other earlier sign either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later Community trade mark was applied for in bad faith.

3. In the cases referred to in paragraphs 1 and 2, the proprietor of a later Community trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later Community trade mark.

SECTION 4

CONSEQUENCES OF REVOCATION AND INVALIDITY

Article 54

Consequences of revocation and invalidity

1. The Community trade mark shall be deemed not to have had, as from the date of the application for revocation or of the counterclaim, the effects specified in this Regulation, to the extent that the rights of the proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.

2. The Community trade mark shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that the trade mark has been declared invalid.

3. Subject to the national provisions relating either to claims for compensation for damage caused by negligence or lack of good faith on the part of the proprietor of the trade mark, or to unjust

enrichment, the retroactive effect of revocation or invalidity of the trade mark shall not affect:

- (a) any decision on infringement which has acquired the authority of a final decision and been enforced prior to the revocation or invalidity decision;
- (b) any contract concluded prior to the revocation or invalidity decision, in so far as it has been performed before that decision; however, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract, may be claimed on grounds of equity.

SECTION 5

PROCEEDINGS IN THE OFFICE IN RELATION TO REVOCATION OR INVALIDITY

Article 55

Application for revocation or for a declaration of invalidity

1. An application for revocation of the rights of the proprietor of a Community trade mark or for a declaration that the trade mark is invalid may be submitted to the Office:

- (a) where Articles 50 and 51 apply, by any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, which under the terms of the law governing it has the capacity in its own name to sue and be sued;
- (b) where Article 52 (1) applies, by the persons referred to in Article 42 (1);
- (c) where Article 52 (2) applies, by the owners of the earlier rights referred to in that provision or by the persons who are entitled under the law of the Member State concerned to exercise the rights in question.

2. The application shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the fee has been paid.

3. An application for revocation or for a declaration of invalidity shall be inadmissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a court in a Member State and has acquired the authority of a final decision.

Article 56

Examination of the application

1. In the examination of the application for revocation of rights or for a declaration of invalidity, the Office shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Office, on communications from the other parties or issued by itself.

2. If the proprietor of the Community trade mark so requests, the proprietor of an earlier Community trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided the earlier Community trade mark has at

that date been registered for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. If, at the date on which the Community trade mark application was published, the earlier Community trade mark had been registered for not less than five years, the proprietor of the earlier Community trade mark shall furnish proof that, in addition, the conditions contained in Article 43 (2) were satisfied at that date. In the absence of proof to this effect the application for a declaration of invalidity shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8 (2) (a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

4. The Office may, if it thinks fit, invite the parties to make a friendly settlement.

5. If the examination of the application for revocation of rights or for a declaration of invalidity reveals that the trade mark should not have been registered in respect of some or all of the goods or services for which it is registered, the rights of the proprietor of the Community trade mark shall be revoked or it shall be declared invalid in respect of those goods or services. Otherwise the application for revocation of rights or for a declaration of invalidity shall be rejected.

6. The decision revoking the rights of the proprietor of the Community trade mark or declaring it invalid shall be entered in the Register upon becoming final.

TITLE VII APPEALS

Article 57

Decisions subject to appeal

1. An appeal shall lie from decisions of the examiners, Opposition Divisions, Administration of Trade Marks and Legal Divisions and Cancellation Divisions. It shall have suspensive effect.

2. A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

Article 58

Persons entitled to appeal and to be parties to appeal proceedings

Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings as of right.

Article 59

Time limit and form of appeal

Notice of appeal must be filed in writing at the Office within two months after the date of notification of the decision appealed from. The notice shall be deemed to have been filed only when the fee

for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

Article 60

Interlocutory revision

1. If the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision. This shall not apply where the appellant is opposed by another party to the proceedings.
2. If the decision is not rectified within one month after receipt of the statement of grounds, the appeal shall be remitted to the Board of Appeal without delay, and without comment as to its merit.

Article 61

Examination of appeals

1. If the appeal is admissible, the Board of Appeal shall examine whether the appeal is allowable.
2. In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself.

Article 62

Decisions in respect of appeals

1. Following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.
2. If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same.
3. The decisions of the Boards of Appeal shall take effect only as from the date of expiration of the period referred to in Article 63 (5) or, if an action has been brought before the Court of Justice within that period, as from the date of rejection of such action.

Article 63

Actions before the Court of Justice

1. Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.

2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.
3. The Court of Justice has jurisdiction to annul or to alter the contested decision.
4. The action shall be open to any party to proceedings before the Board of Appeal adversely affected by its decision.
5. The action shall be brought before the Court of Justice within two months of the date of notification of the decision of the Board of Appeal.
6. The Office shall be required to take the necessary measures to comply with the judgment of the Court of Justice.

TITLE VIII COMMUNITY COLLECTIVE MARKS

Article 64

Community collective marks

1. A Community collective mark shall be a Community trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings. Associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued, as well as legal persons governed by public law, may apply for Community collective marks.
2. In derogation from Article 7 (1) (c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute Community collective marks within the meaning of paragraph 1. A collective mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided he uses them in accordance with honest practices in industrial or commercial matters; in particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.
3. The provisions of this Regulation shall apply to Community collective marks, unless Articles 65 to 72 provide otherwise.

Article 65

Regulations governing use of the mark

1. An applicant for a Community collective mark must submit regulations governing its use within the period prescribed.
2. The regulations governing use shall specify the persons authorized to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark including sanctions. The regulations governing use of a mark referred to in Article 64 (2) must authorize any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark.

Article 66

Refusal of the application

1. In addition to the grounds for refusal of a Community trade mark application provided for in Articles 36 and 38, an application for a Community collective mark shall be refused where the provisions of Article 64 or 65 are not satisfied, or where the regulations governing use are contrary to public policy or to accepted principles of morality.
2. An application for a Community collective mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.
3. An application shall not be refused if the applicant, as a result of amendment of the regulations governing use, meets the requirements of paragraphs 1 and 2.

Article 67

Observations by third parties

Apart from the cases mentioned in Article 41, any person, group or body referred to in that Article may submit to the Office written observations based on the particular grounds on which the application for a Community collective mark should be refused under the terms of Article 66.

Article 68

Use of marks

Use of a Community collective mark by any person who has authority to use it shall satisfy the requirements of this Regulation, provided that the other conditions which this Regulation imposes with regard to the use of Community trade marks are fulfilled.

Article 69

Amendment of the regulations governing use of the mark

1. The proprietor of a Community collective mark must submit to the Office any amended regulations governing use.
2. The amendment shall not be mentioned in the Register if the amended regulations do not satisfy the requirements of Article 65 or involve one of the grounds for refusal referred to in Article 66.
3. Article 67 shall apply to amended regulations governing use.
4. For the purposes of applying this Regulation, amendments to the regulations governing use shall take effect only from the date of entry of the mention of the amendment in the Register.

Article 70

Persons who are entitled to bring an action for infringement

1. The provisions of Article 22 (3) and (4) concerning the rights of licensees shall apply to every person who has authority to use a Community collective mark.
2. The proprietor of a Community collective mark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where they have sustained damage in consequence of unauthorized use of the mark.

Article 71

Grounds for revocation

Apart from the grounds for revocation provided for in Article 50, the rights of the proprietor of a Community collective mark shall be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings, if:

- (a) the proprietor does not take reasonable steps to prevent the mark being used in a manner incompatible with the conditions of use, where these exist, laid down in the regulations governing use, amendments to which have, where appropriate, been mentioned in the Register;
- (b) the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in Article 66 (2);
- (c) an amendment to the regulations governing use of the mark has been mentioned in the Register in breach of the provisions of Article 69 (2), unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of those provisions.

Article 72

Grounds for invalidity

Apart from the grounds for invalidity provided for in Articles 51 and 52, a Community collective mark which is registered in breach of the provisions of Article 66 shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings, unless the proprietor of the mark, by amending the regulations governing use, complies with the requirements of those provisions.

TITLE IX PROCEDURE

SECTION 1

GENERAL PROVISIONS

Article 73

Statement of reasons on which decisions are based

Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

Article 74

Examination of the facts by the Office of its own motion

1. In proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.
2. The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.

Article 75

Oral proceedings

1. If the Office considers that oral proceedings would be expedient they shall be held either at the instance of the Office or at the request of any party to the proceedings.
2. Oral proceedings before the examiners, the Opposition Division and the Administration of Trade Marks and Legal Division shall not be public.
3. Oral proceedings, including delivery of the decision, shall be public before the Cancellation Division and the Boards of Appeal, in so far as the department before which the proceedings are taking place does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings.

Article 76

Taking of evidence

1. In any proceedings before the Office, the means of giving or obtaining evidence shall include the following:
 - (a) hearing the parties;
 - (b) requests for information;
 - (c) the production of documents and items of evidence;
 - (d) hearing witnesses;
 - (e) opinions by experts;
 - (f) statements in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up.
2. The relevant department may commission one of its members to examine the evidence adduced.
3. If the Office considers it necessary for a party, witness or expert to give evidence orally, it shall issue a summons to the person concerned to appear before it.

4. The parties shall be informed of the hearing of a witness or expert before the Office. They shall have the right to be present and to put questions to the witness or expert.

Article 77

Notification

The Office shall, as a matter of course, notify those concerned of decisions and summonses and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Regulation or of the Implementing Regulation, or of which notification has been ordered by the President of the Office.

Article 78

Restitutio in integrum

1. The applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the Office shall, upon application, have his rights re-established if the non-observance in question has the direct consequence, by virtue of the provisions of this Regulation, of causing the loss of any right or means of redress.
2. The application must be filed in writing within two months from the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-submission of the request for renewal of registration or of non-payment of a renewal fee, the further period of six months provided in Article 47 (3), third sentence, shall be deducted from the period of one year.
3. The application must state the grounds on which it is based and must set out the facts on which it relies. It shall not be deemed to be filed until the fee for re-establishment of rights has been paid.
4. The department competent to decide on the omitted act shall decide upon the application.
5. The provisions of this Article shall not be applicable to the time limits referred to in paragraph 2 of this Article, Articles 29 (1) and 42 (1).
6. Where the applicant for or proprietor of a Community trade mark has his rights re-established, he may not invoke his rights vis-à-vis a third party who, in good faith, has put goods on the market or supplied services under a sign which is identical with or similar to the Community trade mark in the course of the period between the loss of rights in the application or in the Community trade mark and publication of the mention of re-establishment of those rights.
7. A third party who may avail himself of the provisions of paragraph 6 may bring third party proceedings against the decision re-establishing the rights of the applicant for or proprietor of a Community trade mark within a period of two months as from the date of publication of the mention of re-establishment of those rights.
8. Nothing in this Article shall limit the right of a Member State to grant restitutio in integrum in respect of time limits provided for in this Regulation and to be observed vis-à-vis the authorities

of such State.

Article 79

Reference to general principles

In the absence of procedural provisions in this Regulation, the Implementing Regulation, the fees regulations or the rules of procedure of the Boards of Appeal, the Office shall take into account the principles of procedural law generally recognized in the Member States.

Article 80

Termination of financial obligations

1. Rights of the Office to the payment of a fee shall be extinguished after four years from the end of the calendar year in which the fee fell due.
2. Rights against the Office for the refunding of fees or sums of money paid in excess of a fee shall be extinguished after four years from the end of the calendar year in which the right arose.
3. The period laid down in paragraphs 1 and 2 shall be interrupted in the case covered by paragraph 1 by a request for payment of the fee and in the case covered by paragraph 2 by a reasoned claim in writing. On interruption it shall begin again immediately and shall end at the latest six years after the end of the year in which it originally began, unless, in the meantime, judicial proceedings to enforce the right have begun; in this case the period shall end at the earliest one year after the judgement has acquired the authority of a final decision.

SECTION 2

COSTS

Article 81

Costs

1. The losing party in opposition proceedings, proceedings for revocation, proceedings for a declaration of invalidity or appeal proceedings shall bear the fees incurred by the other party as well as all costs, without prejudice to Article 115 (6), incurred by him essential to the proceedings, including travel and subsistence and the remuneration of an agent, adviser or advocate, within the limits of the scales set for each category of costs under the conditions laid down in the Implementing Regulation.
2. However, where each party succeeds on some and fails on other heads, or if reasons of equity so dictate, the Opposition Division, Cancellation Division or Board of Appeal shall decide a different apportionment of costs.
3. The party who terminates the proceedings by withdrawing the Community trade mark application, the opposition, the application for revocation of rights, the application for a declaration of invalidity or the appeal, or by not renewing registration of the Community trade mark or by surrendering the Community trade mark, shall bear the fees and the costs incurred by the other party as stipulated

in paragraphs 1 and 2.

4. Where a case does not proceed to judgment the costs shall be at the discretion of the Opposition Division, Cancellation Division or Board of Appeal.

5. Where the parties conclude before the Opposition Division, Cancellation Division or Board of Appeal a settlement of costs differing from that provided for in the preceding paragraphs, the department concerned shall take note of that agreement.

6. On request the registry of the Opposition Division or Cancellation Division or Board of Appeal shall fix the amount of the costs to be paid pursuant to the preceding paragraphs. The amount so determined may be reviewed by a decision of the Opposition Division or Cancellation Division or Board of Appeal on a request filed within the prescribed period.

Article 82

Enforcement of decisions fixing the amount of costs

1. Any final decision of the Office fixing the amount of costs shall be enforceable.

2. Enforcement shall be governed by the rules of civil procedure in force in the State in the territory of which it is carried out. The order for its enforcement shall be appended to the decision, without other formality than verification of the authenticity of the decision, by the national authority which the Government of each Member State shall designate for this purpose and shall make known to the Office and to the Court of Justice.

3. When these formalities have been completed on application by the party concerned, the latter may proceed to enforcement in accordance with the national law, by bringing the matter directly before the competent authority.

4. Enforcement may be suspended only by a decision of the Court of Justice. However, the courts of the country concerned shall have jurisdiction over complaints that enforcement is being carried out in an irregular manner.

SECTION 3

INFORMATION OF THE PUBLIC AND OF THE OFFICIAL AUTHORITIES OF THE MEMBER STATES

Article 83

Register of Community trade marks

The Office shall keep a register to be known as the Register of Community trade marks, which shall contain those particulars the registration or inclusion of which is provided for by this Regulation or by the Implementing Regulation. The Register shall be open to public inspection.

Article 84

Inspection of files

1. The files relating to Community trade mark applications which have not yet been published shall not be made available for inspection without the consent of the applicant.
2. Any person who can prove that the applicant for a Community trade mark has stated that after the trade mark has been registered he will invoke the rights under it against him may obtain inspection of the files prior to the publication of that application and without the consent of the applicant.
3. Subsequent to the publication of the Community trade mark application, the files relating to such application and the resulting trade mark may be inspected on request.
4. However, where the files are inspected pursuant to paragraphs 2 or 3, certain documents in the file may be withheld from inspection in accordance with the provisions of the Implementing Regulation.

Article 85

Periodical publications

The Office shall periodically publish:

- (a) a Community Trade Marks Bulletin containing entries made in the Register of Community trade marks as well as other particulars the publication of which is prescribed by this Regulation or by the Implementing Regulation;
- (b) an Official Journal containing notices and information of a general character issued by the President of the Office, as well as any other information relevant to this Regulation or its implementation.

Article 86

Administrative cooperation

Unless otherwise provided in this Regulation or in national laws, the Office and the courts or authorities of the Member States shall on request give assistance to each other by communicating information or opening files for inspection. Where the 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 84.

Article 87

Exchange of publications

1. The Office and the central industrial property offices of the Member States shall despatch to each other on request and for their own use one or more copies of their respective publications free of charge.
2. The Office may conclude agreements relating to the exchange or supply of publications.

SECTION 4

REPRESENTATION

Article 88

General principles of representation

1. Subject to the provisions of paragraph 2, no person shall be compelled to be represented before the Office.
2. Without prejudice to paragraph 3, second sentence, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must be represented before the Office in accordance with Article 89 (1) in all proceedings established by this Regulation, other than in filing an application for a Community trade mark; the Implementing Regulation may permit other exceptions.
3. Natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the Office by an employee, who must file with it a signed authorization for insertion on the files, the details of which are set out in the Implementing Regulation. An employee of a legal person to which this paragraph applies may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the Community.

Article 89

Professional representatives

1. Representation of natural or legal persons before the Office may only be undertaken by;
 - (a) any legal practitioner qualified in one of the Member States and having his place of business within the Community, to the extent that he is entitled, within the said State, to act as a representative in trade mark matters; or
 - (b) professional representatives whose names appear on the list maintained for this purpose by the Office.Representatives acting before the Office must file with it a signed authorization for insertion on the files, the details of which are set out in the Implementing Regulation.
2. Any natural person who fulfils the following conditions may be entered on the list of professional representatives:
 - (a) he must be a national of one of the Member States;
 - (b) he must have his place of business or employment in the Community;
 - (c) he must be entitled to represent natural or legal persons in trade mark matters before the central industrial property office of the Member State in which he has his place of business or employment. Where, in that State, the entitlement is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list who act in trade mark matters before the central industrial property office of the said State must have habitually so acted for at least five years. However, persons whose professional qualification to represent natural or legal persons in trade mark matters before the central industrial property office of one of the Member

States is officially recognized in accordance with the regulations laid down by such State shall not be subject to the condition of having exercised the profession.

3. Entry shall be effected upon request, accompanied by a certificate furnished by the central industrial property office of the Member State concerned, which must indicate that the conditions laid down in paragraph 2 are fulfilled.

4. The President of the Office may grant exemption from:

- (a) the requirement of paragraph 2 (c), second sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way;
- (b) the requirement of paragraph 2 (a) in special circumstances.

5. The conditions under which a person may be removed from the list of professional representatives shall be laid down in the Implementing Regulation.

TITLE X JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO COMMUNITY TRADE MARKS

SECTION 1

APPLICATION OF THE CONVENTION ON JURISDICTION AND ENFORCEMENT

Article 90

Application of the Convention on Jurisdiction and Enforcement

1. Unless otherwise specified in this Regulation, the Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, signed in Brussels on 27 September 1968, as amended by the Conventions on the Accession to that Convention of the States acceding to the European Communities, the whole of which Convention and of which Conventions of Accession are hereinafter referred to as the 'Convention on Jurisdiction and Enforcement', shall apply to proceedings relating to Community trade marks and applications for Community trade marks, as well as to proceedings relating to simultaneous and successive actions on the basis of Community trade marks and national trade marks.

2. In the case of proceedings in respect of the actions and claims referred to in Article 92:

- (a) Articles 2, 4, 5 (1), (3), (4) and (5) and Article 24 of the Convention on Jurisdiction and Enforcement shall not apply;
- (b) Articles 17 and 18 of that Convention shall apply subject to the limitations in Article 93 (4) of this Regulation;
- (c) the provisions of Title II of that Convention which are applicable to persons domiciled in a Member State shall also be applicable to persons who do not have a domicile in any Member State but have an establishment therein.

SECTION 2

DISPUTES CONCERNING THE INFRINGEMENT AND VALIDITY OF COMMUNITY TRADE MARKS

Article 91

Community trade mark courts

1. The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance, hereinafter referred to as 'Community trade mark courts', which shall perform the functions assigned to them by this Regulation.
2. Each Member State shall communicate to the Commission within three years of the entry into force of this Regulation a list of Community trade mark courts indicating their names and their territorial jurisdiction.
3. Any change made after communication of the list referred to in paragraph 2 in the number, names or territorial jurisdiction of the courts shall be notified without delay by the Member State concerned to the Commission.
4. The information referred to in paragraphs 2 and 3 shall be notified by the Commission to the Member States and published in the Official Journal of the European Communities.
5. As long as a Member State has not communicated the list as stipulated in paragraph 2, jurisdiction for any proceedings resulting from an action or application covered by Article 92, and for which the courts of that State have jurisdiction under Article 93, shall lie with that court of the State in question which would have jurisdiction *ratione loci* and *ratione materiae* in the case of proceedings relating to a national trade mark registered in that State.

Article 92

Jurisdiction over infringement and validity

The Community trade mark courts shall have exclusive jurisdiction:

- (a) for all infringement actions and - if they are permitted under national law - actions in respect of threatened infringement relating to Community trade marks;
- (b) for actions for declaration of non-infringement, if they are permitted under national law;
- (c) for all actions brought as a result of acts referred to in Article 9 (3), second sentence;
- (d) for counterclaims for revocation or for a declaration of invalidity of the Community trade mark pursuant to Article 96.

Article 93

International jurisdiction

1. Subject to the provisions of this Regulation as well as to any provisions of the Convention on Jurisdiction and Enforcement applicable by virtue of Article 90, proceedings in respect of the actions and claims referred to in Article 92 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

2. If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

3. If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat.

4. Notwithstanding the provisions of paragraphs 1, 2 and 3:

- (a) Article 17 of the Convention on Jurisdiction and Enforcement shall apply if the parties agree that a different Community trade mark court shall have jurisdiction;
- (b) Article 18 of that Convention shall apply if the defendant enters an appearance before a different Community trade mark court.

5. Proceedings in respect of the actions and claims referred to in Article 92, with the exception of actions for a declaration of non-infringement of a Community trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened, or in which an act within the meaning of Article 9 (3), second sentence, has been committed.

Article 94

Extent of jurisdiction

1. A Community trade mark court whose jurisdiction is based on Article 93 (1) to (4) shall have jurisdiction in respect of:

- acts of infringement committed or threatened within the territory of any of the Member States,
- acts within the meaning of Article 9 (3), second sentence, committed within the territory of any of the Member States.

2. A Community trade mark court whose jurisdiction is based on Article 93 (5) shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.

Article 95

Presumption of validity - Defence as to the merits

1. The Community trade mark courts shall treat the Community trade mark as valid unless its validity is put in issue by the defendant with a counterclaim for revocation or for a declaration of invalidity.

2. The validity of a Community trade mark may not be put in issue in an action for a declaration of non-infringement.

3. In the actions referred to in Article 92 (a) and (c) a plea relating to revocation or invalidity of the Community trade mark submitted otherwise than by way of a counterclaim shall be admissible in so far as the defendant claims that the rights of the proprietor of the Community trade mark could be revoked for lack of use or that Community trade mark could be declared invalid on account of an earlier right of the defendant.

Article 96

Counterclaims

1. A counterclaim for revocation or for a declaration of invalidity may only be based on the grounds for revocation or invalidity mentioned in this Regulation.
2. A Community trade mark court shall reject a counterclaim for revocation or for a declaration of invalidity if a decision taken by the Office relating to the same subject matter and cause of action and involving the same parties has already become final.
3. If the counterclaim is brought in a legal action to which the proprietor of the trade mark is not already a party, he shall be informed thereof and may be joined as a party to the action in accordance with the conditions set out in national law.
4. The Community trade mark court with which a counterclaim for revocation or for a declaration of invalidity of the Community trade mark has been filed shall inform the Office of the date on which the counterclaim was filed. The latter shall record this fact in the Register of Community trade marks.
5. Article 56 (3), (4), (5) and (6) shall apply.
6. Where a Community trade mark court has given a judgment which has become final on a counterclaim for revocation or for invalidity of a Community trade mark, a copy of the judgment shall be sent to the Office. Any party may request information about such transmission. The Office shall mention the judgment in the Register of Community trade marks in accordance with the provisions of the Implementing Regulation.
7. The Community trade mark court hearing a counterclaim for revocation or for a declaration of invalidity may stay the proceedings on application by the proprietor of the Community trade mark and after hearing the other parties and may request the defendant to submit an application for revocation or for a declaration of invalidity to the Office within a time limit which it shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Article 100 (3) shall apply.

Article 97

Applicable law

1. The Community trade mark courts shall apply the provisions of this Regulation.
2. On all matters not covered by this Regulation a Community trade mark court shall apply its national law, including its private international law.
3. Unless otherwise provided in this Regulation, a Community trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State where it has its seat.

Article 98

Sanctions

1. Where a Community trade mark court finds that the defendant has infringed or threatened to infringe a Community trade mark, it shall, unless there are special reasons for not doing so, issue an order prohibiting the defendant from proceeding with the acts which infringed or would infringe the Community trade mark. It shall also take such measures in accordance with its national law as are aimed at ensuring that this prohibition is complied with.

2. In all other respects the Community trade mark court shall apply the law of the Member State to which the acts of infringement or threatened infringement were committed, including the private international law.

Article 99

Provisional and protective measures

1. Application may be made to the courts of a Member State, including Community trade mark courts, for such provisional, including protective, measures in respect of a Community trade mark or Community trade mark application as may be available under the law of that State in respect of a national trade mark, even if, under this Regulation, a Community trade mark court of another Member State has jurisdiction as to the substance of the matter.

2. A Community trade mark court whose jurisdiction is based on Article 93 (1), (2), (3) or (4) shall have jurisdiction to grant provisional and protective measures which, subject to any necessary procedure for recognition and enforcement pursuant to Title III of the Convention on Jurisdiction and Enforcement, are applicable in the territory of any Member State. No other court shall have such jurisdiction.

Article 100

Specific rules on related actions

1. A Community trade mark court hearing an action referred to in Article 92, other than an action for a declaration of non-infringement shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trade mark is already in issue before another Community trade mark court on account of a counterclaim or where an application for revocation or for a declaration of invalidity has already been filed at the Office.

2. The Office, when hearing an application for revocation or for a declaration of invalidity shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trade mark is already in issue on account of a counterclaim before a Community trade mark court. However, if one of the parties to the proceedings before the Community trade mark court so requests, the court may, after hearing the other parties to these proceedings, stay the proceedings. The Office shall in this instance continue the proceedings pending before it.

3. Where the Community trade mark court stays the proceedings it may order provisional and protective

measures for the duration of the stay.

Article 101

Jurisdiction of Community trade mark courts of second instance - Further appeal

1. An appeal to the Community trade mark courts of second instance shall lie from judgments of the Community trade mark courts of first instance in respect of proceedings arising from the actions and claims referred to in Article 92.
2. The conditions under which an appeal may be lodged with a Community trade mark court of second instance shall be determined by the national law of the Member State in which that court is located.
3. The national rules concerning further appeal shall be applicable in respect of judgments of Community trade mark courts of second instance.

SECTION 3

OTHER DISPUTES CONCERNING COMMUNITY TRADE MARKS

Article 102

Supplementary provisions on the jurisdiction of national courts other than Community trade mark courts

1. Within the Member State whose courts have jurisdiction under Article 90 (1) those courts shall have jurisdiction for actions other than those referred to in Article 92, which would have jurisdiction *ratione loci* and *ratione materiae* in the case of actions relating to a national trade mark registered in that State.
2. Actions relating to a Community trade mark, other than those referred to in Article 92, for which no court has jurisdiction under Article 90 (1) and paragraph 1 of this Article may be heard before the courts of the Member State in which the Office has its seat.

Article 103

Obligation of the national court

A national court which is dealing with an action relating to a Community trade mark, other than the action referred to in Article 92, shall treat the trade mark as valid.

SECTION 4

TRANSITIONAL PROVISION

Article 104

Transitional provision relating to the application of the Convention on Jurisdiction and Enforcement

The provisions of the Convention on Jurisdiction and Enforcement which are rendered applicable by the preceding Articles shall have effect in respect of any Member State solely in the text of the Convention which is in force in respect of that State at any given time.

TITLE XI EFFECTS ON THE LAWS OF THE MEMBER STATES

SECTION 1

CIVIL ACTIONS ON THE BASIS OF MORE THAN ONE TRADE MARK

Article 105

Simultaneous and successive civil actions on the basis of Community trade marks and national trade marks

1. Where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seized on the basis of a Community trade mark and the other seized on the basis of a national trade mark:

- (a) the court other than the court first seized shall of its own motion decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services. The court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested;
- (b) the court other than the court first seized may stay its proceedings where the trade marks concerned are identical and valid for similar goods or services and where the trade marks concerned are similar and valid for identical or similar goods or services.

2. The court hearing an action for infringement on the basis of a Community trade mark shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical national trade mark valid for identical goods or services.

3. The court hearing an action for infringement on the basis of a national trade mark shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical Community trade mark valid for identical goods or services.

4. Paragraphs 1, 2 and 3 shall not apply in respect of provisional, including protective, measures.

SECTION 2

APPLICATION OF NATIONAL LAWS FOR THE PURPOSE OF PROHIBITING THE USE OF COMMUNITY TRADE MARKS

Article 106

Prohibition of use of Community trade marks

1. This Regulation shall, unless otherwise provided for, not affect the right existing under the laws of the Member States to invoke claims for infringement of earlier rights within the meaning of Article 8 or Article 52 (2) in relation to the use of a later Community trade mark. Claims for infringement of earlier rights within the meaning of Article 8 (2) and (4) may, however, no longer be invoked if the proprietor of the earlier right may no longer apply for a declaration that

the Community trade mark is invalid in accordance with Article 53 (2).

2. This Regulation shall, unless otherwise provided for, not affect the right to bring proceedings under the civil, administrative or criminal law of a Member State or under provisions of Community law for the purpose of prohibiting the use of a Community trade mark to the extent that the use of a national trade mark may be prohibited under the law of that Member State or under Community law.

Article 107

Prior rights applicable to particular localities

1. The proprietor of an earlier right which only applies to a particular locality may oppose the use of the Community trade mark in the territory where his right is protected in so far as the law of the Member State concerned so permits.

2. Paragraph 1 shall cease to apply if the proprietor of the earlier right has acquiesced in the use of the Community trade mark in the territory where his right is protected for a period of five successive years, being aware of such use, unless the Community trade mark was applied for in bad faith.

3. The proprietor of the Community trade mark shall not be entitled to oppose use of the right referred to in paragraph 1 even though that right may no longer be invoked against the Community trade mark.

SECTION 3

CONVERSION INTO A NATIONAL TRADE MARK APPLICATION

Article 108

Request for the application of national procedure

1. The applicant for or proprietor of a Community trade mark may request the conversion of his Community trade mark application or Community trade mark into a national trade mark application

- (a) to the extent that the Community trade mark application is refused, withdrawn, or deemed to be withdrawn;
- (b) to the extent that the Community trade mark ceases to have effect.

2. Conversion shall not take place:

- (a) where the rights of the proprietor of the Community trade mark have been revoked on the grounds of non-use, unless in the Member State for which conversion is requested the Community trade mark has been put to use which would be considered to be genuine use under the laws of that Member State;
- (b) for the purpose of protection in a Member State in which, in accordance with the decision of the Office or of the national court, grounds for refusal of registration or grounds for revocation or invalidity apply to the Community trade mark application or Community trade mark.

3. The national trade mark application resulting from the conversion of a Community trade mark application or a Community trade mark shall enjoy in respect of the Member State concerned the

date of filing or the date of priority of that application or trade mark and, where appropriate, the seniority of a trade mark of that State claimed under Article 34 or 35.

4. Where:

- the Community trade mark application is deemed to be withdrawn or is refused by a decision of the Office which has become final,

- the Community trade mark ceases to have effect as a result of a decision of the Office which has become final or as a result of registration of surrender of the Community trade mark,

the Office shall notify to the applicant or proprietor a communication fixing a period of three months from the date of that communication in which a request for conversion may be filed.

5. Where the Community trade mark application is withdrawn or the Community trade mark ceases to have effect as a result of failure to renew the registration, the request for conversion shall be filed within three months after the date on which the Community trade mark application is withdrawn or on which the registration of the Community trade mark expires.

6. Where the Community trade mark ceases to have effect as a result of a decision of a national court, the request for conversion shall be filed within three months after the date on which that decision acquired the authority of a final decision.

7. The effect referred to in Article 32 shall lapse if the request is not filed in due time.

Article 109

Submission, publication and transmission of the request for conversion

1. A request for conversion shall be filed with the Office and shall specify the Member States in which application of the procedure for registration of a national trade mark is desired. The request shall not be deemed to be filed until the conversion fee has been paid.

2. If the Community trade mark application has been published, receipt of any such request shall be recorded in the Register of Community trade marks and the request for conversion shall be published.

3. The Office shall check whether conversion may be requested in accordance with Article 108 (1), whether the request has been filed within the period laid down in Article 108 (4), (5) or (6), as the case may be, and whether the conversion fee has been paid. If these conditions are fulfilled, the Office shall transmit the request to the central industrial property offices of the States specified therein. At the request of the central industrial property office of a State concerned, the Office shall give it any information enabling that office to decide as to the admissibility of the request.

Article 110

Formal requirements for conversion

1. Any central industrial property office to which the request is transmitted shall decide as to its admissibility,

2. A Community trade mark application or a Community trade mark transmitted in accordance with Article 109 shall not be subjected to formal requirements of national law which are different from

or additional to those provided for in this Regulation or in the Implementing Regulation.

3. Any central industrial property office to which the request is transmitted may require that the applicant shall, within not less than two months:

- (a) pay the national application fee;
- (b) file a translation in one of the official languages of the State in question of the request and of the documents accompanying it;
- (c) indicate an address for service in the State in question;
- (d) supply a representation of the trade mark in the number of copies specified by the State in question.

TITLE XII THE OFFICE

SECTION 1

GENERAL PROVISIONS

Article 111

Legal status

1. The Office shall be a body of the Community. It shall have legal personality.
2. In each of the Member States the Office shall enjoy the most extensive legal capacity accorded to legal persons under their laws; it may, in particular, acquire or dispose of movable and immovable property and may be a party to legal proceedings.
3. The Office shall be represented by its President.

Article 112

Staff

1. The Staff Regulations of officials of the European Communities, the Conditions of Employment of other servants of the European Communities, and the rules adopted by agreement between the Institutions of the European Communities for giving effect to those Staff Regulations and Conditions of Employment shall apply to the staff of the Office, without prejudice to the application of Article 131 to the members of the Boards of Appeal.
2. Without prejudice to Article 120, the powers conferred on each Institution by the Staff Regulations and by the Conditions of Employment of other servants shall be exercised by the Office in respect of its staff.

Article 113

Privileges and immunities

The Protocol on the Privileges and Immunities of the European Communities shall apply to the Office.

Article 114

Liability

1. The contractual liability of the Office shall be governed by the law applicable to the contract in question.
2. The Court of Justice shall be competent to give judgment pursuant to any arbitration clause contained in a contract concluded by the Office.
3. In the case of non-contractual liability, the Office shall, in accordance with the general principles common to the laws of the Member States, make good any damage caused by its departments or by its servants in the performance of their duties.
4. The Court of Justice shall have jurisdiction in disputes relating to compensation for the damage referred to in paragraph 3.
5. The personal liability of its servants towards the Office shall be governed by the provisions laid down in their Staff Regulations or in the Conditions of Employment applicable to them.

Article 115

Languages

1. The application for a Community trade mark shall be filed in one of the official languages of the European Community.
2. The languages of the Office shall be English, French, German, Italian and Spanish.
3. The applicant must indicate a second language which shall be a language of the Office the use of which he accepts as a possible language of proceedings for opposition, revocation or invalidity proceedings.

If the application was filed in a language which is not one of the languages of the Office, the Office shall arrange to have the application, as described in Article 26 (1), translated into the language indicated by the applicant.

4. Where the applicant for a Community trade mark is the sole party to proceedings before the Office, the language of proceedings shall be the language used for filing the application for a Community trade mark. If the application was made in a language other than the languages of the Office, the Office may send written communications to the applicant in the second language indicated by the applicant in his application.
5. The notice of opposition and an application for revocation or invalidity shall be filed in one of the languages of the Office.
6. If the language chosen, in accordance with paragraph 5, for the notice of opposition or the application for revocation or invalidity is the language of the application for a trade mark or the second language indicated when the application was filed, that language shall be the language of the proceedings.

If the language chosen, in accordance with paragraph 5, for the notice of opposition or the application for revocation or invalidity is neither the language of the application for a trade mark nor the

second language indicated when the application was filed, the opposing party or the party seeking revocation or invalidity shall be required to produce, at his own expense, a translation of his application either into the language of the application for a trade mark, provided that it is a language of the Office, or into the second language indicated when the application was filed. The translation shall be produced within the period prescribed in the implementing regulation. The language into which the application has been translated shall then become the language of the proceedings.

7. Parties to opposition, revocation, invalidity or appeal proceedings may agree that a different official language of the European Community is to be the language of the proceedings.

Article 116

Publication; entries in the Register

1. An application for a Community trade mark, as described in Article 26 (1), and all other information the publication of which is prescribed by this Regulation or the implementing regulation, shall be published in all the official languages of the European Community.

2. All entries in the Register of Community trade marks shall be made in all the official languages of the European Community.

3. In cases of doubt, the text in the language of the Office in which the application for the Community trade mark was filed shall be authentic. If the application was filed in an official language of the European Community other than one of the languages of the Office, the text in the second language indicated by the applicant shall be authentic.

Article 117

The translation services required for the functioning of the Office shall be provided by the Translation Centre of the Bodies of the Union once this begins operation.

Article 118

Control of legality

1. The Commission shall check the legality of those acts of the President of the Office in respect of which Community law does not provide for any check on legality by another body and of acts of the Budget Committee attached to the Office pursuant to Article 133.

2. It shall require that any unlawful acts as referred to in paragraph 1 be altered or annulled.

3. Member States and any person directly and personally involved may refer to the Commission any act as referred to in paragraph 1, whether express or implied, for the Commission to examine the legality of that act. Referral shall be made to the Commission within 15 days of the day on which the party concerned first became aware of the act in question. The Commission shall take a decision within one month. If no decision has been taken within this period, the case shall be deemed to have been dismissed.

SECTION 2

MANAGEMENT OF THE OFFICE

Article 119

Powers of the President

1. The Office shall be managed by the President.
2. To this end the President shall have in particular the following functions and powers:
 - (a) he shall take all necessary steps, including the adoption of internal administrative instructions and the publication of notices, to ensure the functioning of the Office;
 - (b) he may place before the Commission any proposal to amend this Regulation, the Implementing Regulation, the rules of procedure of the Boards of Appeal, the fees regulations and any other rules applying to Community trade marks after consulting the Administrative Board and, in the case of the fees regulations and the budgetary provisions of this Regulation, the Budget Committee;
 - (c) he shall draw up the estimates of the revenue and expenditure of the Office and shall implement the budget;
 - (d) he shall submit a management report to the Commission, the European Parliament and the Administrative Board each year;
 - (e) he shall exercise in respect of the staff the powers laid down in Article 112 (2);
 - (f) he may delegate his powers.
3. The President shall be assisted by one or more Vice-Presidents. If the President is absent or indisposed, the Vice-President or one of the Vice-Presidents shall take his place in accordance with the procedure laid down by the Administrative Board.

Article 120

Appointment of senior officials

1. The President of the Office shall be appointed by the Council from a list of at most three candidates, which shall be prepared by the Administrative Board. Power to dismiss the President shall lie with the Council, acting on a proposal from the Administrative Board.
2. The term of office of the President shall not exceed five years. This term of office shall be renewable.
3. The Vice-President or Vice-Presidents of the Office shall be appointed or dismissed as in paragraph 1, after consultation of the President.
4. The Council shall exercise disciplinary authority over the officials referred to in paragraphs 1 and 3 of this Article.

SECTION 3

ADMINISTRATIVE BOARD

Article 121

Creation and powers

1. An Administrative Board is hereby set up, attached to the Office. Without prejudice to the powers attributed to the Budget Committee in Section 5 - budget and financial control - the Administrative Board shall have the powers defined below.
2. The Administrative Board shall draw up the lists of candidates provided for in Article 120.
3. It shall fix the date for the first filing of Community trade mark applications, pursuant to Article 143 (3).
4. It shall advise the President on matters for which the Office is responsible.
5. It shall be consulted before adoption of the guidelines for examination in the Office and in the other cases provided for in this Regulation.
6. It may deliver opinions and requests for information to the President and to the Commission where it considers that this is necessary.

Article 122

Composition

1. The Administrative Board shall be composed of one representative of each Member State and one representative of the Commission and their alternates.
2. The members of the Administrative Board may, subject to the provisions of its rules of procedure, be assisted by advisers or experts.

Article 123

Chairmanship

1. The Administrative Board shall elect a chairman and a deputy chairman from among its members. The deputy chairman shall ex officio replace the chairman in the event of his being prevented from attending to his duties.
2. The duration of the terms of office of the chairman and the deputy chairman shall be three years. The terms of office shall be renewable.

Article 124

Meetings

1. Meetings of the Administrative Board shall be convened by its chairman.
2. The President of the Office shall take part in the deliberations, unless the Administrative Board decides otherwise.

3. The Administrative Board shall hold an ordinary meeting once a year; in addition, it shall meet on the initiative of its chairman or at the request of the Commission or of one-third of the Member States.
4. The Administrative Board shall adopt rules of procedure.
5. The Administrative Board shall take its decisions by a simple majority of the representatives of the Member States. However, a majority of three-quarters of the representatives of the Member States shall be required for the decisions which the Administrative Board is empowered to take under Article 120 (1) and (3). In both cases each Member State shall have one vote.
6. The Administrative Board may invite observers to attend its meetings.
7. The Secretariat for the Administrative Board shall be provided by the Office.

SECTION 4

IMPLEMENTATION OF PROCEDURES

Article 125

Competence

For taking decisions in connection with the procedures laid down in this Regulation, the following shall be competent:

- (a) Examiners;
- (b) Opposition Divisions;
- (c) an Administration of Trade Marks and Legal Division;
- (d) Cancellation Divisions;
- (e) Boards of Appeal.

Article 126

Examiners

An examiner shall be responsible for taking decisions on behalf of the Office in relation to an application for registration of a Community trade mark, including the matters referred to in Articles 36, 37, 38 and 66, except in so far as an Opposition Division is responsible.

Article 127

Opposition Divisions

1. An Opposition Division shall be responsible for taking decisions on an opposition to an application to register a Community trade mark.
2. An Opposition Division shall consist of three members. At least one of the members must be legally qualified.

Article 128

Administration of Trade Marks and Legal Division

1. The Administration of Trade Marks and Legal Division shall be responsible for those decisions required by this Regulation which do not fall within the competence of an examiner, an Opposition Division or a Cancellation Division. It shall in particular be responsible for decisions in respect of entries in the Register of Community trade marks.
2. It shall also be responsible for keeping the list of professional representatives which is referred to in Article 89.
3. A decision of the Division shall be taken by one member.

Article 129

Cancellation Divisions

1. A Cancellation Division shall be responsible for taking decisions in relation to an application for the revocation or declaration of invalidity of a Community trade mark.
2. A Cancellation Division shall consist of three members. At least one of the members must be legally qualified.

Article 130

Boards of Appeal

1. The Boards of Appeal shall be responsible for deciding on appeals from decisions of the examiners, Opposition Divisions, Administration of Trade Marks and Legal Division and Cancellation Divisions.
2. A Board of Appeal shall consist of three members. At least two of the members must be legally qualified.

Article 131

Independence of the members of the Boards of Appeal

1. The members, including the chairmen, of the Boards of Appeal shall be appointed, in accordance with the procedure laid down in Article 120, for the appointment of the President of the Office, for a term of five years. They may not be removed from office during this term, unless there are serious grounds for such removal and the Court of Justice, on application by the body which appointed them, takes a decision to this effect. Their term of office shall be renewable.
2. The members of the Boards of Appeal shall be independent. In their decisions they shall not be bound by any instructions.
3. The members of the Boards of Appeal may not be examiners or members of the Opposition Divisions, Administration of Trade Marks and Legal Division or Cancellation Divisions.

Article 132

Exclusion and objection

1. Examiners and members of the Divisions set up within the Office or of the Boards of Appeal may not take part in any proceedings if they have any personal interest therein, or if they have previously been involved as representatives of one of the parties. Two of the three members of an Opposition Division shall not have taken part in examining the application. Members of the Cancellation Divisions may not take part in any proceedings if they have participated in the final decision on the case in the proceedings for registration or opposition proceedings. Members of the Boards of Appeal may not take part in appeal proceedings if they participated in the decision under appeal.
2. If, for one of the reasons mentioned in paragraph 1 or for any other reason, a member of a Division or of a Board of Appeal considers that he should not take part in any proceedings, he shall inform the Division or Board accordingly.
3. Examiners and members of the Divisions or of a Board of Appeal may be objected to by any party for one of the reasons mentioned in paragraph 1, or if suspected of partiality. An objection shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step. No objection may be based upon the nationality of examiners or members.
4. The Divisions and the Boards of Appeal shall decide as to the action to be taken in the cases specified in paragraphs 2 and 3 without the participation of the member concerned. For the purposes of taking this decision the member who withdraws or has been objected to shall be replaced in the Division or Board of Appeal by his alternate.

SECTION 5

BUDGET AND FINANCIAL CONTROL

Article 133

Budget Committee

1. A Budget Committee is hereby set up, attached to the Office. The Budget Committee shall have the powers assigned to it in this Section and in Article 39 (4).
2. Articles 121 (6), 122, 123 and 124 (1) to (4), (6) and (7) shall apply to the Budget Committee *mutatis mutandis*.
3. The Budget Committee shall take its decisions by a simple majority of the representatives of the Member States. However, a majority of three-quarters of the representatives of the Member States shall be required for the decisions which the Budget Committee is empowered to take under Articles 39 (4), 135 (3) and 138. In both cases each Member State shall have one vote.

Article 134

Budget

1. Estimates of all the Office's revenue and expenditure shall be prepared for each financial year and shall be shown in the Office's budget, and each financial year shall correspond with the calendar year.
2. The revenue and expenditure shown in the budget shall be in balance.
3. Revenue shall comprise, without prejudice to other types of income, total fees payable under the fees regulations, and, to the extent necessary, a subsidy entered against a specific heading of the general budget of the European Communities, Commission Section.

Article 135

Preparation of the budget

1. The President shall draw up each year an estimate of the Office's revenue and expenditure for the following year and shall send it to the Budget Committee not later than 31 March in each year, together with a list of posts.
2. Should the budget estimates provide for a Community subsidy, the Budget Committee shall immediately forward the estimate to the Commission, which shall forward it to the budget authority of the Communities. The Commission may attach an opinion on the estimate along with an alternative estimate.
3. The Budget Committee shall adopt the budget, which shall include the Office's list of posts. Should the budget estimates contain a subsidy from the general budget of the Communities, the Office's budget shall, if necessary, be adjusted.

Article 136

Financial control

Control of commitment and payment of all expenditure and control of the existence and recovery of all revenue of the Office shall be carried out by the Financial Controller appointed by the Budget Committee.

Article 137

Auditing of accounts

1. Not later than 31 March in each year the President shall transmit to the Commission, the European Parliament, the Budget Committee and the Court of Auditors accounts of the Office's total revenue and expenditure for the preceding financial year. The Court of Auditors shall examine them in accordance with Article 188c of the Treaty.
2. The Budget Committee shall give a discharge to the President of the Office in respect of the implementation of the budget.

Article 138

Financial provisions

The Budget Committee shall, after consulting the Court of Auditors of the European Communities and the Commission, adopt internal financial provisions specifying, in particular, the procedure for establishing and implementing the Office's budget. As far as is compatible with the particular nature of the Office, the financial provisions shall be based on the financial regulations adopted for other bodies set up by the Community.

Article 139

Fees regulations

1. The fees regulations shall determine in particular the amounts of the fees and the ways in which they are to be paid.
2. The amounts of the fees shall be fixed at such a level as to ensure that the revenue in respect thereof is in principle sufficient for the budget of the Office to be balanced.
3. The fees regulations shall be adopted and amended in accordance with the procedure laid down in Article 141.

TITLE XIII FINAL PROVISIONS

Article 140

Community implementing provisions

1. The rules implementing this Regulation shall be adopted in an Implementing Regulation.
2. In addition to the fees provided for in the preceding Articles, fees shall be charged, in accordance with the detailed rules of application laid down in the Implementing Regulation, in the cases listed below:
 1. alteration of the representation of a Community trade mark;
 2. late payment of the registration fee;
 3. issue of a copy of the certificate of registration;
 4. registration of the transfer of a Community trade mark;
 5. registration of a licence or another right in respect of a Community trade mark;
 6. registration of a licence or another right in respect of an application for a Community trade mark;
 7. cancellation of the registration of a licence or another right;
 8. alteration of a registered Community trade mark;
 9. issue of an extract from the Register;
 10. inspection of the files;
 11. issue of copies of file documents;
 12. issue of certified copies of the application;

13. communication of information in a file;
 14. review of the determination of the procedural costs to be refunded.
3. The Implementing Regulation and the rules of procedure of the Boards of Appeal shall be adopted and amended in accordance with the procedure laid down in Article 141.

Article 141

Establishment of a committee and procedure for the adoption of implementing regulations

1. The Commission shall be assisted by a Committee on Fees, Implementation Rules and the Procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (trade marks and designs), which shall be composed of representatives of the Member States and chaired by a representative of the Commission.

2. The representative of the Commission shall submit to the Committee a draft of the measures to be taken. The Committee shall deliver its opinion on the draft within a time limit which the chairman may lay down according to the urgency of the matter. The opinion shall be delivered by the majority laid down in Article 148 (2) of the Treaty in the case of decisions which the Council is required to adopt on a proposal from the Commission. The votes of the representatives of the Member States within the Committee shall be weighted in the manner set out in that Article. The chairman shall not vote.

The Commission shall adopt the measures envisaged if they are in accordance with the opinion of the Committee.

If the measures envisaged are not in accordance with the opinion of the Committee, or if no opinion is delivered, the Commission shall, without delay, submit to the Council a proposal relating to the measures to be taken. The Council shall act by a qualified majority.

If, on the expiry of a period of three months from the date of referral to the Council, the Council has not acted, the proposed measures shall be adopted by the Commission, save where the Council has decided against the measures by a simple majority.

Article 142

Compatibility with other Community legal provisions

This Regulation shall not affect Council Regulation (EEC) No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (7) of 14 July 1992, and in particular Article 14 thereof.

Article 143

Entry into force

1. This Regulation shall enter into force on the 60th day following that of its publication in the Official Journal of the European Communities.

2. The Member States shall within three years following entry into force of this Regulation take the necessary measures for the purpose of implementing Articles 91 and 110 hereof and shall forthwith inform the Commission of those measures.

3. Applications for Community trade marks may be filed at the Office from the date fixed by the Administrative Board on the recommendation of the President of the Office.

4. Applications for Community trade marks filed within three months before the date referred to in paragraph 3 shall be deemed to have been filed on that date.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 20 December 1993.

For the Council

The President

A. BOURGEOIS

(1) OJ No C 351, 31. 12. 1980, p. 1 and OJ No C 230, 31. 8. 1984, p. 1.

(2) OJ No C 307, 14. 11. 1983, p. 46 and OJ No C 280, 28. 10. 1991, p. 153.

(3) OJ No C 310, 30. 11. 1981, p. 22.

(4) OJ No L 319, 25. 11. 1988, p. 1 and corrigendum in OJ No L 241, 17. 8. 1989, p. 4.

(5) OJ No L 144, 16. 6. 1993, p. 21.

(6) OJ No L 197, 18. 7. 1987, p. 33.

(7) OJ No L 208, 24. 7. 1992, p. 1.

Statement by the Council and the Commission on the seat of the Office for Harmonization in the Internal Market (trade marks and designs)

'In adopting the Regulation on the Community Trade Mark, the Council and the Commission note:

- that the representatives of the Governments of the Member States, meeting at Head of State and Government level on 29 October 1993, decided that the Office for Harmonization in the Internal Market (trade marks and designs) should have its seat in Spain, in a town to be determined by the Spanish Government;

- that the Spanish Government has designated Alicante as the seat of the Office.'

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Amended by 32003R1992 Addition Article 153 from 01/10/2004

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Amended by 12005SPN03/01/01 Replacement Article 159 BI.1 from
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SUBSPREP

Amendment proposed by 51996PC0372
Amendment proposed by 51997PC0489(01)
Amendment proposed by 52001PC0789(04)
Amendment proposed by 52002PC0767
Amendment proposed by 52005PC0190(06)
Amendment proposed by 52005PC0689

SUB

Provisions under Article 235 EEC ; Industrial and commercial property

REGISTER

17200000

PREPWORK

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**Council Regulation (EC) No 3288/94
of 22 December 1994**

**amending Regulation (EC) No 40/94 on the Community trade mark for the implementation of the
agreements concluded in the framework of the Uruguay Round**

COUNCIL REGULATION (EC) No 3288/94 of 22 December 1994 amending Regulation (EC) No 40/94 on the Community trade mark for the implementation of the agreements concluded in the framework of the Uruguay Round

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 235 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Parliament (1),

Whereas the Agreement establishing the World Trade Organization (hereinafter, the 'WTO Agreement') was signed on behalf of the Community; whereas the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter, the 'TRIPs Agreement'), annexed to the WTO Agreement, contains detailed provisions on the protection of intellectual property rights whose purpose is the establishment of international disciplines in this area in order to promote international trade and prevent trade distortions and friction due to the lack of adequate and effective intellectual property protection;

Whereas in order to ensure that all relevant Community legislation is in full compliance with the TRIPs Agreement, the Community must take certain measures in relation to current Community acts on the protection of intellectual property rights; whereas these measures entail in some respects the amendment or modification of Community acts; whereas these measures also entail complementing current Community acts;

Whereas Regulation (EC) No 40/94 creates the Community trade mark (2); whereas Article 5 of Regulation (EC) No 40/94 defines the 'Persons who can be proprietors of Community trade marks' by referring notably to the Paris Convention for the protection of industrial property and requires reciprocal national treatment from countries which are not parties to the Paris Convention; whereas Article 29 of Regulation (EC) No 40/94, concerning the right of priority, also needs to be amended in this respect; whereas in order to comply with the national treatment obligation in Article 3 of the TRIPs Agreement, these provisions should be modified to ensure that nationals of all WTO Members, even if the Member in question is not a party to the Paris Convention, receive a treatment no less favourable than that accorded to nationals of Community Member States;

Whereas Article 23 (2) of the TRIPs Agreement provides for the refusal or invalidation of trade marks which contain or consist of false geographical indications for wines and spirits without the condition that they are of such a nature as to deceive the public, a new subparagraph (j) has to be added to Article 7 (1) of Regulation (EC) No 40/94,

HAS ADOPTED THIS REGULATION:

Article 1

Regulation (EC) No 40/94 is amended as follows:

1. Article 5 (1) (b) shall be replaced by the following:

'(b) nationals of other States which are parties to the Paris Convention for the protection of industrial property, hereinafter referred to as 'the Paris Convention', or to the Agreement establishing

the World Trade Organization;`2. Article 5 (1) (d) shall be replaced by the following:

'(d) nationals, other than those referred to under subparagraph (c), of any State which is not party to the Paris Convention or to the Agreement establishing the World Trade Organization and which, according to published findings, accords to nationals of all the Member States the same protection for trade marks as it accords to its own nationals and, if nationals of the Member States are required to prove registration in the country of origin, recognizes the registration of Community trade marks as such proof.'

3. In Article 7 (1) after subparagraph (i) the following shall be added:

'(j) trade marks for wines which contain or consist of a geographical indication identifying wines or for spirits which contain or consist of a geographical indication identifying spirits with respect to such wines or spirits not having that origin.'

4. Article 29 (1) shall be replaced by the following:

'1. A person who has duly filed an application for a trade mark in or for any State party to the Paris Convention or to the Agreement establishing the World Trade Organization, or his successors in title, shall enjoy, for the purpose of filing a Community trade mark application for the same trade mark in respect of goods or services which are identical with or contained within those for which the application has been filed, a right or priority during a period of six months from the date of filing of the first application.'

5. Article 29 (5) shall be replaced by the following:

'5. If the first filing has been made in a State which is not a party to the Paris Convention or to the Agreement establishing the World Trade Organization, paragraphs 1 to 4 shall apply only in so far as that State, according to published findings, grants, on the basis of the first filing made at the Office and subject to conditions equivalent to those laid down in this Regulation, a right of priority having equivalent effect.'

Article 2

This Regulation shall enter into force on 1 January 1995.

It shall be applicable as of 1 January 1996.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 22 December 1994.

For the Council

The President

H. SEEHOFER

(1) Opinion delivered on 14 December 1994 (not yet published in the Official Journal).

(2) OJ No L 11, 14. 1. 1994, p. 1.

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**Council Regulation (EC) No 1653/2003
of 18 June 2003
amending Regulation (EC) No 40/94 on the Community trade mark**

Council Regulation (EC) No 1653/2003

of 18 June 2003

amending Regulation (EC) No 40/94 on the Community trade mark

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 308 thereof,

Having regard to the proposal from the Commission(1),

Having regard to the opinion of the European Parliament(2),

Having regard to the opinion of the Court of Auditors(3),

Whereas:

- (1) With the entry into force of Council Regulation (EC, Euratom) No 1605/02 of 25 June 2002 on the Financial Regulation applicable to the general budget of the European Communities(4), the concept of centralised ex ante financial control was replaced by more modern control and audit systems.
- (2) The Office for Harmonization in the Internal Market should have control and audit systems comparable with those of the Community institutions.
- (3) The general principles and limits governing right of access to the documents provided for in Article 255 of the Treaty have been laid down by Regulation (EC) No 1049/2001 of the European Parliament and of the Council of 30 May 2001 regarding public access to European Parliament, Council and Commission documents(5).
- (4) When Regulation (EC) No 1049/2001 was adopted, the three institutions agreed in a joint declaration that the agencies and similar bodies should implement rules conforming to those of that Regulation.
- (5) Appropriate provisions should therefore be included in Regulation (EC) No 40/94 of 20 December 1994 on the Community trade mark(6) to make Regulation (EC) No 1049/2001 applicable to the Office for Harmonization in the Internal Market, as should a provision relating to appeals against a refusal of access to documents.
- (6) Regulation (EC) No 40/94 should therefore be amended accordingly,

HAS ADOPTED THIS REGULATION:

Article 1

Regulation (EC) No 40/94 is hereby amended as follows:

1. the following Article shall be inserted:

"Article 118a

Access to documents

1. Regulation (EC) No 1049/2001 of the European Parliament and of the Council of 30 May 2001 regarding access to European Parliament, Council and Commission documents(7) shall apply to documents

held by the Office.

2. The Administrative Board shall adopt the practical arrangements for implementing Regulation (EC) No 1049/2001 within six months of entry into force of Regulation (EC) No 1653/2003 of 18 June 2003 amending Regulation (EC) No 40/94 on the Community trade mark(8).

3. Decisions taken by the Office pursuant to Article 8 of Regulation (EC) No 1049/2001 may give rise to the lodging of a complaint to the Ombudsman or form the subject of an action before the Court of Justice of the European Communities, under the conditions laid down in Articles 195 and 230 of the Treaty respectively.";

2. Article 136 shall be replaced by the following:

"Article 136

Audit and control

1. An internal audit function shall be set up within the Office, to be performed in compliance with the relevant international standards. The internal auditor, appointed by the President, shall be responsible to him for verifying the proper operation of budget implementation systems and procedures of the Office.

2. The internal auditor shall advise the President on dealing with risks, by issuing independent opinions on the quality of management and control systems and by issuing recommendations for improving the conditions of implementation of operations and promoting sound financial management.

3. The responsibility for putting in place internal control systems and procedures suitable for carrying out his tasks shall lie with the authorising officer."

Article 2

This Regulation shall enter into force on the first day of the month following that of its publication in the Official Journal of the European Union.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Luxembourg, 18 June 2003.

For the Council

The President

G. Drys

(1) OJ C 331 E, 31.12.2002, p. 75.

(2) Opinion delivered on 27.3.2003 (not yet published in the Official Journal).

(3) OJ C 285, 21.11.2002, p. 4.

(4) OJ L 248, 16.9.2002, p. 1, with Corrigendum in OJ L 25, 30.1.2003, p. 43.

(5) OJ L 145, 31.5.2001, p. 43.

(6) OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Council Regulation (EC) No 3288/94 (OJ L 349, 31.12.1994, p. 83).

(7) OJ L 145, 31.5.2001, p. 43.

(8) OJ L 245, 29.9.2003, p. 36.

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**Council Regulation (EC) No 1992/2003
of 27 October 2003**

amending Regulation (EC) No 40/94 on the Community trade mark to give effect to the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989

Council Regulation (EC) No 1992/2003

of 27 October 2003

amending Regulation (EC) No 40/94 on the Community trade mark to give effect to the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 308 thereof,

Having regard to the proposal from the Commission(1),

Having regard to the opinion of the European Parliament(2),

Having regard to the opinion of the European Economic and Social Committee(3),

Whereas:

- (1) Regulation (EC) No 40/94(4) (the Community trade mark Regulation), which is based on Article 308 of the Treaty, is designed to create a market which functions properly and offers conditions which are similar to those obtaining in a national market. In order to create a market of this kind and make it increasingly a single market, the said Regulation created the Community trade mark system whereby undertakings can, by means of one procedural system, obtain Community trade marks to which uniform protection is given and which produce their effects throughout the entire area of the European Community.
- (2) The Diplomatic Conference for the conclusion of a Protocol relating to the Madrid Agreement concerning the international registration of marks adopted the Protocol relating to the Madrid Agreement concerning the international registration of marks (hereafter referred to as the Madrid Protocol) on 27 June 1989, at Madrid.
- (3) The Madrid Protocol was adopted in order to introduce certain new features into the system of the international registration of marks existing under the Madrid Agreement concerning the international registration of marks of 14 April 1891 as amended (hereafter referred to as the Madrid Agreement)(5).
- (4) As compared to the Madrid Agreement, the Madrid Protocol introduced, in its Article 14, as one of the main innovations the possibility that an intergovernmental organisation which has a regional office for the purpose of registering marks with effect in the territory of the organisation may become party to the Madrid Protocol.
- (5) The Madrid Protocol entered into force on 1 December 1995 and became operational on 1 April 1996 and the Community trade mark system also became operational on the latter date.
- (6) The Community trade mark system and the international registration system as established by the Madrid Protocol are complementary. Therefore, in order to enable firms to benefit from the advantages of the Community trade mark through the Madrid Protocol and vice versa, it is necessary to allow Community trade mark applicants and holders of such trade marks to apply for international protection of their trade marks through the filing of an international application under the

Madrid Protocol and, conversely, holders of international registrations under the Madrid Protocol to apply for protection of their trade marks under the Community trade mark system.

- (7) Moreover, the establishment of a link between the Community trade mark system and the international registration system under the Madrid Protocol would promote a harmonious development of economic activities, will eliminate distortions of competition, will be cost efficient and will increase the level of integration and functioning of the internal market. Therefore, the accession of the Community to the Madrid Protocol is necessary in order for the Community trade mark system to become more attractive.
- (8) For the above reasons, the Council, acting on a proposal from the Commission(6), approved the Madrid Protocol and authorised the President of the Council to deposit the instrument of accession with the Director-General of the World Intellectual Property Organisation (WIPO) as from the date on which the Council has adopted the measures which are necessary to give effect to the accession of the European Community to the Madrid Protocol. This Regulation contains these measures.
- (9) These measures should be incorporated in the Community trade mark Regulation through the inclusion of a new title on "International registration of marks". For this reason, the legal basis of this proposal should be the same as the legal basis of the Community trade mark Regulation, i.e. Article 308 of the Treaty.
- (10) Furthermore, it is necessary to provide for rules applying to the filing of an international application at the International Bureau of WIPO through the intermediary of the Office for Harmonisation in the Internal Market (trade marks and designs) (the Office).
- (11) Where an international application is filed, on the basis of a Community trade mark application, in a language other than one of the languages allowed under the Madrid Protocol for the filing of international applications, the Office should make its best efforts to arrange for the translation of the list of goods or services into the language indicated by the applicant in order for the application to be forwarded to the International Bureau in time to maintain the date of priority.
- (12) There is nothing in the Madrid Protocol or in the Regulations adopted under the Madrid Protocol which would determine the language regime to be applied by the Office when processing an international application or an international registration.
- (13) Finally, the rules and procedures relating to international registrations designating the European Community should, in principle, be the same as the rules and procedures which apply to Community trade mark applications and the protection of Community trade marks. According to this principle, international registrations designating the European Community should be subject to examination as to absolute grounds for refusal, searches in the Register of Community trade marks and the registers of trade marks of those Member States which have informed the Office of their decision to operate such a search and should be subject to opposition in the same way as published Community trade marks. Likewise international registrations designating the European Community should be subject to the same rules on use and invalidation as Community trade marks. Furthermore the designation of the European Community through international registrations may be converted into national trade mark applications or into the designation of Member States which are party to the Madrid Protocol or the Madrid Agreement where the designation of the European Community through such international registrations is refused or ceases to have effect,

HAS ADOPTED THIS REGULATION:

Article 1

Regulation (EC) No 40/94 is hereby amended as follows:

1. The following subparagraph shall be added to Article 8(2)(a):

"(iv) trade marks registered under international arrangements which have effect in the Community;"

2. Article 134(3) shall be replaced by the following:

"3. Revenue shall comprise, without prejudice to other types of income, total fees payable under the fees regulations, total fees payable under the Madrid Protocol referred to in Article 140 for an international registration designating the European Communities and other payments made to Contracting Parties to the Madrid Protocol, and, to the extent necessary, a subsidy entered against a specific heading of the general budget of the European Communities, Commission section."

3. The following title shall be inserted after title XII:

"TITLE XIII INTERNATIONAL REGISTRATION OF MARKS

SECTION I GENERAL PROVISIONS

Article 140

Application of provisions

Unless otherwise specified in this title, this Regulation and any regulations implementing this Regulation adopted pursuant to Article 158 shall apply to applications for international registrations under the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989 (hereafter referred to as 'international applications' and 'the Madrid Protocol' respectively), based on an application for a Community trade mark or on a Community trade mark and to registrations of marks in the international register maintained by the International Bureau of the World Intellectual Property Organisation (hereafter referred to as 'international registrations' and 'the International Bureau', respectively) designating the European Community.

SECTION 2 INTERNATIONAL REGISTRATION ON THE BASIS OF APPLICATIONS FOR A COMMUNITY TRADE MARK AND OF COMMUNITY TRADE MARKS

Article 141

Filing of an international application

1. International applications pursuant to Article 3 of the Madrid Protocol based on an application for a Community trade mark or on a Community trade mark shall be filed at the Office.

2. Where an international application is filed before the mark on which the international registration is to be based has been registered as a Community trade mark, the applicant for the international registration must indicate whether the international registration is to be based on a Community trade mark application or registration. Where the international registration is to be based on a Community trade mark once it is registered, the international application shall be deemed to

have been received at the Office on the date of registration of the Community trade mark.

Article 142

Form and contents of the international application

1. The international application shall be filed in one of the official languages of the European Community, using a form provided by the Office. Unless otherwise specified by the applicant on that form when he files the international application, the Office shall correspond with the applicant in the language of filing in a standard form.
2. If the international application is filed in a language which is not one of the languages allowed under the Madrid Protocol, the applicant must indicate a second language from among those languages. This shall be the language in which the Office submits the international application to the International Bureau.
3. Where the international application is filed in a language other than one of the languages allowed under the Madrid Protocol for the filing of international applications, the applicant may provide a translation of the list of goods or services in the language in which the international application is to be submitted to the International Bureau pursuant to paragraph 2.
4. The Office shall forward the international application to the International Bureau as soon as possible.
5. The filing of an international application shall be subject to the payment of a fee to the Office. In the cases referred to in the second sentence of Article 141(2), the fee shall be due on the date of registration of the Community trade mark. The application shall be deemed not to have been filed until the required fee has been paid.
6. The international application must fulfil the relevant conditions laid down in the Implementing Regulation referred to in Article 157.

Article 143

Recordal in the files and in the Register

1. The date and number of an international registration based on a Community trade mark application, shall be recorded in the files of that application. When the application results in a Community trade mark, the date and number of the international registration shall be entered in the register.
2. The date and number of an international registration based on a Community trade mark shall be entered in the Register.

Article 144

Request for territorial extension subsequent to the international registration

A request for territorial extension made subsequent to the international registration pursuant to Article 3ter(2) of the Madrid Protocol may be filed through the intermediary of the Office. The request must be filed in the language in which the international application was filed pursuant

to Article 142.

Article 145

International fees

Any fees payable to the International Bureau under the Madrid Protocol shall be paid direct to the International Bureau.

SECTION 3 INTERNATIONAL REGISTRATIONS DESIGNATING THE EUROPEAN COMMUNITY

Article 146

Effects of international registrations designating the European Community

1. An international registration designating the European Community shall, from the date of its registration pursuant to Article 3(4) of the Madrid Protocol or from the date of the subsequent designation of the European Community pursuant to Article 3ter(2) of the Madrid Protocol, have the same effect as an application for a Community trade mark.
2. If no refusal has been notified in accordance with Article 5(1) and (2) of the Madrid Protocol or if any such refusal has been withdrawn, the international registration of a mark designating the European Community shall, from the date referred to in paragraph 1, have the same effect as the registration of a mark as a Community trade mark.
3. For the purposes of applying Article 9(3), publication of the particulars of the international registration designating the European Community pursuant to Article 147(1) shall take the place of publication of a Community trade mark application, and publication pursuant to Article 147(2) shall take the place of publication of the registration of a Community trade mark.

Article 147

Publication

1. The Office shall publish the date of registration of a mark designating the European Community pursuant to Article 3(4) of the Madrid Protocol or the date of the subsequent designation of the European Community pursuant to Article 3ter(2) of the Madrid Protocol, the language of filing of the international application and the second language indicated by the applicant, the number of the international registration and the date of publication of such registration in the Gazette published by the International Bureau, a reproduction of the mark and the numbers of the classes of the goods or services in respect of which protection is claimed.
2. If no refusal of protection of an international registration designating the European Community has been notified in accordance with Article 5(1) and (2) of the Madrid Protocol or if any such refusal has been withdrawn, the Office shall publish this fact, together with the number of the international registration and, where applicable, the date of publication of such registration in the Gazette published by the International Bureau.

Article 148

Seniority

1. The applicant for an international registration designating the European Community may claim, in the international application, the seniority of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, as provided for in Article 34.
2. The holder of an international registration designating the European Community may, as from the date of publication of the effects of such registration pursuant to Article 147(2), claim at the Office the seniority of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, as provided for in Article 35. The Office shall notify the International Bureau accordingly.

Article 149

Examination as to absolute grounds for refusal

1. International registrations designating the European Community shall be subject to examination as to absolute grounds for refusal in the same way as applications for Community trade marks.
2. Protection of an international registration shall not be refused before the holder of the international registration has been allowed the opportunity to renounce or limit the protection in respect of the European Community or of submitting his observations.
3. Refusal of protection shall take the place of refusal of a Community trade mark application.
4. Where protection of an international registration is refused by a decision under this Article which has become final or where the holder of the international registration has renounced the protection in respect of the European Community pursuant to paragraph 2, the Office shall refund the holder of the international registration a part of the individual fee to be laid down in the implementing Regulation.

Article 150

Search

1. Once the Office has received a notification of an international registration designating the European Community, it shall draw up a Community search report as provided for in Article 39(1).
2. As soon as the Office has received a notification of an international registration designating the European Community, the Office shall transmit a copy thereof to the central industrial property office of each Member State which has informed the Office of its decision to operate a search in its own register of trade marks as provided for in Article 39(2).
3. Article 39(3), (4) and (5) shall apply *mutatis mutandis*.
4. The Office shall inform the proprietors of any earlier Community trade marks or Community trade

mark applications cited in the Community search report of the publication of the international registration designating the European Community as provided for in Article 147(1).

Article 151

Opposition

1. International registration designating the European Community shall be subject to opposition in the same way as published Community trade mark applications.
2. Notice of opposition shall be filed within a period of three months which shall begin six months following the date of the publication pursuant to Article 147(1). The opposition shall not be treated as duly entered until the opposition fee has been paid.
3. Refusal of protection shall take the place of refusal of a Community trade mark application.
4. Where protection of an international registration is refused by a decision under this Article which has become final or where the holder of the international registration has renounced the protection in respect of the European Community prior to a decision under this Article which has become final, the Office shall refund the holder of the international registration a part of the individual fee to be laid down in the implementing Regulation.

Article 152

Replacement of a Community trade mark by an international registration

The Office shall, upon request, enter a notice in the Register that a Community trade mark is deemed to have been replaced by an international registration in accordance with Article 4bis of the Madrid Protocol.

Article 153

Invalidation of the effects of an international registration

1. The effects of an international registration designating the European Community may be declared invalid.
2. The application for invalidation of the effects of an international registration designating the European Community shall take the place of an application for a declaration of revocation as provided for in Article 50 or for invalidation as provided for in Article 51 or Article 52.

Article 154

Conversion of a designation of the European Community through an international registration into a national trade mark application or into a designation of Member States

1. Where a designation of the European Community through an international registration has been refused or ceases to have effect, the holder of the international registration may request the conversion

of the designation of the European Community:

- (a) into a national trade mark application pursuant to Articles 108 to 110 or
- (b) into a designation of a Member State party to the Madrid Protocol or the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 14 April 1891, as revised and amended (hereafter referred to as the Madrid Agreement), provided that on the date when conversion was requested it was possible to have designated that Member State directly under the Madrid Protocol or the Madrid Agreement. Articles 108 to 110 shall apply.

2. The national trade mark application or the designation of a Member State party to the Madrid Protocol or the Madrid Agreement resulting from the conversion of the designation of the European Community through an international registration shall enjoy, in respect of the Member State concerned, the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date of the extension to the European Community pursuant to Article 3ter(2) of the Madrid Protocol if the latter was made subsequently to the international registration, or the date of priority of that registration and, where appropriate, the seniority of a trade mark of that State claimed under Article 148.

3. The request for conversion shall be published.

Article 155

Use of a mark subject of an international registration

For the purposes of applying Article 15(1), Article 43(2), Article 50(1)(a) and Article 56(2), the date of publication pursuant to Article 147(2) shall take the place of the date of registration for the purpose of establishing the date as from which the mark which is the subject of an international registration designating the European Community must be put to genuine use in the Community.

Article 156

Transformation

1. Subject to paragraph 2, the provisions applicable to Community trade mark applications shall apply *mutatis mutandis* to applications for transformation of an international registration into a Community trade mark application pursuant to Article 9quinquies of the Madrid Protocol.

2. When the application for transformation relates to an international registration designating the European Community the particulars of which have been published pursuant to Article 147(2), Articles 38 to 43 shall not apply."

4. Title XIII becomes Title XIV.

5. Articles 140, 141, 142 and 143 shall be renumbered as follows:

Article 140 becomes Article 157

Article 141 becomes Article 158

Article 142 becomes Article 159

Article 143 becomes Article 160.

6. The reference to Article 140 in Article 26(3) shall be replaced by a reference to Article 157.

7. The reference to Article 141 in Article 139(3) and Article 140(3) shall be replaced by a reference to Article 158.

Article 2

This Regulation shall enter into force on the date on which the Madrid Protocol enters into force with respect to the European Community. The date of entry into force of this Regulation shall be published in the Official Journal of the European Union.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Luxembourg, 27 October 2003.

For the Council

The President

A. Matteoli

- (1) OJ C 300, 10.10.1996, p. 11.
- (2) OJ C 127, 2.6.1997, p. 251.
- (3) OJ C 89, 19.3.1997, p. 14.
- (4) OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Regulation (EC) No 1653/2003 (OJ L 245, 29.9.2003, p. 36).
- (5) The Madrid Agreement concerning the international registration of marks as revised last at Stockholm on 14 July 1967 and as amended on 2 October 1979.
- (6) Commission proposal for a Council Decision approving the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on June 27, 1989 (OJ C 293, 5.10.1996, p. 11).

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Protocol

relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989

Article 1

Membership in the Madrid Union

The States party to this Protocol (hereinafter referred to as the contracting States), even where they are not party to the Madrid Agreement concerning the international registration of marks as revised at Stockholm in 1967 and as amended in 1979 (hereinafter referred to as the Madrid (Stockholm) Agreement), and the organisations referred to in Article 14(1)(b) which are party to this Protocol (hereinafter referred to as the contracting organisations) shall be members of the same Union of which countries party to the Madrid (Stockholm) Agreement are members. Any reference in this Protocol to "contracting parties" shall be construed as a reference to both contracting States and contracting organisations.

Article 2

Securing protection through international registration

1. Where an application for the registration of a mark has been filed with the office of a contracting party, or where a mark has been registered in the register of the office of a contracting party, the person in whose name that application (hereinafter referred to as the basic application) or that registration (hereinafter referred to as the basic registration) stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the contracting parties, by obtaining the registration of that mark in the register of the International Bureau of the World Intellectual Property Organisation (hereinafter referred to as "the international registration", "the International Register", "the International Bureau" and the "Organisation", respectively), provided that:

(i) where the basic application has been filed with the office of a contracting State or where the basic registration has been made by such an office, the person in whose name that application or registration stands is a national of that contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said contracting State;

(ii) where the basic application has been filed with the office of a contracting organisation or where the basic registration has been made by such an office, the person in whose name that application or registration stands is a national of a State member of that contracting organisation, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of the said contracting organisation.

2. The application for international registration (hereinafter referred to as the international application) shall be filed with the International Bureau through the intermediary of the office with which the basic application was filed or by which the basic registration was made (hereinafter referred to as the office of origin), as the case may be.

3. Any reference in this Protocol to an "office" or an "office of a contracting party" shall be construed as a reference to the office that is in charge, on behalf of a contracting party, of the registration of marks, and any reference in this Protocol to "marks" shall be construed as a reference to trade marks and service marks.

4. For the purposes of this Protocol, "territory of a contracting party" means, where the contracting party is a State, the territory of that State and, where the contracting party is an intergovernmental organisation, the territory in which the constituting treaty of that intergovernmental organisation applies.

Article 3

International application

1. Every international application under this Protocol shall be presented on the form prescribed by the regulations. The office of origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or basic registration, as the case may be. Furthermore, the said office shall indicate:

(i) in the case of a basic application, the date and number of that application;

(ii) in the case of a basic registration, the date and number of that registration as well as the date and number of the application from which the basic registration resulted. The office of origin shall also indicate the date of the international application.

2. The applicant must indicate the goods and services in respect of which protection of the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement concerning the international classification of goods and services for the purposes of the registration of marks. If the applicant does not give such indication, the International Bureau shall classify the goods and services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the office of origin. In the event of disagreement between the said office and the International Bureau, the opinion of the latter shall prevail.

3. If the applicant claims colour as a distinctive feature of his mark, he shall be required:

(i) to state the fact, and to file with his international application a notice specifying the colour or the combination of colours claimed;

(ii) to append to his international application copies in colour of the said mark, which shall be attached to the notifications given by the International Bureau, the number of such copies shall be fixed by the regulations.

4. The International Bureau shall register immediately the marks filed in accordance with Article 2. The international registration shall bear the date on which the international application was received in the office of origin, provided that the international application has been received by the International Bureau within a period of two months from that date. If the international application has not been received within that period, the international registration shall bear the date on which the said international application was received by the International Bureau. The International Bureau shall notify the international registration without delay to the offices concerned. Marks registered in the International Register shall be published in a periodical gazette issued by the International Bureau, on the basis of the

particulars contained in the international application.

5. With a view to the publicity to be given to marks registered in the International Register, each office shall receive from the International Bureau a number of copies of the said gazette free of charge and a number of copies at a reduced price, under the conditions fixed by the assembly referred to in Article 10 (hereinafter referred to as the assembly). Such publicity shall be deemed to be sufficient for the purposes of all the contracting parties, and no other publicity may be required of the holder of the international registration.

Article 3bis

Territorial effect

The protection resulting from the international registration shall extend to any contracting party only at the request of the person who files the international application or who is the holder of the international registration. However, no such request can be made with respect to the contracting party whose office is the office of origin.

Article 3ter

Request for "territorial extension"

1. Any request for extension of the protection resulting from the international registration to any contracting party shall be specially mentioned in the international application.

2. A request for territorial extension may also be made subsequently to the international registration. Any such request shall be presented on the form prescribed by the regulations. It shall be immediately recorded by the International Bureau, which shall notify such recordal without delay to the office or offices concerned. Such recordal shall be published in the periodical gazette of the International Bureau. Such territorial extension shall be effective from the date on which it has been recorded in the International Register; it shall cease to be valid on the expiry of the international registration to which it relates.

Article 4

Effects of international registration

1. (a) From the date of the registration or recordal effected in accordance with the provisions of Articles 3 and 3ter, the protection of the mark in each of the contracting parties concerned shall be the same as if the mark had been deposited direct with the office of that contracting party. If no refusal has been notified to the International Bureau in accordance with Article 5(1) and (2) or if a refusal notified in accordance with the said Article has been withdrawn subsequently, the protection of the mark in the contracting party concerned shall, as from the said date, be the same as if the mark had been registered by the office of that contracting party.

(b) The indication of classes of goods and services provided for in Article 3 shall not bind the contracting parties with regard to the determination of the scope of the protection of the mark.

2. Every international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the protection of industrial property, without it being necessary to comply with the formalities prescribed in section D of that Article.

Article 4bis

Replacement of a national or regional registration by an international registration

1. Where a mark that is the subject of a national or regional registration in the office of a contracting party is also the subject of an international registration and both registrations stand in the name of the same person, the international registration is deemed to replace the national or regional registration, without prejudice to any rights acquired by virtue of the latter, provided that:

- (i) the protection resulting from the international registration extends to the said contracting party under Article 3ter(1) or (2);
- (ii) all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the said contracting party;
- (iii) such extension takes effect after the date of the national or regional registration.

2. The office referred to in paragraph 1 shall, upon request, be required to take note in its register of the international registration.

Article 5

Refusal and invalidation of effects of international registration in respect of certain contracting parties

1. Where the applicable legislation so authorises, any office of a contracting party which has been notified by the International Bureau of an extension to that contracting party, under Article 3ter(1) or (2), of the protection resulting from the international registration shall have the right to declare in a notification of refusal that protection cannot be granted in the said contracting party to the mark which is the subject of such extension. Any such refusal can be based only on the grounds which would apply, under the Paris Convention for the protection of industrial property, in the case of a mark deposited direct with the office which notifies the refusal. However, protection may not be refused, even partially, by reason only that the applicable legislation would permit registration only in a limited number of classes or for a limited number of goods or services.

2. (a) Any office wishing to exercise such right shall notify its refusal to the International Bureau, together with a statement of all grounds, within the period prescribed by the law applicable to that office and at the latest, subject to subparagraphs (b) and (c), before the expiry of one year from the date on which the notification of the extension referred to in paragraph 1 has been sent to that office by the International Bureau.

(b) Notwithstanding subparagraph (a), any contracting party may declare that, for international registrations made under this Protocol, the time limit of one year referred to in subparagraph (a) is replaced by 18 months.

(c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the office of the said contracting party to the International Bureau after the expiry of the 18-month time limit. Such an office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if:

(i) it has, before the expiry of the 18-month time limit, informed the International Bureau of the possibility that oppositions may be filed after the expiry of the 18-month time limit; and

(ii) the notification of the refusal based on an opposition is made within a time limit of not more than seven months from the date on which the opposition period begins; if the opposition period expires before this time limit of seven months, the notification must be made

within a time limit of one month from the expiry of the opposition period.

(d) Any declaration under subparagraphs (b) or (c) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organisation having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director-General of the organisation (hereinafter referred to as the Director-General), or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

(e) Upon the expiry of a period of 10 years from the entry into force of this Protocol, the Assembly shall examine the operation of the system established by subparagraphs (a) to (d). Thereafter, the provisions of the said subparagraphs may be modified by a unanimous decision of the Assembly.

3. The International Bureau shall, without delay, transmit one of the copies of the notification of refusal to the holder of the international registration. The said holder shall have the same remedies as if the mark had been deposited by him direct with the office which has notified its refusal. Where the International Bureau has received information under paragraph 2(c)(i), it shall, without delay, transmit the said information to the holder of the international registration.

4. The grounds for refusing a mark shall be communicated by the International Bureau to any interested party who may so request.

5. Any office which has not notified, with respect to a given international registration, any provisional or final refusal to the International Bureau in accordance with paragraphs 1 and 2 shall, with respect to that international registration, lose the benefit of the right provided for in paragraph 1.

6. Invalidation, by the competent authorities of a contracting party, of the effects, in the territory of that contracting party, of an international registration may not be pronounced without the holder of such international registration having, in good time, been afforded the opportunity of defending his rights. Invalidation shall be notified to the International Bureau.

Article 5bis

Documentary evidence of legitimacy of use of certain elements of the mark

Documentary evidence of the legitimacy of the use of certain elements incorporated in a mark, such as armorial bearings, escutcheons, portraits, honorary distinctions, titles, trade names, names of persons other than the name of the applicant, or other like inscriptions, which might be required by the offices of the contracting parties, shall be exempt from any legalisation as well as from any certification other than that of the office of origin.

Article 5ter

Copies of entries in the International Register; searches for anticipations; extracts from the International Register

1. The International Bureau shall issue to any person applying therefor, upon the payment of a fee fixed by the regulations, a copy of the entries in the International Register concerning a specific mark.

2. The International Bureau may also, upon payment, undertake searches for anticipations among marks that are the subject of international registrations.

3. Extracts from the International Register requested with a view to their production in one of the contracting parties shall be exempt from any legalisation.

Article 6

Period of validity of international registration; dependence and independence of international registration

1. Registration of a mark at the International Bureau is effected for 10 years, with the possibility of renewal under the conditions specified in Article 7.

2. Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.

3. The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if:

(i) an appeal against a decision refusing the effects of the basic application;

(ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration; or

(iii) an opposition to the basic application

results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in item (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

4. The office of origin shall, as prescribed in the regulations, notify the International Bureau of the facts and decisions relevant under paragraph 3, and the International Bureau shall, as prescribed in the regulations, notify the interested parties and effect any publication accordingly. The office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly.

Article 7

Renewal of international registration

1. Any international registration may be renewed for a period of 10 years from the expiry of the preceding period, by the mere payment of the basic fee and, subject to Article 8(7), of the supplementary and complementary fees provided for in Article 8(2).

2. Renewal may not bring about any change in the international registration in its latest form.
3. Six months before the expiry of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration and his representative, if any, of the exact date of expiry.
4. Subject to the payment of a surcharge fixed by the regulations, a period of grace of six months shall be allowed for renewal of the international registration.

Article 8

Fees for international application and registration

1. The office of origin may fix, at its own discretion, and collect, for its own benefit, a fee which it may require from the applicant for international registration or from the holder of the international registration in connection with the filing of the international application or the renewal of the international registration.
2. Registration of a mark at the International Bureau shall be subject to the advance payment of an international fee which shall, subject to the provisions of paragraph 7(a), include:
 - (i) a basic fee;
 - (ii) a supplementary fee for each class of the international classification, beyond three, into which the goods or services to which the mark is applied will fall;
 - (iii) a complementary fee for any request for extension of protection under Article 3ter.
3. However, the supplementary fee specified in paragraph 2(ii) may, without prejudice to the date of the international registration, be paid within the period fixed by the regulations if the number of classes of goods or services has been fixed or disputed by the International Bureau. If, upon expiry of the said period, the supplementary fee has not been paid or the list of goods or services has not been reduced to the required extent by the applicant, the international application shall be deemed to have been abandoned.
4. The annual product of the various receipts from international registration, with the exception of the receipts derived from the fees mentioned in paragraph 2(ii) and (iii), shall be divided equally among the contracting parties by the International Bureau, after deduction of the expenses and charges necessitated by the implementation of this Protocol.
5. The amounts derived from the supplementary fees provided for in paragraph 2(ii) shall be divided, at the expiry of each year, among the interested contracting parties in proportion to the number of marks for which protection has been applied for in each of them during that year, this number being multiplied, in the case of contracting parties which make an examination, by a coefficient which shall be determined by the regulations.
6. The amounts derived from the complementary fees provided for in paragraph 2(iii) shall be divided according to the same rules as those provided for in paragraph 5.
7. (a) Any contracting party may declare that, in connection with each international registration in which it is mentioned under Article 3ter, and in connection with the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary and complementary fees, a fee (hereinafter referred to as the individual fee) whose amount shall be

indicated in the declaration, and can be changed in further declarations, but may not be higher than the equivalent of the amount which the said contracting party's office would be entitled to receive from an applicant for a 10-year registration, or from the holder of a registration for a 10-year renewal of that registration, of the mark in the register of the said office, the said amount being diminished by the savings resulting from the international procedure. Where such an individual fee is payable:

(i) no supplementary fees referred to in paragraph 2(ii) shall be payable if only contracting parties which have made a declaration under this subparagraph are mentioned under Article 3ter; and

(ii) no complementary fee referred to in paragraph 2(iii) shall be payable in respect of any contracting party which has made a declaration under this subparagraph.

(b) Any declaration under subparagraph (a) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organisation having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director-General, or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

Article 9

Recordal of change in the ownership of an international registration

At the request of the person in whose name the international registration stands, or at the request of an interested office made ex officio or at the request of an interested person, the International Bureau shall record in the International Register any change in the ownership of that registration, in respect of all or some of the contracting parties in whose territories the said registration has effect and in respect of all or some of the goods and services has effect and in respect of all or some of the goods and services listed in the registration, provided that the new holder is a person who, under Article 2(1), is entitled to file international applications.

Article 9bis

Recordal of certain matters concerning an international registration

The International Bureau shall record in the International Register:

(i) any change in the name or address of the holder of the international registration;

(ii) the appointment of a representative of the holder of the international registration and any other relevant fact concerning such representative;

(iii) any limitation, in respect of all or some of the contracting parties, of the goods and services listed in the international registration;

(iv) any renunciation, cancellation or invalidation of the international registration in respect of all or some of the contracting parties;

(v) any other relevant fact, identified in the regulations, concerning the rights in a mark that is the subject of an international registration.

Article 9ter

Fees for certain recordals

Any recordal under Article 9 or under Article 9bis may be subject to the payment of a fee.

Article 9quater

Common office of several contracting States

1. If several contracting States agree to effect the unification of their domestic legislation on marks, they may notify the Director-General

(i) that a common office shall be substituted for the national office of each of them, and

(ii) that the whole of their respective territories shall be deemed to be a single State for the purposes of the application of all or part of the provisions preceding this Article as well as the provisions of Articles 9quinquies and 9sexies.

2. Such notification shall not take effect until three months after the date of the communication thereof by the Director-General to the other contracting parties.

Article 9quinquies

Transformation of an international registration into national or regional applications

Where, in the event that the international registration is cancelled at the request of the office of origin under Article 6(4), in respect of all or some of the goods and services listed in the said registration, the person who was the holder of the international registration files an application for the registration of the same mark with the office of any of the contracting parties in the territory of which the international registration had effect, that application shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3ter(2) and, if the international registration enjoyed priority, shall enjoy the same priority, provided that:

(i) such application is filed within three months from the date on which the international registration was cancelled;

(ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the contracting party concerned; and

(iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

Article 9sexies

Safeguard of the Madrid (Stockholm) Agreement

1. Where, with regard to a given international application or a given international registration, the office of origin is the office of a State that is party to both this Protocol and the Madrid (Stockholm) Agreement, the provisions of this Protocol shall have no effect in the territory of any other State that is also party to both this Protocol and the Madrid (Stockholm) Agreement.

2. The Assembly may, by a three-fourths majority, repeal paragraph 1, or restrict the scope of paragraph 1, after the expiry of a period of 10 years from the entry into force of this Protocol, but not before the expiry of a period of five years from the date on which the majority of the countries party to the Madrid (Stockholm) Agreement have become party to this Protocol. In the vote of the Assembly, only those States which are party to both the said Agreement and this Protocol shall have the right to participate.

Article 10

Assembly

1. (a) The contracting parties shall be members of the same Assembly as the countries party to the Madrid (Stockholm) Agreement.
- (b) Each contracting party shall be represented in that Assembly by one delegate, who may be assisted by alternate delegates, advisors, and experts.
- (c) The expenses of each delegation shall be borne by the contracting party which has appointed it, except for the travel expenses and the subsistence allowance of one delegate for each contracting party, which shall be paid from the funds of the Union.
2. The Assembly shall, in addition to the functions which it has under the Madrid (Stockholm) Agreement, also:
 - (i) deal with all matters concerning the implementation of this Protocol;
 - (ii) give directions to the International Bureau concerning the preparation for conferences of revision of this Protocol, due account being taken of any comments made by those countries of the Union which are not party to this Protocol;
 - (iii) adopt and modify the provisions of the regulations concerning the implementation of this Protocol;
 - (iv) perform such other functions as are appropriate under this Protocol.
3. (a) Each contracting party shall have one vote in the Assembly. On matters concerning only countries that are party to the Madrid (Stockholm) Agreement, contracting parties that are not party to the said Agreement shall not have the right to vote, whereas, on matters concerning only contracting parties, only the latter shall have the right to vote.
- (b) One-half of the members of the Assembly which have the right to vote on a given matter shall constitute the quorum for the purposes of the vote on that matter.
- (c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of the members of the Assembly having the right to vote on a given matter which are represented is less than one-half but equal to or more than one-third of the members of the Assembly having the right to vote on that matter, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly having the right to vote on the said matter which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiry of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.
- (d) Subject to the provisions of Articles 5(2)(e), 9sexies(2), Article 12 and Article 13(2), the decisions of the Assembly shall require two-thirds of the votes cast.
- (e) Abstentions shall not be considered as votes.
- (f) A delegate may represent, and vote in the name of, one member of the Assembly only.

4. In addition to meeting in ordinary sessions and extraordinary sessions as provided for by the Madrid (Stockholm) Agreement, the Assembly shall meet in extraordinary session upon convocation by the Director-General, at the request of one-fourth of the members of the Assembly having the right to vote on the matters proposed to be included in the agenda of the session. The agenda of such an extraordinary session shall be prepared by the Director-General.

Article 11

International Bureau

1. International registration and related duties, as well as all other administrative tasks, under or concerning this Protocol, shall be performed by the International Bureau.

2. (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences of revision of this Protocol.

(b) The International Bureau may consult with intergovernmental and international non-governmental organisations concerning preparations for such conferences of revision.

(c) The Director-General and persons designated by him shall take part, without the right to vote, in the discussions at such conferences of revision.

3. The International Bureau shall carry out any other tasks assigned to it in relation to this Protocol.

Article 12

Finances

As far as contracting parties are concerned, the finances of the Union shall be governed by the same provisions as those contained in Article 12 of the Madrid (Stockholm) Agreement, provided that any reference to Article 8 of the said Agreement shall be deemed to be a reference to Article 8 of this Protocol. Furthermore, for the purposes of Article 12(6)(b) of the said Agreement, contracting organisations shall, subject to a unanimous decision to the contrary by the Assembly, be considered to belong to contribution class 1 (one) under the Paris Convention for the protection of industrial property.

Article 13

Amendment of certain Articles of the Protocol

1. Proposals for the amendment of Articles 10, 11, 12, and the present Article, may be initiated by any contracting party, or by the Director-General. Such proposals shall be communicated by the Director-General to the contracting parties at least six months in advance of their consideration by the Assembly.

2. Amendments to the Articles referred to in paragraph 1 shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 10, and to the present paragraph, shall require four-fifths of the votes casts.

3. Any amendment to the Articles referred to in paragraph 1 shall enter into force one month after written notification of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director-General from three-fourths of

those States and intergovernmental organisations which, at the time the amendment was adopted, were members of the Assembly and had the right to vote on the amendment. Any amendment to the said Articles thus accepted shall bind all the States and intergovernmental organisations which are contracting parties at the time the amendment enters into force, or which become contracting parties at a subsequent date.

Article 14

Becoming party to the Protocol; entry into force

1. (a) Any State that is a party to the Paris Convention for the protection of industrial property may become party to this Protocol.

(b) Furthermore, any intergovernmental organisation may also become party to this Protocol where the following conditions are fulfilled:

(i) at least one of the member States of that organisation is a party to the Paris Convention for the protection of industrial property;

(ii) that organisation has a regional office for the purposes of registering marks with effect in the territory of the organisation, provided that such office is not the subject of a notification under Article 9quater.

2. Any State or organisation referred to in paragraph 1 may sign this Protocol. Any such State or organisation may, if it has signed this Protocol, deposit an instrument of ratification, acceptance or approval of this Protocol or, if it has not signed this Protocol, deposit an instrument of accession to this Protocol.

3. The instruments referred to in paragraph 2 shall be deposited with the Director-General.

4. (a) This Protocol shall enter into force three months after four instruments of ratification, acceptance, approval or accession have been deposited, provided that at least one of those instruments has been deposited by a country party to the Madrid (Stockholm) Agreement and at least one other of those instruments has been deposited by a State not party to the Madrid (Stockholm) Agreement or by any of the organisations referred to in paragraph 1(b).

(b) With respect to any other State or organisation referred to in paragraph 1, this Protocol shall enter into force three months after the date on which its ratification, acceptance, approval or accession has been notified by the Director-General.

5. Any State or organisation referred to in paragraph 1 may, when depositing its instrument of ratification, acceptance or approval of, or accession to, this Protocol, declare that the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it.

Article 15

Denunciation

1. This Protocol shall remain in force without limitation as to time.

2. Any contracting party may denounce this Protocol by notification addressed to the Director-General.

3. Denunciation shall take effect one year after the day on which the Director-General has received the notification.

4. The right of denunciation provided for by this Article shall not be exercised by any contracting party before the expiry of five years

from the date upon which this Protocol entered into force with respect to that contracting party.

5. (a) Where a mark is the subject of an international registration having effect in the denouncing State or intergovernmental organisation at the date on which the denunciation becomes effective, the holder of such registration may file an application for the registration of the same mark with the office of the denouncing State or intergovernmental organisation, which shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3ter(2) and, if the international registration enjoyed priority, enjoy the same priority, provided that:

(i) such application is filed within two years from the date on which the denunciation became effective;

(ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the denouncing State or intergovernmental organisation; and

(iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

(b) The provisions of subparagraph (a) shall also apply in respect of any mark that is the subject of an international registration having effect in contracting parties other than the denouncing State or intergovernmental organisation at the date on which denunciation becomes effective and whose holder, because of the denunciation, is no longer entitled to file international applications under Article 2 (1).

Article 16

Signature; languages; depository functions

1. (a) This Protocol shall be signed in a single copy in the English, French and Spanish languages, and shall be deposited with the Director-General when it ceases to be open for signature at Madrid. The texts in the three languages shall be equally authentic.

(b) Official texts of this Protocol shall be established by the Director-General, after consultation with the interested governments and organisations, in the Arabic, Chinese, German, Italian, Japanese, Portuguese and Russian languages, and in such other languages as the Assembly may designate.

2. This Protocol shall remain open for signature at Madrid until 31 December 1989.

3. The Director-General shall transmit two copies, certified by the Government of Spain, of the signed texts of this Protocol to all States and intergovernmental organisations that may become party to this Protocol.

4. The Director-General shall register this Protocol with the Secretariat of the United Nations.

5. The Director-General shall notify all States and international organisations that may become or are party to this Protocol of signatures, deposits of instruments of ratification, acceptance, approval or accession, the entry into force of this protocol and any amendment thereto, any notification of denunciation and any declaration provided for in this Protocol.

Declaration

on the individual fee system

The President of the Council, when depositing this instrument of accession with the Director-General of WIPO, shall attach the following

declaration to the instrument of accession:

"The European Community declares that, in connection with each international registration in which it is mentioned under Article 3ter(1) or (2) of the Madrid Protocol, and in connection with the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary fee and complementary fee,

for an individual mark:

- a designation fee of EUR 1875 plus, where applicable, EUR 400 for each class of goods or services exceeding three, or, where applicable,

- a renewal fee of EUR 2300 plus, where applicable, EUR 500 for each class of goods or services exceeding three;

for a collective mark:

- a designation fee of EUR 3675 plus, where applicable, EUR 800 for each class of goods or services exceeding three, or where applicable,

- a renewal fee of EUR 4800 plus, where applicable, EUR 1000 for each class of goods or services exceeding three."

Notification

on the conversion of a designation of the European Community into designations of its Member States

The President of the Council, when depositing this instrument of accession with the Director-General of WIPO, shall attach the following notification to the instrument of accession:

"The European Community declares that, where a designation of the European Community has been recorded in the International Register, that designation may, to the extent that it has been refused or ceases to have effect, be converted into the designation of any of its Member States, provided that the conditions as set out in Article 154 of the Regulation on the Community trade mark, as amended and the relevant provisions under the Madrid Agreement and Protocol are met."

Declaration

from the European Community to the International Bureau on the period for the notification of the refusal of protection in the territory of a contracting party(1)

The European Community hereby declares that, pursuant to Article 5(2)(b) of the Protocol relating to the Madrid Agreement concerning the international registration of marks (1989), the period of one year to exercise the right to notify the refusal of protection referred to in Article 5(2)(a) thereof is replaced by a period of 18 months.

(1) The European Community notes that its intention is that the present declaration be of a temporary nature only. It will be withdrawn when the elements which justify it have come to an end.

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**Council Regulation (EC) No 422/2004
of 19 February 2004
amending Regulation (EC) No 40/94 on the Community **trade mark** (Text with EEA relevance)**

Council Regulation (EC) No 422/2004

of 19 February 2004

amending Regulation (EC) No 40/94 on the Community trade mark

(Text with EEA relevance)

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 308 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Parliament(1),

Having regard to the opinion of the European Economic and Social Committee(2),

Whereas:

- (1) Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark(3), set up a unitary system of protection of trade marks throughout the Member States via Community registration. This system has generally fulfilled users' expectations satisfactorily. It has also had a positive effect on the effective achievement of the internal market.
- (2) The functioning of the system has made it possible to identify other aspects which could clarify and further supplement it, thereby making it possible to improve the effectiveness of the system, increase the value it adds and anticipate, as of now, the consequences of additional members in future, without it being necessary to change the substance of the system, which has proven itself to be perfectly valid with regard to the objectives set.
- (3) The Community trade mark system should be made accessible to all, without any requirement of reciprocity, equivalence and/or nationality. This would also encourage trade on the world market. Such requirements make the system complex, inflexible and ineffective. In addition, in the context of the new Community design system, the Council took a flexible line on this question.
- (4) In order to rationalise the procedure, the search system should be amended. It should remain compulsory for Community trade marks, but it should be made optional, subject to the payment of a fee, for searches in the trade mark registers of the Member States which notified their own decision to carry out such a search. Furthermore, measures should be provided with a view to improving the quality of the search reports, ensuring greater uniformity by using a standard form and laying down their essential contents.
- (5) Certain measures should be taken in order to give the Boards of Appeal additional means of speeding up their decisions and improving their operation.
- (6) The experience acquired in the application of the system highlighted the possibility of improving certain aspects of the procedure. Consequently, certain points should be amended and others inserted in order to offer users a higher-quality product which is still competitive,

HAS ADOPTED THIS REGULATION:

Article 1

Regulation (EC) No 40/94 is hereby amended as follows:

1. Article 5 shall be replaced by the following:

"Article 5

Persons who can be proprietors of Community trade marks

Any natural or legal person, including authorities established under public law, may be the proprietor of a Community trade mark.";

2. in Article 7(1), the following point shall be added:

"(k) trade marks which contain or consist of a designation of origin or a geographical indication registered in accordance with Regulation (EEC) No 2081/92 when they correspond to one of the situations covered by Article 13 of the said Regulation and regarding the same type of product, on condition that the application for registration of the trade mark has been submitted after the date of filing with the Commission of the application for registration of the designation of origin or geographical indication.";

3. In Article 8(4), the introductory subparagraph shall be replaced by the following:

"4. Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:";

4. Article 21 shall be replaced by the following:

"Article 21

Insolvency proceedings

1. The only insolvency proceedings in which a Community trade mark may be involved are those opened in the Member State in the territory of which the debtor has his centre of main interests.

However, where the debtor is an insurance undertaking or a credit institution as defined in Directives 2001/17/EC(4) and 2001/24/EC(5), respectively, the only insolvency proceedings in which a Community trademark may be involved are those opened in the Member State where that undertaking or institution has been authorised.

2. In the case of joint proprietorship of a Community trade mark, paragraph 1 shall apply to the share of the joint proprietor.

3. Where a Community trade mark is involved in insolvency proceedings, on request of the competent national authority an entry to this effect shall be made in the Register and published in the Community Trade Marks Bulletin referred to in Article 85.";

5. Article 25(3) shall be replaced by the following:

"3. Applications referred to in paragraph 2 which reach the Office more than two months after filing shall be deemed to have been filed on the date on which the application reached the Office.";

6. Article 35(1) shall be replaced by the following:

"1. The proprietor of a Community trade mark who is the proprietor of an earlier identical trade

mark registered in a Member State, including a trade mark registered in the Benelux countries or of an earlier identical trade mark, with an international registration effective in a Member State, for goods or services which are identical to those for which the earlier trade mark has been registered, or contained within them, may claim the seniority of the earlier trade mark in respect of the Member State in or for which it was registered.";

7. Article 36(1)(b) shall be replaced by the following:

"(b) the Community trade mark application complies with the conditions laid down in this Regulation and with the conditions laid down in the Implementing Regulation.";

8. Article 37 shall be deleted;

9. Article 39 shall be replaced by the following:

"Article 39

Search

1. Once the Office has accorded a date of filing, it shall draw up a Community search report citing those earlier Community trade marks or Community trade mark applications discovered which may be invoked under Article 8 against the registration of the Community trade mark applied for.

2. Where, at the time of filing a Community trade mark application, the applicant requests that a search report also be prepared by the central industrial property offices of the Member States and where the appropriate search fee has been paid within the time-limit for the payment of the filing fee, the Office shall, as soon as a Community trade mark application has been accorded a date of filing, transmit a copy thereof to the central industrial property office of each Member State which has informed the Office of its decision to operate a search in its own register of trade marks in respect of Community trade mark applications.

3. Each of the central industrial property offices referred to in paragraph 2 shall communicate to the Office within two months as from the date on which it received the Community trade mark application a search report which shall either cite those earlier national trade marks or trade mark applications discovered which may be invoked under Article 8 against the registration of the Community trade mark applied for, or state that the search has revealed no such rights.

4. The search reports referred to in paragraph 3 shall be prepared on a standard form drawn up by the Office, after consulting the Administrative Board. The essential contents of this form shall be set out in the Implementing Regulation provided for in Article 157(1).

5. An amount shall be paid by the Office to each central industrial property office for each search report provided by that office in accordance with paragraph 3. The amount, which shall be the same for each office, shall be fixed by the Budget Committee by means of a decision adopted by a majority of three-quarters of the representatives of the Member States.

6. The Office shall transmit without delay to the applicant for the Community trade mark the Community search report and any requested national search reports received within the time limit laid down in paragraph 3.

7. Upon publication of the Community trade mark application, which may not take place before the expiry of a period of one month as from the date on which the Office transmits the search reports to the applicant, the Office shall inform the proprietors of any earlier Community trade marks or Community trade mark applications cited in the Community search report of the publication of the Community trade mark application.";

10. Article 40 shall be replaced by the following:

"Article 40

Publication of the application

1. If the conditions which the application for a Community trade mark must satisfy have been fulfilled and if the period referred to in Article 39(7) has expired, the application shall be published to the extent that it has not been refused pursuant to Article 38.

2. Where, after publication, the application is refused under Article 38, the decision that it has been refused shall be published upon becoming final.";

11. in Title IV, the title of Section 5 shall be replaced by the following:

"WITHDRAWAL, RESTRICTION, AMENDMENT AND DIVISION OF THE APPLICATION";

12. the following Article shall be inserted:

"Article 44a

Division of the application

1. The applicant may divide the application by declaring that some of the goods or services included in the original application will be the subject of one or more divisional applications. The goods or services in the divisional application shall not overlap with the goods or services which remain in the original application or those which are included in other divisional applications.

2. The declaration of division shall not be admissible:

- (a) if, where an opposition has been entered against the original application, such a divisional application has the effect of introducing a division amongst the goods or services against which the opposition has been directed, until the decision of the Opposition Division has become final or the opposition proceedings are finally terminated otherwise;
- (b) during the periods laid down in the Implementing Regulation.

3. The declaration of division must comply with the provisions set out in the Implementing Regulation.

4. The declaration of division shall be subject to a fee. The application shall be deemed not to have been made until the fee has been paid.

5. The division shall take effect on the date on which it is recorded in the files kept by the Office concerning the original application.

6. All requests and applications submitted and all fees paid with regard to the original application prior to the date on which the Office receives the declaration of division are deemed also to have been submitted or paid with regard to the divisional application or applications. The fees for the original application which have been duly paid prior to the date on which the declaration of division is received shall not be refunded.

7. The divisional application shall preserve the filing date and any priority date and seniority date of the original application.";

13. the title of Title V shall be replaced by the following:

"DURATION, RENEWAL, ALTERATION AND DIVISION OF COMMUNITY TRADE MARKS";

14. the following Article shall be inserted:

"Article 48a

Division of the registration

1. The proprietor of the Community trade mark may divide the registration by declaring that some of the goods or services included in the original registration will be the subject of one or more divisional registrations. The goods or services in the divisional registration shall not overlap with the goods or services which remain in the original registration or those which are included in other divisional registrations.

2. The declaration of division shall not be admissible:

- (a) if, where an application for revocation of rights or for a declaration of invalidity has been entered against the original registration, such a divisional declaration has the effect of introducing a division amongst the goods or services against which the application for revocation of rights or for a declaration of invalidity is directed, until the decision of the Cancellation Division has become final or the proceedings are finally terminated otherwise;
- (b) if, where a counterclaim for revocation or for a declaration of invalidity has been entered in a case before a Community trade mark court, such a divisional declaration has the effect of introducing a division amongst the goods or services against which the counterclaim is directed, until the mention of the Community trade mark court's judgement is recorded in the Register pursuant to Article 96(6).

3. The declaration of division must comply with the provisions set out in the Implementing Regulation.

4. The declaration of division shall be subject to a fee. The declaration shall be deemed not to have been made until the fee has been paid.

5. The division shall take effect on the date on which it is entered in the Register.

6. All requests and applications submitted and all fees paid with regard to the original registration prior to the date on which the Office receives the declaration of division shall be deemed also to have been submitted or paid with regard to the divisional registration or registrations. The fees for the original registration which have been duly paid prior to the date on which the declaration of division is received shall not be refunded.

7. The divisional registration shall preserve the filing date and any priority date and seniority date of the original registration.";

15. in Article 50(1), point (d) shall be deleted;

16. Article 51(1)(a) shall be replaced by the following:

"(a) where the Community trade mark has been registered contrary to the provisions of Article 7;"

17. Article 52(2) shall be replaced by the following:

"2. A Community trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right, and in particular:

- (a) a right to a name;
- (b) a right of personal portrayal;
- (c) a copyright;
- (d) an industrial property right;

under the Community legislation or national law governing the protection.";

18. Article 56(6) shall be replaced by the following:

"6. A record of the Office's decision on the application for revocation of rights or for a declaration of invalidity shall be entered in the Register once it has become final.";

19. Article 60 shall be replaced by the following:

"Article 60

Revision of decisions in ex parte cases

1. If the party which has lodged the appeal is the sole party to the procedure, and if the department whose decision is contested considers the appeal to be admissible and well founded, the department shall rectify its decision.

2. If the decision is not rectified within one month after receipt of the statement of grounds, the appeal shall be remitted to the Board of Appeal without delay, and without comment as to its merit.";

20. the following Article shall be inserted:

"Article 60a

Revision of decisions in inter partes cases

1. Where the party which has lodged the appeal is opposed by another party and if the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision.

2. The decision may only be rectified if the department whose decision is contested notifies the other party of its intention to rectify it, and that party accepts it within two months of the date on which it received the notification.

3. If, within two months of receiving the notification referred to in paragraph 2, the other party does not accept that the contested decision is to be rectified and makes a declaration to that effect or does not make any declaration within the period laid down, the appeal shall be remitted to the Board of Appeal without delay, and without comment as to its merit.

4. However, if the department whose decision is contested does not consider the appeal to be admissible and well founded within one month after receipt of the statement of grounds, it shall, instead of taking the measures provided for in paragraphs 2 and 3, remit the appeal to the Board of Appeal without delay, and without comment as to its merit.";

21. the following Article shall be inserted:

"Article 77a

Revocation of decisions

1. Where the Office has made an entry in the Register or taken a decision which contains an obvious procedural error attributable to the Office, it shall ensure that the entry is cancelled or the decision is revoked. Where there is only one party to the proceedings and the entry or the act affects its rights, cancellation or revocation shall be determined even if the error was not evident to the party.

2. Cancellation or revocation as referred to in paragraph 1 shall be determined, ex officio or at the request of one of the parties to the proceedings, by the department which made the entry or took the decision. Cancellation or revocation shall be determined within six months from the date on which the entry was made in the Register or the decision was taken, after consultation with the parties to the proceedings and any proprietor of rights to the Community trade mark in question that are entered in the Register.

3. This Article shall be without prejudice to the right of the parties to submit an appeal under Articles 57 and 63, or to the possibility, under the procedures and conditions laid down by the Implementing Regulation referred to in Article 157(1), of correcting any linguistic errors or errors of transcription and obvious errors in the Office's decisions or errors attributable to the Office in registering the trade mark or in publishing its registration.";

22. Article 78(5) shall be replaced by the following:

"5. This Article shall not be applicable to the time limits referred to in paragraph 2 of this Article, Article 42(1) and (3) and Article 78a.";

23. the following Article shall be inserted:

"Article 78a

Continuation of proceedings

1. An applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office who has omitted to observe a time limit vis-à-vis the Office may, upon request, obtain the continuation of proceedings, provided that at the time the request is made the omitted act has been carried out. The request for continuation of proceedings shall be admissible only if it is presented within two months following the expiry of the unobserved time limit. The request shall not be deemed to have been filed until the fee for continuation of the proceedings has been paid.

2. This Article shall not be applicable to the time limits laid down in Article 25(3), Article 27, Article 29(1), Article 33(1), Article 36(2), Article 42, Article 43, Article 47(3), Article 59, Article 60a, Article 63(5), Article 78, Article 108, or to the time limits laid down in this Article or the time limits laid down by the Implementing Regulation referred to in Article 157(1) for claiming priority within the meaning of Article 30, exhibition priority within the meaning of Article 33 or seniority within the meaning of Article 34 after the application has been filed.

3. The department competent to decide on the omitted act shall decide upon the application.

4. If the Office accepts the application, the consequences of having failed to observe the time limit shall be deemed not to have occurred.

5. If the Office rejects the application, the fee shall be refunded.";

24. Article 81(6) shall be replaced by the following:

"6. The Opposition Division or Cancellation Division or Board of Appeal shall fix the amount of the costs to be paid pursuant to the preceding paragraphs when the costs to be paid are limited to the fees paid to the Office and the representation costs. In all other cases, the registry of the Board of Appeal or a member of the staff of the Opposition Division or Cancellation Division shall fix the amount of the costs to be reimbursed on request. The request is admissible only within two months of the date on which the decision for which an application was made for the costs to be fixed became final. The amount so determined may be reviewed by a decision of the Opposition Division or Cancellation Division or Board of Appeal on a request filed within the prescribed period.";

25. Article 88 shall be amended as follows:

(a) the first sentence of paragraph 3 shall be replaced by the following:"Natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the Office by an employee.";

(b) the following paragraph shall be added:

"4. The Implementing Regulation shall specify whether and under what conditions an employee must file with the Office a signed authorisation for insertion on the file.";

26. Article 89 shall be amended as follows:

(a) in paragraph 1, point b shall be replaced by the following:

"(b) professional representatives whose names appear on the list maintained for this purpose by the Office. The Implementing Regulation shall specify whether and under what conditions the representatives before the Office must file with the Office a signed authorisation for insertion on the file.";

(b) in paragraph 2(c) the first sentence shall be replaced by the following:

"(c) he must be entitled to represent natural or legal persons in trade mark matters before the central industrial property office of a Member State.";

27. Article 96(5) shall be replaced by the following:

"5. Article 56(2) to (5) shall apply.";

28. in Article 108 paragraphs 4, 5 and 6 shall be replaced by the following:

"4. In cases where a Community trade mark application is deemed to be withdrawn, the Office shall send to the applicant a communication fixing a period of three months from the date of that communication in which a request for conversion may be filed.

5. Where the Community trade mark application is withdrawn or the Community trade mark ceases to have effect as a result of a surrender being recorded or of failure to renew the registration, the request for conversion shall be filed within three months after the date on which the Community trade mark application has been withdrawn or on which the Community trade mark ceases to have effect.

6. Where the Community trade mark application is refused by decision of the Office or where the Community trade mark ceases to have effect as a result of a decision of the Office or of a Community trade mark court, the request for conversion shall be filed within three months after the date on which that decision acquired the authority of a final decision.";

29. Article 109(3) shall be replaced by the following:

"3. The Office shall check whether the conversion requested fulfils the conditions set out in this Regulation, in particular Article 108(1), (2), (4), (5) and (6), and paragraph 1 of this Article, together with the formal conditions laid down in the Implementing Regulation. If these conditions are fulfilled, the Office shall transmit the request for conversion to the industrial property offices of the Member States specified therein.";

30. Article 110(1) shall be replaced by the following:

"1. Any central industrial property office to which the request for conversion is transmitted may obtain from the Office any additional information concerning the request enabling that office to make a decision regarding the national trade mark resulting from the conversion.";

31. in the second sentence of Article 118(3), the phrase "within 15 days" shall be replaced by the phrase "within one month"and, in the third sentence, the phrase "within one month" shall be replaced by the phrase "within three months";

32. Article 127(2) shall be replaced by the following:

"2. The decisions of the Opposition Divisions shall be taken by three-member groups. At least one member shall be legally qualified. In certain specific cases provided for in the Implementing

Regulation, the decisions shall be taken by a single member.";

33. Article 129(2) shall be replaced by the following:

"2. The decisions of the Cancellation Divisions shall be taken by three-member groups. At least one member shall be legally qualified. In certain specific cases provided for in the Implementing Regulation, the decisions shall be taken by a single member.";

34. Article 130 shall be amended as follows:

(a) paragraph 2 shall be replaced by the following:

"2. The decisions of the Boards of Appeal shall be taken by three members, at least two of whom are legally qualified. In certain specific cases, decisions shall be taken by an enlarged Board chaired by the President of the Boards of Appeal or by a single member, who must be legally qualified.";

(b) the following paragraphs shall be added:

"3. In order to determine the special cases which fall under the jurisdiction of the enlarged Board, account should be taken of the legal difficulty or the importance of the case or of special circumstances which justify it. Such cases may be referred to the enlarged Board:

(a) by the authority of the Boards of Appeal set up in accordance with the rules of procedure of the Boards referred to in Article 157(3), or

(b) by the Board handling the case.

4. The composition of the enlarged Board and the rules on referrals to it shall be laid down pursuant to the rules of procedure of the Boards referred to in Article 157(3).

5. To determine which specific cases fall under the authority of a single member, account should be taken of the lack of difficulty of the legal or factual matters raised, the limited importance of the individual case or the absence of other specific circumstances. The decision to confer a case on one member in the cases referred to shall be adopted by the Board handling the case. Further details shall be laid down in the rules of procedure of the Boards referred to in Article 157(3).";

35. Article 131 shall be replaced by the following:

"Article 131

Independence of the members of the Boards of Appeal

1. The President of the Boards of Appeal and the chairmen of the Boards shall be appointed, in accordance with the procedure laid down in Article 120 for the appointment of the President of the Office, for a term of five years. They may not be removed from office during this term, unless there are serious grounds for such removal and the Court of Justice, on application by the institution which appointed them, takes a decision to this effect. The term of office of the President of Boards of Appeal and the chairmen of the Boards may be renewed for additional five-year periods, or until retirement age if this age is reached during the new term of office.

The President of the Boards of Appeal shall, inter alia, have managerial and organisational powers, principally to:

(a) chair the authority of the Boards of Appeal responsible for laying down the rules and organising the work of the Boards, which authority is provided for in the rules of procedure of the Boards referred to in Article 157(3);

(b) ensure the implementation of the authority's decisions;

- (c) allocate cases to a Board on the basis of objective criteria determined by the authority of the Boards of Appeal;
- (d) forward to the President of the Office the Boards' expenditure requirements, with a view to drawing up the expenditure estimates.

The President of the Boards of Appeal shall chair the enlarged Board.

Further details shall be laid down in the rules of procedure of the Boards referred to in Article 157(3).

2. The members of the Boards of Appeal shall be appointed by the Administrative Board for a term of five years. Their term of office may be renewed for additional five-year periods, or until retirement age if that age is reached during the new term of office.

3. The members of the Boards of Appeal may not be removed from office unless there are serious grounds for such removal and the Court of Justice, after the case has been referred to it by the Administrative Board on the recommendation of the President of the Boards of Appeal, after consulting the chairman of the Board to which the member concerned belongs, takes a decision to this effect.

4. The President of the Boards of Appeal and the chairmen and members of the Boards of Appeal shall be independent. In their decisions they shall not be bound by any instructions.

5. The President of the Boards of Appeal and the chairmen and members of the Boards of Appeal may not be examiners or members of the Opposition Divisions, Administration of Trade Marks and Designs and Legal Division or Cancellation Divisions.";

36. Article 142a shall become Article 159a;

37. in Article 150, paragraph 3 shall be replaced by the following:

"3. Article 39(3) to (6) shall apply mutatis mutandis.";

38. In Article 157(2), points (1) and (4) shall be deleted.

Article 2

1. This Regulation shall enter into force on the day following that of its publication in the Official Journal of the European Union.

2. Points 11 to 14, 21, 23 to 26 and 32 to 36 of Article 1 shall apply from a date which shall be laid down by the Commission and published in the Official Journal of the European Union, when the necessary implementing measures have been adopted.

3. Point 9 of Article 1 shall apply from 10 March 2008.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 19 February 2004.

For the Council

The President

M. McDowell

- (1) Opinion delivered on 23 September 2003 (not yet published in the Official Journal).
- (2) OJ C 208, 3.9.2003, p. 7.

- (3) OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Regulation (EC) No 1992/2003 (OJ L 296, 14.11.2003, p. 1).
- (4) Directive 2001/17/EC of the European Parliament and of the Council of 19 March 2001 on the reorganisation and winding-up of insurance undertakings (OJ L 110, 20.4.2001, p. 28).
- (5) Directive 2001/24/EC of the European Parliament and of the Council of 4 April 2001 on the reorganisation and winding up of credit institutions (OJ L 125, 5.5.2001, p. 15).

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Information regarding the date from which Article 1(34) and (35) of Council Regulation (EC) No 422/2004 amending Regulation (EC) No 40/94 on the Community **trade mark shall apply**

Information regarding the date from which Article 1(34) and (35) of Council Regulation (EC) No 422/2004 amending Regulation (EC) No 40/94 on the Community trade mark shall apply

Article 1(34) and (35) of Council Regulation (EC) No 422/2004 of 19 February 2004 amending Regulation (EC) No 40/94 on the Community trade mark shall apply from the date of entry into force of Commission Regulation (EC) No 2082/2004 of 6 December 2004 [1] amending Regulation (EC) No 216/96 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs).

[1] OJ L 360, 7.12.2004, p. 8.

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**Commission Regulation (EC) No 2868/95
of 13 December 1995
implementing Council Regulation (EC) No 40/94 on the Community **trade mark****

COMMISSION REGULATION (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (1) as amended by Regulation (EC) No 3288/94 (2), and in particular Article 140 thereof,

Whereas Regulation (EC) No 40/94 (hereinafter 'the Regulation') creates a new trade mark system allowing a trade mark having effect throughout the Community to be obtained on the basis of an application to the Office for Harmonization in the Internal Market (trade marks and designs) ('the Office');

Whereas for this purpose, the Regulation contains the necessary provisions for a procedure leading to the registration of a Community trade mark, as well as for the administration of Community trade marks, for appeals against decisions of the Office and for proceedings for the revocation or invalidation of a Community trade mark;

Whereas Article 140 of the Regulation provides that the rules implementing the Regulation shall be adopted in an implementing regulation;

Whereas the implementing regulation is to be adopted in accordance with the procedure laid down in Article 141 of the Regulation;

Whereas this implementing regulation therefore lays down the rules necessary for implementing the provisions of the Regulation on the Community trade mark;

Whereas these rules should ensure the smooth and efficient operating of trade mark proceedings before the Office;

Whereas in accordance with Article 116 (1) of the Regulation, all the elements of the application for a Community trade mark specified in its Article 26 (1) as well as any other information the publication of which is prescribed by this implementing regulation should be published in all the official languages of the Community;

Whereas, however, it is not appropriate for the trade mark itself, names, addresses, dates and any other similar data to be translated and published in all the official languages of the Community;

Whereas the Office should make available standard forms for proceedings before the Office in all official languages of the Community;

Whereas the measures envisaged in this Regulation are in accordance with the opinion of the Committee established under Article 141 of the Regulation,

HAS ADOPTED THIS REGULATION:

Article 1

The rules implementing the Regulation shall be as follows:

TITLE I

APPLICATION PROCEDURE

Rule 1

Content of the application

- (1) The application for a Community trade mark shall contain:
 - (a) a request for registration of the mark as a Community trade mark;
 - (b) the name, address and nationality of the applicant and the State in which he is domiciled or has his seat or an establishment. Names of natural persons shall be indicated by the person's family name and given name(s). Names of legal entities, as well as bodies falling under Article 3 of the Regulation, shall be indicated by their official designation, which may be abbreviated in a customary manner; furthermore, the law of the State governing them shall be indicated. The telegraphic and teletype address, telephone as well as fax numbers and details of other data communications links may be given. Only one address shall, in principle, be indicated for each applicant; where several addresses are indicated, only the address mentioned first shall be taken into account, except where the applicant designates one of the addresses as an address for service;
 - (c) a list of the goods and services for which the trade mark is to be registered, in accordance with Rule 2;
 - (d) a representation of the mark in accordance with Rule 3;
 - (e) if the applicant has appointed a representative, his name and the address of his place of business in accordance with point (b); if the representative has more than one business address or if there are two or more representatives with different business addresses, the application shall indicate which address shall be used as an address for service; where such an indication is not made, only the first-mentioned address shall be taken into account as an address for service;
 - (f) where the priority of a previous application is claimed pursuant to Article 30 of the Regulation, a declaration to that effect, stating the date on which and the country in or for which the previous application was filed;
 - (g) where exhibition priority is claimed pursuant to Article 33 of the Regulation, a declaration to that effect, stating the name of the exhibition and the date of the first display of the goods or services;
 - (h) where the seniority of one or more earlier trade marks, registered in a Member State, including a trade mark registered in the Benelux countries or registered under international arrangements having effect in a Member State (hereinafter referred to as 'earlier registered trade marks, as referred to in Article 34 of the Regulation') is claimed pursuant to Article 34 of the Regulation, a declaration to that effect, stating the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration, and the goods and services for which the mark is registered;
 - (i) where applicable, a statement that the application is for registration of a Community collective mark pursuant to Article 64 of the Regulation;
 - (j) specification of the language in which the application has been filed, and of the second language pursuant to Article 115 (3) of the Regulation;
 - (k) the signature of the applicant or his representative.
- (2) The application for a Community collective mark may include the regulations governing its use.
- (3) The application may include a statement by the applicant that he disclaims any exclusive right

to an element of the trade mark which is not distinctive, to be specified by the applicant.

- (4) If there is more than one applicant, the application may contain the appointment of one applicant or representative as common representative.

Rule 2

List of goods and services

- (1) The common classification referred to in Article 1 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, shall be applied to the classification of the goods and services.
- (2) The list of goods and services shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification.
- (3) The goods and services shall, in principle, be grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes under that Classification.
- (4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

Rule 3

Representation of the mark

- (1) If the applicant does not wish to claim any special graphic feature or colour, the mark shall be reproduced in normal script, as for example, by typing the letters, numerals and signs in the application. The use of small letters and capital letters shall be permitted and shall be followed accordingly in publications of the mark and in the registration by the Office.
- (2) In cases other than those referred to in paragraph 1, the mark shall be reproduced on a sheet of paper separate from the sheet on which the text of the application appears. The sheet on which the mark is reproduced shall not exceed DIN A4 size (29,7 cm high, 21 cm wide) and the space used for the reproduction (type-area) shall not be larger than 26,2 cm x 17 cm. A margin of at least 2,5 cm shall be left on the left-hand side. Where it is not obvious, the correct position of the mark shall be indicated by adding the word 'top` to each reproduction. The reproduction of the mark shall be of such quality as to enable it to be reduced or enlarged to a size not more than 8 cm wide by 16 cm high for publication in the Community Trade Mark Bulletin. The separate sheet shall also indicate the name and address of the applicant. Four copies of the separate sheet carrying the reproduction shall be filed.
- (3) In cases to which paragraph 2 applies, the application shall contain an indication to that effect. The application may contain a description of the mark.
- (4) Where registration of a three-dimensional mark is applied for, the application shall contain an indication to that effect. The representation shall consist of a photographic reproduction or a graphic representation of the mark. The representation may contain up to six different perspectives of the mark.
- (5) Where registration in colour is applied for, the application shall contain an indication to

that effect. The colours making up the mark shall also be indicated. The reproduction under paragraph 2 shall consist of the colour reproduction of the mark.

- (6) The President of the Office may determine that, as far as the requirements of paragraph 2 are concerned, the mark may be reproduced in the text of the application itself and not on a separate sheet of paper and that the the number of copies of the reproduction of the mark may be less than four.

Rule 4

Fees for the application

The fees payable for the application shall be:

- (a) the basic fee;

and

- (b) a class fee for each class exceeding three to which the goods or services belong according to Rule 2.

Rule 5

Filing of the application

- (1) The Office shall mark the documents making up the application with the date of its receipt and the file number of the application. The Office shall issue to the applicant without delay a receipt which shall include at least the file number, a representation, description or other identification of the mark, the nature and the number of the documents and the date of their receipt.
- (2) If the application is filed with the central industrial property office of a Member State or at the Benelux Trade Mark Office in accordance with Article 25 of the Regulation, the office of filing shall number all the pages of the application with arabic numerals. Before forwarding, the office of filing shall mark the documents making up the application with the date of receipt and the number of pages. The office of filing shall issue to the applicant without delay a receipt which shall include at least the nature and the number of the documents and the date of their receipt.
- (3) If the Office receives an application forwarded by the central industrial property office of a Member State or the Benelux Trade Mark Office, it shall mark the application with the date of receipt and the file number and shall issue to the applicant without delay a receipt in accordance with the second sentence of paragraph 1, indicating the date of receipt at the Office.

Rule 6

Claiming priority

- (1) Where the priority of one or more previous applications pursuant to Article 30 of the Regulation is claimed in the application, the applicant shall indicate the file number of the previous application and file a copy of it within three months from the filing date. The copy shall be certified to be an exact copy of the previous application by the authority which received the previous application, and shall be accompanied by a certificate issued by that authority stating the date of filing of the previous application.
- (2) Where the applicant wishes to claim the priority of one or more previous applications pursuant to Article 30 of the Regulation subsequent to the filing of the application, the declaration of priority, stating the date on which and the country in or for which the previous application

was made, shall be submitted within a period of two months from the filing date. The indications and evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of priority.

- (3) If the language of the previous application is not one of the languages of the Office, the Office shall require the applicant to file, within a period specified by the Office, which shall be not less than three months, a translation of the previous application into one of these languages.
- (4) The President of the Office may determine that the evidence to be provided by the applicant may consist of less than is required under paragraph 1, provided that the information required is available to the Office from other sources.

Rule 7

Exhibition priority

- (1) Where the exhibition priority pursuant to Article 33 of the Regulation has been claimed in the application, the applicant shall, within three months from the filing date, file a certificate issued at the exhibition by the authority responsible for the protection of industrial property at the exhibition. This certificate shall declare that the mark was in fact used for the goods or services, and shall state the opening date of the exhibition and, where the first public use did not coincide with the opening date of the exhibition, the date of such first public use. The certificate must be accompanied by an identification of the actual use of the mark, duly certified by the abovementioned authority.
- (2) Where the applicant wishes to claim an exhibition priority subsequently to the filing of the application, the declaration of priority, indicating the name of the exhibition and the date of the first display of the goods or services, shall be submitted within a period of two months from the filing date. The indications and evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of priority.

Rule 8

Claiming the seniority of a national trade mark

- (1) Where the seniority of one or more earlier registered trade marks, as referred to in Article 34 of the Regulation, has been claimed in the application, the applicant shall, within three months from the filing date, submit a copy of the relevant registration. The copy must be certified by the competent authority to be an exact copy of the relevant registration.
- (2) Where the applicant wishes to claim the seniority of one or more earlier registered trade marks as referred to in Article 34 of the Regulation, subsequent to the filing of the application, the declaration of seniority, indicating the Member State or Member States in or for which the mark is registered, the date from which the relevant registration was effective, the number of the relevant registration, and the goods and services for which the mark is registered, shall be submitted within a period of two months from the filing date. The evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of seniority.
- (3) The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the effective claiming of seniority.
- (4) The President of the Office may determine that the evidence to be provided by the applicant may consist of less than is required under paragraph 1, provided that the information required is available to the Office from other sources.

Rule 9

Examination of requirements for a filing date and of formal requirements

(1) If the application fails to meet the requirements for according a filing date because:

(a) the application does not contain:

(i) a request for registration of the mark as a Community trade mark;

(ii) information identifying the applicant;

(iii) a list of the goods and services for which the mark is to be registered;

iv) a representation of the trade mark; or

(b) the basic fee for the application has not been paid within one month of the filing of the application with the Office or, if the application has been filed with the central industrial property office of a Member State or with the Benelux Trade Mark Office, with that office,

the Office shall notify the applicant that a date of filing cannot be accorded in view of those deficiencies.

(2) If the deficiencies referred to under paragraph 1 are remedied within two months of receipt of the notification, the date on which all the deficiencies are remedied shall determine the date of filing. If the deficiencies are not remedied before the time limit expires, the application shall not be dealt with as a Community trade mark application. Any fees paid shall be refunded.

(3) Where, although a date of filing has been accorded, the examination reveals that

(a) the requirements of Rules 1, 2 and 3 or the other formal requirements governing applications laid down in the Regulation or in these Rules are not complied with;

(b) the full amount of the class fees payable under Rule 4 (b), read in conjunction with Commission Regulation (EC) No 2869/95 (3) (hereinafter 'the Fees Regulation') has not been received by the Office;

(c) where priority has been claimed pursuant to Rules 6 and 7, either in the application itself or within two months after the date of filing, the other requirements of the said Rules are not complied with; or

(d) where seniority has been claimed pursuant to Rule 8, either in the application itself or within two months after the date of filing, the other requirements of Rule 8 are not complied with,

the Office shall invite the applicant to remedy the deficiencies noted within such period as it may specify.

(4) If the deficiencies referred to in paragraph 3 (a) are not remedied before the time limit expires, the Office shall reject the application.

(5) If the outstanding class fees are not paid before the time limit expires, the application shall be deemed to have been withdrawn, unless it is clear which class or classes the amount paid is intended to cover. In the absence of other criteria to determine which classes are intended to be covered, the Office shall take the classes in the order of the classification. The application shall be deemed to have been withdrawn with regard to those classes for which the class fees have not been paid or have not been paid in full.

(6) If the deficiencies referred to in paragraph 3 concern the claim to priority, the right of priority for the application shall be lost.

(7) If the deficiencies referred to in paragraph 3 concern the claim to seniority, the right of seniority in respect of that application shall be lost.

- (8) If the deficiencies referred to in paragraph 3 concern only some of the goods and services, the Office shall refuse the application, or the right of priority or the right of seniority shall be lost, only in so far as those goods and services are concerned.

Rule 10

Examination of the conditions relating to the entitlement to be proprietor

Where, pursuant to Article 5 of the Regulation, the applicant is not entitled to be the proprietor of a Community trade mark, the Office shall notify the applicant thereof. The Office shall specify a period within which the applicant may withdraw the application or submit his observations. Where the applicant fails to overcome the objections to registration, the Office shall refuse the application.

Rule 11

Examination as to absolute grounds for refusal

- (1) Where, pursuant to Article 7 of the Regulation, the trade mark may not be registered for all or any part of the goods or services applied for, the office shall notify the applicant of the grounds for refusing registration. The Office shall specify a period within which the applicant may withdraw or amend the application or submit his observations.
- (2) Where, pursuant to Article 38 (2) of the Regulation, registration of the Community trade mark is subject to the applicant's stating that he disclaims any exclusive right in the non-distinctive elements in the mark, the Office shall notify the applicant thereof, stating the reasons, and shall invite him to submit the relevant statement within such period as it may specify.
- (3) Where the applicant fails to overcome the ground for refusing registration or to comply with the condition laid down in paragraph 2 within the time limit, the Office shall refuse the application in whole or in part.

Rule 12

Publication of the application

The publication of the application shall contain:

- (a) the applicant's name and address;
- (b) where applicable, the name and business address of the representative appointed by the applicant other than a representative falling within the first sentence of Article 88 (3) of the Regulation; if there is more than one representative with the same business address, only the name and business address of the first-named representative shall be published and it shall be followed by the words 'and others'; if there are two or more representatives with different business addresses, only the address for service determined pursuant to Rule 1 (1) (e) shall be published; where an association of representatives is appointed under Rule 76 (9), only the name and business address of the association shall be published;
- (c) the reproduction of the mark, together with the indications and descriptions pursuant to Rule 3; where registration in colour is applied for, the publication shall contain the indication 'in colour` and indicate the colour or colours making up the mark;
- (d) the list of goods and services, grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that classification to which that group of goods or services belongs, and presented in the order of the classes of that classification;
- (e) the date of filing and the file number;
- (f) where applicable, particulars of the claim of priority pursuant to Article 30 of the Regulation;

- (g) where applicable, particulars of the claim of exhibition priority pursuant to Article 33 of the Regulation;
- (h) where applicable, particulars of the claim of seniority pursuant to Article 34 of the Regulation;
- (i) where applicable, a statement that the mark has become distinctive in consequence of the use which has been made of it, pursuant to Article 7 (3) of the Regulation;
- (j) where applicable, a statement that the application is for a Community collective mark;
- (k) where applicable, a statement by the applicant disclaiming any exclusive right to an element of the mark pursuant to Rule 1 (3) or Rule 11 (2);
- (l) the language in which the application was filed and the second language which the applicant has indicated pursuant to Article 115 (3) of the Regulation.

Rule 13

Amendment of the application

- (1) An application for amendment of the application under Article 44 of the Regulation shall contain:
 - (a) the file number of the application;
 - (b) the name and the address of the applicant in accordance with Rule 1 (1) (b);
 - (c) where the applicant has appointed a representative, the name and the business address of the representative in accordance with Rule 1 (1) (e);
 - (d) the indication of the element of the application to be corrected or amended, and that element in its corrected or amended version;
 - (e) where the amendment relates to the representation of the mark, a representation of the mark as amended, in accordance with Rule 3.
- (2) Where the application for amendment is subject to the payment of a fee, the application shall not be deemed to have been filed until the required fee has been paid. If the fee has not been paid or has not been paid in full, the Office shall inform the applicant accordingly.
- (3) If the requirements governing the amendment of the application are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period to be specified by the Office, the Office shall reject the application for amendment.
- (4) Where the amendment is published pursuant to Article 44 (2) of the Regulation, Rules 15 to 22 shall apply *mutatis mutandis*.
- (5) A single application for amendment may be made for the amendment of the same element in two or more applications of the same applicant. Where the application for amendment is subject to the payment of a fee, the required fee shall be paid in respect of each application to be amended.
- (6) Paragraphs 1 to 5 shall apply *mutatis mutandis* for applications to correct the name or the business address of a representative appointed by the applicant. Such applications shall not be subject to the payment of a fee.

Rule 14

Correction of mistakes and errors in publications

- (1) Where the publication of the application contains a mistake or error attributable to the Office, the Office shall correct the mistake or error acting of its own motion or at the request of the applicant.

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- (2) Where a request as referred to in paragraph 1 is made by the applicant, Rule 13 shall apply mutatis mutandis. The request shall not be subject to the payment of a fee.
 - (3) The corrections effected under this Rule shall be published.
 - (4) Article 42 (2) of the Regulation and Rules 15 to 22 shall apply mutatis mutandis where the correction concerns the list of goods or services or the representation of the mark.

TITLE II

PROCEDURE FOR OPPOSITION AND PROOF OF USE

Rule 15

Contents of the notice of opposition

- (1) Opposition may be entered on the basis of one or more earlier marks within the meaning of Article 8 (2) of the Regulation ('earlier marks') or of one or more other earlier rights within the meaning of Article 8 (4) of the Regulation ('earlier rights').
- (2) The notice of opposition shall contain:
 - (a) as concerns the application against which opposition is entered:
 - (i) the file number of the application against which opposition is entered;
 - (ii) an indication of the goods and services listed in the Community trade mark application against which opposition is entered;
 - (iii) the name of the applicant for the Community trade mark;
 - (b) as concerns the earlier mark or the earlier right on which the opposition is based:
 - (i) where the opposition is based on an earlier mark, a statement to that effect and an indication that the earlier mark is a Community mark or an indication of the Member State or Member States including, where applicable, the Benelux, where the earlier mark has been registered or applied for, or, where the earlier mark is an internationally registered mark, an indication of the Member State or Member States including, where applicable, the Benelux, to which protection of that earlier mark has been extended;
 - (ii) where available, the file number or the registration number and the filing date, including the priority date of the earlier mark;
 - (iii) where the opposition is based on an earlier mark which is a well-known mark within the meaning of Article 8 (2) (c) of the Regulation, an indication to that effect and an indication of the Member State or Member States in which the earlier mark is well-known;
 - (iv) where the opposition is based on an earlier mark having a reputation within the meaning of Article 8 (5) of the Regulation, an indication to that effect, and an indication of where that earlier mark is registered or applied for in accordance with subparagraph (i);
 - (v) where the opposition is based on an earlier right, an indication to that effect, and an indication of the Member State or Member States where that earlier right exists;
 - (vi) a representation and, where appropriate, a description of the earlier mark or earlier right;
 - (vii) the goods and services in respect of which the earlier mark has been registered or applied for or in respect of which the earlier mark is well-known within the meaning of Article 8 (2) (c) of the Regulation or has a reputation within the meaning of Article 8 (5) of the Regulation; the opposing party shall, when indicating all the goods and services for which the earlier mark

is protected, also indicate those goods and services on which the opposition is based;

(c) as concerns the opposing party:

- (i) where the opposition is entered by the proprietor of the earlier mark or of the earlier right, his name and address in accordance with Rule 1 (1) (b) and an indication that he is the proprietor of such mark or right;
 - (ii) where opposition is entered by a licensee, the name of the licensee and his address in accordance with Rule 1 (1) (b) and an indication that he has been authorized to enter the opposition;
 - (iii) where the opposition is entered by the successor in title to the registered proprietor of a Community trade mark who has not yet been registered as new proprietor, an indication to that effect, the name and address of the opposing party in accordance with Rule 1 (1) (b), and an indication of the date on which the application for registration of the new proprietor was received by the Office or, where this information is not available, was sent to the Office;
 - (iv) where opposition is entered on the basis of an earlier right by a person who is not the proprietor of that right, the name of the person and his address in accordance with Rule 1 (1) (b) and an indication that he is entitled under the relevant national law to exercise that right;
 - (v) where the opposing party has appointed a representative, the name of the representative and his business in accordance with Rule 1 (1) (e);
- (d) a specification of the grounds on which the opposition is based.
- (3) Paragraphs 1 and 2 shall apply mutatis mutandis to an opposition entered pursuant to Article 8 (3) of the Regulation.

Rule 16

Facts, evidence and arguments presented in support of the opposition

- (1) Every notice of opposition may contain particulars of the facts, evidence and arguments presented in support of the opposition, accompanied by the relevant supporting documents.
- (2) If the opposition is based on an earlier mark which is not a Community trade mark, the notice of opposition shall preferably be accompanied by evidence of the registration or filing of that earlier mark, such as a certificate of registration. If the opposition is based on a well-known mark as referred to in Article 8 (2) (c) of the Regulation or on a mark having a reputation as referred to in Article 8 (5) of the Regulation, the notice of opposition shall in principle be accompanied by evidence attesting that it is well-known or that it has a reputation. If the opposition is entered on the basis of any other earlier right, the notice of opposition shall in principle be accompanied by appropriate evidence on the acquisition and scope of protection of that right.
- (3) The particulars of the facts, evidence and arguments and other supporting documents as referred to in paragraphs 1, and the evidence referred to in paragraph 2 may, if they are not submitted together with the notice of opposition or subsequent thereto, be submitted within such period after commencement of the opposition proceedings as the Office may specify pursuant to Rule 20 (2).

Rule 17

Use of languages in opposition proceedings

- (1) Where the notice of opposition is not filed in the language of the application for registration of the Community trade mark, if that language is one of the languages of the Office, or in the

second language indicated when the application was filed, the opposing party shall file a translation of the notice of opposition in one of those languages within a period of one month from the expiry of the opposition period.

- (2) Where the evidence in support of the opposition as provided for in Rule 16 (1) and (2) is not filed in the language of the opposition proceedings, the opposing party shall file a translation of that evidence into that language within a period of one month from the expiry of the opposition period or, where applicable, within the period specified by the Office pursuant to Rule 16 (3).
- (3) Where the opposing party or the applicant informs the Office, before the date on which the opposition proceedings shall be deemed to commence pursuant to Rule 19 (1), that the applicant and the opposing party have agreed on a different language for the opposition proceeding pursuant to Article 115 (7) of the Regulation, the opposing party shall, where the notice of opposition has not been filed in that language, file a translation of the notice of opposition in that language within a period of one month from the said date.

Rule 18

Rejection of notice of opposition as inadmissible

- (1) If the Office finds that the notice of opposition does not comply with the provisions of Article 42 of the Regulation, or where the notice of opposition does not clearly identify the application against which opposition is entered or the earlier mark or the earlier right on the basis of which the opposition is being entered, the Office shall reject the notice of opposition as inadmissible unless those deficiencies have been remedied before expiry of the opposition period. If the opposition fee has not been paid within the opposition period, the notice of opposition shall be deemed not to have been entered. If the opposition fee has been paid after the expiry of the opposition period, it shall be refunded to the opposing party.
- (2) If the Office finds that the notice of opposition does not comply with other provisions of the Regulation or of these Rules, it shall inform the opposing party accordingly and shall call upon him to remedy the deficiencies noted within a period of two months. If the deficiencies are not remedied before the time limit expires, the Office shall reject the notice of opposition as inadmissible.
- (3) Any decision to reject a notice of opposition as inadmissible under paragraphs 1 or 2 shall be communicated to the applicant.

Rule 19

Commencement of opposition proceedings

- (1) If the Office does not reject the notice of opposition in accordance with Rule 18, it shall communicate the opposition to the applicant and shall invite him to file his observations within such period as it may specify. The Office shall draw the applicant's attention to the fact that the opposition proceedings shall be deemed to commence two months after receipt of the communication, unless the applicant informs the Office, before the expiry of this period, that he withdraws his application or restricts the application to goods and services against which the opposition is not directed.
- (2) The Office may, pursuant to Rule 71, grant an extension of the period referred to in the second sentence of paragraph 1 where such request is presented jointly by the applicant and the opposing party.
- (3) Where the application is withdrawn or restricted within the period specified in the second sentence of paragraph 1 or within any extension of that period granted under paragraph 2, the

Office shall inform the opposing party accordingly and shall refund the opposition fee.

Rule 20

Examination of opposition

- (1) If the application is not withdrawn or restricted pursuant to Rule 19, the applicant shall file his observations within the period specified by the Office in its communication referred to in the first sentence of Rule 19 (1).
- (2) Where the notice of opposition does not contain particulars of the facts, evidence and arguments as referred to in Rule 16 (1) and (2), the Office shall call upon the opposing party to submit such particulars within a period specified by the Office. Any submission by the opposing party shall be communicated to the applicant who shall be given an opportunity to reply within a period specified by the Office.
- (3) If the applicant files no observations, the Office may give a ruling on the opposition on the basis of the evidence before it.
- (4) The observations filed by the applicant shall be communicated to the opposing party who shall be called upon by the Office, if it considers it necessary to do so, to reply within a period specified by the Office.
- (5) If, pursuant to Article 44 (1) of the Regulation, the applicant restricts the list of goods and services, the Office shall communicate this to the opposing party and call upon him, within such period as it may specify, to submit observations stating whether he maintains the opposition and, if so, against which of the remaining goods and services.
- (6) The Office may suspend any opposition proceeding where the opposition is based on an application for registration pursuant to Article 8 (2) (b) of the Regulation until a final decision is taken in that proceeding, or where other circumstances are such that such suspension is appropriate.

Rule 21

Multiple oppositions

- (1) Where a number of oppositions have been entered in respect of the same application for a Community trade mark, the Office may deal with them in one set of proceedings. The Office may subsequently decide to no longer deal with them in this way.
- (2) If a preliminary examination of one or more oppositions reveals that the Community trade mark for which an application for registration has been filed is possibly not eligible for registration in respect of some or all of the goods or services for which registration is sought, the Office may suspend the other opposition proceedings. The Office shall inform the remaining opposing parties of any relevant decisions taken during those proceedings which are continued.
- (3) Once a decision rejecting the application has become final, the oppositions on which a decision was deferred in accordance with paragraph 2 shall be deemed to have been disposed of and the opposing parties concerned shall be informed accordingly. Such disposition shall be considered to constitute a case which has not proceeded to judgment within the meaning of Article 81 (4) of the Regulation.
- (4) The Office shall refund 50 % of the opposition fee paid by each opposing party whose opposition is deemed to have been disposed of in accordance with paragraphs 1, 2 and 3.

Rule 22

Proof of use

- (1) Where, pursuant to Article 43 (2) or (3) of the Regulation, the opposing party has to furnish proof of use or show that there are proper reasons for non-use, the Office shall invite him to provide the proof required within such period as it shall specify. If the opposing party does not provide such proof before the time limit expires, the Office shall reject the opposition.
- (2) The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 3.
- (3) The evidence shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76 (1) (f) of the Regulation.
- (4) Where the evidence supplied pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office may require the opposing party to submit a translation of that evidence in that language, within a period specified by the Office.

TITLE III

REGISTRATION PROCEDURE

Rule 23

Registration of the trade mark

- (1) The registration fee provided for in Article 45 of the Regulation shall consist of
 - (a) a basic fee;and
 - (b) a class fee for each class exceeding three in respect of which the mark is to be registered.
- (2) Where no opposition has been entered or where any opposition entered has been finally disposed of by withdrawal, rejection or other disposition, the Office shall request the applicant to pay the registration fee within two months of receipt of the request.
- (3) If the registration fee is not paid within due time, it may still be validly paid within two months of notification of a communication pointing out the failure to observe the time limit, provided that within this period the additional fee specified in the Fees Regulations is paid.
- (4) On receipt of the registration fee the mark applied for and the particulars referred to in Rule 84 (2) shall be recorded in the Register of Community trade marks.
- (5) The registration shall be published in the Community Trade Marks Bulletin.
- (6) The registration fee shall be refunded if the trade mark applied for is not registered.

Rule 24

Certificate of registration

- (1) The Office shall issue to the proprietor of the trade mark a certificate of registration which shall contain the entries in the Register provided for in Rule 84 (2) and a statement to the effect that those entries have been recorded in the Register.
- (2) The proprietor of the trade mark may request that certified or uncertified copies of the certificate of registration be supplied to him upon payment of a fee.

Rule 25

Alteration of the registration

- (1) An application for alteration of the registration pursuant to Article 48 (2) of the Regulation shall contain:
 - (a) the registration number,
 - (b) the name and the address of the proprietor of the mark in accordance with Rule 1 (1) (b);
 - (c) where the proprietor has appointed a representative, the name and the business address of the representative in accordance with Rule 1 (1) (e);
 - (d) the indication of the element in the representation of the mark to be altered and that element in its altered version;
 - (e) a representation of the mark as altered, in accordance with Rule 3.
- (2) The application shall be deemed not to have been filed until the required fee has been paid. If the fee has not been paid or has not been paid in full, the Office shall inform the applicant accordingly.
- (3) If the requirements governing the alteration of the registration are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period to be specified by the Office, the Office shall reject the application.
- (4) Where the registration of the alteration is challenged pursuant to Article 48 (3) of the Regulation, the provisions on opposition contained in the Regulation and in these Rules shall apply *mutatis mutandis*.
- (5) A single application may be made for the alteration of the same element in two or more registrations of the same proprietor. The required fee shall be paid in respect of each registration to be altered.

Rule 26

Change of the name or address of the proprietor of the Community trade mark or of his registered representative

- (1) A change of the name or address of the proprietor of the Community trade mark which is not an alteration of the Community trade mark pursuant to Article 48 (2) of the Regulation and which is not the consequence of a whole or partial transfer of the registered mark shall, at the request of the proprietor, be recorded in the register.
- (2) An application for the change of the name or address of the proprietor of the registered mark shall contain:
 - (a) the registration number of the mark;
 - (b) the name and the address of the proprietor of the mark as recorded in the register;
 - (c) the indication of the name and address of the proprietor of the mark, as amended, in accordance with Rule 1 (1) (e).
 - (d) where the proprietor has appointed a representative, the name and the business address of the representative, in accordance with Rule 1 (1) (e).
- (3) The application shall not be subject to payment of a fee.
- (4) A single application may be made for the change of the name or address in respect of two or more registrations of the same proprietor.

- (5) If the requirements governing the recording of a change are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period to be specified by the Office, the Office shall reject the application.
- (6) Paragraphs 1 to 5 shall apply mutatis mutandis to a change of the name or address of the registered representative.
- (7) Paragraphs 1 to 6 shall apply mutatis mutandis to applications for Community trade marks. The change shall be recorded in the files kept by the Office on the Community trade mark application.

Rule 27

Correction of mistakes and errors in the register and in the publication of the registration

- (1) Where the registration of the mark or the publication of the registration contains a mistake or error attributable to the Office, the Office shall correct the error or mistake of its own motion or at the request of the proprietor.
- (2) Where such a request is made by the proprietor, Rule 26 shall apply mutatis mutandis. The request shall not be subject to payment of a fee.
- (3) The Office shall publish the corrections made under this Rule.

Rule 28

Claiming seniority after registration of the Community trade mark

- (1) An application pursuant to Article 35 of the Regulation to obtain the seniority of one or more earlier registered trade marks as referred to in Article 34 of the Regulation, shall contain:
 - (a) the registration number of the Community trade mark;
 - (b) the name and address of the proprietor of the Community trade mark in accordance with Rule 1 (1) (b);
 - (c) where the proprietor has appointed a representative, the name and the business address of the representative in accordance with Rule 1 (1) (e);
 - (d) an indication of the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration, and the goods and services for which the earlier mark is registered;
 - (e) an indication of the goods and services in respect of which seniority is claimed;
 - (f) a copy of the relevant registration; the copy must be certified as an exact copy of the relevant registration by the competent authority.
- (2) If the requirements governing the claiming of seniority are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period specified by the Office, the Office shall reject the application.
- (3) The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the effective claiming of seniority.
- (4) The President of the Office may determine that the material to be provided by the applicant may consist of less than is required under paragraph 1 (f), provided that the information required is available to the Office from other sources.

TITLE IV

RENEWAL

Rule 29

Notification of expiry

At least six months before expiry of the registration the Office shall inform the proprietor of the Community trade mark, and any person having a registered right, including a licence, in respect of the Community trade mark, that the registration is approaching expiry. Failure to give such notification shall not affect the expiry of the registration.

Rule 30 Renewal of registration

(1) An application for renewal shall contain:

- (a) where the application is filed by the proprietor of the trade mark, his name and address in accordance with Rule 1 (1) (b);
- (b) where the application is filed by a person expressly authorized to do so by the proprietor of the mark, the name and address of that person and evidence that he is authorized to file the application;
- (c) where the applicant has appointed a representative, the name and business address of the representative in accordance with Rule 1 (1) (e);
- (d) the registration number;
- (e) an indication that renewal is requested for all the goods and services covered by the registration or, if the renewal is not requested for all the goods and services for which the mark is registered, an indication of those classes or those goods and services for which renewal is requested or those classes or those goods and services for which renewal is not requested, grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that classification to which that group of goods or services belongs and presented in the order of the classes of that classification.

(2) The fees payable under Article 47 of the Regulation for the renewal of a Community trade mark shall consist of:

- (a) a basic fee;
 - (b) a class fee for each class exceeding three in the list of classes in respect of which renewal is applied for as shown in paragraph 1 (e); and
 - (c) where applicable, the additional fee for late payment of the renewal fee or late submission of the request for renewal, pursuant to Article 47 (3) of the Regulation, as specified in the Fees Regulation.
- (3) Where the application for renewal is filed within the time periods provided for in Article 47 (3) of the Regulation, but the other conditions governing renewal provided for in Article 47 of the Regulation and these Rules are not satisfied, the Office shall inform the applicant of the deficiencies found. If the application is filed by a person whom the proprietor of the trade mark has expressly authorized to do so, the proprietor of the trade mark shall receive a copy of the notification.
- (4) Where an application for renewal is not submitted or is submitted after expiry of the period provided for in the third sentence of Article 47 (3) of the Regulation, or if the fees are not paid or are paid only after the period in question has expired, or if the deficiencies are not remedied within that period, the Office shall determine that the registration has expired and shall so notify the proprietor of the Community trade mark and, where appropriate, the applicant and the person recorded in the Register as having rights in the mark. Where the fees paid are

insufficient to cover all the classes of goods and services for which renewal is requested, such a determination shall not be made if it is clear which class or classes are to be covered. In the absence of other criteria, the Office shall take the classes into account in the order of classification.

- (5) Where the determination made pursuant to paragraph 4 has become final, the Office shall cancel the mark from the register. The cancellation shall take effect from the day following the day on which the existing registration expired.
- (6) Where the renewal fees provided for in paragraph 2 have been paid but the registration is not renewed, those fees shall be refunded.

TITLE V

TRANSFER, LICENCES AND OTHER RIGHTS, CHANGES

Rule 31

Transfer

- (1) An application for registration of a transfer under Article 17 of the Regulation shall contain:
 - (a) the registration number of the Community trade mark;
 - (b) particulars of the new proprietor in accordance with Rule 1 (1) (b);
 - (c) where not all the registered goods or services are included in the transfer, particulars of the registered goods or services to which the transfer relates;
 - (d) documents duly establishing the transfer in accordance with Article 17 (2) and (3) of the Regulation;
- (2) The application may contain, where applicable, the name and business address of the representative of the new proprietor, to be set out in accordance with Rule 1 (1) (e).
- (3) Transfers to any natural or legal persons who cannot be proprietors of Community trade marks pursuant to Article 5 of the Regulation shall not be registered.
- (4) The application shall not be deemed to have been filed until the required fee has been paid. If the fee is not paid or is not paid in full, the Office shall so notify the applicant.
- (5) It shall constitute sufficient proof of transfer under paragraph 1 (d):
 - (a) that the application for registration of the transfer is signed by the registered proprietor or his representative and by the successor in title or his representative; or,
 - (b) that the application, if submitted by the successor in title, is accompanied by a declaration, signed by the registered proprietor or his representative, that he agrees to the registration of the successor in title; or
 - (c) that the application is accompanied by a completed transfer form or document, as specified in Rule 83 (1) (d), signed by the registered proprietor or his representative and by the successor in title or his representative.
- (6) Where the conditions applicable to the registration of a transfer, as laid down in Article 17 (1) to (4) of the Regulation, in paragraphs 1 to 4 above, and in other applicable Rules are not fulfilled, the Office shall notify the applicant of the deficiencies. If the deficiencies are not remedied within a period specified by the Office, it shall reject the application for registration of the transfer.
- (7) A single application for registration of a transfer may be submitted for two or more marks, provided that the registered proprietor and the successor in title are the same in each case.

- (8) Paragraphs 1 to 7 shall apply mutatis mutandis to applications for Community trade marks. The transfer shall be recorded in the files kept by the Office concerning the Community trade mark application.

Rule 32

Partial Transfers

- (1) Where the application for registration of a transfer relates only to some of the goods and services for which the mark is registered, the application shall contain an indication of the goods and services to which the partial transfer relates.
- (2) The goods and services in the original registration shall be distributed between the remaining registration and the new registration so that the goods and services in the remaining registration and the new registration shall not overlap.
- (3) Rule 31 shall apply mutatis mutandis to applications for registrations of a partial transfer.
- (4) The Office shall establish a separate file for the new registration, which shall consist of a complete copy of the file of the original registration and the application for registration of the partial transfer; a copy of that application shall be included in the file of the remaining registration. The Office shall also assign a new registration number to the new registration.
- (5) Any application made by the original proprietor pending with regard to the original registration shall be deemed to be pending with regard to the remaining registration and the new registration. Where such application is subject to the payment of fees and these fees have been paid by the original proprietor, the new proprietor shall not be liable to pay any additional fees with regard to such application.

Rule 33

Registration of licences and other rights

- (1) Rule 31 (1) (a) (b) and (c), (2), (4) and (7) shall apply mutatis mutandis to the registration of the grant or transfer of a licence, to registration of the creation or transfer of a right in rem in respect of a Community trade mark, and to registration of enforcement measures. However, where a Community trade mark is involved in bankruptcy or like proceedings, the request of the competent national authority for an entry in the register to this effect shall not be subject to payment of a fee.
- (2) Where the Community trade mark is licensed for only part of the goods and services for which the mark is registered, or for only a part of the Community, or for a limited period of time, the application for registration shall indicate the goods and services or the part of the Community or the time period for which the licence is granted.
- (3) Where the conditions applicable to registration, as laid down in Articles 19, 20 or 22 of the Regulation, in paragraphs 1 and 2 above, and the other applicable Rules are not fulfilled, the Office shall notify the applicant of the irregularity. If the irregularity is not corrected within a period specified by the Office, it shall reject the application for registration.
- (4) Paragraphs 1, 2 and 3 shall apply mutatis mutandis to applications for Community trade marks. Licences, rights in rem and enforcement measures shall be recorded in the files kept by the Office concerning the Community trade mark application.

Rule 34

Special provisions for the registration of a licence

- (1) A licence in respect of a Community trade mark shall be recorded in the Register as an exclusive licence if the proprietor of the trade mark or the licensee so request.
- (2) A licence in respect of a Community trade mark shall be recorded in the Register as a sub-licence where it is granted by a licensee whose licence is recorded in the Register.
- (3) A licence in respect of a Community trade mark shall be recorded in the Register as a licence limited as to the goods and services or as a territorially limited licence if it is granted for only a part of the goods or services for which the mark is registered or if it is granted only for a part of the Community.
- (4) A licence in respect of a Community trade mark shall be recorded in the Register as a temporary licence if it is granted for a limited period of time.

Rule 35

Cancellation or modification of the registration of licences and other rights

- (1) A registration effected under Rule 33 (1) shall be cancelled at the request of one of the persons concerned.
- (2) The application shall contain:
 - (a) the registration number of the Community trade mark;and
 - (b) particulars of the right whose registration is to be cancelled.
- (3) Application for cancellation of the registration of a licence or another right shall not be deemed to have been filed until the required fee has been paid. If the fee is not paid or is not paid in full, the Office shall so notify the applicant. However, the request of the competent national authority for the cancellation of an entry where a Community trade mark is involved in bankruptcy or like proceedings shall not be subject to payment of a fee.
- (4) The application shall be accompanied by documents showing that the registered right no longer exists or by a statement by the licensee or the holder of another right, to the effect that he consents to cancellation of the registration.
- (5) Where the requirements for cancellation of the registration are not satisfied, the Office shall notify the applicant of the irregularity. If the irregularity is not corrected within a period specified by the Office, it shall reject the application for cancellation of the registration.
- (6) Paragraphs 1, 2, 4 and 5 shall apply mutatis mutandis to a request for the modification of a registration effected under Rule 33 (1).
- (7) Paragraphs 1 to 6 shall apply mutatis mutandis to entries made in the files pursuant to Rule 33 (4).

TITLE VI

SURRENDER

Rule 36

Surrender

- (1) A declaration of surrender pursuant to Article 49 of the Regulation shall contain:
 - (a) the registration number of the Community trade mark;
 - (b) the name and address of the proprietor in accordance with Rule 1 (1) (b);

- (c) where a representative has been appointed, the name and business address of the representative in accordance with Rule 1 (1) (e);
 - (d) where surrender is declared only for some of the goods and services for which the mark is registered, the goods and services for which the surrender is declared or the goods and services for which the mark is to remain registered.
- (2) Where a right of a third party relating to the Community trade mark is entered in the register, it shall be sufficient proof of his agreement to the surrender that a declaration of consent to the surrender is signed by the proprietor of that right or his representative. Where a licence has been registered, surrender shall be registered three months after the date on which the proprietor of the Community trade mark satisfies the Office that he has informed the licensee of his intention to surrender it. If the proprietor proves to the Office before the expiry of that period that the licensee has given his consent, the surrender shall be registered forthwith.
- (3) If the requirements governing surrender are not fulfilled, the Office shall communicate the deficiencies to the declarant. If the deficiencies are not remedied within a period to be specified by the Office, the Office shall reject the entry of the surrender in the Register.

TITLE VII

REVOCATION AND INVALIDITY

Rule 37

Application for revocation or for a declaration of invalidity

An application to the Office for revocation or for a declaration of invalidity pursuant to Article 55 of the Regulation shall contain:

- (a) as concerns the registration in respect of which revocation or a declaration of invalidity is sought;
 - (i) the registration number of the Community trade mark in respect of which revocation or a declaration of invalidity is sought;
 - (ii) the name and address of the proprietor of the Community trade mark in respect of which revocation or a declaration of invalidity is sought;
 - (iii) a statement of the registered goods and services in respect of which revocation or a declaration of invalidity is sought;
- (b) as regards the grounds on which the application is based,
- (i) in the case of an application pursuant to Article 50 or Article 51 of the Regulation, a statement of the grounds on which the application for revocation or a declaration of invalidity is based;
 - (ii) in the case of an application pursuant to Article 52 (1) of the Regulation, particulars of the right on which the application for a declaration of invalidity is based and if necessary particulars showing that the applicant is entitled to adduce the earlier right as grounds for invalidity;
 - (iii) in the case of an application pursuant to Article 52 (2) of the Regulation, particulars of the right on which the application for a declaration of invalidity is based and particulars showing that the applicant is the proprietor of an earlier right as referred to in Article 52 (2) of the Regulation or that he is entitled under the national law applicable to lay claim to that right;
 - (iv) an indication of the facts, evidence and arguments presented in support of those grounds;

- (c) as concerns the applicant,
- (i) his name and address in accordance with Rule 1 (1) (b);
 - (ii) if the applicant has appointed a representative, the name and the business address of the representative, in accordance with Rule 1 (1) (e).

Rule 38

Languages used in revocation or invalidity proceedings

- (1) Where the application for revocation or for a declaration of invalidity is not filed in the language of the application for the registration of the Community trade mark, if that language is one of the languages of the Office, or in the second language indicated when the application was filed, the applicant for revocation or for a declaration of invalidity shall file a translation of his application in one of those two languages within a period of one month from the filing of his application.
- (2) Where the evidence in support of the application is not filed in the language of the revocation or invalidity proceedings, the applicant shall file a translation of that evidence into that language within a period of two months after the filing of such evidence.
- (3) Where the applicant for revocation or for a declaration of invalidity or the proprietor of the Community trade mark inform the Office before the expiry of a period of two months from receipt by the Community trade mark proprietor of the communication referred to in Rule 40 (1), that they have agreed on a different language of proceedings pursuant to Article 115 (7) of the Regulation, the applicant shall, where the application was not filed in that language, file a translation of the application in that language within a period of one month from the said date.

Rule 39

Rejection of the application for revocation or for declaration of invalidity as inadmissible

- (1) If the Office finds that the application does not comply with Article 55 of the Regulation, Rule 37 or any other provision of the Regulation or these Rules, it shall inform the applicant accordingly and shall call upon him to remedy the deficiencies found within such period as it may specify. If the deficiencies are not remedied before expiry of the time limit, the Office shall reject the application as inadmissible.
- (2) Where the Office finds that the required fees have not been paid, it shall inform the applicant accordingly and shall inform him that the application will be deemed not to have been filed if the required fees are not paid within a period specified by the Office. If the required fees are paid after expiry of the period specified by the Office, they shall be refunded to the applicant.
- (3) Any decision to reject an application for revocation or for a declaration of invalidity under paragraph 1 shall be communicated to the applicant. Where the application is considered not to have been filed pursuant to paragraph 2, the applicant shall be informed accordingly.

Rule 40

Examination of the application for revocation or for a declaration of invalidity

- (1) If the Office does not reject the application in accordance with Rule 39, it shall communicate such application to the proprietor of the Community trade mark and shall request him to file his observations within such period as it may specify.
- (2) If the proprietor of the Community trade mark files no observations, the Office may decide on the revocation or invalidity on the basis of the evidence before it.

- (3) Any observations filed by the proprietor of the Community trade mark shall be communicated to the applicant, who shall be requested by the Office, if it sees fit, to reply within a period specified by the Office.
- (4) All communications under Article 56 (1) of the Regulation and all observations filed in this respect shall be sent to the parties concerned.
- (5) If the applicant, under Article 56 (2) or (3) of the Regulation, has to furnish proof of use or proof that there are proper reasons for non-use, Rule 22 shall apply mutatis mutandis.

Rule 41

Multiple applications for revocation or for a declaration of invalidity

- (1) Where a number of applications for revocation or for a declaration of invalidity have been filed relating to the same Community trade mark, the Office may deal with them in one set of proceedings. The Office may subsequently decide no longer to deal with them in this way.
- (2) Rule 21 (2) (3) and (4) shall apply mutatis mutandis.

TITLE VIII

COMMUNITY COLLECTIVE MARKS

Rule 42

Application of provisions

The provisions of these Rules shall apply to Community collective marks, subject to Rule 43.

Rule 43

Regulation governing Community collective marks

- (1) Where the application for a Community collective trade mark does not contain the regulations governing its use pursuant to Article 65 of the Regulation, those regulations shall be submitted to the Office within a period of two months after the date of filing.
- (2) The regulations governing Community collective marks shall specify:
 - (a) the name of the applicant and his office address;
 - (b) the object of the association or the object for which the legal person governed by public law is constituted;
 - (c) the bodies authorized to represent the association or the said legal person;
 - (d) the conditions for membership;
 - (e) the persons authorized to use the mark;
 - (f) where appropriate, the conditions governing use of the mark, including sanctions;
 - (g) where appropriate, the authorization referred to in the second sentence of Article 65 (2) of the Regulation.

TITLE IX

CONVERSION

Rule

44

Application for conversion

- (1) An application for conversion of a Community trade mark application or a registered Community trade mark into a national trademark application pursuant to Article 108 of the Regulation shall contain:
 - (a) the name and the address of the applicant for conversion in accordance with Rule 1 (1) (b);
 - (b) where the applicant for conversion has appointed a representative, the name and the business address of the representative in accordance with Rule 1 (1) (e);
 - (c) the filing number of the Community trade mark application or the registration number of the Community trade mark;
 - (d) the date of filing of the Community trade mark application or the Community trade mark and, where applicable, particulars of the claim to priority for the Community trade mark application or the Community trade mark pursuant to Articles 30 and 33 of the Regulation and particulars of the claim to seniority pursuant to Articles 34 and 35 of the Regulation;
 - (e) a representation of the mark as contained in the application or as registered;
 - (f) the specification of the Member State or the Member States in respect of which conversion is requested;
 - (g) where the request does not relate to all of the goods and services for which the application has been filed or for which the trade mark has been registered, an indication of the goods and services for which conversion is requested, and, where conversion is requested in respect of more than one Member State and the list of goods and services is not the same for all Member States, an indication of the respective goods and services for each Member State;
 - (h) where conversion is requested pursuant to Article 108 (4) of the Regulation, an indication to that effect;
 - (i) where conversion is requested pursuant to Article 108 (5) of the Regulation following a withdrawal of an application for registration, an indication to that effect, and the date on which the application for registration was withdrawn;
 - (j) where conversion is requested pursuant to Article 108 (5) of the Regulation following a failure to renew the registration, an indication to that effect, and the date on which the period of protection has expired, the period of three months provided for in Article 108 (5) of the Regulation shall begin to run on the day following the last day on which the request for renewal can be presented pursuant to Article 47 (3) of the Regulation;
 - (k) where conversion is requested pursuant to article 108 (6) of the Regulation, an indication to that effect, the date on which the decision of the national court has become final, and a copy of that decision.
- (2) Where a copy of a court decision pursuant to paragraph 1 (k) is required, that copy may be submitted in the language in which the decision was given.

Rule 45

Examination of application for conversion

- (1) Where the application for conversion does not comply with the requirements of Article 108 (1) of the Regulation or was not filed within the relevant period of three months, the Office shall reject it.
- (2) Where the conversion fee has not been paid within the relevant period of three months, the

Office shall inform the applicant that the application for conversion shall be deemed not to have been filed.

- (3) Where the other requirements governing conversion as provided for in Rule 44 and in other Rules governing such applications are not fulfilled, the Office shall inform the applicant accordingly and invite him to remedy the deficiency within a period specified by the Office. If the deficiencies are not remedied within that period, the Office shall reject the application for conversion.

Rule 46

Publication of application for conversion

- (1) Where the application for conversion relates to a Community trade mark application which has already been published in the Community Trade Mark Bulletin pursuant to Article 40 of the Regulation or where the application for conversion relates to a Community trade mark, the application for conversion shall be published in the Community Trade Marks Bulletin.
- (2) The publication of the application for conversion shall contain:
 - (a) the filing number or the registration number of the trade mark in respect of which conversion is requested;
 - (b) a reference to the previous publication of the application or the registration in the Community Trade marks Bulletin;
 - (c) an indication of the Member State or Member States in respect of which conversion has been requested;
 - (d) where the request does not relate to all of the goods and services for which the application has been filed or for which the trade mark has been registered, an indication of the goods and services for which conversion is requested;
 - (e) where conversion is requested in respect of more than one Member State and the list of goods and services is not the same for all Member States, an indication of the respective goods and services for each Member State;
 - (f) the date of the application for conversion.

Rule 47

Transmission to central industrial property offices of the Member States

Where the application for conversion complies with the requirements of the Regulation and these Rules, the Office shall transmit without delay the application for conversion to the central industrial property offices of the Member States specified therein, including the Benelux Trade Mark Office. The Office shall inform the applicant of the date of transmission.

TITLE X

APPEALS

Rule 48

Content of the notice of appeal

- (1) The notice of appeal shall contain:
 - (a) the name and address of the appellant in accordance with rule 1 (1) (b);
 - (b) where the appellant has appointed a representative, the name and the business address of the representative in accordance with Rule 1 (1) (e);

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- (c) a statement identifying the decision which is contested and the extent to which amendment or cancellation of the decision is requested.
- (2) The notice of appeal shall be filed in the language of the proceedings in which the decision subject to the appeal was taken.

Rule 49

Rejection of the appeal as inadmissible

- (1) If the appeal does not comply with Articles 57, 58 and 59 of the Regulation and Rule 48 (1) (c) and (2), the Board of Appeal shall reject it as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 59 of the Regulation has expired.
- (2) If the Board of Appeal finds that the appeal does not comply with other provisions of the Regulation or other provisions of these Rules, in particular Rule 48 (1) (a) and (b), it shall inform the appellant accordingly and shall request him to remedy the deficiencies noted within such period as it may specify. If the appeal is not corrected in good time, the Board of Appeal shall reject it as inadmissible.
- (3) If the fee for appeal has been paid after expiry of the period for the filing of appeal pursuant to Article 59 of the Regulation, the appeal shall be deemed not to have been filed and the appeal fee shall be refunded to the appellant.

Rule 50

Examination of appeals

- (1) Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.
- (2) The Board of Appeal's decision shall contain:
- (a) a statement that it is delivered by the Board;
 - (b) the date when the decision was taken;
 - (c) the names of the Chairman and of the other members of the Board of Appeal taking part;
 - (d) the name of the competent employee of the registry;
 - (e) the names of the parties and of their representatives;
 - (f) a statement of the issues to be decided;
 - (g) a summary of the facts;
 - (h) the reasons;
 - (i) the order of the Board of Appeal, including, where necessary, a decision on costs.
- (3) The decision shall be signed by the Chairman and the other members of the Board of Appeal and by the employee of the registry of the Board of Appeal.

Rule 51

Reimbursement of appeal fees

The reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. In the event of interlocutory revision, reimbursement shall

be ordered by the department whose decision has been impugned, and in other cases by the Board of Appeal.

TITLE XI

GENERAL PROVISIONS

Part A

Decisions and communications of the Office

Rule 52

Form of decisions

- (1) Decisions of the Office shall be in writing and shall state the reasons on which they are based. Where oral proceedings are held before the Office, the decision may be given orally. Subsequently, the decision in writing shall be notified to the parties.
- (2) Decisions of the Office which are open to appeal shall be accompanied by a written communication indicating that notice of appeal must be filed in writing at the Office within two months of the date of notification of the decision from which appeal is to be made. The communications shall also draw the attention of the parties to the provisions laid down in Articles 57, 58 and 59 of the Regulation. The parties may not plead any failure to communicate the availability proceedings.

Rule 53

Correction of errors in decisions

In decisions of the Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected. They shall be corrected by the department which took the decision, acting of its own motion or at the request of an interested party.

Rule 54

Noting of loss of rights

- (1) If the Office finds that the loss of any rights results from the Regulation or these Rules without any decision having been taken, it shall communicate this to the person concerned in accordance with Article 77 of the Regulation, and shall draw his attention to the substance of paragraph 2 of this Rule.
- (2) If the person concerned considers that the finding of the Office is inaccurate, he may, within two months after notification of the communication referred to in paragraph 1, apply for a decision on the matter by the Office. Such decision shall be given only if the Office disagrees with the person requesting it; otherwise the Office shall amend its finding and inform the person requesting the decision.

Rule 55

Signature, name, seal

- (1) Any decision, communication or notice from the Office shall indicate the department or division of the Office as well as the name or the names of the official or officials responsible. They shall be signed by the official or officials, or, instead of a signature, carry a printed or stamped seal of the Office.

- (2) The President of the Office may determine that other means of identifying the department or division of the Office and the name of the official or officials responsible or an identification other than a seal may be used where decisions, communications or notices are transmitted by telecopier or any other technical means of communication.

Part B

Oral proceedings and taking of evidence

Rule 56

Summons to oral proceedings

- (1) The parties shall be summoned to oral proceedings provided for in Article 75 of the Regulation and their attention shall be drawn to paragraph 3 of this Rule. At least one month's, notice of the summons shall be given unless the parties agree to a shorter period.
- (2) When issuing the summons, the Office shall draw attention to the points which in its opinion need to be discussed in order for the decision to be taken.
- (3) If a party who has been duly summoned to oral proceedings before the Office does not appear as summoned, the proceedings may continue without him.

Rule 57

Taking of evidence by the Office

- (1) Where the Office considers it necessary to hear the oral evidence of parties, of witnesses or of experts or to carry out an inspection, it shall take a decision to that end, stating the means by which it intends to obtain evidence, the relevant facts to be proved and the date, time and place of hearing or inspection. If oral evidence of witnesses and experts is requested by a party, the decision of the Office shall determine the period of time within which the party filing the request must make known to the Office the names and addresses of the witnesses and experts whom the party wishes to be heard.
- (2) The period of notice given in the summons of a party, witness or expert to give evidence shall be at least one month, unless they agree to a shorter period. The summons shall contain:
- (a) an extract from the decision mentioned in paragraph 1, indicating in particular the date, time and place of the hearing ordered and stating the facts regarding which the parties, witnesses and experts are to be heard;
- (b) the names of the parties to proceedings and particulars of the rights which the witnesses or experts may invoke under Rule 59 (2) to (5).

Rule 58

Commissioning of experts

- (1) The Office shall decide in what form the report made by an expert whom it appoints shall be submitted.
- (2) The terms of reference of the expert shall include:
- (a) a precise description of his task;
- (b) the time limit laid down for the submission of the expert report;

- (c) the names of the parties to the proceedings;
 - (d) particulars of the claims which he may invoke under Rule 59 (2), (3) and (4).
- (3) A copy of any written report shall be submitted to the parties.
- (4) The parties may object to an expert on grounds of incompetence or on the same grounds as those on which objection may be made to an examiner or to a member of a Division or Board of Appeal pursuant to Article 132 (1) and (3) of the Regulation. The department of the Office concerned shall rule on the objection.

Rule 59

Costs of taking of evidence

- (1) The taking of evidence by the Office may be made conditional upon deposit with it, by the party who has requested the evidence to be taken, of a sum which shall be fixed by reference to an estimate of the costs.
- (2) Witnesses and experts who are summoned by and appear before the Office shall be entitled to reimbursement of reasonable expenses for travel and subsistence. An advance for these expenses may be granted to them by the Office. The first sentence shall apply also to witnesses and experts who appear before the Office without being summoned by it and are heard as witnesses or experts.
- (3) Witnesses entitled to reimbursement under paragraph 2 shall also be entitled to appropriate compensation for loss of earnings, and experts to fees for their work. These payments shall be made to the witnesses and experts after they have fulfilled their duties or tasks, where such witnesses and experts have been summoned by the Office of its own initiative.
- (4) The amounts and the advances for expenses to be paid pursuant to paragraphs 1, 2 and 3 shall be determined by the President of the Office and shall be published in the Official Journal of the Office. The amounts shall be calculated on the same basis as the compensation and salaries received by officials in grades A4 to A8 as laid down in the Staff Regulations of Officials of the European Communities and Annex VII thereto.
- (5) Final liability for the amounts due or paid pursuant to paragraphs 1 to 4 shall lie with:
 - (a) the Office where the Office, at its own initiative, considered it necessary to hear the oral evidence of witnesses or experts;or
 - (b) the party concerned where that party requested the giving of oral evidence by witnesses or experts, subject to the decision on apportionment and fixing of costs pursuant to Articles 81 and 82 of the Regulation and Rule 94. Such party shall reimburse the Office for any advances duly paid.

Rule 60

Minutes of oral proceedings and of evidence

- (1) Minutes of oral proceedings or the taking of evidence shall be drawn up, containing the essentials of the oral proceedings or of the taking of evidence, the relevant statements made by the parties, the testimony of the parties, witnesses or experts and the result of any inspection.
- (2) The minutes of the testimony of a witness, expert or party shall be read out or submitted to him so that he may examine them. It shall be noted in the minutes that this formality has been carried out and that the person who gave the testimony approved the minutes. Where his approval is not given, his objections shall be noted.

- (3) The minutes shall be signed by the employee who drew them up and by the employee who conducted the oral proceedings or taking of evidence.
- (4) The parties shall be provided with a copy of the minutes.
- (5) Upon request, the Office shall make available to the parties transcripts of recordings of the oral proceedings, in typescript or in any other machine-readable form. The release under the first sentence of the oral proceedings shall be subject to the payment of the costs incurred by the Office in making such transcript. The amount to be charged shall be determined by the President of the Office.

Part C

Notifications

Rule 61

General provisions on notifications

- (1) In proceedings before the Office, any notifications to be made by the Office shall take the form of the original document, of a copy thereof certified by, or bearing the seal of, the Office or of a computer print-out bearing such seal. Copies of documents emanating from the parties themselves shall not require such certification.
- (2) Notifications shall be made
 - (a) by post in accordance with Rule 62;
 - (b) by hand delivery in accordance with Rule 63;
 - (c) by deposit in a post box at the Office in accordance with Rule 64;
 - (d) by telecopier and other technical means in accordance with Rule 65;
 - (e) by public notification in accordance with Rule 66.

Rule 62

Notification by post

- (1) Decisions subject to a time limit for appeal, summonses and other documents as determined by the President of the Office shall be notified by registered letter with advice of delivery. Decisions and communications subject to some other time limit shall be notified by registered letter, unless the President of the Office determines otherwise. All other communications shall be ordinary mail.
- (2) Notifications in respect of addresses having neither their domicile nor their principal place of business nor an establishment in the Community and who have not appointed a representative in accordance with Article 88 (2) of the Regulation shall be effected by posting the document requiring notification by ordinary mail to the last address of the addressee known to the Office. Notification shall be deemed to have been effected when the posting has taken place.
- (3) Where notification is effected by registered letter, whether or not with advice of delivery, this shall be deemed to be delivered to the addressee on the 10th day following that of its posting, unless the letter has failed to reach the addressee or has reached him at a later date. In the event of any dispute, it shall be for the Office to establish that the letter has reached its destination or to establish the date on which it was delivered to the addressee, as the case

may be.

- (4) Notification by registered letter, with or without advice of delivery, shall be deemed to have been effected even if the addressee refuses to accept the letter.
- (5) To the extent that notification by post is not covered by paragraphs 1 to 4, the law of the State on the territory of which notification is made shall apply.

Rule 63

Notification by hand delivery

Notification may be effected on the premises of the Office by hand delivery of the document to the addressee, who shall on delivery acknowledge its receipt.

Rule 64

Notification by deposit in a post box at the Office

Notification may also be effected to addressees who have been provided with a post box at the Office, by depositing the document therein. A written notification of deposit shall be inserted in the files. The date of deposit shall be recorded on the document. Notification shall be deemed to have taken place on the fifth day following deposit of the document in the post box at the Office.

Rule 65

Notification by telecopier and other technical means

- (1) Notification by telecopier shall be effected by transmitting either the original or a copy, as provided for in Rule 61 (1), of the document to be notified. The details of such transmission shall be determined by the President of the Office.
- (2) Details of notification by other technical means of communication shall be determined by the President of the Office.

Rule 66

Public notification

- (1) If the address of the addressee cannot be established, or if notification in accordance with Rule 62 (1) has proved to be impossible even after a second attempt by the Office, notification shall be effected by public notice. Such notice shall be published at least in the Community Trade Marks Bulletin.
- (2) The President of the Office shall determine how the public notice is to be given and shall fix the beginning of the one-month period on the expiry of which the document shall be deemed to have been notified.

Rule 67

Notification to representatives

- (1) If a representative has been appointed or where the applicant first named in a common application is considered to be the common representative pursuant to Rule 75 (1), notifications shall be addressed to that appointed or common representative.
- (2) If several representatives have been appointed for a single interested party, notification to any one of them shall be sufficient, unless a specific address for service has been indicated in accordance with Rule 1 (1) (e).
- (3) If several interested parties have appointed a common representative, notification of a single

document to the common representative shall be sufficient.

Rule 68

Irregularities in notification

Where a document has reached the addressee, if the Office is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document shall be deemed to have been notified on the date established by the Office as the date of receipt.

Rule 69

Notification of documents in the case of several parties

Documents emanating from parties which contain substantive proposals, or a declaration of withdrawal of a substantive proposal, shall be notified to the other parties as a matter of course. Notification may be dispensed with where the document contains no new pleadings and the matter is ready for decision.

Part D

Timelimits

Rule 70

Calculation of time limits

- (1) Periods shall be laid down in terms of full years, months, weeks or days.
- (2) Calculation shall start on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another period. Where that procedural step is a notification, the event considered shall be the receipt of the document notified, unless otherwise provided.
- (3) Where a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred. Where the relevant month has no day with the same number the period shall expire on the last day of that month.
- (4) Where a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred. Where the day on which the said event occurred was the last day of a month or where the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.
- (5) Where a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the said event occurred.

Rule 71

Duration of time limits

- (1) Where the Regulation or these Rules provide for a period to be specified by the Office, such period shall, when the party concerned has its domicile or its principal place of business or an establishment within the Community, be not less than one month, or, when those conditions are not fulfilled, not less than two months, and no more than six months. The Office may, when this is appropriate under the circumstances, grant an extension of a period specified if such extension is requested by the party concerned and the request is submitted before the original

period expired.

- (2) Where there are two or more parties, the Office may extend a period subject to the agreement of the other parties.

Rule 72

Expiry of time limits in special cases

- (1) If a time limit expires on a day on which the Office is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, ordinary mail is not delivered in the locality in which the Office is located, the time limit shall extend until the first day thereafter on which the Office is open for receipt of documents and on which ordinary mail is delivered. The days referred to in the first sentence shall be as determined by the President of the Office before the commencement of each calendar year.
- (2) If a time limit expires on a day on which there is a general interruption or subsequent dislocation in the delivery of mail in a Member State or between a Member State and the Office, the time limit shall extend until the first day following the end of the period of interruption or dislocation, for parties having their residence or registered office in the State concerned or who have appointed representatives with a place of business in that State. In the event of the Member State concerned being the State in which the Office is located, this provision shall apply to all parties. The duration of the abovementioned period shall be as determined by the President of the Office.
- (3) Paragraphs 1 and 2 shall apply *mutatis mutandis* to the time limits provided for in the Regulation or these Rules in the case of transactions to be carried out with the competent authority within the meaning of Article 25 (1) (b) of the Regulation.
- (4) If an exceptional occurrence such as natural disaster or strike interrupts or dislocates the proper functioning of the Office so that any communication from the Office to parties concerning the expiry of a time limit is delayed, acts to be completed within such a time limit may still be validly completed within one month after the notification of the delayed communication. The date of commencement and the end of any such interruption or dislocation shall be as determined by the President of the Office.

Part E

Interruption of proceedings

Rule 73

Interruption of proceedings

- (1) Proceedings before the Office shall be interrupted:
- (a) in the event of the death or legal incapacity of the applicant for or proprietor of a Community trade mark or of the person authorized by national law to act on his behalf. To the extent that the above events do not affect the authorization of a representative appointed under Article 89 of the Regulation, proceedings shall be interrupted only on application by such representative;
- (b) in the event of the applicant for or proprietor of a Community trade mark, as a result of some action taken against his property, being prevented for legal reasons from continuing the proceedings before the Office;
- (c) in the event of the death or legal incapacity of the representative of an applicant for or proprietor

of a Community trade mark or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the Office.

- (2) When, in the cases referred to in paragraph 1 (a) and (b), the Office has been informed of the identity of the person authorized to continue the proceedings before the Office, the Office shall communicate to such person and to any interested third parties that the proceedings shall be resumed as from a date to be fixed by the Office.
- (3) In the case referred to in paragraph 1 (c), the proceedings shall be resumed when the Office has been informed of the appointment of a new representative of the applicant or when the Office has notified to the other parties the communication of the appointment of a new representative of the proprietor of the Community trade mark. If, three months after the beginning of the interruption of the proceedings, the Office has not been informed of the appointment of a new representative, it shall inform the applicant for or proprietor of the Community trade mark:
 - (a) where Article 88 (2) of the Regulation is applicable, that the Community trade mark application will be deemed to be withdrawn if the information is not submitted within two months after this communication is notified; or
 - (b) where Article 88 (2) of the Regulation is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the Community trade mark as from the date on which this communication is notified.
- (4) The time limits, other than the time limit for paying the renewal fees, in force as regards the applicant for or proprietor of the Community trade mark at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed.

Part F

Waiving of enforced recovery procedures

Rule 74

Waiving of enforced recovery procedures

The President of the Office may waive action for the enforced recovery of any sum due where the sum to be recovered is minimal or where such recovery is too uncertain.

Part G

Representation

Rule 75

Appointment of a common representative

- (1) If there is more than one applicant and the application for a Community trade mark does not name a common representative, the applicant first named in the application shall be considered to be the common representative. However, if one of the applicants is obliged to appoint a professional representative, such representative shall be considered to be the common representative unless the applicant named first in the application has appointed a professional representative. The same shall apply *mutatis mutandis* to third parties acting in common in filing notice of opposition

or applying for revocation or for a declaration of invalidity, and to joint proprietors of a Community trade mark.

- (2) If, during the course of proceedings, transfer is made to more than one person, and such persons have not appointed a common representative, paragraph 1 shall apply. If such application is not possible, the Office shall require such persons to appoint a common representative within two months. If this request is not complied with, the Office shall appoint the common representative.

Rule 76

Authorizations

- (1) Representatives acting before the Office must file with it a signed authorization for inclusion in the files. The authorization may cover one or more applications or one or more registered trade marks.
- (2) A general authorization enabling a representative to act in respect of all trade mark transactions of the party giving the authorization may be filed.
- (3) The authorization may be filed in any language of the Office and in the language of the proceedings if that language is not one of the languages of the Office.
- (4) Where the appointment of a representative is communicated to the Office, the necessary authorization shall be filed within a period specified by the Office. If the authorization is not filed in due time, proceedings shall be continued with the represented person. Any procedural steps other than the filing of the application taken by the representative shall be deemed not to have been taken if the represented person does not approve them. The application of Article 88 (2) of the Regulation shall remain unaffected.
- (5) Paragraphs 1 to 3 shall apply *mutatis mutandis* to a document withdrawing an authorization.
- (6) Any representative who has ceased to be authorized shall continue to be regarded as the representative until the termination of his authorization has been communicated to the Office.
- (7) Subject to any provisions to the contrary contained therein, an authorization shall not terminate *vis-à-vis* the Office upon the death of the person who gave it.
- (8) Where several representatives are appointed by the same party, they may, notwithstanding any provisions to the contrary in their authorizations, act either jointly or singly.
- (9) The authorization of an association of representatives shall be deemed to be an authorization of any representative who can establish that he practises within that association.

Rule 77

Representation

Any notification or other communication addressed by the Office to the duly authorized representative shall have the same effect as if it had been addressed to the represented person. Any communication addressed to the Office by the duly authorized representative shall have the same effect as if it originated from the represented person.

Rule 78

Amendment of the list of professional representatives

- (1) The entry of a professional representative in the list of professional representatives, as referred to in Article 89 of the Regulation, shall be deleted at his request.
- (2) The entry of a professional representative shall be deleted automatically:

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- (a) in the event of the death or legal incapacity of the professional representative;
 - (b) where the professional representative is no longer a national of a Member State, unless the President of the Office has granted an exemption under Article 89 (4) (b) of the Regulation;
 - (c) where the professional representative no longer has his place of business or employment in the Community;
 - (d) where the professional representative no longer possesses the entitlement referred to in the first sentence of Article 89 (2) (c) of the Regulation.
- (3) The entry of a professional representative shall be suspended of the Office's own motion where his entitlement to represent natural or legal persons before the central industrial property office of the Member State as referred to in the first sentence of Article 89 (2) (c) has been suspended.
- (4) A person whose entry has been deleted shall, upon request pursuant to Article 89 (3) of the Regulation, be reinstated in the list of professional representatives if the conditions for deletion no longer exist.
- (5) The Benelux Trade Mark Office and the central industrial property offices of the Member States concerned shall, where they are aware thereof, promptly inform the Office of any relevant events under paragraphs 2 and 3.
- (6) The amendments of the list of professional representatives shall be published in the Official Journal of the Office.

Part H

Written communications and forms

Rule 79

Communication in writing or by other means

Applications for the registration of a Community trade mark as well as any other application provided for in the Regulation and all other communications addressed to the Office shall be submitted as follows:

- (a) by submitting a signed original of the document in question at the Office, such as by post, personal delivery, or by any other means; annexes to documents submitted need not be signed;
- (b) by transmitting a signed original by telecopier in accordance with Rule 80;
- (c) by telex or telegram in accordance with Rule 81;
- (d) by transmitting the contents of the communication by electronic means in accordance with Rule 82.

Rule 80

Communication by telecopier

- (1) Where an application for registration of a trade mark is submitted to the Office by telecopier and the application contains a reproduction of the mark pursuant to Rule 3 (2) which does not satisfy the requirements of that Rule, the required number of original reproductions shall be submitted to the Office in accordance with Rule 79 (a). Where the reproductions are received

by the Office within a period of one month from the date of the receipt of the telecopy by the Office, the application shall be deemed to have been received by the Office on the date on which the telecopy was received by the Office. Where the reproductions are received by the Office after the expiry of that period and the reproduction is necessary for the obtaining of a filing date, the application shall be deemed to have been received by the Office on the date on which the reproductions were received by the Office.

- (2) Where a communication received by telecopier is incomplete or illegible, or where the Office has reasonable doubts as to the accuracy of the transmission, the Office shall inform the sender accordingly and shall invite him, within a period to be specified by the Office, to retransmit the original by telecopy or to submit the original in accordance with Rule 79 (a). Where this request is complied with within the period specified, the date of the receipt of the retransmission or of the original shall be deemed to be the date of the receipt of the original communication, provided that where the deficiency concerns the granting of a filing date for an application to register a trade mark, the provisions on the filing date shall apply. Where the request is not complied with within the period specified, the communication shall be deemed not to have been received.
- (3) Any communication submitted to the Office by telecopier shall be considered to be duly signed if the reproduction of the signature appears on the printout produced by the telecopier.
- (4) The President of the Office may determine additional requirements of communication by telecopier, such as the equipment to be used, technical details of communication, and methods of identifying the sender.

Rule 81

Communication by telex or telegram

- (1) Where an application for registration of a trade mark is submitted to the Office by telex or by telegram and the application contains a reproduction of the mark pursuant to Rule 3 (2), Rule 80 (1) shall apply *mutatis mutandis*.
- (2) Where a communication is submitted by telex or telegram, Rule 80 (2) shall apply *mutatis mutandis*.
- (3) Where a communication is submitted by telex or telegram, the indication of the name of the sender shall be deemed equivalent to the signature.

Rule 82

Communication by electronic means

- (1) Where an application for registration of a trademark is submitted by electronic means and the application contains a reproduction of the mark pursuant to Rule 3 (2), Rule 80 (1) shall apply *mutatis mutandis*.
- (2) Where a communication is sent by electronic means, Rule 80 (2) shall apply *mutatis mutandis*.
- (3) Where a communication is sent to the Office by electronic means, the indication of the name of the sender shall be deemed to be equivalent to the signature.
- (4) The President of the Office shall determine the requirements as to communication by electronic means, such as the equipment to be used, technical details of communication, and methods of identifying the sender.

Rule 83

Forms

- (1) The Office shall make available free of charge forms for the purpose of:
 - (a) filing an application for a Community trade mark;
 - (b) entering opposition to registration of a Community trade mark;
 - (c) applying for an amendment of an application or a registration, for correction of names and addresses and of mistakes and errors;
 - (d) applying for the registration of a transfer and the transfer form and transfer document provided for in Rule 31 (5);
 - (e) applying for the registration of a licence;
 - (f) applying for renewal of the registration of a Community trade mark;
 - (g) applying for revocation or for a declaration of invalidity of a Community trade mark;
 - (h) applying for restitutio in integrum;
 - (i) making an appeal;
 - (j) authorizing a representative, in the form of an individual authorization and in the form of a general authorization.
- (2) The Office may make other forms available free of charge.
- (3) The Office shall make available the forms referred to in paragraphs 1 and 2 in all the official languages of the Community.
- (4) The Office shall place the forms at the disposal of the Benelux Trade Mark Office and the Member States' central industrial property offices free of charge.
- (5) The Office may also make available the forms in machine-readable form.
- (6) Parties to proceedings before the Office shall use the forms provided by the Office, or copies of these forms, or forms with the same content and format as these forms, such as forms generated by means of electronic data processing.
- (7) Forms shall be completed in such a manner as to permit an automated input of the content into a computer, such as by character recognition or scanning.

Part I

Information of the public

Rule 84

Register of Community Trade Marks

- (1) The Register of Community Trade Marks may be maintained in the form of an electronic database.
- (2) The Register of Community Trade Marks shall contain the following entries:
 - (a) the date of filing the application;
 - (b) the file number of the application;
 - (c) the date of the publication of the application;
 - (d) the name, the address and the nationality of the applicant and the State in which he is domiciled

or has his seat or establishment;

- (e) the name and business address of the representative, other than a representative falling within the first sentence of Article 88 (3) of the Regulation; where there is more than one representative, only the name and business address of the first named representative, followed by the words and others, shall be recorded; where an association of representatives is appointed, only the name and address of the association shall be recorded;
 - (f) the reproduction of the mark, with indications as to its nature, unless it is a mark falling under Rule 3 (1); where the registration of the mark is in colour, the indication 'in colour` with an indication of the colour or colours making up the mark; where applicable, a description of the mark;
 - (g) an indication of the goods and services by their names, grouped according to the classes of the Nice Classification; each group shall be preceded by the number of the class of that classification to which that group of goods and services belongs and shall be presented in the order of the classes of that classification
 - (h) particulars of claims of priority pursuant to Article 30 of the Regulation;
 - (i) particulars of claims of exhibition priority pursuant to Article 33 of the Regulation;
 - (j) particulars of claims of seniority of an earlier registered trade mark as referred to in Article 34 of the Regulation;
 - (k) a statement that the mark has become distinctive in consequence of the use which has been made of it, pursuant to Article 7 (3) of the Regulation;
 - (l) a declaration by the applicant disclaiming any exclusive right to some element of the mark pursuant to Article 38 (2) of the Regulation;
 - (m) an indication that the mark is a collective mark;
 - (n) the language in which the application was filed and the second language which the applicant has indicated in his application, pursuant to Article 115 (3) of the Regulation;
 - (o) the date of registration of the mark in the Register and the registration number.
- (3) The Register of Community Trade Marks shall also contain the following entries, each accompanied by the date of recording of such entry:
- (a) changes in the name, the address or the nationality of the proprietor of a Community trade mark or in the State in which he is domiciled or has his seat or establishment;
 - (b) changes in the name or business address of the representative, other than a representative falling within Article 88 (3), first sentence, of the Regulation;
 - (c) when a new representative is appointed, the name and business address of that representative;
 - (d) alterations of the mark pursuant to Article 48 of the Regulation and corrections of mistakes and errors;
 - (e) notice of amendments to the regulations governing the use of the collective mark pursuant to Article 69 of the Regulation;
 - (f) particulars of claims of seniority of an earlier registered trade mark as referred to in Article 34 of the Regulation, pursuant to Article 35 of the Regulation;
 - (g) total or partial transfers pursuant to Article 17 of the Regulation;

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- (h) the creation or transfer of a right in rem pursuant to Article 19 of the Regulation and the nature of the right in rem;
 - (i) levy of execution pursuant to Article 20 of the Regulation and bankruptcy or like proceedings pursuant to Article 21 of the regulation;
 - (j) the grant or transfer of a licence pursuant to Article 22 of the Regulation and, where applicable, the type of licence pursuant to Rule 34;
 - (k) renewal of the registration pursuant to Article 47 of the Regulation, the date from which it takes effect and any restrictions pursuant to Article 47 (4) of the Regulation;
 - (l) a record of the determination of the expiry of the registration pursuant to Article 47 of the Regulation;
 - (m) a declaration of surrender by the proprietor of the mark pursuant to Article 49 of the Regulation;
 - (n) the date of submission of an application pursuant to Article 55 of the Regulation or of the filing of a counterclaim pursuant to Article 96 (4) of the Regulation for revocation or for a declaration of invalidity;
 - (o) the date and content of the decision on the application or counterclaim pursuant to Article 56 (6) or the third sentence of Article 96 (6) of the Regulation;
 - (p) a record of the receipt of a request for conversion pursuant to Article 109 (2) of the Regulation;
 - (q) the cancellation of the representative recorded pursuant to paragraph 2 (e);
 - (r) the cancellation of the seniority of a national mark;
 - (s) the modification or cancellation from the Register of the items referred to in subparagraphs (h), (i) and (j).
- (4) The President of the Office may determine that items other than those referred to in paragraphs 2 and 3 shall be entered in the Register.
- (5) The proprietor of the trade mark shall be notified of any change in the Register.
- (6) The Office shall provide certified or uncertified extracts from the Register on request, on payment of a fee.

Part J

Community Trade Marks Bulletin and Official Journal of the Office

Rule 85

Community Trade Marks Bulletin

- (1) The Community Trade Marks Bulletin shall be published in periodic editions. The Office may make available to the public editions of the Bulletin on CD-ROM or in any other machine-readable form.
- (2) The Community Trade Marks Bulletin shall contain publications of applications and of entries made in the Register as well as other particulars relating to applications or registrations of trade marks whose publication is prescribed by the Regulation or by these Rules.
- (3) Where particulars whose publication is prescribed in the Regulation or in these Rules are

published in the Community Trade Marks Bulletin, the date of issue shown on the Bulletin shall be taken as the date of publication of the particulars.

- (4) To the extent that the entries regarding the registration of a trade mark contain no changes as compared to the publication of the application, the publication of such entries shall be made by way of a reference to the particulars contained in the publication of the application.
- (5) The elements of the application for a Community trade mark, as set out in Article 26 (1) of the Regulation as well as any other information the publication of which is prescribed in Rule 12 shall, where appropriate, be published in all the official languages of the Community.
- (6) The Office shall take into account any translation submitted by the applicant. If the language of the application is not one of the languages of the Office, the translation into the second language indicated by the applicant shall be communicated to the applicant. The applicant may propose changes to the translation within a period to be specified by the Office. If the applicant does not respond within this period or if the Office considers the proposed changes to be inappropriate, the translation proposed by the Office shall be published.

Rule 86

Official Journal of the Office

- (1) The Official Journal of the Office shall be published in periodic editions. The Office may make available to the public editions of the Official Journal on CD-ROM or in any other machine-readable form.
- (2) The Official Journal shall be published in the languages of the Office. The President of the Office may determine that certain items shall be published in all the official languages of the Community.

Rule 87

Data bank

- (1) The Office shall maintain an electronic data bank with the particulars of applications for registration of trade marks and entries in the Register. The Office may also make available the contents of this data bank on CD-ROM or in any other machine-readable form.
- (2) The President of the Office shall determine the conditions of access to the data bank and the manner in which the contents of this data bank may be made available in machine-readable form, including the charges for these acts.

Part K

Inspection of files and keeping of files

Rule 88

Parts of the file excluded from inspection

The parts of the file which shall be excluded from inspection pursuant to Article 84 (4) of the Regulation shall be:

- (a) documents relating to exclusion or objection pursuant to Article 132 of the Regulation;
- (b) draft decisions and opinions, and all other internal documents used for the preparation of decisions and opinions;

- (c) parts of the file which the party concerned showed a special interest in keeping confidential before the application for inspection of the files was made, unless inspection of such part of the file is justified by overriding legitimate interests of the party seeking inspection.

Rule 89

Procedures for the inspection of files

- (1) Inspection of the files of Community trade mark applications and of registered Community trade marks shall either be of the original document, or of copies thereof, or of technical means of storage if the files are stored in this way. The means of inspection shall be determined by the President of the Office. The request for inspection of the files shall not be deemed to have been made until the required fee has been paid.
- (2) Where inspection of the files of a Community trade mark application is requested, the request shall contain an indication and evidence to the effect that the applicant
- (a) has consented to the inspection; or
- (b) has stated that after the trade mark has been registered he will invoke the rights under it against the party requesting the inspection.
- (3) Inspection of the files shall take place on the premises of the Office.
- (4) On request, inspection of the files shall be effected by means of issuing copies of file documents. Such copies shall incur fees.
- (5) The office shall issue on request certified or uncertified copies of the application for a Community trade mark or of those file documents of which copies may be issued pursuant to paragraph 4 upon payment of a fee.

Rule 90

Communication of information contained in the files

Subject to the restrictions provided for in Article 84 of the Regulation and Rule 88, the Office may, upon request, communicate information from any file of a Community trade mark applied for or of a registered Community trade mark, subject to payment of a fee. However, the Office may require the exercise of the option to obtain inspection of the file itself should it deem this to be appropriate in view of the quantity of information to be supplied.

Rule 91

Keeping of files

- (1) The Office shall keep the files relating to Community trade mark applications and registered Community trade marks for at least five years from the end of the year in which:
- (a) the application is rejected or withdrawn or is deemed to be withdrawn;
- (b) the registration of the Community trade mark expires completely pursuant to Article 47 of the Regulation;
- (c) the complete surrender of the Community trade mark is registered pursuant to Article 49 of the Regulation;
- (d) the Community trade mark is completely removed from the Register pursuant to Article 56 (6) or Article 96 (6) of the Regulation.
- (2) The President of the Office shall determine the form in which the files shall be kept.

Part L

Administrative cooperation

Rule 92

Exchange of information and communications between the Office and the authorities of the Member States

- (1) The Office and the central industrial property offices of the Member States shall, upon request, communicate to each other relevant information about the filing of applications for Community trade marks or national marks and about proceedings relating to such applications and the marks registered as a result thereof. Such communications shall not be subject to the restrictions provided for in Article 84 of the Regulation.
- (2) Communications between the Office and the courts or authorities of the Member States which arise out of the application of the Regulation or these Rules shall be effected directly between these authorities. Such communication may also be effected through the central industrial property offices of the Member States.
- (3) Expenditure in respect of communications under paragraphs 1 and 2 shall be chargeable to the authority making the communications, which shall be exempt from fees.

Rule 93

Inspection of files by or via courts or authorities of the Member States

- (1) Inspection of files relating to Community trade marks applied for or registered Community trade marks by courts or authorities of the Member States be of the original documents or of copies thereof, otherwise Rule 89 shall not apply.
- (2) Courts or Public Prosecutors' Offices of the Member States may, in the course of proceedings before them, open files or copies thereof transmitted by the Office to inspection by third parties. Such inspection shall be subject to Article 84 of the Regulation. The Office shall not charge any fee for such inspection.
- (3) The Office shall, at the time of transmission of the files or copies thereof to the courts or Public Prosecutors' Offices of the Member States, indicate the restrictions to which the inspection of files relating to Community trade marks applied for or registered Community trade marks is subject pursuant to Article 84 of the Regulation and Rule 88.

Part M

Costs

Rule 94

Apportionment and fixing of costs

- (1) Apportionment of costs pursuant to Article 81 (1) and (2) of the Regulation shall be dealt with in the decision on the opposition, the decision on the application for revocation or for a declaration of invalidity of a Community trade mark, or the decision on the appeal.
- (2) Apportionment of costs pursuant to Article 81 (3) and (4) of the Regulation shall be dealt

with in a decision on costs by the Opposition Division, the Cancellation Division or the Board of Appeal.

- (3) A bill of costs, with supporting evidence, shall be attached to the request for the fixing of costs provided for in the first sentence of Article 81 (6) of the Regulation. The request shall be admissible only if the decision in respect of which the fixing of costs is required has become final. Costs may be fixed once their credibility is established.
- (4) The request provided for in the second sentence of Article 81 (6) of the Regulation for a review of the decision of the registry on the fixing of costs, stating the reasons on which it is based, must be filed at the Office within one month after the date of notification of the awarding of costs. It shall not be deemed to be filed until the fee for reviewing the amount of the costs has been paid.
- (5) The Opposition Division, the Cancellation Division or the Board of Appeal, as the case may be, shall take a decision on the request referred to in paragraph 4 without oral proceedings.
- (6) The fees to be borne by the losing party pursuant to Article 81 (1) of the Regulation shall be limited to the fees incurred by the other party for opposition, for an application for revocation or for a declaration of invalidity of the Community trade mark and for appeal.
- (7) Cost essential to the proceedings and actually incurred by the successful party shall be borne by the losing party in accordance with Article 81 (1) of the Regulation on the basis of the following maximum rates:
 - (a) travel expenses of one party for the outward and return journey between the place of residence or the place of business and the place where oral proceedings are held or where evidence is taken, as follows:
 - (i) the cost of the first-class rail-fare including usual transport supplements where the total distance by rail does not exceed 800 km;
 - (ii) the cost of the tourist-class air-fare where the total distance by rail exceeds 800 km or the route includes a sea-crossing;
 - (b) subsistence expenses by one party equal to the daily subsistence allowance for officials in grades A4 to A8 as laid down in Article 13 of Annex VII to the Staff Regulations of Officials of the European Communities;
 - (c) travel expenses of representatives within the meaning of Article 89 (1) of the Regulation and of witnesses and of experts, at the rates provided for in subparagraph (a);
 - (d) subsistence expenses of representatives within the meaning of Article 89 (1) of the Regulation and of witnesses and experts, at the rates provided for in subparagraph (b);
 - (e) costs entailed in the taking of evidence in the form of examination of witnesses, opinions by experts or inspection
up to ECU 300 per proceedings;
 - f) cost of representation, within the meaning of Article 89 (1) of the Regulation,
 - (i) of the opposing party in opposition proceedings:
up to ECU 250;
 - (ii) of the applicant in opposition proceedings:
up to ECU 250;

- (iii) of the applicant in proceedings relating to revocation or invalidity of a Community trade mark:
up to ECU 400;
- (iv) of the proprietor of the trade mark in proceedings relating to revocation or invalidity of a Community trade mark:
up to ECU 400;
- (v) of the appellant in appeal proceedings:
up to ECU 500;
- (vi) of the defendant in appeal proceedings:
up to ECU 500;
- Where the taking of evidence in any of the abovementioned proceedings involves the examination of witnesses, opinions by experts or inspection, an additional amount shall be granted for representation costs of up to ECU 600 per proceedings;
- (g) where the successful party is represented by more than one representative within the meaning of Article 89 (1) of the Regulation, the losing party shall bear the costs referred to in subparagraphs (c), (d) and (f) for one such person only;
- (h) the losing party shall not be obliged to reimburse the successful party for any costs, expenses and fees other than those referred to in subparagraphs (a) to (g).

Part N

Languages

Rule 95

Applications and declarations

Without prejudice to Article 115 (5) of the Regulation,

- (a) any application or declaration relating to a Community trade mark application may be filed in the language used for filing the application for a Community trade mark or in the second language indicated by the applicant in his application;
- (b) any application or declaration relating to a registered Community trade mark may be filed in one of the languages of the Office. However, when the application is filed by using any of the forms provided by the Office pursuant to Rule 83, such forms may be used in any of the official languages of the Community, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

Rule 96

Written proceedings

- (1) Without prejudice to Article 115 (4) and (7) of the Regulation, and unless otherwise provided for in these Rules, in written proceedings before the Office any party may use any language of the Office. If the language chosen is not the language of the proceedings, the party shall supply a translation into that language within one month from the date of the submission of the original document. Where the applicant for a Community trade mark is the sole party to proceedings before the Office and the language used for the filing of the application for the Community

trade mark is not one of the languages of the Office, the translation may also be filed in the second language indicated by the applicant in his application.

- (2) Unless otherwise provided for in these Rules, documents to be used in proceedings before the Office may be filed in any official language of the Community. Where the language of such documents is not the language of the proceedings the Office may require that a translation be supplied, within a period specified by it, in that language or, at the choice of the party to the proceeding, in any language of the Office.

Rule 97

Oral proceedings

- (1) Any party to oral proceedings before the Office may, in place of the language of proceedings, use one of the other official languages of the Community, on condition that he makes provision for interpretation into the language of proceedings. Where the oral proceedings are held in a proceeding concerning the application for registration of a trade mark, the applicant may use either the language of the application or the second language indicated by him.
- (2) In oral proceedings concerning the application for registration of a trade mark, the staff of the Office may use either the language of the application or the second language indicated by the applicant. In all other oral proceedings, the staff of the Office may use, in place of the language of the proceedings, one of the other languages of the Office, on condition that the party or parties to the proceedings agree to such use.
- (3) In the case of taking of evidence, any party to be heard, witness or expert who is unable to express himself adequately in the language of proceedings, may use any of the official languages of the Community. Should the taking of evidence be decided upon following a request by a party to the proceedings, parties to be heard, witnesses or experts who express themselves in languages other than the language of proceedings may be heard only if the party who made the request makes provision for interpretation into that language. In proceedings concerning the application for registration of a trade mark, in place of the language of the application, the second language indicated by the applicant may be used. In any proceedings with only one party the Office may on request of the party concerned permit derogations from the provisions in this paragraph.
- (4) If the parties and Office so agree, any official language of the Community may be used in oral proceedings.
- (5) The Office shall, if necessary, make provision at its own expense for interpretation into the language of proceedings, or, where appropriate, into its other languages, unless this interpretation is the responsibility of one of the parties to the proceedings.
- (6) Statements by staff of the Office, by parties to the proceedings and by witnesses and experts, made in one of the languages of the Office during oral proceedings shall be entered in the minutes in the language employed. Statements made in any other language shall be entered in the language of proceedings. Amendments to the text of the application for or the registration of a Community trade mark shall be entered in the minutes in the language of proceedings.

Rule 98

Certification of translations

- (1) When a translation of any document is to be filed, the Office may require the filing, within a period to be specified by it, of a certificate that the translation corresponds to the original text. Where the certificate relates to the translation of a previous application pursuant to Article 30 of the Regulation, such period shall not be less than three months after the date

of filing of the application. Where the certificate is not filed within that period, the document shall be deemed not to have been received.

- (2) The President of the Office may determine the manner in which translations are certified.

Rule 99

Legal authenticity of translations

In the absence of evidence to the contrary, the Office may assume that a translation corresponds to the relevant original text.

Part O

Organization of the Office

Rule 100

Allocation of duties

- (1) The President of the Office shall determine the examiners and their number, the members of the Opposition Divisions and Cancellation Divisions, and the members of the Administration of Trade Marks and Legal Division. He shall allocate duties to the examiners and the Divisions.
- (2) The President of the Office may provide that examiners may also be members of the Opposition Divisions, Cancellation Divisions, and the Administration of Trade Marks and Legal Division, and that members of these Divisions may also be examiners.
- (3) In addition to the responsibilities vested in them under the Regulation, the President of the Office may allocate further duties to the examiners and the members of the Opposition Divisions, Cancellation Divisions and the Administration of Trade Marks and Legal Division.
- (4) The President of the Office may entrust to other members of the staff of the Office who are not examiners or members of any of the Divisions mentioned in paragraph 1 the execution of individual duties falling to the examiners, Opposition Divisions, Cancellation Divisions or the Administration of Trade Marks and Legal Division and involving no special difficulties.

TITLE XII

RECIPROCITY

Rule 101

Publication of reciprocity

- (1) If necessary, the President of the Office shall request the Commission to enquire whether a State which is not party to the Paris Convention or to the Agreement establishing the World Trade Organization accords reciprocal treatment within the meaning of Article 5 (1) (d), Article 5 (3) and Article 29 (5) of the Regulation.
- (2) If the Commission determines that reciprocal treatment in accordance with paragraph 1 is accorded, it shall publish a communication to this effect in the Official Journal of the European Communities.
- (3) Article 5 (1) (d), Article 5 (3) and Article 29 (5) of the Regulation shall take effect for the nationals of the States concerned from the date of publication in the Official Journal of the European Communities of the communication referred to in paragraph 2, unless the communications states an earlier date from which it is applicable. They shall cease to be effective from the

date of publication in the Official Journal of the European Communities of a communication of the Commission to the effect that reciprocal treatment is no longer accorded, unless the communication states an earlier date from which it is applicable.

- (4) Communications referred to in paragraphs 2 and 3 shall also be published in the Official Journal of the Office.

Article 2

Transitional Provisions

- (1) Any application for registration of a Community trade mark filed within three months prior to the date determined pursuant to Article 143 (3) of the Regulation shall be marked by the Office with the filing date determined pursuant to that provision and with the actual date of receipt of the application.
- (2) With regard to the application, the priority period of six months provided for in Articles 29 and 33 of the Regulation shall be calculated from the date determined pursuant to Article 143 (3) of the Regulation.
- (3) The Office may issue a receipt to the applicant prior to the date determined pursuant to Article 143 (3) of the Regulation.
- (4) The Office may examine the applications prior to the date determined pursuant to Article 143 (3) of the Regulation and communicate with the applicant with a view to remedying any deficiencies prior to that date. Any decisions with regard to such applications may be taken only after that date.
- (5) With regard to the application, the Office shall not carry out any search pursuant to Article 39 (1) of the Regulation, regardless of whether or not a priority was claimed for such application pursuant to Articles 29 or 33 of the Regulation.
- (6) Where the date of receipt of an application for the registration of a Community trade mark by the Office, by the central industrial property office of a Member State or by the Benelux Trade Mark Office is before the commencement of the three months period specified in Article 143 (4) of the Regulation the application shall be deemed not to have been filed. The application shall be informed accordingly and the application shall be sent back to him.

Article 3

Entry into force

This Regulation shall enter into force on the seventh day following that of its publication in the Official Journal of the European Communities.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 13 December 1995.

For the Commission

Mario MONTI

Member of the Commission

- (1) OJ No L 11, 14. 1. 1994, p. 1.
(2) OJ No L 349, 31. 12. 1994, p. 83
(3) See p. 33 of this Official Journal.

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**Commission Regulation (EC) No 1041/2005
of 29 June 2005
amending Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the
Community trade mark (Text with EEA relevance)**

Commission Regulation (EC) No 1041/2005

of 29 June 2005

amending Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the
Community trade mark

(Text with EEA relevance)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark
[1], and in particular Article 157 thereof,

Whereas:

- (1) According to Regulation (EC) No 40/94, it is necessary to adopt technical measures to implement dispositions concerning the standard form for the searches reports, division of the application and registration, revocation of decisions, authorisations, and decisions taken by a single member of the Opposition or Cancellation Division.
- (2) After 10 March 2008 the search system will remain compulsory for Community trade marks, but it should be made optional, subject to the payment of a fee, for searches in the trade mark registers of the Member States which notified their own decision to carry out a search. A standard form comprising essential elements for the search report is hereby laid out with a view to improving the quality and uniformity of such search reports.
- (3) The declaration of division and registration must comply with the elements set out in the present regulation. The new ex officio revocation of a decision or an entry in the register by the Office for Harmonization in the Internal Market (trade marks and designs) (The Office) must comply with the specific procedure as established in the present regulation. The exceptional cases where an authorisation is mandatory are specified. A list of simple cases where a decision can be taken by a single member of the Opposition or Cancellation Divisions is provided for.
- (4) Furthermore, existing rules should be amended in order to improve or clarify the procedure for registration. In addition, certain procedural points should be amended without changing the substance of the system.
- (5) In order to cover the specificities and facilities of the e-filing procedure, the following provisions are amended: Rule 1(1)(c), Rule 3(2), Rule 61, Rule 72(4), Rule 79, Rule 82, Rule 89(1) and (2).
- (6) The electronic filing and electronic publication of Community trade mark applications should facilitate the filing of trade marks in general and in particular enhance the filing of trade marks consisting of colours per se or sounds by means of a representation of the mark which is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The technical conditions, in particular the data format for sound files, should be laid down by the President of the Office. E-filing of trade marks consisting of sounds can be accompanied by an electronic sound file and this file can be included in the electronic publication of the Community trade mark applications to facilitate public access to the sound itself.

- (7) The provisions concerning the opposition procedure should be reframed completely as to specify the admissibility requirements, to specify clearly the legal consequences of deficiencies and to bring the provisions in the chronological order of the proceedings.
- (8) Following the additional competence of the Office for the examination of the admissibility of conversion the refusal of a request for conversion may become partial in the sense that conversion can be acceptable for some Member States but inadmissible for others. In addition, some criteria to be used for examining absolute grounds by reference to the language of a Member State should be added.
- (9) Regarding costs to be born by the losing party in opposition and cancellation procedures, reimbursable costs of the representation should be limited but the present maximum amounts should be increased slightly in view of the time elapsed since adoption of the Implementing Regulation. Where witnesses or experts are summoned, no such maximum rate should be provided but the reimbursable costs shall comprise the actual amounts those witnesses and experts can claim.
- (10) Commission Regulation (EC) No 2868/95 [2] should therefore be amended accordingly.
- (11) The measures provided for in this Regulation are in accordance with the opinion of the Committee on Fees, Implementation Rules and the Procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (trade marks and designs),

HAS ADOPTED THIS REGULATION:

Article 1

Article 1 of Regulation (EC) No 2868/95 is amended as follows:

1. Rule 1(1) is amended as follows:

(a) point (b) is replaced by the following:

"(b) the name, address and nationality of the applicant and the State in which he is domiciled or has his seat or an establishment. Names of natural persons shall be indicated by the persons family name and given name(s). Names of legal entities, as well as bodies falling under Article 3 of the Regulation, shall be indicated by their official designation and include the legal form of the entity, which may be abbreviated in a customary manner. The telephone numbers, fax numbers, electronic mail address and details of other data communications links under which the applicant accepts to receive communications may be given. Only one address shall, in principle, be indicated for each applicant. Where several addresses are indicated, only the address mentioned first shall be taken into account, except where the applicant designates one of the addresses as an address for service;"

(b) in point (c), the following is added:

", or a reference to the list of the goods and services of a previous Community trade mark application;"

(c) point (k) is replaced by the following:

"(k) the signature of the applicant or his representative in accordance with Rule 79;"

(d) point (l) is added:

"(l) where applicable, the request of a search report referred to in Article 39(2) of the Regulation.";

2. Rule 3 is amended as follows:

(a) paragraph 2 is replaced by the following:

"2. In cases other than those referred to in paragraph 1 and save where the application is filed by electronic means, the mark shall be reproduced on a sheet of paper separate from the sheet on which the text of the application appears. The sheet on which the mark is reproduced shall not exceed DIN A4 size (29,7 cm high, 21 cm wide) and the space used for the reproduction (type-area) shall not be larger than 26,2 cm x 17 cm. A margin of at least 2,5 cm shall be left on the left-hand side. Where it is not obvious, the correct position of the mark shall be indicated by adding the word "top" to each reproduction. The reproduction of the mark shall be of such quality as to enable it to be reduced or enlarged to a size not more than 8 cm wide by 16 cm high for publication in the Community Trade Mark Bulletin.";

(b) paragraphs 5 and 6 are replaced by the following:

"5. Where registration in colour is applied for, the representation of the mark under paragraph 2 shall consist of the colour reproduction of the mark. The colours making up the mark shall also be indicated in words and a reference to a recognized colour code may be added.

6. Where registration of a sound mark is applied for, the representation of the trade mark shall consist of a graphical representation of the sound, in particular a musical notation; where the application is filed through electronic means, it may be accompanied by an electronic file containing the sound. The President of the Office shall determine the formats and maximum size of the electronic file.";

3. Rule 4 is replaced by the following:

"Rule 4

Fees for the application

The fees payable for the application shall be:

- (a) the basic fee;
- (b) a class fee for each class exceeding three to which the goods or services belong according to Rule 2;
- (c) where applicable, the search fee.";

4. The following Rule 5a is inserted:

"Rule 5a

Search report

The search reports shall be prepared using a standard form which contains at least the following information:

- (a) the name of the central industrial property offices that carried out the search;
- (b) the number of the trademark applications or registrations mentioned in the search report;
- (c) the date of application and if applicable date of priority of the trademark applications or registrations mentioned in the search report;
- (d) the date of registration of the trademarks mentioned in the search report;
- (e) the name and contact address of the holder of the trademarks applications or registrations mentioned in the search report;
- (f) a representation of the trademarks applied for or registered mentioned in the search report;

(g) an indication of the classes, according to the Nice Classification, for which the earlier national trademarks are applied for or registered or of the goods and services for which the trademarks mentioned in the search report are either applied for or registered.";

5. In Rule 6(1) the following sentence is added:

"If the previous application is a Community trade mark application, the Office shall ex officio include a copy of the previous application in the file of the Community trade mark application.";

6. Rule 8(2) is replaced by the following:

"2. Where the applicant wishes to claim the seniority of one or more earlier registered trade marks as referred to in Article 34 of the Regulation, subsequent to the filing of the application, the declaration of seniority, indicating the Member State or Member States in or for which the mark is registered, the number and the filing date of the relevant registration, and the goods and services for which the mark is registered, shall be submitted within a period of two months from the filing date. The evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of seniority.";

7. Rule 10 is replaced by the following:

"Rule 10

Searches by national offices

1. If the request for a search report referred to in Article 39(2) of the Regulation is not made in the application for a Community trade mark, or if the search fee referred to in Rule 4(c) is not paid within the time limit for paying the basic application fee, the application shall not be subjected to a search by the central industrial property offices.

2. An international registration designating the European Community shall not be subjected to a search by the central industrial property offices if the request for a search report pursuant to Article 39(2) of the Regulation is not made to the Office within one month starting with the date on which the International Bureau notifies the international registration to the Office, or if the search fee is not paid within the same period.";

8. Point (c) of Rule 12 is replaced by the following:

"(c) the reproduction of the mark, together with the elements and descriptions referred to in Rule 3; where the reproduction of the mark is in colour or contains colours, the publication shall be in colour and shall indicate the colour or colours making up the mark, as well as, where applicable, the colour code indicated";

9. In Rule 13, point (c) of paragraph 1, and paragraph 2 are deleted;

10. The following Rule 13a is inserted:

"Rule 13a

Division of the application

1. A declaration of the division of the application pursuant to Article 44a of the Regulation shall contain:

(a) the file number of the application;

(b) the name and address of the applicant in accordance with Rule 1(1)(b);

(c) the list of goods and services which shall form the divisional application, or, where the division into more than one divisional application is sought, the list of goods and services for each

divisional application;

(d) the list of goods and services which shall remain in the original application.

2. Where the Office finds that the requirements laid down in paragraph 1 are not fulfilled or the list of goods and services which shall form the divisional application overlap with the goods and services which shall remain in the original application, it shall invite the applicant to remedy the deficiencies noted within such period as it may specify.

If the deficiencies are not remedied before the time limit expires, the Office shall refuse the declaration of division.

3. The periods as referred to in Article 44a(2)(b) of the Regulation during which a declaration of division of the application is not admissible shall be:

- (a) the period before a date of filing has been accorded;
- (b) the period of three months following the publication of the application provided for in Article 42(1) of the Regulation;
- (c) the period after the date of issue of the notification to pay the registration fee referred to in Rule 23(1).

4. Where the Office finds, that the declaration of division is inadmissible pursuant to Article 44a of the Regulation or pursuant to paragraph 3(a) and (b), it shall refuse the declaration of division.

5. The Office shall establish a separate file for the divisional application, which shall consist of a complete copy of the file of the original application, including the declaration of division and the correspondence relating thereto. The Office shall assign a new application number to the divisional application.

6. Where the declaration of division relates to an application which has already been published pursuant to Article 40 of the Regulation, the division shall be published in the Community Trade Marks Bulletin. The divisional application shall be published; the publication shall contain the indications and elements referred to in Rule 12. The publication does not open a new period for the filing of oppositions.";

11. Rules 15 to 20 are replaced by the following:

"Rule 15

Notice of opposition

1. A notice of opposition may be entered on the basis of one or more earlier marks within the meaning of Article 8(2) of the Regulation (earlier marks) and one and/or more other earlier rights within the meaning of Article 8(4) of the Regulation (earlier rights), provided that the earlier marks or earlier rights all belong to the same proprietor or proprietors. If an earlier mark and/or an earlier right has more than one proprietor (co-ownership), the opposition may be filed by any or all of them.

2. The notice of opposition shall contain:

- (a) the file number of the application against which opposition is entered and the name of the applicant for the Community trade mark;
- (b) a clear identification of the earlier mark or earlier right on which the opposition is based, namely:

-
- (i) where the opposition is based on an earlier mark within the meaning of Article 8(2)(a) or (b) of the Regulation or where the opposition is based on Article 8(3) of the Regulation, the indication of the file number or registration number of the earlier mark, the indication whether the earlier mark is registered or an application for registration, as well as the indication of the Member States including, where applicable, the Benelux, in or for which the earlier mark is protected, or, if applicable, the indication that it is a Community trade mark;
 - (ii) where the opposition is based on a well-known mark within the meaning of Article 8(2)(c) of the Regulation, the indication of the Member State where the mark is well-known and either the indications referred to in point (i) or a representation of the mark;
 - (iii) where the opposition is based on an earlier right within the meaning of Article 8(4), an indication of its kind or nature, a representation of the earlier right, and an indication of whether this earlier right exists in the whole Community or in one or more Member States, and if so, an indication of the Member States;
 - (c) the grounds on which the opposition is based, namely a statement to the effect that the respective requirements under Article 8(1), (3), (4) and (5) of the Regulation are fulfilled;
 - (d) the filing date and, where available, the registration date and the priority date of the earlier mark, unless it is an unregistered well-known trade mark;
 - (e) a representation of the earlier mark as registered or applied for; if the earlier mark is in colour, the representation shall be in colour;
 - (f) the goods and services on which the opposition is based;
 - (g) where the opposition is based on an earlier mark having a reputation within the meaning of Article 8(5) of the Regulation, an indication of the Member State in which, and the goods and services for which, the mark has a reputation;
 - (h) as concerns the opposing party:
 - (i) the name and address of the opposing party in accordance with Rule 1(1)(b);
 - (ii) where the opposing party has appointed a representative, the name and business address of the representative in accordance with Rule 1(1)(e);
 - (iii) where the opposition is entered by a licensee or by a person who is entitled under the relevant national law to exercise an earlier right, a statement to that effect and indications concerning the authorisation or entitlement to file the opposition.

3. The notice of opposition may contain:

- (a) an indication of the goods and services against which the opposition is directed; in the absence of such an indication the opposition shall be considered to be directed against all of the goods and services of the opposed Community trade mark application;
- (b) a reasoned statement setting out the main facts and arguments on which the opposition relies, and evidence to support the opposition.

4. Where the opposition is based on more than one earlier mark or earlier right, paragraphs 2 and 3 shall apply for each of these rights.

Rule 16

Use of languages in the notice of opposition

1. The time limit referred to in Article 115(6) of the Regulation within which the opposing party

has to file a translation of his opposition shall be one month from the expiry of the opposition period.

2. Where the opposing party or the applicant, before the date on which the opposition proceedings are deemed to commence pursuant to Rule 18(1), informs the Office that the applicant and the opposing party have agreed on a different language for the opposition proceedings pursuant to Article 115(7) of the Regulation, the opposing party shall, where the notice of opposition has not been filed in that language, file a translation of the notice of opposition in that language within a period of one month from the said date. Where the translation is not filed or filed late, the language of the proceedings shall remain unchanged.

Rule 16a

Information of the applicant

Any notice of opposition and any document submitted by the opposing party, as well as any communication addressed to one of the parties by the Office prior to the expiry of the period referred to in Rule 18 shall be sent by the Office to the other party for purposes of informing of the introduction of an opposition.

Rule 17

Examination of admissibility

1. If the opposition fee has not been paid within the opposition period, the opposition shall be deemed not to have been entered. If the opposition fee has been paid after the expiry of the opposition period, it shall be refunded to the opposing party.

2. If the notice of opposition has not been filed within the opposition period, or if the notice of opposition does not clearly identify the application against which opposition is entered or the earlier mark or the earlier right on which the opposition is based in accordance with Rule 15(2)(a) and (b), or does not contain grounds for opposition in accordance with Rule 15(2)(c), and if those deficiencies have not been remedied before the expiry of the opposition period, the Office shall reject the opposition as inadmissible.

3. Where the opposing party does not submit a translation as required under Rule 16(1), the opposition shall be rejected as inadmissible. Where the opposing party submits an incomplete translation, the part of the notice of opposition that has not been translated shall not be taken into account in the examination of admissibility.

4. If the notice of opposition does not comply with the other provisions of Rule 15, the Office shall inform the opposing party accordingly and shall invite him to remedy the deficiencies noted within a period of two months. If the deficiencies are not remedied before the time limit expires, the Office shall reject the opposition as inadmissible.

5. Any finding pursuant to paragraph 1 that the notice of opposition is deemed not to have been entered and any decision to reject an opposition as inadmissible under paragraphs 2, 3 and 4 shall be notified to the applicant.

Rule 18

Commencement of opposition proceedings

1. When the opposition is found admissible pursuant to Rule 17, the Office shall send a communication to the parties informing them that the opposition proceedings shall be deemed to commence two months after receipt of the communication. This period may be extended up to a total of 24 months if both parties submit requests for such an extension before the period expires.

2. If, within the period referred to in paragraph 1, the application is withdrawn or restricted

to goods and services against which the opposition is not directed, or the Office is informed about a settlement between the parties, or the application is rejected in parallel proceedings, the opposition proceedings shall be closed.

3. If, within the period referred to in paragraph 1, the applicant restricts the application by deleting some of the goods and services against which the opposition is directed, the Office shall invite the opposing party to state, within such a period as it may specify, whether he maintains the opposition, and if so, against which of the remaining goods and services. If the opposing party withdraws the opposition in view of the restriction the opposition proceedings shall be closed.

4. If before expiry of the period referred to in paragraph 1 the opposition proceedings are closed pursuant to paragraphs 2 or 3, no decision on costs shall be taken.

5. If before expiry of the period referred to in paragraph 1 the opposition proceedings are closed following a withdrawal or restriction of the application or pursuant to paragraph 3, the opposition fee shall be refunded.

Rule 19

Substantiation of the opposition

1. The Office shall give the opposing party the opportunity to present the facts, evidence and arguments in support of his opposition or to complete any facts, evidence or arguments that have already been submitted pursuant to Rule 15(3), within a time limit specified by it and which shall be at least 2 months starting on the date on which the opposition proceedings shall be deemed to commence in accordance with Rule 18(1).

2. Within the period referred to in paragraph 1, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right, as well as evidence proving his entitlement to file the opposition. In particular, the opposing party shall provide the following evidence:

- (a) if the opposition is based on a trade mark which is not a Community trade mark, evidence of its filing or registration, by submitting:
 - (i) if the trade mark is not yet registered, a copy of the relevant filing certificate or an equivalent document emanating from the administration with which the trade mark application was filed; or
 - (ii) if the trade mark is registered, a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time limit referred to in paragraph 1 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered;
- (b) if the opposition is based on a well-known mark within the meaning of Article 8(2)(c) of the Regulation, evidence showing that this mark is well-known in the relevant territory;
- (c) if the opposition is based on a mark with reputation within the meaning of Article 8(5) of the Regulation, in addition to the evidence referred to in point (a) of this paragraph, evidence showing that the mark has a reputation, as well as evidence or arguments showing that use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;
- (d) if the opposition is based on an earlier right within the meaning of Article 8(4) of the Regulation, evidence of its acquisition, continued existence and scope of protection of that right;
- (e) if the opposition is based on Article 8(3) of the Regulation, evidence of the opposing party's proprietorship and of the nature of his relationship with the agent or representative.

3. The information and evidence referred to in paragraphs 1 and 2 shall be in the language of the proceedings or accompanied by a translation. The translation shall be submitted within the time limit specified for submitting the original document.

4. The Office shall not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within the time limit set by the Office.

Rule 20

Examination of the opposition

1. If until expiry of the period referred to in Rule 19(1) the opposing party has not proven the existence, validity and scope of protection of his earlier mark or earlier right, as well his entitlement to file the opposition, the opposition shall be rejected as unfounded.

2. If the opposition is not rejected pursuant to paragraph 1, the Office shall communicate the submission of the opposing party to the applicant and shall invite him to file his observations within a period specified by the Office.

3. If the applicant submits no observations, the Office shall base its ruling on the opposition on the evidence before it.

4. The observations submitted by the applicant shall be communicated to the opposing party who shall be invited by the Office, if it considers it necessary to do so, to reply within a period specified by the Office.

5. Rule 18(2) and (3) shall apply mutatis mutandis after the date on which the opposition proceedings are deemed to commence.

6. In appropriate cases, the Office may invite the parties to limit their observations to particular issues, in which case it shall allow the party to raise the other issues at a later stage of the proceedings. In no case shall the Office be required to inform the parties which facts or evidence could be or have not been submitted.

7. The Office may suspend opposition proceedings:

- (a) where the opposition is based on an application for registration pursuant to Article 8(2)(b) of the Regulation until a final decision is taken in that proceeding;
- (b) where the opposition is based on an application for registration for a geographical indication or designation of origin under Council Regulation (EEC) No 2081/92 [3] until a final decision is taken in that proceeding; or
- (c) where a suspension is appropriate under the circumstances.

12. Rule 22 is replaced by the following:

"Rule 22

Proof of use

1. A request for proof of use pursuant to Article 43(2) or (3) of the Regulation shall be admissible only if the applicant submits such a request within the period specified by the Office pursuant to Rule 20(2).

2. Where the opposing party has to furnish proof of use or show that there are proper reasons for non-use, the Office shall invite him to provide the proof required within such period as it shall specify. If the opposing party does not provide such proof before the time limit expires, the Office

shall reject the opposition.

3. The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 4.

4. The evidence shall be filed in accordance with Rules 79 and 79a and shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76(1)(f) of the Regulation.

5. A request for proof of use may be made with or without submitting at the same time observations on the grounds on which the opposition is based. Such observations may be filed together with the observations in reply to the proof of use.

6. Where the evidence supplied by the opposing party is not in the language of the opposition proceedings, the Office may require the opposing party to submit a translation of that evidence in that language, within a period specified by the Office."

13. Rule 24(2) is replaced by the following:

"2. The Office shall provide certified or uncertified copies of the certificate of registration, upon payment of a fee.";

14. In Rule 25(1) point (c) is deleted;

15. The following Rule 25a is inserted:

"Rule 25a

Division of a registration

1. A declaration of the division of a registration pursuant to Article 48a of the Regulation shall contain:

- (a) the registration number;
- (b) the name and address of the proprietor of the trade mark in accordance with Rule 1(1)(b);
- (c) the list of goods and services which shall form the divisional registration, or, where the division into more than one divisional registration is sought, the list of goods and services for each divisional registration;
- (d) the list of goods and services which shall remain in the original registration.

2. Where the Office finds that the requirements laid down in paragraph 1 are not fulfilled or the list of goods and services which shall form the divisional registration overlap with the goods and services which shall remain in the original registration, it shall invite the applicant to remedy the deficiencies noted within such period as it may specify.

If the deficiencies are not remedied before the time limit expires, the Office shall refuse the declaration of division.

3. Where the Office finds, that the declaration of division is inadmissible pursuant to Article 48a of the Regulation, it shall refuse the declaration of division.

4. The Office shall establish a separate file for the divisional registration, which shall consist of a complete copy of the file of the original registration, including the declaration of division and the correspondence relating thereto. The Office shall assign a new registration number to the

divisional registration.";

16. In Rule 26(2), point (d) is deleted;

17. Rule 28(1) is amended as follows:

(a) point (c) is deleted;

(b) point (d) is replaced by the following:

"(d) an indication of the Member State or Member States in or for which the earlier mark is registered, the number and the filing date of the relevant registration, and the goods and services for which the earlier mark is registered;"

18. Rule 30 is replaced by the following:

"Rule 30

Renewal of registration

1. An application for renewal shall contain:

(a) the name of the person requesting renewal;

(b) the registration number of the Community trade mark to be renewed;

(c) if the renewal is requested for only part of the goods and services for which the mark is registered, an indication of those classes or those goods and services for which renewal is requested or those classes or those goods and services for which renewal is not requested, grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that classification to which that group of goods or services belongs and presented in the order of the classes of that classification.

2. The fees payable under Article 47 of the Regulation for the renewal of a Community trade mark shall consist of the following:

(a) a basic fee;

(b) a class fee for each class exceeding three in respect of which renewal is applied for; and

(c) where applicable, the additional fee for late payment of the renewal fee or late submission of the request for renewal, pursuant to Article 47(3) of the Regulation, as specified in the Fees Regulation.

3. It shall be deemed to constitute a request for renewal if the payment referred to in paragraph 2 is made by a means of payment referred to in Article 5(1) of the Fees Regulation, provided that it contains all the indications required under paragraph 1 (a) and (b) of this Rule and Article 7(1) of the Fees Regulation.

4. Where the application for renewal is filed within the periods provided for in Article 47(3) of the Regulation, but the other conditions governing renewal provided for in Article 47 of the Regulation and these Rules are not satisfied, the Office shall inform the applicant of the deficiencies found.

5. Where an application for renewal is not submitted or is submitted after expiry of the period provided for in the third sentence of Article 47(3) of the Regulation, or where the fees are not paid or are paid only after the period in question has expired, or where the deficiencies are not remedied within that period, the Office shall determine that the registration has expired and shall so notify the proprietor of the Community trade mark.

Where the fees paid are insufficient to cover all the classes of goods and services for which renewal is requested, such a determination shall not be made if it is clear which class or classes are to be covered. In the absence of other criteria, the Office shall take the classes into account in the order of classification.

6. Where the determination made pursuant to paragraph 5 has become final, the Office shall cancel the mark from the register. The cancellation shall take effect from the day following the day on which the existing registration expired.

7. Where the renewal fees provided for in paragraph 2 have been paid but the registration is not renewed, those fees shall be refunded.

8. A single application for renewal may be submitted for two or more marks, upon payment of the required fees for each of the marks, provided that the proprietors or the representatives are the same in each case.";

19. Rule 31(3) and (4) is deleted;

20. Rule 32(4) is replaced by the following:

"4. The Office shall establish a separate file for the new registration, which shall consist of a complete copy of the file of the original registration, including the application for registration of the partial transfer and the correspondence relating thereto. The Office shall assign a new registration number to the new registration.";

21. Rule 33 is amended as follows:

(a) paragraph 1 is replaced by the following:

"1. Rule 31(1), (2), (5) and (7) shall apply mutatis mutandis to the registration of a licence, of a transfer of a licence, of a right in rem, of a transfer of a right in rem, of an enforcement measure or of insolvency proceedings, subject to the following:

(a) Rule 31(1)(c) shall not apply in respect of a request for registration of a right in rem, of a levy of execution or of insolvency proceedings;

(b) Rule 31(1)(d) and (5) shall not apply where the request was made by the proprietor of the Community trade mark.";

(b) paragraph 2 is replaced by the following:

"2. The application for registration of a licence, a transfer of a licence, a right in rem, a transfer of a right in rem or an enforcement measure shall not be deemed to have been filed until the required fee has been paid.";

(c) in paragraph 3, "Articles 19, 20 or 22" is replaced by "Articles 19 to 22" and "in paragraphs 1 and 2 above," is replaced by "in paragraph 1 of this Rule and in Rule 34(2)".

(d) paragraph 4 is replaced by the following:

"4. Paragraphs 1 and 3 shall apply mutatis mutandis to applications for Community trade marks. Licences, rights in rem, insolvency proceedings and enforcement measures shall be recorded in the files kept by the Office concerning the Community trade mark application.";

22. Rule 34 is replaced by the following:

"Rule 34

Special provisions for the registration of a licence

1. The application for registration of a licence may contain a request to record the licence in the Register as one or more of the following:

- (a) an exclusive licence;
- (b) a sub-licence in case where the licence is granted by a licensee whose licence is recorded in the Register;
- (c) a licence limited to only a part of the goods or services for which the mark is registered;
- (d) a licence limited to part of the Community;
- (e) a temporary licence.

2. Where a request is made to record the licence as a licence pursuant to paragraph 1(c), (d) and (e), the application for registration of a licence shall indicate the goods and services and the part of the Community and the time period for which the licence is granted.";

23. Rule 35(3) is replaced by the following:

"3. The application for cancellation of a licence, a right in rem or an enforcement measure shall not be deemed to have been filed until the required fee has been paid.";

24. Point (c) of Rule 36(1) is deleted;

25. Rule 38 is amended as follows:

(a) paragraph 1 is replaced by the following:

"1. The time limit referred to in Article 115(6) of the Regulation within which the applicant for revocation or a declaration of invalidity has to file a translation of his application shall be one month, starting with the date of the filing of his application, failing which the application shall be rejected as inadmissible.";

(b) in paragraph 3, the following sentence is added:

"Where the translation is not filed or filed late, the language of the proceedings shall remain unchanged.";

26. Rule 39 is replaced by the following:

"Rule 39

Rejection of the application for revocation or for declaration of invalidity as inadmissible

1. Where the Office finds that the required fee has not been paid, it shall invite the applicant to pay the fee within a period specified by it. If the required fee is not paid within the period specified by the Office, the Office shall inform the applicant that the application for revocation or for declaration of invalidity is deemed not to have been filed. If the fee has been paid after expiry of the period specified, it shall be refunded to the applicant.

2. Where the translation required under Rule 38(1) is not filed within the prescribed period, the Office shall reject the application for revocation or for declaration of invalidity as inadmissible.

3. If the Office finds that the application does not comply with Rule 37, it shall invite the applicant to remedy the deficiencies found within such period as it may specify. If the deficiencies are not remedied before expiry of the time limit, the Office shall reject the application as inadmissible.

4. Any decision to reject an application for revocation or declaration of invalidity under paragraph 2 or 3 shall be communicated to the applicant and the proprietor of the Community trade mark.";

27. Rule 40 is amended as follows:

(a) paragraph 1 is replaced by the following:

"1. Every application for revocation or for declaration of invalidity which is deemed to have been filed shall be notified to the proprietor of the Community trade mark. When the Office has found the application admissible, it shall invite the proprietor of the Community trade mark to file his observations within such period as it may specify."

(b) paragraph 4 is replaced by the following:

"4. Save where Rule 69 otherwise provides or allows, all observations filed by the parties shall be sent to the other party concerned.";

(c) paragraph 5 is replaced by the following:

"5. In the case of an application for revocation based on Article 50(1)(a) of the Regulation, the Office shall invite the proprietor of the Community trade mark to furnish proof of genuine use of the mark, within such period as it may specify. If the proof is not provided within the time limit set, the Community trade mark shall be revoked. Rule 22(2), (3) and (4) shall apply *mutatis mutandis*.";

(d) a new paragraph 6 is added:

"6. If the applicant has to furnish proof of use or proof that there are proper reasons for non-use under Article 56(2) or (3) of the Regulation, the Office shall invite the applicant to furnish proof of genuine use of the mark, within such period as it may specify. If the proof is not provided within the time limit set, the application for declaration of invalidity shall be rejected. Rule 22(2), (3) and (4) shall apply *mutatis mutandis*.";

28. Rules 44 and 45 are replaced by the following:

"Rule 44

Application for conversion

1. An application for conversion of a Community trade mark application or a registered Community trade mark into a national trade mark application pursuant to Article 108 of the Regulation shall contain:

- (a) the name and the address of the applicant for conversion in accordance with Rule 1(1)(b);
- (b) the filing number of the Community trade mark application or the registration number of the Community trade mark;
- (c) the indication of the ground for conversion in accordance with Article 108(1)(a) or (b) of the Regulation;
- (d) the specification of the Member State or the Member States in respect of which conversion is requested;
- (e) where the request does not relate to all of the goods and services for which the application has been filed or for which the trade mark has been registered, the application shall contain an indication of the goods and services for which conversion is requested, and, where conversion is requested in respect of more than one Member State and the list of goods and services is not the same for all Member States, an indication of the respective goods and services for each Member State;
- (f) where conversion is requested pursuant to Article 108(6) of the Regulation, the application shall contain the indication of the date on which the decision of the national court has become final, and a copy of that decision; that copy may be submitted in the language in which the decision

was given.

2. The application for conversion shall be filed within the relevant period pursuant to Article 108(4), (5) or (6) of the Regulation. Where conversion is requested following a failure to renew the registration, the period of three months provided for in Article 108(5) of the Regulation shall begin to run on the day following the last day on which the request for renewal can be presented pursuant to Article 47(3) of the Regulation.

Rule 45

Examination of application for conversion

1. Where the application for conversion does not comply with the requirements of Article 108(1) or (2) of the Regulation or has not been filed within the relevant period of three months or does not comply with Rule 44 or other Rules, the Office shall notify the applicant accordingly and specify a period within which he may amend the application or furnish any missing information or indications.

2. Where the conversion fee has not been paid within the relevant period of three months, the Office shall inform the applicant that the application for conversion is deemed not to have been filed.

3. Where the missing indications have not been furnished within the period specified by the Office, the Office shall reject the application for conversion.

Where Article 108(2) of the Regulation applies, the Office shall reject the application for conversion as inadmissible only with respect to those Member States for which conversion is excluded under that provision.

4. If the Office or a Community trade mark court has refused the Community trade mark application or has declared the Community trade mark invalid on absolute grounds by reference to the language of a Member State, conversion shall be excluded under Article 108(2) of the Regulation for all the Member States in which that language is one of the official languages. If the Office or a Community trade mark court has refused the Community trade mark application or has declared the Community trade mark invalid on absolute grounds which are found to apply in the whole Community or on account of an earlier Community trade mark or other Community industrial property right, conversion is excluded under Article 108(2) of the Regulation for all Member States.";

29. Rule 47 is replaced by the following:

"Rule 47

Transmission to central industrial property offices of the Member States

Where the application for conversion complies with the requirements of the Regulation and these Rules, the Office shall transmit the application for conversion and the data referred to in Rule 84(2), to the central industrial property offices of the Member States, including the Benelux Trade Mark Office, for which the application has been found admissible. The Office shall inform the applicant of the date of transmission.";

30. In Rule 50(1) the following is added:

"In particular, when the appeal is directed against a decision taken in opposition proceedings, Article 78a of the Regulation shall not be applicable to the time limits fixed pursuant to Article 61(2) of the Regulation.

Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board

considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 74(2) of the Regulation.";

31. Rule 51 is replaced by the following:

"Rule 51

Reimbursement of appeal fees

The appeal fee shall only be reimbursed by order of either of the following:

- (a) the department whose decision has been impugned, where it grants revision pursuant to Article 60(1) or Article 60a of the Regulation;
- (b) the Board of Appeal, where it allows the appeal and considers such reimbursement equitable by reason of a substantial procedural violation.";

32. Rule 53 is replaced by the following:

"Rule 53

Correction of errors in decisions

Where the Office becomes aware, of its own motion or at the instance of a party to the proceedings, of a linguistic error, error of transcription or obvious mistake in a decision, it shall ensure that error or mistake is corrected by the department or division responsible."

33. The following Rule 53a is inserted:

"Rule 53a

Revocation of a decision or entry in the Register

1. Where the Office finds of its own motion or pursuant to corresponding information by the parties to the proceedings that a decision or entry in the Register is subject to revocation pursuant to Article 77a of the Regulation, it shall inform the party affected about the intended revocation.
2. The affected party may submit observations on the intended revocation within a period specified by the Office.
3. Where the affected party agrees to the intended revocation or where he does not submit any observations within the period, the Office shall revoke the decision or entry. If the affected party does not agree to the revocation, the Office shall take a decision on the revocation.
4. Paragraphs 1, 2 and 3 shall apply mutatis mutandis if the revocation is likely to affect more than one party. In these cases the observations submitted by one of the parties pursuant to paragraph 3 shall always be communicated to the other party or parties with an invitation to submit observations.
5. Where the revocation of a decision or an entry in the Register affects a decision or entry that has been published, the revocation shall also be published.
6. Competence for revocation under paragraphs 1 to 4 shall lie with the department or unit which took the decision.";

34. Rule 59(4) is replaced by the following:

"4. The amounts and the advances for expenses to be paid pursuant to paragraphs 1, 2 and 3 shall be determined by the President of the Office and shall be published in the Official Journal of the Office. The amounts shall be calculated on the same basis as laid in the Staff Regulations of the Officials of the European Communities and Annex VII thereto.";

35. Rule 60 is replaced by the following:

"Rule 60

Minutes of oral proceedings

1. Minutes of oral proceedings or the taking of evidence shall be drawn up, containing:

- (a) the date of the proceedings;
- (b) the names of the competent officials of the Office, the parties, their representatives, and of the witnesses and experts who are present;
- (c) the applications and requests made by the parties;
- (d) the means of giving or obtaining evidence;
- (e) where applicable, the orders or the decision issued by the Office.

2. The minutes shall become part of the file of the relevant Community trade mark application or registration. The parties shall be provided with a copy of the minutes.

3. Where witnesses, experts or parties are heard in accordance with Article 76(1)(a) or (d) of the Regulation or Rule 59(2), their statements shall be recorded.";

36. Rule 61 is amended as follows:

(a) paragraph 1 is replaced by the following:

"1. In proceedings before the Office, notifications to be made by the Office shall take the form of transmitting the original document, an uncertified copy thereof or a computer print-out in accordance with Rule 55, or, as concerns documents emanating from the parties themselves, duplicates or uncertified copies.";

(b) the following paragraph 3 is added:

"3. Where the addressee has indicated his telecopier number or contact details for communicating with him through other technical means, the Office shall have the choice between any of these means of notification and notification by post.";

37. Rule 62 is amended as follows:

(a) paragraph 1 is replaced by the following:

"1. Decisions subject to a time limit for appeal, summonses and other documents as determined by the President of the Office shall be notified by registered letter with advice of delivery. All other notifications shall be by ordinary mail.";

(b) the second sentence of paragraph 2 is deleted;

(c) paragraph 5 is replaced by the following:

"5. Notification by ordinary mail shall be deemed to have been effected on the tenth day following that of its posting.";

38. In Rule 65(1), the second sentence is replaced by the following:

"Notification shall be deemed to have been taken place on the date on which the communication was received by the telecopying device of the recipient.";

39. Rule 66(1) is replaced by the following:

"1. If the address of the addressee cannot be established or if after at least one attempt, notification in accordance with Rule 62 has proved impossible, notification shall be effected by public notice.";

40. Rule 72(2) is replaced by the following:

"2. If a time limit expires on a day on which there is a general interruption in the delivery of mail in the Member State where the Office is located, or, if and to the extent that the President of the Office has allowed communications to be sent by electronic means pursuant to Rule 82, on which there is an actual interruption of the Office's connection to these electronic means of communication, the time limit shall extend until the first day following that interruption on which the Office is open for the receipt of documents and on which ordinary mail is delivered. The duration of the period of interruption shall be determined by the President of the Office.";

41. Rule 72(4) is replaced by the following:

"4. If an exceptional occurrence such as a natural disaster or strike interrupts or dislocates proper communication from the parties to the proceedings to the Office or vice versa, the President of the Office may determine that for parties of the proceedings having their residence or registered office in the State concerned or who have appointed a representative with a place of business in the State concerned, all time limits that otherwise would expire on or after the date of commencement of such occurrence, as determined by him, shall extend until a date to be determined by him. If the occurrence affects the seat of the Office, such determination of the President shall specify that it applies in respect of all parties to the proceedings.";

42. Rule 76 is amended as follows:

(a) paragraphs 1 to 4 are replaced by the following:

"1. Legal practitioners and professional representatives entered on the list maintained by the Office pursuant to Article 89(2) of the Regulation shall file with the Office a signed authorisation for insertion in the files only if the Office expressly requires it, or where there are several parties to the proceedings in which the representative acts before the Office, if the other party expressly asks for it.

2. Employees acting on behalf of natural or legal persons pursuant to Article 88(3) of the Regulation shall file with the Office a signed authorisation for insertion in the files.

3. The authorisation may be filed in any official language of the Community. It may cover one or more applications or registered trade marks or may be in the form of a general authorisation authorising the representative to act in respect of all proceedings before the Office to which the person giving the authorisation is a party.

4. Where it is required, pursuant to paragraphs 1 or 2, that a signed authorisation be filed, the Office shall specify a time limit within which such authorisation shall be filed. If the authorisation is not filed in due time, proceedings shall be continued with the represented person. Any procedural steps other than the filing of the application taken by the representative shall be deemed not to have been taken if the represented person does not approve them within a period specified by the Office. The application of Article 88(2) of the Regulation shall remain unaffected.";

(b) paragraphs 8 and 9 are replaced by the following:

"8. Where the appointment of a representative is communicated to the Office, the name and the business address of the representative shall be indicated in accordance with Rule 1(1)(e). Where a representative acts before the Office who has already been appointed, he shall indicate his name and preferably the identification number attributed to him by the Office. Where several representatives are appointed by the same party, they may, notwithstanding any provisions to the contrary in their authorisations, act either jointly or singly.

9. The appointment or authorisation of an association of representatives shall be deemed to be

an appointment or authorisation of any representative who practices within that association.";

43. Rule 79 is amended as follows:

(a) points (a) and (b) are replaced by the following:

"(a) by submitting a signed original of the document in question at the Office, such as by post, personal delivery, or by any other means;

(b) by transmitting a document by telecopier in accordance with Rule 80;"

(b) point (c) is deleted;

44. The following Rule 79a is inserted:

"Rule 79a

Annexes to written communications

Where a document or an item of evidence is submitted in accordance with Rule 79 point (a) by a party in a proceeding before the Office involving more than one party to the proceedings, the document or item of evidence, as well as any annex to the document, shall be submitted in as many copies as the number of parties to the proceedings."

45. Rule 80 is amended as follows:

(a) paragraph 1 is replaced by the following:

"1. Where an application for a Community trade mark is submitted to the Office by telecopier and the application contains a reproduction of the mark pursuant to Rule 3(2) which does not satisfy the requirements of that Rule, the required reproduction suitable for publication shall be submitted to the Office in accordance with Rule 79(a). Where the reproduction is received by the Office within a period of one month from the date of receipt of the telecopy, the reproduction shall be deemed to have been received by the Office on the date on which the telecopy was received.";

(b) in paragraph 3, the following sentence is added:

"Where the communication has been sent by telecopier electronically, the indication of the name of the sender shall be equivalent to the signature.";

(c) paragraph 4 is deleted;

46. Rule 81 is deleted;

47. Rule 82 is amended as follows:

(a) paragraph 1 is replaced by the following:

"1. The President of the Office shall determine whether, to what extent and under what technical conditions communications may be sent to the Office by electronic means.";

(b) paragraph 4 is deleted;

48. Rule 83 is replaced by the following:

"Rule 83

Forms

1. The Office shall make available to the public free of charge forms for the purposes of:

(a) filing an application for a Community trade mark, including where appropriate a request for the search report;

- (b) entering an opposition;
- (c) applying for revocation or declaration of invalidity;
- (d) applying for the registration of a transfer and the transfer form and transfer document provided for in Rule 31(5);
- (e) applying for the registration of a licence;
- (f) applying for the renewal of a Community trade mark;
- (g) making an appeal;
- (h) authorising a representative, in the form of an individual authorisation or a general authorisation;
- (i) submitting an international application or a subsequent designation under the Madrid Protocol to the Office.

2. Parties to the proceedings before the Office may also use

- (a) forms established under the Trademark Law Treaty or pursuant to recommendations of the Assembly of the Paris Union for the Protection of Industrial Property;
- (b) with the exception of the form referred to in point (i) of paragraph 1, forms with the same content and format.

3. The Office shall make available the forms referred to in paragraph 1 in all the official languages for the Community.";

49. Rule 84 is amended as follows:

- (a) in Paragraph 2 point (d) is replaced by the following:

"(d) the name and address of the applicant;"

- (b) paragraph 3 is amended as follows:

- (i) point (i) is replaced by the following:

"(i) levy of execution pursuant to Article 20 of the Regulation and insolvency proceedings pursuant to Article 21 of the Regulation;"

- (ii) the following points (w) and (x) are added:

"(w) the division of a registration pursuant to Article 48a of the Regulation and Rule 25a, together with the items referred to in paragraph 2 in respect of the divisional registration, as well as the list of goods and services of the original registration as amended;

- (x) the revocation of a decision or an entry in the Register pursuant to Article 77a of the Regulation, where the revocation concerns a decision or entry which has been published.";

50. Rule 85(1) is replaced by the following:

"1. The Community Trade Marks Bulletin shall be published in the manner and frequency determined by the President of the Office.";

51. Rule 89(1) and (2) is replaced by the following:

"1. Inspection of the files of Community trade mark applications and of registered Community trade marks shall either be of the original document, or of copies thereof, or of technical means of storage if the files are stored in this way. The means of inspection shall be determined by the President of the Office.

Where inspection takes place as provided for in paragraphs 3, 4 and 5, the request for inspection of the files shall not be deemed to have been made until the required fee has been paid. No fee is payable if inspection of technical means of storage takes place online.

2. Where inspection of the files of a Community trade mark application which has not yet been published pursuant to Article 40 of the Regulation is requested, the request shall contain an indication and evidence to the effect that the applicant has consented to the inspection or has stated that after the trade mark has been registered he will invoke the rights under it against the party requesting the inspection.";

52. Rule 91 is replaced by the following:

"Rule 91

Keeping of files

1. The President of the Office shall determine the form in which the files shall be kept.

2. Where files are kept electronically, these electronic files, or back-up copies thereof, shall be kept without time limitation. The original documents filed by parties to the proceedings which form the basis of such electronic files shall be disposed of after a period following their reception by the Office, which shall be determined by the President of the Office.

3. Where and to the extent that files or parts of the files are kept in any other form than electronically, documents or items of evidence constituting part of such files shall be kept for at least five years from the end of the year in which any of the following occurrences takes place:

- (a) the application is rejected or withdrawn or is deemed to be withdrawn;
- (b) the registration of the Community trade mark expires completely pursuant to Article 47 of the Regulation;
- (c) the complete surrender of the Community trade mark is registered pursuant to Article 49 of the Regulation;
- (d) the Community trade mark is completely removed from the Register pursuant to Article 56(6) or Article 96(6) of the Regulation.";

53. Rule 94 is amended as follows:

(a) paragraph 3 is replaced by the following:

"3. Where the amount of the costs has not been fixed pursuant to Article 81(6), first sentence, of the Regulation, the request for the fixing of costs shall be accompanied by a bill and supporting evidence. For the costs of representation referred to in paragraph 7(d) of this Rule, an assurance by the representative that the costs have been incurred shall be sufficient. For other costs, it shall be sufficient if their plausibility is established. Where the amount of the costs is fixed pursuant to Article 81(6), first sentence, of the Regulation, representation costs shall be awarded at the level laid down in paragraph 7(d) of this Rule and irrespective of whether they have been actually incurred.";

(b) in paragraph 4, the words "the second sentence of Article 81(6)" are replaced by "the third sentence of Article 81(6)";

(c) paragraph 7 is replaced by the following:

"7. Subject to paragraph 3 of this Rule, costs essential to the proceedings and actually incurred by the successful party shall be borne by the losing party in accordance with Article 81(1) of the Regulation on the basis of the following maximum rates:

-
- (a) where the party is not represented by a representative, travel and subsistence expenses of one party for one person for the outward and return journey between the place of residence or the place of business and the place where oral proceedings are held pursuant to Rule 56, as follows:
- (i) the cost of the first-class rail-fare including usual transport supplements where the total distance by rail does not exceed 800 km;
 - (ii) the cost of the tourist-class air-fare where the total distance by rail exceeds 800 km or the route includes a sea-crossing;
 - (iii) subsistence expenses as laid down in Article 13 of Annex VII to the Staff Regulations of Officials of the European Communities;
- (b) travel expenses of representatives within the meaning of Article 89(1) of the Regulation, at the rates provided for in point (a)(i) and (ii) of this Rule;
- (c) travel expenses, subsistence expenses, compensation for loss of earnings and fees to which witnesses and experts are entitled to be reimbursed pursuant to Rule 59(2), (3) or (4), to the extent that final liability lies with a party to the proceedings pursuant to Rule 59(5)(b);
- (d) cost of representation, within the meaning of Article 89(1) of the Regulation,
- (i) of the opposing party in opposition proceedings:
EUR 300;
 - (ii) of the applicant in opposition proceedings:
EUR 300;
 - (iii) of the applicant in proceedings relating to revocation or invalidity of a Community trade mark:
EUR 450;
 - (iv) of the proprietor of the trade mark in proceedings relating to revocation or invalidity of a Community trade mark:
EUR 450;
 - (v) of the appellant in appeal proceedings:
EUR 550;
 - (vi) of the defendant in appeal proceedings:
EUR 550;
- (vii) where an oral proceedings have taken place to which the parties have been summoned pursuant to Rule 56, the amount referred to in the points (i) to (vi) shall be incremented by EUR 400;
- (e) where there are several applicants or proprietors of the Community trade mark application or registration or where there are several opposing parties or applicants for revocation or declaration of invalidity who have filed the opposition or application for revocation or declaration of invalidity jointly, the losing party shall bear the costs referred to in point (a) for one such person only;
- (f) where the successful party is represented by more than one representative within the meaning of Article 89(1) of the Regulation, the losing party shall bear the costs referred to in points (b) and (d) of this Rule for one such person only;
- (g) the losing party shall not be obliged to reimburse the successful party for any costs, expenses and fees other than those referred to in points (a) to (f).";

54. Rule 98 is replaced by the following:

"Rule 98

Translations

1. When a translation of a document is to be filed, the translation shall identify the document to which it refers and reproduce the structure and contents of the original document. The Office may require the filing, within a period to be specified by it, of a certificate that the translation corresponds to the original text. The President of the Office shall determine the manner in which translations shall be certified.

2. Save where the Regulation or these Rules provide otherwise, a document for which a translation is to be filed shall be deemed not to have been received by the Office

- (a) where the translation is received by the Office after expiry of the relevant period for submitting the original document or the translation;
- (b) in the case of paragraph 1, where the certificate is not filed within the period specified.";

55. Rule 100 is replaced by the following:

"Rule 100

Decisions taken by a single member

The cases in which pursuant to Article 127(2), or Article 129(2), of the Regulation a single member of the Opposition Division or of the Cancellation Division may take a decision shall be the following:

- (a) decisions on the apportionment of costs;
- (b) decisions to fix the amount of the costs to be paid pursuant to Article 81(6), first sentence, of the Regulation;
- (c) decisions to close the file or not to proceed to judgment;
- (d) decisions to reject an opposition as inadmissible before expiry of the period referred to in Rule 18(1);
- (e) decisions to stay proceedings;
- (f) decisions to join or separate multiple oppositions pursuant to Rule 21(1).";

56. Paragraphs 1, 2 and 3 of Rule 101 are replaced by the following:

"1. If necessary, the President of the Office shall request the Commission to enquire whether a State which is not party to the Paris Convention or to the Agreement establishing the World Trade Organization accords reciprocal treatment within the meaning of Article 29(5) of the Regulation.

2. If the Commission determines that reciprocal treatment in accordance with paragraph 1 is accorded, it shall publish a communication to this effect in the Official Journal of the European Union.

3. Article 29(5) of the Regulation shall apply from the date of publication in the Official Journal of the European Union of the communication referred to in paragraph 2, unless the communication states an earlier date from which it is applicable. It shall cease to apply from the date of publication in the Official Journal of the European Union of a communication of the Commission to the effect that reciprocal treatment is no longer accorded, unless the communication states an earlier date from which it is applicable.";

57. Rule 114 is amended as follows:

- (a) in paragraph 1 point (d) is replaced by the following:

"(d) the indications and elements referred to in Rule 15(2)(b) to (h).";

(b) in paragraph 2, the introductory phrase is replaced by the following:

"Rules 15(1), (3) and (4) and 16 to 22 shall apply, subject to the following:";

58. Point (c) of Rule 122(1) is replaced by the following:

"(c) the indications and elements referred to in Rule 44(1)(a), (c), (d), (e) and (f)".

Article 2

1. This Regulation shall enter into force on the 20th day following its publication in the Official Journal of the European Union.

2. In Article 1 point (1)(d), point (3), point (4) and point (7) shall apply from 10 March 2008, as shall the second part, commencing with the word "including", of point (a) of Rule 83(1), set out at point 48 of Article 1 of this Regulation.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 29 June 2005.

For the Commission

Charlie McCreevy

Member of the Commission

[1] OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Regulation (EC) No 422/2004 (OJ L 70, 9.3.2004, p. 1).

[2] OJ L 303, 15.12.1995, p. 1. Regulation as amended by Regulation (EC) No 782/2004 (OJ L 123, 27.4.2004, p. 88).

[3] OJ L 208, 24.7.1992, p. 1.";

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**Commission Communication
of 3 December 1999**

**on the Commission findings concerning reciprocal treatment with the Principality of Andorra
within the meaning of Article 5(1)(d) and (3) and Article 29(5) of Council Regulation (EC) No 40/94
on the Community [trade mark](#)**

COMMISSION COMMUNICATION

of 3 December 1999

on the Commission findings concerning reciprocal treatment with the Principality of Andorra within the meaning of Article 5(1)(d) and (3) and Article 29(5) of Council Regulation (EC) No 40/94 on the Community trade mark

(1999/C 359/08)

Under Rule 101(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark(1), the President of the Office for Harmonisation in the Internal Market (OHIM) asked the Commission to establish whether the Principality of Andorra accorded to nationals of all Member States of the Community reciprocal treatment within the meaning of Article 5(1)(d) and (3) and Article 29(5) of Council Regulation (EC) No 40/94(2), hereinafter referred to as "the Community Trade Mark Regulation", as amended by Regulation (EC) No 3288/94(3).

The Commission has examined the corresponding trade mark laws and has exchanged correspondence with the authorities of the Principality of Andorra.

- Under Article 5(1)(d) of the Community Trade Mark Regulation, nationals of any State which is not party to the Paris Convention and which, according to published findings, accords to nationals of all the Member States the same protection for trade marks as it accords to its own nationals may be proprietors of Community trade marks.

Likewise, under paragraph (c) of Article 5 of the Andorran law on trade marks, a national of another State which grants the same protection to nationals of the Principality of Andorra as it does to its own nationals with respect to trade marks, may be owner of the registration of a mark in the Principality of Andorra.

Moreover, the Andorran legislation on trade marks does not entail any obligation to the applicant regarding the need to prove the previous registration of a trade mark in the country of origin within the meaning of Article 5(1)(d) of the Community Trade Mark Regulation. Therefore, Article 5(3) of that Regulation does not apply in this case.

Finally, on a request for information on the application of Article 5 of the Andorran Trade Mark Law in respect of nationals of the European Union, the Andorran authorities have given proof that the current practice of the Andorran trade mark office is to grant to nationals of all Member States the same protection as it does to its own nationals with regard to trade marks.

Accordingly, OHIM shall accept, pursuant to Article 5(1) of the Community Trade Mark Regulation, trade mark applications from nationals of the Principality of Andorra.

- Under Article 29(5) of the Community Trade Mark Regulation, a person who has duly filed an application for a trade mark in a State which is not a party to the Paris Convention or to the Agreement establishing the World Trade Organisation, may only claim the priority date of that filing for the purpose of the filing of that mark as a Community trade mark, in so far as the State concerned accepts Community trade mark applications as a first filing for the purpose of the claiming of priority in relation to the filing of the same mark as its own trade mark office.

In this sense, the Andorran trade mark law states in its Article 6(5) that, provided that a State grants nationals of the Principality of Andorra a right of priority subject to conditions and having effects equivalent to those of the right of priority provided for in the said Article, nationals of that State may claim the right of priority provided for in Article 6 of the Andorran trade mark law in the Principality of Andorra.

Having been consulted about the application of that provision in relation to applicants of all the Member States or in relation to rights of priority derived from a first filing in any of the Member States or in the OHIM, the Andorran authorities have given proof that the Andorran trade mark office grants the right of priority set out in Article 29 of the Community Trade Mark Regulation.

Therefore, the OHIM shall accept, pursuant to Article 29(5) of the Community Trade Mark Regulation, trade mark priority claims deriving from a first application for the registration of a trade mark with the Andorran trade mark office.

Conclusions

This examination has shown that the Principality of Andorra's law on trade marks, and the practice of the Andorran trade mark office, afford nationals of all Member States the same protection in the matter of trade marks as its own nationals. Thus, under Article 5(1)(d) of the Community Trade Mark Regulation, Andorran nationals may become proprietors of a Community trade mark.

Applicants for a Community trade mark need not prove the prior registration in the Principality of Andorra of the trade mark for which they have filed a Community trade mark application.

This examination has also shown that the Principality of Andorra's law on trade marks, and the practice of the Andorran trade mark office, grants, on the basis of a first filing made at the OHIM and subject to conditions equivalent to those laid down in the Community Trade Mark Regulation, a right of priority as set out in Article 29 of that Regulation.

Therefore, the OHIM shall accept, pursuant to Article 29(5) of the Community Trade Mark Regulation, priority claims deriving from a first application for the registration of a trade mark with the Andorran trade mark office.

These findings shall take effect on 1 April 1996.

(1) OJ L 303, 15.12.1995, p. 1.

(2) OJ L 11, 14.1.1994, p. 1.

(3) OJ L 349 vom 31.12.1994, p. 83.

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**First Council Directive 89/104/EEC
of 21 December 1988
to approximate the laws of the Member States relating to trade marks**

FIRST COUNCIL DIRECTIVE of 21 December 1988 to approximate the laws of the Member States relating to trade marks (89/104/EEC)

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community, and in particular Article 100a thereof,

Having regard to the proposal from the Commission (1),

In cooperation with the European Parliament (2),

Having regard to the opinion of the Economic and Social Committee (3),

Whereas the trade mark laws at present applicable in the Member States contain disparities which may impede the free movement of goods and freedom to provide services and may distort competition within the common market; whereas it is therefore necessary, in view of the establishment and functioning of the internal market, to approximate the laws of Member States;

Whereas it is important not to disregard the solutions and advantages which the Community trade mark system may afford to undertakings wishing to acquire trade marks;

Whereas it does not appear to be necessary at present to undertake full-scale approximation of the trade mark laws of the Member States and it will be sufficient if approximation is limited to those national provisions of law which most directly affect the functioning of the internal market;

Whereas the Directive does not deprive the Member States of the right to continue to protect trademarks acquired through use but takes them into account only in regard to the relationship between them and trade marks acquired by registration;

Whereas Member States also remain free to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration; whereas they can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an ex officio examination procedure or both; whereas Member States remain free to determine the effects of revocation or invalidity of trade marks;

Whereas this Directive does not exclude the application to trade marks of provisions of law of the Member States other than trade mark law, such as the provisions relating to unfair competition, civil liability or consumer protection;

Whereas attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States; whereas, to this end, it is necessary to list examples of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of another or of invalidity concerning the trade mark itself, for example, the absence of any distinctive character, or concerning conflicts between the trade mark and earlier rights, are to be listed in an exhaustive manner, even if some of these grounds are listed as an option for the Member States which will therefore be able to maintain or introduce those grounds in their legislation; whereas Member States will be able to maintain or introduce into their legislation grounds of refusal or invalidity linked to conditions for obtaining and continuing to hold a trade mark for which there is no provision of approximation, concerning, for example,

the eligibility for the grant of a [trade mark](#), the renewal of the [trade mark](#) or rules on fees, or related to the non-compliance with procedural rules;

Whereas in order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation; whereas it is necessary to provide that a [trade mark](#) cannot be invalidated on the basis of the existence of a non-used earlier [trade mark](#), while the Member States remain free to apply the same principle in respect of the registration of a [trade mark](#) or to provide that a [trade mark](#) may not be successfully invoked in infringement proceedings if it is established as a result of a plea that the [trade mark](#) could be revoked; whereas in all these cases it is up to the Member States to establish the applicable rules of procedure;

Whereas it is fundamental, in order to facilitate the free circulation of goods and services, to ensure that henceforth registered trade marks enjoy the same protection under the legal systems of all the Member States; whereas this should however not prevent the Member States from granting at their option extensive protection to those trade marks which have a reputation;

Whereas the protection afforded by the registered [trade mark](#), the function of which is in particular to guarantee the [trade mark](#) as an indication of origin, is absolute in the case of identity between the mark and the sign and goods or services; whereas the protection applies also in case of similarity between the mark and the sign and the goods or services; whereas it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion; whereas the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the [trade mark](#) on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the [trade mark](#) and the sign and between the goods or services identified, constitutes the specific condition for such protection; whereas the ways in which likelihood of confusion may be established, and in particular the onus of proof, are a matter for national Procedural rules which are not prejudiced by the [Directive](#);

Whereas it is important, for reasons of legal certainty and without inequitably prejudicing the interests of a proprietor of an earlier [trade mark](#), to Provide that the latter may no longer request a declaration of invalidity nor may he oppose the use of a [trade mark](#) subsequent to his own of which he has knowingly tolerated the use for a substantial length of time, unless the application for the subsequent [trade mark](#) was made in bad faith:

Whereas all Member States of the Community are bound by the Paris Convention for the Protection of Industrial Property; whereas it is necessary that the provisions of this [Directive](#) are entirely consistent with those of the Paris Convention; whereas the obligations of the Member States resulting from this Convention are not affected by this [Directive](#); whereas, where appropriate, the second subparagraph of Article 234 of the Treaty is applicable,

HAS ADOPTED THIS [DIRECTIVE](#):

Article 1

Scope

This [Directive](#) shall apply to every [trade mark](#) in respect of goods or services which is the subject of registration or of an application in a Member State for registration as an individual [trade mark](#), a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux [Trade Mark](#) Office or of an international registration

having effect in a Member State.

Article 2

Signs of which a **trade mark** may consist

A **trade mark** may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Article 3

Grounds for refusal or invalidity

1. The following shall not be registered or if registered shall be liable to be declared invalid:

- (a) signs which cannot constitute a **trade mark**;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
- (e) signs which consist exclusively of:
 - the shape which results from the nature of the goods themselves, or
 - the shape of goods which is necessary to obtain a technical result, or
 - the shape which gives substantial value to the goods;
- (f) trade marks which are contrary to public policy or to accepted principles of morality;
- (g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;
- (h) trade marks which have not been authorized by the competent authorities and are to be refused or invalidated pursuant to Article 6 ter of the Paris Convention for the Protection of Industrial Property, hereinafter referred to as the 'Paris Convention'.

2. Any Member State may provide that a **trade mark** shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that:

- (a) the use of that **trade mark** may be prohibited pursuant to provisions of law other than **trade mark** law of the Member State concerned or of the Community;
- (b) the **trade mark** covers a sign of high symbolic value, in particular a religious symbol;
- (c) the **trade mark** includes badges, emblems and escutcheons other than those covered by Article 6 ter of the Paris Convention and which are of public interest, unless the consent of the appropriate authorities to its registration has been given in conformity with the legislation of the Member

State;

(d) the application for registration of the **trade mark** was made in bad faith by the applicant.

3. A **trade mark** shall not be refused registration or be declared invalid in accordance with paragraph 1 (b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration.

4. Any Member State may provide that, by derogation from the preceding paragraphs, the grounds of refusal of registration or invalidity in force in that State prior to the date on which the provisions necessary to comply with this **Directive** enter into force, shall apply to trade marks for which application has been made prior to that date.

Article 4

Further grounds for refusal or invalidity concerning conflicts with earlier rights

1. A **trade mark** shall not be registered or, if registered, shall be liable to be declared invalid:

- (a) if it is identical with an earlier **trade mark**, and the goods or services for which the **trade mark** is applied for or is registered are identical with the goods or services for which the earlier **trade mark** is protected;
- (b) if because of its identity with, or similarity to, the earlier **trade mark** and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier **trade mark**.

2. 'Earlier trade marks' within the meaning of paragraph 1 means:

- (a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the **trade mark**, taking account, where appropriate, of the priorities claimed in respect of those trade marks; (i) Community trade marks;
- (ii) trade marks registered in the Member State or, in the case of Belgium, Luxembourg or the Netherlands, at the Benelux **Trade Mark** Office;
- (iii) trade marks registered under international arrangements which have effect in the Member State;
- (b) Community trade marks which validly claim seniority, in accordance with the Regulation on the Community **trade mark**, from a **trade mark** referred to in (a) (ii) and (iii), even when the latter **trade mark** has been surrendered or allowed to lapse;
- (c) applications for the trade marks referred to in (a) and (b), subject to their registration;
- (d) trade marks which, on the date of application for registration of the **trade mark**, or, where appropriate, of the priority claimed in respect of the application for registration of the **trade mark**, are well known in a Member State, in the sense in which the words 'well known' are used in Article 6 bis of the Paris Convention.

3. A **trade mark** shall furthermore not be registered or, if registered, shall be liable to be declared invalid if it is identical with, or similar to, an earlier Community **trade mark** within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier Community **trade mark** is registered, where the earlier Community

trade mark has a reputation in the Community and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the ea4. Any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

- (a) the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;
- (b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;
- (c) the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraphs 2 and 4 (b) and in particular:
 - (i) a right to a name;
 - (ii) a right of personal portrayal;
 - (iii) a copyright;
 - (iv) an industrial property right;
- (d) the trade mark is identical with, or similar to, an earlier collective trade mark conferring a right which expired within a period of a maximum of three years preceding application;
- (e) the trade mark is identical with, or similar to, an earlier guarantee or certification mark conferring a right which expired within a period preceding application the length of which is fixed by the Member State;
- (f) the trade mark is identical with, or similar to, an earlier trade mark which was registered for identical or similar goods or services and conferred on them a right which has expired for failure to renew within a period of a maximum of two years preceding application, unless the proprietor of the earlier trade mark gave his agreement for the registration of the later mark or did not use his trade mark;
- (g) the trade mark is liable to be confused with a mark which was in use abroad on the filing date of the application and which is still in use there, provided that at the date of the application the applicant was acting in bad faith?

5. The Member States may permit that in appropriate circumstances registration need not be refused or the trade mark need not be declared invalid where the proprietor of the earlier trade mark or other earlier right consents to the registration of the later trade mark.

6. Any Member State may provide that, by derogation from paragraphs 1 to 5, the grounds for refusal of registration or invalidity in force in that State prior to the date on which the provisions necessary to comply with this Directive enter into force, shall apply to trade marks for which application has been made prior to that date.

*Article 5*Rights conferred by a [trade mark](#)

1. The registered [trade mark](#) shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

- (a) any sign which is identical with the [trade mark](#) in relation to goods or services which are identical with those for which the [trade mark](#) is registered;
- (b) any sign where, because of its identity with, or similarity to, the [trade mark](#) and the identity or similarity of the goods or services covered by the [trade mark](#) and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the [trade mark](#).

2. Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the [trade mark](#) in relation to goods or services which are not similar to those for which the [trade mark](#) is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the [trade mark](#).

3. The following, inter alia, may be prohibited under paragraphs 1 and 2:

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under the sign;
- (d) using the sign on business papers and in advertising.

4. Where, under the law of the Member State, the use of a sign under the conditions referred to in 1 (b) or 2 could not be prohibited before the date on which the provisions necessary to comply with this [Directive](#) entered into force in the Member State concerned, the rights conferred by the [trade mark](#) may not be relied on to prevent the continued use of the sign.

5. Paragraphs 1 to 4 shall not affect provisions in any Member State relating to the protection against the use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the [trade mark](#)

*Article 6*Limitation of the effects of a [trade mark](#)

1. The [trade mark](#) shall not entitle the proprietor to prohibit a third party from using, in the course of trade,

- (a) his own name or address;
- (h) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin,

the time of production of goods or of rendering of the service, or other characteristics of goods or services;

- (c) the [trade mark](#) where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;

provided he uses them in accordance with honest practices in industrial or commercial matters

2. The [trade mark](#) shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognized by the laws of the Member State in question and within the limits of the territory in which it is recognized.

Article 7

Exhaustion of the rights conferred by a [trade mark](#)

1. The [trade mark](#) shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Community under that [trade mark](#) by the proprietor or with his consent.

2. Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialization of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

Article 8

Licensing

1. A [trade mark](#) may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Member State concerned. A license may be exclusive or non-exclusive.

2. The proprietor of a [trade mark](#) may invoke the rights conferred by that [trade mark](#) against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form covered by the registration in which the [trade mark](#) may be used, the scope of the goods or services for which the licence is granted, the territory in which the [trade mark](#) may be affixed, or the quality of the goods manufactured or of the services provided by the licensee.

Article 9

Limitation in consequence of acquiescence

1. Where, in a Member State, the proprietor of an earlier [trade mark](#) as referred to in Article 4 (2) has acquiesced, for a period of five successive years, in the use of a later [trade mark](#) registered in that Member State while being aware of such use, he shall no longer be entitled on the basis of the earlier [trade mark](#) either to apply for a declaration that the later [trade mark](#) is invalid or to oppose the use of the later [trade mark](#) in respect of the goods or services for which the later [trade mark](#) has been used, unless registration of the later [trade mark](#) was applied for in bad faith.

2. Any Member State may provide that paragraph 1 shall apply *mutatis mutandis* to the proprietor

of an earlier [trade mark](#) referred to in Article 4 (4) (a) or an other earlier right referred to in Article 4 (4) (b) or (c).

3. In the cases referred to in paragraphs 1 and 2, the proprietor of a later registered [trade mark](#) shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later [trade mark](#).

Article 10

Use of trade marks

1. If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the [trade mark](#) to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the [trade mark](#) shall be subject to the sanctions provided for in this [Directive](#), unless there are proper reasons for non-use.

2. The following shall also constitute use within the meaning of paragraph 1:

- (a) use of the [trade mark](#) in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;
- (b) affixing of the [trade mark](#) to goods or to the packaging thereof in the Member State concerned solely for export purposes.

3. Use of the [trade mark](#) with the consent of the proprietor or by any person who has authority to use a collective mark or a guarantee or certification mark shall be deemed to constitute use by the proprietor.

4. In relation to trade marks registered before the date on which the provisions necessary to comply with this [Directive](#) enter into force in the Member State concerned:

- (a) where a provision in force prior to that date attaches sanctions to non-use of a [trade mark](#) during an uninterrupted period, the relevant period of five years mentioned in paragraph 1 shall be deemed to have begun to run at the same time as any period of non-use which is already running at that date;
- (b) where there is no use provision in force prior to that date, the periods of five years mentioned in paragraph 1 shall be deemed to run from that date at the earliest.

Article 11

Sanctions for non use of a [trade mark](#) in legal or administrative proceedings

1. A [trade mark](#) may not be declared invalid on the ground that there is an earlier conflicting [trade mark](#) if the latter does not fulfil the requirements of use set out in Article 10 (1), (2) and (3) or in Article 10 (4), as the case may be.

2. Any Member State may provide that registration of a [trade mark](#) may not be refused on the ground that there is an earlier conflicting [trade mark](#) if the latter does not fulfil the requirements of use set out in Article 10 (1), (2) and (3) or in Article 10 (4), as the case may be.

3. Without prejudice to the application of Article 12, where a counter-claim for revocation is

made, any Member State may provide that a **trade mark** may not be successfully invoked in infringement proceedings if it is established as a result of a plea that the **trade mark** could be revoked pursuant to Article 12 (1).

4. If the earlier **trade mark** has been used in relation to part only of the goods or services for which it is registered, it shall, for purposes of applying paragraphs 1, 2 and 3, be deemed to be registered in respect only of that part of the goods or services.

Article 12

Grounds for revocation

1. A **trade mark** shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the goods or

services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor's rights in a **trade mark** should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, genuine use of the **trade mark** has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application for revocation which began at the earliest on expiry of the continuous period of five years of non-use, shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.

2. A **trade mark** shall also be liable to revocation if, after the date on which it was registered,

- (a) in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered;
- (b) in consequence of the use made of it by the proprietor of the **trade mark** or with his consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

Article 13

Grounds for refusal or revocation or invalidity relating to only some of the goods or services

Where grounds for refusal of registration or for revocation or invalidity of a **trade mark** exist in respect of only some of the goods or services for which that **trade mark** has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.

Article 14

Establishment a posteriori of invalidity or revocation of a **trade mark**

Where the seniority of an earlier **trade mark** which has been surrendered or allowed to lapse, is claimed for a Community **trade mark**, the invalidity or revocation of the earlier **trade mark** may be established a posteriori

Article 15

Special provisions in respect of collective marks, guarantee marks and certification marks

1. Without prejudice to Article 4, Member States whose laws authorize the registration of collective marks or of

guarantee or certification marks may provide that such marks shall not be registered, or shall be revoked or declared invalid, on grounds additional to those specified in Articles 3 and 12 where the function of those marks so requires.

2. By way of derogation from Article 3 (1) (c), Member States may provide that signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective, guarantee or certification marks. Such a mark does not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided he uses them in accordance with honest practices in industrial or commercial matters; in particular, such a mark may not be invoked against a third party who is entitled to use a geographical name

Article 16

National provisions to be adopted pursuant to this [Directive](#)

1. The Member States shall bring into force the laws, regulations and administrative provisions necessary to

comply with this [Directive](#) not later than 28 December 1991. They shall immediately inform the Commission thereof.

2. Acting on a proposal from the Commission, the Council, acting by qualified majority, may defer the date referred to in paragraph 1 until 31 December 1992 at the latest.

3. Member States shall communicate to the Commission the text of the main provisions of national law which they adopt in the field governed by this [Directive](#).

Article 17

Addressees.

This [Directive](#) is addressed to the Member States.

Done at Brussels, 21 December 1988.

For the Council

The President

V. PAPANDREOU

(1) OJ N° C 351, 31. 12. 1980, p. 1 and OJ N° C 351, 31. 12. 1985, p.4.

(2) OJ N° C 307, 14. 11. 1983, p. 66 and OJ N° C 309, 5. 12. 1988.

(3) OJ N° C 310, 30. 11. 1981, p. 22.

DOCNUM 31989L0104
AUTHOR Council
FORM [Directive](#)
TREATY European Economic Community
TYPDOC 3 ; secondary legislation ; 1989 ; L
PUBREF Official Journal L 040 , 11/02/1989 P. 0001 - 0007
 Finnish special edition: Chapter 13 Volume 17 P. 0178
 Swedish special edition: Chapter 13 Volume 17 P. 0178
DESCRIPT approximation of laws ; trademark ; brand name ; trademark law ; patents
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PUB 1989/02/11
DOC 1988/12/21
NOTIFIED 1988/12/27
INFORCE 1988/12/27=EV
ENDVAL 9999/99/99
TRANSPOS 1992/12/31
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[11957E149-P2](#).....
LEGCIT [11957E234](#).....
MODIFIES [51980PC0635\(01\)](#)..... Adoption.....
MODIFIED Corrected by.. [31989L0104R\(01\)](#).....
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 Amended by... [31992D0010](#)..... Replacement DATE ART.16.1
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COURTDEC A07P1.....: Interpreted by..... [61993J0427](#)
 A07P2.....: Interpreted by..... [61993J0427](#)
 A12P2LB.....: Interpreted by..... [61994J0313](#)
 A04P1LB.....: Interpreted by..... [61995J0251](#)
 A07.....: Interpreted by..... [61995J0337](#)
 A07P2.....: Interpreted by..... [61995J0337](#)
 A05.....: Interpreted by..... [61995J0337](#)
 A07.....: Interpreted by..... [61995J0352](#)
 A07P1.....: Interpreted by..... [61996J0355](#)
 A04P1LB.....: Interpreted by..... [61997J0039](#)
 Interpreted by..... [61997J0063](#)
 A05.....: Interpreted by..... [61997J0063](#)
 A05P1LA.....: Interpreted by..... [61997J0063](#)
 A06.....: Interpreted by..... [61997J0063](#)
 A07.....: Interpreted by..... [61997J0063](#)

A03P1LC.....: Interpreted by..... 61997J0108
 A03P3.....: Interpreted by..... 61997J0108
 A05P1LB.....: Interpreted by..... 61997J0342
 A05P2.....: Interpreted by..... 61997J0375
 A07P1.....: Interpreted by..... 61998J0173
 A05P1LB.....: Interpreted by..... 61998J0425
 A07P1.....: Interpreted by..... 61999J0414
 A07P2.....: Interpreted by..... 61999J0443
 A03P1LD.....: Interpreted by..... 61999J0517
 A05P1.....: Interpreted by..... 62000J0002
 A07P2.....: Interpreted by..... 62000J0143
 A02.....: Interpreted by..... 62000J0273
 A04P4LA.....: Interpreted by..... 62000J0292
 A05P2.....: Interpreted by..... 62000J0292
 A05P1LA.....: Interpreted by..... 62001J0206

SUB Internal market ; Industrial and commercial property

REGISTER 17200000

ADDRESS The Member States

AUTLANG The official languages ; Norwegian ; Icelandic

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 Proposal Commission;Com 85/0793 Final;OJ C 351/80 P 4
 Cooperation procedure ;Opinion European Parliament;OJ C 307/83 P 66
 Cooperation procedure ;Decision European Parliament;OJ C 309/88 P 43
 Opinion Economic and Social Committee;OJ C 310/81 P 22

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 AU02;/2/6/04/1995 AU03;26/04/1995 AU04;/2/6/04/1995 AU05;/2/6/04/1995
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 DE02/;

DESPNPR 21/0/6//1991 DK01;/1/5/10/1991 ES01;/1/4/11/1991 FR01;18/12/1992
 IT01;/2/4/06/1994 PT01;/0/2/01/1995 DE01;26/04/1995 AU01;/2/6/04/1995
 AU02;/2/6/04/1995 AU03;26/04/1995 AU04;/2/6/04/1995 AU05;/2/6/04/1995
 AU06;26/04/1995 AU07;/2/6/04/1995 FI01;/2/6/04/1995 SV01;26/04/1995
 SV02;/2/6/04/1995 SV03;/1/9/09/1996 LU01;06/12/1996 BE01;/0/2/01/1995
 DE02/;

**92/10/EEC: Council Decision
of 19 December 1991**

**postponing the date on which the national provisions applying Directive 89/104/EEC to
approximate the laws of the Member States relating to trade marks are to be put into effect**

COUNCIL DECISION of 19 December 1991 postponing the date on which the national provisions applying Directive 89/104/EEC to approximate the laws of the Member States relating to trade marks are to be put into effect (92/10/EEC)

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community,

Having regard to the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (1), and in particular Article 16 (2) thereof,

Having regard to the proposal from the Commission,

Whereas, pursuant to Article 16 (1) of Directive 89/104/EEC, Member States are to bring into force the laws, regulations and administrative provisions necessary to comply with the Directive not later than 28 December 1991;

Whereas pursuant to Article 16 (2) of that Directive, on a proposal from the Commission, the Council, acting by qualified majority, may defer the date referred to in paragraph 1 of that Article until 31 December 1992 at the latest;

Whereas this exceptional provision was included in the said Directive to ensure, if necessary, that the date of the putting into effect of the national provisions applying the Directive should, as far as possible, be aligned with the date as from which it would be possible for Community trade mark applications to be filed;

Whereas the Commission's proposal for a Council Regulation on the Community trade mark (1) has not yet been adopted; whereas it is expected that the said Regulation will be adopted shortly;

Whereas it seems therefore appropriate to postpone until 31 December 1992 the date provided for in Article 16 (1) of Directive 89/104/EEC, so that the objective referred to above may be the more easily pursued;

Whereas the objectives set for the completion of the internal market continue to be respected notwithstanding this postponement,

HAS ADOPTED THIS DECISION:

Article 1

The date set in Article 16 (1) of Directive 89/104/EEC shall be replaced by 31 December 1992.

Article 2

This Decision is addressed to the Member States. Done at Brussels, 19 December 1991. For the Council

The President

P. DANKERT

(1) OJ No L 40, 11. 2. 1989, p. 1. (2) OJ No C 351, 31. 12. 1981, p. 1 and OJ No C 230, 31. 8. 1984, p. 1.

DOCNUM 31992D0010
AUTHOR Council
FORM Decision
TREATY European Economic Community
TYPDOC 3 ; secondary legislation ; 1992 ; D
PUBREF Official Journal L 006 , 11/01/1992 P. 0035 - 0035
Finnish special edition....: Chapter 13 Volume 22 P. 0003
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DESCRIPT trademark ; industrial property ; approximation of laws
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32005H0737R(01)
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**Corrigendum to Commission Recommendation 2005/737/EC
of 18 May 2005**

**on collective cross-border management of [copyright](#) and related rights for legitimate online music
services (OJ L 276, 21.10.2005)**

Corrigendum to Commission Recommendation 2005/737/EC of 18 May 2005 on collective cross-border
management of copyright and related rights for legitimate online music services

(Official Journal of the European Union L 276 of 21 October 2005)

On the cover page, in the contents, on page 54 in the title and on page 57 in the signature:

for:

" 18 May 2005",

read:

" 18 October 2005".

DOCNUM	32005H0737R(01)
AUTHOR	European Commission
FORM	Recommendation
PUBREF	Official Journal L 284 , 27/10/2005 P. 0010 - 0010 (ES, CS, DA, DE, ET, EL, EN, FR, IT, LV, LT, HU, NL, PL, PT, SK, SL, FI, SV)
PUB	2005/10/27
MODIFIES	32005H0737 Corrigendum

**Commission Recommendation
of 18 May 2005
on collective cross-border management of **copyright** and related rights for legitimate online music
services (Text with EEA relevance)**

Commission Recommendation

of 18 May 2005

on collective cross-border management of copyright and related rights for legitimate online music services

(Text with EEA relevance)

(2005/737/EC)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community, and in particular Article 211 thereof,

Whereas:

- (1) In April 2004 the Commission adopted a Communication on the Management of Copyright and Related Rights in the Internal Market.
- (2) The European Parliament, in its report of 15 January 2004 [1], stated that right-holders should be able to enjoy copyright and related rights protection wherever such rights are established, independent of national borders or modes of use during the whole term of their validity.
- (3) The European Parliament further emphasised that any action by the Community in respect of the collective cross-border management of copyright and related rights should strengthen the confidence of artists, including writers and musicians, that the pan-European use of their creative works will be financially rewarded [2].
- (4) New technologies have led to the emergence of a new generation of commercial users that make use of musical works and other subject matter online. The provision of legitimate online music services requires management of a series of copyright and related rights.
- (5) One category of those rights is the exclusive right of reproduction which covers all reproductions made in the process of online distribution of a musical work. Other categories of rights are the right of communication to the public of musical works, the right to equitable remuneration for the communication to the public of other subject matter and the exclusive right of making available a musical work or other subject matter.
- (6) Pursuant to Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society [3] and Council Directive 92/100/EEC of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of intellectual property [4], a licence is required for each of the rights in the online exploitation of musical works. These rights may be managed by collective rights managers that provide certain management services to right-holders as agents or by individual right-holders themselves.
- (7) Licensing of online rights is often restricted by territory, and commercial users negotiate in each Member State with each of the respective collective rights managers for each right that is included in the online exploitation.
- (8) In the era of online exploitation of musical works, however, commercial users need a licensing policy that corresponds to the ubiquity of the online environment and which is multi-territorial.

It is therefore appropriate to provide for multi-territorial licensing in order to enhance greater legal certainty to commercial users in relation to their activity and to foster the development of legitimate online services, increasing, in turn, the revenue stream for right-holders.

- (9) Freedom to provide collective management services across national borders entails that right-holders are able to freely choose the collective rights manager for the management of the rights necessary to operate legitimate online music services across the Community. That right implies the possibility to entrust or transfer all or a part of the online rights to another collective rights manager irrespective of the Member State of residence or the nationality of either the collective rights manager or the rights-holder.
- (10) Fostering effective structures for cross-border management of rights should also ensure that collective rights managers achieve a higher level of rationalisation and transparency, with regard to compliance with competition rules, especially in the light of the requirements arising out of the digital environment.
- (11) The relationship between right-holders and collective rights managers, whether based on contract or statutory membership rules, should include a minimum protection for right-holders with respect to all categories of rights that are necessary for the provision of legitimate online music services. There should be no difference in treatment of right-holders by rights managers on the basis of the Member State of residence or nationality.
- (12) Royalties collected on behalf of right-holders should be distributed equitably and without discrimination on the grounds of residence, nationality, or category of right-holder. In particular, royalties collected on behalf of right-holders in Member States other than those in which the right-holders are resident or of which they are nationals should be distributed as effectively and efficiently as possible.
- (13) Additional recommendations on accountability, right-holder representation in the decision-making bodies of collective rights managers and dispute resolution should ensure that collective rights managers achieve a higher level of rationalisation and transparency and that right-holders and commercial users can make informed choices. There should be no difference in treatment on the basis of category of membership in the collective rights management society: all right-holders, be they authors, composers, publishers, record producers, performers or others, should be treated equally.
- (14) It is appropriate to continuously assess the development of the online music market,

HEREBY RECOMMENDS:

Definitions

1. For the purposes of this Recommendation the following definitions are applied:

- (a) "management of copyright and related rights for the provision of legitimate online music services at Community level" means the provision of the following services: the grant of licences to commercial users, the auditing and monitoring of rights, the enforcement of copyright and related rights, the collection of royalties and the distribution of royalties to right-holders;
- (b) "musical works" means any musical work or other protected subject matter;
- (c) "repertoire" means the catalogue of musical works which is administered by a collective rights manager;
- (d) "multi-territorial licence" means a licence which covers the territory of more than one Member state;

-
- (e) "collective rights manager" means any person providing the services set out in point (a) to several right-holders;
- (f) "online rights" means any of the following rights:
- (i) the exclusive right of reproduction that covers all reproductions provided for under Directive 2001/29/EC in the form of intangible copies, made in the process of online distribution of musical works;
- (ii) the right of communication to the public of a musical work, either in the form of a right to authorise or prohibit pursuant to Directive 2001/29/EC or a right to equitable remuneration in accordance with Directive 92/100/EEC, which includes webcasting, internet radio and simulcasting or near-on-demand services received either on a personal computer or on a mobile telephone;
- (iii) the exclusive right of making available a musical work pursuant to Directive 2001/29/EC, which includes on-demand or other interactive services;
- (g) "right-holder" means any natural or legal person that holds online rights;
- (h) "commercial user" means any person involved in the provision of online music services who needs a licence from right-holders in order to provide legitimate online music services;
- (i) "reciprocal representation agreement" means any bilateral agreement between collective rights managers whereby one collective rights manager grants to the other the right to represent its repertoire in the territory of the other.

General

2. Member States are invited to take the steps necessary to facilitate the growth of legitimate online services in the Community by promoting a regulatory environment which is best suited to the management, at Community level, of copyright and related rights for the provision of legitimate online music services.

The relationship between right-holders, collective rights managers and commercial users

3. Right-holders should have the right to entrust the management of any of the online rights necessary to operate legitimate online music services, on a territorial scope of their choice, to a collective rights manager of their choice, irrespective of the Member State of residence or the nationality of either the collective rights manager or the right-holder.

4. Collective rights managers should apply the utmost diligence in representing the interests of right-holders.

5. With respect to the licensing of online rights the relationship between right-holders and collective rights managers, whether based on contract or statutory membership rules, should, at least be governed by the following:

- (a) right-holders should be able to determine the online rights to be entrusted for collective management;
- (b) right-holders should be able to determine the territorial scope of the mandate of the collective rights managers;
- (c) right-holders should, upon reasonable notice of their intention to do so, have the right to withdraw any of the online rights and transfer the multi territorial management of those rights to another collective rights manager, irrespective of the Member State of residence or the nationality of either the collective rights manager or the right-holder;
- (d) where a right-holder has transferred the management of an online right to another collective rights manager, without prejudice to other forms of cooperation among rights managers, all collective

rights managers concerned should ensure that those online rights are withdrawn from any existing reciprocal representation agreement concluded amongst them.

6. Collective rights managers should inform right-holders and commercial users of the repertoire they represent, any existing reciprocal representation agreements, the territorial scope of their mandates for that repertoire and the applicable tariffs.

7. Collective rights managers should give reasonable notice to each other and commercial users of changes in the repertoire they represent.

8. Commercial users should inform collective right managers of the different features of the services for which they want to acquire online rights.

9. Collective rights managers should grant commercial users licences on the basis of objective criteria and without any discrimination among users.

Equitable distribution and deductions

10. Collective rights managers should distribute royalties to all right-holders or category of right-holders they represent in an equitable manner.

11. Contracts and statutory membership rules governing the relationship between collective rights managers and right-holders for the management, at Community level, of musical works for online use should specify whether and to what extent, there will be deductions from the royalties to be distributed for purposes other than for the management services provided.

12. Upon payment of the royalties collective rights managers should specify vis-à-vis all the right-holders they represent, the deductions made for purposes other than for the management services provided.

Non-discrimination and representation

13. The relationship between collective rights managers and right-holders, whether based on contract or statutory membership rules should be based on the following principles:

- (a) any category of right-holder is treated equally in relation to all elements of the management service provided;
- (b) the representation of right-holders in the internal decision making process is fair and balanced.

Accountability

14. Collective rights managers should report regularly to all right-holders they represent, whether directly or under reciprocal representation agreements, on any licences granted, applicable tariffs and royalties collected and distributed.

Dispute settlement

15. Member States are invited to provide for effective dispute resolution mechanisms, in particular in relation to tariffs, licensing conditions, entrustment of online rights for management and withdrawal of online rights.

Follow-up

16. Member States and collective rights managers are invited to report, on a yearly basis, to the Commission on the measures they have taken in relation to this Recommendation and on the management, at Community level, of copyright and related rights for the provision of legitimate online music services.

17. The Commission intends to assess, on a continuous basis, the development of the online music sector and in the light of this Recommendation.

18. The Commission will to consider, on the basis of the assessment referred to in point 17, the need for further action at Community level.

Addressees

19. This Recommendation is addressed to the Member States and to all economic operators which are involved in the management of copyright and related rights within the Community.

Done at Brussels, 18 May 2005.

For the Commission

Charlie McCreevy

Member of the Commission

[1] A5-0478/2003.

[2] See recital 29.

[3] OJ L 167, 22.6.2001, p. 10.

[4] OJ L 346, 27.11.1992, p. 61. Directive as amended by Directive 2001/29/EC.

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AUTHOR	European Commission
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32001L0029R(01)

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**Corrigendum to Directive 2001/29/EC of the European Parliament and of the Council
of 22 May 2001
on the harmonisation of certain aspects of **copyright** and related rights in the information society
(OJ L 167 of 22.6.2001)**

Corrigendum to Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society

(Official Journal of the European Communities L 167 of 22 June 2001)

On page 16, in Article 5(1), introductory phrase:

for:

1. Temporary acts of reproduction referred to in Article 2, which are transient or incidental [and] an integral and essential part of a technological process and whose sole purpose is to enable;

read:

1. Temporary acts of reproduction referred to in Article 2, which are transient or incidental, which are an integral and essential part of a technological process and the sole purpose of which is to enable:.

DOCNUM	32001L0029R(01)
TYPDOC	3 ; secondary legislation ; 2001 ; L
PUBREF	Official Journal L 006 , 10/01/2002 P. 0070 - 0070 ES EN
DESCRIPT	information society ; copyright ; approximation of laws
PUB	2002/01/10
MODIFIES	32001L0029 Corrigendum... (EN, ES)

Directive 2001/84/EC of the European Parliament and of the Council of 27 September 2001 on the resale right for the benefit of the author of an original work of art

Directive 2001/84/EC of the European Parliament and of the Council
of 27 September 2001

on the resale right for the benefit of the author of an original work of art

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 95 thereof,

Having regard to the proposal from the Commission(1),

Having regard to the opinion of the Economic and Social Committee(2),

Acting in accordance with the procedure laid down in Article 251 of the Treaty(3), and in the light of the joint text approved by the Conciliation Committee on 6 June 2001,

Whereas:

- (1) In the field of copyright, the resale right is an unassignable and inalienable right, enjoyed by the author of an original work of graphic or plastic art, to an economic interest in successive sales of the work concerned.
- (2) The resale right is a right of a productive character which enables the author/artist to receive consideration for successive transfers of the work. The subject-matter of the resale right is the physical work, namely the medium in which the protected work is incorporated.
- (3) The resale right is intended to ensure that authors of graphic and plastic works of art share in the economic success of their original works of art. It helps to redress the balance between the economic situation of authors of graphic and plastic works of art and that of other creators who benefit from successive exploitations of their works.
- (4) The resale right forms an integral part of copyright and is an essential prerogative for authors. The imposition of such a right in all Member States meets the need for providing creators with an adequate and standard level of protection.
- (5) Under Article 151(4) of the Treaty the Community is to take cultural aspects into account in its action under other provisions of the Treaty.
- (6) The Berne Convention for the Protection of Literary and Artistic Works provides that the resale right is available only if legislation in the country to which the author belongs so permits. The right is therefore optional and subject to the rule of reciprocity. It follows from the case-law of the Court of Justice of the European Communities on the application of the principle of non-discrimination laid down in Article 12 of the Treaty, as shown in the judgment of 20 October 1993 in Joined Cases C-92/92 and C-326/92 *Phil Collins and Others*(4), that domestic provisions containing reciprocity clauses cannot be relied upon in order to deny nationals of other Member States rights conferred on national authors. The application of such clauses in the Community context runs counter to the principle of equal treatment resulting from the prohibition of any discrimination on grounds of nationality.
- (7) The process of internationalisation of the Community market in modern and contemporary art, which is now being speeded up by the effects of the new economy, in a regulatory context in which few States outside the EU recognise the resale right, makes it essential for the European Community, in the external sphere, to open negotiations with a view to making Article 14b of the Berne

Convention compulsory.

- (8) The fact that this international market exists, combined with the lack of a resale right in several Member States and the current disparity as regards national systems which recognise that right, make it essential to lay down transitional provisions as regards both entry into force and the substantive regulation of the right, which will preserve the competitiveness of the European market.
- (9) The resale right is currently provided for by the domestic legislation of a majority of Member States. Such laws, where they exist, display certain differences, notably as regards the works covered, those entitled to receive royalties, the rate applied, the transactions subject to payment of a royalty, and the basis on which these are calculated. The application or non-application of such a right has a significant impact on the competitive environment within the internal market, since the existence or absence of an obligation to pay on the basis of the resale right is an element which must be taken into account by each individual wishing to sell a work of art. This right is therefore a factor which contributes to the creation of distortions of competition as well as displacement of sales within the Community.
- (10) Such disparities with regard to the existence of the resale right and its application by the Member States have a direct negative impact on the proper functioning of the internal market in works of art as provided for by Article 14 of the Treaty. In such a situation Article 95 of the Treaty constitutes the appropriate legal basis.
- (11) The objectives of the Community as set out in the Treaty include laying the foundations of an ever closer union among the peoples of Europe, promoting closer relations between the Member States belonging to the Community, and ensuring their economic and social progress by common action to eliminate the barriers which divide Europe. To that end the Treaty provides for the establishment of an internal market which presupposes the abolition of obstacles to the free movement of goods, freedom to provide services and freedom of establishment, and for the introduction of a system ensuring that competition in the common market is not distorted. Harmonisation of Member States' laws on the resale right contributes to the attainment of these objectives.
- (12) The Sixth Council Directive (77/388/EEC) of 17 May 1977 on the harmonisation of the laws of the Member States relating to turnover taxes - common system of value added tax: uniform basis of assessment⁽⁵⁾, progressively introduces a Community system of taxation applicable inter alia to works of art. Measures confined to the tax field are not sufficient to guarantee the harmonious functioning of the art market. This objective cannot be attained without harmonisation in the field of the resale right.
- (13) Existing differences between laws should be eliminated where they have a distorting effect on the functioning of the internal market, and the emergence of any new differences of that kind should be prevented. There is no need to eliminate, or prevent the emergence of, differences which cannot be expected to affect the functioning of the internal market.
- (14) A precondition of the proper functioning of the internal market is the existence of conditions of competition which are not distorted. The existence of differences between national provisions on the resale right creates distortions of competition and displacement of sales within the Community and leads to unequal treatment between artists depending on where their works are sold. The issue under consideration has therefore transnational aspects which cannot be satisfactorily regulated by action by Member States. A lack of Community action would conflict with the requirement of the Treaty to correct distortions of competition and unequal treatment.
- (15) In view of the scale of divergences between national provisions it is therefore necessary to adopt harmonising measures to deal with disparities between the laws of the Member States

in areas where such disparities are liable to create or maintain distorted conditions of competition. It is not however necessary to harmonise every provision of the Member States' laws on the resale right and, in order to leave as much scope for national decision as possible, it is sufficient to limit the harmonisation exercise to those domestic provisions that have the most direct impact on the functioning of the internal market.

- (16) This Directive complies therefore, in its entirety, with the principles of subsidiarity and proportionality as laid down in Article 5 of the Treaty.
- (17) Pursuant to Council Directive 93/98/EEC of 29 October 1993 harmonising the term of protection of copyright and certain related rights(6), the term of copyright runs for 70 years after the author's death. The same period should be laid down for the resale right. Consequently, only the originals of works of modern and contemporary art may fall within the scope of the resale right. However, in order to allow the legal systems of Member States which do not, at the time of the adoption of this Directive, apply a resale right for the benefit of artists to incorporate this right into their respective legal systems and, moreover, to enable the economic operators in those Member States to adapt gradually to the aforementioned right whilst maintaining their economic viability, the Member States concerned should be allowed a limited transitional period during which they may choose not to apply the resale right for the benefit of those entitled under the artist after his death.
- (18) The scope of the resale right should be extended to all acts of resale, with the exception of those effected directly between persons acting in their private capacity without the participation of an art market professional. This right should not extend to acts of resale by persons acting in their private capacity to museums which are not for profit and which are open to the public. With regard to the particular situation of art galleries which acquire works directly from the author, Member States should be allowed the option of exempting from the resale right acts of resale of those works which take place within three years of that acquisition. The interests of the artist should also be taken into account by limiting this exemption to such acts of resale where the resale price does not exceed EUR 10000.
- (19) It should be made clear that the harmonisation brought about by this Directive does not apply to original manuscripts of writers and composers.
- (20) Effective rules should be laid down based on experience already gained at national level with the resale right. It is appropriate to calculate the royalty as a percentage of the sale price and not of the increase in value of works whose original value has increased.
- (21) The categories of works of art subject to the resale right should be harmonised.
- (22) The non-application of royalties below the minimum threshold may help to avoid disproportionately high collection and administration costs compared with the profit for the artist. However, in accordance with the principle of subsidiarity, the Member States should be allowed to establish national thresholds lower than the Community threshold, so as to promote the interests of new artists. Given the small amounts involved, this derogation is not likely to have a significant effect on the proper functioning of the internal market.
- (23) The rates set by the different Member States for the application of the resale right vary considerably at present. The effective functioning of the internal market in works of modern and contemporary art requires the fixing of uniform rates to the widest possible extent.
- (24) It is desirable to establish, with the intention of reconciling the various interests involved in the market for original works of art, a system consisting of a tapering scale of rates for several price bands. It is important to reduce the risk of sales relocating and of the circumvention

of the Community rules on the resale right.

- (25) The person by whom the royalty is payable should, in principle, be the seller. Member States should be given the option to provide for derogations from this principle in respect of liability for payment. The seller is the person or undertaking on whose behalf the sale is concluded.
- (26) Provision should be made for the possibility of periodic adjustment of the threshold and rates. To this end, it is appropriate to entrust to the Commission the task of drawing up periodic reports on the actual application of the resale right in the Member States and on the impact on the art market in the Community and, where appropriate, of making proposals relating to the amendment of this Directive.
- (27) The persons entitled to receive royalties must be specified, due regard being had to the principle of subsidiarity. It is not appropriate to take action through this Directive in relation to Member States' laws of succession. However, those entitled under the author must be able to benefit fully from the resale right after his death, at least following the expiry of the transitional period referred to above.
- (28) The Member States are responsible for regulating the exercise of the resale right, particularly with regard to the way this is managed. In this respect management by a collecting society is one possibility. Member States should ensure that collecting societies operate in a transparent and efficient manner. Member States must also ensure that amounts intended for authors who are nationals of other Member States are in fact collected and distributed. This Directive is without prejudice to arrangements in Member States for collection and distribution.
- (29) Enjoyment of the resale right should be restricted to Community nationals as well as to foreign authors whose countries afford such protection to authors who are nationals of Member States. A Member State should have the option of extending enjoyment of this right to foreign authors who have their habitual residence in that Member State.
- (30) Appropriate procedures for monitoring transactions should be introduced so as to ensure by practical means that the resale right is effectively applied by Member States. This implies also a right on the part of the author or his authorised representative to obtain any necessary information from the natural or legal person liable for payment of royalties. Member States which provide for collective management of the resale right may also provide that the bodies responsible for that collective management should alone be entitled to obtain information,

HAVE ADOPTED THIS DIRECTIVE:

CHAPTER I

SCOPE

Article 1

Subject matter of the resale right

1. Member States shall provide, for the benefit of the author of an original work of art, a resale right, to be defined as an inalienable right, which cannot be waived, even in advance, to receive a royalty based on the sale price obtained for any resale of the work, subsequent to the first transfer of the work by the author.
2. The right referred to in paragraph 1 shall apply to all acts of resale involving as sellers, buyers or intermediaries art market professionals, such as salesrooms, art galleries and, in general,

any dealers in works of art.

3. Member States may provide that the right referred to in paragraph 1 shall not apply to acts of resale where the seller has acquired the work directly from the author less than three years before that resale and where the resale price does not exceed EUR 10000.

4. The royalty shall be payable by the seller. Member States may provide that one of the natural or legal persons referred to in paragraph 2 other than the seller shall alone be liable or shall share liability with the seller for payment of the royalty.

Article 2

Works of art to which the resale right relates

1. For the purposes of this Directive, "original work of art" means works of graphic or plastic art such as pictures, collages, paintings, drawings, engravings, prints, lithographs, sculptures, tapestries, ceramics, glassware and photographs, provided they are made by the artist himself or are copies considered to be original works of art.

2. Copies of works of art covered by this Directive, which have been made in limited numbers by the artist himself or under his authority, shall be considered to be original works of art for the purposes of this Directive. Such copies will normally have been numbered, signed or otherwise duly authorised by the artist.

CHAPTER II

PARTICULAR PROVISIONS

Article 3

Threshold

1. It shall be for the Member States to set a minimum sale price from which the sales referred to in Article 1 shall be subject to resale right.

2. This minimum sale price may not under any circumstances exceed EUR 3000.

Article 4

Rates

1. The royalty provided for in Article 1 shall be set at the following rates:

- (a) 4 % for the portion of the sale price up to EUR 50000;
- (b) 3 % for the portion of the sale price from EUR 50000,01 to EUR 200000;
- (c) 1 % for the portion of the sale price from EUR 200000,01 to EUR 350000;
- (d) 0,5 % for the portion of the sale price from EUR 350000,01 to EUR 500000;
- (e) 0,25 % for the portion of the sale price exceeding EUR 500000.

However, the total amount of the royalty may not exceed EUR 12500.

2. By way of derogation from paragraph 1, Member States may apply a rate of 5 % for the portion of the sale price referred to in paragraph 1(a).

3. If the minimum sale price set should be lower than EUR 3000, the Member State shall also determine the rate applicable to the portion of the sale price up to EUR 3000; this rate may not be lower than 4 %.

Article 5

Calculation basis

The sale prices referred to in Articles 3 and 4 are net of tax.

Article 6

Persons entitled to receive royalties

1. The royalty provided for under Article 1 shall be payable to the author of the work and, subject to Article 8(2), after his death to those entitled under him/her.

2. Member States may provide for compulsory or optional collective management of the royalty provided for under Article 1.

Article 7

Third-country nationals entitled to receive royalties

1. Member States shall provide that authors who are nationals of third countries and, subject to Article 8(2), their successors in title shall enjoy the resale right in accordance with this Directive and the legislation of the Member State concerned only if legislation in the country of which the author or his/her successor in title is a national permits resale right protection in that country for authors from the Member States and their successors in title.

2. On the basis of information provided by the Member States, the Commission shall publish as soon as possible an indicative list of those third countries which fulfil the condition set out in paragraph 1. This list shall be kept up to date.

3. Any Member State may treat authors who are not nationals of a Member State but who have their habitual residence in that Member State in the same way as its own nationals for the purpose of resale right protection.

Article 8

Term of protection of the resale right

1. The term of protection of the resale right shall correspond to that laid down in Article 1 of

Directive 93/98/EEC.

2. By way of derogation from paragraph 1, those Member States which do not apply the resale right on (the entry into force date referred to in Article 13), shall not be required, for a period expiring not later than 1 January 2010, to apply the resale right for the benefit of those entitled under the artist after his/her death.

3. A Member State to which paragraph 2 applies may have up to two more years, if necessary to enable the economic operators in that Member State to adapt gradually to the resale right system while maintaining their economic viability, before it is required to apply the resale right for the benefit of those entitled under the artist after his/her death. At least 12 months before the end of the period referred to in paragraph 2, the Member State concerned shall inform the Commission giving its reasons, so that the Commission can give an opinion, after appropriate consultations, within three months following the receipt of such information. If the Member State does not follow the opinion of the Commission, it shall within one month inform the Commission and justify its decision. The notification and justification of the Member State and the opinion of the Commission shall be published in the Official Journal of the European Communities and forwarded to the European Parliament.

4. In the event of the successful conclusion, within the periods referred to in Article 8(2) and (3), of international negotiations aimed at extending the resale right at international level, the Commission shall submit appropriate proposals.

Article 9

Right to obtain information

The Member States shall provide that for a period of three years after the resale, the persons entitled under Article 6 may require from any art market professional mentioned in Article 1(2) to furnish any information that may be necessary in order to secure payment of royalties in respect of the resale.

CHAPTER III

FINAL PROVISIONS

Article 10

Application in time

This Directive shall apply in respect of all original works of art as defined in Article 2 which, on 1 January 2006, are still protected by the legislation of the Member States in the field of copyright or meet the criteria for protection under the provisions of this Directive at that date.

Article 11

Revision clause

1. The Commission shall submit to the European Parliament, the Council and the Economic and Social

Committee not later than 1 January 2009 and every four years thereafter a report on the implementation and the effect of this Directive, paying particular attention to the competitiveness of the market in modern and contemporary art in the Community, especially as regards the position of the Community in relation to relevant markets that do not apply the resale right and the fostering of artistic creativity and the management procedures in the Member States. It shall examine in particular its impact on the internal market and the effect of the introduction of the resale right in those Member States that did not apply the right in national law prior to the entry into force of this Directive. Where appropriate, the Commission shall submit proposals for adapting the minimum threshold and the rates of royalty to take account of changes in the sector, proposals relating to the maximum amount laid down in Article 4(1) and any other proposal it may deem necessary in order to enhance the effectiveness of this Directive.

2. A Contact Committee is hereby established. It shall be composed of representatives of the competent authorities of the Member States. It shall be chaired by a representative of the Commission and shall meet either on the initiative of the Chairman or at the request of the delegation of a Member State.

3. The task of the Committee shall be as follows:

- to organise consultations on all questions deriving from application of this Directive,
- to facilitate the exchange of information between the Commission and the Member States on relevant developments in the art market in the Community.

Article 12

Implementation

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive before 1 January 2006. They shall forthwith inform the Commission thereof.

When Member States adopt these measures, they shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such a reference shall be laid down by the Member States.

2. Member States shall communicate to the Commission the provisions of national law which they adopt in the field covered by this Directive.

Article 13

Entry into force

This Directive shall enter into force on the day of its publication in the Official Journal of the European Communities.

Article 14

Addressees

This Directive is addressed to the Member States.

Done at Brussels, 27 September 2001.

For the European Parliament

The President

N. Fontaine

For the Council

The President

C. Picqué

(1) OJ C 178, 21.6.1996, p. 16 and OJ C 125, 23.4.1998, p. 8.

(2) OJ C 75, 10.3.1997, p. 17.

(3) Opinion of the European Parliament of 9 April 1997 (OJ C 132, 28.4.1997, p. 88), confirmed on 27 October 1999, Council Common Position of 19 June 2000 (OJ C 300, 20.10.2000, p. 1) and Decision of the European Parliament of 13 December 2000 (OJ C 232, 17.8.2001, p. 173). Decision of the European Parliament of 3 July 2001 and Decision of the Council of 19 July 2001.

(4) [1993] ECR I-5145.

(5) OJ L 145, 13.6.1977, p. 1. Directive as last amended by Directive 1999/85/EC (OJ L 277, 28.10.1999, p. 34).

(6) OJ L 290, 24.11.1993, p. 9.

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Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of [copyright](#) and related rights in the information society

Directive 2001/29/EC of the European Parliament and of the Council
of 22 May 2001

on the harmonisation of certain aspects of copyright and related rights in the information society

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Articles 47(2), 55 and 95 thereof,

Having regard to the proposal from the Commission(1),

Having regard to the opinion of the Economic and Social Committee(2),

Acting in accordance with the procedure laid down in Article 251 of the Treaty(3),

Whereas:

- (1) The Treaty provides for the establishment of an internal market and the institution of a system ensuring that competition in the internal market is not distorted. Harmonisation of the laws of the Member States on copyright and related rights contributes to the achievement of these objectives.
- (2) The European Council, meeting at Corfu on 24 and 25 June 1994, stressed the need to create a general and flexible legal framework at Community level in order to foster the development of the information society in Europe. This requires, inter alia, the existence of an internal market for new products and services. Important Community legislation to ensure such a regulatory framework is already in place or its adoption is well under way. Copyright and related rights play an important role in this context as they protect and stimulate the development and marketing of new products and services and the creation and exploitation of their creative content.
- (3) The proposed harmonisation will help to implement the four freedoms of the internal market and relates to compliance with the fundamental principles of law and especially of property, including intellectual property, and freedom of expression and the public interest.
- (4) A harmonised legal framework on copyright and related rights, through increased legal certainty and while providing for a high level of protection of intellectual property, will foster substantial investment in creativity and innovation, including network infrastructure, and lead in turn to growth and increased competitiveness of European industry, both in the area of content provision and information technology and more generally across a wide range of industrial and cultural sectors. This will safeguard employment and encourage new job creation.
- (5) Technological development has multiplied and diversified the vectors for creation, production and exploitation. While no new concepts for the protection of intellectual property are needed, the current law on copyright and related rights should be adapted and supplemented to respond adequately to economic realities such as new forms of exploitation.
- (6) Without harmonisation at Community level, legislative activities at national level which have already been initiated in a number of Member States in order to respond to the technological challenges might result in significant differences in protection and thereby in restrictions on the free movement of services and products incorporating, or based on, intellectual property, leading to a refragmentation of the internal market and legislative inconsistency. The impact of such legislative differences and uncertainties will become more significant with the further

development of the information society, which has already greatly increased transborder exploitation of intellectual property. This development will and should further increase. Significant legal differences and uncertainties in protection may hinder economies of scale for new products and services containing copyright and related rights.

- (7) The Community legal framework for the protection of copyright and related rights must, therefore, also be adapted and supplemented as far as is necessary for the smooth functioning of the internal market. To that end, those national provisions on copyright and related rights which vary considerably from one Member State to another or which cause legal uncertainties hindering the smooth functioning of the internal market and the proper development of the information society in Europe should be adjusted, and inconsistent national responses to the technological developments should be avoided, whilst differences not adversely affecting the functioning of the internal market need not be removed or prevented.
- (8) The various social, societal and cultural implications of the information society require that account be taken of the specific features of the content of products and services.
- (9) Any harmonisation of copyright and related rights must take as a basis a high level of protection, since such rights are crucial to intellectual creation. Their protection helps to ensure the maintenance and development of creativity in the interests of authors, performers, producers, consumers, culture, industry and the public at large. Intellectual property has therefore been recognised as an integral part of property.
- (10) If authors or performers are to continue their creative and artistic work, they have to receive an appropriate reward for the use of their work, as must producers in order to be able to finance this work. The investment required to produce products such as phonograms, films or multimedia products, and services such as "on-demand" services, is considerable. Adequate legal protection of intellectual property rights is necessary in order to guarantee the availability of such a reward and provide the opportunity for satisfactory returns on this investment.
- (11) A rigorous, effective system for the protection of copyright and related rights is one of the main ways of ensuring that European cultural creativity and production receive the necessary resources and of safeguarding the independence and dignity of artistic creators and performers.
- (12) Adequate protection of copyright works and subject-matter of related rights is also of great importance from a cultural standpoint. Article 151 of the Treaty requires the Community to take cultural aspects into account in its action.
- (13) A common search for, and consistent application at European level of, technical measures to protect works and other subject-matter and to provide the necessary information on rights are essential insofar as the ultimate aim of these measures is to give effect to the principles and guarantees laid down in law.
- (14) This Directive should seek to promote learning and culture by protecting works and other subject-matter while permitting exceptions or limitations in the public interest for the purpose of education and teaching.
- (15) The Diplomatic Conference held under the auspices of the World Intellectual Property Organisation (WIPO) in December 1996 led to the adoption of two new Treaties, the "WIPO Copyright Treaty" and the "WIPO Performances and Phonograms Treaty", dealing respectively with the protection of authors and the protection of performers and phonogram producers. Those Treaties update the international protection for copyright and related rights significantly, not least with regard to the so-called "digital agenda", and improve the means to fight piracy world-wide. The Community and a majority of Member States have already signed the Treaties and the process of making arrangements

for the ratification of the Treaties by the Community and the Member States is under way. This Directive also serves to implement a number of the new international obligations.

- (16) Liability for activities in the network environment concerns not only copyright and related rights but also other areas, such as defamation, misleading advertising, or infringement of trademarks, and is addressed horizontally in Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the internal market ("Directive on electronic commerce")(4), which clarifies and harmonises various legal issues relating to information society services including electronic commerce. This Directive should be implemented within a timescale similar to that for the implementation of the Directive on electronic commerce, since that Directive provides a harmonised framework of principles and provisions relevant inter alia to important parts of this Directive. This Directive is without prejudice to provisions relating to liability in that Directive.
- (17) It is necessary, especially in the light of the requirements arising out of the digital environment, to ensure that collecting societies achieve a higher level of rationalisation and transparency with regard to compliance with competition rules.
- (18) This Directive is without prejudice to the arrangements in the Member States concerning the management of rights such as extended collective licences.
- (19) The moral rights of rightholders should be exercised according to the legislation of the Member States and the provisions of the Berne Convention for the Protection of Literary and Artistic Works, of the WIPO Copyright Treaty and of the WIPO Performances and Phonograms Treaty. Such moral rights remain outside the scope of this Directive.
- (20) This Directive is based on principles and rules already laid down in the Directives currently in force in this area, in particular Directives 91/250/EEC(5), 92/100/EEC(6), 93/83/EEC(7), 93/98/EEC(8) and 96/9/EC(9), and it develops those principles and rules and places them in the context of the information society. The provisions of this Directive should be without prejudice to the provisions of those Directives, unless otherwise provided in this Directive.
- (21) This Directive should define the scope of the acts covered by the reproduction right with regard to the different beneficiaries. This should be done in conformity with the *acquis communautaire*. A broad definition of these acts is needed to ensure legal certainty within the internal market.
- (22) The objective of proper support for the dissemination of culture must not be achieved by sacrificing strict protection of rights or by tolerating illegal forms of distribution of counterfeited or pirated works.
- (23) This Directive should harmonise further the author's right of communication to the public. This right should be understood in a broad sense covering all communication to the public not present at the place where the communication originates. This right should cover any such transmission or retransmission of a work to the public by wire or wireless means, including broadcasting. This right should not cover any other acts.
- (24) The right to make available to the public subject-matter referred to in Article 3(2) should be understood as covering all acts of making available such subject-matter to members of the public not present at the place where the act of making available originates, and as not covering any other acts.
- (25) The legal uncertainty regarding the nature and the level of protection of acts of on-demand transmission of copyright works and subject-matter protected by related rights over networks should be overcome by providing for harmonised protection at Community level. It should be made clear that all rightholders recognised by this Directive should have an exclusive right to make

available to the public copyright works or any other subject-matter by way of interactive on-demand transmissions. Such interactive on-demand transmissions are characterised by the fact that members of the public may access them from a place and at a time individually chosen by them.

- (26) With regard to the making available in on-demand services by broadcasters of their radio or television productions incorporating music from commercial phonograms as an integral part thereof, collective licensing arrangements are to be encouraged in order to facilitate the clearance of the rights concerned.
- (27) The mere provision of physical facilities for enabling or making a communication does not in itself amount to communication within the meaning of this Directive.
- (28) Copyright protection under this Directive includes the exclusive right to control distribution of the work incorporated in a tangible article. The first sale in the Community of the original of a work or copies thereof by the rightholder or with his consent exhausts the right to control resale of that object in the Community. This right should not be exhausted in respect of the original or of copies thereof sold by the rightholder or with his consent outside the Community. Rental and lending rights for authors have been established in Directive 92/100/EEC. The distribution right provided for in this Directive is without prejudice to the provisions relating to the rental and lending rights contained in Chapter I of that Directive.
- (29) The question of exhaustion does not arise in the case of services and on-line services in particular. This also applies with regard to a material copy of a work or other subject-matter made by a user of such a service with the consent of the rightholder. Therefore, the same applies to rental and lending of the original and copies of works or other subject-matter which are services by nature. Unlike CD-ROM or CD-I, where the intellectual property is incorporated in a material medium, namely an item of goods, every on-line service is in fact an act which should be subject to authorisation where the copyright or related right so provides.
- (30) The rights referred to in this Directive may be transferred, assigned or subject to the granting of contractual licences, without prejudice to the relevant national legislation on copyright and related rights.
- (31) A fair balance of rights and interests between the different categories of rightholders, as well as between the different categories of rightholders and users of protected subject-matter must be safeguarded. The existing exceptions and limitations to the rights as set out by the Member States have to be reassessed in the light of the new electronic environment. Existing differences in the exceptions and limitations to certain restricted acts have direct negative effects on the functioning of the internal market of copyright and related rights. Such differences could well become more pronounced in view of the further development of transborder exploitation of works and cross-border activities. In order to ensure the proper functioning of the internal market, such exceptions and limitations should be defined more harmoniously. The degree of their harmonisation should be based on their impact on the smooth functioning of the internal market.
- (32) This Directive provides for an exhaustive enumeration of exceptions and limitations to the reproduction right and the right of communication to the public. Some exceptions or limitations only apply to the reproduction right, where appropriate. This list takes due account of the different legal traditions in Member States, while, at the same time, aiming to ensure a functioning internal market. Member States should arrive at a coherent application of these exceptions and limitations, which will be assessed when reviewing implementing legislation in the future.
- (33) The exclusive right of reproduction should be subject to an exception to allow certain acts of temporary reproduction, which are transient or incidental reproductions, forming an integral and essential part of a technological process and carried out for the sole purpose of enabling

either efficient transmission in a network between third parties by an intermediary, or a lawful use of a work or other subject-matter to be made. The acts of reproduction concerned should have no separate economic value on their own. To the extent that they meet these conditions, this exception should include acts which enable browsing as well as acts of caching to take place, including those which enable transmission systems to function efficiently, provided that the intermediary does not modify the information and does not interfere with the lawful use of technology, widely recognised and used by industry, to obtain data on the use of the information. A use should be considered lawful where it is authorised by the rightholder or not restricted by law.

- (34) Member States should be given the option of providing for certain exceptions or limitations for cases such as educational and scientific purposes, for the benefit of public institutions such as libraries and archives, for purposes of news reporting, for quotations, for use by people with disabilities, for public security uses and for uses in administrative and judicial proceedings.
- (35) In certain cases of exceptions or limitations, rightholders should receive fair compensation to compensate them adequately for the use made of their protected works or other subject-matter. When determining the form, detailed arrangements and possible level of such fair compensation, account should be taken of the particular circumstances of each case. When evaluating these circumstances, a valuable criterion would be the possible harm to the rightholders resulting from the act in question. In cases where rightholders have already received payment in some other form, for instance as part of a licence fee, no specific or separate payment may be due. The level of fair compensation should take full account of the degree of use of technological protection measures referred to in this Directive. In certain situations where the prejudice to the rightholder would be minimal, no obligation for payment may arise.
- (36) The Member States may provide for fair compensation for rightholders also when applying the optional provisions on exceptions or limitations which do not require such compensation.
- (37) Existing national schemes on reprography, where they exist, do not create major barriers to the internal market. Member States should be allowed to provide for an exception or limitation in respect of reprography.
- (38) Member States should be allowed to provide for an exception or limitation to the reproduction right for certain types of reproduction of audio, visual and audio-visual material for private use, accompanied by fair compensation. This may include the introduction or continuation of remuneration schemes to compensate for the prejudice to rightholders. Although differences between those remuneration schemes affect the functioning of the internal market, those differences, with respect to analogue private reproduction, should not have a significant impact on the development of the information society. Digital private copying is likely to be more widespread and have a greater economic impact. Due account should therefore be taken of the differences between digital and analogue private copying and a distinction should be made in certain respects between them.
- (39) When applying the exception or limitation on private copying, Member States should take due account of technological and economic developments, in particular with respect to digital private copying and remuneration schemes, when effective technological protection measures are available. Such exceptions or limitations should not inhibit the use of technological measures or their enforcement against circumvention.
- (40) Member States may provide for an exception or limitation for the benefit of certain non-profit making establishments, such as publicly accessible libraries and equivalent institutions, as well as archives. However, this should be limited to certain special cases covered by the reproduction right. Such an exception or limitation should not cover uses made in the context of on-line delivery of protected works or other subject-matter. This Directive should be without prejudice to the

Member States' option to derogate from the exclusive public lending right in accordance with Article 5 of Directive 92/100/EEC. Therefore, specific contracts or licences should be promoted which, without creating imbalances, favour such establishments and the disseminative purposes they serve.

- (41) When applying the exception or limitation in respect of ephemeral recordings made by broadcasting organisations it is understood that a broadcaster's own facilities include those of a person acting on behalf of and under the responsibility of the broadcasting organisation.
- (42) When applying the exception or limitation for non-commercial educational and scientific research purposes, including distance learning, the non-commercial nature of the activity in question should be determined by that activity as such. The organisational structure and the means of funding of the establishment concerned are not the decisive factors in this respect.
- (43) It is in any case important for the Member States to adopt all necessary measures to facilitate access to works by persons suffering from a disability which constitutes an obstacle to the use of the works themselves, and to pay particular attention to accessible formats.
- (44) When applying the exceptions and limitations provided for in this Directive, they should be exercised in accordance with international obligations. Such exceptions and limitations may not be applied in a way which prejudices the legitimate interests of the rightholder or which conflicts with the normal exploitation of his work or other subject-matter. The provision of such exceptions or limitations by Member States should, in particular, duly reflect the increased economic impact that such exceptions or limitations may have in the context of the new electronic environment. Therefore, the scope of certain exceptions or limitations may have to be even more limited when it comes to certain new uses of copyright works and other subject-matter.
- (45) The exceptions and limitations referred to in Article 5(2), (3) and (4) should not, however, prevent the definition of contractual relations designed to ensure fair compensation for the rightholders insofar as permitted by national law.
- (46) Recourse to mediation could help users and rightholders to settle disputes. The Commission, in cooperation with the Member States within the Contact Committee, should undertake a study to consider new legal ways of settling disputes concerning copyright and related rights.
- (47) Technological development will allow rightholders to make use of technological measures designed to prevent or restrict acts not authorised by the rightholders of any copyright, rights related to copyright or the sui generis right in databases. The danger, however, exists that illegal activities might be carried out in order to enable or facilitate the circumvention of the technical protection provided by these measures. In order to avoid fragmented legal approaches that could potentially hinder the functioning of the internal market, there is a need to provide for harmonised legal protection against circumvention of effective technological measures and against provision of devices and products or services to this effect.
- (48) Such legal protection should be provided in respect of technological measures that effectively restrict acts not authorised by the rightholders of any copyright, rights related to copyright or the sui generis right in databases without, however, preventing the normal operation of electronic equipment and its technological development. Such legal protection implies no obligation to design devices, products, components or services to correspond to technological measures, so long as such device, product, component or service does not otherwise fall under the prohibition of Article 6. Such legal protection should respect proportionality and should not prohibit those devices or activities which have a commercially significant purpose or use other than to circumvent the technical protection. In particular, this protection should not hinder research into cryptography.
- (49) The legal protection of technological measures is without prejudice to the application of

any national provisions which may prohibit the private possession of devices, products or components for the circumvention of technological measures.

- (50) Such a harmonised legal protection does not affect the specific provisions on protection provided for by Directive 91/250/EEC. In particular, it should not apply to the protection of technological measures used in connection with computer programs, which is exclusively addressed in that Directive. It should neither inhibit nor prevent the development or use of any means of circumventing a technological measure that is necessary to enable acts to be undertaken in accordance with the terms of Article 5(3) or Article 6 of Directive 91/250/EEC. Articles 5 and 6 of that Directive exclusively determine exceptions to the exclusive rights applicable to computer programs.
- (51) The legal protection of technological measures applies without prejudice to public policy, as reflected in Article 5, or public security. Member States should promote voluntary measures taken by rightholders, including the conclusion and implementation of agreements between rightholders and other parties concerned, to accommodate achieving the objectives of certain exceptions or limitations provided for in national law in accordance with this Directive. In the absence of such voluntary measures or agreements within a reasonable period of time, Member States should take appropriate measures to ensure that rightholders provide beneficiaries of such exceptions or limitations with appropriate means of benefiting from them, by modifying an implemented technological measure or by other means. However, in order to prevent abuse of such measures taken by rightholders, including within the framework of agreements, or taken by a Member State, any technological measures applied in implementation of such measures should enjoy legal protection.
- (52) When implementing an exception or limitation for private copying in accordance with Article 5(2)(b), Member States should likewise promote the use of voluntary measures to accommodate achieving the objectives of such exception or limitation. If, within a reasonable period of time, no such voluntary measures to make reproduction for private use possible have been taken, Member States may take measures to enable beneficiaries of the exception or limitation concerned to benefit from it. Voluntary measures taken by rightholders, including agreements between rightholders and other parties concerned, as well as measures taken by Member States, do not prevent rightholders from using technological measures which are consistent with the exceptions or limitations on private copying in national law in accordance with Article 5(2)(b), taking account of the condition of fair compensation under that provision and the possible differentiation between various conditions of use in accordance with Article 5(5), such as controlling the number of reproductions. In order to prevent abuse of such measures, any technological measures applied in their implementation should enjoy legal protection.
- (53) The protection of technological measures should ensure a secure environment for the provision of interactive on-demand services, in such a way that members of the public may access works or other subject-matter from a place and at a time individually chosen by them. Where such services are governed by contractual arrangements, the first and second subparagraphs of Article 6(4) should not apply. Non-interactive forms of online use should remain subject to those provisions.
- (54) Important progress has been made in the international standardisation of technical systems of identification of works and protected subject-matter in digital format. In an increasingly networked environment, differences between technological measures could lead to an incompatibility of systems within the Community. Compatibility and interoperability of the different systems should be encouraged. It would be highly desirable to encourage the development of global systems.
- (55) Technological development will facilitate the distribution of works, notably on networks, and this will entail the need for rightholders to identify better the work or other subject-matter, the author or any other rightholder, and to provide information about the terms and conditions of use of the work or other subject-matter in order to render easier the management of rights

attached to them. Rightholders should be encouraged to use markings indicating, in addition to the information referred to above, inter alia their authorisation when putting works or other subject-matter on networks.

- (56) There is, however, the danger that illegal activities might be carried out in order to remove or alter the electronic copyright-management information attached to it, or otherwise to distribute, import for distribution, broadcast, communicate to the public or make available to the public works or other protected subject-matter from which such information has been removed without authority. In order to avoid fragmented legal approaches that could potentially hinder the functioning of the internal market, there is a need to provide for harmonised legal protection against any of these activities.
- (57) Any such rights-management information systems referred to above may, depending on their design, at the same time process personal data about the consumption patterns of protected subject-matter by individuals and allow for tracing of on-line behaviour. These technical means, in their technical functions, should incorporate privacy safeguards in accordance with Directive 95/46/EC of the European Parliament and of the Council of 24 October 1995 on the protection of individuals with regard to the processing of personal data and the free movement of such data(10).
- (58) Member States should provide for effective sanctions and remedies for infringements of rights and obligations as set out in this Directive. They should take all the measures necessary to ensure that those sanctions and remedies are applied. The sanctions thus provided for should be effective, proportionate and dissuasive and should include the possibility of seeking damages and/or injunctive relief and, where appropriate, of applying for seizure of infringing material.
- (59) In the digital environment, in particular, the services of intermediaries may increasingly be used by third parties for infringing activities. In many cases such intermediaries are best placed to bring such infringing activities to an end. Therefore, without prejudice to any other sanctions and remedies available, rightholders should have the possibility of applying for an injunction against an intermediary who carries a third party's infringement of a protected work or other subject-matter in a network. This possibility should be available even where the acts carried out by the intermediary are exempted under Article 5. The conditions and modalities relating to such injunctions should be left to the national law of the Member States.
- (60) The protection provided under this Directive should be without prejudice to national or Community legal provisions in other areas, such as industrial property, data protection, conditional access, access to public documents, and the rule of media exploitation chronology, which may affect the protection of copyright or related rights.
- (61) In order to comply with the WIPO Performances and Phonograms Treaty, Directives 92/100/EEC and 93/98/EEC should be amended,

HAVE ADOPTED THIS DIRECTIVE:

CHAPTER I

OBJECTIVE AND SCOPE

Article 1

Scope

1. This Directive concerns the legal protection of copyright and related rights in the framework

of the internal market, with particular emphasis on the information society.

2. Except in the cases referred to in Article 11, this Directive shall leave intact and shall in no way affect existing Community provisions relating to:

- (a) the legal protection of computer programs;
- (b) rental right, lending right and certain rights related to copyright in the field of intellectual property;
- (c) copyright and related rights applicable to broadcasting of programmes by satellite and cable retransmission;
- (d) the term of protection of copyright and certain related rights;
- (e) the legal protection of databases.

CHAPTER II

RIGHTS AND EXCEPTIONS

Article 2

Reproduction right

Member States shall provide for the exclusive right to authorise or prohibit direct or indirect, temporary or permanent reproduction by any means and in any form, in whole or in part:

- (a) for authors, of their works;
- (b) for performers, of fixations of their performances;
- (c) for phonogram producers, of their phonograms;
- (d) for the producers of the first fixations of films, in respect of the original and copies of their films;
- (e) for broadcasting organisations, of fixations of their broadcasts, whether those broadcasts are transmitted by wire or over the air, including by cable or satellite.

Article 3

Right of communication to the public of works and right of making available to the public other subject-matter

1. Member States shall provide authors with the exclusive right to authorise or prohibit any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access them from a place and at a time individually chosen by them.

2. Member States shall provide for the exclusive right to authorise or prohibit the making available to the public, by wire or wireless means, in such a way that members of the public may access them from a place and at a time individually chosen by them:

- (a) for performers, of fixations of their performances;

- (b) for phonogram producers, of their phonograms;
 - (c) for the producers of the first fixations of films, of the original and copies of their films;
 - (d) for broadcasting organisations, of fixations of their broadcasts, whether these broadcasts are transmitted by wire or over the air, including by cable or satellite.
3. The rights referred to in paragraphs 1 and 2 shall not be exhausted by any act of communication to the public or making available to the public as set out in this Article.

Article 4

Distribution right

1. Member States shall provide for authors, in respect of the original of their works or of copies thereof, the exclusive right to authorise or prohibit any form of distribution to the public by sale or otherwise.
2. The distribution right shall not be exhausted within the Community in respect of the original or copies of the work, except where the first sale or other transfer of ownership in the Community of that object is made by the rightholder or with his consent.

Article 5

Exceptions and limitations

1. Temporary acts of reproduction referred to in Article 2, which are transient or incidental [and] an integral and essential part of a technological process and whose sole purpose is to enable:
 - (a) a transmission in a network between third parties by an intermediary, or
 - (b) a lawful useof a work or other subject-matter to be made, and which have no independent economic significance, shall be exempted from the reproduction right provided for in Article 2.
2. Member States may provide for exceptions or limitations to the reproduction right provided for in Article 2 in the following cases:
 - (a) in respect of reproductions on paper or any similar medium, effected by the use of any kind of photographic technique or by some other process having similar effects, with the exception of sheet music, provided that the rightholders receive fair compensation;
 - (b) in respect of reproductions on any medium made by a natural person for private use and for ends that are neither directly nor indirectly commercial, on condition that the rightholders receive fair compensation which takes account of the application or non-application of technological measures referred to in Article 6 to the work or subject-matter concerned;
 - (c) in respect of specific acts of reproduction made by publicly accessible libraries, educational establishments or museums, or by archives, which are not for direct or indirect economic or commercial advantage;
 - (d) in respect of ephemeral recordings of works made by broadcasting organisations by means of their own facilities and for their own broadcasts; the preservation of these recordings in official

archives may, on the grounds of their exceptional documentary character, be permitted;

(e) in respect of reproductions of broadcasts made by social institutions pursuing non-commercial purposes, such as hospitals or prisons, on condition that the rightholders receive fair compensation.

3. Member States may provide for exceptions or limitations to the rights provided for in Articles 2 and 3 in the following cases:

(a) use for the sole purpose of illustration for teaching or scientific research, as long as the source, including the author's name, is indicated, unless this turns out to be impossible and to the extent justified by the non-commercial purpose to be achieved;

(b) uses, for the benefit of people with a disability, which are directly related to the disability and of a non-commercial nature, to the extent required by the specific disability;

(c) reproduction by the press, communication to the public or making available of published articles on current economic, political or religious topics or of broadcast works or other subject-matter of the same character, in cases where such use is not expressly reserved, and as long as the source, including the author's name, is indicated, or use of works or other subject-matter in connection with the reporting of current events, to the extent justified by the informatory purpose and as long as the source, including the author's name, is indicated, unless this turns out to be impossible;

(d) quotations for purposes such as criticism or review, provided that they relate to a work or other subject-matter which has already been lawfully made available to the public, that, unless this turns out to be impossible, the source, including the author's name, is indicated, and that their use is in accordance with fair practice, and to the extent required by the specific purpose;

(e) use for the purposes of public security or to ensure the proper performance or reporting of administrative, parliamentary or judicial proceedings;

(f) use of political speeches as well as extracts of public lectures or similar works or subject-matter to the extent justified by the informatory purpose and provided that the source, including the author's name, is indicated, except where this turns out to be impossible;

(g) use during religious celebrations or official celebrations organised by a public authority;

(h) use of works, such as works of architecture or sculpture, made to be located permanently in public places;

(i) incidental inclusion of a work or other subject-matter in other material;

(j) use for the purpose of advertising the public exhibition or sale of artistic works, to the extent necessary to promote the event, excluding any other commercial use;

(k) use for the purpose of caricature, parody or pastiche;

(l) use in connection with the demonstration or repair of equipment;

(m) use of an artistic work in the form of a building or a drawing or plan of a building for the purposes of reconstructing the building;

(n) use by communication or making available, for the purpose of research or private study, to individual members of the public by dedicated terminals on the premises of establishments referred to in paragraph 2(c) of works and other subject-matter not subject to purchase or licensing terms which are contained in their collections;

(o) use in certain other cases of minor importance where exceptions or limitations already exist under national law, provided that they only concern analogue uses and do not affect the free

circulation of goods and services within the Community, without prejudice to the other exceptions and limitations contained in this Article.

4. Where the Member States may provide for an exception or limitation to the right of reproduction pursuant to paragraphs 2 and 3, they may provide similarly for an exception or limitation to the right of distribution as referred to in Article 4 to the extent justified by the purpose of the authorised act of reproduction.

5. The exceptions and limitations provided for in paragraphs 1, 2, 3 and 4 shall only be applied in certain special cases which do not conflict with a normal exploitation of the work or other subject-matter and do not unreasonably prejudice the legitimate interests of the rightholder.

CHAPTER III

PROTECTION OF TECHNOLOGICAL MEASURES AND RIGHTS-MANAGEMENT INFORMATION

Article 6

Obligations as to technological measures

1. Member States shall provide adequate legal protection against the circumvention of any effective technological measures, which the person concerned carries out in the knowledge, or with reasonable grounds to know, that he or she is pursuing that objective.

2. Member States shall provide adequate legal protection against the manufacture, import, distribution, sale, rental, advertisement for sale or rental, or possession for commercial purposes of devices, products or components or the provision of services which:

- (a) are promoted, advertised or marketed for the purpose of circumvention of, or
- (b) have only a limited commercially significant purpose or use other than to circumvent, or
- (c) are primarily designed, produced, adapted or performed for the purpose of enabling or facilitating the circumvention of,

any effective technological measures.

3. For the purposes of this Directive, the expression "technological measures" means any technology, device or component that, in the normal course of its operation, is designed to prevent or restrict acts, in respect of works or other subject-matter, which are not authorised by the rightholder of any copyright or any right related to copyright as provided for by law or the sui generis right provided for in Chapter III of Directive 96/9/EC. Technological measures shall be deemed "effective" where the use of a protected work or other subject-matter is controlled by the rightholders through application of an access control or protection process, such as encryption, scrambling or other transformation of the work or other subject-matter or a copy control mechanism, which achieves the protection objective.

4. Notwithstanding the legal protection provided for in paragraph 1, in the absence of voluntary measures taken by rightholders, including agreements between rightholders and other parties concerned, Member States shall take appropriate measures to ensure that rightholders make available to the beneficiary of an exception or limitation provided for in national law in accordance with Article 5(2)(a), (2)(c), (2)(d), (2)(e), (3)(a), (3)(b) or (3)(e) the means of benefiting from that exception or limitation, to the extent necessary to benefit from that exception or limitation and where that beneficiary has legal access to the protected work or subject-matter concerned.

A Member State may also take such measures in respect of a beneficiary of an exception or limitation provided for in accordance with Article 5(2)(b), unless reproduction for private use has already been made possible by rightholders to the extent necessary to benefit from the exception or limitation concerned and in accordance with the provisions of Article 5(2)(b) and (5), without preventing rightholders from adopting adequate measures regarding the number of reproductions in accordance with these provisions.

The technological measures applied voluntarily by rightholders, including those applied in implementation of voluntary agreements, and technological measures applied in implementation of the measures taken by Member States, shall enjoy the legal protection provided for in paragraph 1.

The provisions of the first and second subparagraphs shall not apply to works or other subject-matter made available to the public on agreed contractual terms in such a way that members of the public may access them from a place and at a time individually chosen by them.

When this Article is applied in the context of Directives 92/100/EEC and 96/9/EC, this paragraph shall apply *mutatis mutandis*.

Article 7

Obligations concerning rights-management information

1. Member States shall provide for adequate legal protection against any person knowingly performing without authority any of the following acts:

- (a) the removal or alteration of any electronic rights-management information;
- (b) the distribution, importation for distribution, broadcasting, communication or making available to the public of works or other subject-matter protected under this Directive or under Chapter III of Directive 96/9/EC from which electronic rights-management information has been removed or altered without authority,

if such person knows, or has reasonable grounds to know, that by so doing he is inducing, enabling, facilitating or concealing an infringement of any copyright or any rights related to copyright as provided by law, or of the *sui generis* right provided for in Chapter III of Directive 96/9/EC.

2. For the purposes of this Directive, the expression "rights-management information" means any information provided by rightholders which identifies the work or other subject-matter referred to in this Directive or covered by the *sui generis* right provided for in Chapter III of Directive 96/9/EC, the author or any other rightholder, or information about the terms and conditions of use of the work or other subject-matter, and any numbers or codes that represent such information.

The first subparagraph shall apply when any of these items of information is associated with a copy of, or appears in connection with the communication to the public of, a work or other subject-matter referred to in this Directive or covered by the *sui generis* right provided for in Chapter III of Directive 96/9/EC.

CHAPTER IV

COMMON PROVISIONS

Article 8

Sanctions and remedies

1. Member States shall provide appropriate sanctions and remedies in respect of infringements of the rights and obligations set out in this Directive and shall take all the measures necessary to ensure that those sanctions and remedies are applied. The sanctions thus provided for shall be effective, proportionate and dissuasive.
2. Each Member State shall take the measures necessary to ensure that rightholders whose interests are affected by an infringing activity carried out on its territory can bring an action for damages and/or apply for an injunction and, where appropriate, for the seizure of infringing material as well as of devices, products or components referred to in Article 6(2).
3. Member States shall ensure that rightholders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe a copyright or related right.

Article 9

Continued application of other legal provisions

This Directive shall be without prejudice to provisions concerning in particular patent rights, trade marks, design rights, utility models, topographies of semi-conductor products, type faces, conditional access, access to cable of broadcasting services, protection of national treasures, legal deposit requirements, laws on restrictive practices and unfair competition, trade secrets, security, confidentiality, data protection and privacy, access to public documents, the law of contract.

Article 10

Application over time

1. The provisions of this Directive shall apply in respect of all works and other subject-matter referred to in this Directive which are, on 22 December 2002, protected by the Member States' legislation in the field of copyright and related rights, or which meet the criteria for protection under the provisions of this Directive or the provisions referred to in Article 1(2).
2. This Directive shall apply without prejudice to any acts concluded and rights acquired before 22 December 2002.

Article 11

Technical adaptations

1. Directive 92/100/EEC is hereby amended as follows:
 - (a) Article 7 shall be deleted;
 - (b) Article 10(3) shall be replaced by the following: "3. The limitations shall only be applied in certain special cases which do not conflict with a normal exploitation of the subject-matter and do not unreasonably prejudice the legitimate interests of the rightholder."
2. Article 3(2) of Directive 93/98/EEC shall be replaced by the following: "2. The rights of

producers of phonograms shall expire 50 years after the fixation is made. However, if the phonogram has been lawfully published within this period, the said rights shall expire 50 years from the date of the first lawful publication. If no lawful publication has taken place within the period mentioned in the first sentence, and if the phonogram has been lawfully communicated to the public within this period, the said rights shall expire 50 years from the date of the first lawful communication to the public.

However, where through the expiry of the term of protection granted pursuant to this paragraph in its version before amendment by Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society(11) the rights of producers of phonograms are no longer protected on 22 December 2002, this paragraph shall not have the effect of protecting those rights anew."

Article 12

Final provisions

1. Not later than 22 December 2004 and every three years thereafter, the Commission shall submit to the European Parliament, the Council and the Economic and Social Committee a report on the application of this Directive, in which, inter alia, on the basis of specific information supplied by the Member States, it shall examine in particular the application of Articles 5, 6 and 8 in the light of the development of the digital market. In the case of Article 6, it shall examine in particular whether that Article confers a sufficient level of protection and whether acts which are permitted by law are being adversely affected by the use of effective technological measures. Where necessary, in particular to ensure the functioning of the internal market pursuant to Article 14 of the Treaty, it shall submit proposals for amendments to this Directive.

2. Protection of rights related to copyright under this Directive shall leave intact and shall in no way affect the protection of copyright.

3. A contact committee is hereby established. It shall be composed of representatives of the competent authorities of the Member States. It shall be chaired by a representative of the Commission and shall meet either on the initiative of the chairman or at the request of the delegation of a Member State.

4. The tasks of the committee shall be as follows:

- (a) to examine the impact of this Directive on the functioning of the internal market, and to highlight any difficulties;
- (b) to organise consultations on all questions deriving from the application of this Directive;
- (c) to facilitate the exchange of information on relevant developments in legislation and case-law, as well as relevant economic, social, cultural and technological developments;
- (d) to act as a forum for the assessment of the digital market in works and other items, including private copying and the use of technological measures.

Article 13

Implementation

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive before 22 December 2002. They shall forthwith inform the Commission thereof.

When Member States adopt these measures, they shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such reference shall be laid down by Member States.

2. Member States shall communicate to the Commission the text of the provisions of domestic law which they adopt in the field governed by this Directive.

Article 14

Entry into force

This Directive shall enter into force on the day of its publication in the Official Journal of the European Communities.

Article 15

Addressees

This Directive is addressed to the Member States.

Done at Brussels, 22 May 2001.

For the European Parliament

The President

N. Fontaine

For the Council

The President

M. Winberg

(1) OJ C 108, 7.4.1998, p. 6 and

OJ C 180, 25.6.1999, p. 6.

(2) OJ C 407, 28.12.1998, p. 30.

(3) Opinion of the European Parliament of 10 February 1999 (OJ C 150, 28.5.1999, p. 171), Council Common Position of 28 September 2000 (OJ C 344, 1.12.2000, p. 1) and Decision of the European Parliament of 14 February 2001 (not yet published in the Official Journal). Council Decision of 9 April 2001.

(4) OJ L 178, 17.7.2000, p. 1.

(5) Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs (OJ L 122, 17.5.1991, p. 42). Directive as amended by Directive 93/98/EEC.

(6) Council Directive 92/100/EEC of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of intellectual property (OJ L 346, 27.11.1992,

p. 61). Directive as amended by Directive 93/98/EEC.

- (7) Council Directive 93/83/EEC of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission (OJ L 248, 6.10.1993, p. 15).
- (8) Council Directive 93/98/EEC of 29 October 1993 harmonising the term of protection of copyright and certain related rights (OJ L 290, 24.11.1993, p. 9).
- (9) Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases (OJ L 77, 27.3.1996, p. 20).
- (10) OJ L 281, 23.11.1995, p. 31.
- (11) OJ L 167, 22.6.2001, p. 10.

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BELPROV	1. - Loi du 22 mai 2005 transposant en droit belge la Directive 2001/29/CE du 22 mai 2001 sur l'harmonisation de certains aspects du droit d'auteur et des droits voisins dans la société de l'information
DEUPROV	1. - Gesetz zur Regelung des Urheberrechts in der Informationsgesellschaft vom 10/09/2003 BGBl. Teil I n° 46 vom 12/09/2003 p. 1774
DNKPROV	1. - Lov om ændring af ophavsretsloven ref: Lov n° 1051 du 17/12/2002 p. 7881
ESPPROV	NO REFERENCE AVAILABLE
FRAPROV	NO REFERENCE AVAILABLE
GRCPROV	1. - Acte législatif n° 3057/2002 FEK A n° 239 du 10/10/2002 p. 4535
IRLPROV	

NO REFERENCE AVAILABLE

ITAPROV

1. - Decreto legislativo 09/04/2003 n. 68 - Attuazione delle direttiva 2001/29/CE sull'armonizzazione di taluni aspetti del diritto d'autore e dei diritti connessi nella società dell'informazione GURI Serie generale n° 87 du 14/04/2003

LUXPROV

NO REFERENCE AVAILABLE

NLDPROV

1. - Wet van 6 juli 2004 tot aanpassing van de Auteurswet 1912, de Wet op de naburige rechten en de Databankenwet ter uitvoering van richtlijn nr. 2001/29/EG van het Europees Parlement en de Raad van de Europese Unie van 22 mei 2001 betreffende de harmonisatie van bepaalde aspecten van het auteursrecht en de naburige rechten in de informatiemaatschappij (PbEG L 167) (Uitvoering richtlijn auteursrecht en naburige rechten in de informatiemaatschappij)

2. - Besluit van 9 augustus 2004 tot het vaststellen van het tijdstip van inwerkingtreding van de Wet houdende aanpassing van de Auteurswet 1912, de Wet op de naburige rechten en de Databankenwet ter uitvoering van richtlijn nr. 2001/29/EG van het Europees Parlement en de Raad van de Europese Unie van 22 mei 2001 betreffende de harmonisatie van bepaalde aspecten van het auteursrecht en de naburige rechten in de informatiemaatschappij (PbEG L 167) (Uitvoering richtlijn auteursrecht en naburige rechten in de informatiemaatschappij)

3. - Beschikking van de Minister van Justitie van 18 augustus , houdende plaatsing in het Staatsblad van de tekst van de Auteurswet 1912, zoals deze luidt met ingang van 1 september 2004

PRTPROV

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COMMISSION OF THE EUROPEAN COMMUNITIES

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COMMISSION STAFF WORKING PAPER

Possible abuses of trade mark rights within the EU in the context of Community exhaustion

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POSSIBLE ABUSES OF TRADE MARK RIGHTS WITHIN THE EU IN THE CONTEXT OF COMMUNITY EXHAUSTION

This report examines the background behind the current discussion on exhaustion of trade marks before proceeding to a description of the Commission's investigation in response to the Parliament's question and the results of that investigation.

In addition to making a study of past and present competition cases involving alleged abuses of trade marks, the Commission also sent questionnaires to over sixty interested parties, chiefly organisations representing rightsholders, consumers and parallel traders asking for their experiences of such abuses.

The possible abuses identified in the course of the investigation can broadly be divided into three categories – problems that appear to relate to selective distribution systems, problems of abusive refusal to license trade marks, and problems of trade mark infringements themselves. For each of these different areas, an overview is made of the relevant case law (both settled and on-going) and it is concluded that the alleged abuses identified can, in general, be dealt with through existing legal provisions particular to that area.

Therefore, the report concludes that the Commission, as a result of the present investigation, has not found any deficiencies in current legal provision relating to possible abuses of trade marks within the EU.

1. INTRODUCTION

This report comes in response to the resolution adopted by the European Parliament on the 3rd October 2001 calling on the European Commission to examine various aspects relating to the exhaustion of trade marks within the EU. The Commission stated its willingness to look at the Parliament's request for it "*to present a report on any abuses of trade mark rights notified to the Commission, to explain how such cases of abuse have been addressed, including with regard to competition rules, and to identify possible deficiencies that may exist in current legal provision*"¹.

In addition to looking at possible abuses notified to the Commission (and interpreting the notion of 'abuse' in its widest sense i.e. beyond the definition used in Article 82 EC "*abuse by one or more undertakings of a dominant position*"), we have also taken the opportunity to consult with interested parties on a wider basis in order to look at the

¹ statement of Commissioner Bolkestein 3/10/01, this commitment was subsequently confirmed in response to a question submitted by MEPs Mayer and Lehne on 25/9/02.

question of possible abuses of trade marks occurring in the EU which have not been directly notified to the Commission.

2. BACKGROUND

The current régime inside the EU of Community exhaustion means that, in law, trade mark rights cannot be invoked to restrain the free movement of goods within the EU, but they can be used to restrain the entry of such goods into the EU. An alternative to this, international exhaustion (or, more correctly, global exhaustion) would mean that the flow of goods into the EU could not be restrained by such rights.

2.1. Current legal situation on exhaustion of trade marks

The current legal situation regarding the exhaustion of trade marks within the EU is rather clear. First of all, the principle of *Community* exhaustion has been well established as upheld by the European Court of Justice in cases such as Centrafarm/Winthrop² and Hoffman-La Roche/Centrafarm³.

It is also clearly established that there is no international, or global, exhaustion as a result, in particular, of the Silhouette⁴, Sebago⁵ and Zino Davidoff⁶ cases. In other words, trade mark holders *do* have the right to prevent the import into the EU of goods even if those goods were placed on the market *outside* the EU with the consent of the trade mark holder.

2.2. Commission study of exhaustion régime for trade marks

In February 1999, a study prepared by NERA⁷ at the request of the Commission, was published which examined the economic consequences of the different exhaustion régimes for trade marks. Furthermore, two meetings of Member States experts were organised on the issue on the basis of a Commission working document and a public hearing was held in 1999 with interested parties to allow an exchange of views.

3. METHODOLOGY

3.1. Working approach

In order to gather as much relevant information as possible, an extensive consultation was carried out both internally, within the different departments of the Commission, and externally with interested parties.

² Case 16/74 [1974] ECR p. 1183

³ Case 102/77 [1978] ECR p. 1139

⁴ Case C-355/96 [1998] ECR I p. 4799

⁵ Case C-173/98 [1999] ECR I-4103

⁶ Joined Cases C-414 to 416/99 [2001] ECR I p. 8691

⁷ National Economic Research Associates

In the course of July 2002, questionnaires (see annex) were sent out to over sixty organisations. Responses were requested by 30th September 2002. The organisations chosen fell into three broad categories: (i) rightsholders (ii) consumer groups and (iii) parallel traders. In some cases, the addressees were lawyers representing the respective organisations.

The term ‘parallel trader’ is here used to denote companies which are not rightsholders but which trade at a wholesale or retail level and exploit differences in price levels between different regions or countries. This applies to traders both within and outside the EU.

A decision was made, on grounds of efficiency, to target representative organisations at a European level. In general, there are many more European-level associations representing rightsholders than consumer groups or parallel traders. A special effort was therefore made to identify organisations representing the latter in order to ensure that a full range of interests and opinions was covered.

3.2. Results of questionnaires

Replies were eventually received from some two dozen organisations. Of these, two were from consumer groups and six from ‘parallel traders’ within the definition above. Although the consumer groups and parallel traders provided a minority of the respondents, they provided probably three quarters of the responses in terms of volume of text received (some 300-400 pages). They therefore made a very important contribution to the survey that was undertaken.

The following represents a summary of the responses received. It should be noted that several respondents only agreed to contribute to the study on the understanding that their responses would not be published. To respect their wish, the Commission has not therefore annexed the responses to the present report.

3.2.1. Rightsholders

Perhaps not surprisingly, none of the rightsholders who responded to the questionnaire reported being aware of any cases of abuse of trade mark rights.

A number of respondents addressed the issue of the disadvantages associated with international, rather than Community, exhaustion of trade marks. They mentioned the difficulties this would cause rightsholders in tailoring their products to different local market conditions and the effect this would have on consumer confidence, and even safety.

One respondent also noted that international exhaustion would impede the ability of rightsholders to prevent counterfeit goods coming onto the market. Although they did not explicitly explain why, the implication seems to be that certain countries (outside the EU) are the origin of a disproportionate number of counterfeit goods. It follows that, the ability of rightsholders to prevent imports of both legitimate *and* illegitimate goods from these countries may be a useful tool to combat counterfeiting.

A number of respondents noted that many of the possible ‘abuses’ of trade mark rights would be covered by the relevant provisions of European competition law, both Articles 81 and 82 EC, and notably Block Exemption Regulation 2790/99 (see section 4.2).

In particular, one respondent raised the question of how the Commission is supposed to assess whether ‘pricesetting’ by trade mark holders is abusive. Price differences between different countries would not be evidence of abusive pricing (see also discussion in section 5.2). Such differences could result from differences in tax levels, exchange rates, subsidies, market scale, consumer preferences, sales promotion strategies, retail market characteristics and production, distribution and/or marketing costs.

The same respondent made the point that, for non-dominant companies, abusive conduct such as supercompetitive pricing would be punished by market forces since buyers would switch to other suppliers. It is furthermore not demonstrated that the markets in which branded goods are claimed to be overpriced are characterised by market dominance of a single company.

3.2.2. *Consumer groups*

The response from consumer groups was rather sparse. Neither of the two responses provided any evidence of cases of abuse of trade marks, and one of the responses suggested that the Commission was, in any case, not seriously interested in finding any such cases.

3.2.3. *Parallel traders*

The respondents noted a number of problems deriving from the lack of international exhaustion. These problems related particularly to the cosmetics, and also the alcoholic spirits, sectors, but it was claimed (although not substantiated) that similar problems also arise in textiles, films and photos and other types of branded goods.

One respondent gave a detailed analysis of the difference in price levels of cosmetics between the EU and the USA, claiming that prices in the EU were typically 20%-40% higher, a difference that could not be attributed to transport costs for the goods in question.

The complaints centred on a number of interrelated issues. Firstly, that, following the Zino Davidoff ruling, the burden of proof is placed on parallel traders to demonstrate the origin of the goods which they are trading. This means that a rightsholder has the ability, by alleging trade mark infringement, to force the parallel trader to reveal the origin of branded goods even if this origin is within the EU and the goods are authentic. Thus the allegation of infringement, even if completely unsubstantiated, can be used by rightsholders to identify the origin of branded goods.

A similar complaint is made in relation to number-based code systems. This is where the manufacturer places a code on the product which identifies the origin of the goods. These codes are typically encrypted such that they can be understood only by the manufacturer himself (rather than a parallel trader). A number of respondents complained that the removal of the number code from the product is considered illegal under either national fair trading regulations or trade mark law itself (this is claimed to be particularly the case in the Netherlands⁸, Belgium⁹, Germany¹⁰, the United Kingdom¹¹ and Italy), even where the companies in question were not trying to repackage the goods, or interfere with the trade mark in any way.

The respondents claim that, once rightsholders are able to identify the origin of branded goods (through the two methods noted above), they are then able to abuse this information at the expense of the parallel traders. Here the complaints centred almost entirely on selective distribution systems (in the economic sectors noted above). It was alleged that rightsholders use these systems, and the information on origin of goods, to restrict parallel trade *within* the EU and to put pressure on distributors and retailers to keep prices high.

In particular, one respondent complained that most contracts for selective distribution systems contain very vaguely worded requirements that the distributor or retailer must meet. Such clauses would discriminate among newcomers to the system and against those with novel forms of distribution. In some cases, it is alleged that there is a situation of a dominant oligopoly of producers which, in combination with selective distribution and the lack of international exhaustion, closes all alternative supply routes to retailers excluded from the distribution system. Finally, suppliers in selective distribution systems are alleged to exert a high degree of sales pressure by setting unachievable sales targets for distributors. If these targets are not met, distributors are threatened with termination of their distribution agreements.

The same respondent also noted that manufacturers may produce quantities of products in excess of the actual consumer demand. They may then offload the products on distributors within the EU and then prevent precisely those same distributors from selling within the EU (presumably the origin of the products in question is outside the EU).

⁸ see ruling of Het Gerechtshof's Gravenhage 15/2/00 Dior/Etos, injunction of the Arrondissementsrechtbank te Groningen 29/11/96 Davidoff et al

⁹ see ruling of Tribunal de Commerce de Liège 18/10/99 Parfums Nina Ricci/Best Sellers Belgium, Cour d'Appels de Bruxelles/Hof van Beroep te Brussel 23/11/95

¹⁰ see ruling of Oberlandesgericht Karlsruhe 27/9/95 Lancaster/Parfumland

¹¹ see ruling of English High Court of Justice 18/5/99 RPC

3.3. Interface with competition law

3.3.1. *On-going or informally resolved cases involving trade marks and Article 81 EC*

3.3.1.1. Use of trade marks to enforce restriction of sales to authorised distributors in selective distribution systems

A number of complaints have been received regarding control systems in selective distribution systems which allow manufacturers to track products through the distribution chain. So far, however, the Commission has considered the use of codes to detect whether products remain within the authorised network of distributors to be a reasonable means to monitor and implement compliance with agreements exempted (approved in principle, see section 4.2.1) by the Commission. Hence the Commission did not find any of the control systems complained of to infringe Article 81 EC.

3.3.1.2. Licensing of trade marks according to national territories

In the Duales System Deutschland case (DSD), the Commission assessed the set of agreements by which DSD granted the association Pro Europe the right to control the Green Dot trade mark outside Germany. Through the same set of agreements, Pro Europe licensed the right to use and sublicense the Green Dot trade mark to its members in their respective territories. Pro Europe submitted undertakings to the Commission stating that its licensing arrangements would not prevent the entry into the market of competitors.

In the Visa International case, the Commission examined the principle of territorial licensing, including of trade marks, in the agreements between Visa International and its member financial institutions which operated the Visa card system network. The Commission, in its decision¹², noted that each Visa member was able to obtain an amendment to the original trade mark licence or an ‘additional licence’, depending on local trade mark law, for any other territory where it was authorised to carry out banking activities. Hence, the principle of territorial licensing *as such* was not found to be an appreciable restriction of competition under Article 81(1) EC¹³.

3.3.1.3. Clause for termination of trade mark licences on the acquisition of the licensee by a resident of another Member State

In Vickers/Rolls Royce, the Commission did not find any restriction of competition in the clause granting the trade mark

¹² of 9/8/01

¹³ Commission Decision of 9/8/01, OJ 2001 L-293/24

holder (Rolls Royce) the power to terminate the trade mark licence in the event of a licensee (Rolls Royce Motors Group) coming under the control of a non-UK resident. The Commission rejected the request of Vickers (a parent company of the licensee) for interim measures after having found no *prima facie* infringement of competition rules. For the Commission, it was not clear that the ‘resident clause’ had a significant impact on the conditions of competition as Vickers failed to show that the purchase of a company currently active in the relevant market(s) was the only way for a new company to enter the market for luxury cars. Moreover, the ‘resident clause’ did not seem to have the significance claimed by Vickers as the licensor actually supported the sale of the licensee to a non-UK resident¹⁴.

3.3.1.4. Delimitation agreements

Delimitation agreements may infringe Article 81 EC if they aim at dividing up the market or restricting competition in other ways. However, such agreements are lawful and useful if they serve to delimit, in the mutual interest of the parties concerned, the spheres within which their respective trade marks may be used and are intended to avoid confusion or conflict between them¹⁵. On the same basis, the Commission cleared a notified agreement in which the use of similar trade marks was delimited on a non-geographical basis¹⁶.

3.3.2. *On-going or informally resolved cases involving trade marks and Article 82 EC*

In the Duales System Deutschland (DSD) case¹⁷, the Commission ruled on a system under which DSD, the owner of the Green Dot trade mark, organised a waste recovery system on behalf of manufacturers and distributors in Germany. The Commission found that there had been an abuse of dominant position with respect to DSD’s practice of linking the licence fees solely to the amount of packaging using the Green Dot trade mark and not to the amount of packaging for which DSD was actually providing its waste recovery service. This obliged customers to pay for services not actually provided by DSD and hence prevented market entry by competitors.

The Commission and DSD disagreed over the function of the Green Dot trade mark, as to whether it implied that the packaging in question would be recovered by DSD itself or whether it merely implied to the consumer

¹⁴ 28th Report on Competition Policy – 1998 p. 168-169

¹⁵ ECJ Case 35/83 BAT vs. Commission [1985] ECR p. 363 §33

¹⁶ Case 37365 Sears Clothing and Selfridges Retail (negative clearance comfort letter 9/6/99)

¹⁷ Commission Decision of 20/4/01 OJ 2001 L-166/1

that (s)he has the option of having the packaging collected by DSD¹⁸. The parties are currently awaiting a judgement of the Court of First Instance on the substance of the case.

4. SELECTIVE DISTRIBUTION SYSTEMS

4.1. Economic role of selective distribution systems

Some of the products commonly protected by trade marks are also marketed through selective distribution systems, in particular cosmetics. Selective distribution systems are used by suppliers who generally do not distribute the products themselves and who require that the products in question should be sold in a certain way, in particular that specified *pre-sales services* should be provided to the customer.

For cosmetics, this may be to ensure that the sales service provided is consistent with the image of the brand concerned, that the customer should be fully informed and advised about the product they are purchasing. Another example might be consumer electronic goods where the customer requires technical advice before purchasing the product in question.

In the absence of a selective distribution system, there may be a problem of *free riding*. A customer may find it suits them best to go to a *bona fide* distributor where they will be informed about the product in question but then buy the products themselves from a free riding distributor who is able to sell more cheaply because he does not provide the pre-sales services in question.

In order to circumvent this problem, suppliers may decide to set up a selective distribution system. In the system, the supplier supplies the product only to *authorised* distributors. These distributors are constrained, in return, to provide certain pre-sales services to customers. They are also constrained only to resell to end customers or to other authorised distributors. In this way, the system is said to be impermeable because, in theory, none of the products will 'leak' into the hands of unauthorised distributors.

In some cases, notably cosmetics, selective distribution systems are *complementary* to the use of trade marks, but they are not the same. Selective distribution systems ensure the provision of pre-sales services whereas trade marks are designed to protect the presentation of the products themselves. Many trade marked goods are not distributed selectively, and some non-trade marked goods may be subject to selective distribution (e.g. certain electronic components).

4.2. Legal framework

Agreements between different companies ('undertakings') are governed by Article 81 EC. This includes also the agreements at issue here, namely trade mark licensing and selective distribution agreements.

¹⁸ see §143-146 of the Decision

The latter are also covered by more specific rules applying to so-called ‘vertical agreements’ (i.e. between supplier, distributor and retailer rather than between competitors). These rules are laid out in the Block Exemption Regulation 2790/99 on ‘the application of Article 81(3) of the Treaty to categories of vertical agreements and concerted practices’, in particular Articles 4 and 5 which prescribe the types of provisions in vertical agreements which are not acceptable.

It should also be noted that special rules apply in the case of motor vehicles¹⁹.

4.2.1. Article 81 EC

Article 81(1) EC prohibits as "*incompatible with the common market: all agreements between undertakings, decisions by associations of undertakings and concerted practices which may affect trade between Member States and which have as their object or effect the prevention, restriction or distortion of competition within the common market*".

Any such agreements or decisions are automatically void (Article 81(2) EC). However, certain types of agreements can be exempted from this prohibition on the grounds that they contribute “*to improving the production or distribution of goods or to promoting technical or economic progress, while allowing consumers a fair share of the resulting benefit*”. An agreement, notified to the Commission, which is found to fall within the scope of Articles 81(1) and 81(3) may then receive a so-called ‘exemption’.

4.2.2. Regulation 2790/99

Distribution agreements, such as those complained about above by parallel traders, are generally covered by Block Exemption Regulation 2790/99. This Regulation in particular covers selective distribution agreements and provides a general exemption from the competition rules for agreements which cover 30% or less of a given relevant market.

However, certain types of provision are considered to render either part or all of a given agreement non-exemptable²⁰. Examples of such restrictive provisions in selective distribution agreements are:

- retail price maintenance
- restriction on sales between authorised wholesalers (‘cross-supply’ restrictions)
- customer allocation to a given distributor, including customer allocation by territory

¹⁹ Regulation 1400/2002

²⁰ Article 4 Regulation 2790/99, note that agreements falling outside the exemption provided for in Regulation 2790/99 may still be granted an individual exemption under Article 81 EC

It should also be noted what is *not* considered objectionable *per se*. For example in Ford vs. Commission²¹, the Court ruled that, in the context of a distribution system, only the agreement embodied in the distribution contract is capable of constituting an infringement of Article 81(1) of the Treaty. From this it follows that the refusal by a rightsholder to supply a particular parallel trader, or sign a distribution agreement with that company, cannot be considered *in itself* to fall within the scope of Article 81(1).

4.3. Relevant settled case law

Since many (or even most) selective distribution systems apply to trade marked goods, there are a number of examples of relevant case law.

For example, in Yves Saint Laurent²², the Commission exempted a selective distribution system for cosmetics. Of particular interest is the fact that the Commission, as a condition for exemption, required the distribution agreements to be changed whereby distributors had been previously required to provide Yves Saint Laurent with details of who they had sold goods to. This was changed to provide that distributors had to keep the relevant information, but were only required to release it to Yves Saint Laurent where there was *prima facie* suspicion of sales to unauthorised distributors.

In this case, the Commission considered that, within a system of selective distribution, the tracing of the origin of branded goods cannot be considered to infringe Article 81 EC in so far as it serves the lawful purpose of preventing sales to unauthorised distributors. However, such practices *would* constitute an infringement of the competition rules where it is clear that such information is being used to limit cross-supplies between *authorised* distributors within the selective distribution system.

The facts of this case, relating to the provision by distributors of information about the origin of goods to their supplier, are thus rather similar to the complaints from parallel traders about being forced to reveal the origin of the branded goods they sell to the trade mark holder. This is all the more so given that, where branded goods are being sold through a selective distribution system, the (ultimate) supplier and trade mark holder are likely to be the same company.

4.4. Conclusion

Selective distribution systems are not *per se* illegal, indeed the Commission has recognised the economic benefits to consumers which may derive from them. Restrictions of the sort enumerated in section 4.2.2 in the context of a selective distribution system *are* illegal and Article 81 EC, in the context of Regulation 2790/99, provides an effective means to combat them.

²¹ Joined Cases 228 and 229/82, [1984] ECR p. 1129 §21

²² Decision 92/33/EEC, particularly §7

5. ABUSE OF DOMINANT POSITION INVOLVING TRADE MARKS

5.1. Possible types of abuse involving trade marks

There has historically been a certain level of tension between the granting of intellectual property rights, such as trade marks, which generally entail a right to exclude others from using that property, and the obligation under competition law for a dominant company to provide a license to others where a failure to do so would damage competition in the market in question. Such a failure by a dominant company could conceivably be regarded as an abusive refusal to license and fall within the scope of Article 82 EC.

Other types of behaviour involving trade mark licensing could also fall within the scope of Article 82 EC. It is not possible to exhaustively list such behaviour but one example is excessive pricing of trade mark licence fees.

5.2. Legal framework

Unilateral anti-competitive conduct by companies is covered by Article 82 EC, so-called ‘abuse of dominant position’.

5.2.1. Article 82 EC

Article 82 EC states that “*any abuse by one or more undertakings of a dominant position within the common market [...] shall be prohibited [...] in so far as it may affect trade between Member States*”. Such abuse includes “*directly or indirectly imposing unfair purchase or selling prices*”.

Refusal by a rightsholder to license its trade mark to another company could conceivably fall under the scope of this article. However, the European Court of Justice (ECJ) has ruled that²³ “*the very subject matter of*” an intellectual property right is the power to exclude others and that there is no general obligation to grant licences, even in return for a royalty. It follows that, in the case of a dominant company refusing to license a trade mark, an extra element is required, in addition to the refusal to license, to demonstrate an infringement of Article 82 EC.

5.2.2. Article 10 EC in conjunction with Article 82 EC

According to Article 10 EC, “*Member States shall take all appropriate measures, whether general or particular, to ensure fulfilment of the obligations arising out of this Treaty or resulting from action taken by the institutions of the Community. They shall facilitate the achievement of the Community's tasks.*

They shall abstain from any measure which could jeopardise the attainment of the objectives of this Treaty”.

²³ Volvo vs. Veng decision 238/87/EEC [1988] ECR p. 6211

The case law of the Court of Justice²⁴ shows that a Member State may be in breach of its obligations under Article 10 if it induces a company to infringe Article 81 e.g. by imposing or encouraging the fixing of prices. At least in theory, the same would be true if a Member State was to induce an undertaking to abuse its dominant position in a particular relevant market.

It might be argued that, since the rule of Community exhaustion (or, rather, the absence of international exhaustion) allows certain undertakings within the EEA to charge higher prices than would otherwise be the case, this means that, in the case of a dominant undertaking, one can say that state-imposed rule enables it to abuse its dominant position by overcharging.

There are however considerable difficulties with this approach. First of all, it could only apply in the case of dominant companies. Secondly, if they were really in a dominant position in the first place, it would very likely be this dominant position, and not the rule of Community exhaustion, which would enable them to charge high prices, or at least, the cause of high prices would be very difficult to determine. Thirdly, and unanswerably, a Member State could never be in breach of its Community law obligations by virtue of upholding the rule of Community exhaustion, since this is a rule laid down by the Community legislator in Article 7 of the Trade Mark Directive, as interpreted by the Court of Justice in Silhouette, Sebago and Zino Davidoff."

5.3. Relevant settled case law

There is no settled case law in this area. As noted above, there is a relevant ongoing case, namely DSD. However, it should be noted that the main market of concern, in which DSD was found by the Commission to be dominant, is for recycling *services*. It is therefore difficult to see much relevance in the case given that the question of Community/international exhaustion applies only to goods²⁵.

5.4. Conclusion

For cases where a dominant company might seek to abuse its trade mark rights, for example by charging excessively high prices for its branded goods, legal provisions exist under Article 82 to combat such abusive conduct. Furthermore, the situation where such an abuse is found to consist of a refusal to license the trade mark rights in question is likely to be very rare, and there is no relevant settled case law in this area.

²⁴ e.g. Case 209/84 Asjes [1986] ECR-1425

²⁵ there is no exhaustion for services within the EU, see Directive 92/100/EEC, also Metronome Musik Case C-200/96 [1998] ECR I p. 1953 and Coditel I Case 62/79

6. TRADE MARK INFRINGEMENTS

6.1. Economic role of trade marks

As was noted in the NERA report, the economic role of trade marks is twofold: “to assist and protect the consumer in identifying the source of products and hence improving their ability to judge quality” and to allow “trade mark holders to be rewarded for their investment in product development and quality and [...] in creating brand image or ‘branding’ of a product” through the use of their exclusive rights.

6.2. Legal framework

Within the EU, both national and Community trade marks co-exist. Both are regulated at Community level through, respectively, Directive 89/104/EEC and Regulation 40/94. Also of relevance in cases of (alleged) trade mark infringements and exhaustion of trade marks are Articles 28 and 30 EC relating to the free movement of goods within the EU.

6.2.1. Directive 89/104/EEC

Directive 89/104/EEC harmonises national trade mark law throughout the EU. Of particular relevance to the question of exhaustion are Articles 7(1), which states that “*The trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Community under that trade mark by the proprietor or with his consent*”, and 7(2) which states that, “[*the previous paragraph*] shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market”.

6.2.2. Regulation 40/94

Regulation 40/94 creates a unitary Community trade mark throughout the EU. Articles 13(1) and (2) correspond almost exactly to Articles 7(1) and (2) of the trade mark directive, hence establishing an identical exhaustion régime for both national and Community trade marks.

6.2.3. Articles 28 and 30 EC

Article 28 EC, which enshrines the key principle of free movement of goods within the EU, prohibits “*quantitative restrictions on imports and all measures having equivalent effect*” between Member States.

Article 30 EC allows an exception to Article 28 EC in various cases, including “*the protection of industrial and commercial property*” i.e. trade marks. However, “*such prohibitions or restrictions shall not [...] constitute [...] a disguised restriction on trade between Member States*”.

6.3. Relevant settled case law

Trade mark law has also been invoked to settle the question of under what conditions a rightsholder can prevent the advertising of branded goods by a

retailer. In Dior/Evora²⁶, where Dior had objected to advertising by Evora of goods incorporating its trade marks, the ECJ ruled that “a balance must be struck between the legitimate interest of the trade mark holder [to prevent advertising] which could damage the reputation of the trade mark and the reseller’s legitimate interest [to] resell the goods [...] using advertising methods [...] customary in his sector of trade”. The two principles at stake were thus the protection of trade mark rights and the free movement of goods within the EU.

In Loendersloot²⁷, the Court assessed the compatibility of a prohibition on the removal of identification numbers placed on products to trace their origin with the rules on the free movement of goods. Parallel traders argued that the removal of such identification numbers was necessary to prevent the artificial partitioning of markets by the suppliers of the goods. However, the Court ruled that the use of identification numbers for legitimate objectives, including the prevention of counterfeiting, itself did not lead to artificial partitioning of markets and hence was not an infringement of Community rules on free movement of goods.

6.4. Conclusion

Where it is trade marks, rather than contractual provisions or the market power of a dominant company, which are being invoked to restrict the free movement of goods within the EU, Community law provides an effective means to prevent such a restriction while protecting the legitimate rights of the trade mark holder.

7. OVERALL CONCLUSIONS

This report has presented a summary of cases involving alleged abuses of trade mark rights notified to the Commission, particularly regarding competition law aspects, and has shown how these cases were dealt with under existing legal provisions.

In addition, the report has presented the results of the survey carried out by the Commission of trade mark holders, consumer groups and parallel traders. Most of the complaints made by the latter relate to the means by which rightsholders can identify the origin of branded goods. Inasmuch as this allows rightsholders to interdict the import of such goods from outside the EU, this can hardly be seen as an abuse since it is an inevitable consequence of the Silhouette ruling.

Inasmuch as this allows rightsholders to restrict parallel trade *within* the EU, such restrictions might well be unlawful, but this is a question which can be judged on the basis of existing provisions in European competition law (Articles 81 and 82 EC), European trade mark law (trade mark directive and regulation) and provisions on free movement of goods (Articles 28 and 30 EC).

It may be true that some branded goods are more expensive than they would be if a system of international exhaustion prevailed within the EU, although the NERA study suggests that such an effect is in general rather minor. However, such a pricing situation

²⁶ Case C-337/95 [1997] ECR I p. 6013, particularly §44

²⁷ Case C-349/95, Loendersloot vs. Ballantine et al [1997] ECR I-6227

cannot be considered to constitute an abuse of dominant position in the sense of Article 82 EC, whether considered in conjunction with Article 86(1) or not.

It follows that the Commission, as a result of the investigations carried out in the preparation of this report, has not found any deficiencies in current legal provision relating to possible abuses of trade marks within the EU.

ANNEX

Letter sent on 24.07.2002 by Erik Nooteboom, Head of Unit Industrial property - Services, Electronic Commerce, Intellectual and Industrial Property And The Media - Internal Market DG - EUROPEAN COMMISSION (references : 4468 - MARKT/E/2/DE D(2002) / 398)

Contact: David Ellard, Telephone:(32-2) 296.31.81, Fax:(32-2) 299.31.04, David.Ellard@cec.eu.int

Subject: International exhaustion of trade marks

Sir/Madam,

I am writing to you regarding the question of the so-called international exhaustion of trade marks within the European Union. By this, I mean whether a trade mark holder in the EU should have the right, under trade mark law, to prevent the import into the EU of goods which were originally placed on the market outside the EU either by the trade mark holder himself or with his consent.

As you may well be aware, this issue formed the basis of a recent resolution of the European Parliament on the 3rd October 2001 calling on the European Commission to investigate, *inter alia*, “any cases of abuse of trade marks notified to the Commission”.

I am therefore writing to you to ask for your assistance in letting us know about any recent instances of abuse of trade marks in terms of pricesetting which you are aware of, and whether or not you have already notified the European Commission of this.

I should stress that, by ‘abuse of trade marks’, I do not intend to cover instances where counterfeit or pirated goods were put on the market.

To clarify, such instances might well include cases where a trade mark holder (or companies acting in his interest):

- places restrictions in agreements with distributors (e.g. selective distribution arrangements)
- restrictive provisions in supply contracts (e.g. prohibitions or coercive measures to prevent further export of the supplied goods to certain geographic areas)
- introduces guarantee terms which effectively inhibit supply into certain geographical areas

or, where the supplier is dominant in a particular relevant market:

- withdraws from that market and/or refuses to supply resellers in the market
- prices goods at excessive levels
- applies sanctions on distributors not adhering to the same kinds of practice

Of course, the above list is intended to be illustrative rather than exhaustive and we would welcome information on any other possible instances of abuse of trade mark

rights. It would help us greatly if you could send us your contributions by **30th September 2002**. I look forward to hearing from you on this matter.

Yours sincerely,

EXHAUSTION OF TRADE MARK RIGHTS

WORKING DOCUMENT FROM THE COMMISSION SERVICES

INTRODUCTION

This document constitutes the Commission services' working document on exhaustion of trade mark rights that the Commission undertook to prepare at the Internal Market Council of 21 June 1999.

The working document should serve as a basis for a further and detailed discussion in a Council expert group in order to prepare the EC position on a possible change to the current trade mark exhaustion regime in the EC. The discussion should focus in particular on four key issues which were raised at the Internal market Council in June. These are: a) Possible consequences of different regimes for national trade marks compared to Community trade marks, b) Differentiation of exhaustion regimes between different intellectual property rights, c) Differentiation of exhaustion regimes for different sectors of industry and d) International exhaustion through international agreements.

The working document explores different options available if it is decided that a change of exhaustion is necessary. Each option has its own advantages and disadvantages and will require careful examination before any conclusions can be drawn. The document does not elaborate on other issues which are also relevant in the larger context of parallel trade, like competition issues and questions on vertical restraints. It such in this context be noticed that from the judgement of the Court of Justice in the Javico case, it is clear that an export prohibition from a third country may, under certain circumstances, be acceptable under EU competition rules.¹

The four key issues outlined above are - as stated - of relevance when considering possible merits and problems related to a change from the existing Community exhaustion regime to that of international exhaustion. The discussion on the legal and practical consequences of these options must not necessarily be limited to that based on this document. It appears useful to address further questions, which are linked to the implication of the Community exhaustion regime for the function of a trade mark. In fact it appears that, in the light of recent case law on exhaustion, the purpose of a trade mark is no longer to function as an indicator of source but also of good will ("brand") calling for specific distribution systems.

¹ Javico v. Yves Saint Laurent, case C-306/96 (1998) ECR I-1983.

Developments in the information society including e-commerce are also of relevance when discussing the merits and problems of the Community exhaustion regime, in so far as they open up new possibilities for consumers to obtain branded goods which have initially been marketed on foreign markets.

The discussion on exhaustion regimes is not a purely academic one, but has important economic implications. The following information illustrates the scale and economic background of the industries that may be affected by the choice of exhaustion regime: The world market for musical recordings amounts to nearly 30 billion EURO, of which the EU accounts for about 30 per cent. The number of people employed in that sector is about 600.000. European companies are the world's leading producers of pharmaceuticals with a turnover of about 93,500 million EURO. The number of people directly employed in the pharmaceutical industry is about 520,000. The EU is the largest producer of cosmetics and perfumes in the world. This is also the case for confectionery where EU citizens are also the largest consumers in the world. EU companies producing footwear, leather goods and alcoholic drinks are also among the world leaders. The EU motor vehicle industry is a net exporter². The number of people employed in the vehicle sector alone is about 1,000,000 (0,7 % of EU total employment).

² National Economic Research Associates "The Economic consequences of the choice of regime of exhaustion in the area of trademarks" (available on the DG Internal Market web site), Executive Summary of the NERA study, page20-23 NERA study pages 31,

I. THE FOUR KEY ISSUES

- a. CHANGE OF THE EXHAUSTION REGIMES FOR COMMUNITY TRADE MARKS AND NATIONAL TRADE MARKS. SHOULD THE REGIMES BE THE SAME ?

*In theory, there are three options available; (1) to change the exhaustion regime for **both national trade marks and Community trade marks**, (2) to change the exhaustion regime for **national trade marks only**, or (3)) to change the exhaustion regime for **Community trade marks only** .*

The introduction of a full international exhaustion scheme for all types of trade marks in the Union would require a change to both Directive 89/104 on national trade marks and Regulation 40/94 on the Community trade mark³.

A change to the Directive would require a qualified majority decision from the Council and approval through co-decision with the Parliament pursuant to Article 95 of the Treaty. A change to the Regulation on the Community trade mark would however require an unanimous Council decision, after having consulted the European Parliament under Article 308 of the Treaty.

If, within the Council, a qualified majority, but not a consensus, could be obtained for the introduction of international exhaustion then the EC could be confronted with the possibility of having two different exhaustion regimes, i.e. (1) an international exhaustion regime for national trade marks, and (2) a Community exhaustion regime for Community trade marks.

The co-existence of two different schemes within the EC might create confusion within the market place as well as in the minds of consumers, in particular in relation to the question of whether a given trade marked product had been lawfully put on the market or not.

Furthermore, this situation might weaken the position of holders of national trade marks in the Union vis-à-vis the holders of Community trade marks. This is because that holders of national trade marks would be exposed to competition through parallel trade and increased inter-brand competition whereas the holders of Community trade marks would still be able to prevent parallel imports on the basis of their Community trade mark rights. An important element which should be taken into account when assessing the possible consequences of such differentiation is the question of whether such a policy would put SMEs in a weaker position than larger

³ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, OJ N° L 40 of 11 February 1989 and Council Regulation (EC) N° 40/94 of 20 December 1993 on the Community trade mark, OJ N° L 11 OF 14 January 1994.

companies. In this respect, the extent to which products with national trade marks are, or would become, the subject of parallel imports should be further studied.

A Community trade mark (CTM) is generally used by companies seeking protection in at least 4 or 5 Member States. Most Community trade mark holders are therefore the larger European and non-European (e.g. American) companies. SMEs, whilst also to some extent using the CTM system, rely much more on national trade mark systems. This is because they often only supply their local markets.

Any weakening of the position of national trade mark holders in relation to the exhaustion issue might increase the attractiveness of the CTM system for those companies, including SMEs, that are confronted with parallel imports and who wish to maintain the possibility of opposing such imports. However, this would impose a heavy burden on SMEs in terms of costs and procedures. Larger companies who rely on the CTM system would however not face any additional burdens.

Clearly, the cost of a CTM is higher than the price of a limited number of national trade marks and the procedures relating to the registration of a CTM may be more complex to handle than those necessary to obtain a very limited number of national trade mark registrations. Trade mark holders for whom the exhaustion regime is of less importance could continue to rely on national trade marks. It should also be recalled that in the debate on exhaustion, trade mark holders strongly advocated the present Community wide exhaustion regime for both types of trade marks.

b. DIFFERENTIATION OF EXHAUSTION REGIMES BETWEEN DIFFERENT INTELLECTUAL PROPERTY RIGHTS

*Two options are available: either to change the exhaustion regime for **trade marks only** or to change the exhaustion regime for **trade marks and some or all of the other categories of intellectual property**.*

In practice, a great variety of products are covered by multitude of IP rights at the same time.

In respect of a music CD for example, the music as such may be protected by copyright and neighbouring rights, the CD technology by patents, and the label by trade mark rights. Computers for example, may be protected by a trade mark right, a design right, and patents. The NERA study indicated the relevance of the various IP rights for a wide range of products.

These examples show that the possible introduction of international exhaustion for trade marks only would still allow the producer of products which are protected by a bundle of IP rights, to rely on the other IP rights to oppose the importation of a given product into the EU.

There are relatively few type of products which are the subject of only trade mark protection. The NERA study identified in this respect in particular the clothing industry, soft drinks, confectionery and alcoholic drinks.

Certain fundamental questions need to be answered before deciding whether the possible introduction of international exhaustion for trade mark rights should be extended to other IP rights.

It should be recalled that IP rights, by their very nature, have traditionally always been granted on a State-by-State basis and with legal effects only in the territory of the State concerned. This allowed States to define their own policy on the creation, grant and scope of protection of IP rights as market instruments within their territories, subject to their obligations under international agreements and for EU countries their obligations under Community law.

The establishment of the EC as an economic region, has had significant consequences on the traditional principle of territoriality of IP rights. The creation of a common market between States providing for, in principle, uniform (economic) market conditions and based, inter alia, on the principle of free movement of goods led the EC Court of Justice to introduce the concept of “international exhaustion” between the EC Member Sates. This has become known as “Community exhaustion”. It should be stressed that the existence of common market conditions and the principle of free movement of goods within the EC constituted the main argument for the Court to considerably restrict the possibilities for holders of IP rights within the EC to rely on these rights to oppose inter-(EC)state trade of their products.

When considering the possible extension of international exhaustion to other IP rights in addition to trade marks, one should also bear in mind that for each of these IP rights, the justification for their existence (their “raison d’être”) and enforcement are different. Consequently, it is important to examine the question of exhaustion regime for the IP rights on a case-by-case basis.

Trade marks serve in particular as an indicator of source and as an important bearer of “goodwill” for the producers of the products concerned. Trade marks can be maintained for an unlimited period of time unlike most other IP rights.

For **patents**, it should in particular be stressed that they serve as a major instrument to promote investment in research & development. The availability of patents serves to promote innovation and employment by ensuring a return on investment for inventors during a limited period of time (generally 20 years from the filing of the patent application).

For the pharmaceutical industry for example, it is known that a key characteristic of its research-based industry is its reliance on patents.

For **design rights**, it should be mentioned that they serve as an instrument to promote investment and innovation in industrial design. A design right is generally granted for a maximum period of 25 years after filing.

Finally, **copyright** serves to promote and stimulate human creativity. Copyright is generally granted for 70 years *post mortem auctoris*.

Industry has on several occasions stressed that it is vital for them to be able to protect various elements of their products using a multitude of IP rights. This allows them to focus on different issues such as confidence of the consumers in the quality of a given product (through trade marks) and obtaining a return on the investment made in the developing of the product (through design and patents).

For certain sectors (for example musical recordings) the enforcement of IP rights is a major problem. Most problems with piracy occur in countries with poor intellectual property protection. In the current regime of EC exhaustion it is not necessary to prove that imported goods are counterfeit, as imports of marked goods from third countries are not allowed without the consent of the right holders. With international exhaustion it would be necessary to prove that counterfeit goods were indeed counterfeit. Therefore the choice of trade mark exhaustion regime could have an effect on the right holder's ability to enforce his trade mark. This could undermine the fight against piracy and counterfeits.

Finally, it should be recalled that companies tend to be more willing to supply those markets where there is a high level of IP right protection than those providing a low level of protection for IP rights.

On the basis of the above, a preliminary conclusion would be that the introduction of international exhaustion for trade marks only would, from an IP right point of view, affect only a limited number of sectors in a limited way. The introduction of international exhaustion for all intellectual property rights would affect all industrial sectors.

c. DIFFERENTIATION OF EXHAUSTION REGIMES FOR DIFFERENT SECTORS OF INDUSTRY

A differentiation of exhaustion regimes between different sectors could be obtained through two different alternatives.

*It could be decided to introduce **international exhaustion only in relation to specific products, included in an exhaustive list**. The other approach would be to*

introduce international exhaustion as a matter of principle, but to exclude international exhaustion for specific products, included in an exhaustive list.

The role of trade marks may be of particular importance for certain sectors. International exhaustion may also be considered essential for specific sectors. Some sectors would be directly effected by a change in exhaustion regime, while other sectors would remain more or less untouched by such a change. This may depend on the role of other IP rights, transaction costs, technical barriers, vertical constraints and price differences.

The pharmaceutical industry has often been referred to as a sector where trade mark rights and patents play a vital role and where a change in the exhaustion regime(s) would be extremely delicate. The audio visual industries also continuously stress the vital importance of copyright and trade marks for the continuation of their business. These particular industries are however often identified as examples where prices for the same products may significantly differ between different states and different regions.

Generally speaking, the narrower the area of exhaustion, the greater the value the IP right has as a marketing instrument. Against this, enforcing wider areas of exhaustion creates pressure to reduce prices in some countries.

Also the role of governments in the pricing and purchasing of medicines has to be fully considered while analysing the specific situation for the pharmaceutical industry.

With regard to the possibility of introducing international exhaustion on a sector-by-sector basis, it should be noted that the main difficulty which will probably arise will be identifying those sectors to be covered by international exhaustion. In this respect, a further complication might be that certain products might be classified under different sectors. In any case, both options, referred to above, would require careful examination of all the elements which are crucial for the sectors concerned.

d. INTERNATIONAL EXHAUSTION THROUGH INTERNATIONAL AGREEMENTS

From a macro-economic point of view, three different options or “models” are available to introduce international exhaustion in the Union.

- i) On a **unilateral** basis, through a change to the relevant Community legal instruments*
- ii) on the basis of **bilateral agreements** with third countries, and*
- iii) on the basis of a **multilateral agreement**.*

i. Unilateral introduction of international exhaustion.

It has been argued that a unilateral change to the EC legislation would create the most immediate and foreseeable effect on trade but it would also put the EU at a disadvantage vis-à-vis trading partners if they did not follow.

Under the unilateral scenario, trade mark holders within the EU could not prevent parallel imports from products which they have put on the markets in any third countries. Such a system might increase parallel imports to Europe from third countries, but it would not compensate Europe through increased “parallel” exports from Europe to those third countries.

For some sectors the loss of profits if there were a unilateral change could be twice that if there were a bilateral (or multilateral) change⁴.

ii. International exhaustion with specific EU trade partners on the basis of bilateral agreements.

A second option to provide for international exhaustion would be through the conclusion of bilateral agreements with certain trading partners.

This approach might provide an opportunity to carefully select the countries with which the EC would be ready to open the markets for parallel imports to a certain extent, to ensure that European industry would not be exposed to unbalanced competition.

Clearly the EU would have to decide on what criteria it would be ready to enter into bilateral agreements. Such criteria should probably include the level of IP protection available, the market conditions, the level of pricing and possibly the country's' GNP.

However, it should be carefully considered whether bilateral agreements on this issue could come under the scope of the WTO Agreements and in particular the TRIPs Agreement. The "Most Favoured Nation Treatment" clause in Article 4 of TRIPs for example, provides that “with regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members”.

iii. International exhaustion on the basis of a multilateral agreement.

⁴ NERA study pages 80, 88, 90, 97 and 99.

A third option would be to establish the principle of international exhaustion of trade marks at the global level through the conclusion of a multilateral agreement, for example in the context of WTO.

This approach would in principle allow any State to become a party to the multilateral agreement on international exhaustion of trade marks, unless the idea would be to build in certain thresholds. In the latter case, important and delicate criteria as mentioned under (ii) would need to be examined in greater detail.

However, it should be noted that negotiations on a multilateral level may be quite time consuming. It should also be noted that to overcome possible problems with TRIPS compatibility, it might be necessary to involve all WTO Members in the multilateral approach.

III. MISCELLANEOUS

In addition to the elements mentioned above, other issues may also play an important role. The implications of the future enlargement of the European Union on this issue of exhaustion will also need consideration, given that enlargement will extend the free trade area within Europe. The development and the growth of electronic commerce/Internet should also be taken into account. Due regard has to be given to the creation of the Internal Market legal framework which will allow European companies to fully reap the benefit of electronic commerce and the Internal Market. The introduction and use of new technologies may give consumers access to a greater choice of products at lower prices.

III SUMMARY OF OPTIONS AVAILABLE

The following lists summarises the options available for changing the present situation.

The final option would comprise one option from each list ((I), (II) and (III)). For example, one could envisage to change the exhaustion regime for national trade marks only ((I)(2)), for all sectors ((II)(i)), on a unilateral basis ((III)(A)).

I. Possible changes to the exhaustion regime

1. Change the exhaustion regime for national trade marks and Community trade marks, e.g. amend the EC Directive on trade marks and the Community trade mark Regulation.
2. Change the exhaustion regime for national trade marks only, e.g. amend the EC Directive on trade marks.
3. Change the exhaustion regime for all IP rights, e.g. change each relevant Directive/Regulation or Convention.

II. Sectors affected

- (i) Introduce international exhaustion for all sectors.
- (ii) Introduce international exhaustion for certain sectors only (Opt in).
- (iii) Introduce the principle of international exhaustion, but exclude certain sectors (Opt out).

III. Methods of introducing any change

- A. On a Unilateral basis.
- B. On a Bilateral basis.
- C. On a Multilateral basis.

ANNEX I

DEFINITIONS

a. Trade marks

Trade marks fulfil two mutually dependent economic functions.

First of all they assist and protect the consumer in identifying the source of products and hence improving their ability to judge quality.

Secondly, they provide a property right to the trade mark holders, by limiting the rights of other parties to copy their products, specifically by prohibiting the unauthorised use of their trade mark; this allows trade mark holders to be rewarded for their investment in product development and product quality, and for their expenditure in creating brand image or "branding" of a product.

b. Exhaustion of trade mark rights within the Union

“Exhaustion” of trade mark rights implies that once a branded product has been “put” (commercialised) on the market by the trade mark holder or with his consent, he cannot prohibit the further commercialisation (such as subsequent re-sale) of that product. His rights in respect of a specific individual item or consignment are "exhausted" by the act of selling it.

There are two different exhaustion regimes – national (or Community/EEA-wide) exhaustion and international exhaustion.

The current EU exhaustion regime is related to the territory of the Member States (and the EEA) only; a trade mark holder cannot legally prevent the further commercialisation of a given product within the EU (and the EEA), once the product has been put on the EU/EEA market by him or with his consent.

c. Parallel trade

From an EU perspective, parallel trade (sometimes referred to as the "grey market") consists of trade in genuine trade mark protected products, which have been firstly commercialised (by the trade mark holder) outside the EU/EEA, and which are subsequently imported into the EU/EEA area.

For the purpose of the discussion on exhaustion of trade mark rights, it is also assumed that parallel trade takes place without the consent of the trade mark owner. Under this assumption, the “authorised” goods reach the final consumer through the intermediaries and distribution networks that are designated by trade mark owner.

Parallel traders acquire goods, typically without the consent of the trade mark owner, from some layer of the authorised channel. This can either be directly from the manufacturer, from an intermediary (wholesaler or middleman) or from authorised retailers.

Occasionally a trade mark owner may give tacit consent to the disposal of some part of production through parallel traders. It is a characteristic of the phenomena of parallel trade, that it could take many different forms and use many different channels.

ANNEX II

LEGAL FRAMEWORK

a. Acquis communautaire

The exhaustion regime for national trade marks is defined by Article 7 of Directive No 89/104/EEC of 21 December 1988⁵, the exhaustion regime for Community trade marks is defined by Article 13 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark⁶.

According to both instruments, Community exhaustion is the current regime for both types of trade marks.

In its basic proposal both for a trade mark Directive and the Community trade mark Regulation in 1980, the Commission originally proposed international exhaustion. After discussions in the Council and at the explicit request of the European Parliament it was finally decided to adopt the Community exhaustion regime for both instruments.

In addition to both trade mark instruments, there are five other Community instruments in the field of intellectual property, which establish Community exhaustion⁷.

The Silhouette case - During the summer 1998 the Court of Justice delivered a judgement in the *Silhouette case*⁸. In its decision, the Court confirmed that Article 7 of Directive 40/89 establishes the absolute principle of Community exhaustion, i.e. that the wording of the said provision does not allow Member States to extend the principle of Community exhaustion to international exhaustion.

⁵ OJ No L 40 of 11 February 1989.

⁶ OJ No L 11 of 14 January 1994.

⁷ Council Directive 87/54/EEC of 16 December 1986 on the legal protection of topographies of semiconductor products (OJ No L 24 of 27 January 1987), Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs (OJ No L 122 of 17 May 1991), Council Directive 92/100/EEC of 19 November 1992 on rental and lending right and on certain rights related to copyright in the field of intellectual property (OJ No L 346 of 27 November 1992), Council Regulation 2100/94/EG of 27 July 1994 on Community plant variety rights (OJ No L 45 of 15 February 1994) and Directive 96/9/EC of the European Parliament and the Council of 11 March 1996 on legal protection of databases (OJ No 77 of 27 March 1996).

⁸ Case C-355/96, [1998] ECR 676

Thus, trade mark holders within the Community may rely on their national trade mark rights to prevent parallel imports of their products when these imports originate in non-EEA countries.

After the Silhouette decision the question of exhaustion has become an important issue. Following the Silhouette decision, some Member States have voiced concerns about the economic consequences of the situation currently applied in the Community, especially as regards the difficulties for consumers to obtain cheaper branded products through parallel imports from third countries.

b. Other International instruments

The question of exhaustion of intellectual property rights was discussed in the Uruguay Round in the framework of the Agreement on Trade Related aspects of Intellectual Property ("TRIPs"). However, the exhaustion issue was too delicate and was therefore not included in the Agreement on TRIPs⁹.

According to the Europe Agreement, the candidate countries are obliged to provide for the same level of protection of IPR as the EU including enforcement of such rights. There is no specific agreement on exhaustion regimes¹⁰.

c. Legal situation within important trading partners US and Japan

US applies *a priori* a national exhaustion regime for trade mark rights in cases where products are not from the same corporate entity or where parallel imports may cause "consumer confusion". The national exhaustion scheme applies also in principle in the field of patents and designs.

Further to a recent Court decision in Japan¹¹, it is considered that international exhaustion applies in the field of patents and trade marks, unless, through licences, it is otherwise agreed.

⁹ Article 6 of TRIPS: "nothing in this Agreement shall be used to address the exhaustion of intellectual property rights".

¹⁰ Bulgaria OJ L 323/93, Estonia OJ L 68/98, Cyprus OJ L 133/73, Czech Republic OJ L 115/92 , Hungary L 347/93, Latvia OJ L 26/98, Lithuania OJ L 51/98, Malta OJ L 61/71, Poland OJ L 114/92, Romania OJ L 81/93, Slovakia OJ L 115/92 , Slovenia OJ L 344/96, Turkey OJ L217/64 and OJ L 35/96

¹¹ BBS Kraftverzeug Technik AG - v - Racimax Japan KK& Jap Auto Products KK (Heisei (1995) (o) N°.1998 (July 1, 1997).

ANNEX III

BACKGROUND

I. INTRODUCTION

Identification of the problem

The question of exhaustion of trade mark rights has become an important issue. Discussions within the Council and discussions in hearings and meetings, organised by the Commission services have shown that the views between Member States as well as between the various interested circles are divided.

It is sometimes claimed that the actual Community exhaustion regime on trade marks within the Union constitutes an important barrier for (parallel) trade and creates artificially high prices for consumer goods within the Union.

Those advocating the Community exhaustion regime claim that this system is necessary for the promotion of investment in innovation and in high-quality goods.

II. THE NERA STUDY

With a view to obtaining a clearer picture of its economic effects, the Commission launched a study on the possible economic consequences of a possible change of the current Community exhaustion regime. The study has been carried out by the NERA institute in London and was presented to the Commission in February 1999.

According to the study the issue of exhaustion is very complex and may have an impact not only on prices, but also on product quality, product availability, after-sales services (guarantees), employment, distribution agreements, market segmentation, etc. The study also shows that the impact of a change in the existing Community exhaustion regime would be minimal in certain sectors like alcoholic drinks and confectionery, whereas it may have more significant consequences in others such as consumer electronics, domestic appliances and footwear. The study calculates that the lowering effect on prices would range from "negligible" (soft drinks) to "small" (around 1% for footwear, musical recordings, motorcars) or "moderate" (around 2% for consumer electronics).

a. Arguments for the present exhaustion regime

The study lists a number of arguments in favour of retaining the present arrangements, i.e. Community exhaustion.

The main argument for maintaining the current exhaustion regime is that it is essential to protect EC competitiveness and innovation, in that it guarantees a return on investment in new products.

Further it was held that the present exhaustion regime provides a higher economic reward to firms that invest in the quality or style of their products, and that this incentive is necessary in order to maintain the range of products and the quality of goods and associated service that EU consumers expect. A change to international exhaustion would reduce the value of intellectual property and put European companies at a disadvantage against countries not applying the same regime.

The study also indicates that a change in the exhaustion regime for trade marks would not necessarily lead to a tangible change on the market. Right holders have also other means to control the distribution of their products, such as setting up selective distribution networks prohibiting sales to unauthorised dealers. The study also suggests that parallel imports may confuse the consumer as a result of problems such as instructions in foreign language, lack of after-sales service, quality etc.

Finally, it is stated that international exhaustion would lead to more imports of counterfeit products, thus having a severe negative impact on health and safety of consumers.

b. Arguments for a change to international exhaustion

Besides a reduction of prices, the study lists a series of other arguments in favour of changing to international exhaustion.

Parallel imports would increase (inter-brand) competition, by reducing the possibility for a trade mark holder to exploit his position in that brand and to set higher prices in certain markets, and by increasing competition in the distribution of the product. Beside this claimed effect from a change in the exhaustion regime, the study lists a series of other arguments in favour of changing the present regime.

Some of the interviewees point at the fact that trade mark legislation is intended to provide assurance of origin of a product and not to be an instrument of market segmentation. Further it is stressed that there is little evidence that consumers would be confused if more parallel imports were to be permitted.

Moreover, some important trading partners partially implement international exhaustion with no evidence of alleged ill effects such as poor consumer service or lack of availability.

Finally, it is stated in the study that sometimes manufactures use parallel trade when they wish to off-load excess supplies.

III.TWO HEARINGS ON EXHAUSTION

During spring 1999 the Commission arranged for two meetings on exhaustion - one with representatives of the Member States and one hearing with interested circles.

a. Meeting with the Member States

On 26 April DG XV, together with the Legal Service, DG 1A, DG III, DG IV and DG XXIV, met with representatives from the Member States. The objective of this meeting was to inform Member States in detail on the NERA study, to discuss the main findings, and to allow the Member States to express their (preliminary) views on the preferred exhaustion regime. The researchers from the NERA Institute made a presentation of the study. At the meeting, Sweden presented a study on exhaustion carried out by the Swedish Competition Authority¹².

Regarding the methodology of the study, it became a subject of argument whether the issue of trade mark exhaustion could be discussed separately from the questions concerning exhaustion of other intellectual property rights. The question was also raised, to what extent associations of parallel traders were involved in preparation of the study. It was further pointed out that the study assumes constant price levels, whereas the prices encountered in parallel trade transactions often are inconsistent and specific to the circumstances. It was finally suggested that issues such as potential problems for certain sectors, the impact of electronic commerce on the issues involved and the effects caused by different characteristics of parallel imported products should be studied in greater detail.

Certain delegations expressed their doubts on the conclusions of the study with regard to the presumed negative effects of international exhaustion.

It was also mentioned that the positive long-term effects of international exhaustion should have received more attention, whereas on the other hand it was suggested that the potential negative impacts on consumers caused by a change of regime had been played down. The suggested increase in employment was said to be contradicted by the finding that profits of trade mark proprietors would decrease.

Finally, the question why there were no numerical estimates of long-term effects was also raised.

The estimated effects of a change of regime varied, with some delegations pointing to price reductions and increased competition to be anticipated, other expressing

¹² "Parallel imports - Effects of the Silhouette Ruling", Swedish Competition Authority, Report Series 1999:1.

concern over the fate of distribution chains, after-sale-services and guarantees as well as suggesting that there is a link between parallel importing and product piracy. In particular two delegations presented strong but diverting views on the exhaustion issue; one delegation expressed strong support for the present Community exhaustion regime, whereas another delegation strongly pleaded for a change to international exhaustion.

It emerged from the meeting that a considerable number of Member States are still in the process of examining the matter in greater detail.

b. Hearing with interested circles

On 28 April 1999, DG XV organised a hearing at Brussels with around 180 representatives of interested parties¹³ on the subject of exhaustion.

The interested circles were given the opportunity to express their views on the NERA study, the issue of the trade mark exhaustion as such, and the possible impact of a change from Community to international exhaustion for trade marks. Around 60 interventions were made.

As regards the estimated effects of a change in current trade mark exhaustion regime, representatives of all industries emphasised the important role of trade marks and other intellectual property rights as incentives for innovation and research. It was held that international exhaustion would weaken the position of trade mark proprietors and have implications for their strategic behaviour, this in turn leading to losses in innovation, production and employment.

Representatives from the pharmaceutical industry expressed their concern that extending the exhaustion regime in the field of trade marks would initiate a similar change in the field of patents with even worse effects for their sector; corresponding fears with respect to copyright exhaustion were expressed by the Audio-visual industry.

It was suggested that allowing international exhaustion would complicate the fight against counterfeiting and piracy: therefore, support of Community exhaustion was strongly advocated from industry.

Representatives of foreign trade associations, parallel trader's associations and consumer organisations underlined the welfare benefits resulting from free trade.

¹³ Associations of parallel importers, associations of trade mark holders, associations of different sectors of industry, consumer's associations etc.

According to these groups a change to an international exhaustion regime would lower prices, increase product availability and increase consumption in the Community.

Position papers

The Commission has received around 50 position papers from interested circles.

IV.COMMISSION WORKING PAPER

At the Internal Market Council on 21 June 1999, Commissioner Monti reported from the two hearings and announced that he envisaged to charge the Commission services with the preparation of a working document for discussion at Council working group level during the autumn 1999. The working document should focus on key issues which merit further examination before taking any final decisions on the matter of exhaustion.

ANNEX IV

THE NERA FINDINGS

The NERA researchers drafted the following table to present the relevance of the various IP rights for specific products.¹⁴

Sector	Trade mark	Copyright	Design	Patent
Footwear and leather goods	High	Low	High	Low
Musical recordings	High	High	Low	Low
Motorcars	High	Low	High	Only for components
Consumer electronics	High	Generally low	Medium/high	Only for components
Domestic appliances	High	Low	Medium/high	Only for components
Cosmetics and perfumes	High	Low	Medium/high	Low/medium
Clothing	High	Low	Low	Low
Soft drinks	High	Low	Low	Low
Confectionery	High	Low	Low	Low
Alcoholic drinks	High	Low	Low	Low

On the basis of the above table, the NERA researchers concluded the following. “Trade marks are clearly the most important form of intellectual property protection for the sectors we have examined, with the exception of musical recordings, where copyright is for obvious reasons also of great importance. Even for musical recordings, trade mark holders tend to regard trade marks as important because trade mark rights are often easier to enforce. Design protection is also fairly important in a number of sectors. Overall the availability of other forms of intellectual property protection would appear to offer only limited comfort, even if these operated with different and more restricted exhaustion regimes. For analytical convenience we make the working assumption that trade marks are the dominant form of protection, and that possibly different regimes for the other forms of protection will not alter the effects we describe.”

The NERA study revealed the following overall assessment of the scope for parallel trade for the following sectors¹⁵.

¹⁴ Executive Summary NERA report, “Relative Importance of Different Intellectual Property Rights”, table 4.3, p. 13.

¹⁵ Executive Summary NERA report, “Qualitative Assessment: Scope for Increase in Parallel Trade”, table 4.9, p. 19.

Sector	Price differences	Transaction costs	Technical barriers	Trade policy	Vertical constraints	Current parallel trade	Overall scope
Footwear and leather goods	++	+	+	-	-	-	+
Musical recordings	+	++	++	-	-	++	++
Motorcars	+	+	-	++	-	-	+
Consumer electronics	++	-/+	-	-	-	+	+
Domestic appliances	++	-	-	+	-	-	+
Cosmetics and perfumes	+	-	-	++	-	++	++
Clothing	+	+	+	--	-	+	+
Soft drinks	++	---	+	-	+	+	+
Confectionery	+	--	+	-	+	+	+
Alcoholic drinks	---	--	+	-	-	+	-

++ and + indicate strong and moderate positive influence tending to promote parallel trade; - - and - indicate negative influences tending to reduce parallel trade; blank denotes neutral effect

In the NERA report certain interesting conclusions are drawn from this table. For the footwear and leather sector, for example, there are rather considerable price differences, which would stimulate parallel trade; on the other hand there are also elements that have the potential of discouraging parallel trade like import duties and tight vertical restraints/long-term relationship.

According to the study the scope for extra parallel trade after a change of exhaustion regime would be moderate overall, but may be greater in some segments of the market for these goods.

For the market for motor cars, technical barriers constitute a significant deterrent for parallel imports. The study therefore only foresees some low to moderate penetration of parallel imports, in particular from Japan. The study notes that also other considerations than price are also important for vehicles and that it is not clear to what extent purchases of parallel imports will enjoy service, guarantees etc.

On cosmetics and perfumes the study states that there may be quite a high level of parallel imports for premium products, though the price level outside Europe is often the same or higher. The savings that would encourage parallel trade come according to the study from avoiding the cost of retailing in a luxury setting and selling the products in non-traditional outlets. According to the study, this might damage the luxury image of the products.

The clothing market is characterised by price differences in particular for premium brand names, and of tight vertical restraints for luxury clothes. In the study the assumption is made that parallel imports may limit the market as a whole although focussed on a small number of premium brands.

For soft drinks the study does not foresee any increase in parallel imports as the prices differ within Europe and the transport costs would be relatively high. The market for alcoholic drinks has barriers in terms of transaction costs and vertical relationships. As the prices for alcoholic drinks are relatively low it is estimated that it is unlikely that the level of parallel imports to Europe would increase.

**Directive 96/9/EC of the European Parliament and of the Council
the Council the Council March 1996 on the legal protection of databases**

March 1996 on the legal protection of databases

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 57 (2), 66 and 100a thereof,

Having regard to the proposal from the Commission (1),

Having regard to the opinion of the Economic and Social Committee (2),

Acting in accordance with the procedure laid down in Article 189b of the Treaty (3),

- (1) Whereas databases are at present not sufficiently protected in all Member States by existing legislation; whereas such protection, where it exists, has different attributes;
- (2) Whereas such differences in the legal protection of databases offered by the legislation of the Member States have direct negative effects on the functioning of the internal market as regards databases and in particular on the freedom of natural and legal persons to provide on-line database goods and services on the basis of harmonized legal arrangements throughout the Community; whereas such differences could well become more pronounced as Member States introduce new legislation in this field, which is now taking on an increasingly international dimension;
- (3) Whereas existing differences distorting the functioning of the internal market need to be removed and new ones prevented from arising, while differences not adversely affecting the functioning of the internal market or the development of an information market within the Community need not be removed or prevented from arising;
- (4) Whereas copyright protection for databases exists in varying forms in the Member States according to legislation or case-law, and whereas, if differences in legislation in the scope and conditions of protection remain between the Member States, such unharmonized intellectual property rights can have the effect of preventing the free movement of goods or services within the Community;
- (5) Whereas copyright remains an appropriate form of exclusive right for authors who have created databases;
- (6) Whereas, nevertheless, in the absence of a harmonized system of unfair-competition legislation or of case-law, other measures are required in addition to prevent the unauthorized extraction and/or re-utilization of the contents of a database;
- (7) Whereas the making of databases requires the investment of considerable human, technical and financial resources while such databases can be copied or accessed at a fraction of the cost needed to design them independently;
- (8) Whereas the unauthorized extraction and/or re-utilization of the contents of a database constitute acts which can have serious economic and technical consequences;
- (9) Whereas databases are a vital tool in the development of an information market within the Community; whereas this tool will also be of use in many other fields;
- (10) Whereas the exponential growth, in the Community and worldwide, in the amount of information generated and processed annually in all sectors of commerce and industry calls for investment in all the Member States in advanced information processing systems;
- (11) Whereas there is at present a very great imbalance in the level of investment in the database sector both as between the Member States and between the Community and the world's largest database-producing

third countries;

- (12) Whereas such an investment in modern information storage and processing systems will not take place within the Community unless a stable and uniform legal protection regime is introduced for the protection of the rights of makers of databases;
- (13) Whereas this Directive protects collections, sometimes called 'compilations', of works, data or other materials which are arranged, stored and accessed by means which include electronic, electromagnetic or electro-optical processes or analogous processes;
- (14) Whereas protection under this Directive should be extended to cover non-electronic databases;
- (15) Whereas the criteria used to determine whether a database should be protected by copyright should be defined to the fact that the selection or the arrangement of the contents of the database is the author's own intellectual creation; whereas such protection should cover the structure of the database;
- (16) Whereas no criterion other than originality in the sense of the author's intellectual creation should be applied to determine the eligibility of the database for copyright protection, and in particular no aesthetic or qualitative criteria should be applied;
- (17) Whereas the term 'database' should be understood to include literary, artistic, musical or other collections of works or collections of other material such as texts, sound, images, numbers, facts, and data; whereas it should cover collections of independent works, data or other materials which are systematically or methodically arranged and can be individually accessed; whereas this means that a recording or an audiovisual, cinematographic, literary or musical work as such does not fall within the scope of this Directive;
- (18) Whereas this Directive is without prejudice to the freedom of authors to decide whether, or in what manner, they will allow their works to be included in a database, in particular whether or not the authorization given is exclusive; whereas the protection of databases by the sui generis right is without prejudice to existing rights over their contents, and whereas in particular where an author or the holder of a related right permits some of his works or subject matter to be included in a database pursuant to a non-exclusive agreement, a third party may make use of those works or subject matter subject to the required consent of the author or of the holder of the related right without the sui generis right of the maker of the database being invoked to prevent him doing so, on condition that those works or subject matter are neither extracted from the database nor re-utilized on the basis thereof;
- (19) Whereas, as a rule, the compilation of several recordings of musical performances on a CD does not come within the scope of this Directive, both because, as a compilation, it does not meet the conditions for copyright protection and because it does not represent a substantial enough investment to be eligible under the sui generis right;
- (20) Whereas protection under this Directive may also apply to the materials necessary for the operation or consultation of certain databases such as thesaurus and indexation systems;
- (21) Whereas the protection provided for in this Directive relates to databases in which works, data or other materials have been arranged systematically or methodically; whereas it is not necessary for those materials to have been physically stored in an organized manner;
- (22) Whereas electronic databases within the meaning of this Directive may also include devices such as CD-ROM and CD-i;
- (23) Whereas the term 'database' should not be taken to extend to computer programs used in the making or operation of a database, which are protected by Council Directive 91/250/EEC of 14

May 1991 on the legal protection of computer programs (4);

- (24) Whereas the rental and lending of databases in the field of copyright and related rights are governed exclusively by Council Directive 92/100/EEC of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of intellectual property (5);
- (25) Whereas the term of copyright is already governed by Council Directive 93/98/EEC of 29 October 1993 harmonizing the term of protection of copyright and certain related rights (6);
- (26) Whereas works protected by copyright and subject matter protected by related rights, which are incorporated into a database, remain nevertheless protected by the respective exclusive rights and may not be incorporated into, or extracted from, the database without the permission of the rightholder or his successors in title;
- (27) Whereas copyright in such works and related rights in subject matter thus incorporated into a database are in no way affected by the existence of a separate right in the selection or arrangement of these works and subject matter in a database;
- (28) Whereas the moral rights of the natural person who created the database belong to the author and should be exercised according to the legislation of the Member States and the provisions of the Berne Convention for the Protection of Literary and Artistic Works; whereas such moral rights remain outside the scope of this Directive;
- (29) Whereas the arrangements applicable to databases created by employees are left to the discretion of the Member States; whereas, therefore nothing in this Directive prevents Member States from stipulating in their legislation that where a database is created by an employee in the execution of his duties or following the instructions given by his employer, the employer exclusively shall be entitled to exercise all economic rights in the database so created, unless otherwise provided by contract;
- (30) Whereas the author's exclusive rights should include the right to determine the way in which his work is exploited and by whom, and in particular to control the distribution of his work to unauthorized persons;
- (31) Whereas the copyright protection of databases includes making databases available by means other than the distribution of copies;
- (32) Whereas Member States are required to ensure that their national provisions are at least materially equivalent in the case of such acts subject to restrictions as are provided for by this Directive;
- (33) Whereas the question of exhaustion of the right of distribution does not arise in the case of on-line databases, which come within the field of provision of services; whereas this also applies with regard to a material copy of such a database made by the user of such a service with the consent of the rightholder; whereas, unlike CD-ROM or CD-i, where the intellectual property is incorporated in a material medium, namely an item of goods, every on-line service is in fact an act which will have to be subject to authorization where the copyright so provides;
- (34) Whereas, nevertheless, once the rightholder has chosen to make available a copy of the database to a user, whether by an on-line service or by other means of distribution, that lawful user must be able to access and use the database for the purposes and in the way set out in the agreement with the rightholder, even if such access and use necessitate performance of otherwise restricted acts;
- (35) Whereas a list should be drawn up of exceptions to restricted acts, taking into account the

fact that copyright as covered by this Directive applies only to the selection or arrangements of the contents of a database; whereas Member States should be given the option of providing for such exceptions in certain cases; whereas, however, this option should be exercised in accordance with the Berne Convention and to the extent that the exceptions relate to the structure of the database; whereas a distinction should be drawn between exceptions for private use and exceptions for reproduction for private purposes, which concerns provisions under national legislation of some Member States on levies on blank media or recording equipment;

- (36) Whereas the term 'scientific research' within the meaning of this Directive covers both the natural sciences and the human sciences;
- (37) Whereas Article 10 (1) of the Berne Convention is not affected by this Directive;
- (38) Whereas the increasing use of digital recording technology exposes the database maker to the risk that the contents of his database may be copied and rearranged electronically, without his authorization, to produce a database of identical content which, however, does not infringe any copyright in the arrangement of his database;
- (39) Whereas, in addition to aiming to protect the copyright in the original selection or arrangement of the contents of a database, this Directive seeks to safeguard the position of makers of databases against misappropriation of the results of the financial and professional investment made in obtaining and collection the contents by protecting the whole or substantial parts of a database against certain acts by a user or competitor;
- (40) Whereas the object of this sui generis right is to ensure protection of any investment in obtaining, verifying or presenting the contents of a database for the limited duration of the right; whereas such investment may consist in the deployment of financial resources and/or the expending of time, effort and energy;
- (41) Whereas the objective of the sui generis right is to give the maker of a database the option of preventing the unauthorized extraction and/or re-utilization of all or a substantial part of the contents of that database; whereas the maker of a database is the person who takes the initiative and the risk of investing; whereas this excludes subcontractors in particular from the definition of maker;
- (42) Whereas the special right to prevent unauthorized extraction and/or re-utilization relates to acts by the user which go beyond his legitimate rights and thereby harm the investment; whereas the right to prohibit extraction and/or re-utilization of all or a substantial part of the contents relates not only to the manufacture of a parasitical competing product but also to any user who, through his acts, causes significant detriment, evaluated qualitatively or quantitatively, to the investment;
- (43) Whereas, in the case of on-line transmission, the right to prohibit re-utilization is not exhausted either as regards the database or as regards a material copy of the database or of part thereof made by the addressee of the transmission with the consent of the rightholder;
- (44) Whereas, when on-screen display of the contents of a database necessitates the permanent or temporary transfer of all or a substantial part of such contents to another medium, that act should be subject to authorization by the rightholder;
- (45) Whereas the right to prevent unauthorized extraction and/or re-utilization does not in any way constitute an extension of copyright protection to mere facts or data;
- (46) Whereas the existence of a right to prevent the unauthorized extraction and/or re-utilization of the whole or a substantial part of works, data or materials from a database should not give rise to the creation of a new right in the works, data or materials themselves;

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- (47) Whereas, in the interests of competition between suppliers of information products and services, protection by the sui generis right must not be afforded in such a way as to facilitate abuses of a dominant position, in particular as regards the creation and distribution of new products and services which have an intellectual, documentary, technical, economic or commercial added value; whereas, therefore, the provisions of this Directive are without prejudice to the application of Community or national competition rules;
- (48) Whereas the objective of this Directive, which is to afford an appropriate and uniform level of protection of databases as a means to secure the remuneration of the maker of the database, is different from the aim of Directive 95/46/EC of the European Parliament and of the Council of 24 October 1995 on the protection of individuals with regard to the processing of personal data and on the free movement of such data (7), which is to guarantee free circulation of personal data on the basis of harmonized rules designed to protect fundamental rights, notably the right to privacy which is recognized in Article 8 of the European Convention for the Protection of Human Rights and Fundamental Freedoms; whereas the provisions of this Directive are without prejudice to data protection legislation;
- (49) Whereas, notwithstanding the right to prevent extraction and/or re-utilization of all or a substantial part of a database, it should be laid down that the maker of a database or rightholder may not prevent a lawful user of the database from extracting and re-utilizing insubstantial parts; whereas, however, that user may not unreasonably prejudice either the legitimate interests of the holder of the sui generis right or the holder of copyright or a related right in respect of the works or subject matter contained in the database;
- (50) Whereas the Member States should be given the option of providing for exceptions to the right to prevent the unauthorized extraction and/or re-utilization of a substantial part of the contents of a database in the case of extraction for private purposes, for the purposes of illustration for teaching or scientific research, or where extraction and/or re-utilization are/is carried out in the interests of public security or for the purposes of an administrative or judicial procedure; whereas such operations must not prejudice the exclusive rights of the maker to exploit the database and their purpose must not be commercial;
- (51) Whereas the Member States, where they avail themselves of the option to permit a lawful user of a database to extract a substantial part of the contents for the purposes of illustration for teaching or scientific research, may limit that permission to certain categories of teaching or scientific research institution;
- (52) Whereas those Member States which have specific rules providing for a right comparable to the sui generis right provided for in this Directive should be permitted to retain, as far as the new right is concerned, the exceptions traditionally specified by such rules;
- (53) Whereas the burden of proof regarding the date of completion of the making of a database lies with the maker of the database;
- (54) Whereas the burden of proof that the criteria exist for concluding that a substantial modification of the contents of a database is to be regarded as a substantial new investment lies with the maker of the database resulting from such investment;
- (55) Whereas a substantial new investment involving a new term of protection may include a substantial verification of the contents of the database;
- (56) Whereas the right to prevent unauthorized extraction and/or re-utilization in respect of a database should apply to databases whose makers are nationals or habitual residents of third countries or to those produced by legal persons not established in a Member State, within the

meaning of the Treaty, only if such third countries offer comparable protection to databases produced by nationals of a Member State or persons who have their habitual residence in the territory of the Community;

- (57) Whereas, in addition to remedies provided under the legislation of the Member States for infringements of copyright or other rights, Member States should provide for appropriate remedies against unauthorized extraction and/or re-utilization of the contents of a database;
- (58) Whereas, in addition to the protection given under this Directive to the structure of the database by copyright, and to its contents against unauthorized extraction and/or re-utilization under the sui generis right, other legal provisions in the Member States relevant to the supply of database goods and services continue to apply;
- (59) Whereas this Directive is without prejudice to the application to databases composed of audiovisual works of any rules recognized by a Member State's legislation concerning the broadcasting of audiovisual programmes;
- (60) Whereas some Member States currently protect under copyright arrangements databases which do not meet the criteria for eligibility for copyright protection laid down in this Directive; whereas, even if the databases concerned are eligible for protection under the right laid down in this Directive to prevent unauthorized extraction and/or re-utilization of their contents, the term of protection under that right is considerably shorter than that which they enjoy under the national arrangements currently in force; whereas harmonization of the criteria for determining whether a database is to be protected by copyright may not have the effect of reducing the term of protection currently enjoyed by the rightholders concerned; whereas a derogation should be laid down to that effect; whereas the effects of such derogation must be confined to the territories of the Member States concerned,

HAVE ADOPTED THIS DIRECTIVE:

CHAPTER I

SCOPE

Article 1

Scope

1. This Directive concerns the legal protection of databases in any form.
2. For the purposes of this Directive, 'database' shall mean a collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means.
3. Protection under this Directive shall not apply to computer programs used in the making or operation of databases accessible by electronic means.

Article 2

Limitations on the scope

This Directive shall apply without prejudice to Community provisions relating to:

- (a) the legal protection of computer programs;
- (b) rental right, lending right and certain rights related to copyright in the field of intellectual property;
- (c) the term of protection of copyright and certain related rights.

CHAPTER II

COPYRIGHT

Article 3

Object of protection

1. In accordance with this Directive, databases which, by reason of the selection or arrangement of their contents, constitute the author's own intellectual creation shall be protected as such by copyright. No other criteria shall be applied to determine their eligibility for that protection.
2. The copyright protection of databases provided for by this Directive shall not extend to their contents and shall be without prejudice to any rights subsisting in those contents themselves.

Article 4

Database authorship

1. The author of a database shall be the natural person or group of natural persons who created the base or, where the legislation of the Member States so permits, the legal person designated as the rightholder by that legislation.
2. Where collective works are recognized by the legislation of a Member State, the economic rights shall be owned by the person holding the copyright.
3. In respect of a database created by a group of natural persons jointly, the exclusive rights shall be owned jointly.

Article 5

Restricted acts

In respect of the expression of the database which is protectable by copyright, the author of a database shall have the exclusive right to carry out or to authorize:

- (a) temporary or permanent reproduction by any means and in any form, in whole or in part;
- (b) translation, adaptation, arrangement and any other alteration;
- (c) any form of distribution to the public of the database or of copies thereof. The first sale in the Community of a copy of the database by the rightholder or with his consent shall exhaust the right to control resale of that copy within the Community;
- (d) any communication, display or performance to the public;

- (e) any reproduction, distribution, communication, display or performance to the public of the results of the acts referred to in (b).

Article 6

Exceptions to restricted acts

1. The performance by the lawful user of a database or of a copy thereof of any of the acts listed in Article 5 which is necessary for the purposes of access to the contents of the databases and normal use of the contents by the lawful user shall not require the authorization of the author of the database. Where the lawful user is authorized to use only part of the database, this provision shall apply only to that part.

2. Member States shall have the option of providing for limitations on the rights set out in Article 5 in the following cases:

- (a) in the case of reproduction for private purposes of a non-electronic database;
- (b) where there is use for the sole purpose of illustration for teaching or scientific research, as long as the source is indicated and to the extent justified by the non-commercial purpose to be achieved;
- (c) where there is use for the purposes of public security or for the purposes of an administrative or judicial procedure;
- (d) where other exceptions to copyright which are traditionally authorized under national law are involved, without prejudice to points (a), (b) and (c).

3. In accordance with the Berne Convention for the protection of Literary and Artistic Works, this Article may not be interpreted in such a way as to allow its application to be used in a manner which unreasonably prejudices the rightholder's legitimate interests or conflicts with normal exploitation of the database.

CHAPTER III

SUI GENERIS RIGHT

Article 7

Object of protection

1. Member States shall provide for a right for the maker of a database which shows that there has been qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents to prevent extraction and/or re-utilization of the whole or of a substantial part, evaluated qualitatively and/or quantitatively, of the contents of that database.

2. For the purposes of this Chapter:

- (a) 'extraction` shall mean the permanent or temporary transfer of all or a substantial part of the contents of a database to another medium by any means or in any form;
- (b) 're-utilization` shall mean any form of making available to the public all or a substantial part of the contents of a database by the distribution of copies, by renting, by on-line or other forms of transmission. The first sale of a copy of a database within the Community by the rightholder

or with his consent shall exhaust the right to control resale of that copy within the Community;

Public lending is not an act of extraction or re-utilization.

3. The right referred to in paragraph 1 may be transferred, assigned or granted under contractual licence.
4. The right provided for in paragraph 1 shall apply irrespective of the eligibility of that database for protection by copyright or by other rights. Moreover, it shall apply irrespective of eligibility of the contents of that database for protection by copyright or by other rights. Protection of databases under the right provided for in paragraph 1 shall be without prejudice to rights existing in respect of their contents.
5. The repeated and systematic extraction and/or re-utilization of insubstantial parts of the contents of the database implying acts which conflict with a normal exploitation of that database or which unreasonably prejudice the legitimate interests of the maker of the database shall not be permitted.

Article 8

Rights and obligations of lawful users

1. The maker of a database which is made available to the public in whatever manner may not prevent a lawful user of the database from extracting and/or re-utilizing insubstantial parts of its contents, evaluated qualitatively and/or quantitatively, for any purposes whatsoever. Where the lawful user is authorized to extract and/or re-utilize only part of the database, this paragraph shall apply only to that part.
2. A lawful user of a database which is made available to the public in whatever manner may not perform acts which conflict with normal exploitation of the database or unreasonably prejudice the legitimate interests of the maker of the database.
3. A lawful user of a database which is made available to the public in any manner may not cause prejudice to the holder of a copyright or related right in respect of the works or subject matter contained in the database.

Article 9

Exceptions to the sui generis right

Member States may stipulate that lawful users of a database which is made available to the public in whatever manner may, without the authorization of its maker, extract or re-utilize a substantial part of its contents:

- (a) in the case of extraction for private purposes of the contents of a non-electronic database;
- (b) in the case of extraction for the purposes of illustration for teaching or scientific research, as long as the source is indicated and to the extent justified by the non-commercial purpose to be achieved;
- (c) in the case of extraction and/or re-utilization for the purposes of public security or an administrative or judicial procedure.

Article 10

Term of protection

1. The right provided for in Article 7 shall run from the date of completion of the making of the database. It shall expire fifteen years from the first of January of the year following the date of completion.
2. In the case of a database which is made available to the public in whatever manner before expiry of the period provided for in paragraph 1, the term of protection by that right shall expire fifteen years from the first of January of the year following the date when the database was first made available to the public.
3. Any substantial change, evaluated qualitatively or quantitatively, to the contents of a database, including any substantial change resulting from the accumulation of successive additions, deletions or alterations, which would result in the database being considered to be a substantial new investment, evaluated qualitatively or quantitatively, shall qualify the database resulting from that investment for its own term of protection.

Article 11

Beneficiaries of protection under the sui generis right

1. The right provided for in Article 7 shall apply to database whose makers or rightholders are nationals of a Member State or who have their habitual residence in the territory of the Community.
2. Paragraph 1 shall also apply to companies and firms formed in accordance with the law of a Member State and having their registered office, central administration or principal place of business within the Community; however, where such a company or firm has only its registered office in the territory of the Community, its operations must be genuinely linked on an ongoing basis with the economy of a Member State.
3. Agreements extending the right provided for in Article 7 to databases made in third countries and falling outside the provisions of paragraphs 1 and 2 shall be concluded by the Council acting on a proposal from the Commission. The term of any protection extended to databases by virtue of that procedure shall not exceed that available pursuant to Article 10.

CHAPTER IV

COMMON PROVISIONS

Article 12

Remedies

Member States shall provide appropriate remedies in respect of infringements of the rights provided for in this Directive.

Article 13

Continued application of other legal provisions

This Directive shall be without prejudice to provisions concerning in particular copyright, rights related to copyright or any other rights or obligations subsisting in the data, works or other materials incorporated into a database, patent rights, trade marks, design rights, the protection of national treasures, laws on restrictive practices and unfair competition, trade secrets, security, confidentiality, data protection and privacy, access to public documents, and the law of contract.

Article 14

Application over time

1. Protection pursuant to this Directive as regards copyright shall also be available in respect of databases created prior to the date referred to in Article 16 (1) which on that date fulfil the requirements laid down in this Directive as regards copyright protection of databases.
2. Notwithstanding paragraph 1, where a database protected under copyright arrangements in a Member State on the date of publication of this Directive does not fulfil the eligibility criteria for copyright protection laid down in Article 3 (1), this Directive shall not result in any curtailing in that Member State of the remaining term of protection afforded under those arrangements.
3. Protection pursuant to the provisions of this Directive as regards the right provided for in Article 7 shall also be available in respect of databases the making of which was completed not more than fifteen years prior to the date referred to in Article 16 (1) and which on that date fulfil the requirements laid down in Article 7.
4. The protection provided for in paragraphs 1 and 3 shall be without prejudice to any acts concluded and rights acquired before the date referred to in those paragraphs.
5. In the case of a database the making of which was completed not more than fifteen years prior to the date referred to in Article 16 (1), the term of protection by the right provided for in Article 7 shall expire fifteen years from the first of January following that date.

Article 15

Binding nature of certain provisions

Any contractual provision contrary to Articles 6 (1) and 8 shall be null and void.

Article 16

Final provisions

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive before 1 January 1998.

When Member States adopt these provisions, they shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such reference shall be laid down by Member States.

2. Member States shall communicate to the Commission the text of the provisions of domestic law which they adopt in the field governed by this Directive.

3. Not later than at the end of the third year after the date referred to in paragraph 1, and every three years thereafter, the Commission shall submit to the European Parliament, the Council and the Economic and Social Committee a report on the application of this Directive, in which, inter alia, on the basis of specific information supplied by the Member States, it shall examine in particular the application of the sui generis right, including Articles 8 and 9, and shall verify especially whether the application of this right has led to abuse of a dominant position or other interference with free competition which would justify appropriate measures being taken, including the establishment of non-voluntary licensing arrangements. Where necessary, it shall submit proposals for adjustment of this Directive in line with developments in the area of databases.

Article 17

This Directive is addressed to the Member States.

Done at Strasbourg, 11 March 1996.

For the European Parliament

The President

K. HÆNSCHFor the Council

The President

L. DINI

(1) OJ No C 156, 23. 6. 1992, p. 4 and

OJ No C 308, 15. 11. 1993, p. 1.

(2) OJ No C 19, 25. 1. 1993, p. 3.

(3) Opinion of the European Parliament of 23 June 1993 (OJ No C 194, 19. 7. 1993, p. 144), Common Position of the Council of 10 July 1995 (OJ No C 288, 30. 10. 1995, p. 14), Decision of the European Parliament of 14 December 1995 (OJ No C 17, 22 1. 1996) and Council Decision of 26 February 1996.

(4) OJ No L 122, 17. 5. 1991, p. 42. Directive as last amended by Directive 93/98/EEC (OJ No L 290, 24. 11. 1993, p. 9.)

(5) OJ No L 346, 27. 11. 1992, p. 61.

(6) OJ No L 290, 24. 11. 1993, p. 9.

(7) OJ No L 281, 23. 11. 1995, p. 31.

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BELPROV

1. - Loi du 10/08/1998 transposant en droit judiciaire belge la directive

européenne du 11 mars 1996 concernant la protection juridique des bases de données. Moniteur belge du 14/11/1998 p. 36913

DEUPROV

1. - Gesetz zur Regelung der Rahmenbedingungen für Informations- und Kommunikationsdienste (Informations- und Kommunikationsdienste-Gesetz-LuKDG) vom 22/07/1997, Bundesgesetzblatt Teil I vom 28/07/1997 Seite 1870

DNKPROV

1. - Lov nr. 407 af 26/06/1998 om ændring af ophavsretsloven. Kulturmin., 5.kt., j.nr. 1998.7001-7

ESPPROV

1. - Ley numero 5/98 de 06/03/1998, de incorporacion al Derecho español de la Directiva 96/9/CE, del Parlamento Europeo y del Consejo, de 11/03/1996 sobre la proteccion jurídica de las bases de datos. Boletín Oficial del Estado numero 57 de 07/03/1998 Pagina 7935 (Marginal 5568)

FRAPROV

NO REFERENCE AVAILABLE

GRCPROV

NO REFERENCE AVAILABLE

IRLPROV

NO REFERENCE AVAILABLE

ITAPROV

NO REFERENCE AVAILABLE

LUXPROV

NO REFERENCE AVAILABLE

NLDPROV

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PRTPROV

NO REFERENCE AVAILABLE

GBRPROV

1. - "Copyright and Rights in Databases Regulations 1997" of 18 December 1997, in " Statutory Instrument 1997 N. 3032 Copyright Rights in Databases - The Copyright and Rights in Databases Regulations 1997".

Implementing SIs

['*' indicates information added by Justis Publishing]

- The Copyright and Rights in Databases Regulations 1997, SI 1997/3032

Related SIs

['*' indicates information added by Justis Publishing]

- *The Copyright and Rights in Databases (Amendment) Regulations 2003, SI 2003/2501

AUTPROV

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1997 - UrhG-Nov 1997). Bundesgesetzblatt für die Republik Österreich, Nr. 25/1998 ausgegeben am 09/01/1998

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3. - Valtioneuvoston asetus tietokantojen erityissuojan soveltamisesta Mansaaresta peräisin oleviin suojan kohteisiin. SSK n° 877 tethy 22/10/2003 p. 3207 (SG (2003)A/11283 du 18/11/2003)

:

1. - Obchodní zákoník
2. - Zakon o pravu autorském, o pravech souvisejících s právem autorskum a o změn některých zákon (autorsku zakon)
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4. - Zakon. 140/1961 Sb., trestní zakon
5. - Zakon eské narodní rady. 200/1990 Sb., o pestupcích

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1. - Autortiesbu likums
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1. - Lietuvos Respublikos autori teisi ir gretutini teisi statymo pakeitimo statymas Nr. IX-1355 (nauja redakcija)

:

1. - 2003. évi CII. törvényegyes iparjogvédelmi és szerzi jogi törvények módosításáról
2. - 2001. évi LXXVII. törvénya szerzi jogról szolo 1999. évi LXXVI. törvény módosításáról

:

1. - Regolamenti ta' l-2003 dwar Data Personali uProtezzjoni tal-Privatezza

taht-Att Biex Jirregola T-Telekomunikazzjoni(Kap. 399)

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:

1. - Ustawa z dnia 4 lutego 1994 r. o prawie autorskim i prawach pokrewnych

2. - Ustawa z dnia 27 lipca 2001 r. o ochronie baz danych

:

1. - Zakon. 618/2003 Z. z. o autorskom prave a pravach suvisiacich s autorskum pravom (autorsku zakon)

:

1. - Zakon o spremembah in dopolnitvah zakona o avtorski in sorodnih pravicah

2. - Zakon o avtorski in sorodnih pravicah

3. - Zakon o spremembah in dopolnitvah zakona o avtorski in sorodnih pravicah

4. - Zakon o avtorski in sorodnih pravicah - uradno preieno besedilo

**Council Directive 92/100/EEC
of 19 November 1992
on rental right and lending right and on certain rights related to **copyright** in the field of
intellectual property**

COUNCIL DIRECTIVE 92/100/EEC of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of intellectual property

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community, and in particular Articles 57 (2), 66 and 100a thereof,

Having regard to the proposal from the Commission (1),

In cooperation with the European Parliament (2),

Having regard to the opinion of the Economic and Social Committee (3),

Whereas differences exist in the legal protection provided by the laws and practices of the Member States for copyright works and subject matter of related rights protection as regards rental and lending; whereas such differences are sources of barriers to trade and distortions of competition which impede the achievement and proper functioning of the internal market;

Whereas such differences in legal protection could well become greater as Member States adopt new and different legislation or as national case-law interpreting such legislation develops differently;

Whereas such differences should therefore be eliminated in accordance with the objective of introducing an area without internal frontiers as set out in Article 8a of the Treaty so as to institute, pursuant to Article 3 (f) of the Treaty, a system ensuring that competition in the common market is not distorted;

Whereas rental and lending of copyright works and the subject matter of related rights protection is playing an increasingly important role in particular for authors, performers and producers of phonograms and films; whereas piracy is becoming an increasing threat;

Whereas the adequate protection of copyright works and subject matter of related rights protection by rental and lending rights as well as the protection of the subject matter of related rights protection by the fixation right, reproduction right, distribution right, right to broadcast and communication to the public can accordingly be considered as being of fundamental importance for the Community's economic and cultural development;

Whereas copyright and related rights protection must adapt to new economic developments such as new forms of exploitation;

Whereas the creative and artistic work of authors and performers necessitates an adequate income as a basis for further creative and artistic work, and the investments required particularly for the production of phonograms and films are especially high and risky; whereas the possibility for securing that income and recouping that investment can only effectively be guaranteed through adequate legal protection of the rightholders concerned;

Whereas these creative, artistic and entrepreneurial activities are, to a large extent, activities of self-employed persons; whereas the pursuit of such activities must be made easier by providing a harmonized legal protection within the Community;

Whereas, to the extent that these activities principally constitute services, their provision must equally be facilitated by the establishment in the Community of a harmonized legal framework;

Whereas the legislation of the Member States should be approximated in such a way so as not to

conflict with the international conventions on which many Member States' copyright and related rights laws are based;

Whereas the Community's legal framework on the rental right and lending right and on certain rights related to copyright can be limited to establishing that Member States provide rights with respect to rental and lending for certain groups of rightholders and further to establishing the rights of fixation, reproduction, distribution, broadcasting and communication to the public for certain groups of rightholders in the field of related rights protection;

Whereas it is necessary to define the concepts of rental and lending for the purposes of this Directive;

Whereas it is desirable, with a view to clarity, to exclude from rental and lending within the meaning of this Directive certain forms of making available, as for instance making available phonograms or films (cinematographic or audiovisual works or moving images, whether or not accompanied by sound) for the purpose of public performance or broadcasting, making available for the purpose of exhibition, or making available for on-the-spot reference use; whereas lending within the meaning of this Directive does not include making available between establishments which are accessible to the public;

Whereas, where lending by an establishment accessible to the public gives rise to a payment the amount of which does not go beyond what is necessary to cover the operating costs of the establishment, there is no direct or indirect economic or commercial advantage within the meaning of this Directive;

Whereas it is necessary to introduce arrangements ensuring that an unwaivable equitable remuneration is obtained by authors and performers who must retain the possibility to entrust the administration of this right to collecting societies representing them;

Whereas the equitable remuneration may be paid on the basis of one or several payments at any time on or after the conclusion of the contract;

Whereas the equitable remuneration must take account of the importance of the contribution of the authors and performers concerned to the phonogram or film;

Whereas it is also necessary to protect the rights at least of authors as regards public lending by providing for specific arrangements; whereas, however, any measures based on Article 5 of this Directive have to comply with Community law, in particular with Article 7 of the Treaty;

Whereas the provisions of Chapter II do not prevent Member States from extending the presumption set out in Article 2 (5) to the exclusive rights included in that chapter; whereas furthermore the provisions of Chapter II do not prevent Member States from providing for a rebuttable presumption of the authorization of exploitation in respect of the exclusive rights of performers provided for in those articles, in so far as such presumption is compatible with the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (hereinafter referred to as the Rome Convention);

Whereas Member States may provide for more far-reaching protection for owners of rights related to copyright than that required by Article 8 of this Directive;

Whereas the harmonized rental and lending rights and the harmonized protection in the field of rights related to copyright should not be exercised in a way which constitutes a disguised restriction on trade between Member States or in a way which is contrary to the rule of media exploitation chronology, as recognized in the Judgment handed down in *Société Cinéthèque v. FNCF* (4),

HAS ADOPTED THIS DIRECTIVE: CHAPTER I RENTAL AND LENDING RIGHT

Article 1

Object of harmonization 1. In accordance with the provisions of this Chapter, Member States shall provide, subject to Article 5, a right to authorize or prohibit the rental and lending of originals and copies of copyright works, and other subject matter as set out in Article 2 (1).

2. For the purposes of this Directive, 'rental' means making available for use, for a limited period of time and for direct or indirect economic or commercial advantage.

3. For the purposes of this Directive, 'lending' means making available for use, for a limited period of time and not for direct or indirect economic or commercial advantage, when it is made through establishments which are accessible to the public.

4. The rights referred to in paragraph 1 shall not be exhausted by any sale or other act of distribution of originals and copies of copyright works and other subject matter as set out in Article 2 (1).

Article 2

Rightholders and subject matter of rental and lending right 1. The exclusive right to authorize or prohibit rental and lending shall belong:

- to the author in respect of the original and copies of his work,
- to the performer in respect of fixations of his performance,
- to the phonogram producer in respect of his phonograms, and
- to the producer of the first fixation of a film in respect of the original and copies of his film. For the purposes of this Directive, the term 'film' shall designate a cinematographic or audiovisual work or moving images, whether or not accompanied by sound.

2. For the purposes of this Directive the principal director of a cinematographic or audiovisual work shall be considered as its author or one of its authors. Member States may provide for others to be considered as its co-authors.

3. This Directive does not cover rental and lending rights in relation to buildings and to works of applied art.

4. The rights referred to in paragraph 1 may be transferred, assigned or subject to the granting of contractual licences.

5. Without prejudice to paragraph 7, when a contract concerning film production is concluded, individually or collectively, by performers with a film producer, the performer covered by this contract shall be presumed, subject to contractual clauses to the contrary, to have transferred his rental right, subject to Article 4.

6. Member States may provide for a similar presumption as set out in paragraph 5 with respect to authors.

7. Member States may provide that the signing of a contract concluded between a performer and a film producer concerning the production of a film has the effect of authorizing rental, provided that such contract provides for an equitable remuneration within the meaning of Article 4. Member States may also provide that this paragraph shall apply *mutatis mutandis* to the rights included

in Chapter II.

Article 3

Rental of computer programs This Directive shall be without prejudice to Article 4 (c) of Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs (5).

Article 4

Unwaivable right to equitable remuneration 1. Where an author or performer has transferred or assigned his rental right concerning a phonogram or an original or copy of a film to a phonogram or film producer, that author or performer shall retain the right to obtain an equitable remuneration for the rental.

2. The right to obtain an equitable remuneration for rental cannot be waived by authors or performers.

3. The administration of this right to obtain an equitable remuneration may be entrusted to collecting societies representing authors or performers.

4. Member States may regulate whether and to what extent administration by collecting societies of the right to obtain an equitable remuneration may be imposed, as well as the question from whom this remuneration may be claimed or collected.

Article 5

Derogation from the exclusive public lending right 1. Member States may derogate from the exclusive right provided for in Article 1 in respect of public lending, provided that at least authors obtain a remuneration for such lending. Member States shall be free to determine this remuneration taking account of their cultural promotion objectives.

2. When Member States do not apply the exclusive lending right provided for in Article 1 as regards phonograms, films and computer programs, they shall introduce, at least for authors, a remuneration.

3. Member States may exempt certain categories of establishments from the payment of the remuneration referred to in paragraphs 1 and 2.

4. The Commission, in cooperation with the Member States, shall draw up before 1 July 1997 a report on public lending in the Community. It shall forward this report to the European Parliament and to the Council.

CHAPTER II RIGHTS RELATED TO COPYRIGHT

Article 6

Fixation right 1. Member States shall provide for performers the exclusive right to authorize or prohibit the fixation of their performances.

2. Member States shall provide for broadcasting organizations the exclusive right to authorize or prohibit the fixation of their broadcasts, whether these broadcasts are transmitted by wire or

over the air, including by cable or satellite.

3. A cable distributor shall not have the right provided for in paragraph 2 where it merely retransmits by cable the broadcasts of broadcasting organizations.

Article 7

Reproduction right 1. Member States shall provide the exclusive right to authorize or prohibit the direct or indirect reproduction:

- for performers, of fixations of their performances,
- for phonogram producers, of their phonograms,
- for producers of the first fixations of films, in respect of the original and copies of their films, and
- for broadcasting organizations, of fixations of their broadcasts, as set out in Article 6 (2).

2. The reproduction right referred to in paragraph 1 may be transferred, assigned or subject to the granting of contractual licences.

Article 8

Broadcasting and communication to the public 1. Member States shall provide for performers the exclusive right to authorize or prohibit the broadcasting by wireless means and the communication to the public of their performances, except where the performance is itself already a broadcast performance or is made from a fixation.

2. Member States shall provide a right in order to ensure that a single equitable remuneration is paid by the user, if a phonogram published for commercial purposes, or a reproduction of such phonogram, is used for broadcasting by wireless means or for any communication to the public, and to ensure that this remuneration is shared between the relevant performers and phonogram producers. Member States may, in the absence of agreement between the performers and phonogram producers, lay down the conditions as to the sharing of this remuneration between them.

3. Member States shall provide for broadcasting organizations the exclusive right to authorize or prohibit the rebroadcasting of their broadcasts by wireless means, as well as the communication to the public of their broadcasts if such communication is made in places accessible to the public against payment of an entrance fee.

Article 9

Distribution right 1. Member States shall provide

- for performers, in respect of fixations of their performances,
- for phonogram producers, in respect of their phonograms,
- for producers of the first fixations of films, in respect of the original and copies of their films,

- for broadcasting organizations, in respect of fixations of their broadcast as set out in Article 6 (2), the exclusive right to make available these objects, including copies thereof, to the public by sale or otherwise, hereafter referred to as the 'distribution right'.

2. The distribution right shall not be exhausted within the Community in respect of an object as referred to in paragraph 1, except where the first sale in the Community of that object is made by the rightholder or with his consent.

3. The distribution right shall be without prejudice to the specific provisions of Chapter I, in particular Article 1 (4).

4. The distribution right may be transferred, assigned or subject to the granting of contractual licences.

Article 10

Limitations to rights 1. Member States may provide for limitations to the rights referred to in Chapter II in respect of:

(a) private use;

(b) use of short excerpts in connection with the reporting of current events;

(c) ephemeral fixation by a broadcasting organization by means of its own facilities and for its own broadcasts;

(d) use solely for the purposes of teaching or scientific research.

2. Irrespective of paragraph 1, any Member State may provide for the same kinds of limitations with regard to the protection of performers, producers of phonograms, broadcasting organizations and of producers of the first fixations of films, as it provides for in connection with the protection of copyright in literary and artistic works. However, compulsory licences may be provided for only to the extent to which they are compatible with the Rome Convention.

3. Paragraph 1 (a) shall be without prejudice to any existing or future legislation on remuneration for reproduction for private use. CHAPTER III DURATION

Article 11

Duration of authors' rights Without prejudice to further harmonization, the authors' rights referred to in this Directive shall not expire before the end of the term provided by the Berne Convention for the Protection of Literary and Artistic Works.

Article 12

Duration of related rights Without prejudice to further harmonization, the rights referred to in this Directive of performers, phonogram producers and broadcasting organizations shall not expire before the end of the respective terms provided by the Rome Convention. The rights referred to

in this Directive for producers of the first fixations of films shall not expire before the end of a period of 20 years computed from the end of the year in which the fixation was made. CHAPTER IV COMMON PROVISIONS

Article 13

Application in time 1. This Directive shall apply in respect of all copyright works, performances, phonograms, broadcasts and first fixations of films referred to in this Directive which are, on 1 July 1994, still protected by the legislation of the Member States in the field of copyright and related rights or meet the criteria for protection under the provisions of this Directive on that date.

2. This Directive shall apply without prejudice to any acts of exploitation performed before 1 July 1994.

3. Member States may provide that the rightholders are deemed to have given their authorization to the rental or lending of an object referred to in Article 2 (1) which is proven to have been made available to third parties for this purpose or to have been acquired before 1 July 1994. However, in particular where such an object is a digital recording, Member States may provide that rightholders shall have a right to obtain an adequate remuneration for the rental or lending of that object.

4. Member States need not apply the provisions of Article 2 (2) to cinematographic or audiovisual works created before 1 July 1994.

5. Member States may determine the date as from which the Article 2 (2) shall apply, provided that that date is no later than 1 July 1997.

6. This Directive shall, without prejudice to paragraph 3 and subject to paragraphs 8 and 9, not affect any contracts concluded before the date of its adoption.

7. Member States may provide, subject to the provisions of paragraphs 8 and 9, that when rightholders who acquire new rights under the national provisions adopted in implementation of this Directive have, before 1 July 1994, given their consent for exploitation, they shall be presumed to have transferred the new exclusive rights.

8. Member States may determine the date as from which the unwaivable right to an equitable remuneration referred to in Article 4 exists, provided that that date is no later than 1 July 1997.

9. For contracts concluded before 1 July 1994, the unwaivable right to an equitable remuneration provided for in Article 4 shall apply only where authors or performers or those representing them have submitted a request to that effect before 1 January 1997. In the absence of agreement between rightholders concerning the level of remuneration, Member States may fix the level of equitable remuneration.

Article 14

Relation between copyright and related rights Protection of copyright-related rights under this Directive shall leave intact and shall in no way affect the protection of copyright.

Article 15

Final provisions 1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive not later than 1 July 1994. They shall forthwith inform the Commission thereof.

When Member States adopt these measures, they shall contain a reference to this Directive or shall be accompanied by such reference at the time of their official publication. The methods of making such a reference shall be laid down by the Member States.

2. Member States shall communicate to the Commission the main provisions of domestic law which they adopt in the field covered by this Directive.

Article 16

This Directive is addressed to the Member States. Done at Brussels, 19 November 1992. For the Council

The President

E. LEIGH

- (1) OJ No C 53, 28. 2. 1991, p. 35 and OJ No C 128, 20. 5. 1992, p. 8. (2) OJ No C 67, 16. 3. 1992, p. 92 and Decision of 28 October 1992 (not yet published in the Official Journal). (3) OJ No C 269, 14. 10. 1991, p. 54. (4) Cases 60/84 and 61/84, ECR 1985, p. 2605. (5) OJ No L 122, 17. 5. 1991, p. 42.

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SUBSPREP Amendment proposed by 51997PC0628.....

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**Council Directive 93/83/EEC
of 27 September 1993**

on the coordination of certain rules concerning **copyright and rights related to **copyright** applicable to satellite broadcasting and cable retransmission**

COUNCIL DIRECTIVE 93/83/EEC of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community, and in particular Articles 57 (2) and 66 thereof,

Having regard to the proposal from the Commission (1),

In cooperation with the European Parliament (2),

Having regard to the opinion of the Economic and Social Committee (3),

- (1) Whereas the objectives of the Community as laid down in the Treaty include establishing an ever closer union among the peoples of Europe, fostering closer relations between the States belonging to the Community and ensuring the economic and social progress of the Community countries by common action to eliminate the barriers which divide Europe;
- (2) Whereas, to that end, the Treaty provides for the establishment of a common market and an area without internal frontiers; whereas measures to achieve this include the abolition of obstacles to the free movement of services and the institution of a system ensuring that competition in the common market is not distorted; whereas, to that end, the Council may adopt directives for the coordination of the provisions laid down by law, regulation or administrative action in Member States concerning the taking up and pursuit of activities as self-employed persons;
- (3) Whereas broadcasts transmitted across frontiers within the Community, in particular by satellite and cable, are one of the most important ways of pursuing these Community objectives, which are at the same time political, economic, social, cultural and legal;
- (4) Whereas the Council has already adopted Directive 89/552/EEC of 3 October 1989 on the coordination of certain provisions laid down by law, regulation or administrative action in Member States concerning the pursuit of television broadcasting activities (4), which makes provision for the promotion of the distribution and production of European television programmes and for advertising and sponsorship, the protection of minors and the right of reply;
- (5) Whereas, however, the achievement of these objectives in respect of cross-border satellite broadcasting and the cable retransmission of programmes from other Member States is currently still obstructed by a series of differences between national rules of copyright and some degree of legal uncertainty; whereas this means that holders of rights are exposed to the threat of seeing their works exploited without payment of remuneration or that the individual holders of exclusive rights in various Member States block the exploitation of their rights; whereas the legal uncertainty in particular constitutes a direct obstacle in the free circulation of programmes within the Community;
- (6) Whereas a distinction is currently drawn for copyright purposes between communication to the public by direct satellite and communication to the public by communications satellite; whereas, since individual reception is possible and affordable nowadays with both types of satellite, there is no longer any justification for this differing legal treatment;
- (7) Whereas the free broadcasting of programmes is further impeded by the current legal uncertainty over whether broadcasting by a satellite whose signals can be received directly affects the

rights in the country of transmission only or in all countries of reception together; whereas, since communications satellites and direct satellites are treated alike for copyright purposes, this legal uncertainty now affects almost all programmes broadcast in the Community by satellite;

- (8) Whereas, furthermore, legal certainty, which is a prerequisite for the free movement of broadcasts within the Community, is missing where programmes transmitted across frontiers are fed into and retransmitted through cable networks;
- (9) Whereas the development of the acquisition of rights on a contractual basis by authorization is already making a vigorous contribution to the creation of the desired European audiovisual area; whereas the continuation of such contractual agreements should be ensured and their smooth application in practice should be promoted wherever possible;
- (10) Whereas at present cable operators in particular cannot be sure that they have actually acquired all the programme rights covered by such an agreement;
- (11) Whereas, lastly, parties in different Member States are not all similarly bound by obligations which prevent them from refusing without valid reason to negotiate on the acquisition of the rights necessary for cable distribution or allowing such negotiations to fail;
- (12) Whereas the legal framework for the creation of a single audiovisual area laid down in Directive 89/552/EEC must, therefore, be supplemented with reference to copyright;
- (13) Whereas, therefore, an end should be put to the differences of treatment of the transmission of programmes by communications satellite which exist in the Member States, so that the vital distinction throughout the Community becomes whether works and other protected subject matter are communicated to the public; whereas this will also ensure equal treatment of the suppliers of cross-border broadcasts, regardless of whether they use a direct broadcasting satellite or a communications satellite;
- (14) Whereas the legal uncertainty regarding the rights to be acquired which impedes cross-border satellite broadcasting should be overcome by defining the notion of communication to the public by satellite at a Community level; whereas this definition should at the same time specify where the act of communication takes place; whereas such a definition is necessary to avoid the cumulative application of several national laws to one single act of broadcasting; whereas communication to the public by satellite occurs only when, and in the Member State where, the programme-carrying signals are introduced under the control and responsibility of the broadcasting organization into an uninterrupted chain of communication leading to the satellite and down towards the earth; whereas normal technical procedures relating to the programme-carrying signals should not be considered as interruptions to the chain of broadcasting;
- (15) Whereas the acquisition on a contractual basis of exclusive broadcasting rights should comply with any legislation on copyright and rights related to copyright in the Member State in which communication to the public by satellite occurs;
- (16) Whereas the principle of contractual freedom on which this Directive is based will make it possible to continue limiting the exploitation of these rights, especially as far as certain technical means of transmission or certain language versions are concerned;
- (17) Whereas, in arriving at the amount of the payment to be made for the rights acquired, the parties should take account of all aspects of the broadcast, such as the actual audience, the potential audience and the language version;
- (18) Whereas the application of the country-of-origin principle contained in this Directive could pose a problem with regard to existing contracts; whereas this Directive should provide for a period of five years for existing contracts to be adapted, where necessary, in the light of

the Directive; whereas the said country-of-origin principle should not, therefore, apply to existing contracts which expire before 1 January 2000; whereas if by that date parties still have an interest in the contract, the same parties should be entitled to renegotiate the conditions of the contract;

- (19) Whereas existing international co-production agreements must be interpreted in the light of the economic purpose and scope envisaged by the parties upon signature; whereas in the past international co-production agreements have often not expressly and specifically addressed communication to the public by satellite within the meaning of this Directive a particular form of exploitation; whereas the underlying philosophy of many existing international co-production agreements is that the rights in the co-production are exercised separately and independently by each co-producer, by dividing the exploitation rights between them along territorial lines; whereas, as a general rule, in the situation where a communication to the public by satellite authorized by one co-producer would prejudice the value of the exploitation rights of another co-producer, the interpretation of such an existing agreement would normally suggest that the latter co-producer would have to give his consent to the authorization, by the former co-producer, of the communication to the public by satellite; whereas the language exclusivity of the latter co-producer will be prejudiced where the language version or versions of the communication to the public, including where the version is dubbed or subtitled, coincide(s) with the language or the languages widely understood in the territory allotted by the agreement to the latter co-producer; whereas the notion of exclusivity should be understood in a wider sense where the communication to the public by satellite concerns a work which consists merely of images and contains no dialogue or subtitles; whereas a clear rule is necessary in cases where the international co-production agreement does not expressly regulate the division of rights in the specific case of communication to the public by satellite within the meaning of this Directive;
- (20) Whereas communications to the public by satellite from non-member countries will under certain conditions be deemed to occur within a Member State of the Community;
- (21) Whereas it is necessary to ensure that protection for authors, performers, producers of phonograms and broadcasting organizations is accorded in all Member States and that this protection is not subject to a statutory licence system; whereas only in this way is it possible to ensure that any difference in the level of protection within the common market will not create distortions of competition;
- (22) Whereas the advent of new technologies is likely to have an impact on both the quality and the quantity of the exploitation of works and other subject matter;
- (23) Whereas in the light of these developments the level of protection granted pursuant to this Directive to all rightholders in the areas covered by this Directive should remain under consideration;
- (24) Whereas the harmonization of legislation envisaged in this Directive entails the harmonization of the provisions ensuring a high level of protection of authors, performers, phonogram producers and broadcasting organizations; whereas this harmonization should not allow a broadcasting organization to take advantage of differences in levels of protection by relocating activities, to the detriment of audiovisual productions;
- (25) Whereas the protection provided for rights related to copyright should be aligned on that contained in Council Directive 92/100/EEC of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of intellectual property (5) for the purposes of communication to the public by satellite; whereas, in particular, this will ensure that performers and phonogram producers are guaranteed an appropriate remuneration for the communication to the public by satellite of their performances or phonograms;
- (26) Whereas the provisions of Article 4 do not prevent Member States from extending the presumption

set out in Article 2 (5) of Directive 92/100/EEC to the exclusive rights referred to in Article 4; whereas, furthermore, the provisions of Article 4 do not prevent Member States from providing for a rebuttable presumption of the authorization of exploitation in respect of the exclusive rights of performers referred to in that Article, in so far as such presumption is compatible with the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations;

- (27) Whereas the cable retransmission of programmes from other Member States is an act subject to copyright and, as the case may be, rights related to copyright; whereas the cable operator must, therefore, obtain the authorization from every holder of rights in each part of the programme retransmitted; whereas, pursuant to this Directive, the authorizations should be granted contractually unless a temporary exception is provided for in the case of existing legal licence schemes;
- (28) Whereas, in order to ensure that the smooth operation of contractual arrangements is not called into question by the intervention of outsiders holding rights in individual parts of the programme, provision should be made, through the obligation to have recourse to a collecting society, for the exclusive collective exercise of the authorization right to the extent that this is required by the special features of cable retransmission; whereas the authorization right as such remains intact and only the exercise of this right is regulated to some extent, so that the right to authorize a cable retransmission can still be assigned; whereas this Directive does not affect the exercise of moral rights;
- (29) Whereas the exemption provided for in Article 10 should not limit the choice of holders of rights to transfer their rights to a collecting society and thereby have a direct share in the remuneration paid by the cable distributor for cable retransmission;
- (30) Whereas contractual arrangements regarding the authorization of cable retransmission should be promoted by additional measures; whereas a party seeking the conclusion of a general contract should, for its part, be obliged to submit collective proposals for an agreement; whereas, furthermore, any party shall be entitled, at any moment, to call upon the assistance of impartial mediators whose task is to assist negotiations and who may submit proposals; whereas any such proposals and any opposition thereto should be served on the parties concerned in accordance with the applicable rules concerning the service of legal documents, in particular as set out in existing international conventions; whereas, finally, it is necessary to ensure that the negotiations are not blocked without valid justification or that individual holders are not prevented without valid justification from taking part in the negotiations; whereas none of these measures for the promotion of the acquisition of rights calls into question the contractual nature of the acquisition of cable retransmission rights;
- (31) Whereas for a transitional period Member States should be allowed to retain existing bodies with jurisdiction in their territory over cases where the right to retransmit a programme by cable to the public has been unreasonably refused or offered on unreasonable terms by a broadcasting organization; whereas it is understood that the right of parties concerned to be heard by the body should be guaranteed and that the existence of the body should not prevent the parties concerned from having normal access to the courts;
- (32) Whereas, however, Community rules are not needed to deal with all of those matters, the effects of which perhaps with some commercially insignificant exceptions, are felt only inside the borders of a single Member State;
- (33) Whereas minimum rules should be laid down in order to establish and guarantee free and uninterrupted cross-border broadcasting by satellite and simultaneous, unaltered cable retransmission of programmes broadcast from other Member States, on an essentially contractual basis;

- (34) Whereas this Directive should not prejudice further harmonization in the field of copyright and rights related to copyright and the collective administration of such rights; whereas the possibility for Member States to regulate the activities of collecting societies should not prejudice the freedom of contractual negotiation of the rights provided for in this Directive, on the understanding that such negotiation takes place within the framework of general or specific national rules with regard to competition law or the prevention of abuse of monopolies;
- (35) Whereas it should, therefore, be for the Member States to supplement the general provisions needed to achieve the objectives of this Directive by taking legislative and administrative measures in their domestic law, provided that these do not run counter to the objectives of this Directive and are compatible with Community law;
- (36) Whereas this Directive does not affect the applicability of the competition rules in Articles 85 and 86 of the Treaty,

HAS ADOPTED THIS DIRECTIVE:

CHAPTER I DEFINITIONS

Article 1

Definitions 1. For the purpose of this Directive, 'satellite' means any satellite operating on frequency bands which, under telecommunications law, are reserved for the broadcast of signals for reception by the public or which are reserved for closed, point-to-point communication. In the latter case, however, the circumstances in which individual reception of the signals takes place must be comparable to those which apply in the first case.

2. (a) For the purpose of this Directive, 'communication to the public by satellite' means the act of introducing, under the control and responsibility of the broadcasting organization, the programme-carrying signals intended for reception by the public into an uninterrupted chain of communication leading to the satellite and down towards the earth.

- (b) The act of communication to the public by satellite occurs solely in the Member State where, under the control and responsibility of the broadcasting organization, the programme-carrying signals are introduced into an uninterrupted chain of communication leading to the satellite and down towards the earth.
- (c) If the programme-carrying signals are encrypted, then there is communication to the public by satellite on condition that the means for decrypting the broadcast are provided to the public by the broadcasting organization or with its consent.
- (d) Where an act of communication to the public by satellite occurs in a non-Community State which does not provide the level of protection provided for under Chapter II,
- (i) if the programme-carrying signals are transmitted to the satellite from an uplink situation situated in a Member State, that act of communication to the public by satellite shall be deemed to have occurred in that Member State and the rights provided for under Chapter II shall be exercisable against the person operating the uplink station; or
- (ii) if there is no use of an uplink station situated in a Member State but a broadcasting organization established in a Member State has commissioned the act of communication to the public by satellite, that act shall be deemed to have occurred in the Member State in which the broadcasting organization has its principal establishment in the Community and the rights provided for under Chapter II

shall be exercisable against the broadcasting organization.

3. For the purposes of this Directive, 'cable retransmission' means the simultaneous, unaltered and unabridged retransmission by a cable or microwave system for reception by the public of an initial transmission from another Member State, by wire or over the air, including that by satellite, of television or radio programmes intended for reception by the public.

4. For the purposes of this Directive 'collecting society' means any organization which manages or administers copyright or rights related to copyright as its sole purpose or as one of its main purposes.

5. For the purposes of this Directive, the principal director of a cinematographic or audiovisual work shall be considered as its author or one of its authors. Member States may provide for others to be considered as its co-authors.

CHAPTER II BROADCASTING OF PROGRAMMES BY SATELLITE

Article 2

Broadcasting right Member States shall provide an exclusive right for the author to authorize the communication to the public by satellite of copyright works, subject to the provisions set out in this chapter.

Article 3

Acquisition of broadcasting rights 1. Member States shall ensure that the authorization referred to in Article 2 may be acquired only by agreement.

2. A Member State may provide that a collective agreement between a collecting society and a broadcasting organization concerning a given category of works may be extended to rightholders of the same category who are not represented by the collecting society, provided that:

- the communication to the public by satellite simulcasts a terrestrial broadcast by the same broadcaster, and
- the unrepresented rightholder shall, at any time, have the possibility of excluding the extension of the collective agreement to his works and of exercising his rights either individually or collectively.

3. Paragraph 2 shall not apply to cinematographic works, including works created by a process analogous to cinematography.

4. Where the law of a Member State provides for the extension of a collective agreement in accordance with the provisions of paragraph 2, that Member States shall inform the Commission which broadcasting organizations are entitled to avail themselves of that law. The Commission shall publish this information in the Official Journal of the European Communities (C series).

Article 4

Rights of performers, phonogram producers and broadcasting organizations 1. For the purposes of communication to the public by satellite, the rights of performers, phonogram producers and broadcasting

organizations shall be protected in accordance with the provisions of Articles 6, 7, 8 and 10 of Directive 92/100/EEC.

2. For the purposes of paragraph 1, 'broadcasting by wireless means' in Directive 92/100/EEC shall be understood as including communication to the public by satellite.

3. With regard to the exercise of the rights referred to in paragraph 1, Articles 2 (7) and 12 of Directive 92/100/EEC shall apply.

Article 5

Relation between copyright and related rights Protection of copyright-related rights under this Directive shall leave intact and shall in no way affect the protection of copyright.

Article 6

Minimum protection 1. Member States may provide for more far-reaching protection for holders of rights related to copyright than that required by Article 8 of Directive 92/100/EEC.

2. In applying paragraph 1 Member States shall observe the definitions contained in Article 1 (1) and (2).

Article 7

Transitional provisions 1. With regard to the application in time of the rights referred to in Article 4 (1) of this Directive, Article 13 (1), (2), (6) and (7) of Directive 92/100/EEC shall apply. Article 13 (4) and (5) of Directive 92/100/EEC shall apply mutatis mutandis.

2. Agreements concerning the exploitation of works and other protected subject matter which are in force on the date mentioned in Article 14 (1) shall be subject to the provisions of Articles 1 (2), 2 and 3 as from 1 January 2000 if they expire after that date.

3. When an international co-production agreement concluded before the date mentioned in Article 14 (1) between a co-producer from a Member State and one or more co-producers from other Member States or third countries expressly provides for a system of division of exploitation rights between the co-producers by geographical areas for all means of communication to the public, without distinguishing the arrangement applicable to communication to the public by satellite from the provisions applicable to the other means of communication, and where communication to the public by satellite of the co-production would prejudice the exclusivity, in particular the language exclusivity, of one of the co-producers or his assignees in a given territory, the authorization by one of the co-producers or his assignees for a communication to the public by satellite shall require the prior consent of the holder of that exclusivity, whether co-producer or assignee.

CHAPTER III CABLE RETRANSMISSION

Article 8

Cable retransmission right 1. Member States shall ensure that when programmes from other Member States are retransmitted by cable in their territory the applicable copyright and related rights are observed and that such retransmission takes place on the basis of individual or collective contractual agreements between copyright owners, holders of related rights and cable operators.

2. Notwithstanding paragraph 1, Member States may retain until 31 December 1997 such statutory licence systems which are in operation or expressly provided for by national law on 31 July 1991.

Article 9

Exercise of the cable retransmission right 1. Member States shall ensure that the right of copyright owners and holders or related rights to grant or refuse authorization to a cable operator for a cable retransmission may be exercised only through a collecting society.

2. Where a rightholder has not transferred the management of his rights to a collecting society, the collecting society which manages rights of the same category shall be deemed to be mandated to manage his rights. Where more than one collecting society manages rights of that category, the rightholder shall be free to choose which of those collecting societies is deemed to be mandated to manage his rights. A rightholder referred to in this paragraph shall have the same rights and obligations resulting from the agreement between the cable operator and the collecting society which is deemed to be mandated to manage his rights as the rightholders who have mandated that collecting society and he shall be able to claim those rights within a period, to be fixed by the Member State concerned, which shall not be shorter than three years from the date of the cable retransmission which includes his work or other protected subject matter.

3. A Member State may provide that, when a rightholder authorizes the initial transmission within its territory of a work or other protected subject matter, he shall be deemed to have agreed not to exercise his cable retransmission rights on an individual basis but to exercise them in accordance with the provisions of this Directive.

Article 10

Exercise of the cable retransmission right by broadcasting organizations Member States shall ensure that Article 9 does not apply to the rights exercised by a broadcasting organization in respect of its own transmission, irrespective of whether the rights concerned are its own or have been transferred to it by other copyright owners and/or holders of related rights.

Article 11

Mediators 1. Where no agreement is concluded regarding authorization of the cable retransmission of a broadcast. Member States shall ensure that either party may call upon the assistance of one or more mediators.

2. The task of the mediators shall be to provide assistance with negotiation. They may also submit proposals to the parties.

3. It shall be assumed that all the parties accept a proposal as referred to in paragraph 2 if none of them expresses its opposition within a period of three months. Notice of the proposal and

of any opposition thereto shall be served on the parties concerned in accordance with the applicable rules concerning the service of legal documents.

4. The mediators shall be so selected that their independence and impartiality are beyond reasonable doubt.

Article 12

Prevention of the abuse of negotiating positions 1. Member States shall ensure by means of civil or administrative law, as appropriate, that the parties enter and conduct negotiations regarding authorization for cable retransmission in good faith and do not prevent or hinder negotiation without valid justification.

2. A Member State which, on the date mentioned in Article 14 (1), has a body with jurisdiction in its territory over cases where the right to retransmit a programme by cable to the public in that Member State has been unreasonably refused or offered on unreasonable terms by a broadcasting organization may retain that body.

3. Paragraph 2 shall apply for a transitional period of eight years from the date mentioned in Article 14 (1).

CHAPTER IV GENERAL PROVISIONS

Article 13

Collective administration of rights This Directive shall be without prejudice to the regulation of the activities of collecting societies by the Member States.

Article 14

Final provisions 1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive before 1 January 1995. They shall immediately inform the Commission thereof.

When Member States adopt these measures, the latter shall contain a reference to this Directive or shall be accompanied by such reference at the time of their official publication. The methods of making such a reference shall be laid down by the Member States.

2. Member States shall communicate to the Commission the provisions of national law which they adopt in the field covered by this Directive.

3. Not later than 1 January 2000, the Commission shall submit to the European Parliament, the Council and the Economic and Social Committee a report on the application of this Directive and, if necessary, make further proposals to adapt it to developments in the audio and audiovisual sector.

Article 15

This Directive is addressed to the Member States.

Done at Brussels, 27 September 1993.

For the Council

The President

R. URBAIN

- (1) OJ No C 255, 1. 10. 1991, p. 3 and OJ No C 25, 28. 1. 1993, p. 43.
- (2) OJ No C 305, 23. 11. 1992, p. 129 and OJ No C 255, 20. 9. 1993.
- (3) OJ No C 98, 21. 4. 1992, p. 44.
- (4) OJ No L 298, 17. 10. 1989, p. 23.
- (5) OJ No L 346, 27. 11. 1992, p. 61.

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**Council Directive 93/98/EEC
of 29 October 1993**

harmonizing the term of protection of **copyright and certain related rights**

COUNCIL DIRECTIVE 93/98/EEC of 29 October 1993 harmonizing the term of protection of copyright and certain related rights

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community, and in particular Articles 57 (2), 66 and 100a thereof,

Having regard to the proposal from the Commission (1),

In cooperation with the European Parliament (2),

Having regard to the opinion of the Economic and Social Committee (3),

- (1) Whereas the Berne Convention for the protection of literary and artistic works and the International Convention for the protection of performers, producers of phonograms and broadcasting organizations (Rome Convention) lay down only minimum terms of protection of the rights they refer to, leaving the Contracting States free to grant longer terms; whereas certain Member States have exercised this entitlement; whereas in addition certain Member States have not become party to the Rome Convention;
- (2) Whereas there are consequently differences between the national laws governing the terms of protection of copyright and related rights, which are liable to impede the free movement of goods and freedom to provide services, and to distort competition in the common market; whereas therefore with a view to the smooth operation of the internal market, the laws of the Member States should be harmonized so as to make terms of protection identical throughout the Community;
- (3) Whereas harmonization must cover not only the terms of protection as such, but also certain implementing arrangements such as the date from which each term of protection is calculated;
- (4) Whereas the provisions of this Directive do not affect the application by the Member States of the provisions of Article 14a (2) (b), (c) and (d) and (3) of the Berne Convention;
- (5) Whereas the minimum term of protection laid down by the Berne Convention, namely the life of the author and 50 years after his death, was intended to provide protection for the author and the first two generations of his descendants; whereas the average lifespan in the Community has grown longer, to the point where this term is no longer sufficient to cover two generations;
- (6) Whereas certain Member States have granted a term longer than 50 years after the death of the author in order to offset the effects of the world wars on the exploitation of authors' works;
- (7) Whereas for the protection of related rights certain Member States have introduced a term of 50 years after lawful publication or lawful communication to the public;
- (8) Whereas under the Community position adopted for the Uruguay Round negotiations under the General Agreement on Tariffs and Trade (GATT) the term of protection for producers of phonograms should be 50 years after first publication;
- (9) Whereas due regard for established rights is one of the general principles of law protected by the Community legal order; whereas, therefore, a harmonization of the terms of protection of copyright and related rights cannot have the effect of reducing the protection currently enjoyed by rightholders in the Community; whereas in order to keep the effects of transitional measures to a minimum and to allow the internal market to operate in practice, the harmonization of the term of protection should take place on a long term basis;

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- (10) Whereas in its communication of 17 January 1991 'Follow-up to the Green Paper - Working programme of the Commission in the field of copyright and neighbouring rights' the Commission stresses the need to harmonize copyright and neighbouring rights at a high level of protection since these rights are fundamental to intellectual creation and stresses that their protection ensures the maintenance and development of creativity in the interest of authors, cultural industries, consumers and society as a whole;
- (11) Whereas in order to establish a high level of protection which at the same time meets the requirements of the internal market and the need to establish a legal environment conducive to the harmonious development of literary and artistic creation in the Community, the term of protection for copyright should be harmonized at 70 years after the death of the author or 70 years after the work is lawfully made available to the public, and for related rights at 50 years after the event which sets the term running;
- (12) Whereas collections are protected according to Article 2 (5) of the Berne Convention when, by reason of the selection and arrangement of their content, they constitute intellectual creations; whereas those works are protected as such, without prejudice to the copyright in each of the works forming part of such collections, whereas in consequence specific terms of protection may apply to works included in collections;
- (13) Whereas in all cases where one or more physical persons are identified as authors the term of protection should be calculated after their death; whereas the question of authorship in the whole or a part of a work is a question of fact which the national courts may have to decide;
- (14) Whereas terms of protection should be calculated from the first day of January of the year following the relevant event, as they are in the Berne and Rome Conventions;
- (15) Whereas Article 1 of Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs (4) provides that Member States are to protect computer programs, by copyright, as literary works within the meaning of the Berne Convention; whereas this Directive harmonizes the term of protection of literary works in the Community; whereas Article 8 of Directive 91/250/EEC, which merely makes provisional arrangements governing the term of protection of computer programs, should accordingly be repealed;
- (16) Whereas Articles 11 and 12 of Council Directive 92/100/EEC of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of intellectual property (5) make provision for minimum terms of protection only, subject to any further harmonization; whereas this Directive provides such further harmonization; whereas these Articles should accordingly be repealed;
- (17) Whereas the protection of photographs in the Member States is the subject of varying regimes; whereas in order to achieve a sufficient harmonization of the term of protection of photographic works, in particular of those which, due to their artistic or professional character, are of importance within the internal market, it is necessary to define the level of originality required in this Directive; whereas a photographic work within the meaning of the Berne Convention is to be considered original if it is the author's own intellectual creation reflecting his personality, no other criteria such as merit or purpose being taken into account; whereas the protection of other photographs should be left to national law;
- (18) Whereas, in order to avoid differences in the term of protection as regards related rights it is necessary to provide the same starting point for the calculation of the term throughout the Community; whereas the performance, fixation, transmission, lawful publication, and lawful communication to the public, that is to say the means of making a subject of a related right perceptible in all appropriate ways to persons in general, should be taken into account for the

calculation of the term of protection regardless of the country where this performance, fixation, transmission, lawful publication, or lawful communication to the public takes place;

- (19) Whereas the rights of broadcasting organizations in their broadcasts, whether these broadcasts are transmitted by wire or over the air, including by cable or satellite, should not be perpetual; whereas it is therefore necessary to have the term of protection running from the first transmission of a particular broadcast only; whereas this provision is understood to avoid a new term running in cases where a broadcast is identical to a previous one;
- (20) Whereas the Member States should remain free to maintain or introduce other rights related to copyright in particular in relation to the protection of critical and scientific publications; whereas, in order to ensure transparency at Community level, it is however necessary for Member States which introduce new related rights to notify the Commission;
- (21) Whereas it is useful to make clear that the harmonization brought about by this Directive does not apply to moral rights;
- (22) Whereas, for works whose country of origin within the meaning of the Berne Convention is a third country and whose author is not a Community national, comparison of terms of protection should be applied, provided that the term accorded in the Community does not exceed the term laid down in this Directive;
- (23) Whereas where a rightholder who is not a Community national qualifies for protection under an international agreement the term of protection of related rights should be the same as that laid down in this Directive, except that it should not exceed that fixed in the country of which the rightholder is a national;
- (24) Whereas comparison of terms should not result in Member States being brought into conflict with their international obligations;
- (25) Whereas, for the smooth functioning of the internal market this Directive should be applied as from 1 July 1995;
- (26) Whereas Member States should remain free to adopt provisions on the interpretation, adaptation and further execution of contracts on the exploitation of protected works and other subject matter which were concluded before the extension of the term of protection resulting from this Directive;
- (27) Whereas respect of acquired rights and legitimate expectations is part of the Community legal order; whereas Member States may provide in particular that in certain circumstances the copyright and related rights which are revived pursuant to this Directive may not give rise to payments by persons who undertook in good faith the exploitation of the works at the time when such works lay within the public domain,

HAS ADOPTED THIS DIRECTIVE:

Article 1

Duration of authors' rights

1. The rights of an author of a literary or artistic work within the meaning of Article 2 of the Berne Convention shall run for the life of the author and for 70 years after his death, irrespective of the date when the work is lawfully made available to the public.
2. In the case of a work of joint authorship the term referred to in paragraph 1 shall be calculated from the death of the last surviving author.

3. In the case of anonymous or pseudonymous works, the term of protection shall run for seventy years after the work is lawfully made available to the public. However, when the pseudonym adopted by the author leaves no doubt as to his identity, or if the author discloses his identity during the period referred to in the first sentence, the term of protection applicable shall be that laid down in paragraph 1.

4. Where a Member State provides for particular provisions on copyright in respect of collective works or for a legal person to be designated as the rightholder, the term of protection shall be calculated according to the provisions of paragraph 3, except if the natural persons who have created the work as such are identified as such in the versions of the work which are made available to the public. This paragraph is without prejudice to the rights of identified authors whose identifiable contributions are included in such works, to which contributions paragraph 1 or 2 shall apply.

5. Where a work is published in volumes, parts, instalments, issues or episodes and the term of protection runs from the time when the work was lawfully made available to the public, the term of protection shall run for each such item separately.

6. In the case of works for which the term of protection is not calculated from the death of the author or authors and which have not been lawfully made available to the public within seventy years from their creation, the protection shall terminate.

Article 2

Cinematographic or audiovisual works

1. The principal director of a cinematographic or audiovisual work shall be considered as its author or one of its authors. Member States shall be free to designate other co-authors.

2. The term of protection of cinematographic or audiovisual works shall expire 70 years after the death of the last of the following persons to survive, whether or not these persons are designated as co-authors: the principal director, the author of the screenplay, the author of the dialogue and the composer of music specifically created for use in the cinematographic or audiovisual work.

Article 3

Duration of related rights

1. The rights of performers shall expire 50 years after the date of the performance. However, if a fixation of the performance is lawfully published or lawfully communicated to the public within this period, the rights shall expire 50 years from the date of the first such publication or the first such communication to the public, whichever is the earlier.

2. The rights of producers of phonograms shall expire 50 years after the fixation is made. However, if the phonogram is lawfully published or lawfully communicated to the public during this period, the rights shall expire 50 years from the date of the first such publication or the first such communication to the public, whichever is the earlier.

3. The rights of producers of the first fixation of a film shall expire 50 years after the fixation is made. However, if the film is lawfully published or lawfully communicated to the public during this period, the rights shall expire 50 years from the date of the first such publication or the first such communication to the public, whichever is the earlier. The term 'film' shall designate

a cinematographic or audiovisual work or moving images, whether or not accompanied by sound.

4. The rights of broadcasting organizations shall expire 50 years after the first transmission of a broadcast, whether this broadcast is transmitted by wire or over the air, including by cable or satellite.

Article 4

Protection of previously unpublished works

Any person who, after the expiry of copyright protection, for the first time lawfully publishes or lawfully communicates to the public a previously unpublished work, shall benefit from a protection equivalent to the economic rights of the author. The term of protection of such rights shall be 25 years from the time when the work was first lawfully published or lawfully communicated to the public.

Article 5

Critical and scientific publications

Member States may protect critical and scientific publications of works which have come into the public domain. The maximum term of protection of such rights shall be 30 years from the time when the publication was first lawfully published.

Article 6

Protection of photographs

Photographs which are original in the sense that they are the author's own intellectual creation shall be protected in accordance with Article 1. No other criteria shall be applied to determine their eligibility for protection. Member States may provide for the protection of other photographs.

Article 7

Protection vis-à-vis third countries

1. Where the country of origin of a work, within the meaning of the Berne Convention, is a third country, and the author of the work is not a Community national, the term of protection granted by the Member States shall expire on the date of expiry of the protection granted in the country of origin of the work, but may not exceed the term laid down in Article 1.

2. The terms of protection laid down in Article 3 shall also apply in the case of rightholders who are not Community nationals, provided Member States grant them protection. However, without prejudice to the international obligations of the Member States, the term of protection granted by Member States shall expire no later than the date of expiry of the protection granted in the country of which the rightholder is a national and may not exceed the term laid down in Article 3.

3. Member States which, at the date of adoption of this Directive, in particular pursuant to their international obligations, granted a longer term of protection than that which would result from the provisions, referred to in paragraphs 1 and 2 may maintain this protection until the conclusion of international agreements on the term of protection by copyright or related rights.

Article 8

Calculation of terms

The terms laid down in this Directive are calculated from the first day of January of the year following the event which gives rise to them.

Article 9

Moral rights

This Directive shall be without prejudice to the provisions of the Member States regulating moral rights.

Article 10

Application in time

1. Where a term of protection, which is longer than the corresponding term provided for by this Directive, is already running in a Member State on the date referred to in Article 13 (1), this Directive shall not have the effect of shortening that term of protection in that Member State.

2. The terms of protection provided for in this Directive shall apply to all works and subject matter which are protected in at least one Member State, on the date referred to in Article 13 (1), pursuant to national provisions on copyright or related rights or which meet the criteria for protection under Directive 92/100/EEC.

3. This Directive shall be without prejudice to any acts of exploitation performed before the date referred to in Article 13 (1). Member States shall adopt the necessary provisions to protect in particular acquired rights of third parties.

4. Member States need not apply the provisions of Article 2 (1) to cinematographic or audiovisual works created before 1 July 1994.

5. Member States may determine the date as from which Article 2 (1) shall apply, provided that date is no later than 1 July 1997.

Article 11

Technical adaptation

1. Article 8 of Directive 91/250/EEC is hereby repealed.

2. Articles 11 and 12 of Directive 92/100/EEC are hereby repealed.

Article 12

Notification procedure

Member States shall immediately notify the Commission of any governmental plan to grant new related rights, including the basic reasons for their introduction and the term of protection envisaged.

Article 13

General provisions

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with Articles 1 to 11 of this Directive before 1 July 1995.

When Member States adopt these provisions, they shall contain a reference to this Directive or shall be accompanied by such reference at the time of their official publication. The methods of making such a reference shall be laid down by the Member States.

Member States shall communicate to the Commission the texts of the provisions of national law which they adopt in the field governed by this Directive.

2. Member States shall apply Article 12 from the date of notification of this Directive.

Article 14

This Directive is addressed to the Member States.

Done at Brussels, 29 October 1993.

For the Council

The President

R. URBAIN

(1) OJ No C 92, 11. 4. 1992, p. 6 and

OJ No C 27, 30. 1. 1993, p. 7.

(2) OJ No C 337, 21. 12. 1992, p. 205 and

Decision of 27 October 1993 (not yet published in the Official Journal).

(3) OJ No C 287, 4. 11. 1992, p. 53.

(4) OJ No L 122, 17. 5. 1991, p. 42.

(5) OJ No L 346, 27. 11. 1992, p. 61.

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 31992L0100..... Repeal..... Repeal ART.12 from 19/11/1993
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SUBSPREP Amendment proposed by 51997PC0628.....
COURTDEC A10P3.....: Interpreted by..... 61998J0060
SUB Internal market ; Approximation of laws ; Industrial and commercial property
REGISTER 17200000
ADDRESS The Member States
AUTLANG The official languages
PREPWORK Proposal Commission;Com 92/0033 Final
 Proposal Commission;Com 92/0602 Final;OJ C 27/93 P 7
 Cooperation procedure European Parliament;OJ C 337/92 P 205
 Decision European Parliament;given on 27/10/93
 Opinion Economic and Social Committee;OJ C 287/92 P 53
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NL01/;0/9/07/1997 IR01/;2/6/04/1995 AU01;05/07/1996 AU02/;0/2/01/1996
SV01/;0/2/01/1996 SV02;30/01/1996 FI01/;0/8/02/1996 SV03/;1/4/05/1997
FR01;15/05/1997 GR01/;0/9/07/1997 IT01/;0/9/07/1997 UK01;11/07/1997
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NL01/;0/9/07/1997 IR01/;2/6/04/1995 AU01;05/07/1996 AU02/;0/2/01/1996
SV01/;0/2/01/1996 SV02;30/01/1996 FI01/;0/8/02/1996 SV03/;1/4/05/1997
FR01;15/05/1997 GR01/;0/9/07/1997 IT01/;0/9/07/1997 UK01;11/07/1997
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PT02/;0/4/02/1998 GR02/;

**Council Resolution
of 14 May 1992
on increased protection for **copyright** and **neighbouring rights****

COUNCIL RESOLUTION of 14 May 1992 on increased protection for copyright and neighbouring rights (92/C 138/01)

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Whereas advances in technology have encouraged the exploitation of literary and artistic works throughout the world; whereas the protection of copyright and neighbouring rights should therefore be consolidated at national, Community and international level;

Whereas, because of the level of protection they guarantee for literary and artistic works, rights of performers, producers of phonograms and broadcasting organizations, the Berne Convention for the Protection of Literary and Artistic works enshrined in the Paris Act of 24 July 1971 (Paris Act of the Berne Convention), and the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (Rome Convention) of 26 October 1961 enjoy a wide and increasing international acceptance; whereas it is necessary that all the Member States of the Community become parties to these Conventions;

Whereas, given the problem of piracy, it is in the interests of rightholders in the Community protected by these instruments that they should be ensured the minimum level of protection afforded by the latter in the maximum possible number of third countries, without prejudice to more detailed provisions in bilateral or multilateral agreements; whereas it is desirable that third countries become parties to these instruments,

HEREBY ADOPTS THIS RESOLUTION:

1. The Council notes that the Member States of the Community, in so far as they have not already done so, undertake, subject to their constitutional provisions, to become by 1 January 1995 parties to the Paris Act of the Berne Convention and the Rome Convention, and to introduce national legislation to ensure effective compliance therewith.
2. The Council considers that it is in the interests of Community copyright-holders and holders of neighbouring rights in the Community that third countries should ratify the Paris Act of the Berne Convention and the Rome Convention or accede thereto. It accordingly invites the Commission, when negotiating agreements between the Community and third countries, to pay particular attention, within the terms of the mandates given to them for the purpose, to the ratification of these instruments by the third countries concerned, or to the accession of the latter thereto, and to the effective compliance of such countries with these instruments.

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TYPDOC	3 ; SECONDARY LEGISLATION ; 1992 ; Y
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INFORCE	1992/05/14=EV
ENDVAL	9999/99/99
SUB	INDUSTRIAL AND COMMERCIAL PROPERTY
REGISTER	17200000
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Conclusions of the Ministers for Culture meeting within the Council of 7 June 1991 on copyright and neighbouring rights

CONCLUSIONS OF THE MINISTERS FOR CULTURE MEETING WITHIN THE COUNCIL of 7 June 1991 on copyright and neighbouring rights (91/C 188/04)

THE MINISTERS FOR CULTURE MEETING WITHIN THE COUNCIL,

Referring to the 'Green Paper on copyright and the technological challenge' published by the Commission in 1988 for discussion by the Member States and the professional circles concerned,

Bearing in mind their wish expressed both at the informal meeting of Culture Ministers on 2 November 1989 at Blois and in the Council on 19 November 1990, that the Commission should propose a comprehensive discussion of questions concerning the rights of authors, artists and producers in the Community, taking into account the completion of the single market on 1 January 1993,

Recalling their opinion that the matter of cultural goods and services cannot be addressed in the Community without taking into account their specific nature,

Consequently voicing their concern that the completion of the single market should not constitute a threat to cultural identities and to the rich diversity of Europe and that, taking into account the cultural dimension of copyright, internal harmonization at Community level in this area should be implemented only in areas affecting the establishment or functioning of the common market,

Considering that the Commission, when approving on 5 December 1990 its work programme in the matter of copyright and neighbouring rights in the form of a communication entitled 'Follow-up to the Green Paper', opens up real opportunities in this field for the completion of the single market,

Having taken note of the first three documents put forward by the Commission:

- the proposal for a Council Decision concerning the accession of the Member States to the Berne Convention (Paris Act of 24 July 1971) and the Rome International Convention of 26 October 1961,
- the proposal for a Directive on rental right, lending right and on certain related rights,
- the consultative document entitled 'Broadcasting and copyright in the internal market', on cable and satellite broadcasting,

WELCOME the overall approach to the harmonization of copyright and neighbouring rights adopted by the Commission in its work programme,

EXPRESS their satisfaction that the Commission has clearly demonstrated its will to seek, with a view to the single market, a high level of protection for authors, artists and producers in the whole Community,

POINT OUT that concern with the cultural industries should not cause to be relegated to a secondary level the giving of priority attention to the specific problems encountered by the professionals,

POINT OUT further that the free movement of goods should at no time detract from moral rights and rights to beneficial economic use associated with the different forms of presentation of works to the public,

REQUEST that in connection with the harmonization of copyright and neighbouring rights and while respecting the provisions of the Treaty of Rome, the capacity of Member States to preserve the balance of creative and artistic activity, particularly in limited geographical or linguistic distribution areas, should not be jeopardized,

REQUEST that allowance should be made for the consequences which the adoption of normative measures would have on the conditions of the exercise of the rights granted for the holders of these rights,

INVITE the Commission to make as quickly as possible a study of the conditions of the administration of these rights,

REQUEST that in negotiations with third parties (in particular the European economic area and countries of Central and Eastern Europe, without neglecting the other regions of the world), the cultural content of copyright and neighbouring rights should be taken into account,

INVITE the Commission to seek reinforced cooperation with the Council of Europe in this field.

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AUTHOR REPRESENTATIVES OF THE MEMBER STATES MEETING IN THE COUNCIL
FORM VARIOUS ACTS
TREATY European Economic Community
TYPDOC 4 ; SUPPLEMENTARY LEGAL ACTS ; 1991 ; Y
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ENDVAL 9999/99/99
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**Council Directive 91/250/EEC
of 14 May 1991
on the legal protection of computer programs**

COUNCIL DIRECTIVE of 14 May 1991 on the legal protection of computer programs (91/250/EEC)

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community and in particular Article 100a thereof,

Having regard to the proposal from the Commission (1),

In cooperation with the European Parliament (2),

Having regard to the opinion of the Economic and Social Committee (3),

Whereas computer programs are at present not clearly protected in all Member States by existing legislation and such protection, where it exists, has different attributes;

Whereas the development of computer programs requires the investment of considerable human, technical and financial resources while computer programs can be copied at a fraction of the cost needed to develop them independently;

Whereas computer programs are playing an increasingly important role in a broad range of industries and computer program technology can accordingly be considered as being of fundamental importance for the Community's industrial development;

Whereas certain differences in the legal protection of computer programs offered by the laws of the Member States have direct and negative effects on the functioning of the common market as regards computer programs and such differences could well become greater as Member States introduce new legislation on this subject;

Whereas existing differences having such effects need to be removed and new ones prevented from arising, while differences not adversely affecting the functioning of the common market to a substantial degree need not be removed or prevented from arising;

Whereas the Community's legal framework on the protection of computer programs can accordingly in the first instance be limited to establishing that Member States should accord protection to computer programs under copyright law as literary works and, further, to establishing who and what should be protected, the exclusive rights on which protected persons should be able to rely in order to authorize or prohibit certain acts and for how long the protection should apply;

Whereas, for the purpose of this Directive, the term 'computer program' shall include programs in any form, including those which are incorporated into hardware; whereas this term also includes preparatory design work leading to the development of a computer program provided that the nature of the preparatory work is such that a computer program can result from it at a later stage;

Whereas, in respect of the criteria to be applied in determining whether or not a computer program is an original work, no tests as to the qualitative or aesthetic merits of the program should be applied;

Whereas the Community is fully committed to the promotion of international standardization;

Whereas the function of a computer program is to communicate and work together with other components of a computer system and with users and, for this purpose, a logical and, where appropriate, physical interconnection and interaction is required to permit all elements of software and hardware to work with other software and hardware and with users in all the ways in which they are intended to function;

Whereas the parts of the program which provide for such interconnection and interaction between elements of software and hardware are generally known as 'interfaces`;

Whereas this functional interconnection and interaction is generally known as 'interoperability`; whereas such interoperability can be defined as the ability to exchange information and mutually to use the information which has been exchanged;

Whereas, for the avoidance of doubt, it has to be made clear that only the expression of a computer program is protected and that ideas and principles which underlie any element of a program, including those which underlie its interfaces, are not protected by copyright under this Directive;

Whereas, in accordance with this principle of copyright, to the extent that logic, algorithms and programming languages comprise ideas and principles, those ideas and principles are not protected under this Directive;

Whereas, in accordance with the legislation and jurisprudence of the Member States and the international copyright conventions, the expression of those ideas and principles is to be protected by copyright;

Whereas, for the purposes of this Directive, the term 'rental` means the making available for use, for a limited period of time and for profit-making purposes, of a computer program or a copy thereof; whereas this term does not include public lending, which, accordingly, remains outside the scope of this Directive;

Whereas the exclusive rights of the author to prevent the unauthorized reproduction of his work have to be subject to a limited exception in the case of a computer program to allow the reproduction technically necessary for the use of that program by the lawful acquirer;

Whereas this means that the acts of loading and running necessary for the use of a copy of a program which has been lawfully acquired, and the act of correction of its errors, may not be prohibited by contract; whereas, in the absence of specific contractual provisions, including when a copy of the program has been sold, any other act necessary for the use of the copy of a program may be performed in accordance with its intended purpose by a lawful acquirer of that copy;

Whereas a person having a right to use a computer program should not be prevented from performing acts necessary to observe, study or test the functioning of the program, provided that these acts do not infringe the copyright in the program;

Whereas the unauthorized reproduction, translation, adaptation or transformation of the form of the code in which a copy of a computer program has been made available constitutes an infringement of the exclusive rights of the author;

Whereas, nevertheless, circumstances may exist when such a reproduction of the code and translation of its form within the meaning of Article 4 (a) and (b) are indispensable to obtain the necessary information to achieve the interoperability of an independently created program with other programs;

Whereas it has therefore to be considered that in these limited circumstances only, performance of the acts of reproduction and translation by or on behalf of a person having a right to use a copy of the program is legitimate and compatible with fair practice and must therefore be deemed not to require the authorization of the rightholder;

Whereas an objective of this exception is to make it possible to connect all components of a computer system, including those of different manufacturers, so that they can work together;

Whereas such an exception to the author's exclusive rights may not be used in a way which prejudices the legitimate interests of the rightholder or which conflicts with a normal exploitation of the program;

Whereas, in order to remain in accordance with the provisions of the Berne Convention for the Protection of Literary and Artistic Works, the term of protection should be the life of the author and fifty years from the first of January of the year following the year of his death or, in the case of an anonymous or pseudonymous work, 50 years from the first of January of the year following the year in which the work is first published;

Whereas protection of computer programs under copyright laws should be without prejudice to the application, in appropriate cases, of other forms of protection; whereas, however, any contractual provisions contrary to Article 6 or to the exceptions provided for in Article 5 (2) and (3) should be null and void;

Whereas the provisions of this Directive are without prejudice to the application of the competition rules under Articles 85 and 86 of the Treaty if a dominant supplier refuses to make information available which is necessary for interoperability as defined in this Directive;

Whereas the provisions of this Directive should be without prejudice to specific requirements of Community law already enacted in respect of the publication of interfaces in the telecommunications sector or Council Decisions relating to standardization in the field of information technology and telecommunication;

Whereas this Directive does not affect derogations provided for under national legislation in accordance with the Berne Convention on points not covered by this Directive,

HAS ADOPTED THIS DIRECTIVE:

Article 1 Object of protection

1. In accordance with the provisions of this Directive, Member States shall protect computer programs, by copyright, as literary works within the meaning of the Berne Convention for the Protection of Literary and Artistic Works. For the purposes of this Directive, the term 'computer programs' shall include their preparatory design material.
2. Protection in accordance with this Directive shall apply to the expression in any form of a computer program. Ideas and principles which underlie any element of a computer program, including those which underlie its interfaces, are not protected by copyright under this Directive.
3. A computer program shall be protected if it is original in the sense that it is the author's own intellectual creation. No other criteria shall be applied to determine its eligibility for protection.

Article 2 Authorship of computer programs

1. The author of a computer program shall be the natural person or group of natural persons who has created the program or, where the legislation of the Member State permits, the legal person designated as the rightholder by that legislation. Where collective works are recognized by the legislation of a Member State, the person considered by the legislation of the Member State to have created the work shall be deemed to be its author.
2. In respect of a computer program created by a group of natural persons jointly, the exclusive rights shall be owned jointly.
3. Where a computer program is created by an employee in the execution of his duties or following the instructions given by his employer, the employer exclusively shall be entitled to exercise all economic rights in the program so created, unless otherwise provided by contract.

Article 3 Beneficiaries of protection

Protection shall be granted to all natural or legal persons eligible under national copyright legislation

as applied to literary works.

Article 4 Restricted Acts

Subject to the provisions of Articles 5 and 6, the exclusive rights of the rightholder within the meaning of Article 2, shall include the right to do or to authorize:

- (a) the permanent or temporary reproduction of a computer program by any means and in any form, in part or in whole. Insofar as loading, displaying, running, transmission or storage of the computer program necessitate such reproduction, such acts shall be subject to authorization by the rightholder;
- (b) the translation, adaptation, arrangement and any other alteration of a computer program and the reproduction of the results thereof, without prejudice to the rights of the person who alters the program;
- (c) any form of distribution to the public, including the rental, of the original computer program or of copies thereof. The first sale in the Community of a copy of a program by the rightholder or with his consent shall exhaust the distribution right within the Community of that copy, with the exception of the right to control further rental of the program or a copy thereof.

Article 5 Exceptions to the restricted acts

1. In the absence of specific contractual provisions, the acts referred to in Article 4 (a) and (b) shall not require authorization by the rightholder where they are necessary for the use of the computer program by the lawful acquirer in accordance with its intended purpose, including for error correction.
2. The making of a back-up copy by a person having a right to use the computer program may not be prevented by contract insofar as it is necessary for that use.
3. The person having a right to use a copy of a computer program shall be entitled, without the authorization of the rightholder, to observe, study or test the functioning of the program in order to determine the ideas and principles which underlie any element of the program if he does so while performing any of the acts of loading, displaying, running, transmitting or storing the program which he is entitled to do.

Article 6 Decompilation

1. The authorization of the rightholder shall not be required where reproduction of the code and translation of its form within the meaning of Article 4 (a) and (b) are indispensable to obtain the information necessary to achieve the interoperability of an independently created computer program with other programs, provided that the following conditions are met:

- (a) these acts are performed by the licensee or by another person having a right to use a copy of a program, or on their behalf by a person authorized to do so;
- (b) the information necessary to achieve interoperability has not previously been readily available to the persons referred to in subparagraph (a); and (c) these acts are confined to the parts of the original program which are necessary to achieve interoperability.

2. The provisions of paragraph 1 shall not permit the information obtained through its application:

- (a) to be used for goals other than to achieve the interoperability of the independently created computer program;
- (b) to be given to others, except when necessary for the interoperability of the independently created computer program; or (c) to be used for the development, production or marketing of a computer program substantially similar in its expression, or for any other act which infringes copyright.

3. In accordance with the provisions of the Berne Convention for the protection of Literary and Artistic Works, the provisions of this Article may not be interpreted in such a way as to allow its application to be used in a manner which unreasonably prejudices the right holder's legitimate interests or conflicts with a normal exploitation of the computer program.

Article 7 Special measures of protection

1. Without prejudice to the provisions of Articles 4, 5 and 6, Member States shall provide, in accordance with their national legislation, appropriate remedies against a person committing any of the acts listed in subparagraphs (a), (b) and (c) below:

- (a) any act of putting into circulation a copy of a computer program knowing, or having reason to believe, that it is an infringing copy;
- (b) the possession, for commercial purposes, of a copy of a computer program knowing, or having reason to believe, that it is an infringing copy;
- (c) any act of putting into circulation, or the possession for commercial purposes of, any means the sole intended purpose of which is to facilitate the unauthorized removal or circumvention of any technical device which may have been applied to protect a computer program.

2. Any infringing copy of a computer program shall be liable to seizure in accordance with the legislation of the Member State concerned.

3. Member States may provide for the seizure of any means referred to in paragraph 1 (c).

Article 8 Term of protection

1. Protection shall be granted for the life of the author and for fifty years after his death or after the death of the last surviving author; where the computer program is an anonymous or pseudonymous work, or where a legal person is designated as the author by national legislation in accordance with Article 2 (1), the term of protection shall be fifty years from the time that the computer program is first lawfully made available to the public. The term of protection shall be deemed to begin on the first of January of the year following the abovementioned events.

2. Member States which already have a term of protection longer than that provided for in paragraph 1 are allowed to maintain their present term until such time as the term of protection for copyright works is harmonized by Community law in a more general way.

Article 9 Continued application of other legal provisions

1. The provisions of this Directive shall be without prejudice to any other legal provisions such as those concerning patent rights, trade-marks, unfair competition, trade secrets, protection of semi-conductor products or the law of contract. Any contractual provisions contrary to Article 6 or to the exceptions provided for in Article 5 (2) and (3) shall be null and void.

2. The provisions of this Directive shall apply also to programs created before 1 January 1993 without prejudice to any acts concluded and rights acquired before that date.

Article 10 Final provisions

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive before 1 January 1993.

When Member States adopt these measures, the latter shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such a reference shall be laid down by the Member States.

2. Member States shall communicate to the Commission the provisions of national law which they

adopt in the field governed by this Directive.

Article 11

This Directive is addressed to the Member States.

Done at Brussels, 14 May 1991. For the Council The President J. F. POOS

(1) OJ No C 91, 12. 4. 1989, p. 4; and OJ No C 320, 20. 12. 1990, p. 22.

(2) No C 231, 17. 9. 1990, p. 78; and Decision of 17 April 1991. yet published in the Official Journal).

(3) OJ No C 329, 30. 12. 1989, p. 4.

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BE01/;1/8/07/1994 PT01/;21/11/1994 PT02/;1/1/05/1995 LU01/;2/6/04/1995
AU01/;26/04/1995 AU02/;2/6/04/1995 FI01/;2/6/04/1995 FI02/;26/04/1995
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DE01/;2/0/04/1993 GR01/;1/0/02/1994 ES01/;10/06/1994 FR01/;1/0/08/1994
BE01/;1/8/07/1994 PT01/;21/11/1994 PT02/;1/1/05/1995 LU01/;2/6/04/1995
AU01/;26/04/1995 AU02/;2/6/04/1995 FI01/;2/6/04/1995 FI02/;26/04/1995
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**2000/278/EC: Council Decision
of 16 March 2000**

**on the approval, on behalf of the European Community, of the WIPO Copyright Treaty and the
WIPO Performances and Phonograms Treaty**

Council Decision

of 16 March 2000

on the approval, on behalf of the European Community, of the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty(1)

(2000/278/EC)

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Articles 47(2), 55 and 95 thereof, in conjunction with the first sentence of Article 300(2) and the second subparagraph of Article 300(3),

Having regard to the proposal from the Commission(2),

Having regard to the assent of the European Parliament(3),

Whereas:

- (1) The WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT) adopted in Geneva on 20 December 1996 under the auspices of the World Intellectual Property Organisation will help to ensure a balanced level of protection for works and other subject matter, while allowing the public access to material available via networks.
- (2) The competence of the Community to conclude or accede to international agreements or treaties does not derive only from explicit conferral by the Treaty but may also derive from other provisions of the Treaty and from acts adopted pursuant to those provisions by Community institutions.
- (3) The subject matter of the WCT and the WPPT falls to a large extent within the scope of existing Community directives in this field.
- (4) It follows that the approval of the WCT and the WPPT is a matter for both the Community and its Member States.
- (5) The WCT and the WPPT should therefore be approved on behalf of the Community with regard to matters within its competence.
- (6) The Community has already signed the WCT and the WPPT, subject to final conclusion.
- (7) The deposit of the instruments of conclusion of the Community should take place as far as possible simultaneously with the deposit of the instruments of ratification of the Member States,

HAS DECIDED AS FOLLOWS:

Article 1

1. The WIPO Copyright Treaty (WCT) is hereby approved on behalf of the Community with regard to matters within its competence.
2. The WIPO Performances and Phonograms Treaty (WPPT) is hereby approved on behalf of the Community with regard to matters within its competence.

3. The texts of the Treaties are attached to this Decision.

Article 2

The President of the Council is hereby authorised to deposit the instruments of conclusion with the Director-General of the World Intellectual Property Organisation as from the date by which the Member States will have to bring into force the measures adopted by the European Parliament and the Council necessary to adapt the existing Community legislation to the obligations deriving from the WCT and the WPPT.

Article 3

1. The Commission is hereby authorised to represent the Community at the meetings of the Assemblies referred to in the WCT and WPPT.

2. On all matters within the sphere of competence of the Community, the Commission shall negotiate in the Assemblies of the WCT and the WPPT on behalf of the Community in accordance with the applicable rules of the EC Treaty, in particular Article 300 thereof.

3. The position which the Community may adopt within the Assemblies shall be prepared by the relevant Council working party.

Done at Brussels, 16 March 2000.

For the Council

The President

F. Seixas da Costa

(1) Two statements relating to this Decision are set out in OJ C 103, 11.4.2000, page 1.

(2) OJ C 165, 30.5.1998, p. 8.

(3) Assent of 16 February 2000 (not yet published in the Official Journal).

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Berne Convention for the Protection of Literary and Artistic Works

Paris Act
of July 24, 1971,
as amended on
September 28, 1979

Berne Convention for the Protection of Literary and Artistic Works

of September 9, 1886,
completed at PARIS on May 4, 1896,
revised at BERLIN on November 13, 1908,
completed at BERNE on March 20, 1914,
revised at ROME on June 2, 1928,
at BRUSSELS on June 26, 1948,
at STOCKHOLM on July 14, 1967,
and at PARIS on July 24, 1971,
and amended on September 28, 1979

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The countries of the Union, being equally animated by the desire to protect, in as effective and uniform a manner as possible, the rights of authors in their literary and artistic works,

Recognizing the importance of the work of the Revision Conference held at Stockholm in 1967,

Have resolved to revise the Act adopted by the Stockholm Conference, while maintaining without change Articles 1 to 20 and 22 to 26 of that Act.

Consequently, the undersigned Plenipotentiaries, having presented their full powers, recognized as in good and due form, have agreed as follows:

Article 1

*[Establishment of a Union]*¹

The countries to which this Convention applies constitute a Union for the protection of the rights of authors in their literary and artistic works.

Article 2

[Protected Works: 1. “Literary and artistic works”; 2. Possible requirement of fixation; 3. Derivative works; 4. Official texts; 5. Collections; 6. Obligation to protect; beneficiaries of protection; 7. Works of applied art and industrial designs; 8. News]

(1) The expression “literary and artistic works” shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico-musical works; choreographic works and entertainments in dumb show; musical compositions with or without words; cinematographic works to which are assimilated works expressed by a process analogous to cinematography; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works to which are assimilated works expressed by a process analogous to photography; works of applied art; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.

(2) It shall, however, be a matter for legislation in the countries of the Union to prescribe that works in general or any specified categories of works shall not be protected unless they have been fixed in some material form.

(3) Translations, adaptations, arrangements of music and other alterations of a literary or artistic work shall be protected as original works without prejudice to the copyright in the original work.

(4) It shall be a matter for legislation in the countries of the Union to determine the protection to be granted to official texts of a legislative, administrative and legal nature, and to official translations of such texts.

(5) Collections of literary or artistic works such as encyclopaedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations shall be protected as such, without prejudice to the copyright in each of the works forming part of such collections.

¹ Each Article and the Appendix have been given titles to facilitate their identification. There are no titles in the signed (English) text.

(6) The works mentioned in this Article shall enjoy protection in all countries of the Union. This protection shall operate for the benefit of the author and his successors in title.

(7) Subject to the provisions of Article 7(4) of this Convention, it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected. Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works.

(8) The protection of this Convention shall not apply to news of the day or to miscellaneous facts having the character of mere items of press information.

Article 2^{bis}

[Possible Limitation of Protection of Certain Works: 1. Certain speeches; 2. Certain uses of lectures and addresses; 3. Right to make collections of such works]

(1) It shall be a matter for legislation in the countries of the Union to exclude, wholly or in part, from the protection provided by the preceding Article political speeches and speeches delivered in the course of legal proceedings.

(2) It shall also be a matter for legislation in the countries of the Union to determine the conditions under which lectures, addresses and other works of the same nature which are delivered in public may be reproduced by the press, broadcast, communicated to the public by wire and made the subject of public communication as envisaged in Article 11^{bis}(1) of this Convention, when such use is justified by the informatory purpose.

(3) Nevertheless, the author shall enjoy the exclusive right of making a collection of his works mentioned in the preceding paragraphs.

Article 3

[Criteria of Eligibility for Protection: 1. Nationality of author; place of publication of work; 2. Residence of author; 3. "Published" works; 4. "Simultaneously published" works]

(1) The protection of this Convention shall apply to:

- (a) authors who are nationals of one of the countries of the Union, for their works, whether published or not;
- (b) authors who are not nationals of one of the countries of the Union, for their works first published in one of those countries, or simultaneously in a country outside the Union and in a country of the Union.

(2) Authors who are not nationals of one of the countries of the Union but who have their habitual residence in one of them shall, for the purposes of this Convention, be assimilated to nationals of that country.

(3) The expression "published works" means works published with the consent of their authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work. The performance of a dramatic, dramatico-musical, cinematographic or musical work, the public recitation of a literary work, the communication by wire or the broadcasting of literary or artistic works, the exhibition of a work of art and the construction of a work of architecture shall not constitute publication.

(4) A work shall be considered as having been published simultaneously in several countries if it has been published in two or more countries within thirty days of its first publication.

Article 4

[Criteria of Eligibility for Protection of Cinematographic Works, Works of Architecture and Certain Artistic Works]

The protection of this Convention shall apply, even if the conditions of Article 3 are not fulfilled, to:

- (a) authors of cinematographic works the maker of which has his headquarters or habitual residence in one of the countries of the Union;
- (b) authors of works of architecture erected in a country of the Union or of other artistic works incorporated in a building or other structure located in a country of the Union.

Article 5

[Rights Guaranteed: 1. and 2. Outside the country of origin; 3. In the country of origin; 4. "Country of origin"]

(1) Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.

(2) The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work. Consequently, apart from the provisions of this Convention, the extent of protection, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where protection is claimed.

(3) Protection in the country of origin is governed by domestic law. However, when the author is not a national of the country of origin of the work for which he is protected under this Convention, he shall enjoy in that country the same rights as national authors.

(4) The country of origin shall be considered to be:

- (a) in the case of works first published in a country of the Union, that country; in the case of works published simultaneously in several countries of the Union which grant different terms of protection, the country whose legislation grants the shortest term of protection;
- (b) in the case of works published simultaneously in a country outside the Union and in a country of the Union, the latter country;
- (c) in the case of unpublished works or of works first published in a country outside the Union, without simultaneous publication in a country of the Union, the country of the Union of which the author is a national, provided that:
 - (i) when these are cinematographic works the maker of which has his headquarters or his habitual residence in a country of the Union, the country of origin shall be that country, and
 - (ii) when these are works of architecture erected in a country of the Union or other artistic works incorporated in a building or other structure located in a country of the Union, the country of origin shall be that country.

Article 6

[Possible Restriction of Protection in Respect of Certain Works of Nationals of Certain Countries Outside the Union: 1. In the country of the first publication and in other countries; 2. No retroactivity; 3. Notice]

(1) Where any country outside the Union fails to protect in an adequate manner the works of authors who are nationals of one of the countries of the Union, the latter country may restrict the protection given to the works of authors who are, at the date of the first publication thereof, nationals of the other country and are not habitually resident in one of the countries of the Union. If the country of first publication avails itself of this right, the other countries of the Union shall not be required to grant to works thus subjected to special treatment a wider protection than that granted to them in the country of first publication.

(2) No restrictions introduced by virtue of the preceding paragraph shall affect the rights which an author may have acquired in respect of a work published in a country of the Union before such restrictions were put into force.

(3) The countries of the Union which restrict the grant of copyright in accordance with this Article shall give notice thereof to the Director General of the World Intellectual Property Organization (hereinafter designated as “the Director General”) by a written declaration specifying the countries in regard to which protection is restricted, and the restrictions to which rights of authors who are nationals of those countries are subjected. The Director General shall immediately communicate this declaration to all the countries of the Union.

Article 6^{bis}

[*Moral Rights*: 1. To claim authorship; to object to certain modifications and other derogatory actions; 2. After the author’s death; 3. Means of redress]

(1) Independently of the author’s economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.

(2) The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed. However, those countries whose legislation, at the moment of their ratification of or accession to this Act, does not provide for the protection after the death of the author of all the rights set out in the preceding paragraph may provide that some of these rights may, after his death, cease to be maintained.

(3) The means of redress for safeguarding the rights granted by this Article shall be governed by the legislation of the country where protection is claimed.

Article 7

[*Term of Protection*: 1. Generally; 2. For cinematographic works; 3. For anonymous and pseudonymous works; 4. For photographic works and works of applied art; 5. Starting date of computation; 6. Longer terms; 7. Shorter terms; 8. Applicable law; “comparison” of terms]

(1) The term of protection granted by this Convention shall be the life of the author and fifty years after his death.

(2) However, in the case of cinematographic works, the countries of the Union may provide that the term of protection shall expire fifty years after the work has been made available to the public with the consent of the author, or, failing such an event within fifty years from the making of such a work, fifty years after the making.

(3) In the case of anonymous or pseudonymous works, the term of protection granted by this Convention shall expire fifty years after the work has been lawfully made available to the public. However, when the pseudonym adopted by the author leaves no doubt as to his identity, the term of protection shall be that provided in paragraph (1). If the author of an anonymous or pseudonymous work discloses his identity during the above-mentioned period, the term of protection applicable shall be that provided in paragraph (1). The countries of the Union shall not be required to protect anonymous or pseudonymous works in respect of which it is reasonable to presume that their author has been dead for fifty years.

(4) It shall be a matter for legislation in the countries of the Union to determine the term of protection of photographic works and that of works of applied art in so far as they are protected as artistic works; however, this term shall last at least until the end of a period of twenty-five years from the making of such a work.

(5) The term of protection subsequent to the death of the author and the terms provided by paragraphs (2), (3) and (4) shall run from the date of death or of the event referred to in those paragraphs, but such terms shall always be deemed to begin on the first of January of the year following the death or such event.

(6) The countries of the Union may grant a term of protection in excess of those provided by the preceding paragraphs.

(7) Those countries of the Union bound by the Rome Act of this Convention which grant, in their national legislation in force at the time of signature of the present Act, shorter terms of protection than those provided for in the preceding paragraphs shall have the right to maintain such terms when ratifying or acceding to the present Act.

(8) In any case, the term shall be governed by the legislation of the country where protection is claimed; however, unless the legislation of that country otherwise provides, the term shall not exceed the term fixed in the country of origin of the work.

Article 7^{bis}

[Term of Protection for Works of Joint Authorship]

The provisions of the preceding Article shall also apply in the case of a work of joint authorship, provided that the terms measured from the death of the author shall be calculated from the death of the last surviving author.

Article 8

[Right of Translation]

Authors of literary and artistic works protected by this Convention shall enjoy the exclusive right of making and of authorizing the translation of their works throughout the term of protection of their rights in the original works.

Article 9

[Right of Reproduction: 1. Generally; 2. Possible exceptions; 3. Sound and visual recordings]

(1) Authors of literary and artistic works protected by this Convention shall have the exclusive right of authorizing the reproduction of these works, in any manner or form.

(2) It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.

(3) Any sound or visual recording shall be considered as a reproduction for the purposes of this Convention.

Article 10

[Certain Free Uses of Works: 1. Quotations; 2. Illustrations for teaching; 3. Indication of source and author]

(1) It shall be permissible to make quotations from a work which has already been lawfully made available to the public, provided that their making is compatible with fair practice, and their extent does not exceed that justified by the purpose, including quotations from newspaper articles and periodicals in the form of press summaries.

(2) It shall be a matter for legislation in the countries of the Union, and for special agreements existing or to be concluded between them, to permit the utilization, to the extent justified by the purpose, of literary or artistic works by way of illustration in publications, broadcasts or sound or visual recordings for teaching, provided such utilization is compatible with fair practice.

(3) Where use is made of works in accordance with the preceding paragraphs of this Article, mention shall be made of the source, and of the name of the author if it appears thereon.

Article 10^{bis}

[*Further Possible Free Uses of Works*: 1. Of certain articles and broadcast works; 2. Of works seen or heard in connection with current events]

(1) It shall be a matter for legislation in the countries of the Union to permit the reproduction by the press, the broadcasting or the communication to the public by wire of articles published in newspapers or periodicals on current economic, political or religious topics, and of broadcast works of the same character, in cases in which the reproduction, broadcasting or such communication thereof is not expressly reserved. Nevertheless, the source must always be clearly indicated; the legal consequences of a breach of this obligation shall be determined by the legislation of the country where protection is claimed.

(2) It shall also be a matter for legislation in the countries of the Union to determine the conditions under which, for the purpose of reporting current events by means of photography, cinematography, broadcasting or communication to the public by wire, literary or artistic works seen or heard in the course of the event may, to the extent justified by the informatory purpose, be reproduced and made available to the public.

Article 11

[*Certain Rights in Dramatic and Musical Works*: 1. Right of public performance and of communication to the public of a performance; 2. In respect of translations]

(1) Authors of dramatic, dramatico-musical and musical works shall enjoy the exclusive right of authorizing:

- (i) the public performance of their works, including such public performance by any means or process;
- (ii) any communication to the public of the performance of their works.

(2) Authors of dramatic or dramatico-musical works shall enjoy, during the full term of their rights in the original works, the same rights with respect to translations thereof.

Article 11^{bis}

[*Broadcasting and Related Rights*: 1. Broadcasting and other wireless communications, public communication of broadcast by wire or rebroadcast, public communication of broadcast by loudspeaker or analogous instruments; 2. Compulsory licenses; 3. Recording; ephemeral recordings]

(1) Authors of literary and artistic works shall enjoy the exclusive right of authorizing:

- (i) the broadcasting of their works or the communication thereof to the public by any other means of wireless diffusion of signs, sounds or images;
- (ii) any communication to the public by wire or by rebroadcasting of the broadcast of the work, when this communication is made by an organization other than the original one;
- (iii) the public communication by loudspeaker or any other analogous instrument transmitting, by signs, sounds or images, the broadcast of the work.

(2) It shall be a matter for legislation in the countries of the Union to determine the conditions under which the rights mentioned in the preceding paragraph may be exercised, but these conditions shall apply only in the countries where they have been prescribed. They shall not in any circumstances be prejudicial to the moral rights of the author, nor to his right to obtain equitable remuneration which, in the absence of agreement, shall be fixed by competent authority.

(3) In the absence of any contrary stipulation, permission granted in accordance with paragraph (1) of this Article shall not imply permission to record, by means of instruments recording sounds or images, the work broadcast. It shall, however, be a matter for legislation in the countries of the Union to determine the regulations for ephemeral recordings made by a broadcasting organization by means of its own facilities and used for its own broadcasts. The preservation of these recordings in official archives may, on the ground of their exceptional documentary character, be authorized by such legislation.

Article 11^{ter}

[*Certain Rights in Literary Works*: 1. Right of public recitation and of communication to the public of a recitation; 2. In respect of translations]

- (1) Authors of literary works shall enjoy the exclusive right of authorizing:
 - (i) the public recitation of their works, including such public recitation by any means or process;
 - (ii) any communication to the public of the recitation of their works.
- (2) Authors of literary works shall enjoy, during the full term of their rights in the original works, the same rights with respect to translations thereof.

Article 12

[*Right of Adaptation, Arrangement and Other Alteration*]

Authors of literary or artistic works shall enjoy the exclusive right of authorizing adaptations, arrangements and other alterations of their works.

Article 13

[*Possible Limitation of the Right of Recording of Musical Works and Any Words Pertaining Thereto*:

1. Compulsory licenses; 2. Transitory measures; 3. Seizure on importation of copies made without the author's permission]

(1) Each country of the Union may impose for itself reservations and conditions on the exclusive right granted to the author of a musical work and to the author of any words, the recording of which together with the musical work has already been authorized by the latter, to authorize the sound recording of that musical work, together with such words, if any; but all such reservations and conditions shall apply only in the countries which have imposed them and shall not, in any circumstances, be prejudicial to the rights of these authors to obtain equitable remuneration which, in the absence of agreement, shall be fixed by competent authority.

(2) Recordings of musical works made in a country of the Union in accordance with Article 13(3) of the Conventions signed at Rome on June 2, 1928, and at Brussels on June 26, 1948, may be reproduced in that country without the permission of the author of the musical work until a date two years after that country becomes bound by this Act.

(3) Recordings made in accordance with paragraphs (1) and (2) of this Article and imported without permission from the parties concerned into a country where they are treated as infringing recordings shall be liable to seizure.

Article 14

[*Cinematographic and Related Rights*: 1. Cinematographic adaptation and reproduction; distribution; public performance and public communication by wire of works thus adapted or reproduced; 2. Adaptation of cinematographic productions; 3. No compulsory licenses]

- (1) Authors of literary or artistic works shall have the exclusive right of authorizing:
 - (i) the cinematographic adaptation and reproduction of these works, and the distribution of the works thus adapted or reproduced;
 - (ii) the public performance and communication to the public by wire of the works thus adapted or reproduced.
- (2) The adaptation into any other artistic form of a cinematographic production derived from literary or artistic works shall, without prejudice to the authorization of the author of the cinematographic production, remain subject to the authorization of the authors of the original works.
- (3) The provisions of Article 13(1) shall not apply.

Article 14^{bis}

[*Special Provisions Concerning Cinematographic Works*: 1. Assimilation to “original” works; 2. Ownership; limitation of certain rights of certain contributors; 3. Certain other contributors]

(1) Without prejudice to the copyright in any work which may have been adapted or reproduced, a cinematographic work shall be protected as an original work. The owner of copyright in a cinematographic work shall enjoy the same rights as the author of an original work, including the rights referred to in the preceding Article.

(2)

(a) Ownership of copyright in a cinematographic work shall be a matter for legislation in the country where protection is claimed.

(b) However, in the countries of the Union which, by legislation, include among the owners of copyright in a cinematographic work authors who have brought contributions to the making of the work, such authors, if they have undertaken to bring such contributions, may not, in the absence of any contrary or special stipulation, object to the reproduction, distribution, public performance, communication to the public by wire, broadcasting or any other communication to the public, or to the subtitling or dubbing of texts, of the work.

(c) The question whether or not the form of the undertaking referred to above should, for the application of the preceding subparagraph (b), be in a written agreement or a written act of the same effect shall be a matter for the legislation of the country where the maker of the cinematographic work has his headquarters or habitual residence. However, it shall be a matter for the legislation of the country of the Union where protection is claimed to provide that the said undertaking shall be in a written agreement or a written act of the same effect. The countries whose legislation so provides shall notify the Director General by means of a written declaration, which will be immediately communicated by him to all the other countries of the Union.

(d) By “contrary or special stipulation” is meant any restrictive condition which is relevant to the aforesaid undertaking.

(3) Unless the national legislation provides to the contrary, the provisions of paragraph (2)(b) above shall not be applicable to authors of scenarios, dialogues and musical works created for the making of the cinematographic work, or to the principal director thereof. However, those countries of the Union whose legislation does not contain rules providing for the application of the said paragraph (2)(b) to such director shall notify the Director General by means of a written declaration, which will be immediately communicated by him to all the other countries of the Union.

Article 14^{ter}

[*“Droit de suite” in Works of Art and Manuscripts*:

1. Right to an interest in resales; 2. Applicable law; 3. Procedure]

(1) The author, or after his death the persons or institutions authorized by national legislation, shall, with respect to original works of art and original manuscripts of writers and composers, enjoy the inalienable right to an interest in any sale of the work subsequent to the first transfer by the author of the work.

(2) The protection provided by the preceding paragraph may be claimed in a country of the Union only if legislation in the country to which the author belongs so permits, and to the extent permitted by the country where this protection is claimed.

(3) The procedure for collection and the amounts shall be matters for determination by national legislation.

Article 15

[*Right to Enforce Protected Rights:* 1. Where author's name is indicated or where pseudonym leaves no doubt as to author's identity; 2. In the case of cinematographic works; 3. In the case of anonymous and pseudonymous works; 4. In the case of certain unpublished works of unknown authorship]

(1) In order that the author of a literary or artistic work protected by this Convention shall, in the absence of proof to the contrary, be regarded as such, and consequently be entitled to institute infringement proceedings in the countries of the Union, it shall be sufficient for his name to appear on the work in the usual manner. This paragraph shall be applicable even if this name is a pseudonym, where the pseudonym adopted by the author leaves no doubt as to his identity.

(2) The person or body corporate whose name appears on a cinematographic work in the usual manner shall, in the absence of proof to the contrary, be presumed to be the maker of the said work.

(3) In the case of anonymous and pseudonymous works, other than those referred to in paragraph (1) above, the publisher whose name appears on the work shall, in the absence of proof to the contrary, be deemed to represent the author, and in this capacity he shall be entitled to protect and enforce the author's rights. The provisions of this paragraph shall cease to apply when the author reveals his identity and establishes his claim to authorship of the work.

(4)

(a) In the case of unpublished works where the identity of the author is unknown, but where there is every ground to presume that he is a national of a country of the Union, it shall be a matter for legislation in that country to designate the competent authority which shall represent the author and shall be entitled to protect and enforce his rights in the countries of the Union.

(b) Countries of the Union which make such designation under the terms of this provision shall notify the Director General by means of a written declaration giving full information concerning the authority thus designated. The Director General shall at once communicate this declaration to all other countries of the Union.

Article 16

[*Infringing Copies:* 1. Seizure; 2. Seizure on importation; 3. Applicable law]

(1) Infringing copies of a work shall be liable to seizure in any country of the Union where the work enjoys legal protection.

(2) The provisions of the preceding paragraph shall also apply to reproductions coming from a country where the work is not protected, or has ceased to be protected.

(3) The seizure shall take place in accordance with the legislation of each country.

Article 17

[*Possibility of Control of Circulation, Presentation and Exhibition of Works*]

The provisions of this Convention cannot in any way affect the right of the Government of each country of the Union to permit, to control, or to prohibit, by legislation or regulation, the circulation, presentation, or exhibition of any work or production in regard to which the competent authority may find it necessary to exercise that right.

Article 18

[*Works Existing on Convention's Entry Into Force:* 1. Protectable where protection not yet expired in country of origin; 2. Non-protectable where protection already expired in country where it is claimed; 3. Application of these principles; 4. Special cases]

(1) This Convention shall apply to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection.

(2) If, however, through the expiry of the term of protection which was previously granted, a work has fallen into the public domain of the country where protection is claimed, that work shall not be protected anew.

(3) The application of this principle shall be subject to any provisions contained in special conventions to that effect existing or to be concluded between countries of the Union. In the absence of such provisions, the respective countries shall determine, each in so far as it is concerned, the conditions of application of this principle.

(4) The preceding provisions shall also apply in the case of new accessions to the Union and to cases in which protection is extended by the application of Article 7 or by the abandonment of reservations.

Article 19

[Protection Greater than Resulting from Convention]

The provisions of this Convention shall not preclude the making of a claim to the benefit of any greater protection which may be granted by legislation in a country of the Union.

Article 20

[Special Agreements Among Countries of the Union]

The Governments of the countries of the Union reserve the right to enter into special agreements among themselves, in so far as such agreements grant to authors more extensive rights than those granted by the Convention, or contain other provisions not contrary to this Convention. The provisions of existing agreements which satisfy these conditions shall remain applicable.

Article 21

[Special Provisions Regarding Developing Countries: 1. Reference to Appendix; 2. Appendix part of Act]

- (1) Special provisions regarding developing countries are included in the Appendix.
- (2) Subject to the provisions of Article 28(1)(b), the Appendix forms an integral part of this Act.

Article 22

[Assembly: 1. Constitution and composition; 2. Tasks; 3. Quorum, voting, observers; 4. Convocation; 5. Rules of procedure]

- (1)
 - (a) The Union shall have an Assembly consisting of those countries of the Union which are bound by Articles 22 to 26.
 - (b) The Government of each country shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.
 - (c) The expenses of each delegation shall be borne by the Government which has appointed it.
- (2)
 - (a) The Assembly shall:
 - (i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Convention;
 - (ii) give directions concerning the preparation for conferences of revision to the International Bureau of Intellectual Property (hereinafter designated as "the International Bureau") referred to in the Convention Establishing the World Intellectual Property Organization (hereinafter designated as "the Organization"), due account being taken of any comments made by those countries of the Union which are not bound by Articles 22 to 26;

- (iii) review and approve the reports and activities of the Director General of the Organization concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union;
- (iv) elect the members of the Executive Committee of the Assembly;
- (v) review and approve the reports and activities of its Executive Committee, and give instructions to such Committee;
- (vi) determine the program and adopt the biennial budget of the Union, and approve its final accounts;
- (vii) adopt the financial regulations of the Union;
- (viii) establish such committees of experts and working groups as may be necessary for the work of the Union;
- (ix) determine which countries not members of the Union and which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;
- (x) adopt amendments to Articles 22 to 26;
- (xi) take any other appropriate action designed to further the objectives of the Union;
- (xii) exercise such other functions as are appropriate under this Convention;
- (xiii) subject to its acceptance, exercise such rights as are given to it in the Convention establishing the Organization.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3)

(a) Each country member of the Assembly shall have one vote.

(b) One-half of the countries members of the Assembly shall constitute a quorum.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of countries represented is less than one-half but equal to or more than one-third of the countries members of the Assembly, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the following conditions are fulfilled. The International Bureau shall communicate the said decisions to the countries members of the Assembly which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of countries having thus expressed their vote or abstention attains the number of countries which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Article 26(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(f) A delegate may represent, and vote in the name of, one country only.

(g) Countries of the Union not members of the Assembly shall be admitted to its meetings as observers.

(4)

(a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of the Executive Committee or at the request of one-fourth of the countries members of the Assembly.

(5) The Assembly shall adopt its own rules of procedure.

Article 23

[*Executive Committee*: 1. Constitution; 2. Composition; 3. Number of members; 4. Geographical distribution; special agreements; 5. Term, limits of re-eligibility, rules of election; 6. Tasks; 7. Convocation; 8. Quorum, voting; 9. Observers; 10. Rules of procedure]

(1) The Assembly shall have an Executive Committee.

(2)

(a) The Executive Committee shall consist of countries elected by the Assembly from among countries members of the Assembly. Furthermore, the country on whose territory the Organization has its headquarters shall, subject to the provisions of Article 25(7)(b), have an ex officio seat on the Committee.

(b) The Government of each country member of the Executive Committee shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it.

(3) The number of countries members of the Executive Committee shall correspond to one-fourth of the number of countries members of the Assembly. In establishing the number of seats to be filled, remainders after division by four shall be disregarded.

(4) In electing the members of the Executive Committee, the Assembly shall have due regard to an equitable geographical distribution and to the need for countries party to the Special Agreements which might be established in relation with the Union to be among the countries constituting the Executive Committee.

(5)

(a) Each member of the Executive Committee shall serve from the close of the session of the Assembly which elected it to the close of the next ordinary session of the Assembly.

(b) Members of the Executive Committee may be re-elected, but not more than two-thirds of them.

(c) The Assembly shall establish the details of the rules governing the election and possible re-election of the members of the Executive Committee.

(6)

(a) The Executive Committee shall:

(i) prepare the draft agenda of the Assembly;

(ii) submit proposals to the Assembly respecting the draft program and biennial budget of the Union prepared by the Director General;

(iii) *[deleted]*

(iv) submit, with appropriate comments, to the Assembly the periodical reports of the Director General and the yearly audit reports on the accounts;

(v) in accordance with the decisions of the Assembly and having regard to circumstances arising between two ordinary sessions of the Assembly, take all necessary measures to ensure the execution of the program of the Union by the Director General;

(vi) perform such other functions as are allocated to it under this Convention.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Executive Committee shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(7)

(a) The Executive Committee shall meet once a year in ordinary session upon convocation by the Director General, preferably during the same period and at the same place as the Coordination Committee of the Organization.

(b) The Executive Committee shall meet in extraordinary session upon convocation by the Director General, either on his own initiative, or at the request of its Chairman or one-fourth of its members.

(8)

(a) Each country member of the Executive Committee shall have one vote.

(b) One-half of the members of the Executive Committee shall constitute a quorum.

- (c) Decisions shall be made by a simple majority of the votes cast.
- (d) Abstentions shall not be considered as votes.
- (e) A delegate may represent, and vote in the name of, one country only.
- (9) Countries of the Union not members of the Executive Committee shall be admitted to its meetings as observers.
- (10) The Executive Committee shall adopt its own rules of procedure.

Article 24

[*International Bureau*: 1. Tasks in general, Director General; 2. General information; 3. Periodical; 4. Information to countries; 5. Studies and services; 6. Participation in meetings; 7. Conferences of revision; 8. Other tasks]

(1)

(a) The administrative tasks with respect to the Union shall be performed by the International Bureau, which is a continuation of the Bureau of the Union united with the Bureau of the Union established by the International Convention for the Protection of Industrial Property.

(b) In particular, the International Bureau shall provide the secretariat of the various organs of the Union.

(c) The Director General of the Organization shall be the chief executive of the Union and shall represent the Union.

(2) The International Bureau shall assemble and publish information concerning the protection of copyright. Each country of the Union shall promptly communicate to the International Bureau all new laws and official texts concerning the protection of copyright.

(3) The International Bureau shall publish a monthly periodical.

(4) The International Bureau shall, on request, furnish information to any country of the Union on matters concerning the protection of copyright.

(5) The International Bureau shall conduct studies, and shall provide services, designed to facilitate the protection of copyright.

(6) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the Executive Committee and any other committee of experts or working group. The Director General, or a staff member designated by him, shall be ex officio secretary of these bodies.

(7)

(a) The International Bureau shall, in accordance with the directions of the Assembly and in cooperation with the Executive Committee, make the preparations for the conferences of revision of the provisions of the Convention other than Articles 22 to 26.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at these conferences.

(8) The International Bureau shall carry out any other tasks assigned to it.

Article 25

[*Finances*: 1. Budget; 2. Coordination with other Unions; 3. Resources; 4. Contributions; possible extension of previous budget; 5. Fees and charges; 6. Working capital fund; 7. Advances by host Government; 8. Auditing of accounts]

(1)

(a) The Union shall have a budget.

(b) The budget of the Union shall include the income and expenses proper to the Union, its contribution to the budget of expenses common to the Unions, and, where applicable, the sum made available to the budget of the Conference of the Organization.

(c) Expenses not attributable exclusively to the Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Union in such common expenses shall be in proportion to the interest the Union has in them.

(2) The budget of the Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) The budget of the Union shall be financed from the following sources:

- (i) contributions of the countries of the Union;
- (ii) fees and charges due for services performed by the International Bureau in relation to the Union;
- (iii) sale of, or royalties on, the publications of the International Bureau concerning the Union;
- (iv) gifts, bequests, and subventions;
- (v) rents, interests, and other miscellaneous income.

(4)

(a) For the purpose of establishing its contribution towards the budget, each country of the Union shall belong to a class, and shall pay its annual contributions on the basis of a number of units fixed as follows:

Class I	25
Class II	20
Class III	15
Class IV	10
Class V	5
Class VI	3
Class VII	1

(b) Unless it has already done so, each country shall indicate, concurrently with depositing its instrument of ratification or accession, the class to which it wishes to belong. Any country may change class. If it chooses a lower class, the country must announce it to the Assembly at one of its ordinary sessions. Any such change shall take effect at the beginning of the calendar year following the session.

(c) The annual contribution of each country shall be an amount in the same proportion to the total sum to be contributed to the annual budget of the Union by all countries as the number of its units is to the total of the units of all contributing countries.

(d) Contributions shall become due on the first of January of each year.

(e) A country which is in arrears in the payment of its contributions shall have no vote in any of the organs of the Union of which it is a member if the amount of its arrears equals or exceeds the amount of the contributions due from it for the preceding two full years. However, any organ of the Union may allow such a country to continue to exercise its vote in that organ if, and as long as, it is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

(f) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, in accordance with the financial regulations.

(5) The amount of the fees and charges due for services rendered by the International Bureau in relation to the Union shall be established, and shall be reported to the Assembly and the Executive Committee, by the Director General.

(6)

(a) The Union shall have a working capital fund which shall be constituted by a single payment made by each country of the Union. If the fund becomes insufficient, an increase shall be decided by the Assembly.

(b) The amount of the initial payment of each country to the said fund or of its participation in the increase thereof shall be a proportion of the contribution of that country for the year in which the fund is established or the increase decided.

(c) The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(7)

(a) In the headquarters agreement concluded with the country on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such country shall grant advances. The amount of these advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such country and the Organization. As long as it remains under the obligation to grant advances, such country shall have an ex officio seat on the Executive Committee.

(b) The country referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(8) The auditing of the accounts shall be effected by one or more of the countries of the Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

Article 26

[Amendments: 1. Provisions susceptible of amendment by the Assembly; proposals; 2. Adoption; 3. Entry into force]

(1) Proposals for the amendment of Articles 22, 23, 24, 25, and the present Article, may be initiated by any country member of the Assembly, by the Executive Committee, or by the Director General. Such proposals shall be communicated by the Director General to the member countries of the Assembly at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment of Article 22, and of the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the countries members of the Assembly at the time it adopted the amendment. Any amendment to the said Articles thus accepted shall bind all the countries which are members of the Assembly at the time the amendment enters into force, or which become members thereof at a subsequent date, provided that any amendment increasing the financial obligations of countries of the Union shall bind only those countries which have notified their acceptance of such amendment.

Article 27

[Revision: 1. Objective; 2. Conferences; 3. Adoption]

(1) This Convention shall be submitted to revision with a view to the introduction of amendments designed to improve the system of the Union.

(2) For this purpose, conferences shall be held successively in one of the countries of the Union among the delegates of the said countries.

(3) Subject to the provisions of Article 26 which apply to the amendment of Articles 22 to 26, any revision of this Act, including the Appendix, shall require the unanimity of the votes cast.

Article 28

[Acceptance and Entry Into Force of Act for Countries of the Union: 1. Ratification, accession; possibility of excluding certain provisions; withdrawal of exclusion; 2. Entry into force of Articles 1 to 21 and Appendix; 3. Entry into force of Articles 22 to 38]

(1)

(a) Any country of the Union which has signed this Act may ratify it, and, if it has not signed it, may accede to it. Instruments of ratification or accession shall be deposited with the Director General.

(b) Any country of the Union may declare in its instrument of ratification or accession that its ratification or accession shall not apply to Articles 1 to 21 and the Appendix, provided that, if such country has previously made a declaration under Article VI(1) of the Appendix, then it may declare in the said instrument only that its ratification or accession shall not apply to Articles 1 to 20.

(c) Any country of the Union which, in accordance with subparagraph (b), has excluded provisions therein referred to from the effects of its ratification or accession may at any later time declare that it extends the effects of its ratification or accession to those provisions. Such declaration shall be deposited with the Director General.

(2)

(a) Articles 1 to 21 and the Appendix shall enter into force three months after both of the following two conditions are fulfilled:

- (i) at least five countries of the Union have ratified or acceded to this Act without making a declaration under paragraph (1)(b),
- (ii) France, Spain, the United Kingdom of Great Britain and Northern Ireland, and the United States of America, have become bound by the Universal Copyright Convention as revised at Paris on July 24, 1971.

(b) The entry into force referred to in subparagraph (a) shall apply to those countries of the Union which, at least three months before the said entry into force, have deposited instruments of ratification or accession not containing a declaration under paragraph (1)(b).

(c) With respect to any country of the Union not covered by subparagraph (b) and which ratifies or accedes to this Act without making a declaration under paragraph (1)(b), Articles 1 to 21 and the Appendix shall enter into force three months after the date on which the Director General has notified the deposit of the relevant instrument of ratification or accession, unless a subsequent date has been indicated in the instrument deposited. In the latter case, Articles 1 to 21 and the Appendix shall enter into force with respect to that country on the date thus indicated.

(d) The provisions of subparagraphs (a) to (c) do not affect the application of Article VI of the Appendix.

(3) With respect to any country of the Union which ratifies or accedes to this Act with or without a declaration made under paragraph (1)(b), Articles 22 to 38 shall enter into force three months after the date on which the Director General has notified the deposit of the relevant instrument of ratification or accession, unless a subsequent date has been indicated in the instrument deposited. In the latter case, Articles 22 to 38 shall enter into force with respect to that country on the date thus indicated.

Article 29

[Acceptance and Entry Into Force for Countries Outside the Union: 1. Accession; 2. Entry into force]

(1) Any country outside the Union may accede to this Act and thereby become party to this Convention and a member of the Union. Instruments of accession shall be deposited with the Director General.

(2)

(a) Subject to subparagraph (b), this Convention shall enter into force with respect to any country outside the Union three months after the date on which the Director General has notified the deposit of its instrument of accession, unless a subsequent date has been indicated in the instrument deposited. In the latter case, this Convention shall enter into force with respect to that country on the date thus indicated.

(b) If the entry into force according to subparagraph (a) precedes the entry into force of Articles 1 to 21 and the Appendix according to Article 28(2)(a), the said country shall, in the meantime, be bound, instead of by Articles 1 to 21 and the Appendix, by Articles 1 to 20 of the Brussels Act of this Convention.

Article 29^{bis}

[*Effect of Acceptance of Act for the Purposes of Article 14(2) of the WIPO Convention*]

Ratification of or accession to this Act by any country not bound by Articles 22 to 38 of the Stockholm Act of this Convention shall, for the sole purposes of Article 14(2) of the Convention establishing the Organization, amount to ratification of or accession to the said Stockholm Act with the limitation set forth in Article 28(1)(b)(i) thereof.

Article 30

[*Reservations: 1. Limits of possibility of making reservations; 2. Earlier reservations; reservation as to the right of translation; withdrawal of reservation*]

(1) Subject to the exceptions permitted by paragraph (2) of this Article, by Article 28(1)(b), by Article 33(2), and by the Appendix, ratification or accession shall automatically entail acceptance of all the provisions and admission to all the advantages of this Convention.

(2)

(a) Any country of the Union ratifying or acceding to this Act may, subject to Article V(2) of the Appendix, retain the benefit of the reservations it has previously formulated on condition that it makes a declaration to that effect at the time of the deposit of its instrument of ratification or accession.

(b) Any country outside the Union may declare, in acceding to this Convention and subject to Article V(2) of the Appendix, that it intends to substitute, temporarily at least, for Article 8 of this Act concerning the right of translation, the provisions of Article 5 of the Union Convention of 1886, as completed at Paris in 1896, on the clear understanding that the said provisions are applicable only to translations into a language in general use in the said country. Subject to Article I(6)(b) of the Appendix, any country has the right to apply, in relation to the right of translation of works whose country of origin is a country availing itself of such a reservation, a protection which is equivalent to the protection granted by the latter country.

(c) Any country may withdraw such reservations at any time by notification addressed to the Director General.

Article 31

[*Applicability to Certain Territories: 1. Declaration; 2. Withdrawal of declaration; 3. Effective date; 4. Acceptance of factual situations not implied*]

(1) Any country may declare in its instrument of ratification or accession, or may inform the Director General by written notification at any time thereafter, that this Convention shall be applicable to all or part of those territories, designated in the declaration or notification, for the external relations of which it is responsible.

(2) Any country which has made such a declaration or given such a notification may, at any time, notify the Director General that this Convention shall cease to be applicable to all or part of such territories.

(3)

(a) Any declaration made under paragraph (1) shall take effect on the same date as the ratification or accession in which it was included, and any notification given under that paragraph shall take effect three months after its notification by the Director General.

(b) Any notification given under paragraph (2) shall take effect twelve months after its receipt by the Director General.

(4) This Article shall in no way be understood as implying the recognition or tacit acceptance by a country of the Union of the factual situation concerning a territory to which this Convention is made applicable by another country of the Union by virtue of a declaration under paragraph (1).

Article 32

[*Applicability of this Act and of Earlier Acts:* 1. As between countries already members of the Union; 2. As between a country becoming a member of the Union and other countries members of the Union;
3. Applicability of the Appendix in Certain Relations]

(1) This Act shall, as regards relations between the countries of the Union, and to the extent that it applies, replace the Berne Convention of September 9, 1886, and the subsequent Acts of revision. The Acts previously in force shall continue to be applicable, in their entirety or to the extent that this Act does not replace them by virtue of the preceding sentence, in relations with countries of the Union which do not ratify or accede to this Act.

(2) Countries outside the Union which become party to this Act shall, subject to paragraph (3), apply it with respect to any country of the Union not bound by this Act or which, although bound by this Act, has made a declaration pursuant to Article 28(1)(b). Such countries recognize that the said country of the Union, in its relations with them:

- (i) may apply the provisions of the most recent Act by which it is bound, and
- (ii) subject to Article I(6) of the Appendix, has the right to adapt the protection to the level provided for by this Act.

(3) Any country which has availed itself of any of the faculties provided for in the Appendix may apply the provisions of the Appendix relating to the faculty or faculties of which it has availed itself in its relations with any other country of the Union which is not bound by this Act, provided that the latter country has accepted the application of the said provisions.

Article 33

[*Disputes:* 1. Jurisdiction of the International Court of Justice; 2. Reservation as to such jurisdiction; 3. Withdrawal of reservation]

(1) Any dispute between two or more countries of the Union concerning the interpretation or application of this Convention, not settled by negotiation, may, by any one of the countries concerned, be brought before the International Court of Justice by application in conformity with the Statute of the Court, unless the countries concerned agree on some other method of settlement. The country bringing the dispute before the Court shall inform the International Bureau; the International Bureau shall bring the matter to the attention of the other countries of the Union.

(2) Each country may, at the time it signs this Act or deposits its instrument of ratification or accession, declare that it does not consider itself bound by the provisions of paragraph (1). With regard to any dispute between such country and any other country of the Union, the provisions of paragraph (1) shall not apply.

(3) Any country having made a declaration in accordance with the provisions of paragraph (2) may, at any time, withdraw its declaration by notification addressed to the Director General.

Article 34

[*Closing of Certain Earlier Provisions:* 1. Of earlier Acts; 2. Of the Protocol to the Stockholm Act]

(1) Subject to Article 29^{bis} no country may ratify or accede to earlier Acts of this Convention once Articles 1 to 21 and the Appendix have entered into force.

(2) Once Articles 1 to 21 and the Appendix have entered into force, no country may make a declaration under Article 5 of the Protocol Regarding Developing Countries attached to the Stockholm Act.

Article 35

[*Duration of the Convention; Denunciation:* 1. Unlimited duration; 2. Possibility of denunciation;
3. Effective date of denunciation; 4. Moratorium on denunciation]

(1) This Convention shall remain in force without limitation as to time.

(2) Any country may denounce this Act by notification addressed to the Director General. Such denunciation shall constitute also denunciation of all earlier Acts and shall affect only the country making it, the Convention remaining in full force and effect as regards the other countries of the Union.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided by this Article shall not be exercised by any country before the expiration of five years from the date upon which it becomes a member of the Union.

Article 36

[*Application of the Convention*: 1. Obligation to adopt the necessary measures; 2. Time from which obligation exists]

(1) Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.

(2) It is understood that, at the time a country becomes bound by this Convention, it will be in a position under its domestic law to give effect to the provisions of this Convention.

Article 37

[*Final Clauses*: 1. Languages of the Act; 2. Signature; 3. Certified copies; 4. Registration; 5. Notifications]

(1)

(a) This Act shall be signed in a single copy in the French and English languages and, subject to paragraph (2), shall be deposited with the Director General.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in the Arabic, German, Italian, Portuguese and Spanish languages, and such other languages as the Assembly may designate.

(c) In case of differences of opinion on the interpretation of the various texts, the French text shall prevail.

(2) This Act shall remain open for signature until January 31, 1972. Until that date, the copy referred to in paragraph (1)(a) shall be deposited with the Government of the French Republic.

(3) The Director General shall certify and transmit two copies of the signed text of this Act to the Governments of all countries of the Union and, on request, to the Government of any other country.

(4) The Director General shall register this Act with the Secretariat of the United Nations.

(5) The Director General shall notify the Governments of all countries of the Union of signatures, deposits of instruments of ratification or accession and any declarations included in such instruments or made pursuant to Articles 28(1)(c), 30(2)(a) and (b), and 33(2), entry into force of any provisions of this Act, notifications of denunciation, and notifications pursuant to Articles 30(2)(c), 31(1) and (2), 33(3), and 38(1), as well as the Appendix.

Article 38

[*Transitory Provisions*: 1. Exercise of the "five-year privilege"; 2. Bureau of the Union, Director of the Bureau; 3. Succession of Bureau of the Union]

(1) Countries of the Union which have not ratified or acceded to this Act and which are not bound by Articles 22 to 26 of the Stockholm Act of this Convention may, until April 26, 1975, exercise, if they so desire, the rights provided under the said Articles as if they were bound by them. Any country desiring to exercise such rights shall give written notification to this effect to the Director General; this notification shall be effective on the date of its receipt. Such countries shall be deemed to be members of the Assembly until the said date.



(2) As long as all the countries of the Union have not become Members of the Organization, the International Bureau of the Organization shall also function as the Bureau of the Union, and the Director General as the Director of the said Bureau.

(3) Once all the countries of the Union have become Members of the Organization, the rights, obligations, and property, of the Bureau of the Union shall devolve on the International Bureau of the Organization.

APPENDIX

[SPECIAL PROVISIONS REGARDING DEVELOPING COUNTRIES]

Article I

[*Faculties Open to Developing Countries*: 1. Availability of certain faculties; declaration: 2. Duration of effect of declaration, 3. Cessation of developing country status; 4. Existing stocks of copies; 5. Declarations concerning certain territories; 6. Limits of reciprocity]

(1) Any country regarded as a developing country in conformity with the established practice of the General Assembly of the United Nations which ratifies or accedes to this Act, of which this Appendix forms an integral part, and which, having regard to its economic situation and its social or cultural needs, does not consider itself immediately in a position to make provision for the protection of all the rights as provided for in this Act, may, by a notification deposited with the Director General at the time of depositing its instrument of ratification or accession or, subject to Article V(1)(c), at any time thereafter, declare that it will avail itself of the faculty provided for in Article II, or of the faculty provided for in Article III, or of both of those faculties. It may, instead of availing itself of the faculty provided for in Article II, make a declaration according to Article V(1)(a).

(2)

(a) Any declaration under paragraph (1) notified before the expiration of the period of ten years from the entry into force of Articles 1 to 21 and this Appendix according to Article 28(2) shall be effective until the expiration of the said period. Any such declaration may be renewed in whole or in part for periods of ten years each by a notification deposited with the Director General not more than fifteen months and not less than three months before the expiration of the ten-year period then running.

(b) Any declaration under paragraph (1) notified after the expiration of the period of ten years from the entry into force of Articles 1 to 21 and this Appendix according to Article 28(2) shall be effective until the expiration of the ten-year period then running. Any such declaration may be renewed as provided for in the second sentence of subparagraph (a).

(3) Any country of the Union which has ceased to be regarded as a developing country as referred to in paragraph (1) shall no longer be entitled to renew its declaration as provided in paragraph (2), and, whether or not it formally withdraws its declaration, such country shall be precluded from availing itself of the faculties referred to in paragraph (1) from the expiration of the ten-year period then running or from the expiration of a period of three years after it has ceased to be regarded as a developing country, whichever period expires later.

(4) Where, at the time when the declaration made under paragraph (1) or (2) ceases to be effective, there are copies in stock which were made under a license granted by virtue of this Appendix, such copies may continue to be distributed until their stock is exhausted.

(5) Any country which is bound by the provisions of this Act and which has deposited a declaration or a notification in accordance with Article 31(1) with respect to the application of this Act to a particular territory, the situation of which can be regarded as analogous to that of the countries referred to in paragraph (1), may, in respect of such territory, make the declaration referred to in paragraph (1) and the notification of renewal referred to in paragraph (2). As long as such declaration or notification remains in effect, the provisions of this Appendix shall be applicable to the territory in respect of which it was made.

(6)

(a) The fact that a country avails itself of any of the faculties referred to in paragraph (1) does not permit another country to give less protection to works of which the country of origin is the former country than it is obliged to grant under Articles 1 to 20.

(b) The right to apply reciprocal treatment provided for in Article 30(2)(b), second sentence, shall not, until the date on which the period applicable under Article I(3) expires, be exercised in respect of works the country of origin of which is a country which has made a declaration according to Article V(1)(a).

Article II

[*Limitations on the Right of Translation:* 1. Licenses grantable by competent authority; 2. to 4. Conditions allowing the grant of such licenses; 5. Purposes for which licenses may be granted; 6. Termination of licenses; 7. Works composed mainly of illustrations; 8. Works withdrawn from circulation; 9. Licenses for broadcasting organizations]

(1) Any country which has declared that it will avail itself of the faculty provided for in this Article shall be entitled, so far as works published in printed or analogous forms of reproduction are concerned, to substitute for the exclusive right of translation provided for in Article 8 a system of non-exclusive and non-transferable licenses, granted by the competent authority under the following conditions and subject to Article IV.

(2)

(a) Subject to paragraph (3), if, after the expiration of a period of three years, or of any longer period determined by the national legislation of the said country, commencing on the date of the first publication of the work, a translation of such work has not been published in a language in general use in that country by the owner of the right of translation, or with his authorization, any national of such country may obtain a license to make a translation of the work in the said language and publish the translation in printed or analogous forms of reproduction.

(b) A license under the conditions provided for in this Article may also be granted if all the editions of the translation published in the language concerned are out of print.

(3)

(a) In the case of translations into a language which is not in general use in one or more developed countries which are members of the Union, a period of one year shall be substituted for the period of three years referred to in paragraph (2)(a).

(b) Any country referred to in paragraph (1) may, with the unanimous agreement of the developed countries which are members of the Union and in which the same language is in general use, substitute, in the case of translations into that language, for the period of three years referred to in paragraph (2)(a) a shorter period as determined by such agreement but not less than one year. However, the provisions of the foregoing sentence shall not apply where the language in question is English, French or Spanish. The Director General shall be notified of any such agreement by the Governments which have concluded it.

(4)

(a) No license obtainable after three years shall be granted under this Article until a further period of six months has elapsed, and no license obtainable after one year shall be granted under this Article until a further period of nine months has elapsed

(i) from the date on which the applicant complies with the requirements mentioned in Article IV(1), or

(ii) where the identity or the address of the owner of the right of translation is unknown, from the date on which the applicant sends, as provided for in Article IV(2), copies of his application submitted to the authority competent to grant the license.

(b) If, during the said period of six or nine months, a translation in the language in respect of which the application was made is published by the owner of the right of translation or with his authorization, no license under this Article shall be granted.

(5) Any license under this Article shall be granted only for the purpose of teaching, scholarship or research.

(6) If a translation of a work is published by the owner of the right of translation or with his authorization at a price reasonably related to that normally charged in the country for comparable works, any license granted under this Article shall terminate if such translation is in the same language and with substantially the same content as the translation published under the license. Any copies already made before the license terminates may continue to be distributed until their stock is exhausted.

(7) For works which are composed mainly of illustrations, a license to make and publish a translation of the text and to reproduce and publish the illustrations may be granted only if the conditions of Article III are also fulfilled.

(8) No license shall be granted under this Article when the author has withdrawn from circulation all copies of his work.

(9)

(a) A license to make a translation of a work which has been published in printed or analogous forms of reproduction may also be granted to any broadcasting organization having its headquarters in a country referred to in paragraph (1), upon an application made to the competent authority of that country by the said organization, provided that all of the following conditions are met:

- (i) the translation is made from a copy made and acquired in accordance with the laws of the said country;
- (ii) the translation is only for use in broadcasts intended exclusively for teaching or for the dissemination of the results of specialized technical or scientific research to experts in a particular profession;
- (iii) the translation is used exclusively for the purposes referred to in condition (ii) through broadcasts made lawfully and intended for recipients on the territory of the said country, including broadcasts made through the medium of sound or visual recordings lawfully and exclusively made for the purpose of such broadcasts;
- (iv) all uses made of the translation are without any commercial purpose.

(b) Sound or visual recordings of a translation which was made by a broadcasting organization under a license granted by virtue of this paragraph may, for the purposes and subject to the conditions referred to in subparagraph (a) and with the agreement of that organization, also be used by any other broadcasting organization having its headquarters in the country whose competent authority granted the license in question.

(c) Provided that all of the criteria and conditions set out in subparagraph (a) are met, a license may also be granted to a broadcasting organization to translate any text incorporated in an audio-visual fixation where such fixation was itself prepared and published for the sole purpose of being used in connection with systematic instructional activities.

(d) Subject to subparagraphs (a) to (c), the provisions of the preceding paragraphs shall apply to the grant and exercise of any license granted under this paragraph.

Article III

[Limitation on the Right of Reproduction: 1. Licenses grantable by competent authority; 2. to 5. Conditions allowing the grant of such licenses; 6. Termination of licenses; 7. Works to which this Article applies]

(1) Any country which has declared that it will avail itself of the faculty provided for in this Article shall be entitled to substitute for the exclusive right of reproduction provided for in Article 9 a system of non-exclusive and non-transferable licenses, granted by the competent authority under the following conditions and subject to Article IV.

(2)

(a) If, in relation to a work to which this Article applies by virtue of paragraph (7), after the expiration of

- (i) the relevant period specified in paragraph (3), commencing on the date of first publication of a particular edition of the work, or
- (ii) any longer period determined by national legislation of the country referred to in paragraph (1), commencing on the same date,

copies of such edition have not been distributed in that country to the general public or in connection with systematic instructional activities, by the owner of the right of reproduction or with his authorization, at a price reasonably related to that normally charged in the country for comparable works, any national of such country may obtain a license to reproduce and publish such edition at that or a lower price for use in connection with systematic instructional activities.

(b) A license to reproduce and publish an edition which has been distributed as described in subparagraph (a) may also be granted under the conditions provided for in this Article if, after the expiration of the applicable period, no authorized copies of that edition have been on sale for a period of six months in

the country concerned to the general public or in connection with systematic instructional activities at a price reasonably related to that normally charged in the country for comparable works.

- (3) The period referred to in paragraph (2)(a)(i) shall be five years, except that
- (i) for works of the natural and physical sciences, including mathematics, and of technology, the period shall be three years;
 - (ii) for works of fiction, poetry, drama and music, and for art books, the period shall be seven years.

(4)

(a) No license obtainable after three years shall be granted under this Article until a period of six months has elapsed

- (i) from the date on which the applicant complies with the requirements mentioned in Article IV(1), or
- (ii) where the identity or the address of the owner of the right of reproduction is unknown, from the date on which the applicant sends, as provided for in Article IV(2), copies of his application submitted to the authority competent to grant the license.

(b) Where licenses are obtainable after other periods and Article IV(2) is applicable, no license shall be granted until a period of three months has elapsed from the date of the dispatch of the copies of the application.

(c) If, during the period of six or three months referred to in subparagraphs (a) and (b), a distribution as described in paragraph (2)(a) has taken place, no license shall be granted under this Article.

(d) No license shall be granted if the author has withdrawn from circulation all copies of the edition for the reproduction and publication of which the license has been applied for.

(5) A license to reproduce and publish a translation of a work shall not be granted under this Article in the following cases:

- (i) where the translation was not published by the owner of the right of translation or with his authorization, or
- (ii) where the translation is not in a language in general use in the country in which the license is applied for.

(6) If copies of an edition of a work are distributed in the country referred to in paragraph (1) to the general public or in connection with systematic instructional activities, by the owner of the right of reproduction or with his authorization, at a price reasonably related to that normally charged in the country for comparable works, any license granted under this Article shall terminate if such edition is in the same language and with substantially the same content as the edition which was published under the said license. Any copies already made before the license terminates may continue to be distributed until their stock is exhausted.

(7)

(a) Subject to subparagraph (b), the works to which this Article applies shall be limited to works published in printed or analogous forms of reproduction.

(b) This Article shall also apply to the reproduction in audio-visual form of lawfully made audio-visual fixations including any protected works incorporated therein and to the translation of any incorporated text into a language in general use in the country in which the license is applied for, always provided that the audio-visual fixations in question were prepared and published for the sole purpose of being used in connection with systematic instructional activities.

Article IV

[Provisions Common to Licenses Under Articles II and III: 1 and 2. Procedure; 3. Indication of author and title of work; 4. Exportation of copies; 5. Notice; 6. Compensation]

(1) A license under Article II or Article III may be granted only if the applicant, in accordance with the procedure of the country concerned, establishes either that he has requested, and has been denied, authorization by the owner of the right to make and publish the translation or to reproduce and publish the

edition, as the case may be, or that, after due diligence on his part, he was unable to find the owner of the right. At the same time as making the request, the applicant shall inform any national or international information center referred to in paragraph (2).

(2) If the owner of the right cannot be found, the applicant for a license shall send, by registered airmail, copies of his application, submitted to the authority competent to grant the license, to the publisher whose name appears on the work and to any national or international information center which may have been designated, in a notification to that effect deposited with the Director General, by the Government of the country in which the publisher is believed to have his principal place of business.

(3) The name of the author shall be indicated on all copies of the translation or reproduction published under a license granted under Article II or Article III. The title of the work shall appear on all such copies. In the case of a translation, the original title of the work shall appear in any case on all the said copies.

(4)

(a) No license granted under Article II or Article III shall extend to the export of copies, and any such license shall be valid only for publication of the translation or of the reproduction, as the case may be, in the territory of the country in which it has been applied for.

(b) For the purposes of subparagraph (a), the notion of export shall include the sending of copies from any territory to the country which, in respect of that territory, has made a declaration under Article I(5).

(c) Where a governmental or other public entity of a country which has granted a license to make a translation under Article II into a language other than English, French or Spanish sends copies of a translation published under such license to another country, such sending of copies shall not, for the purposes of subparagraph (a), be considered to constitute export if all of the following conditions are met:

- (i) the recipients are individuals who are nationals of the country whose competent authority has granted the license, or organizations grouping such individuals;
- (ii) the copies are to be used only for the purpose of teaching, scholarship or research;
- (iii) the sending of the copies and their subsequent distribution to recipients is without any commercial purpose; and
- (iv) the country to which the copies have been sent has agreed with the country whose competent authority has granted the license to allow the receipt, or distribution, or both, and the Director General has been notified of the agreement by the Government of the country in which the license has been granted.

(5) All copies published under a license granted by virtue of Article II or Article III shall bear a notice in the appropriate language stating that the copies are available for distribution only in the country or territory to which the said license applies.

(6)

(a) Due provision shall be made at the national level to ensure

- (i) that the license provides, in favour of the owner of the right of translation or of reproduction, as the case may be, for just compensation that is consistent with standards of royalties normally operating on licenses freely negotiated between persons in the two countries concerned, and
- (ii) payment and transmittal of the compensation: should national currency regulations intervene, the competent authority shall make all efforts, by the use of international machinery, to ensure transmittal in internationally convertible currency or its equivalent.

(b) Due provision shall be made by national legislation to ensure a correct translation of the work, or an accurate reproduction of the particular edition, as the case may be.

Article V

[*Alternative Possibility for Limitation of the Right of Translation*: 1. Regime provided for under the 1886 and 1896 Acts; 2. No possibility of change to regime under Article II; 3. Time limit for choosing the alternative possibility]

(1)

(a) Any country entitled to make a declaration that it will avail itself of the faculty provided for in Article II may, instead, at the time of ratifying or acceding to this Act:

- (i) if it is a country to which Article 30(2)(a) applies, make a declaration under that provision as far as the right of translation is concerned;
- (ii) if it is a country to which Article 30(2)(a) does not apply, and even if it is not a country outside the Union, make a declaration as provided for in Article 30(2)(b), first sentence.

(b) In the case of a country which ceases to be regarded as a developing country as referred to in Article I(1), a declaration made according to this paragraph shall be effective until the date on which the period applicable under Article I(3) expires.

(c) Any country which has made a declaration according to this paragraph may not subsequently avail itself of the faculty provided for in Article II even if it withdraws the said declaration.

(2) Subject to paragraph (3), any country which has availed itself of the faculty provided for in Article II may not subsequently make a declaration according to paragraph (1).

(3) Any country which has ceased to be regarded as a developing country as referred to in Article I(1) may, not later than two years prior to the expiration of the period applicable under Article I(3), make a declaration to the effect provided for in Article 30(2)(b), first sentence, notwithstanding the fact that it is not a country outside the Union. Such declaration shall take effect at the date on which the period applicable under Article I(3) expires.

Article VI

[Possibilities of applying, or admitting the application of, certain provisions of the Appendix before becoming bound by it: 1. Declaration; 2. Depository and effective date of declaration]

(1) Any country of the Union may declare, as from the date of this Act, and at any time before becoming bound by Articles 1 to 21 and this Appendix:

- (i) if it is a country which, were it bound by Articles 1 to 21 and this Appendix, would be entitled to avail itself of the faculties referred to in Article I(1), that it will apply the provisions of Article II or of Article III or of both to works whose country of origin is a country which, pursuant to (ii) below, admits the application of those Articles to such works, or which is bound by Articles 1 to 21 and this Appendix; such declaration may, instead of referring to Article II, refer to Article V;
- (ii) that it admits the application of this Appendix to works of which it is the country of origin by countries which have made a declaration under (i) above or a notification under Article I.

(2) Any declaration made under paragraph (1) shall be in writing and shall be deposited with the Director General. The declaration shall become effective from the date of its deposit.

**98/731/EC: Commission Decision
of 11 December 1998**

**under the provisions of Council Regulation (EC) No 3286/94 concerning section 110(5) of the
Copyright Act of the United States of America (notified under document number C(1998) 4033)**

Council Regulation (EC) No 3286/94 concerning section 110(5) of the Copyright Act of the United States of America (notified under document number C(1998) 4033) (98/731/EC)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 3286/94 of 22 December 1994 laying down Community procedures in the field of the common commercial policy in order to ensure the exercise of the Community's right under international trade rules, in particular those established under the auspices of the World Trade Organisation (1), as amended by Regulation (EC) No 356/95 (2), and in particular Articles 13 and 14 thereof,

After consulting the Advisory Committee,

Whereas:

A. PROCEDURE

- (1) On 21 April 1997 the Commission received a complaint pursuant to Article 4 of Council Regulation (EC) No 3286/94 (hereafter 'the Regulation'). The complaint was lodged by the Irish Music Rights Organisation (IMRO) with the unanimous support of the Groupement européen des sociétés d'auteurs et compositeurs (GESAC).
- (2) The complainant alleged that Section 110(5) of the 1976 Copyright Act of the United States of America is inconsistent with several provisions of the Agreement establishing the World Trade Organisation (hereafter 'the WTO Agreement') and its annexes. On that basis the complainant asked the Commission to take the necessary actions to convince the United States of America to repeal this measure.
- (3) The complaint contained sufficient prima facie evidence to justify the initiation of a Community examination procedure pursuant to Article 8 of the Regulation. Consequently, such procedure was initiated on 11 June 1997 (3).
- (4) Following the initiation of the examination procedure the Commission conducted an in-depth legal and factual investigation into Section 110(5) of the US Copyright Act as well as into the amendments to the statute as discussed in US Congress at the time of the investigation and enacted meanwhile. Based on the findings of this investigation the Commission reached the conclusions which are indicated below.

B. FINDINGS REGARDING THE EXISTENCE OF AN OBSTACLE TO TRADE

- (5) Although under the US Copyright Act the right holder of a musical work has the exclusive right 'to perform the copyrighted work publicly', Section 110(5) of the US Copyright Act exempts certain public performances from protection. Before the recent addition of a new subparagraph widening the scope of the exemption (see further under item D) it read as follows: 'Notwithstanding the provisions of Section 106, the following are not infringements of copyright: (...) communication or transmission embodying a performance or display of a work by the public reception of the transmission on a single receiving apparatus of a kind commonly used in private homes, unless (a) a direct charge is made to see or hear the transmission or (b) the transmission thus received is further retransmitted to the public'. The exemption covers the use of a radio or television set 'of a type commonly found in private homes' in a shop, a bar, a restaurant or any other place frequented by the public. As a result of its vague and ambiguous statutory language, Section 110(5) has

given rise to a very broad interpretation of what is commonly referred to as the 'homestyle exemption'. For example, it has been held that the exemption can also apply to companies operating large chains of stores throughout the country and using the playing of music in stores as part of their commercial policy (4).

- (6) Under Article 9(1) of the WTO Agreement on Trade-Related Intellectual Property Rights (hereafter 'TRIPs'), members must comply with Articles 1 to 21 of the Berne Convention for the Protection of Literary and Artistic Works (hereafter the 'Berne Convention'). Article 11bis(1) of the Berne Convention, as revised by the Paris Act of 1971, grants the right holders of literary and artistic works (which include musical works) the exclusive right of authorising not only the broadcasting and other wireless communication of their works, but also the public communication of a broadcast of their works by loudspeaker or analogous instrument. By permitting qualifying locations to use music without being licensed by the right holders and without payment of royalties, the US exemption deprives right holders of the protection to which they are entitled under Article 11bis(1)(iii) when broadcasts of their works are publicly communicated by loudspeakers or analogous instruments and under Article 11(1)(ii) when direct cable transmissions of their works are publicly communicated by such instruments. Article 11bis(1)(iii) or Article 11(1)(ii) clearly cover situations where broadcast music or music transmitted by cable is further transmitted to the public by a radio or a television apparatus (such as under the homestyle exemption) or any other means since it addresses the issue of public communication of broadcast works and not the technical specifications of the means used for that purpose.
- (7) Article 11bis(2) of the Berne Convention provides that, while countries may place conditions on the exercise of the exclusive rights set out in Article 11bis(1), such conditions may not be prejudicial to the right holders' right to obtain equitable remuneration. Section 110(5) of the US Copyright Act is prejudicial to the right holders' right to obtain such remuneration, as it deprives them of all remuneration in respect of the use of their works in situations covered by the homestyle exemption.
- (8) The Commission also reviewed the homestyle exemption from the point of view of 'minor reservations', a category of exceptions which might be considered to apply on the exercise of the exclusive rights under the Berne Convention, but concluded that, even where 'minor reservations' were applicable to the exclusive rights set out in Article 11bis(1)(iii) and (1)(ii), it would still remain that the homestyle exemption is clearly not a minor reservation. The exemption is widely applied on a commercial basis through the US and the economic losses incurred by Community rightholders are important, ranging between 13 to 24 % of the US performing rights organisations' annual distributions to Community collecting societies representing composers and arrangers of music, lyricists and publishers.
- (9) Since Article 9(1) of TRIPs imposes a mandatory obligation on WTO members to comply with Articles 1 to 21 of the Berne Convention, a WTO member is in breach of its obligations under the TRIPs Agreement where it fails to comply with the Berne Convention. Therefore, since Section 110(5) of the US Copyright Act contravenes Article 11bis(1), bis (2) and (1) of the Berne Convention, Section 110(5) of the US Copyright Act is in breach of Article 9(1) of TRIPs. Also, the Commission holds the opinion that Article 13 of TRIPs cannot be invoked by the United States to justify the homestyle exemption, as this provision limits the scope of existing exemptions under the Berne Convention to special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder. It does not allow additional exemptions to the rights protected under the Berne Convention.
- (10) Under these circumstances the Commission considers that the complainant's allegations are

well-founded and that Section 110(5) of the US Copyright Act constitutes an obstacle to trade within the meaning of Article 2(1) of the Regulation, that is 'a practice adopted or maintained by a third country in respect of which international trade rules establish a right of action`.

- (11) The Commission none the less considers that reference to the above legal bases does not rule out recourse to any other pertinent provision of the WTO Agreement and of the Agreements annexed to it, which could be of use in procedures before the WTO.

C. FINDINGS REGARDING ADVERSE TRADE EFFECTS

- (12) Section 110(5) of the US Copyright Act curtails Community right holders in the full and normal exercise of their exclusive rights under the Berne Convention and the TRIPs Agreement. The right holders are deprived of the possibility to license the performing right of their work (either directly or through collecting societies) and of the possibility to obtain remuneration for the communication of their works to the public.
- (13) The most direct effect of Section 110(5) is that it deprives right holders of their remuneration for certain communications to the public. Estimations made by the Commission reveal that the direct loss of licensing income to Community right holders for performing rights in music (i.e. composers and arrangers of music, lyricists and music publishers) resulting from the application of Section 110(5) amounts to between USD 3,8 and 6,8 million a year. These amounts represent 13 to 24 % of the US performing rights organisations' annual distributions to Community collecting societies representing these three categories of right holders. This shows that the losses caused by the homestyle exemption to the Community right holders are important.
- (14) The homestyle exemption also entails indirect losses to the Community right holders as it acts as a disincentive to the US performing right organisations to effectively and efficiently license bars, shops, restaurants and others in markets where no exemption exists and leads to a reduction of the efficiency of US organisations when trying to license such venues. The result of the very existence of Section 110(5) is that even those venues which clearly do not qualify for the exemption are not always properly licensed.
- (15) Further indirect losses are also caused by the fact that the homestyle exemption has acted as a catalyst for negative public and private attitudes towards licensing of non-dramatical musical works in the US. Powerful lobbies of music users have systematically (and successfully) resisted efforts by the collecting societies to effectively license and to collect reasonable fees for the communication of music to the public.
- (16) As a result of Section 110(5), the prospective revenue a right holder can expect from the licensing of his work in the US is less than it should be. This reduced prospective income may have a negative impact on the stimulus to export music to the US.
- (17) Under these circumstances the Commission considers that the complainant's allegations are well-founded and that Section 110(5) of the US Copyright Act is causing adverse trade effects within the meaning of Article 2(4) of the Regulation.

D. RECENT AMENDMENTS TO SECTION 110(5) OF THE US COPYRIGHT ACT

- (18) While the Commission was investigating the homestyle exemption, US Congress was examining a bill amending Section 110(5) of the US Copyright Act in view of widening its scope.
- (19) On 6 and 7 October 1998, the bill, entitled 'Fairness in Music Licensing Act', was adopted by, respectively, the US House of Representatives and the US Senate. The bill consists of adding a new subparagraph B to Section 110(5) of the US Copyright Act which provides for a further exception to the rightholders' exclusive right to authorise public communication of their works, while the homestyle exemption remains unchanged under subparagraph A. The new subparagraph

B now applies to a much wider range of beneficiaries, namely eating, drinking and other commercial establishments provided that they fulfil a certain number of conditions, mainly with regard to the surface of the establishment and the number of loudspeakers used. It covers the use of any type of audiovisual device, and is thus not limited to the use of a 'homestyle' apparatus only.

- (20) The bill was signed by the President of the United States on 27 October 1998, to enter into force 90 days after enactment. Since this means that, from a legal point of view, the bill is now part of the US legal order, although its entry into effect has been delayed for 90 days, it can already be the object of a dispute settlement procedure under WTO.
- (21) From a legal point of view, the new paragraph B of Section 110(5) also deprives right holders to the protection they are entitled under Articles 11bis (1)(iii) and 11(1)(ii) of the Berne Convention when broadcasts of their works or cable transmissions of their works are communicated to the public. Therefore, the Commission's analysis of the 1976 version of Section 110(5) of the US Copyright Act (now under subparagraph A of the section) fully applies to the new version of the Statute, which is thus equally in breach of the Berne Convention and the TRIPs Agreement.
- (22) As far as the adverse trade effects are concerned, it is clear that they will be seriously amplified by the widening of the Statute's scope in terms of beneficiaries and type of audiovisual devices used to perform music in public establishments. Whereas the Commission estimated that the 1976 homestyle exemption applied to between 20 and 35 % of US business establishments categorised as small business by US Government and employing fewer than 20 persons, and to between 6 and 12 % of US business of the same category employing more than 20 persons, the US collecting societies estimate that, only where eating and drinking business is concerned, the new Bill would already exempt 70 % of all US bars and restaurants, as they fall below the surface thresholds under the new Section 110(5)B.

E. COMMUNITY INTEREST

- (23) Ensuring that WTO partners fully comply with their obligations is of the utmost importance for the Community which has committed itself to the same obligations. Therefore, the Community should immediately challenge Section 110(5) of the US Copyright Act.

F. CONCLUSIONS AND MEASURES TO BE TAKEN

- (24) Meetings have been held and letters have been exchanged with the relevant US authorities to discuss this matter further and aimed at finding an amicable solution to the problems concerning the licensing of music works but the US authorities have not forwarded any proposals in view of such a solution.
- (25) In these circumstances, it appears that the interests of the Community call for initiation of WTO dispute settlement proceedings,

HAS DECIDED AS FOLLOWS:

Article 1

1. Section 110(5) of the Copyright Act of the United States of America appears to be inconsistent with the obligations of that country under the Marrakesh Agreement Establishing the World Trade Organisation and constitutes an 'obstacle to trade' within the meaning of Article 2(1) of Regulation (EC) No 3286/94.
2. The Community, will commence action against the United States of America under the Understanding

on the Rules and Procedures for the Settlement of Disputes and other relevant WTO provisions with a view to securing removal of the obstacle to trade.

Article 2

This Decision shall apply from the date of its publication in the Official Journal of the European Communities.

Done at Brussels, 11 December 1998.

For the Commission

Leon BRITTAN

Vice-President

- (1) OJ L 349, 31. 12. 1994, p. 71.
- (2) OJ L 41, 23. 2. 1995, p. 3.
- (3) OJ C 177, 11. 6. 1997, p. 5.
- (4) See BMI v. Edison Bros Stores Inc. United States Court of Appeals for the Eighth Circuit, No 91-2115 and BMI v. Claire's Boutiques United States Court of Appeals for the Seventh Circuit, No 91-1232.

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**Council Regulation (EC) No 6/2002
of 12 December 2001
on Community designs**

Council Regulation (EC) No 6/2002

of 12 December 2001

on Community designs

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 308 thereof,

Having regard to the proposal from the Commission(1),

Having regard to the opinion of the European Parliament(2),

Having regard to the opinion of the Economic and Social Committee(3),

Whereas:

- (1) A unified system for obtaining a Community design to which uniform protection is given with uniform effect throughout the entire territory of the Community would further the objectives of the Community as laid down in the Treaty.
- (2) Only the Benelux countries have introduced a uniform design protection law. In all the other Member States the protection of designs is a matter for the relevant national law and is confined to the territory of the Member State concerned. Identical designs may be therefore protected differently in different Member States and for the benefit of different owners. This inevitably leads to conflicts in the course of trade between Member States.
- (3) The substantial differences between Member States' design laws prevent and distort Community-wide competition. In comparison with domestic trade in, and competition between, products incorporating a design, trade and competition within the Community are prevented and distorted by the large number of applications, offices, procedures, laws, nationally circumscribed exclusive rights and the combined administrative expense with correspondingly high costs and fees for the applicant. [Directive 98/71/EC](#) of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs(4) contributes to remedying this situation.
- (4) The effect of design protection being limited to the territory of the individual Member States whether or not their laws are approximated, leads to a possible division of the internal market with respect to products incorporating a design which is the subject of national rights held by different individuals, and hence constitutes an obstacle to the free movement of goods.
- (5) This calls for the creation of a Community design which is directly applicable in each Member State, because only in this way will it be possible to obtain, through one application made to the Office for Harmonisation in the Internal Market (Trade Marks and Design) in accordance with a single procedure under one law, one design right for one area encompassing all Member States.
- (6) Since the objectives of the proposed action, namely, the protection of one design right for one area encompassing all the Member States, cannot be sufficiently achieved by the Member States by reason of the scale and the effects of the creation of a Community design and a Community design authority and can therefore, and can therefore be better achieved at Community level, the Community may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty. In accordance with the principle of proportionality, as set out

in that Article, this Regulation does not go beyond what is necessary in order to achieve those objectives.

- (7) Enhanced protection for industrial design not only promotes the contribution of individual designers to the sum of Community excellence in the field, but also encourages innovation and development of new products and investment in their production.
- (8) Consequently a more accessible design-protection system adapted to the needs of the internal market is essential for Community industries.
- (9) The substantive provisions of this Regulation on design law should be aligned with the respective provisions in [Directive 98/71/EC](#).
- (10) Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function. It is understood that this does not entail that a design must have an aesthetic quality. Likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings. Consequently, those features of a design which are excluded from protection for those reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.
- (11) The mechanical fittings of modular products may nevertheless constitute an important element of the innovative characteristics of modular products and present a major marketing asset, and therefore should be eligible for protection.
- (12) Protection should not be extended to those component parts which are not visible during normal use of a product, nor to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual character. Therefore, those features of design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.
- (13) Full-scale approximation of the laws of the Member States on the use of protected designs for the purpose of permitting the repair of a complex product so as to restore its original appearance, where the design is applied to or incorporated in a product which constitutes a component part of a complex product upon whose appearance the protected design is dependent, could not be achieved through [Directive 98/71/EC](#). Within the framework of the conciliation procedure on the said [Directive](#), the Commission undertook to review the consequences of the provisions of that [Directive](#) three years after the deadline for transposition of the [Directive](#) in particular for the industrial sectors which are most affected. Under these circumstances, it is appropriate not to confer any protection as a Community design for a design which is applied to or incorporated in a product which constitutes a component part of a complex product upon whose appearance the design is dependent and which is used for the purpose of the repair of a complex product so as to restore its original appearance, until the Council has decided its policy on this issue on the basis of a Commission proposal.
- (14) The assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design.
- (15) A Community design should, as far as possible, serve the needs of all sectors of industry in the Community.
- (16) Some of those sectors produce large numbers of designs for products frequently having a short

market life where protection without the burden of registration formalities is an advantage and the duration of protection is of lesser significance. On the other hand, there are sectors of industry which value the advantages of registration for the greater legal certainty it provides and which require the possibility of a longer term of protection corresponding to the foreseeable market life of their products.

- (17) This calls for two forms of protection, one being a short-term unregistered design and the other being a longer term registered design.
- (18) A registered Community design requires the creation and maintenance of a register in which will be registered all those applications which comply with formal conditions and which have been accorded a date of filing. This registration system should in principle not be based upon substantive examination as to compliance with requirements for protection prior to registration, thereby keeping to a minimum the registration and other procedural burdens on applicants.
- (19) A Community design should not be upheld unless the design is new and unless it also possesses an individual character in comparison with other designs.
- (20) It is also necessary to allow the designer or his successor in title to test the products embodying the design in the market place before deciding whether the protection resulting from a registered Community design is desirable. To this end it is necessary to provide that disclosures of the design by the designer or his successor in title, or abusive disclosures during a period of 12 months prior to the date of the filing of the application for a registered Community design should not be prejudicial in assessing the novelty or the individual character of the design in question.
- (21) The exclusive nature of the right conferred by the registered Community design is consistent with its greater legal certainty. It is appropriate that the unregistered Community design should, however, constitute a right only to prevent copying. Protection could not therefore extend to design products which are the result of a design arrived at independently by a second designer. This right should also extend to trade in products embodying infringing designs.
- (22) The enforcement of these rights is to be left to national laws. It is necessary therefore to provide for some basic uniform sanctions in all Member States. These should make it possible, irrespective of the jurisdiction under which enforcement is sought, to stop the infringing acts.
- (23) Any third person who can establish that he has in good faith commenced use even for commercial purposes within the Community, or has made serious and effective preparations to that end, of a design included within the scope of protection of a registered Community design, which has not been copied from the latter, may be entitled to a limited exploitation of that design.
- (24) It is a fundamental objective of this Regulation that the procedure for obtaining a registered Community design should present the minimum cost and difficulty to applicants, so as to make it readily available to small and medium-sized enterprises as well as to individual designers.
- (25) Those sectors of industry producing large numbers of possibly short-lived designs over short periods of time of which only some may be eventually commercialised will find advantage in the unregistered Community design. Furthermore, there is also a need for these sectors to have easier recourse to the registered Community design. Therefore, the option of combining a number of designs in one multiple application would satisfy that need. However, the designs contained in a multiple application may be dealt with independently of each other for the purposes of enforcement of rights, licensing, rights in rem, levy of execution, insolvency proceedings, surrender, renewal, assignment, deferred publication or declaration of invalidity.
- (26) The normal publication following registration of a Community design could in some cases destroy

or jeopardise the success of a commercial operation involving the design. The facility of a deferment of publication for a reasonable period affords a solution in such cases.

- (27) A procedure for hearing actions concerning validity of a registered Community design in a single place would bring savings in costs and time compared with procedures involving different national courts.
- (28) It is therefore necessary to provide safeguards including a right of appeal to a Board of Appeal, and ultimately to the Court of Justice. Such a procedure would assist the development of uniform interpretation of the requirements governing the validity of Community designs.
- (29) It is essential that the rights conferred by a Community design can be enforced in an efficient manner throughout the territory of the Community.
- (30) The litigation system should avoid as far as possible "forum shopping". It is therefore necessary to establish clear rules of international jurisdiction.
- (31) This Regulation does not preclude the application to designs protected by Community designs of the industrial property laws or other relevant laws of the Member States, such as those relating to design protection acquired by registration or those relating to unregistered designs, trade marks, patents and utility models, unfair competition or civil liability.
- (32) In the absence of the complete harmonisation of copyright law, it is important to establish the principle of cumulation of protection under the Community design and under copyright law, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred.
- (33) The measures necessary for the implementation of this Regulation should be adopted in accordance with Council Decision 1999/468/EC of 28 June 1999 laying down the procedures for the exercise of implementing powers conferred on the Commission(5),

HAS ADOPTED THIS REGULATION:

TITLE I

GENERAL PROVISIONS

Article 1

Community design

1. A design which complies with the conditions contained in this Regulation is hereinafter referred to as a "Community design".
2. A design shall be protected:
 - (a) by an "unregistered Community design", if made available to the public in the manner provided for in this Regulation;
 - (b) by a "registered Community design", if registered in the manner provided for in this Regulation.
3. A Community design shall have a unitary character. It shall have equal effect throughout the Community. It shall not be registered, transferred or surrendered or be the subject of a decision declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle and its implications shall apply unless otherwise provided in this Regulation.

Article 2

Office

The Office for Harmonisation in the Internal Market (Trade Marks and Designs), hereinafter referred to as "the Office", instituted by Council Regulation (EC) No 40/94 of 20 December 1993 on the Community [trade mark](#)(6), hereinafter referred to as the "Regulation on the Community [trade mark](#)", shall carry out the tasks entrusted to it by this Regulation.

TITLE II

THE LAW RELATING TO DESIGNS

Section 1

Requirements for protection

Article 3

Definitions

For the purposes of this Regulation:

- (a) "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;
- (b) "product" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;
- (c) "complex product" means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

Article 4

Requirements for protection

1. A design shall be protected by a Community design to the extent that it is new and has individual character.
2. A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:
 - (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
 - (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.
3. "Normal use" within the meaning of paragraph (2)(a) shall mean use by the end user, excluding maintenance, servicing or repair work.

Article 5

Novelty

1. A design shall be considered to be new if no identical design has been made available to the public:
 - (a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;
 - (b) in the case of a registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.
2. Designs shall be deemed to be identical if their features differ only in immaterial details.

Article 6

Individual character

1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public:
 - (a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;
 - (b) in the case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority.
2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

Article 7

Disclosure

1. For the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.
2. A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 and if a design for which protection is claimed under a registered Community design has been made available to the public:
 - (a) by the designer, his successor in title, or a third person as a result of information provided

or action taken by the designer or his successor in title; and

(b) during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority.

3. Paragraph 2 shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

Article 8

Designs dictated by their technical function and designs of interconnections

1. A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

2. A Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.

3. Notwithstanding paragraph 2, a Community design shall under the conditions set out in Articles 5 and 6 subsist in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.

Article 9

Designs contrary to public policy or morality

A Community design shall not subsist in a design which is contrary to public policy or to accepted principles of morality.

Section 2

Scope and term of protection

Article 10

Scope of protection

1. The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.

2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

Article 11

Commencement and term of protection of the unregistered Community design

1. A design which meets the requirements under Section 1 shall be protected by an unregistered Community design for a period of three years as from the date on which the design was first made available to the public within the Community.

2. For the purpose of paragraph 1, a design shall be deemed to have been made available to the public within the Community if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

Article 12

Commencement and term of protection of the registered Community design

Upon registration by the Office, a design which meets the requirements under Section 1 shall be protected by a registered Community design for a period of five years as from the date of the filing of the application. The right holder may have the term of protection renewed for one or more periods of five years each, up to a total term of 25 years from the date of filing.

Article 13

Renewal

1. Registration of the registered Community design shall be renewed at the request of the right holder or of any person expressly authorised by him, provided that the renewal fee has been paid.

2. The Office shall inform the right holder of the registered Community design and any person having a right entered in the register of Community designs, referred to in Article 72, hereafter referred to as the "register" in respect of the registered Community design, of the expiry of the registration in good time before the said expiry. Failure to give such information shall not involve the responsibility of the Office.

3. The request for renewal shall be submitted and the renewal fee paid within a period of six months ending on the last day of the month in which protection ends. Failing this, the request may be submitted and the fee paid within a further period of six months from the day referred to in the first sentence, provided that an additional fee is paid within this further period.

4. Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be entered in the register.

Section 3

Right to the Community design

Article 14

Right to the Community design

1. The right to the Community design shall vest in the designer or his successor in title.

2. If two or more persons have jointly developed a design, the right to the Community design shall vest in them jointly.

3. However, where a design is developed by an employee in the execution of his duties or following the instructions given by his employer, the right to the Community design shall vest in the employer, unless otherwise agreed or specified under national law.

Article 15

Claims relating to the entitlement to a Community design

1. If an unregistered Community design is disclosed or claimed by, or a registered Community design has been applied for or registered in the name of, a person who is not entitled to it under Article 14, the person entitled to it under that provision may, without prejudice to any other remedy which may be open to him, claim to become recognised as the legitimate holder of the Community design.

2. Where a person is jointly entitled to a Community design, that person may, in accordance with paragraph 1, claim to become recognised as joint holder.

3. Legal proceedings under paragraphs 1 or 2 shall be barred three years after the date of publication of a registered Community design or the date of disclosure of an unregistered Community design. This provision shall not apply if the person who is not entitled to the Community design was acting in bad faith at the time when such design was applied for or disclosed or was assigned to him.

4. In the case of a registered Community design, the following shall be entered in the register:

- (a) the mention that legal proceedings under paragraph 1 have been instituted;
- (b) the final decision or any other termination of the proceedings;
- (c) any change in the ownership of the registered Community design resulting from the final decision.

Article 16

Effects of a judgement on entitlement to a registered Community design

1. Where there is a complete change of ownership of a registered Community design as a result of legal proceedings under Article 15(1), licences and other rights shall lapse upon the entering in the register of the person entitled.

2. If, before the institution of the legal proceedings under Article 15(1) has been registered, the holder of the registered Community design or a licensee has exploited the design within the Community or made serious and effective preparations to do so, he may continue such exploitation provided that he requests within the period prescribed by the implementing regulation a non-exclusive licence from the new holder whose name is entered in the register. The licence shall be granted for a reasonable period and upon reasonable terms.

3. Paragraph 2 shall not apply if the holder of the registered Community design or the licensee was acting in bad faith at the time when he began to exploit the design or to make preparations to do so.

Article 17

Presumption in favour of the registered holder of the design

The person in whose name the registered Community design is registered or, prior to registration, the person in whose name the application is filed, shall be deemed to be the person entitled in any proceedings before the Office as well as in any other proceedings.

Article 18

Right of the designer to be cited

The designer shall have the right, in the same way as the applicant for or the holder of a registered Community design, to be cited as such before the Office and in the register. If the design is the result of teamwork, the citation of the team may replace the citation of the individual designers.

Section 4

Effects of the Community design

Article 19

Rights conferred by the Community design

1. A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

2. An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from copying the protected design.

The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

3. Paragraph 2 shall also apply to a registered Community design subject to deferment of publication as long as the relevant entries in the register and the file have not been made available to the public in accordance with Article 50(4).

Article 20

Limitation of the rights conferred by a Community design

1. The rights conferred by a Community design shall not be exercised in respect of:

(a) acts done privately and for non-commercial purposes;

- (b) acts done for experimental purposes;
 - (c) acts of reproduction for the purpose of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.
2. In addition, the rights conferred by a Community design shall not be exercised in respect of:
- (a) the equipment on ships and aircraft registered in a third country when these temporarily enter the territory of the Community;
 - (b) the importation in the Community of spare parts and accessories for the purpose of repairing such craft;
 - (c) the execution of repairs on such craft.

Article 21

Exhaustion of rights

The rights conferred by a Community design shall not extend to acts relating to a product in which a design included within the scope of protection of the Community design is incorporated or to which it is applied, when the product has been put on the market in the Community by the holder of the Community design or with his consent.

Article 22

Rights of prior use in respect of a registered Community design

1. A right of prior use shall exist for any third person who can establish that before the date of filing of the application, or, if a priority is claimed, before the date of priority, he has in good faith commenced use within the Community, or has made serious and effective preparations to that end, of a design included within the scope of protection of a registered Community design, which has not been copied from the latter.
2. The right of prior use shall entitle the third person to exploit the design for the purposes for which its use had been effected, or for which serious and effective preparations had been made, before the filing or priority date of the registered Community design.
3. The right of prior use shall not extend to granting a licence to another person to exploit the design.
4. The right of prior use cannot be transferred except, where the third person is a business, along with that part of the business in the course of which the act was done or the preparations were made.

Article 23

Government use

Any provision in the law of a Member State allowing use of national designs by or for the government

may be applied to Community designs, but only to the extent that the use is necessary for essential defence or security needs.

Section 5

Invalidity

Article 24

Declaration of invalidity

1. A registered Community design shall be declared invalid on application to the Office in accordance with the procedure in Titles VI and VII or by a Community design court on the basis of a counterclaim in infringement proceedings.

2. A Community design may be declared invalid even after the Community design has lapsed or has been surrendered.

3. An unregistered Community design shall be declared invalid by a Community design court on application to such a court or on the basis of a counterclaim in infringement proceedings.

Article 25

Grounds for invalidity

1. A Community design may be declared invalid only in the following cases:

- (a) if the design does not correspond to the definition under Article 3(a);
- (b) if it does not fulfil the requirements of Articles 4 to 9;
- (c) if, by virtue of a court decision, the right holder is not entitled to the Community design under Article 14;
- (d) if the Community design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if a priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date by a registered Community design or an application for such a design, or by a registered design right of a Member State, or by an application for such a right;
- (e) if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use;
- (f) if the design constitutes an unauthorised use of a work protected under the copyright law of a Member State;
- (g) if the design constitutes an improper use of any of the items listed in Article 6ter of the "Paris Convention" for the Protection of Industrial Property hereafter referred to as the "Paris Convention", or of badges, emblems and escutcheons other than those covered by the said Article 6ter and which are of particular public interest in a Member State.

2. The ground provided for in paragraph (1)(c) may be invoked solely by the person who is entitled to the Community design under Article 14.

3. The grounds provided for in paragraph (1)(d), (e) and (f) may be invoked solely by the applicant for or holder of the earlier right.
4. The ground provided for in paragraph (1)(g) may be invoked solely by the person or entity concerned by the use.
5. Paragraphs 3 and 4 shall be without prejudice to the freedom of Member States to provide that the grounds provided for in paragraphs 1(d) and (g) may also be invoked by the appropriate authority of the Member State in question on its own initiative.
6. A registered Community design which has been declared invalid pursuant to paragraph (1)(b), (e), (f) or (g) may be maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained. "Maintenance" in an amended form may include registration accompanied by a partial disclaimer by the holder of the registered Community design or entry in the register of a court decision or a decision by the Office declaring the partial invalidity of the registered Community design.

Article 26

Consequences of invalidity

1. A Community design shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that it has been declared invalid.
2. Subject to the national provisions relating either to claims for compensation for damage caused by negligence or lack of good faith on the part of the holder of the Community design, or to unjust enrichment, the retroactive effect of invalidity of the Community design shall not affect:
 - (a) any decision on infringement which has acquired the authority of a final decision and been enforced prior to the invalidity decision;
 - (b) any contract concluded prior to the invalidity decision, in so far as it has been performed before the decision; however, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract may be claimed on grounds of equity.

TITLE III

COMMUNITY DESIGNS AS OBJECTS OF PROPERTY

Article 27

Dealing with Community designs as national design rights

1. Unless Articles 28, 29, 30, 31 and 32 provide otherwise, a Community design as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national design right of the Member State in which:
 - (a) the holder has his seat or his domicile on the relevant date; or
 - (b) where point (a) does not apply, the holder has an establishment on the relevant date.
2. In the case of a registered Community design, paragraph 1 shall apply according to the entries in the register.

3. In the case of joint holders, if two or more of them fulfil the condition under paragraph 1, the Member State referred to in that paragraph shall be determined:

- (a) in the case of an unregistered Community design, by reference to the relevant joint holder designated by them by common agreement;
- (b) in the case of a registered Community design, by reference to the first of the relevant joint holders in the order in which they are mentioned in the register.

4. Where paragraphs 1, 2 and 3 do not apply, the Member State referred to in paragraph 1 shall be the Member State in which the seat of the Office is situated.

Article 28

Transfer of the registered Community design

The transfer of a registered Community design shall be subject to the following provisions:

- (a) at the request of one of the parties, a transfer shall be entered in the register and published;
- (b) until such time as the transfer has been entered in the register, the successor in title may not invoke the rights arising from the registration of the Community design;
- (c) where there are time limits to be observed in dealings with the Office, the successor in title may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office;
- (d) all documents which by virtue of Article 66 require notification to the holder of the registered Community design shall be addressed by the Office to the person registered as holder or his representative, if one has been appointed.

Article 29

Rights in rem on a registered Community design

- 1. A registered Community design may be given as security or be the subject of rights in rem.
- 2. On request of one of the parties, the rights mentioned in paragraph 1 shall be entered in the register and published.

Article 30

Levy of execution

- 1. A registered Community design may be levied in execution.
- 2. As regards the procedure for levy of execution in respect of a registered Community design, the courts and authorities of the Member State determined in accordance with Article 27 shall have exclusive jurisdiction.
- 3. On request of one of the parties, levy of execution shall be entered in the register and published.

Article 31

Insolvency proceedings

1. The only insolvency proceedings in which a Community design may be involved shall be those opened in the Member State within the territory of which the centre of a debtor's main interests is situated.
2. In the case of joint proprietorship of a Community design, paragraph 1 shall apply to the share of the joint proprietor.
3. Where a Community design is involved in insolvency proceedings, on request of the competent national authority an entry to this effect shall be made in the register and published in the Community Designs Bulletin referred to in Article 73(1).

Article 32

Licensing

1. A Community design may be licensed for the whole or part of the Community. A licence may be exclusive or non-exclusive.
2. Without prejudice to any legal proceedings based on the law of contract, the holder may invoke the rights conferred by the Community design against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form in which the design may be used, the range of products for which the licence is granted and the quality of products manufactured by the licensee.
3. Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a Community design only if the right holder consents thereto. However, the holder of an exclusive licence may bring such proceedings if the right holder in the Community design, having been given notice to do so, does not himself bring infringement proceedings within an appropriate period.
4. A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in an infringement action brought by the right holder in a Community design.
5. In the case of a registered Community design, the grant or transfer of a licence in respect of such right shall, at the request of one of the parties, be entered in the register and published.

Article 33

Effects vis-à-vis third parties

1. The effects vis-à-vis third parties of the legal acts referred to in Articles 28, 29, 30 and 32 shall be governed by the law of the Member State determined in accordance with Article 27.
2. However, as regards registered Community designs, legal acts referred to in Articles 28, 29 and 32 shall only have effect vis-à-vis third parties in all the Member States after entry in the register. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights in the registered Community design after the date of that act

but who knew of the act at the date on which the rights were acquired.

3. Paragraph 2 shall not apply to a person who acquires the registered Community design or a right concerning the registered Community design by way of transfer of the whole of the undertaking or by any other universal succession.

4. Until such time as common rules for the Member States in the field of insolvency enter into force, the effects vis-à-vis third parties of insolvency proceedings shall be governed by the law of the Member State in which such proceedings are first brought under the national law or the regulations applicable in this field.

Article 34

The application for a registered Community design as an object of property

1. An application for a registered Community design as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national design right of the Member State determined in accordance with Article 27.

2. Articles 28, 29, 30, 31, 32 and 33 shall apply mutatis mutandis to applications for registered Community designs. Where the effect of one of these provisions is conditional upon an entry in the register, that formality shall be performed upon registration of the resulting registered Community design.

TITLE IV

APPLICATION FOR A REGISTERED COMMUNITY DESIGN

Section 1

Filing of applications and the conditions which govern them

Article 35

Filing and forwarding of applications

1. An application for a registered Community design shall be filed, at the option of the applicant:

- (a) at the Office; or
- (b) at the central industrial property office of a Member State; or
- (c) in the Benelux countries, at the Benelux Design Office.

2. Where the application is filed at the central industrial property office of a Member State or at the Benelux Design Office, that office shall take all steps to forward the application to the Office within two weeks after filing. It may charge the applicant a fee which shall not exceed the administrative costs of receiving and forwarding the application.

3. As soon as the Office has received an application which has been forwarded by a central industrial property office of a Member State or by the Benelux Design Office, it shall inform the applicant accordingly, indicating the date of its receipt at the Office.

4. No less than 10 years after the entry into force of this Regulation, the Commission shall draw up a report on the operation of the system of filing applications for registered Community designs,

accompanied by any proposals for revision that it may deem appropriate.

Article 36

Conditions with which applications must comply

1. An application for a registered Community design shall contain:

- (a) a request for registration;
 - (b) information identifying the applicant;
 - (c) a representation of the design suitable for reproduction. However, if the object of the application is a two-dimensional design and the application contains a request for deferment of publication in accordance with Article 50, the representation of the design may be replaced by a specimen.
2. The application shall further contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.
3. In addition, the application may contain:
- (a) a description explaining the representation or the specimen;
 - (b) a request for deferment of publication of the registration in accordance with Article 50;
 - (c) information identifying the representative if the applicant has appointed one;
 - (d) the classification of the products in which the design is intended to be incorporated or to which it is intended to be applied according to class;
 - (e) the citation of the designer or of the team of designers or a statement under the applicant's responsibility that the designer or the team of designers has waived the right to be cited.
4. The application shall be subject to the payment of the registration fee and the publication fee. Where a request for deferment under paragraph 3(b) is filed, the publication fee shall be replaced by the fee for deferment of publication.
5. The application shall comply with the conditions laid down in the implementing regulation.
6. The information contained in the elements mentioned in paragraph 2 and in paragraph 3(a) and (d) shall not affect the scope of protection of the design as such.

Article 37

Multiple applications

1. Several designs may be combined in one multiple application for registered Community designs. Except in cases of ornamentation, this possibility is subject to the condition that the products in which the designs are intended to be incorporated or to which they are intended to be applied all belong to the same class of the International Classification for Industrial Designs.
2. Besides the fees referred to in Article 36(4), the multiple application shall be subject to payment of an additional registration fee and an additional publication fee. Where the multiple application contains a request for deferment of publication, the additional publication fee shall be replaced by the additional fee for deferment of publication. The additional fees shall correspond

to a percentage of the basic fees for each additional design.

3. The multiple application shall comply with the conditions of presentation laid down in the implementing regulation.

4. Each of the designs contained in a multiple application or registration may be dealt with separately from the others for the purpose of applying this Regulation. It may in particular, separately from the others, be enforced, licensed, be the subject of a right in rem, a levy of execution or insolvency proceedings, be surrendered, renewed or assigned, be the subject of deferred publication or be declared invalid. A multiple application or registration may be divided into separate applications or registrations only under the conditions set out in the implementing regulation.

Article 38

Date of filing

1. The date of filing of an application for a registered Community design shall be the date on which documents containing the information specified in Article 36(1) are filed with the Office by the applicant, or, if the application has been filed with the central industrial property office of a Member State or with the Benelux Design Office, with that office.

2. By derogation from paragraph 1, the date of filing of an application filed with the central industrial property office of a Member State or with the Benelux Design Office and reaching the Office more than two months after the date on which documents containing the information specified in Article 36(1) have been filed shall be the date of receipt of such documents by the Office.

Article 39

Equivalence of Community filing with national filing

An application for a registered Community design which has been accorded a date of filing shall, in the Member States, be equivalent to a regular national filing, including where appropriate the priority claimed for the said application.

Article 40

Classification

For the purpose of this Regulation, use shall be made of the Annex to the Agreement establishing an International Classification for Industrial Designs, signed at Locarno on 8 October 1968.

Section 2

Priority

Article 41

Right of priority

1. A person who has duly filed an application for a design right or for a utility model in or for any State party to the Paris Convention for the Protection of Industrial Property, or to the Agreement establishing the World Trade Organisation, or his successors in title, shall enjoy, for the purpose of filing an application for a registered Community design in respect of the same design or utility model, a right of priority of six months from the date of filing of the first application.
2. Every filing that is equivalent to a regular national filing under the national law of the State where it was made or under bilateral or multilateral agreements shall be recognised as giving rise to a right of priority.
3. "Regular national filing" means any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application.
4. A subsequent application for a design which was the subject of a previous first application, and which is filed in or in respect of the same State, shall be considered as the first application for the purpose of determining priority, provided that, at the date of the filing of the subsequent application, the previous application has been withdrawn, abandoned or refused without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming priority. The previous application may not thereafter serve as a basis for claiming a right of priority.
5. If the first filing has been made in a State which is not a party to the Paris Convention, or to the Agreement establishing the World Trade Organisation, paragraphs 1 to 4 shall apply only in so far as that State, according to published findings, grants, on the basis of a filing made at the Office and subject to conditions equivalent to those laid down in this Regulation, a right of priority having equivalent effect.

Article 42

Claiming priority

An applicant for a registered Community design desiring to take advantage of the priority of a previous application shall file a declaration of priority and a copy of the previous application. If the language of the latter is not one of the languages of the Office, the Office may require a translation of the previous application in one of those languages.

Article 43

Effect of priority right

The effect of the right of priority shall be that the date of priority shall count as the date of the filing of the application for a registered Community design for the purpose of Articles 5, 6, 7, 22, 25(1)(d) and 50(1).

Article 44

Exhibition priority

1. If an applicant for a registered Community design has disclosed products in which the design is incorporated, or to which it is applied, at an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions signed in Paris on 22 November 1928 and last revised on 30 November 1972, he may, if he files the application within a period of six months from the date of the first disclosure of such products, claim a right of priority from that date within the meaning of Article 43.

2. An applicant who wishes to claim priority pursuant to paragraph 1, under the conditions laid down in the implementing regulation, must file evidence that he has disclosed at an exhibition the products in or to which the design is incorporated or applied.

3. An exhibition priority granted in a Member State or in a third country does not extend the period of priority laid down in Article 41.

TITLE V

REGISTRATION PROCEDURE

Article 45

Examination as to formal requirements for filing

1. The Office shall examine whether the application complies with the requirements laid down in Article 36(1) for the accordancy of a date of filing.

2. The Office shall examine whether:

- (a) the application complies with the other requirements laid down in Article 36(2), (3), (4) and (5) and, in the case of a multiple application, Article 37(1) and (2);
- (b) the application meets the formal requirements laid down in the implementing regulation for the implementation of Articles 36 and 37;
- (c) the requirements of Article 77(2) are satisfied;
- (d) the requirements concerning the claim to priority are satisfied, if a priority is claimed.

3. The conditions for the examination as to the formal requirements for filing shall be laid down in the implementing regulation.

Article 46

Remediable deficiencies

1. Where, in carrying out the examination under Article 45, the Office notes that there are deficiencies which may be corrected, the Office shall request the applicant to remedy them within the prescribed period.

2. If the deficiencies concern the requirements referred to in Article 36(1) and the applicant complies with the Office's request within the prescribed period, the Office shall accord as the date of filing the date on which the deficiencies are remedied. If the deficiencies are not remedied within the prescribed period, the application shall not be dealt with as an application for a registered Community design.

3. If the deficiencies concern the requirements, including the payment of fees, as referred to in Article 45(2)(a), (b) and (c) and the applicant complies with the Office's request within the prescribed period, the Office shall accord as the date of filing the date on which the application was originally filed. If the deficiencies or the default in payment are not remedied within the prescribed period, the Office shall refuse the application.

4. If the deficiencies concern the requirements referred to in Article 45(2)(d), failure to remedy them within the prescribed period shall result in the loss of the right of priority for the application.

Article 47

Grounds for non-registrability

1. If the Office, in carrying out the examination pursuant to Article 45, notices that the design for which protection is sought:

(a) does not correspond to the definition under Article 3(a); or

(b) is contrary to public policy or to accepted principles of morality, it shall refuse the application.

2. The application shall not be refused before the applicant has been allowed the opportunity of withdrawing or amending the application or of submitting his observations.

Article 48

Registration

If the requirements that an application for a registered Community design must satisfy have been fulfilled and to the extent that the application has not been refused by virtue of Article 47, the Office shall register the application in the Community design Register as a registered Community design. The registration shall bear the date of filing of the application referred to in Article 38.

Article 49

Publication

Upon registration, the Office shall publish the registered Community design in the Community Designs Bulletin as mentioned in Article 73(1). The contents of the publication shall be set out in the implementing regulation.

Article 50

Deferment of publication

1. The applicant for a registered Community design may request, when filing the application, that the publication of the registered Community design be deferred for a period of 30 months from the date of filing the application or, if a priority is claimed, from the date of priority.

2. Upon such request, where the conditions set out in Article 48 are satisfied, the registered Community design shall be registered, but neither the representation of the design nor any file relating to the application shall, subject to Article 74(2), be open to public inspection.

3. The Office shall publish in the Community Designs Bulletin a mention of the deferment of the publication of the registered Community design. The mention shall be accompanied by information identifying the right holder in the registered Community design, the date of filing the application and any other particulars prescribed by the implementing regulation.

4. At the expiry of the period of deferment, or at any earlier date on request by the right holder, the Office shall open to public inspection all the entries in the register and the file relating to the application and shall publish the registered Community design in the Community Designs Bulletin, provided that, within the time limit laid down in the implementing regulation:

- (a) the publication fee and, in the event of a multiple application, the additional publication fee are paid;
- (b) where use has been made of the option pursuant to Article 36(1)(c), the right holder has filed with the Office a representation of the design.

If the right holder fails to comply with these requirements, the registered Community design shall be deemed from the outset not to have had the effects specified in this Regulation.

5. In the case of multiple applications, paragraph 4 need only be applied to some of the designs included therein.

6. The institution of legal proceedings on the basis of a registered Community design during the period of deferment of publication shall be subject to the condition that the information contained in the register and in the file relating to the application has been communicated to the person against whom the action is brought.

TITLE VI

SURRENDER AND INVALIDITY OF THE REGISTERED COMMUNITY DESIGN

Article 51

Surrender

1. The surrender of a registered Community design shall be declared to the Office in writing by the right holder. It shall not have effect until it has been entered in the register.

2. If a Community design which is subject to deferment of publication is surrendered it shall be deemed from the outset not to have had the effects specified in this Regulation.

3. A registered Community design may be partially surrendered provided that its amended form complies with the requirements for protection and the identity of the design is retained.

4. Surrender shall be registered only with the agreement of the proprietor of a right entered in the register. If a licence has been registered, surrender shall be entered in the register only if the right holder in the registered Community design proves that he has informed the licensee of his intention to surrender. This entry shall be made on expiry of the period prescribed by the implementing regulation.

5. If an action pursuant to Article 14 relating to the entitlement to a registered Community design has been brought before a Community design court, the Office shall not enter the surrender in the

register without the agreement of the claimant.

Article 52

Application for a declaration of invalidity

1. Subject to Article 25(2), (3), (4) and (5), any natural or legal person, as well as a public authority empowered to do so, may submit to the Office an application for a declaration of invalidity of a registered Community design.
2. The application shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the fee for an application for a declaration of invalidity has been paid.
3. An application for a declaration of invalidity shall not be admissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a Community design court and has acquired the authority of a final decision.

Article 53

Examination of the application

1. If the Office finds that the application for a declaration of invalidity is admissible, the Office shall examine whether the grounds for invalidity referred to in Article 25 prejudice the maintenance of the registered Community design.
2. In the examination of the application, which shall be conducted in accordance with the implementing regulation, the Office shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Office, on communications from the other parties or issued by itself.
3. The decision declaring the registered Community design invalid shall be entered in the register upon becoming final.

Article 54

Participation in the proceedings of the alleged infringer

1. In the event of an application for a declaration of invalidity of a registered Community design being filed, and as long as no final decision has been taken by the Office, any third party who proves that proceedings for infringement of the same design have been instituted against him may be joined as a party in the invalidity proceedings on request submitted within three months of the date on which the infringement proceedings were instituted.

The same shall apply in respect of any third party who proves both that the right holder of the Community design has requested that he cease an alleged infringement of the design and that he has instituted proceedings for a court ruling that he is not infringing the Community design.

2. The request to be joined as a party shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the invalidity fee, referred to in Article 52(2), has been paid. Thereafter the request shall, subject to any exceptions laid down in the implementing regulation, be treated as an application for a declaration of invalidity.

TITLE VII

APPEALS

Article 55

Decisions subject to appeal

1. An appeal shall lie from decisions of the examiners, the Administration of Trade Marks and Designs and Legal Division and Invalidity Divisions. It shall have suspensive effect.
2. A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

Article 56

Persons entitled to appeal and to be parties to appeal proceedings

Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings as of right.

Article 57

Time limit and form of appeal

Notice of appeal must be filed in writing at the Office within two months after the date of notification of the decision appealed from. The notice shall be deemed to have been filed only when the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

Article 58

Interlocutory revision

1. If the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision. This shall not apply where the appellant is opposed by another party to the proceedings.
2. If the decision is not rectified within one month after receipt of the statement of grounds, the appeal shall be remitted to the Board of Appeal without delay and without comment as to its merits.

Article 59

Examination of appeals

1. If the appeal is admissible, the Board of Appeal shall examine whether the appeal is to be allowed.
2. In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself.

Article 60

Decisions in respect of appeals

1. Following the examination as to the merits of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed against or remit the case to that department for further prosecution.
2. If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same.
3. The decisions of the Boards of Appeal shall take effect only from the date of expiry of the period referred to in Article 61(5) or, if an action has been brought before the Court of Justice within that period, from the date of rejection of such action.

Article 61

Actions before the Court of Justice

1. Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.
2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.
3. The Court of Justice has jurisdiction to annul or to alter the contested decision.
4. The action shall be open to any party to proceedings before the Board of Appeal adversely affected by its decision.
5. The action shall be brought before the Court of Justice within two months of the date of notification of the decision of the Board of Appeal.
6. The Office shall be required to take the necessary measures to comply with the judgment of the Court of Justice.

TITLE VIII

PROCEDURE BEFORE THE OFFICE

Section 1

General provisions

Article 62

Statement of reasons on which decisions are based

Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

Article 63

Examination of the facts by the Office of its own motion

1. In proceedings before it the Office shall examine the facts of its own motion. However, in proceedings relating to a declaration of invalidity, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

2. The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.

Article 64

Oral proceedings

1. If the Office considers that oral proceedings would be expedient, they shall be held either at the instance of the Office or at the request of any party to the proceedings.

2. Oral proceedings, including delivery of the decision, shall be public, unless the department before which the proceedings are taking place decides otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings.

Article 65

Taking of evidence

1. In any proceedings before the Office the means of giving or obtaining evidence shall include the following:

- (a) hearing the parties;
- (b) requests for information;
- (c) the production of documents and items of evidence;
- (d) hearing witnesses;
- (e) opinions by experts;
- (f) statements in writing, sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up.

2. The relevant department of the Office may commission one of its members to examine the evidence

adduced.

3. If the Office considers it necessary for a party, witness or expert to give evidence orally, it shall issue a summons to the person concerned to appear before it.

4. The parties shall be informed of the hearing of a witness or expert before the Office. They shall have the right to be present and to put questions to the witness or expert.

Article 66

Notification

The Office shall, as a matter of course, notify those concerned of decisions and summonses and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Regulation or of the implementing regulation, or of which notification has been ordered by the President of the Office.

Article 67

Restitutio in integrum

1. The applicant for or holder of a registered Community design or any other party to proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the Office shall, upon application, have his rights re-established if the non-observance in question has the direct consequence, by virtue of the provisions of this Regulation, of causing the loss of any rights or means of redress.

2. The application must be filed in writing within two months of the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-submission of the request for renewal of registration or of non-payment of a renewal fee, the further period of six months provided for in the second sentence of Article 13(3) shall be deducted from the period of one year.

3. The application must state the grounds on which it is based and must set out the facts on which it relies. It shall not be deemed to be filed until the fee for the re-establishment of rights has been paid.

4. The department competent to decide on the omitted act shall decide upon the application.

5. The provisions of this Article shall not be applicable to the time limits referred to in paragraph 2 and Article 41(1).

6. Where the applicant for or holder of a registered Community design has his rights re-established, he may not invoke his rights vis-à-vis a third party who, in good faith, in the course of the period between the loss of rights in the application for or registration of the registered Community design and publication of the mention of re-establishment of those rights, has put on the market products in which a design included within the scope of protection of the registered Community design is incorporated or to which it is applied.

7. A third party who may avail himself of the provisions of paragraph 6 may bring third party proceedings against the decision re-establishing the rights of the applicant for or holder of the registered

Community design within a period of two months as from the date of publication of the mention of re-establishment of those rights.

8. Nothing in this Article shall limit the right of a Member State to grant restitutio in integrum in respect of time limits provided for in this Regulation and to be complied with vis-à-vis the authorities of such State.

Article 68

Reference to general principles

In the absence of procedural provisions in this Regulation, the implementing regulation, the fees regulation or the rules of procedure of the Boards of Appeal, the Office shall take into account the principles of procedural law generally recognised in the Member States.

Article 69

Termination of financial obligations

1. Rights of the Office to the payment of fees shall be barred four years from the end of the calendar year in which the fee fell due.
2. Rights against the Office for the refunding of fees or sums of money paid in excess of a fee shall be barred after four years from the end of the calendar year in which the right arose.
3. The periods laid down in paragraphs 1 and 2 shall be interrupted, in the case covered by paragraph 1, by a request for payment of the fee and, in the case covered by paragraph 2, by a reasoned claim in writing. On interruption it shall begin again immediately and shall end at the latest six years after the end of the year in which it originally began, unless in the meantime judicial proceedings to enforce the right have begun. In this case the period shall end at the earliest one year after the judgment has acquired the authority of a final decision.

Section 2

Costs

Article 70

Apportionment of costs

1. The losing party in proceedings for a declaration of invalidity of a registered Community design or appeal proceedings shall bear the fees incurred by the other party as well as all costs incurred by him essential to the proceedings, including travel and subsistence and the remuneration of an agent, adviser or advocate, within the limits of scales set for each category of costs under the conditions laid down in the implementing regulation.
2. However, where each party succeeds on some and fails on other heads, or if reasons of equity so dictate, the Invalidity Division or Board of Appeal shall decide a different apportionment of costs.

3. A party who terminates the proceedings by surrendering the registered Community design or by not renewing its registration or by withdrawing the application for a declaration of invalidity or the appeal, shall bear the fees and the costs incurred by the other party as stipulated in paragraphs 1 and 2.

4. Where a case does not proceed to judgment, the costs shall be at the discretion of the Invalidity Division or Board of Appeal.

5. Where the parties conclude before the Invalidity Division or Board of Appeal a settlement of costs differing from that provided for in paragraphs 1, 2, 3 and 4, the body concerned shall take note of that agreement.

6. On request, the registry of the Invalidity Division or Board of Appeal shall fix the amount of the costs to be paid pursuant to the preceding paragraphs. The amount so determined may be reviewed by a decision of the Invalidity Division or Board of Appeal on a request filed within the period prescribed by the implementing regulation.

Article 71

Enforcement of decisions fixing the amount of costs

1. Any final decision of the Office fixing the amount of costs shall be enforceable.

2. Enforcement shall be governed by the rules of civil procedure in force in the State in the territory of which it is carried out. The order for its enforcement shall be appended to the decision, without any other formality than verification of the authenticity of the decision, by the national authority which the government of each Member State shall designate for this purpose and shall make known to the Office and to the Court of Justice.

3. When these formalities have been completed on application by the party concerned, the latter may proceed to enforcement in accordance with the national law, by bringing the matter directly before the competent authority.

4. Enforcement may be suspended only by a decision of the Court of Justice. However, the courts of the Member State concerned shall have jurisdiction over complaints that enforcement is being carried out in an irregular manner.

Section 3

Informing the public and the official authorities of the Member States

Article 72

Register of Community designs

The Office shall keep a register to be known as the register of Community designs, which shall contain those particulars of which the registration is provided for by this Regulation or by the implementing regulation. The register shall be open to public inspection, except to the extent that Article 50(2) provides otherwise.

Article 73

Periodical publications

1. This Office shall periodically publish a Community Designs Bulletin containing entries open to public inspection in the register as well as other particulars the publication of which is prescribed by this Regulation or by the implementing regulation.
2. Notices and information of a general character issued by the President of the Office, as well as any other information relevant to this Regulation or its implementation, shall be published in the Official Journal of the Office.

Article 74

Inspection of files

1. The files relating to applications for registered Community designs which have not yet been published or the files relating to registered Community designs which are subject to deferment of publication in accordance with Article 50 or which, being subject to such deferment, have been surrendered before or on the expiry of that period, shall not be made available for inspection without the consent of the applicant for or the right holder in the registered Community design.
2. Any person who can establish a legitimate interest may inspect a file without the consent of the applicant for or holder of the registered Community design prior to the publication or after the surrender of the latter in the case provided for in paragraph 1.

This shall in particular apply if the interested person proves that the applicant for or the holder of the registered Community design has taken steps with a view to invoking against him the right under the registered Community design.

3. Subsequent to the publication of the registered Community design, the file may be inspected on request.
4. However, where a file is inspected pursuant to paragraph 2 or 3, certain documents in the file may be withheld from inspection in accordance with the provisions of the implementing regulation.

Article 75

Administrative cooperation

Unless otherwise provided in this Regulation or in national laws, the Office and the courts or authorities of the Member States shall on request give assistance to each other by communicating information or opening files for inspection.

Where the Office opens files 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 74.

Article 76

Exchange of publications

1. The Office and the central industrial property offices of the Member States shall despatch to each other on request and for their own use one or more copies of their respective publications free of charge.
2. The Office may conclude agreements relating to the exchange or supply of publications.

Section 4

Representation

Article 77

General principles of representation

1. Subject to paragraph 2, no person shall be compelled to be represented before the Office.
2. Without prejudice to the second subparagraph of paragraph 3, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must be represented before the Office in accordance with Article 78(1) in all proceedings before the Office established by this Regulation, other than in filing an application for a registered Community design; the implementing regulation may permit other exceptions.
3. Natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the Office by one of their employees, who must file with it a signed authorisation for inclusion in the files, the details of which are set out in the implementing regulation.

An employee of a legal person to which this paragraph applies may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the Community.

Article 78

Professional representation

1. Representation of natural or legal persons in proceedings before the Office under this Regulation may only be undertaken by:
 - (a) any legal practitioner qualified in one of the Member States and having his place of business within the Community, to the extent that he is entitled, within the said State, to act as a representative in industrial property matters; or
 - (b) any professional representatives whose name has been entered on the list of professional representatives referred to in Article 89(1)(b) of the Regulation on the Community [trade mark](#); or

- (c) persons whose names are entered on the special list of professional representatives for design matters referred to in paragraph 4.
2. The persons referred to in paragraph 1(c) shall only be entitled to represent third persons in proceedings on design matters before the Office.
3. The implementing regulation shall provide whether and under what conditions representatives must file with the Office a signed authorisation for insertion on the files.
4. Any natural person may be entered on the special list of professional representatives in design matters, if he fulfils the following conditions:
- (a) he must be a national of one of the Member States;
- (b) he must have his place of business or employment in the Community;
- (c) he must be entitled to represent natural or legal persons in design matters before the central industrial property office of a Member State or before the Benelux Design Office. Where, in that State, the entitlement to represent in design matters is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list must have habitually acted in design matters before the central industrial property office of the said State for at least five years. However, persons whose professional qualification to represent natural or legal persons in design matters before the central industrial property office of one of the Member States is officially recognised in accordance with the regulations laid by such State shall not be subject to the condition of having exercised the profession.
5. Entry on the list referred to in paragraph 4 shall be effected upon request, accompanied by a certificate furnished by the central industrial property office of the Member State concerned, which must indicate that the conditions laid down in the said paragraph are fulfilled.
6. The President of the Office may grant exemption from:
- (a) the requirement of paragraph 4(a) in special circumstances;
- (b) the requirement of paragraph 4(c), second sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way.
7. The conditions under which a person may be removed from the list shall be laid down in the implementing regulation.

TITLE IX

JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO COMMUNITY DESIGNS

Section 1

Jurisdiction and enforcement

Article 79

Application of the Convention on Jurisdiction and Enforcement

1. Unless otherwise specified in this Regulation, the Convention on Jurisdiction and the Enforcement of Judgements in Civil and Commercial Matters, signed in Brussels on 27 September 1968(7), hereinafter referred to as the "Convention on Jurisdiction and Enforcement", shall apply to proceedings relating to Community designs and applications for registered Community designs, as well as to proceedings relating to actions on the basis of Community designs and national designs enjoying simultaneous

protection.

2. The provisions of the Convention on Jurisdiction and Enforcement which are rendered applicable by the paragraph 1 shall have effect in respect of any Member State solely in the text which is in force in respect of that State at any given time.

3. In the event of proceedings in respect of the actions and claims referred to in Article 85:

- (a) Articles 2, 4, 5(1), (3), (4) and (5), 16(4) and 24 of the Convention on Jurisdiction and Enforcement shall not apply;
- (b) Articles 17 and 18 of that Convention shall apply subject to the limitations in Article 82(4) of this Regulation;
- (c) the provisions of Title II of that Convention which are applicable to persons domiciled in a Member State shall also be applicable to persons who do not have a domicile in any Member State but have an establishment therein.

4. The provisions of the Convention on Jurisdiction and Enforcement shall not have effect in respect of any Member State for which that Convention has not yet entered into force. Until such entry into force, proceedings referred to in paragraph 1 shall be governed in such a Member State by any bilateral or multilateral convention governing its relationship with another Member State concerned, or, if no such convention exists, by its domestic law on jurisdiction, recognition and enforcement of decisions.

Section 2

Disputes concerning the infringement and validity of Community designs

Article 80

Community design courts

1. The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance (Community design courts) which shall perform the functions assigned to them by this Regulation.
2. Each Member State shall communicate to the Commission not later than 6 March 2005 a list of Community design courts, indicating their names and their territorial jurisdiction.
3. Any change made after communication of the list referred to in paragraph 2 in the number, names or territorial jurisdiction of the Community design courts shall be notified without delay by the Member State concerned to the Commission.
4. The information referred to in paragraphs 2 and 3 shall be notified by the Commission to the Member States and published in the Official Journal of the European Communities.
5. As long as a Member State has not communicated the list as stipulated in paragraph 2, jurisdiction for any proceedings resulting from an action covered by Article 81 for which the courts of that State have jurisdiction pursuant to Article 82 shall lie with that court of the State in question which would have jurisdiction *ratione loci* and *ratione materiae* in the case of proceedings relating to a national design right of that State.

Article 81

Jurisdiction over infringement and validity

The Community design courts shall have exclusive jurisdiction:

- (a) for infringement actions and - if they are permitted under national law - actions in respect of threatened infringement of Community designs;
- (b) for actions for declaration of non-infringement of Community designs, if they are permitted under national law;
- (c) for actions for a declaration of invalidity of an unregistered Community design;
- (d) for counterclaims for a declaration of invalidity of a Community design raised in connection with actions under (a).

Article 82

International jurisdiction

1. Subject to the provisions of this Regulation and to any provisions of the Convention on Jurisdiction and Enforcement applicable by virtue of Article 79, proceedings in respect of the actions and claims referred to in Article 81 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.

2. If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.

3. If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat.

4. Notwithstanding paragraphs 1, 2 and 3:

- (a) Article 17 of the Convention on Jurisdiction and Enforcement shall apply if the parties agree that a different Community design court shall have jurisdiction;
- (b) Article 18 of that Convention shall apply if the defendant enters an appearance before a different Community design court.

5. Proceedings in respect of the actions and claims referred to in Article 81(a) and (d) may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened.

Article 83

Extent of jurisdiction on infringement

1. A Community design court whose jurisdiction is based on Article 82(1), (2) (3) or (4) shall

have jurisdiction in respect of acts of infringement committed or threatened within the territory of any of the Member States.

2. A Community design court whose jurisdiction is based on Article 82(5) shall have jurisdiction only in respect of acts of infringement committed or threatened within the territory of the Member State in which that court is situated.

Article 84

Action or counterclaim for a declaration of invalidity of a Community design

1. An action or a counterclaim for a declaration of invalidity of a Community design may only be based on the grounds for invalidity mentioned in Article 25.

2. In the cases referred to in Article 25(2), (3), (4) and (5) the action or the counterclaim may be brought solely by the person entitled under those provisions.

3. If the counterclaim is brought in a legal action to which the right holder of the Community design is not already a party, he shall be informed thereof and may be joined as a party to the action in accordance with the conditions set out in the law of the Member State where the court is situated.

4. The validity of a Community design may not be put in issue in an action for a declaration of non-infringement.

Article 85

Presumption of validity - defence as to the merits

1. In proceedings in respect of an infringement action or an action for threatened infringement of a registered Community design, the Community design court shall treat the Community design as valid. Validity may be challenged only with a counterclaim for a declaration of invalidity. However, a plea relating to the invalidity of a Community design, submitted otherwise than by way of counterclaim, shall be admissible in so far as the defendant claims that the Community design could be declared invalid on account of an earlier national design right, within the meaning of Article 25(1)(d), belonging to him.

2. In proceedings in respect of an infringement action or an action for threatened infringement of an unregistered Community design, the Community design court shall treat the Community design as valid if the right holder produces proof that the conditions laid down in Article 11 have been met and indicates what constitutes the individual character of his Community design. However, the defendant may contest its validity by way of a plea or with a counterclaim for a declaration of invalidity.

Article 86

Judgements of invalidity

1. Where in a proceeding before a Community design court the Community design has been put in

issue by way of a counterclaim for a declaration of invalidity:

- (a) if any of the grounds mentioned in Article 25 are found to prejudice the maintenance of the Community design, the court shall declare the Community design invalid;
- (b) if none of the grounds mentioned in Article 25 is found to prejudice the maintenance of the Community design, the court shall reject the counterclaim.

2. The Community design court with which a counterclaim for a declaration of invalidity of a registered Community design has been filed shall inform the Office of the date on which the counterclaim was filed. The latter shall record this fact in the register.

3. The Community design court hearing a counterclaim for a declaration of invalidity of a registered Community design may, on application by the right holder of the registered Community design and after hearing the other parties, stay the proceedings and request the defendant to submit an application for a declaration of invalidity to the Office within a time limit which the court shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Article 91(3) shall apply.

4. Where a Community design court has given a judgment which has become final on a counterclaim for a declaration of invalidity of a registered Community design, a copy of the judgment shall be sent to the Office. Any party may request information about such transmission. The Office shall mention the judgment in the register in accordance with the provisions of the implementing regulation.

5. No counterclaim for a declaration of invalidity of a registered Community design may be made if an application relating to the same subject matter and cause of action, and involving the same parties, has already been determined by the Office in a decision which has become final.

Article 87

Effects of the judgement on invalidity

When it has become final, a judgment of a Community design court declaring a Community design invalid shall have in all the Member States the effects specified in Article 26.

Article 88

Applicable law

1. The Community design courts shall apply the provisions of this Regulation.
2. On all matters not covered by this Regulation, a Community design court shall apply its national law, including its private international law.
3. Unless otherwise provided in this Regulation, a Community design court shall apply the rules of procedure governing the same type of action relating to a national design right in the Member State where it is situated.

Article 89

Sanctions in actions for infringement

1. Where in an action for infringement or for threatened infringement a Community design court finds that the defendant has infringed or threatened to infringe a Community design, it shall, unless there are special reasons for not doing so, order the following measures:

- (a) an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design;
- (b) an order to seize the infringing products;
- (c) an order to seize materials and implements predominantly used in order to manufacture the infringing goods, if their owner knew the effect for which such use was intended or if such effect would have been obvious in the circumstances;
- (d) any order imposing other sanctions appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law.

2. The Community design court shall take such measures in accordance with its national law as are aimed at ensuring that the orders referred to in paragraph 1 are complied with.

Article 90

Provisional measures, including protective measures

1. Application may be made to the courts of a Member State, including Community design courts, for such provisional measures, including protective measures, in respect of a Community design as may be available under the law of that State in respect of national design rights even if, under this Regulation, a Community design court of another Member State has jurisdiction as to the substance of the matter.

2. In proceedings relating to provisional measures, including protective measures, a plea otherwise than by way of counterclaim relating to the invalidity of a Community design submitted by the defendant shall be admissible. Article 85(2) shall, however, apply *mutatis mutandis*.

3. A Community design court whose jurisdiction is based on Article 82(1), (2), (3) or (4) shall have jurisdiction to grant provisional measures, including protective measures, which, subject to any necessary procedure for recognition and enforcement pursuant to Title III of the Convention on Jurisdiction and Enforcement, are applicable in the territory of any Member State. No other court shall have such jurisdiction.

Article 91

Specific rules on related actions

1. A Community design court hearing an action referred to in Article 81, other than an action for a declaration of non-infringement, shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties, or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community design is already in issue before another Community design court on account of a counterclaim or, in the case of a registered Community design, where an application for a declaration of invalidity has

already been filed at the Office.

2. The Office, when hearing an application for a declaration of invalidity of a registered Community design, shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties, or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the registered Community design is already in issue on account of a counterclaim before a Community design court. However, if one of the parties to the proceedings before the Community design court so requests, the court may, after hearing the other parties to these proceedings, stay the proceedings. The Office shall in this instance continue the proceedings pending before it.

3. Where the Community design court stays the proceedings it may order provisional measures, including protective measures, for the duration of the stay.

Article 92

Jurisdiction of Community design courts of second instance - further appeal

1. An appeal to the Community design courts of second instance shall lie from judgments of the Community design courts of first instance in respect of proceedings arising from the actions and claims referred to in Article 81.

2. The conditions under which an appeal may be lodged with a Community design court of second instance shall be determined by the national law of the Member State in which that court is located.

3. The national rules concerning further appeal shall be applicable in respect of judgments of Community design courts of second instance.

Section 3

Other disputes concerning Community designs

Article 93

Supplementary provisions on the jurisdiction of national courts other than Community design courts

1. Within the Member State whose courts have jurisdiction under Article 79(1) or (4), those courts shall have jurisdiction for actions relating to Community designs other than those referred to in Article 81 which would have jurisdiction *ratione loci* and *ratione materiae* in the case of actions relating to a national design right in that State.

2. Actions relating to a Community design, other than those referred to in Article 81, for which no court has jurisdiction pursuant to Article 79(1) and (4) and paragraph 1 of this Article may be heard before the courts of the Member State in which the Office has its seat.

Article 94

Obligation of the national court

A national court which is dealing with an action relating to a Community design other than the

actions referred to in Article 81 shall treat the design as valid. Articles 85(2) and 90(2) shall, however, apply *mutatis mutandis*.

TITLE X

EFFECTS ON THE LAWS OF THE MEMBER STATES

Article 95

Parallel actions on the basis of Community designs and national design rights

1. Where actions for infringement or for threatened infringement involving the same cause of action and between the same parties are brought before the courts of different Member States, one seized on the basis of a Community design and the other seized on the basis of a national design right providing simultaneous protection, the court other than the court first seized shall of its own motion decline jurisdiction in favour of that court. The court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested.
2. The Community design court hearing an action for infringement or threatened infringement on the basis of a Community design shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of a design right providing simultaneous protection.
3. The court hearing an action for infringement or for threatened infringement on the basis of a national design right shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of a Community design providing simultaneous protection.
4. Paragraphs 1, 2 and 3 shall not apply in respect of provisional measures, including protective measures.

Article 96

Relationship to other forms of protection under national law

1. The provisions of this Regulation shall be without prejudice to any provisions of Community law or of the law of the Member States concerned relating to unregistered designs, trade marks or other distinctive signs, patents and utility models, typefaces, civil liability and unfair competition.
2. A design protected by a Community design shall also be eligible for protection under the law of copyright of Member States as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State.

TITLE XI

SUPPLEMENTARY PROVISIONS CONCERNING THE OFFICE

Section 1

General provisions

Article 97

General provision

Unless otherwise provided in this Title, Title XII of the Regulation on the Community [trade mark](#) shall apply to the Office with regard to its tasks under this Regulation.

Article 98

Language of proceedings

1. The application for a registered Community design shall be filed in one of the official languages of the Community.

2. The applicant must indicate a second language which shall be a language of the Office the use of which he accepts as a possible language of proceedings before the Office.

If the application was filed in a language which is not one of the languages of the Office, the Office shall arrange to have the application translated into the language indicated by the applicant.

3. Where the applicant for a registered Community design is the sole party to proceedings before the Office, the language of proceedings shall be the language used for filing the application. If the application was made in a language other than the languages of the Office, the Office may send written communications to the applicant in the second language indicated by the applicant in his application.

4. In the case of invalidity proceedings, the language of proceedings shall be the language used for filing the application for a registered Community design if this is one of the languages of the Office. If the application was made in a language other than the languages of the Office, the language of proceedings shall be the second language indicated in the application.

The application for a declaration of invalidity shall be filed in the language of proceedings.

Where the language of proceedings is not the language used for filing the application for a registered Community design, the right holder of the Community design may file observations in the language of filing. The Office shall arrange to have those observations translated into the language of proceedings.

The implementing regulation may provide that the translation expenses to be borne by the Office may not, subject to a derogation granted by the Office where justified by the complexity of the case, exceed an amount to be fixed for each category of proceedings on the basis of the average size of statements of case received by the Office. Expenditure in excess of this amount may be allocated to the losing party in accordance with Article 70.

5. Parties to invalidity proceedings may agree that a different official language of the Community is to be the language of the proceedings.

Article 99

Publication and register

1. All information the publication of which is prescribed by this Regulation or the implementing regulation shall be published in all the official languages of the Community.
2. All entries in the Register of Community designs shall be made in all the official languages of the Community.
3. In cases of doubt, the text in the language of the Office in which the application for a registered Community design was filed shall be authentic. If the application was filed in an official language of the Community other than one of the languages of the Office, the text in the second language indicated by the applicant shall be authentic.

Article 100

Supplementary powers of the President

In addition to the functions and powers conferred on the President of the Office by Article 119 of the Regulation on the Community [trade mark](#), the President may place before the Commission any proposal to amend this Regulation, the implementing regulation, the fees regulation and any other rule to the extent that they apply to registered Community designs, after consulting the Administrative Board and, in the case of the fees regulation, the Budget Committee.

Article 101

Supplementary powers of the Administrative Board

In addition to the powers conferred on it by Article 121 et seq of the Regulation on the Community [trade mark](#) or by other provisions of this Regulation, the Administrative Board;

- (a) shall set the date for the first filing of applications for registered Community designs pursuant to Article 111(2);
- (b) shall be consulted before adoption of the guidelines for examination as to formal requirements, examination as to grounds for refusal of registration and invalidity proceedings in the Office and in the other cases provided for in this Regulation.

Section 2

Procedures

Article 102

Competence

For taking decisions in connection with the procedures laid down in this Regulation the following shall be competent:

- (a) examiners;
- (b) the Administration of Trade Marks and Designs and Legal Division;
- (c) Invalidity Divisions;

(d) Boards of Appeal.

Article 103

Examiners

An examiner shall be responsible for taking decisions on behalf of the Office in relation to an application for a registered Community design.

Article 104

The Administration of Trade Marks and Designs and Legal Division

1. The Administration of Trade Marks and Legal Division provided for by Article 128 of the Regulation on the Community [trade mark](#) shall become the Administration of Trade Marks and Designs and Legal Division.

2. In addition to the powers conferred upon it by the Regulation on the Community [trade mark](#), it shall be responsible for taking those decisions required by this Regulation which do not fall within the competence of an examiner or an Invalidity Division. It shall in particular be responsible for decisions in respect of entries in the register.

Article 105

Invalidity Divisions

1. An Invalidity Division shall be responsible for taking decisions in relation to applications for declarations of invalidity of registered Community designs.

2. An Invalidity Division shall consist of three members. At least one of the members must be legally qualified.

Article 106

Boards of Appeal

In addition to the powers conferred upon it by Article 131 of the Regulation on the Community [trade mark](#), the Boards of Appeal instituted by that Regulation shall be responsible for deciding on appeals from decisions of the examiners, the Invalidity Divisions and from the decisions of the Administration of Trade Marks and Designs and Legal Division as regards their decisions concerning Community designs.

TITLE XII

FINAL PROVISIONS

Article 107

Implementing regulation

1. The rules implementing this Regulation shall be adopted in an implementing regulation.

2. In addition to the fees already provided for in this Regulation, fees shall be charged, in accordance with the detailed rules of application laid down in the implementing regulation and in a fees regulation, in the cases listed below:

- (a) late payment of the registration fee;
- (b) late payment of the publication fee;
- (c) late payment of the fee for deferment of publication;
- (d) late payment of additional fees for multiple applications;
- (e) issue of a copy of the certificate of registration;
- (f) registration of the transfer of a registered Community design;
- (g) registration of a licence or another right in respect of a registered Community design;
- (h) cancellation of the registration of a licence or another right;
- (i) issue of an extract from the register;
- (j) inspection of the files;
- (k) issue of copies of file documents;
- (l) communication of information in a file;
- (m) review of the determination of the procedural costs to be refunded;
- (n) issue of certified copies of the application.

3. The implementing regulation and the fees regulation shall be adopted and amended in accordance with the procedure laid down in Article 109(2).

Article 108

Rules of procedure of the Boards of Appeal

The rules of procedure of the Boards of Appeal shall apply to appeals heard by those Boards under this Regulation, without prejudice to any necessary adjustment or additional provision, adopted in accordance with the procedure laid down in Article 109(2).

Article 109

Committee

1. The Commission shall be assisted by a Committee.
2. Where reference is made to this paragraph, Articles 5 and 7 of Decision 1999/468/EC shall

apply.

The period laid down in Article 5(6) of Decision 1999/468/EC shall be set at three months.

3. The Committee shall adopt its rules of procedure

Article 110

Transitional provision

1. Until such time as amendments to this Regulation enter into force on a proposal from the Commission on this subject, protection as a Community design shall not exist for a design which constitutes a component part of a complex product used within the meaning of Article 19(1) for the purpose of the repair of that complex product so as to restore its original appearance.

2. The proposal from the Commission referred to in paragraph 1 shall be submitted together with, and take into consideration, any changes which the Commission shall propose on the same subject pursuant to Article 18 of [Directive 98/71/EC](#).

Article 111

Entry into force

1. This Regulation shall enter into force on the 60th day following its publication in the Official Journal of the European Communities.

2. Applications for registered Community designs may be filed at the Office from the date fixed by the Administrative Board on the recommendation of the President of the Office.

3. Applications for registered Community designs filed within three months before the date referred to in paragraph 2 shall be deemed to have been filed on that date.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 12 December 2001.

For the Council

The President

M. Aelvoet

(1) OJ C 29, 31.1.1994, p. 20 and OJ C 248, 29.8.2000, p. 3.

(2) OJ C 67, 1.3.2001, p. 318.

(3) OJ C 110, 2.5.1995 and OJ C 75, 15.3.2000, p. 35.

(4) OJ L 289, 28.10.1998, p. 28.

(5) OJ L 184, 17.7.1999, p. 23.

(6) OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Regulation (EC) No 3288/94 (OJ L 349, 31.12.1994, p. 83).

(7) OJ L 299, 31.12.1972, p. 32. Convention as amended by the Conventions on the Accession to that Convention of the States acceding to the European Communities.

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**Commission Regulation (EC) No 2245/2002
of 21 October 2002
implementing Council Regulation (EC) No 6/2002 on Community designs**

Commission Regulation (EC) No 2245/2002

of 21 October 2002

implementing Council Regulation (EC) No 6/2002 on Community designs

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs(1), and in particular Article 107(3) thereof,

Whereas:

- (1) Regulation (EC) No 6/2002 creates a system enabling a design having effect throughout the Community to be obtained on the basis of an application to the Office for Harmonisation in the Internal Market (trade marks and designs) (hereinafter "the Office").
- (2) For this purpose, Regulation (EC) No 6/2002 contains the necessary provisions for a procedure leading to the registration of a Community design, as well as for the administration of registered Community designs, for appeals against decisions of the Office and for proceedings for the invalidation of a Community design.
- (3) The present Regulation lays down the necessary measures for implementing the provisions of Regulation (EC) No 6/2002.
- (4) This Regulation should ensure the smooth and efficient operation of design proceedings before the Office.
- (5) The measures provided for in this Regulation are in accordance with the opinion of the Committee established under Article 109 of Regulation (EC) No 6/2002,

HAS ADOPTED THIS REGULATION:

CHAPTER I

APPLICATION PROCEDURE

Article 1

Content of the application

1. The application for a registered Community design shall contain:

- (a) a request for registration of the design as a registered Community design;
- (b) the name, address and nationality of the applicant and the State in which the applicant is domiciled or in which it has its seat or establishment. Names of natural persons shall take the form of the family name and the given name(s). Names of legal entities shall be indicated by their official designation, which may be abbreviated in a customary manner; furthermore, the State whose law governs such entities shall be indicated.

The telephone numbers as well as fax numbers and details of other data-communications links, such as electronic mail, may be given. Only one address shall, in principle, be indicated for each applicant;

where several addresses are indicated, only the address mentioned first shall be taken into account, except where the applicant designates one of the addresses as an address for service. If the Office has given the applicant an identification number, it shall be sufficient to mention that number together with the name of the applicant;

- (c) a representation of the design in accordance with Article 4 of this Regulation or, if the application concerns a two-dimensional design and contains a request for deferment of publication in accordance with Article 50 of Regulation (EC) No 6/2002, a specimen in accordance with Article 5 of this Regulation;
- (d) an indication, in accordance with Article 3(3), of the products in which the design is intended to be incorporated or to which it is intended to be applied;
- (e) if the applicant has appointed a representative, the name of that representative and the address of his/her place of business in accordance with point (b); if the representative has more than one business address or if there are two or more representatives with different business addresses, the application shall indicate which address shall be used as an address for service; where no such indication is made, only the first-mentioned address shall be taken into account as an address for service. If there is more than one applicant, the application may indicate the appointment of one applicant or representative as common representative. If an appointed representative has been given an identification number by the Office, it shall be sufficient to mention that number together with the name of the representative;
- (f) if applicable, a declaration that priority of a previous application is claimed pursuant to Article 42 of Regulation (EC) No 6/2002, stating the date on which the previous application was filed and the country in which or for which it was filed;
- (g) if applicable, a declaration that exhibition priority is claimed pursuant to Article 44 of Regulation (EC) No 6/2002, stating the name of the exhibition and the date of the first disclosure of the products in which the design is incorporated or to which it is applied;
- (h) a specification of the language in which the application is filed, and of the second language pursuant to Article 98(2) of Regulation (EC) No 6/2002;
- (i) the signature of the applicant or his/her representative in accordance with Article 65.

2. The application may contain:

- (a) a single description per design not exceeding 100 words explaining the representation of the design or the specimen; the description must relate only to those features which appear in the reproductions of the design or the specimen; it shall not contain statements as to the purported novelty or individual character of the design or its technical value;
- (b) a request for deferment of publication of registration in accordance with Article 50(1) of Regulation (EC) No 6/2002;
- (c) an indication of the "Locarno classification" of the products contained in the application, that is to say, of the class or classes and the subclass or subclasses to which they belong in accordance with the Annex to the Agreement establishing an international classification for industrial designs, signed at Locarno on 8 October 1968 (hereinafter "the Locarno Agreement"), referred to in Article 3 and subject to Article 2(2);
- (d) the citation of the designer or of the team of designers or a statement signed by the applicant to the effect that the designer or team of designers has waived the right to be cited under Article 36(3)(e) of Regulation (EC) No 6/2002.

Article 2

Multiple application

1. An application may be a multiple application requesting the registration of several designs.
2. When several designs other than ornamentation are combined in a multiple application, the application shall be divided if the products in which the designs are intended to be incorporated or to which they are intended to be applied belong to more than one class of the Locarno Classification.
3. For each design contained in the multiple application the applicant shall provide a representation of the design in accordance with Article 4 and the indication of the product in which the design is intended to be incorporated or to be applied.
4. The applicant shall number the designs contained in the multiple application consecutively, using arabic numerals.

Article 3

Classification and indication of products

1. Products shall be classified in accordance with Article 1 of the Locarno Agreement, as amended and in force at the date of filing of the design.
2. The classification of products shall serve exclusively administrative purposes.
3. The indication of products shall be worded in such a way as to indicate clearly the nature of the products and to enable each product to be classified in only one class of the Locarno classification, preferably using the terms appearing in the list of products set out therein.
4. The products shall be grouped according to the classes of the Locarno classification, each group being preceded by the number of the class to which that group of products belongs and presented in the order of the classes and subclasses under that classification.

Article 4

Representation of the design

1. The representation of the design shall consist in a graphic or photographic reproduction of the design, either in black and white or in colour. It shall meet the following requirements:
 - (a) save where the application is filed by electronic means pursuant to Article 67, the representation must be filed on separate sheets of paper or reproduced on the page provided for that purpose in the form made available by the Office pursuant to Article 68;
 - (b) in the case of separate sheets of paper, the design shall be reproduced on opaque white paper and either pasted or printed directly on it. Only one copy shall be filed and the sheets of paper shall not be folded or stapled;
 - (c) the size of the separate sheet shall be DIN A4 size (29,7 cm x 21 cm) and the space used for the reproduction shall be no larger than 26,2 cm x 17 cm. A margin of at least 2,5 cm shall be

left on the left-hand side; at the top of each sheet of paper the number of views shall be indicated pursuant to paragraph 2 and, in the case of a multiple application, the consecutive number of the design; no explanatory text, wording or symbols, other than the indication "top" or the name or address of the applicant, may be displayed thereon;

- (d) where the application is filed by electronic means, the graphic or photographic reproduction of the designs shall be in a data format determined by the President of the Office; the manner of identifying the different designs contained in a multiple application, or the different views, shall be determined by the President of the Office;
- (e) the design shall be reproduced on a neutral background and shall not be retouched with ink or correcting fluid. It shall be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size no greater than 8 cm by 16 cm per view for entry in the Register of Community Designs provided for in Article 72 of Regulation (EC) No 6/2002, hereinafter "the Register", and for direct publishing in the Community Designs Bulletin referred to in Article 73 of that Regulation.

2. The representation may contain no more than seven different views of the design. Any one graphic or photographic reproduction may contain only one view. The applicant shall number each view using arabic numerals. The number shall consist of separate numerals separated by a point, the numeral to the left of the point indicating the number of the design, that to the right indicating the number of the view.

In cases where more than seven views are provided, the Office may disregard for registration and publication any of the extra views. The Office shall take the views in the consecutive order in which the views are numbered by the applicant.

3. Where an application concerns a design that consists in a repeating surface pattern, the representation of the design shall show the complete pattern and a sufficient portion of the repeating surface.

The size limits set out in paragraph 1(c) shall apply.

4. Where an application concerns a design consisting in a typographic typeface, the representation of the design shall consist in a string of all the letters of the alphabet, in both upper and lower case, and of all the arabic numerals, together with a text of five lines produced using that typeface, both letters and numerals being in the size pitch 16.

Article 5

Specimens

1. Where the application concerns a two-dimensional design and contains a request for a deferment of publication, in accordance with Article 50(1) of Regulation (EC) No 6/2002, the representation of the design may be replaced by a specimen pasted on a sheet of paper.

Applications for which a specimen is submitted must be sent by a single mail or directly delivered to the office of filing.

Both the application and the specimen shall be submitted at the same time.

2. The specimens shall not exceed 26,2 cm x 17 cm in size, 50 grams in weight or 3 mm in thickness. The specimen shall be capable of being stored, unfolded, alongside documents of the size prescribed in Article 4(1)(c).

3. Specimens that are perishable or dangerous to store shall not be filed.

The specimen shall be filed in five copies; in the case of a multiple application, five copies of the specimen shall be filed for each design.

4. Where the design concerns a repeating surface pattern, the specimen shall show the complete pattern and a sufficient portion of the repeating surface in length and width. The limits set out in paragraph 2 shall apply.

Article 6

Fees for the application

1. The following fees shall be paid at the time when the application is submitted to the Office:

- (a) the registration fee;
- (b) the publication fee or a deferment fee if deferment of publication has been requested;
- (c) an additional registration fee in respect of each additional design included in a multiple application;
- (d) an additional publication fee in respect of each additional design included in a multiple application, or an additional deferment fee in respect of each additional design included in a multiple application if deferment of publication has been requested.

2. Where the application includes a request for deferment of publication of registration, the publication fee and any additional publication fee in respect of each additional design included in a multiple application shall be paid within the time limits specified in Article 15(4).

Article 7

Filing of the application

1. The Office shall mark the documents making up the application with the date of its receipt and the file number of the application.

Each design contained in a multiple application shall be numbered by the Office in accordance with a system determined by the President.

The Office shall issue to the applicant without delay a receipt which shall specify the file number, the representation, description or other identification of the design, the nature and the number of the documents and the date of their receipt.

In the case of a multiple application, the receipt issued by the Office shall specify the first design and the number of designs filed.

2. If the application is filed with the central industrial property office of a Member State or at the Benelux Design Office in accordance with Article 35 of Regulation (EC) No 6/2002, the office of filing shall number each page of the application, using arabic numerals. The office of filing shall mark the documents making up the application with the date of receipt and the number of pages before forwarding the application to the Office.

The office of filing shall issue to the applicant without delay a receipt specifying the nature and the number of the documents and the date of their receipt.

3. If the Office receives an application forwarded by the central industrial property office of

a Member State or the Benelux Design Office, it shall mark the application with the date of receipt and the file number and shall issue to the applicant without delay a receipt in accordance with the third and fourth subparagraphs of paragraph 1, indicating the date of receipt at the Office.

Article 8

Claiming priority

1. Where the priority of one or more previous applications is claimed in the application pursuant to Article 42 of Regulation (EC) No 6/2002, the applicant shall indicate the file number of the previous application and file a copy of it within three months of the filing date referred to in Article 38 of that Regulation. The President of the Office shall determine the evidence to be provided by the applicant.

2. Where, subsequent to the filing of the application, the applicant wishes to claim the priority of one or more previous applications pursuant to Article 42 of Regulation (EC) No 6/2002, he/she shall submit, within one month of the filing date, the declaration of priority, stating the date on which and the country in or for which the previous application was made.

The applicant shall submit to the Office the indications and evidence referred to in paragraph 1 within three months of receipt of the declaration of priority.

Article 9

Exhibition priority

1. Where exhibition priority has been claimed in the application pursuant to Article 44 of Regulation (EC) No 6/2002, the applicant shall, together with the application or at the latest within three months of the filing date, file a certificate issued at the exhibition by the authority responsible for the protection of industrial property at the exhibition.

That certificate shall declare that the design was incorporated in or applied to the product and disclosed at the exhibition, and shall state the opening date of the exhibition and, where the first disclosure of the product did not coincide with the opening date of the exhibition, the date of such first disclosure. The certificate shall be accompanied by an identification of the actual disclosure of the product, duly certified by that authority.

2. Where the applicant wishes to claim an exhibition priority subsequent to the filing of the application, the declaration of priority, indicating the name of the exhibition and the date of the first disclosure of the product in which the design was incorporated or to which it was applied, shall be submitted within one month of the filing date. The indications and evidence referred to in paragraph 1 shall be submitted to the Office within three months of receipt of the declaration of priority.

Article 10

Examination of requirements for a filing date and of formal requirements

1. The Office shall notify the applicant that a date of filing cannot be granted if the application does not contain:

- (a) a request for registration of the design as a registered Community design;
- (b) information identifying the applicant;
- (c) a representation of the design pursuant to Article 4(1)(d) and (e) or, where applicable, a specimen.

2. If the deficiencies indicated in paragraph 1 are remedied within two months of receipt of the notification, the date on which all the deficiencies are remedied shall determine the date of filing.

If the deficiencies are not remedied before the time limit expires, the application shall not be dealt with as a Community design application. Any fees paid shall be refunded.

3. The Office shall call upon the applicant to remedy the deficiencies noted within a time limit specified by it where, although a date of filing has been granted, the examination reveals that:

- (a) the requirements set out in Articles 1, 2, 4 and 5 or the other formal requirements for applications laid down in the Regulation (EC) No 6/2002 or in this Regulation have not been complied with;
- (b) the full amount of the fees payable pursuant to Article 6(1), read in conjunction with Commission Regulation (EC) No 2246/2002(2), has not been received by the Office;
- (c) where priority has been claimed pursuant to Articles 8 and 9, either in the application itself or within one month after the date of filing, the other requirements set out in those Articles have not been complied with;
- (d) in the case of a multiple application, the products in which the designs are intended to be incorporated or to which they are intended to be applied belong to more than one class of the Locarno classification.

In particular, the Office shall call upon the applicant to pay the required fees within two months of the date of notification, together with the late payment fees provided for in Article 107(2)(a) to (d) of Regulation (EC) No 6/2002 and as set out in Regulation (EC) No 2246/2002.

In the case of the deficiency referred to in point (d) of the first subparagraph, the Office shall call upon the applicant to divide the multiple application in order to ensure compliance with the requirements under Article 2(2). It shall also call upon the applicant to pay the total amount of the fees for all the applications resulting from the separation of the multiple application, within such a time limit as it may specify.

After the applicant has complied with the request to divide the application within the time limit set, the date of filing of the resulting application or applications shall be the date of filing granted to the multiple application initially filed.

4. If the deficiencies referred to in paragraph 3(a) and (d) are not remedied before the time limit expires, the Office shall reject the application.

5. If the fees payable pursuant to Article 6(1)(a) and (b) are not paid before the time limit expires, the Office shall reject the application.

6. If any additional fees payable pursuant to Article 6(1)(c) or (d) in respect of multiple applications are not paid or not paid in full before the time limit expires, the Office shall reject the application in respect of all the additional designs which are not covered by the amount paid.

In the absence of any criteria for determining which designs are intended to be covered, the Office shall take the designs in the numerical order in which they are represented in accordance with Article 2(4). The Office shall reject the application in so far as it concerns designs for which additional fees have not been paid or have not been paid in full.

7. If the deficiencies referred to in paragraph 3(c) are not remedied before the time limit expires, the right of priority for the application shall be lost.

8. If any of the deficiencies referred to in paragraph 3 is not remedied before the time limit expires and such deficiency concerns only some of the designs contained in a multiple application, the Office shall reject the application, or the right of priority shall be lost, only in so far as those designs are concerned.

Article 11

Examination of grounds for non-registrability

1. Where, pursuant to Article 47 of Regulation (EC) No 6/2002, the Office finds, in the course of carrying out the examination under Article 10 of this Regulation, that the design for which protection is sought does not correspond to the definition of design provided in Article 3(a) of Regulation (EC) No 6/2002 or that the design is contrary to public policy or to accepted principles of morality, it shall inform the applicant that the design is non-registrable, specifying the ground for non-registrability.

2. The Office shall specify a time limit within which the applicant may submit his/her observations, withdraw the application or amend it by submitting an amended representation of the design, provided that the identity of the design is retained.

3. Where the applicant fails to overcome the grounds for non-registrability within the time limit, the Office shall refuse the application. If those grounds concern only some of the designs contained in a multiple application, the Office shall refuse the application only in so far as those designs are concerned.

Article 12

Withdrawal or correction of the application

1. The applicant may at any time withdraw a Community design application or, in the case of a multiple application, withdraw some of the designs contained in the application.

2. Only the name and address of the applicant, errors of wording or of copying, or obvious mistakes may be corrected, at the request of the applicant and provided that such correction does not change the representation of the design.

3. An application for the correction of the application pursuant to paragraph 2 shall contain:

- (a) the file number of the application;
- (b) the name and the address of the applicant in accordance with Article 1(1)(b);
- (c) where the applicant has appointed a representative, the name and the business address of the representative in accordance with Article 1(1)(e);
- (d) the indication of the element of the application to be corrected and that element in its corrected version.

4. If the requirements for the correction of the application are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within the time

limits specified by the Office, the Office shall reject the application for correction.

5. A single application may be made for the correction of the same element in two or more applications submitted by the same applicant.

6. Paragraphs 2 to 5 shall apply *mutatis mutandis* to applications to correct the name or the business address of a representative appointed by the applicant.

CHAPTER II

REGISTRATION PROCEDURE

Article 13

Registration of the design

1. If the application satisfies the requirements referred to in Article 48 of Regulation (EC) No 6/2002, the design contained in that application and the particulars set out in Article 69(2) of this Regulation shall be recorded in the Register.

2. If the application contains a request for deferment of publication pursuant to Article 50 of Regulation (EC) No 6/2002, that fact and the date of expiry of the period of deferment shall be recorded.

3. The fees payable pursuant to Article 6(1) shall not be refunded even if the design applied for is not registered.

Article 14

Publication of the registration

1. The registration of the design shall be published in the Community Designs Bulletin.

2. Subject to paragraph 3, the publication of the registration shall contain:

- (a) the name and address of the holder of the Community design (hereinafter "the holder");
- (b) where applicable, the name and business address of the representative appointed by the holder other than a representative falling within the first subparagraph of Article 77(3) of Regulation (EC) No 6/2002; if more than one representative has the same business address, only the name and business address of the first-named representative shall be published, the name being followed by the words "et al"; if there are two or more representatives with different business addresses, only the address for service determined pursuant to Article 1(1)(e) of this Regulation shall be published; where an association of representatives is appointed pursuant to Article 62(9) only the name and business address of the association shall be published;
- (c) the representation of the design pursuant to Article 4; where the representation of the design is in colour, the publication shall be in colour;
- (d) where applicable, an indication that a description has been filed pursuant to Article 1(2)(a);
- (e) an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied, preceded by the number of the relevant classes and subclasses of the Locarno classification, and grouped accordingly;

- (f) where applicable, the name of the designer or the team of designers;
- (g) the date of filing and the file number and, in the case of a multiple application, the file number of each design;
- (h) where applicable, particulars of the claim of priority pursuant to Article 42 of Regulation (EC) No 6/2002;
- (i) where applicable, particulars of the claim of exhibition priority pursuant to Article 44 of Regulation (EC) No 6/2002;
- (j) the date and the registration number and the date of the publication of the registration;
- (k) the language in which the application was filed and the second language indicated by the applicant pursuant to Article 98(2) of Regulation (EC) No 6/2002.

3. If the application contains a request for deferment of publication pursuant to Article 50 of Regulation (EC) No 6/2002, a mention of the deferment shall be published in the Community Designs Bulletin, together with the name of the holder, the name of the representative, if any, the date of filing and registration, and the file number of the application. Neither the representation of the design nor any particulars identifying its appearance shall be published.

Article 15

Deferment of publication

1. Where the application contains a request for deferment of publication pursuant to Article 50 of Regulation (EC) No 6/2002, the holder shall, together with the request or at the latest three months before the 30-month deferment period expires:

- (a) pay the publication fee referred to in Article 6(1)(b);
- (b) in the case of a multiple registration, pay the additional publication fees, referred to in Article 6(1)(d);
- (c) in cases where a representation of the design has been replaced by a specimen in accordance with Article 5, file a representation of the design in accordance with Article 4. This applies to all the designs contained in a multiple application for which publication is requested;
- (d) in the case of a multiple registration, clearly indicate which of the designs contained therein is to be published or which of the designs are to be surrendered, or, if the period of deferment has not yet expired, for which designs deferment is to be continued.

Where the holder requests publication before the expiry of the 30-month deferment period, he/she shall, at the latest three months before the requested date of publication, comply with the requirements set out in points (a) to (d) of the first paragraph.

2. If the holder fails to comply with the requirements set out in paragraph 1(c) or (d), the Office shall call upon him/her to remedy the deficiencies within a specified time limit which shall in no case expire after the 30-month deferment period.

3. If the holder fails to remedy the deficiencies referred to in paragraph 2 within the applicable time limit:

- (a) the registered Community design shall be deemed from the outset not to have had the effects specified in Regulation (EC) No 6/2002;

(b) where the holder has requested earlier publication as provided for under the second subparagraph of paragraph 1, the request shall be deemed not to have been filed.

4. If the holder fails to pay the fees referred to in paragraph 1(a) or (b), the Office shall call upon him/her to pay those fees together with the fees for late payment provided for in Article 107(2)(b) or (d) of Regulation (EC) No 6/2002 and as set out in Regulation (EC) No 2246/2002, within a specified time limit which shall in no case expire after the 30-month deferment period.

If no payment has been made within that time limit, the Office shall notify the holder that the registered Community design has from the outset not had the effects specified in Regulation (EC) No 6/2002.

If, in respect of a multiple registration, a payment is made within that time limit but is insufficient to cover all the fees payable pursuant to paragraph 1(a) and (b), as well as the applicable fee for late payment, all the designs in respect of which the fees have not been paid shall be deemed from the outset not to have had the effects specified in Regulation (EC) No 6/2002.

Unless it is clear which designs the amount paid is intended to cover, and in the absence of other criteria for determining which designs are intended to be covered, the Office shall take the designs in the numerical order in which they are represented in accordance with Article 2(4).

All designs for which the additional publication fee has not been paid or has not been paid in full, together with the applicable fee for late payment, shall be deemed from the outset not to have had the effects specified in Regulation (EC) No 6/2002.

Article 16

Publication after the period for deferment

1. Where the holder has complied with the requirements laid down in Article 15, the Office shall, at the expiry of the period for deferment or in the case of a request for earlier publication, as soon as is technically possible:

- (a) publish the registered Community design in the Community Designs Bulletin, with the indications set out in Article 14(2), together with an indication of the fact that the application contained a request for deferment of publication pursuant to Article 50 of Regulation (EC) No 6/2002 and, where applicable, that a specimen was filed in accordance with Article 5 of this Regulation;
- (b) make available for public inspection any file relating to the design;
- (c) open to public inspection all the entries in the Register, including any entries withheld from inspection pursuant to Article 73.

2. Where Article 15(4) applies, the actions referred to in paragraph 1 of this Article shall not take place in respect of those designs contained in the multiple registration which are deemed from the outset not to have had the effects specified in Regulation (EC) No 6/2002.

Article 17

Certificate of registration

1. After publication, the Office shall issue to the holder a certificate of registration which

shall contain the entries in the Register provided for in Article 69(2) and a statement to the effect that those entries have been recorded in the Register.

2. The holder may request that certified or uncertified copies of the certificate of registration be supplied to him/her upon payment of a fee.

Article 18

Maintenance of the design in an amended form

1. Where, pursuant to Article 25(6) of Regulation (EC) No 6/2002, the registered Community design is maintained in an amended form, the Community design in its amended form shall be entered in the Register and published in the Community Designs Bulletin.

2. Maintenance of a design in an amended form may include a partial disclaimer, not exceeding 100 words, by the holder or an entry in the Register of Community Designs of a court decision or a decision by the Office declaring the partial invalidity of the design right.

Article 19

Change of the name or address of the holder or of his/her registered representative

1. A change of the name or address of the holder which is not the consequence of a transfer of the registered design shall, at the request of the holder, be recorded in the Register.

2. An application for a change of the name or address of the holder shall contain:

- (a) the registration number of the design;
- (b) the name and the address of the holder as recorded in the Register. If the holder has been given an identification number by the Office, it shall be sufficient to indicate that number together with the name of the holder;
- (c) the indication of the name and address of the holder, as changed, in accordance with Article 1(1)(b);
- (d) where the holder has appointed a representative, the name and business address of the representative, in accordance with Article 1(1)(e).

3. The application referred to in paragraph 2 shall not be subject to payment of a fee.

4. A single application may be made for a change of the name or address in respect of two or more registrations of the same holder.

5. If the requirements set out in paragraphs 1 and 2 are not fulfilled, the Office shall communicate the deficiency to the applicant.

If the deficiency is not remedied within the time limits specified by the Office, the Office shall reject the application.

6. Paragraphs 1 to 5 shall apply *mutatis mutandis* to a change of the name or address of the registered representative.

7. Paragraphs 1 to 6 shall apply *mutatis mutandis* to applications for Community designs. The change shall be recorded in the files kept by the Office concerning the Community design application.

Article 20

Correction of mistakes and errors in the Register and in the publication of the registration

Where the registration of a design or the publication of the registration contains a mistake or error attributable to the Office, the Office shall correct the error or mistake of its own motion or at the request of the holder.

Where such a request is made by the holder, Article 19 shall apply *mutatis mutandis*. The request shall not be subject to payment of a fee.

The Office shall publish the corrections made pursuant to this Article.

CHAPTER III

RENEWAL OF REGISTRATION

Article 21

Notification of expiry of registration

At least six months before expiry of the registration, the Office shall inform the holder, and any person having a right entered in the Register, including a licence, in respect of the Community design, that the registration is approaching expiry. Failure to give notification shall not affect the expiry of the registration.

Article 22

Renewal of registration

1. An application for renewal of registration shall contain:

- (a) where the application is filed by the holder, his/her name and address in accordance with Article 1(1)(b);
- (b) where the application is filed by a person expressly authorised to do so by the holder, the name and address of that person and evidence that he/she is authorised to file the application;
- (c) where the applicant has appointed a representative, the name and business address of the representative in accordance with Article 1(1)(e);
- (d) the registration number;
- (e) where applicable, an indication that renewal is requested for all the designs covered by a multiple registration or, if the renewal is not requested for all such designs, an indication of those designs for which renewal is requested.

2. The fees payable pursuant to Article 13 of Regulation (EC) No 6/2002 for the renewal of a registration shall consist of:

- (a) a renewal fee, which, in cases where several designs are covered by a multiple registration, shall be proportionate to the number of designs covered by the renewal;

(b) where applicable, the additional fee for late payment of the renewal fee or late submission of the request for renewal, pursuant to Article 13 of Regulation (EC) No 6/2002, as specified in Regulation (EC) No 2246/2002.

3. Where the application for renewal is filed within the time limits provided for in Article 13(3) of Regulation (EC) No 6/2002, but the other conditions for renewal provided for in Article 13 thereof and in this Regulation are not satisfied, the Office shall inform the applicant of the deficiencies.

If the application is filed by a person whom the holder has expressly authorised to do so, the holder of the design shall receive a copy of the notification.

4. Where an application for renewal is not submitted or is submitted after expiry of the time limit provided for in the second sentence of Article 13(3) of Regulation (EC) No 6/2002, or if the fees are not paid or are paid only after expiry of the relevant time limit, or if the deficiencies are not remedied within the time limit specified by the Office, the Office shall determine that the registration has expired and shall notify accordingly the holder and, where appropriate, the applicant for renewal and the person recorded in the Register as having rights in the design.

In the case of a multiple registration, where the fees paid are insufficient to cover all the designs for which renewal is requested, such a determination shall be made only after the Office has established which designs the amount paid is intended to cover.

In the absence of other criteria for determining which designs are intended to be covered, the Office shall take the designs in the numerical order in which they are represented in accordance with Article 2(4).

The Office shall determine that the registration has expired with regard to all designs for which the renewal fees have not been paid or have not been paid in full.

5. Where the determination made pursuant to paragraph 4 has become final, the Office shall cancel the design from the Register with effect from the day following the day on which the existing registration expired.

6. Where the renewal fees provided for in paragraph 2 have been paid but the registration is not renewed, those fees shall be refunded.

CHAPTER IV

TRANSFER, LICENCES AND OTHER RIGHTS, CHANGES

Article 23

Transfer

1. An application for registration of a transfer pursuant to Article 28 of Regulation (EC) No 6/2002 shall contain:

- (a) the registration number of the Community design;
- (b) particulars of the new holder in accordance with Article 1(1)(b);
- (c) where not all of the designs covered by a multiple registration are included in the transfer, particulars of the registered designs to which the transfer relates;
- (d) documents duly establishing the transfer.

2. The application may contain, where applicable, the name and business address of the representative of the new holder, to be set out in accordance with Article 1(1)(e).

3. The application shall not be deemed to have been filed until the required fee has been paid. If the fee is not paid or is not paid in full, the Office shall notify the applicant accordingly.

4. The following shall constitute sufficient proof of transfer under paragraph 1(d):

- (a) the application for registration of the transfer is signed by the registered holder or his/her representative and by the successor in title or his/her representative; or
- (b) the application, if submitted by the successor in title, is accompanied by a declaration, signed by the registered holder or his/her representative, that he/she agrees to the registration of the successor in title; or
- (c) the application is accompanied by a completed transfer form or document, signed by the registered holder or his/her representative and by the successor in title or his/her representative.

5. Where the conditions applicable to the registration of a transfer are not fulfilled, the Office shall notify the applicant of the deficiencies.

If the deficiencies are not remedied within the time limit specified by the Office, it shall reject the application for registration of the transfer.

6. A single application for registration of a transfer may be submitted for two or more registered Community designs, provided that the registered holder and the successor in title are the same in each case.

7. Paragraphs 1 to 6 shall apply *mutatis mutandis* to the transfer of applications for registered Community designs. The transfer shall be recorded in the files kept by the Office concerning the Community design application.

Article 24

Registration of licences and other rights

1. Article 23(1)(a), (b) and (c) and Article 23(2), (3), (5) and (6) shall apply *mutatis mutandis* to the registration of the grant or transfer of a licence, to registration of the creation or transfer of a right in rem in respect of a registered Community design, and to registration of enforcement measures. However, where a registered Community design is involved in insolvency proceedings, the request of the competent national authority for an entry in the Register to this effect shall not be subject to payment of a fee.

In the case of a multiple registration, each registered Community design may, separately from the others, be licensed, the subject of a right in rem, levy of execution or insolvency proceedings.

2. Where the registered Community design is licensed for only a part of the Community, or for a limited period of time, the application for registration of the licence shall indicate the part of the Community or the period of time for which the licence is granted.

3. Where the conditions applicable to registration of licences and other rights, set out in Articles 29, 30 or 32 of Regulation (EC) No 6/2002, in paragraph 1 of this Article, and in the other applicable Articles of this Regulation are not fulfilled, the Office shall notify the applicant of the deficiencies.

If the deficiencies are not remedied within a time limit specified by the Office, it shall reject the application for registration.

4. Paragraphs 1, 2 and 3 shall apply mutatis mutandis to licences and other rights concerning applications for registered Community designs. Licences, rights in rem and enforcement measures shall be recorded in the files kept by the Office concerning the Community design application.

5. The request for a non-exclusive licence pursuant to Article 16(2) of Regulation (EC) No 6/2002 shall be made within three months of the date of the entry in the Register of the newly entitled holder.

Article 25

Special provisions for the registration of a licence

1. A licence in respect of a registered Community design shall be recorded in the Register as an exclusive licence if the holder of the design or the licensee so requests.

2. A licence in respect of a registered Community design shall be recorded in the Register as a sub-licence where it is granted by a licensee whose licence is recorded in the Register.

3. A licence in respect of a registered Community design shall be recorded in the Register as a territorially limited licence if it is granted for a part of the Community.

4. A licence in respect of a registered Community design shall be recorded in the Register as a temporary licence if it is granted for a limited period of time.

Article 26

Cancellation or modification of the registration of licences and other rights

1. A registration effected under Article 24 shall be cancelled upon application by one of the persons concerned.

2. The application shall contain:

- (a) the registration number of the registered Community design, or in the case of a multiple registration, the number of each design; and
- (b) particulars of the right whose registration is to be cancelled.

3. Application for cancellation of the registration of a licence or other right shall not be deemed to have been filed until the required fee has been paid.

If the fee is not paid or is not paid in full, the Office shall notify the applicant accordingly. A request from a competent national authority for cancellation of an entry where a registered Community design is involved in insolvency proceedings shall not be subject to payment of a fee.

4. The application shall be accompanied by documents showing that the registered right no longer exists or by a statement by the licensee or the holder of another right to the effect that he/she consents to cancellation of the registration.

5. Where the requirements for cancellation of the registration are not satisfied, the Office shall notify the applicant of the deficiencies. If the deficiencies are not remedied within the time limit specified by the Office, it shall reject the application for cancellation of the registration.

6. Paragraphs 1, 2, 4 and 5 shall apply mutatis mutandis to a request for modification of a registration

effected pursuant to Article 24.

7. Paragraphs 1 to 6 shall apply mutatis mutandis to entries made in the files pursuant to Article 24(4).

CHAPTER V

SURRENDER AND INVALIDITY

Article 27

Surrender

1. A declaration of surrender pursuant to Article 51 of Regulation (EC) No 6/2002 shall contain:

- (a) the registration number of the registered Community design;
- (b) the name and address of the holder in accordance with Article 1(1)(b);
- (c) where a representative has been appointed, the name and business address of the representative in accordance with Article 1(1)(e);
- (d) where surrender is declared only for some of the designs contained in a multiple registration, an indication of the designs for which the surrender is declared or the designs which are to remain registered;
- (e) where, pursuant to Article 51(3) of Regulation (EC) No 6/2002, the registered Community design is partially surrendered, a representation of the amended design in accordance with Article 4 of this Regulation.

2. Where a right of a third party relating to the registered Community design is entered in the Register, it shall be sufficient proof of his/her agreement to the surrender that a declaration of consent to the surrender is signed by the holder of that right or his/her representative.

Where a licence has been registered, surrender of the design shall be registered three months after the date on which the holder satisfies the Office that he/she has informed the licensee of his/her intention to surrender it. If the holder proves to the Office before the expiry of that period that the licensee has given his/her consent, the surrender shall be registered forthwith.

3. Where a claim relating to the entitlement to a registered Community design has been brought before a court pursuant to Article 15 of Regulation (EC) No 6/2002, a declaration of consent to the surrender, signed by the claimant or his/her representative, shall be sufficient proof of his/her agreement to the surrender.

4. If the requirements governing surrender are not fulfilled, the Office shall communicate the deficiencies to the declarant. If the deficiencies are not remedied within the time limit specified by the Office, the Office shall reject the entry of the surrender in the Register.

Article 28

Application for a declaration of invalidity

1. An application to the Office for a declaration of invalidity pursuant to Article 52 of Regulation (EC) No 6/2002 shall contain:

-
- (a) as concerns the registered Community design for which the declaration of invalidity is sought:
- (i) its registration number;
 - (ii) the name and address of its holder;
- (b) as regards the grounds on which the application is based:
- (i) a statement of the grounds on which the application for a declaration of invalidity is based;
 - (ii) additionally, in the case of an application pursuant to Article 25(1)(d) of Regulation (EC) No 6/2002, the representation and particulars identifying the prior design on which the application for a declaration of invalidity is based and showing that the applicant is entitled to invoke the earlier design as a ground for invalidity pursuant to Article 25(3) of that Regulation;
 - (iii) additionally, in the case of an application pursuant to Article 25(1)(e) or (f) of Regulation (EC) No 6/2002, the representation and particulars identifying the distinctive sign or the work protected by copyright on which the application for a declaration of invalidity is based and particulars showing that the applicant is the holder of the earlier right pursuant to Article 25(3) of that Regulation;
 - (iv) additionally, in the case of an application pursuant to Article 25(1)(g) of the Regulation (EC) No 6/2002, the representation and particulars of the relevant item as referred to in that Article and particulars showing that the application is filed by the person or entity concerned by the improper use pursuant to Article 25(4) of that Regulation;
 - (v) where the ground for invalidity is that the registered Community design does not fulfil the requirements set out in Article 5 or 6 of Regulation (EC) No 6/2002, the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the registered Community design, as well as documents proving the existence of those earlier designs;
 - (vi) an indication of the facts, evidence and arguments submitted in support of those grounds;
- (c) as concerns the applicant:
- (i) his/her name and address in accordance with Article 1(1)(b);
 - (ii) if the applicant has appointed a representative, the name and the business address of the representative, in accordance with Article 1(1)(e);
 - (iii) additionally, in the case of an application pursuant to Article 25(1)(c) of Regulation (EC) No 6/2002, particulars showing that the application is made by a person or by persons duly entitled pursuant to Article 25(2) of that Regulation.
2. The application shall be subject to the fee referred to in Article 52(2) of Regulation (EC) No 6/2002.
3. The Office shall inform the holder that an application for declaration of invalidity has been filed.

Article 29

Languages used in invalidity proceedings

1. The application for a declaration of invalidity shall be filed in the language of proceedings pursuant to Article 98(4) of Regulation (EC) No 6/2002.

2. Where the language of proceedings is not the language used for filing the application and the holder has filed his/her observations in the language of filing, the Office shall arrange to have those observations translated into the language of proceedings.
3. Three years after the date fixed in accordance with Article 111(2) of Regulation (EC) No 6/2002, the Commission will submit to the Committee mentioned in Article 109 of Regulation (EC) No 6/2002 a report on the application of paragraph 2 of this Article and, if appropriate, proposals for fixing a limit for the expenses borne by the Office in this respect as provided for in the fourth subparagraph of Article 98(4) of Regulation (EC) No 6/2002.
4. The Commission may decide to submit the report and possible proposals referred to in paragraph 3 at an earlier date, and the Committee shall discuss them as a matter of priority if the facilities in paragraph 2 lead to disproportionate expenditure.
5. Where the evidence in support of the application is not filed in the language of the invalidity proceedings, the applicant shall file a translation of that evidence into that language within two months of the filing of such evidence.
6. Where the applicant for a declaration of invalidity or the holder informs the Office, within two months of receipt by the holder of the communication referred to in Article 31(1) of this Regulation, that they have agreed on a different language of proceedings pursuant to Article 98(5) of Regulation (EC) No 6/2002, the applicant shall, where the application was not filed in that language, file a translation of the application in that language within one month of the said date.

Article 30

Rejection of the application for declaration of invalidity as inadmissible

1. If the Office finds that the application for declaration of invalidity does not comply with Article 52 of Regulation (EC) No 6/2002, Article 28(1) of this Regulation or any other provision of Regulation (EC) No 6/2002 or this Regulation, it shall inform the applicant accordingly and shall call upon him/her to remedy the deficiencies within such time limit as it may specify.

If the deficiencies are not remedied within the specified time limit, the Office shall reject the application as inadmissible.

2. Where the Office finds that the required fees have not been paid, it shall inform the applicant accordingly and shall inform him/her that the application will be deemed not to have been filed if the required fees are not paid within a specified time limit.

If the required fees are paid after the expiry of the time limit specified, they shall be refunded to the applicant.

3. Any decision to reject an application for a declaration of invalidity pursuant to paragraph 1 shall be communicated to the applicant.

Where, pursuant to paragraph 2, an application is deemed not to have been filed, the applicant shall be informed accordingly.

Article 31

Examination of the application for a declaration of invalidity

1. If the Office does not reject the application for declaration of invalidity in accordance with Article 30, it shall communicate such application to the holder and shall request him/her to file his/her observations within such time limits as it may specify.
2. If the holder files no observations, the Office may base its decision concerning invalidity on the evidence before it.
3. Any observations filed by the holder shall be communicated to the applicant, who may be called upon by the Office to reply within specified time limits.
4. All communications pursuant to Article 53(2) of Regulation (EC) No 6/2002 and all observations filed in that respect shall be sent to the parties concerned.
5. The Office may call upon the parties to make a friendly settlement.

Article 32

Multiple applications for a declaration of invalidity

1. Where a number of applications for a declaration of invalidity have been filed relating to the same registered Community design, the Office may deal with them in one set of proceedings.

The Office may subsequently decide no longer to deal with them in that way.

2. If a preliminary examination of one or more applications reveals that the registered Community design may be invalid, the Office may suspend the other invalidity proceedings.

The Office shall inform the remaining applicants of any relevant decisions taken during such proceedings as are continued.

3. Once a decision declaring the invalidity of the design has become final, the applications in respect of which the proceedings have been suspended in accordance with paragraph 2 shall be deemed to have been disposed of and the applicants concerned shall be informed accordingly. Such disposition shall be considered to constitute a case which has not proceeded to judgment for the purposes of Article 70(4) of Regulation (EC) No 6/2002.
4. The Office shall refund 50 % of the invalidity fee referred to in Article 52(2) of Regulation (EC) No 6/2002 paid by each applicant whose application is deemed to have been disposed of in accordance with paragraphs 1, 2 and 3 of this Article.

Article 33

Participation of an alleged infringer

Where, pursuant to Article 54 of Regulation (EC) No 6/2002, an alleged infringer seeks to join the proceedings, he/she shall be subject to the relevant provisions of Articles 28, 29 and 30 of this Regulation, and shall in particular file a reasoned statement and pay the fee referred to in Article 52(2) of Regulation (EC) No 6/2002.

CHAPTER VI

APPEALS

Article 34

Content of the notice of appeal

1. The notice of appeal shall contain:

- (a) the name and address of the appellant in accordance with Article 1(1)(b);
- (b) where the appellant has appointed a representative, the name and the business address of the representative in accordance with Article 1(1)(e);
- (c) a statement identifying the decision which is contested and the extent to which amendment or cancellation of the decision is requested.

2. The notice of appeal shall be filed in the language of the proceedings in which the decision subject to the appeal was taken.

Article 35

Rejection of the appeal as inadmissible

1. If the appeal does not comply with Articles 55, 56 and 57 of Regulation (EC) No 6/2002 and Article 34(1)(c) and (2) of this Regulation, the Board of Appeal shall reject it as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 57 of Regulation (EC) No 6/2002 has expired.

2. If the Board of Appeal finds that the appeal does not comply with other provisions of Regulation (EC) No 6/2002 or other provisions of this Regulation, in particular with Article 34(1)(a) and (b), it shall inform the appellant accordingly and shall request him/her to remedy the deficiencies noted within such time limit as it may specify. If the deficiencies are not remedied in good time, the Board of Appeal shall reject the appeal as inadmissible.

3. If the fee for appeal has been paid after expiry of the time limits for the filing of an appeal pursuant to Article 57 of Regulation (EC) No 6/2002, the appeal shall be deemed not to have been filed and the appeal fee shall be refunded to the appellant.

Article 36

Examination of appeals

1. Save as otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.

2. The Board of Appeal's decision shall contain:

- (a) a statement that it is delivered by the Board;
- (b) the date when the decision was taken;
- (c) the names of the Chairman and the other members of the Board of Appeal taking part;

- (d) the name of the competent employee of the registry;
- (e) the names of the parties and of their representatives;
- (f) a statement of the issues to be decided;
- (g) a summary of the facts;
- (h) the reasons;
- (i) the order of the Board of Appeal, including, where necessary, a decision on costs.

3. The decision shall be signed by the Chairman and the other members of the Board of Appeal and by the employee of the registry of the Board of Appeal.

Article 37

Reimbursement of appeal fees

The reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. In the event of interlocutory revision, reimbursement shall be ordered by the department whose decision has been impugned, and in other cases by the Board of Appeal.

CHAPTER VII

DECISIONS AND COMMUNICATIONS OF THE OFFICE

Article 38

Form of decisions

1. Decisions of the Office shall be in writing and shall state the reasons on which they are based.

Where oral proceedings are held before the Office, the decision may be given orally. Subsequently, the decision in writing shall be notified to the parties.

2. Decisions of the Office which are open to appeal shall be accompanied by a written communication indicating that notice of appeal must be filed in writing at the Office within two months of the date of notification of the decision from which appeal is to be made. The communications shall also draw the attention of the parties to the provisions laid down in Articles 55, 56 and 57 of Regulation (EC) No 6/2002.

The parties may not plead any failure to communicate the availability of such appeal proceedings.

Article 39

Correction of errors in decisions

In decisions of the Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected. They shall be corrected by the department which took the decision, acting of its own motion or at the request of an interested party.

Article 40

Noting of loss of rights

1. If the Office finds that the loss of any rights results from Regulation (EC) No 6/2002 or this Regulation without any decision having been taken, it shall communicate this to the person concerned in accordance with Article 66 of Regulation (EC) No 6/2002, and shall draw his/her attention to the legal remedies set out in paragraph 2 of this Article.

2. If the person concerned considers that the finding of the Office is inaccurate, he/she may, within two months of notification of the communication referred to in paragraph 1, apply for a decision on the matter by the Office.

Such decision shall be given only if the Office disagrees with the person requesting it; otherwise the Office shall amend its finding and inform the person requesting the decision.

Article 41

Signature, name, seal

1. Any decision, communication or notice from the Office shall indicate the department or division of the Office as well as the name or the names of the official or officials responsible. They shall be signed by the official or officials, or, instead of a signature, carry a printed or stamped seal of the Office.

2. The President of the Office may determine that other means of identifying the department or division of the Office and the name of the official or officials responsible or an identification other than a seal may be used where decisions, communications or notices are transmitted by fax or any other technical means of communication.

CHAPTER VIII

ORAL PROCEEDINGS AND TAKING OF EVIDENCE

Article 42

Summons to oral proceedings

1. The parties shall be summoned to oral proceedings provided for in Article 64 of Regulation (EC) No 6/2002 and their attention shall be drawn to paragraph 3 of this Article. At least one month's notice of the summons shall be given unless the parties agree to a shorter time limit.

2. When issuing the summons, the Office shall draw attention to the points which in its opinion need to be discussed in order for the decision to be taken.

3. If a party who has been duly summoned to oral proceedings before the Office does not appear as summoned, the proceedings may continue without him/her.

Article 43

Taking of evidence by the Office

1. Where the Office considers it necessary to hear the oral evidence of parties, of witnesses or of experts or to carry out an inspection, it shall take a decision to that end, stating the means by which it intends to obtain evidence, the relevant facts to be proved and the date, time and place of the hearing or inspection.

If oral evidence from witnesses and experts is requested by a party, the decision of the Office shall determine the period of time within which the party filing the request must make known to the Office the names and addresses of the witnesses and experts whom the party wishes to be heard.

2. The period of notice given in the summons of a party, witness or expert to give evidence shall be at least one month, unless they agree to a shorter time limit.

The summons shall contain:

- (a) an extract from the decision mentioned in the first subparagraph of paragraph 1, indicating in particular the date, time and place of the hearing ordered and stating the facts regarding which the parties, witnesses and experts are to be heard;
- (b) the names of the parties to proceedings and particulars of the rights which the witnesses or experts may invoke pursuant to Article 45(2) to (5).

Article 44

Commissioning of experts

1. The Office shall decide in what form the report made by an expert whom it appoints shall be submitted.

2. The terms of reference of the expert shall include:

- (a) a precise description of his/her task;
- (b) the time limit laid down for the submission of the expert's report;
- (c) the names of the parties to the proceedings;
- (d) particulars of the claims which the expert may invoke pursuant to Article 45(2), (3) and (4).

3. A copy of any written report shall be submitted to the parties.

4. The parties may object to an expert on grounds of incompetence or on the same grounds as those on which objection may be made to an examiner or to a member of a Division or Board of Appeal pursuant to Article 132(1) and (3) of Council Regulation (EC) No 40/94(3). The department of the Office concerned shall rule on the objection.

Article 45

Costs of taking of evidence

1. The taking of evidence by the Office may be made conditional upon deposit with it, by the party who has requested the evidence to be taken, of a sum which shall be fixed by reference to an estimate of the costs.

2. Witnesses and experts who are summoned by and appear before the Office shall be entitled to reimbursement of reasonable expenses for travel and subsistence. An advance for those expenses may be granted to them by the Office. The first sentence shall apply also to witnesses and experts who appear before the Office without being summoned by it and who are heard as witnesses or experts.

3. Witnesses entitled to reimbursement under paragraph 2 shall also be entitled to appropriate compensation for loss of earnings, and experts shall be entitled to fees for their services. Those payments shall be made to the witnesses and experts after they have fulfilled their duties or tasks, where such witnesses and experts have been summoned by the Office on its own initiative.

4. The amounts and the advances for expenses to be paid pursuant to paragraphs 1, 2 and 3 shall be determined by the President of the Office and shall be published in the Official Journal of the Office.

The amounts shall be calculated on the same basis as the compensation and salaries received by officials in grades A 4 to A 8 as laid down in the Staff Regulations of officials of the European Communities and in Annex VII thereto.

5. Final liability for the amounts due or paid pursuant to paragraphs 1 to 4 shall lie with:

- (a) the Office where the Office, on its own initiative, considered it necessary to hear the oral evidence of witnesses or experts; or
- (b) the party concerned where that party requested the giving of oral evidence by witnesses or experts, subject to the decision on apportionment and fixing of costs pursuant to Articles 70 and 71 of Regulation (EC) No 6/2002 and Article 79 of this Regulation.

The party referred to in point (b) of the first subparagraph shall reimburse the Office for any advances duly paid.

Article 46

Minutes of oral proceedings and of evidence

1. Minutes of oral proceedings or the taking of evidence shall be drawn up, containing the essentials of the oral proceedings or of the taking of evidence, the relevant statements made by the parties, the testimony of the parties, witnesses or experts and the result of any inspection.

2. The minutes of the testimony of a witness, expert or party shall be read out or submitted to him/her so that he/she may examine them. It shall be noted in the minutes that this formality has been carried out and that the person who gave the testimony approved the minutes. Where his/her approval is not given, his/her objections shall be noted.

3. The minutes shall be signed by the employee who drew them up and by the employee who conducted the oral proceedings or taking of evidence.

4. The parties shall be provided with a copy of the minutes.

5. Upon request, the Office shall make available to the parties transcripts of recordings of the oral proceedings, in typescript or in any other machine-readable form.

The release of transcripts of those recordings shall be subject to the payment of the costs incurred

by the Office in making such transcript. The amount to be charged shall be determined by the President of the Office.

CHAPTER IX

NOTIFICATIONS

Article 47

General provisions on notifications

1. In proceedings before the Office, any notifications to be made by the Office shall take the form of the original document, of a copy thereof certified by, or bearing the seal of, the Office or of a computer print-out bearing such seal. Copies of documents emanating from the parties themselves shall not require such certification.

2. Notifications shall be made:

- (a) by post in accordance with Article 48;
- (b) by hand delivery in accordance with Article 49;
- (c) by deposit in a post box at the Office in accordance with Article 50;
- (d) by fax and other technical means in accordance with Article 51;
- (e) by public notification in accordance with Article 52.

Article 48

Notification by post

1. Decisions subject to a time limit for appeal, summonses and other documents as determined by the President of the Office shall be notified by registered letter with acknowledgement of delivery.

Decisions and communications subject to another time limit shall be notified by registered letter, unless the President of the Office determines otherwise.

All other communications shall be ordinary mail.

2. Notifications to addressees having neither their domicile nor their principal place of business nor an establishment in the Community and who have not appointed a representative in accordance with Article 77(2) of Regulation (EC) No 6/2002 shall be effected by posting the document requiring notification by ordinary mail to the last address of the addressee known to the Office.

Notification shall be deemed to have been effected when the posting has taken place.

3. Where notification is effected by registered letter, whether or not with acknowledgement of delivery, it shall be deemed to be delivered to the addressee on the 10th day following that of its posting, unless the letter has failed to reach the addressee or has reached him/her at a later date.

In the event of any dispute, it shall be for the Office to establish that the letter has reached its destination or to establish the date on which it was delivered to the addressee, as the case may be.

4. Notification by registered letter, with or without acknowledgement of delivery, shall be deemed to have been effected even if the addressee refuses to accept the letter.

5. To the extent that notification by post is not covered by paragraphs 1 to 4, the law of the State on the territory of which notification is made shall apply.

Article 49

Notification by hand delivery

Notification may be effected on the premises of the Office by hand delivery of the document to the addressee, who shall on delivery acknowledge its receipt.

Article 50

Notification by deposit in a post box at the Office

Notification may also be effected to addressees who have been provided with a post box at the Office, by depositing the document therein. A written notification of deposit shall be inserted in the files. The date of deposit shall be recorded on the document. Notification shall be deemed to have taken place on the fifth day following deposit of the document in the post box at the Office.

Article 51

Notification by fax and other technical means

1. Notification by fax shall be effected by transmitting either the original or a copy, as provided for in Article 47(1), of the document to be notified. The details of such transmission shall be determined by the President of the Office.

2. Details of notification by other technical means of communication shall be determined by the President of the Office.

Article 52

Public notification

1. If the address of the addressee cannot be established, or if notification in accordance with Article 48(1) has proved to be impossible even after a second attempt by the Office, notification shall be effected by public notice.

Such notice shall be published at least in the Community Designs Bulletin.

2. The President of the Office shall determine how the public notice is to be given and shall fix the beginning of the time limit of one month on the expiry of which the document shall be deemed to have been notified.

Article 53

Notification to representatives

1. If a representative has been appointed or where the applicant first named in a common application is considered to be the common representative pursuant to Article 61(1), notifications shall be addressed to that appointed or common representative.
2. If several representatives have been appointed for a single interested party, notification to any one of them shall be sufficient, unless a specific address for service has been indicated in accordance with Article 1(1)(e).
3. If several interested parties have appointed a common representative, notification of a single document to the common representative shall be sufficient.

Article 54

Irregularities in notification

Where a document has reached the addressee, if the Office is unable to prove that it has been duly notified or if provisions relating to its notification have not been observed, the document shall be deemed to have been notified on the date established by the Office as the date of receipt.

Article 55

Notification of documents in the case of several parties

Documents emanating from parties which contain substantive proposals, or a declaration of withdrawal of a substantive proposal, shall be notified to the other parties as a matter of course. Notification may be dispensed with where the document contains no new pleadings and the matter is ready for decision.

CHAPTER X

TIME LIMITS

Article 56

Calculation of time limits

1. Time limits shall be laid down in terms of full years, months, weeks or days.
2. The beginning of any time limit shall be calculated starting on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another time limit. Where that procedural step is a notification, the event considered shall be the receipt of the document notified, unless otherwise provided.
3. Where a time limit is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the relevant event occurred. Where the relevant month has no

day with the same number the time limit shall expire on the last day of that month.

4. Where a time limit is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the relevant event occurred. Where the day on which the relevant event occurred was the last day of a month or where the relevant subsequent month has no day with the same number the time limit shall expire on the last day of that month.

5. Where a time limit is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the relevant event occurred.

Article 57

Duration of time limits

1. Where Regulation (EC) No 6/2002 or this Regulation provide for a time limit to be specified by the Office, such time limit shall, when the party concerned has its domicile or its principal place of business or an establishment within the Community, be not less than one month, or, when those conditions are not fulfilled, not less than two months, and no more than six months.

The Office may, when this is appropriate under the circumstances, grant an extension of a time limit specified if such extension is requested by the party concerned and the request is submitted before the original time limit expires.

2. Where there are two or more parties, the Office may make the extension of a time limit subject to the agreement of the other parties.

Article 58

Expiry of time limits in special cases

1. If a time limit expires on a day on which the Office is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, ordinary mail is not delivered in the locality in which the Office is located, the time limit shall extend until the first day thereafter on which the Office is open for receipt of documents and on which ordinary mail is delivered.

The days on which the Office is not open for receipt of documents shall be determined by the President of the Office before the commencement of each calendar year.

2. If a time limit expires on a day on which there is a general interruption or subsequent dislocation in the delivery of mail in a Member State or between a Member State and the Office, the time limit shall extend until the first day following the end of the period of interruption or dislocation, for parties having their residence or registered office in the State concerned or who have appointed representatives with a place of business in that State.

In the event of the Member State concerned being the State in which the Office is located, the first subparagraph shall apply to all parties.

The period referred to in the first subparagraph shall be as determined by the President of the Office.

3. Paragraphs 1 and 2 shall apply *mutatis mutandis* to the time limits provided for in Regulation (EC) No 6/2002 or this Regulation in the case of transactions to be carried out with the competent authority within the meaning of Article 35(1)(b) and (c) of Regulation (EC) No 6/2002.

4. If an exceptional occurrence such as natural disaster or strike interrupts or dislocates the proper functioning of the Office so that any communication from the Office to parties concerning the expiry of a time limit is delayed, acts to be completed within such a time limit may still be validly completed within one month of the notification of the delayed communication.

The date of commencement and the end of any such interruption or dislocation shall be as determined by the President of the Office.

CHAPTER XI

INTERRUPTION OF PROCEEDINGS AND WAIVING OF ENFORCED RECOVERY PROCEDURES

Article 59

Interruption of proceedings

1. Proceedings before the Office shall be interrupted:

- (a) in the event of the death or legal incapacity of the applicant for or holder of a registered Community design or of the person authorised by national law to act on his/her behalf;
- (b) in the event that the applicant for or holder of a registered Community design is, as a result of some action taken against his/her property, prevented for legal reasons from continuing the proceedings before the Office;
- (c) in the event of the death or legal incapacity of the representative of an applicant for or holder of a registered Community design or of his/her being prevented for legal reasons resulting from action taken against his/her property from continuing the proceedings before the Office.

To the extent that the events referred to in point (a) of the first subparagraph do not affect the authorisation of a representative appointed under Article 78 of Regulation (EC) No 6/2002, proceedings shall be interrupted only on application by such representative.

2. When, in the cases referred to in points (a) and (b) of the first subparagraph of paragraph 1, the Office has been informed of the identity of the person authorised to continue the proceedings before the Office, the Office shall communicate to such person and to any interested third parties that the proceedings shall be resumed as from a date to be fixed by the Office.

3. In the case referred to in paragraph 1(c), the proceedings shall be resumed when the Office has been informed of the appointment of a new representative of the applicant or when the Office has notified to the other parties the communication of the appointment of a new representative of the holder of the design.

If, three months after the beginning of the interruption of the proceedings, the Office has not been informed of the appointment of a new representative, it shall communicate that fact to the applicant for or holder of the registered Community design:

- (a) where Article 77(2) of Regulation (EC) No 6/2002 is applicable, that the Community design application will be deemed to be withdrawn if the information is not submitted within two months after that communication is notified; or
- (b) where Article 77(2) of Regulation (EC) No 6/2002 is not applicable, that the proceedings

will be resumed with the applicant for or holder as from the date on which that communication is notified.

4. The time limits, other than the time limit for paying the renewal fees, in force as regards the applicant for or holder of the Community design at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed.

Article 60

Waiving of enforced recovery procedures

The President of the Office may waive action for the enforced recovery of any sum due where the sum to be recovered is minimal or where such recovery is too uncertain.

CHAPTER XII

REPRESENTATION

Article 61

Appointment of a common representative

1. If there is more than one applicant and the application for a registered Community design does not name a common representative, the applicant first named in the application shall be considered to be the common representative.

However, if one of the applicants is obliged to appoint a professional representative, such representative shall be considered to be the common representative unless the applicant named first in the application has also appointed a professional representative.

The first and second subparagraphs shall apply *mutatis mutandis* to third parties acting in common in applying for a declaration of invalidity, and to joint holders of a registered Community design.

2. If, during the course of proceedings, transfer is made to more than one person, and such persons have not appointed a common representative, paragraph 1 shall apply.

If such application is not possible, the Office shall require such persons to appoint a common representative within two months. If this request is not complied with, the Office shall appoint the common representative.

Article 62

Authorisations

1. Legal practitioners and professional representatives entered on the lists maintained by the Office pursuant to Article 78(1)(b) or (c) of Regulation (EC) No 6/2002 may file with the Office a signed authorisation for inclusion in the files.

Such authorisation shall be filed if the Office expressly requires it or, where there are several parties to the proceedings in which the representative acts before the Office, one of the parties expressly request it.

2. Employees acting on behalf of natural or legal persons pursuant to Article 77(3) of Regulation (EC) No 6/2002 shall file with the Office a signed authorisation for insertion in the files.
3. The authorisation may be filed in any of the official languages of the Community. It may cover one or more applications or registered Community designs or may be in the form of a general authorisation allowing the representative to act in respect of all proceedings before the Office to which the person who has issued it is a party.
4. Where, pursuant to paragraphs 1 or 2, an authorisation has to be filed, the Office shall specify a time limit within which such authorisation shall be filed. If the authorisation is not filed in due time, proceedings shall be continued with the represented person. Any procedural steps other than the filing of the application taken by the representative shall be deemed not to have been taken if the represented person does not approve them. The application of Article 77(2) of Regulation (EC) No 6/2002 shall remain unaffected.
5. Paragraphs 1, 2 and 3 shall apply *mutatis mutandis* to a document withdrawing an authorisation.
6. Any representative who has ceased to be authorised shall continue to be regarded as the representative until the termination of his/her authorisation has been communicated to the Office.
7. Subject to any provisions to the contrary contained therein, an authorisation shall not terminate *vis-à-vis* the Office upon the death of the person who gave it.
8. Where several representatives are appointed by the same party, they may, notwithstanding any provisions to the contrary in their authorisations, act either collectively or individually.
9. The authorisation of an association of representatives shall be deemed to be an authorisation of any representative who can establish that he/she practises within that association.

Article 63

Representation

Any notification or other communication addressed by the Office to the duly authorised representative shall have the same effect as if it had been addressed to the represented person.

Any communication addressed to the Office by the duly authorised representative shall have the same effect as if it originated from the represented person.

Article 64

Amendment of the special list of professional representatives for design matters

1. The entry of a professional representative in the special list of professional representatives for design matters, as referred to in Article 78(4) of Regulation (EC) No 6/2002, shall be deleted at his/her request.
2. The entry of a professional representative shall be deleted automatically:
 - (a) in the event of the death or legal incapacity of the professional representative;
 - (b) where the professional representative is no longer a national of a Member State, unless the President of the Office has granted an exemption pursuant to Article 78(6)(a) of Regulation (EC) No 6/2002;

- (c) where the professional representative no longer has his/her place of business or employment in the Community;
- (d) where the professional representative no longer possesses the entitlement referred to in the first sentence of Article 78(4)(c) of Regulation (EC) No 6/2002.

3. The entry of a professional representative shall be suspended of the Office's own motion where his/her entitlement to represent natural or legal persons before the Benelux Design Office or the central industrial property office of the Member State as referred to in the first sentence of Article 78(4)(c) of Regulation (EC) No 6/2002 has been suspended.

4. A person whose entry has been deleted shall, upon request pursuant to Article 78(5) of Regulation (EC) No 6/2002, be reinstated in the list of professional representatives if the conditions for deletion no longer exist.

5. The Benelux Design Office and the central industrial property offices of the Member States concerned shall, where they are aware thereof, promptly inform the Office of any relevant events referred to in paragraphs 2 and 3.

6. The amendments of the special list of professional representatives for design matters shall be published in the Official Journal of the Office.

CHAPTER XIII

WRITTEN COMMUNICATIONS AND FORMS

Article 65

Communication in writing or by other means

1. Subject to paragraph 2, applications for the registration of a Community design as well as any other application or declaration provided for in Regulation (EC) No 6/2002 and all other communications addressed to the Office shall be submitted as follows:

- (a) by submitting a signed original of the document in question to the Office, by post, personal delivery, or by any other means; annexes to documents submitted need not be signed;
- (b) by transmitting a signed original by fax in accordance with Article 66; or
- (c) by transmitting the contents of the communication by electronic means in accordance with Article 67.

2. Where the applicant avails himself of the possibility provided for in Article 36(1)(c) of Regulation (EC) No 6/2002 of filing a specimen of the design, the application and the specimen shall be submitted to the Office by a single mail in the form prescribed in paragraph 1(a) of this Article. If the application and the specimen, or specimens in the case of a multiple application, are not submitted by a single mail the Office shall not give a filing date until the last item has been received pursuant to Article 10(1) of this Regulation.

Article 66

Communication by fax

1. Where an application for registration of a Community design is submitted by fax and the application

contains a reproduction of the design pursuant to Article 4(1) which does not satisfy the requirements of that Article, the required reproduction suitable for registration and publication shall be submitted to the Office in accordance with Article 65(1)(a).

Where the reproduction is received by the Office within a time limit of one month from the date of the receipt of the fax, the application shall be deemed to have been received by the Office on the date on which the fax was received.

Where the reproduction is received by the Office after the expiry of that time limit, the application shall be deemed to have been received by the Office on the date on which the reproduction was received.

2. Where a communication received by fax is incomplete or illegible, or where the Office has reasonable doubts as to the accuracy of the transmission, the Office shall inform the sender accordingly and shall call upon him/her, within a time limit to be specified by the Office, to retransmit the original by fax or to submit the original in accordance with Article 65(1)(a).

Where that request is complied with within the time limit specified, the date of the receipt of the retransmission or of the original shall be deemed to be the date of the receipt of the original communication, provided that where the deficiency concerns the granting of a filing date for an application to register a Community design, the provisions on the filing date shall apply.

Where the request is not complied with within the time limit specified, the communication shall be deemed not to have been received.

3. Any communication submitted to the Office by fax shall be considered to be duly signed if the reproduction of the signature appears on the printout produced by the fax.

4. The President of the Office may determine additional requirements for communication by fax, such as the equipment to be used, technical details of communication, and methods of identifying the sender.

Article 67

Communication by electronic means

1. Applications for registration of a Community design may be submitted by electronic means, including the representation of the design, and notwithstanding Article 65(2) in the case of filing a specimen.

The conditions shall be laid down by the President of the Office.

2. The President of the Office shall determine the requirements for communication by electronic means, such as the equipment to be used, technical details of communication, and methods of identifying the sender.

3. Where a communication is sent by electronic means, Article 66(2) shall apply *mutatis mutandis*.

4. Where a communication is sent to the Office by electronic means, the indication of the name of the sender shall be deemed to be equivalent to the signature.

Article 68

Forms

1. The Office shall make available free of charge forms for the purpose of:

- (a) filing an application for a registered Community design;
 - (b) applying for the correction of an application or a registration;
 - (c) applying for the registration of a transfer and the transfer form and transfer document referred to in Article 23(4);
 - (d) applying for the registration of a licence;
 - (e) applying for renewal of registration of a registered Community design;
 - (f) applying for a declaration of invalidity of a registered Community design;
 - (g) applying for restitutio in integrum;
 - (h) taking an appeal;
 - (i) authorising a representative, in the form of an individual authorisation and in the form of a general authorisation.
2. The Office may make other forms available free of charge.
 3. The Office shall make available the forms referred to in paragraphs 1 and 2 in all the official languages of the Community.
 4. The Office shall place the forms at the disposal of the Benelux Design Office and of the Member States' central industrial property offices free of charge.
 5. The Office may also make available the forms in machine-readable form.
 6. Parties to proceedings before the Office should use the forms provided by the Office, or copies of those forms, or forms with the same content and format as those forms, such as forms generated by means of electronic data processing.
 7. Forms shall be completed in such a manner as to permit an automated input of the content into a computer, such as by character recognition or scanning.

CHAPTER XIV

INFORMATION TO THE PUBLIC

Article 69

Register of Community Designs

1. The Register may be maintained in the form of an electronic database.
2. The Register shall contain the following entries:
 - (a) the date of filing the application;
 - (b) the file number of the application and the file number of each individual design included in a multiple application;
 - (c) the date of the publication of the registration;
 - (d) the name, the address and the nationality of the applicant and the State in which he/she is domiciled or has his/her seat or establishment;
 - (e) the name and business address of the representative, other than an employee acting as representative in accordance with the first subparagraph of Article 77(3) of Regulation (EC) No 6/2002; where

there is more than one representative, only the name and business address of the first named representative, the name being followed by the words "et al", shall be recorded; where an association of representatives is appointed, only the name and address of the association shall be recorded;

- (f) the representation of the design;
- (g) an indication of the products by their names, preceded by the numbers of the classes and subclasses of the Locarno classification, and grouped accordingly;
- (h) particulars of claims of priority pursuant to Article 42 of Regulation (EC) No 6/2002;
- (i) particulars of claims of exhibition priority pursuant to Article 44 of Regulation (EC) No 6/2002;
- (j) where applicable, the citation of the designer or of the team of designers pursuant to Article 18 of Regulation (EC) No 6/2002, or a statement that the designer or the team of designers has waived the right to be cited;
- (k) the language in which the application was filed and the second language which the applicant has indicated in his/her application, pursuant to Article 98(2) of Regulation (EC) No 6/2002;
- (l) the date of registration of the design in the Register and the registration number;
- (m) a mention of any request for deferment of publication pursuant to Article 50(3) of Regulation (EC) No 6/2002, specifying the date of expiry of the period of deferment;
- (n) a mention that a specimen was filed pursuant to Article 5;
- (o) a mention that a description was filed pursuant to Article 1(2)(a).

3. In addition to the entries set out in paragraph 2 the Register shall contain the following entries, each accompanied by the date of recording such entry:

- (a) changes in the name, the address or the nationality of the holder or in the State in which he/she is domiciled or has his/her seat or establishment;
- (b) changes in the name or business address of the representative, other than a representative falling within the first subparagraph of Article 77(3) of Regulation (EC) No 6/2002;
- (c) when a new representative is appointed, the name and business address of that representative;
- (d) a mention that a multiple application or registration has been divided into separate applications or registrations pursuant to Article 37(4) of Regulation (EC) No 6/2002;
- (e) the notice of an amendment to the design pursuant to Article 25(6) of Regulation (EC) No 6/2002, including, if applicable, a reference to the disclaimer made or the court decision or the decision by the Office declaring the partial invalidity of the design right, as well as corrections of mistakes and errors pursuant to Article 20 of this Regulation;
- (f) a mention that entitlement proceedings have been instituted under Article 15(1) of Regulation (EC) No 6/2002 in respect of a registered Community design;
- (g) the final decision or other termination of proceedings pursuant to Article 15(4)(b) of Regulation (EC) No 6/2002 concerning entitlement proceedings;
- (h) a change of ownership pursuant to Article 15(4)(c) of Regulation (EC) No 6/2002;
- (i) transfers pursuant to Article 28 of Regulation (EC) No 6/2002;
- (j) the creation or transfer of a right in rem pursuant to Article 29 of Regulation (EC) No 6/2002 and the nature of the right in rem;

- (k) levy of execution pursuant to Article 30 of Regulation (EC) No 6/2002 and insolvency proceedings pursuant to Article 31 of that Regulation;
 - (l) the grant or transfer of a licence pursuant to Article 16(2) or Article 32 of Regulation (EC) No 6/2002 and, where applicable, the type of licence pursuant to Article 25 of this Regulation;
 - (m) renewal of the registration pursuant to Article 13 of Regulation (EC) No 6/2002 and the date from which it takes effect;
 - (n) a record of the determination of the expiry of the registration;
 - (o) a declaration of total or partial surrender by the holder pursuant to Article 51(1) and (3) of Regulation (EC) No 6/2002;
 - (p) the date of submission of an application or of the filing of a counterclaim for a declaration of invalidity pursuant, respectively, to Article 52 or Article 86(2) of Regulation (EC) No 6/2002;
 - (q) the date and content of the decision on the application or counterclaim for declaration of invalidity or any other termination of proceedings pursuant, respectively, to Article 53 or Article 86(4) of Regulation (EC) No 6/2002;
 - (r) a mention pursuant to Article 50(4) of Regulation (EC) No 6/2002 that the registered Community design is deemed from the outset not to have had the effects specified in that Regulation;
 - (s) the cancellation of the representative recorded pursuant to paragraph 2(e);
 - (t) the modification or cancellation from the Register of the items referred to in points (j), (k) and (l).
4. The President of the Office may determine that items other than those referred to in paragraphs 2 and 3 shall be entered in the Register.
5. The holder shall be notified of any change in the Register.
6. Subject to Article 73, the Office shall provide certified or uncertified extracts from the Register on request, on payment of a fee.

CHAPTER XV

COMMUNITY DESIGNS BULLETIN AND DATA BASE

Article 70

Community Designs Bulletin

1. The Office shall determine the frequency of the publication of the Community Designs Bulletin and the manner in which such publication shall take place.
2. Without prejudice to the provisions of Article 50(2) of Regulation (EC) No 6/2002 and subject to Articles 14 and 16 of this Regulation relating to deferment of publication, the Community Designs Bulletin shall contain publications of registration and of entries made in the Register as well as other particulars relating to registrations of designs whose publication is prescribed by Regulation (EC) No 6/2002 or by this Regulation.
3. Where particulars whose publication is prescribed in Regulation (EC) No 6/2002 or in this Regulation are published in the Community Designs Bulletin, the date of issue shown on the Bulletin

shall be taken as the date of publication of the particulars.

4. The information the publication of which is prescribed in Articles 14 and 16 shall, where appropriate, be published in all the official languages of the Community.

Article 71

Database

1. The Office shall maintain an electronic database with the particulars of applications for registration of Community designs and entries in the Register. The Office may, subject to the restrictions prescribed by Article 50(2) and (3) of Regulation (EC) No 6/2002, make available the contents of that database for direct access or on CD-ROM or in any other machine-readable form.

2. The President of the Office shall determine the conditions of access to the database and the manner in which the contents of this database may be made available in machine-readable form, including the charges for those acts.

CHAPTER XVI

INSPECTION OF FILES AND KEEPING OF FILES

Article 72

Parts of the file excluded from inspection

The parts of the file which shall be excluded from inspection pursuant to Article 74(4) of Regulation (EC) No 6/2002 shall be:

- (a) documents relating to exclusion or objection pursuant to Article 132 of Regulation (EC) No 40/94, the provisions of that Article being considered for this purpose as applying *mutatis mutandis* to registered Community designs and to applications for these;
- (b) draft decisions and opinions, and all other internal documents used for the preparation of decisions and opinions;
- (c) parts of the file which the party concerned showed a special interest in keeping confidential before the application for inspection of the files was made, unless inspection of such part of the file is justified by overriding legitimate interests of the party seeking inspection.

Article 73

Inspection of the Register of Community Designs

Where the registration is subject to a deferment of publication pursuant to Article 50(1) of Regulation (EC) No 6/2002:

- (a) access to the Register to persons other than the holder shall be limited to the name of the holder, the name of any representative, the date of filing and registration, the file number of the application and the mention that publication is deferred;

- (b) the certified or uncertified extracts from the Register shall contain only the name of the holder, the name of any representative, the date of filing and registration, the file number of the application and the mention that publication is deferred, except where the request has been made by the holder or his/her representative.

Article 74

Procedures for the inspection of files

1. Inspection of the files of registered Community designs shall either be of the original document, or of copies thereof, or of technical means of storage if the files are so stored.

The request for inspection of the files shall not be deemed to have been made until the required fee has been paid.

The means of inspection shall be determined by the President of the Office.

2. Where inspection of the files relates to an application for a registered Community design or to a registered Community design which is subject to deferment of publication, which, being subject to such deferment, has been surrendered before or on the expiry of that period or which, pursuant to Article 50(4) of Regulation (EC) No 6/2002, is deemed from the outset not to have had the effects specified in that Regulation, the request shall contain an indication and evidence to the effect that:

- (a) the applicant for or holder of the Community design has consented to the inspection; or
- (b) the person requesting the inspection has established a legitimate interest in the inspection of the file, in particular where the applicant for or holder of the Community design has stated that after the design has been registered he/she will invoke the rights under it against the person requesting the inspection.

3. Inspection of the files shall take place on the premises of the Office.

4. On request, inspection of the files shall be effected by means of issuing copies of file documents. Such copies shall incur fees.

5. The Office shall issue on request certified or uncertified copies of the application for a registered Community design or of those file documents of which copies may be issued pursuant to paragraph 4 upon payment of a fee.

Article 75

Communication of information contained in the files

Subject to the restrictions provided for in Article 74 of Regulation (EC) No 6/2002 and Articles 72 and 73 of this Regulation, the Office may, upon request, communicate information from any file of a Community design applied for or of a registered Community design, subject to payment of a fee.

However, the Office may require the applicant to inspect the file in situ, should it deem that to be appropriate in view of the quantity of information to be supplied.

Article 76

Keeping of files

1. The Office shall keep the files relating to Community design applications and to registered Community designs for at least five years from the end of the year in which:

- (a) the application is rejected or withdrawn;
- (b) the registration of the registered Community design expires definitively;
- (c) the complete surrender of the registered Community design is registered pursuant to Article 51 of Regulation (EC) No 6/2002;
- (d) the registered Community design is definitively removed from the Register;
- (e) the registered Community design is deemed not to have had the effects specified in Regulation (EC) No 6/2002 pursuant to Article 50(4) thereof.

2. The President of the Office shall determine the form in which the files shall be kept.

CHAPTER XVII

ADMINISTRATIVE COOPERATION

Article 77

Exchange of information and communications between the Office and the authorities of the Member States

1. The Office and the central industrial property offices of the Member States and the Benelux Design Office shall, upon request, communicate to each other relevant information about the filing of applications for registered Community designs, Benelux designs or national registered designs and about proceedings relating to such applications and the designs registered as a result thereof. Such communications shall not be subject to the restrictions provided for in Article 74 of Regulation (EC) No 6/2002.

2. Communications between the Office and the courts or authorities of the Member States which arise out of the application of Regulation (EC) No 6/2002 or this Regulation shall be effected directly between those authorities.

Such communication may also be effected through the central industrial property offices of the Member States or the Benelux Design Office.

3. Expenditure in respect of communications pursuant to paragraphs 1 and 2 shall be chargeable to the authority making the communications, which shall be exempt from fees.

Article 78

Inspection of files by or via courts or authorities of the Member States

1. Inspection of files relating to Community designs applied for or registered Community designs

by courts or authorities of the Member States shall if so requested be of the original documents or of copies thereof. Article 74 shall not apply.

2. Courts or public prosecutors' offices of the Member States may, in the course of proceedings before them, open files or copies thereof transmitted by the Office to inspection by third parties. Such inspection shall be subject to Article 74 of Regulation (EC) No 6/2002.

3. The Office shall not charge any fee for inspections pursuant to paragraphs 1 and 2.

4. The Office shall, at the time of transmission of the files or copies thereof to the courts or public prosecutors' offices of the Member States, indicate the restrictions to which the inspection of files relating to Community designs applied for or registered Community designs is subject pursuant to Article 74 of Regulation (EC) No 6/2002 and Article 72 of this Regulation.

CHAPTER XVIII

COSTS

Article 79

Apportionment and fixing of costs

1. Apportionment of costs pursuant to Article 70(1) and (2) of Regulation (EC) No 6/2002 shall be dealt with in the decision on the application for a declaration of invalidity of a registered Community design, or in the decision on the appeal.

2. Apportionment of costs pursuant to Article 70(3) and (4) of Regulation (EC) No 6/2002 shall be dealt with in a decision on costs by the Invalidity Division or the Board of Appeal.

3. A bill of costs, with supporting evidence, shall be attached to the request for the fixing of costs provided for in the first sentence of Article 70(6) of Regulation (EC) No 6/2002.

The request shall be admissible only if the decision in respect of which the fixing of costs is required has become final. Costs may be fixed once their credibility is established.

4. The request provided for in the second sentence of Article 70(6) of Regulation (EC) No 6/2002 for a review of the decision of the registry on the fixing of costs, stating the reasons on which it is based, must be filed at the Office within one month of the date of notification of the awarding of costs.

It shall not be deemed to be filed until the fee for reviewing the amount of the costs has been paid.

5. The Invalidity Division or the Board of Appeal, as the case may be, shall take a decision on the request referred to in paragraph 4 without oral proceedings.

6. The fees to be borne by the losing party pursuant to Article 70(1) of Regulation (EC) No 6/2002 shall be limited to the fees incurred by the other party for the application for a declaration of invalidity and/or for the appeal.

7. Costs essential to the proceedings and actually incurred by the successful party shall be borne by the losing party in accordance with Article 70(1) of Regulation (EC) No 6/2002 on the basis of the following maximum rates:

- (a) travel expenses of one party for the outward and return journey between the place of residence or the place of business and the place where oral proceedings are held or where evidence is taken,

as follows:

- (i) the cost of the first-class rail fare including usual transport supplements where the total distance by rail does not exceed 800 km;
- (ii) the cost of the tourist-class air fare where the total distance by rail exceeds 800 km or the route includes a sea crossing;
- (b) subsistence expenses of one party equal to the daily subsistence allowance for officials in grades A 4 to A 8 as laid down in Article 13 of Annex VII to the Staff Regulations of officials of the European Communities;
- (c) travel expenses of representatives within the meaning of Article 78(1) of Regulation (EC) No 6/2002 and of witnesses and of experts, at the rates provided for in point (a);
- (d) subsistence expenses of representatives within the meaning of Article 78(1) of Regulation (EC) No 6/2002 and of witnesses and experts, at the rates referred to in point (b);
- (e) costs entailed in the taking of evidence in the form of examination of witnesses, opinions by experts or inspection, up to EUR 300 per proceedings;
- (f) costs of representation, within the meaning of Article 78(1) of Regulation (EC) No 6/2002:
 - (i) of the applicant in proceedings relating to invalidity of a registered Community design up to EUR 400;
 - (ii) of the holder in proceedings relating to invalidity of a registered Community design up to EUR 400;
 - (iii) of the appellant in appeal proceedings up to EUR 500;
 - (iv) of the defendant in appeal proceedings up to EUR 500;
- (g) where the successful party is represented by more than one representative within the meaning of Article 78(1) of the Regulation (EC) No 6/2002, the losing party shall bear the costs referred to in points (c), (d) and (f) for one such person only;
- (h) the losing party shall not be obliged to reimburse the successful party for any costs, expenses and fees other than those referred to in points (a) to (g).

Where the taking of evidence in any of the proceedings referred to in point (f) of the first subparagraph involves the examination of witnesses, opinions by experts or inspection, an additional amount shall be granted for representation costs of up to EUR 600 per proceedings.

CHAPTER XIX

LANGUAGES

Article 80

Applications and declarations

Without prejudice to Article 98(4) of Regulation (EC) No 6/2002:

- (a) any application or declaration relating to an application for a registered Community design may be filed in the language used for filing the application or in the second language indicated by the applicant in his/her application;

- (b) any application or declaration other than an application for declaration of invalidity pursuant to Article 52 of Regulation (EC) No 6/2002, or declaration of surrender pursuant to Article 51 of that Regulation relating to a registered Community design may be filed in one of the languages of the Office;
- (c) when any of the forms provided by the Office pursuant to Article 68 is used, such forms may be used in any of the official languages of the Community, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

Article 81

Written proceedings

1. Without prejudice to Article 98(3) and (5) of Regulation (EC) No 6/2002 and save as otherwise provided in this Regulation, in written proceedings before the Office a party may use any language of the Office.

If the language chosen is not the language of the proceedings, the party shall supply a translation into that language within one month of the date of the submission of the original document.

Where the applicant for a registered Community design is the sole party to proceedings before the Office and the language used for the filing of the application for the registered Community design is not one of the languages of the Office, the translation may also be filed in the second language indicated by the applicant in his/her application.

2. Save as otherwise provided in this Regulation, documents to be used in proceedings before the Office may be filed in any official language of the Community.

Where the language of such documents is not the language of the proceedings the Office may require that a translation be supplied, within a time limit specified by it, in that language or, at the choice of the party to the proceeding, in any language of the Office.

Article 82

Oral proceedings

1. Any party to oral proceedings before the Office may, in place of the language of proceedings, use one of the other official languages of the Community, on condition that he/she makes provision for interpretation into the language of proceedings.

Where the oral proceedings are held in a proceeding concerning the application for registration of a design the applicant may use either the language of the application or the second language indicated by him/her.

2. In oral proceedings concerning the application for registration of a design, the staff of the Office may use either the language of the application or the second language indicated by the applicant.

In all other oral proceedings, the staff of the Office may use, in place of the language of the proceedings, one of the other languages of the Office, on condition that the party or parties to the proceedings agree(s) to such use.

3. With regard to the taking of evidence, any party to be heard, witness or expert who is unable

to express himself/herself adequately in the language of proceedings, may use any of the official languages of the Community.

Where the taking of evidence is decided upon following a request by a party to the proceedings, parties to be heard, witnesses or experts who express themselves in languages other than the language of proceedings may be heard only if the party who made the request makes provision for interpretation into that language.

In proceedings concerning the application for registration of a design, in place of the language of the application, the second language indicated by the applicant may be used.

In any proceedings with only one party, the Office may at the request of the party concerned permit derogation from the provisions in this paragraph.

4. If the parties and the Office so agree, any official language of the Community may be used in oral proceedings.

5. The Office shall, if necessary, make provision at its own expense for interpretation into the language of proceedings, or, where appropriate, into its other languages, unless this interpretation is the responsibility of one of the parties to the proceedings.

6. Statements by staff of the Office, by parties to the proceedings and by witnesses and experts, made in one of the languages of the Office during oral proceedings shall be entered in the minutes in the language employed. Statements made in any other language shall be entered in the language of proceedings.

Corrections to the application for or the registration of a Community design shall be entered in the minutes in the language of proceedings.

Article 83

Certification of translations

1. When a translation of any document is to be filed, the Office may require the filing, within a time limit to be specified by it, of a certificate that the translation corresponds to the original text.

Where the certificate relates to the translation of a previous application pursuant to Article 42 of Regulation (EC) No 6/2002, such time limit shall not be less than three months after the date of filing of the application.

Where the certificate is not filed within that time limit, the document shall be deemed not to have been received.

2. The President of the Office may determine the manner in which translations are certified.

Article 84

Legal authenticity of translations

In the absence of evidence to the contrary, the Office may assume that a translation corresponds to the relevant original text.

CHAPTER XX

RECIPROCITY, TRANSITION PERIOD AND ENTRY INTO FORCE

Article 85

Publication of reciprocity

1. If necessary, the President of the Office shall request the Commission to enquire whether a State which is not party to the Paris Convention for the Protection of Industrial Property or to the Agreement establishing the World Trade Organisation grants reciprocal treatment within the meaning of Article 41(5) Regulation (EC) No 6/2002.

2. If the Commission determines that reciprocal treatment in accordance with paragraph 1 is granted, it shall publish a communication to that effect in the Official Journal of the European Communities.

3. Article 41(5) of Regulation (EC) No 6/2002 shall apply from the date of publication in the Official Journal of the European Communities of the communication referred to in paragraph 2, unless the communication states an earlier date from which it is applicable.

Article 41(5) of Regulation (EC) No 6/2002 shall cease to be applicable from the date of publication in the Official Journal of the European Communities of a communication of the Commission stating that reciprocal treatment is no longer granted, unless the communication states an earlier date from which it is applicable.

4. Communications referred to in paragraphs 2 and 3 shall also be published in the Official Journal of the Office.

Article 86

Transition period

1. Any application for registration of a Community design filed no more than three months before the date fixed pursuant to Article 111(2) of Regulation (EC) No 6/2002 shall be marked by the Office with the filing date determined pursuant to that provision and with the actual date of receipt of the application.

2. With regard to the application, the priority period of six months provided for in Articles 41 and 44 of Regulation (EC) No 6/2002 shall be calculated from the date fixed pursuant to Article 111(2) of that Regulation.

3. The Office may issue a receipt to the applicant prior to the date fixed pursuant to Article 111(2) of Regulation (EC) No 6/2002.

4. The Office may examine the applications prior to the date fixed pursuant to Article 111(2) of Regulation (EC) No 6/2002 and communicate with the applicant with a view to remedying any deficiencies prior to that date.

Any decisions with regard to such applications may be taken only after that date.

5. Where the date of receipt of an application for the registration of a Community design by the Office, by the central industrial property office of a Member State or by the Benelux Design Office is before the commencement of the three-month period specified in Article 111(3) of Regulation (EC) No 6/2002 the application shall be deemed not to have been filed.

The applicant shall be informed accordingly and the application shall be sent back to him/her.

Article 87

Entry into force

This Regulation shall enter into force on the seventh day following its publication in the Official Journal of the European Communities.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 21 October 2002.

For the Commission

Frederik Bolkestein

Member of the Commission

(1) OJ L 3, 5.1.2002, p. 1.

(2) See page 54 of this Official Journal.

(3) OJ L 11, 14.1.1994, p. 1.

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Industrial property: Registration of "Community Designs" from 1 April 2003 - frequently asked questions

Reference: MEMO/03/77 Date: 01/04/2003

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MEMO/03/77

Brussels, 1st April 2003

Industrial property: Registration of "Community Designs" from 1 April 2003 - frequently asked questions

The Office for Harmonisation in the Internal Market (OHIM) in Alicante will register Community designs as from 1st April 2003, under the EU's new Community system for the protection of designs. This system has been set up under a Regulation adopted by the EU's Council of Ministers on 12 December 2001, after a proposal from the European Commission. The registration procedure is simple and inexpensive. Unregistered designs will also be protected.

What are the objectives of the new system?

To reduce legal obstacles to the circulation of design goods within the Internal Market and to ensure fair competition in this respect.

The system will foster creativity and innovation by making it easier to protect designs throughout the Internal Market with a single application. It will also help fight counterfeiting and piracy.

How does the system work?

Community Designs registered by the OHIM will enjoy protection in all fifteen Member States.

Procedural burdens on applicants will be kept to a minimum: in particular, there will be no need for designs submitted to undergo, before registration is granted, a detailed examination in order to ensure they qualify for protection.

Instead, the OHIM will be able to annul non-qualifying registrations after invalidity proceedings.

Member States' Community design courts will also be able to decide, if appropriate, that a registered design should not in fact be entitled to protection, following a counterclaim for a declaration of invalidity in the context of litigation arising from an alleged infringement of that protection.

Exactly what protection is conferred by the registration of a design?

Holders of registered designs will have exclusive rights to use the design concerned and to prevent any third party from using it anywhere within the European Union. They will be protected against both deliberate copying and the independent development of a similar design

How long will this protection last?

For up to 25 years. Registrations will need to be renewed every five years up to that maximum.

What is the cost of registering designs?

The basic registration fee for a first design will be € 230, with lower fees for any further design registered at the same time. Renewals will cost € 90 for a first renewal up to € 180 for a maximum fourth renewal.

A full table of costs is annexed.

What criteria must a design meet to be eligible for protection?

To be eligible for protection, designs must be **new** and must have **an individual character**. In other words it must be apparent to the public that they are different from products which existed previously.

What about unregistered designs? Will there be any protection at EU level for them?

Yes. Unregistered designs must meet the same criteria as registered ones - they must be new and have an individual character - in order to enjoy protection.

This protection will be applicable from the date of disclosure of designs to the public within the European Union. That disclosure may occur through designs going on sale or through prior marketing or publicity. The relevant designs will be protected for **three years**.

The main difference in the **level** of protection afforded will be that a Registered Community Design will be protected against both deliberate copying and the independent development of a similar design. An unregistered design will be protected only against deliberate copying.

How long will it be before designs can be registered in practice?

Designs can be registered as of now. In order to get the system up and running immediately, the OHIM has been accepting pre-applications since 2 January 2003.

Can companies still register designs under national law?

Companies will still be able to choose to register designs under national law, as national design protection, as harmonised by the Design Protection Directive (98/71/EC, see below), will continue to exist in parallel with Community design protection.

How much will all this cost the taxpayer?

The aim is that fee revenue will enable the OHIM to cover the costs it incurs in setting up and managing the system.

What is the historical background to the introduction of the Community Design system?

Since 1993, when it brought forward its first proposal on the EU-wide protection of designs, the Commission has viewed this as a high priority.

The first step was achieved in 1998, with the adoption of the **Directive on Design Protection** (98/71/EC) harmonising the main rules governing designs registered in the Member States.

However, until now, designs have had to be registered separately in every individual Member State where protection was sought. This means there has continued to be a potential obstacle to the free movement of those products which incorporate designs, which are the subject of national rights, held in different countries by different entities.

In order to remove this barrier to the efficient working of the Internal Market, the **Regulation on Community Designs** was adopted by the Council on 12 December 2001 (see IP/01/1803), after a proposal from the Commission in June 1999 (see IP/99/407). This amended the earlier proposal from 1993, in order to ensure compatibility with the Directive.

The Commission then adopted on 22 October 2002 a Regulation of its own giving the OHIM **the administrative tools** it needed to operate the system, such as the registration and cancellation of designs and the procedure for appeals (see IP/02/1535).

Finally, a second Commission Regulation adopted on 19 December 2002 **set the fees** payable for the registration of Community Designs (see IP/02/1926).

Are there any types of design, which are not covered by the Community Design system?

Component parts not visible once incorporated into complex products, designs dictated by function of the product - for example certain parts of a shaver which must have a certain shape in order to work - and "must-fit" parts of complex products, for example electrical or other interconnections (with the exception of connections in modular systems such as lego) will not be protected under the Community Design.

Furthermore, in line with Directive 98/71, designs which constitute a component part of a complex product will not be protected when used for the purpose of repairing that complex product so as to restore its original appearance. The Commission intends to make parallel proposals to amend the spare parts provisions of both the Directive and the Regulation, in 2004.

What is the relationship with the Community trademark system?

The procedures for applying for registration of Community Designs are aligned as closely as possible with those set up for registering Community Trade Marks under the equivalent Commission Regulation adopted in 1995. This is to ensure that the registration procedures dealt with by the OHIM are as coherent and convenient as possible for future users of the system.

Where can I get more information and detailed instructions on how to register a design?

The full text of the Regulation is available at:

http://www.europa.eu.int/comm/internal_market/en/indprop/design/index.htm

Further practical details are available on the OHIM website at:

<http://oami.eu.int/>

Fees for the registration of Community Designs

Reason for Fee	Fee	Additional fee (designs 2-10 each)	Additional fee (designs 11+ each)
Registration	â,-230	â,-115	â,-50
Publication	â,-120	â,-60	â,-30
Deferred Publication	â,-40	â,-20	â,-10
Late Payment Registration	â,-60		
Late Payment Publication	â,-30		
Late Payment Deferment	â,-10		
Late Payment Additional Designs	25% of additional fee		
Renewal (first)	â,-90		
Renewal (second)	â,-120		
Renewal (third)	â,-150		

Renewal (fourth)	â,-180
Late Renewal	25% of late fee
Invalidity Application	â,-350
Appeal	â,-800
Restitution in integrum	â,-200
Transfer Application	â,-200 (max â,-1000)
Transfer Design	
Licence Registration	
Licence Cancellation	
Copy of Application, Certificate or Extract (uncertified)	â,-10
Copy of Application, Certificate or Extract (certified)	â,-30
Inspection of Files	â,-30
Copy of file (uncertified)	â,-10 + â,-1 per page over 10
Copy of file (certified)	â,-30 + â,-1 per page over 10
Communication of File	â,-10 + â,-1 per page over 10
Review of Refund	â,-100

**Directive 98/71/EC of the European Parliament and of the Council
the Councilthe CouncilOctober 1998 on the legal protection of designs**

DIRECTIVE 98/71/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 13 October 1998 on the legal protection of designs

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community and in particular Article 100a thereof,

Having regard to the proposal by the Commission (1),

Having regard to the opinion of the Economic and Social Committee (2),

Acting in accordance with the procedure laid down in Article 189b of the Treaty (3), in the light of the joint text approved by the Conciliation Committee on 29 July 1998,

- (1) Whereas the objectives of the Community, as laid down in the Treaty, include laying the foundations of an ever closer union among the peoples of Europe, fostering closer relations between Member States of the Community, and ensuring the economic and social progress of the Community countries by common action to eliminate the barriers which divide Europe; whereas to that end the Treaty provides for the establishment of an internal market characterised by the abolition of obstacles to the free movement of goods and also for the institution of a system ensuring that competition in the internal market is not distorted; whereas an approximation of the laws of the Member States on the legal protection of designs would further those objectives;
- (2) Whereas the differences in the legal protection of designs offered by the legislation of the Member States directly affect the establishment and functioning of the internal market as regards goods embodying designs; whereas such differences can distort competition within the internal market;
- (3) Whereas it is therefore necessary for the smooth functioning of the internal market to approximate the design protection laws of the Member States;
- (4) Whereas, in doing so, it is important to take into consideration the solutions and the advantages with which the Community design system will provide undertakings wishing to acquire design rights;
- (5) Whereas it is unnecessary to undertake a full-scale approximation of the design laws of the Member States, and it will be sufficient if approximation is limited to those national provisions of law which most directly affect the functioning of the internal market; whereas provisions on sanctions, remedies and enforcement should be left to national law; whereas the objectives of this limited approximation cannot be sufficiently achieved by the Member States acting alone;
- (6) Whereas Member States should accordingly remain free to fix the procedural provisions concerning registration, renewal and invalidation of design rights and provisions concerning the effects of such invalidity;
- (7) Whereas this Directive does not exclude the application to designs of national or Community legislation providing for protection other than that conferred by registration or publication as design, such as legislation relating to unregistered design rights, trade marks, patents and utility models, unfair competition or civil liability;
- (8) Whereas, in the absence of harmonisation of copyright law, it is important to establish the principle of cumulation of protection under specific registered design protection law and under copyright law, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred;

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- (9) Whereas the attainment of the objectives of the internal market requires that the conditions for obtaining a registered design right be identical in all the Member States; whereas to that end it is necessary to give a unitary definition of the notion of design and of the requirements as to novelty and individual character with which registered design rights must comply;
 - (10) Whereas it is essential, in order to facilitate the free movement of goods, to ensure in principle that registered design rights confer upon the right holder equivalent protection in all Member States;
 - (11) Whereas protection is conferred by way of registration upon the right holder for those design features of a product, in whole or in part, which are shown visibly in an application and made available to the public by way of publication or consultation of the relevant file;
 - (12) Whereas protection should not be extended to those component parts which are not visible during normal use of a product, or to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual character; whereas features of design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection;
 - (13) Whereas the assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design;
 - (14) Whereas technological innovation should not be hampered by granting design protection to features dictated solely by a technical function; whereas it is understood that this does not entail that a design must have an aesthetic quality; whereas, likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings; whereas features of a design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection;
 - (15) Whereas the mechanical fittings of modular products may nevertheless constitute an important element of the innovative characteristics of modular products and present a major marketing asset and therefore should be eligible for protection;
 - (16) Whereas a design right shall not subsist in a design which is contrary to public policy or to accepted principles of morality; whereas this Directive does not constitute a harmonisation of national concepts of public policy or accepted principles of morality;
 - (17) Whereas it is fundamental for the smooth functioning of the internal market to unify the term of protection afforded by registered design rights;
 - (18) Whereas the provisions of this Directive are without prejudice to the application of the competition rules under Articles 85 and 86 of the Treaty;
 - (19) Whereas the rapid adoption of this Directive has become a matter of urgency for a number of industrial sectors; whereas full-scale approximation of the laws of the Member States on the use of protected designs for the purpose of permitting the repair of a complex product so as to restore its original appearance, where the product incorporating the design or to which the design is applied constitutes a component part of a complex product upon whose appearance the protected design is dependent, cannot be introduced at the present stage; whereas the lack of

full-scale approximation of the laws of the Member States on the use of protected designs for such repair of a complex product should not constitute an obstacle to the approximation of those other national provisions of design law which most directly affect the functioning of the internal market; whereas for this reason Member States should in the meantime maintain in force any provisions in conformity with the Treaty relating to the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance, or, if they introduce any new provisions relating to such use, the purpose of these provisions should be only to liberalise the market in such parts; whereas those Member States which, on the date of entry into force of this Directive, do not provide for protection for designs of component parts are not required to introduce registration of designs for such parts; whereas three years after the implementation date the Commission should submit an analysis of the consequences of the provisions of this Directive for Community industry, for consumers, for competition and for the functioning of the internal market; whereas, in respect of component parts of complex products, the analysis should, in particular, consider harmonisation on the basis of possible options, including a remuneration system and a limited term of exclusivity; whereas, at the latest one year after the submission of its analysis, the Commission should, after consultation with the parties most affected, propose to the European Parliament and the Council any changes to this Directive needed to complete the internal market in respect of component parts of complex products, and any other changes which it considers necessary;

- (20) Whereas the transitional provision in Article 14 concerning the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance is in no case to be construed as constituting an obstacle to the free movement of a product which constitutes such a component part;
- (21) Whereas the substantive grounds for refusal of registration in those Member States which provide for substantive examination of applications prior to registration, and the substantive grounds for the invalidation of registered design rights in all the Member States, must be exhaustively enumerated,

HAVE ADOPTED THIS DIRECTIVE:

Article 1

Definitions

For the purpose of this Directive:

- (a) 'design` means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;
- (b) 'product` means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;
- (c) 'complex product` means a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product.

Article 2

Scope of application

1. This Directive shall apply to:

- (a) design rights registered with the central industrial property offices of the Member States;
- (b) design rights registered at the Benelux Design Office;
- (c) design rights registered under international arrangements which have effect in a Member State;
- (d) applications for design rights referred to under (a), (b) and (c).

2. For the purpose of this Directive, design registration shall also comprise the publication following filing of the design with the industrial property office of a Member State in which such publication has the effect of bringing a design right into existence.

Article 3

Protection requirements

1. Member States shall protect designs by registration, and shall confer exclusive rights upon their holders in accordance with the provisions of this Directive.

2. A design shall be protected by a design right to the extent that it is new and has individual character.

3. A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter, and
- (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

4. 'Normal use' within the meaning of paragraph (3)(a) shall mean use by the end user, excluding maintenance, servicing or repair work.

Article 4

Novelty

A design shall be considered new if no identical design has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.

Article 5

Individual character

1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration

or, if priority is claimed, the date of priority.

2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

Article 6

Disclosure

1. For the purpose of applying Articles 4 and 5, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community, before the date of filing of the application for registration or, if priority is claimed, the date of priority. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

2. A disclosure shall not be taken into consideration for the purpose of applying Articles 4 and 5 if a design for which protection is claimed under a registered design right of a Member State has been made available to the public:

- (a) by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer, or his successor in title; and
- (b) during the 12-month period preceding the date of filing of the application or, if priority is claimed, the date of priority.

3. Paragraph 2 shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

Article 7

Designs dictated by their technical function and designs of interconnections

1. A design right shall not subsist in features of appearance of a product which are solely dictated by its technical function.

2. A design right shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.

3. Notwithstanding paragraph 2, a design right shall, under the conditions set out in Articles 4 and 5, subsist in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

Article 8

Designs contrary to public policy or morality

A design right shall not subsist in a design which is contrary to public policy or to accepted principles of morality.

Article 9

Scope of protection

1. The scope of the protection conferred by a design right shall include any design which does not produce on the informed user a different overall impression.
2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

Article 10

Term of protection

Upon registration, a design which meets the requirements of Article 3(2) shall be protected by a design right for one or more periods of five years from the date of filing of the application. The right holder may have the term of protection renewed for one or more periods of five years each, up to a total term of 25 years from the date of filing.

Article 11

Invalidity or refusal of registration

1. A design shall be refused registration, or, if the design has been registered, the design right shall be declared invalid:
 - (a) if the design is not a design within the meaning of Article 1(a); or
 - (b) if it does not fulfil the requirements of Articles 3 to 8; or
 - (c) if the applicant for or the holder of the design right is not entitled to it under the law of the Member State concerned; or
 - (d) if the design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if priority is claimed, the date of priority, and which is protected from a date prior to the said date by a registered Community design or an application for a registered Community design or by a design right of the Member State concerned, or by an application for such a right.
2. Any Member State may provide that a design shall be refused registration, or, if the design has been registered, that the design right shall be declared invalid:
 - (a) if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State concerned governing that sign confers on the right holder of the sign the right to prohibit such use; or
 - (b) if the design constitutes an unauthorised use of a work protected under the copyright law of the Member State concerned; or

- (c) if the design constitutes an improper use of any of the items listed in Article 6b of the Paris Convention for the Protection of Industrial Property, or of badges, emblems and escutcheons other than those covered by Article 6b of the said Convention which are of particular public interest in the Member State concerned.
3. The ground provided for in paragraph 1(c) may be invoked solely by the person who is entitled to the design right under the law of the Member State concerned.
 4. The grounds provided for in paragraph 1(d) and in paragraph 2(a) and (b) may be invoked solely by the applicant for or the holder of the conflicting right.
 5. The ground provided for in paragraph 2(c) may be invoked solely by the person or entity concerned by the use.
 6. Paragraphs 4 and 5 shall be without prejudice to the freedom of Member States to provide that the grounds provided for in paragraphs 1(d) and 2(c) may also be invoked by the appropriate authority of the Member State in question on its own initiative.
 7. When a design has been refused registration or a design right has been declared invalid pursuant to paragraph 1(b) or to paragraph 2, the design may be registered or the design right maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained. Registration or maintenance in an amended form may include registration accompanied by a partial disclaimer by the holder of the design right or entry in the design Register of a court decision declaring the partial invalidity of the design right.
 8. Any Member State may provide that, by way of derogation from paragraphs 1 to 7, the grounds for refusal of registration or for invalidation in force in that State prior to the date on which the provisions necessary to comply with this Directive enter into force shall apply to design applications which have been made prior to that date and to resulting registrations.
 9. A design right may be declared invalid even after it has lapsed or has been surrendered.

Article 12

Rights conferred by the design right

1. The registration of a design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.
2. Where, under the law of a Member State, acts referred to in paragraph 1 could not be prevented before the date on which the provisions necessary to comply with this Directive entered into force, the rights conferred by the design right may not be invoked to prevent continuation of such acts by any person who had begun such acts prior to that date.

Article 13

Limitation of the rights conferred by the design right

1. The rights conferred by a design right upon registration shall not be exercised in respect of:

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- (a) acts done privately and for non-commercial purposes;
- (b) acts done for experimental purposes;
- (c) acts of reproduction for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.
2. In addition, the rights conferred by a design right upon registration shall not be exercised in respect of:
- (a) the equipment on ships and aircraft registered in another country when these temporarily enter the territory of the Member State concerned;
- (b) the importation in the Member State concerned of spare parts and accessories for the purpose of repairing such craft;
- (c) the execution of repairs on such craft.

Article 14

Transitional provision

Until such time as amendments to this Directive are adopted on a proposal from the Commission in accordance with the provisions of Article 18, Member States shall maintain in force their existing legal provisions relating to the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance and shall introduce changes to those provisions only if the purpose is to liberalise the market for such parts.

Article 15

Exhaustion of rights

The rights conferred by a design right upon registration shall not extend to acts relating to a product in which a design included within the scope of protection of the design right is incorporated or to which it is applied, when the product has been put on the market in the Community by the holder of the design right or with his consent.

Article 16

Relationship to other forms of protection

The provisions of this Directive shall be without prejudice to any provisions of Community law or of the law of the Member State concerned relating to unregistered design rights, trade marks or other distinctive signs, patents and utility models, typefaces, civil liability or unfair competition.

Article 17

Relationship to copyright

A design protected by a design right registered in or in respect of a Member State in accordance with this Directive shall also be eligible for protection under the law of copyright of that State as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State.

Article 18

Revision

Three years after the implementation date specified in Article 19, the Commission shall submit an analysis of the consequences of the provisions of this Directive for Community industry, in particular the industrial sectors which are most affected, particularly manufacturers of complex products and component parts, for consumers, for competition and for the functioning of the internal market. At the latest one year later the Commission shall propose to the European Parliament and the Council any changes to this Directive needed to complete the internal market in respect of component parts of complex products and any other changes which it considers necessary in light of its consultations with the parties most affected.

Article 19

Implementation

1. Member States shall bring into force the laws, regulations or administrative provisions necessary to comply with this Directive not later than 28 October 2001.

When Member States adopt these provisions, they shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such reference shall be laid down by Member States.

2. Member States shall communicate to the Commission the provisions of national law which they adopt in the field governed by this Directive.

Article 20

Entry into force

This Directive shall enter into force on the 20th day following its publication in the Official Journal of the European Communities.

Article 21

Addressees

This Directive is addressed to the Member States.

Done at Luxembourg, 13 October 1998.

For the European Parliament

The President

J. M. GIL-ROBLES

For the Council

The President

C. EINEM

(1) OJ C 345, 23. 12. 1993, p. 14 and OJ C 142, 14. 5. 1996, p. 7.

(2) OJ C 388, 31. 12. 1994, p. 9 and OJ C 110, 2. 5. 1995, p. 12.

(3) Opinion of the European Parliament of 12 October 1995 (OJ C 287, 30. 10. 1995, p. 157), common position of the Council of 17 June 1997 (OJ C 237, 4. 8. 1997, p. 1), Decision of the European Parliament of 22 October 1997 (OJ C 339, 10. 11. 1997, p. 52). Decision of the European Parliament of 15 September 1998. Decision of the Council of 24 September 1998.

Statement by the Commission

The Commission shares the European Parliament's concern about combating counterfeiting.

The Commission's intention is to present before the end of the year a Green Paper regarding piracy and counterfeiting in the internal market.

The Commission will include in this Green Paper Parliament's idea of creating an obligation for counterfeiters to provide holders of design rights with information on their illegal acts.

Statement by the Commission regarding Article 18

Immediately following the date of adoption of the Directive, and without prejudice to Article 18, the Commission proposes to launch a consultation exercise involving manufacturers of complex products and of component parts in the motor vehicles sector. The aim of this consultation will be to arrive at a voluntary agreement between the parties involved on the protection of designs in cases where the product incorporating the design or to which the design is applied constitutes a component part of a complex product upon whose appearance the protected design is dependent.

The Commission will coordinate the consultation exercise and will report regularly to the Parliament and the Council on its progress. The consulted parties will be invited by the Commission to consider a range of possible options on which to base a voluntary agreement, including a remuneration system and a system based on a limited period of design protection.

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BELPROV	1. - Loi du 13 mars 2003 portant essentiment au Protocole portant modification de loi uniforme Benelux en matière de desins ou modèles ,Fait à Bruxelles le 20/06/2002. MB Ed. 5 du 14/03/2003 p. 12832 (C - 2003/15046)
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2. - Acte législatif FEK n° 185 du 19/09/1997, p.6631

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GBRPROV

1. - The Registered Designs Regulations 2001 S.I. n° 3949 of 2001 du 08/12/2001
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Implementing SIs

['*' indicates information added by Justis Publishing]

- *The Registered Designs Regulations 2001, SI 2001/3949
- *The Registered Designs Regulations 2003, SI 2003/550

Related SIs

['*' indicates information added by Justis Publishing]

- *The Registered Designs (Amendment) Rules 2001, SI 2001/3950
- *The Registered Designs (Fees) (Amendment) Rules 2001, SI 2001/3951

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Industrial property: Commission proposes linking of EU design registration system with WIPO international system

Reference: IP/05/1691 Date: 22/12/2005

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IP/05/1691

Brussels, 22 December 2005

Industrial property: Commission proposes linking of EU design registration system with WIPO international system

The European Commission has presented two proposals to link the 'Community Design' system, which protects designs within the EU, with the international design registration system of the World Intellectual Property Organisation (WIPO). The proposals would allow companies, with a single application, to obtain protection of a design not only throughout the EU with the Community Design, but also in the countries which are members of the Geneva Act of the Hague Agreement concerning the international registration of industrial designs. The first proposal relates to the accession of the European Community (EC) to the Geneva Act. The second proposal contains the necessary provisions to give effect to that accession, in particular through an amendment of Council Regulation No 6/2002 on Community Designs.

Internal Market and Services Commissioner Charlie McCreevy said: "These proposals will allow EU firms to safeguard valuable design rights with less bureaucracy while at the same time encouraging them to trade with third countries in the knowledge that their design rights are protected. I hope that the Council will now adopt these proposals as soon as possible."

In 2004 the Commission launched a consultation with interested parties on the possible impact on business of EC accession to the Hague system. An overwhelming majority of businesses, professional organisations and Member States were in favour of accession in the near future.

The Community Design system^[1], which became fully operational on 1 April 2003, provides for the acquisition of protection for designs with unitary effect for the whole territory of the EU. The Office for the Harmonization in the Internal Market (Trade Marks and Designs), which is located in Alicante (Spain), is in charge of handling the administration of the registered Community designs.

The Geneva Act, signed on 2 July 1999, became fully operational on 1 April 2004. It allows designers to obtain design protection in a number of countries through a single international registration filed with the International Bureau of WIPO, replacing a whole series of registrations with different national or regional offices.

This simplified procedure would lead to a saving of costs: there would no longer be a need to provide translations of the documents, to keep watch on the different deadlines for renewal of a great number of national registrations and to pay a series of national fees and fees to agents in different countries.

All this would have a positive impact on research, development and innovation activities. The simplified procedure would also facilitate access to protection in third countries, which would encourage EU companies to trade with these countries in the knowledge that their designs are protected.

The creation of a link between the Community design system and the Hague arrangement would benefit a wide range of industrial sectors, in particular textiles, furniture, cars, jewellery and mobile phones.

So far 18 countries have become party to the Geneva Act, including Singapore, Korea, Turkey and Switzerland.

For more information see:

http://europa.eu.int/comm/internal_market/en/indprop/design/index.htm

<http://www.wipo.int/hague/en/>

[11] Council Regulation (EC) No 6/2002 on Community Designs, OJ No L 3, 5.1.2002, p.1.



COMMISSION OF THE EUROPEAN COMMUNITIES

Brussels, 22.12.2005
COM(2005)687 final

2005/0273 (CNS)

Proposal for a

COUNCIL DECISION

approving the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999

{SEC(2005)1748}

(presented by the Commission)

EXPLANATORY MEMORANDUM

1. Introduction

On 12 December 2001, the Council adopted Regulation (EC) No 6/2002 on Community Designs (hereinafter referred to as “the Community Designs Regulation”).¹

The Community Designs Regulation establishes the Community design system, which provides for the acquisition of protection for designs with unitary effect for the whole territory of the European Community. According to the Regulation, a design may be protected either by an unregistered Community design, if the design is made available to the public in the manner provided for in the Regulation, or by a registered Community design, if registered under the procedure provided for in the Regulation.

The Community Designs Regulation entrusts the Office for the Harmonization in the Internal Market (Trade Marks and Designs), hereinafter referred to as “the Office”,² to handle the administration of the Community design. On 1 January 2003, the Office enabled applications for registered Community designs with the first date of filing being granted on 1 April 2003.

On 23 December 2003, the 1999 Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999 (hereinafter referred to as “the Geneva Act”) entered into force. The Geneva Act allows designers to obtain design protection in a number of countries through a single international registration. Thus, under the Geneva Act, a single international application filed with the International Bureau of the World Intellectual Property Organization (WIPO) replaces a whole series of applications which, otherwise, should have been effected with different national or regional Offices.

The objective of this proposal is to establish a link between the Community design system and the international registration system established under the Geneva Act. This link will enable designers to file a single international application at the International Bureau of WIPO designating, amongst other Contracting Parties, the European Community in order to obtain protection under the Community design system.

2. The Geneva Act

The Hague System is based on the Hague Agreement Concerning the International Registration of Industrial Designs. This Agreement is constituted by three different Acts: the London Act of 1934, the Hague Act of 1960 and the Geneva Act of 1999. The three Acts are autonomous and coexist with respect to their substantive provisions. Contracting parties may decide to become party to only one, to two or to all three of the Acts. They automatically become member of the Hague Union which at present has 42 Contracting States, amongst which 12 EU Member States.³

¹ OJ L 3, 5.1.2002, p. 1.

² The OHIM is established by Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ L 11, 14.1.1994, p. 1.

³ Belgium, Estonia, France, Germany, Greece, Hungary, Italy, Latvia, Luxembourg, Netherlands, Slovenia, Spain. n Five EU Member States – out of 18 countries in total - have become party to the Geneva Act (Estonia, Hungary, Latvia, Slovenia and Spain). Updates will be published on the WIPO website: www.wipo.int.

The system of international registration of designs arose from a need for simplicity and economy. In effect, it enables design owners originating from a Contracting State to obtain protection of their designs with a minimum of formality and expense.

The international application can be filed in one language (English or French), upon payment of a single set of fees. The applicant has to designate the Contracting States in which protection is sought. An international application is normally sent directly to the International Bureau. Upon receipt, the International Bureau checks that the international application complies with the prescribed formal requirements and then publishes the application – or better, the registration - in the *International Designs Bulletin* (on WIPO's internet website). Following publication, each national Office must identify the international registrations in which they have been designated, in order to proceed with the substantive examination, if any, provided for by its own legislation.

Any substantive aspect of the protection (including in particular the substantive examination carried out by each Office, the assessment of the conditions of protection and the scope of that protection) is thus entirely a matter of the legislation of each designated Contracting Party.

As a result of that examination, the Office may notify to the International Bureau a refusal of protection for its territory. However, an international registration may not be refused on grounds of non-compliance with formal requirements. Such requirements must be considered as already satisfied, following the examination carried out by the International Bureau.

Once the international registration has been accepted it produces the same effect in each of the countries designated as if the design had been deposited there directly. The international registration is therefore equivalent to a national right in terms of its scope of protection and enforcement. At the same time, the international registration facilitates the maintenance of protection: there is a single deposit to renew and one simple procedure for recording any changes (e.g. in ownership or address).

The adoption of the Geneva Act in 1999 had a twofold objective, namely:

- to make the Hague System more attractive for applicants and to extend the system to new members; to that end, the 1999 Act has introduced a number of features into the Hague system with a view to facilitating the accession to the Hague Union of countries which administer design examination systems (such as USA and Japan);
- to provide for the establishment of a *link* between the international registration system and regional systems by providing that intergovernmental organizations may become a party to the Act.

The second objective opens the door for the accession of the European Community to the Hague System. The territory of the EU would then be regarded as a single country for the purposes of the Geneva Act, with the Community design rules as the relevant domestic legislation. The OHIM would become the Office responsible for the substantive examination of international applications in which the Community has been designated.

The Community design system and the international registration system as established by the Hague Agreement can be considered as being complementary. The Community design system provides for a complete and unified regional designs registration system which covers the

whole territory of the European Union. The Hague Agreement constitutes a treaty centralizing the procedures for obtaining protection of designs in the territory of the designated Contracting Parties.

The Geneva Act system became fully operational on 1 April 2004. On that date, both the Geneva Act and the modernised Common Regulations under the Hague Agreement, which simplify the entire proceedings, became effective.

3. Legal basis

A Community act to accede to the Geneva Act must be based on Article 308 EC, the provision of the Treaty on which the common rules, i.e. the Community Designs Regulation, are based. In addition, a reference should be made to Article 300 of the Treaty, which confers powers to the European Community to enter into agreements between the European Community and one or more States or international organisations.

A recent precedent on a similar intellectual property exercise is Council Decision 2003/793/EC of 27 October 2003 approving the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989.⁴ This Decision is based on Article 308 EC, in conjunction with Article 300 (2), second sentence, and Article 300(3), first subparagraph.

4. Procedure for the accession of the European Community to the Geneva Act

Under Article 27(1)(ii) of the Geneva Act, an intergovernmental organization may become party provided the following conditions are fulfilled:

- at least one of the Member States of the intergovernmental organization is a member of WIPO, and
- the organization maintains an Office through which protection of industrial designs may be obtained with effect in the territory in which the constituting treaty of the intergovernmental organization applies;
- the Office of such organization is not the subject of a notification under Article 19 of the Geneva Act.

The European Community fulfils those conditions. First, all Member States are member of WIPO. Second, OHIM is managing the administration of the Community design system set up under Regulation 6/2002. Third, OHIM is not subject of a notification under Article 19 of the Geneva Act.⁵

According to Article 27(2) of the Geneva Act, the instrument of accession to the Act shall be deposited by any State or international organization if it has not signed this Act. The EC has not signed the Geneva Act and is therefore obliged to deposit the instrument of accession. Article 27(3)(a) declares that for the EC accession the effective date of the deposit of the instrument of accession shall be the date on which the instrument is deposited. According to

⁴ OJ L 296 of 14.11.2003, p. 20.

⁵ This provision is relevant for countries which share a common Office, like the Benelux countries.

Article 28(3)(b) the accession of the EC then becomes effective three months after the date on which its instrument of accession has been deposited.

5. Declarations to be made in the framework of the accession of the Community to the Geneva Act

The Geneva Act and the Common Regulations under the Geneva Act, the London Act and the Hague Act of the Hague Agreement provide for the possibility or obligation for Contracting States to make certain declarations concerning the operation of the international registration system. Declarations made in the instrument of accession become effective on the date on which the Contracting Party becomes bound by the Act.

The Commission proposes that declarations to the Director-General of WIPO be made on the following matters.

(i) Article 4(1)(a) of the Geneva Act states that the international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant's Contracting party. However, according to Article 4(1)(b) a Contracting Party may notify that international applications may not be filed through its Office.

The Hague system draws most of its advantages from its simplicity and the location of the receiving office seems to be of minor importance for the application of designs. The European Community should therefore exclude the filing of an application through the Office in order to avoid useless duplication of work. Direct filing at WIPO is also to be preferred in order to avoid confusion by applicants between applications for registering Community designs and applications for international registrations. Such confusion would be all the more problematic in case of payment of the basic fee for an international application, which has to be paid in any event directly to the International Bureau and which is payable at the time of filing. If applicants would erroneously pay the fee to OHIM, this Office would have to return the fee.

It is significant that at present WIPO does not receive applications filed through national offices even from those Contracting Parties who would permit such a procedure.⁶

(ii) The Geneva Act provides in Article 7 that the prescribed fees shall include a standard designation fee that has to be paid for each designated Contracting Party. In addition, any Contracting Party that is an intergovernmental organisation may declare that, for each application and for each renewal of an international registration in which it is designated, the standard designation fee is replaced by an individual designation fee, whose amount shall be indicated in the declaration and can be changed in further declarations. The fixed amount may not be higher than the equivalent of the amount which the Contracting Party would be entitled to receive for a national application and renewal, that amount being diminished by the savings resulting from the international procedure. The designation fee shall be transferred by the International Bureau to the respective Contracting Party.⁷

⁶ In this respect, the Geneva Act differs from the Madrid Protocol concerning the international registration of marks, which specifies in Article 2 (2) that international applications shall be filed with the International Bureau through the intermediary of the office with which the basic application was filed or by which the basic registration was made.

⁷ The total fees payable in connection with an international application consist of (i) a basic fee; (ii) the standard designation fee or the individual designation fee, (iii) a publication fee. These fees are payable

In terms of income, the choice between the standard designation fee and the individual designation fee will have budgetary consequences for the Office. The European Community should therefore take advantage of this option and determine its own individual designation fee.

Such determination will have to be made on the basis of a number of elements. Fees will have to be sufficient to cover the costs incurred by the procedures relating to designs the protection of which is requested in the EU. This means not only the costs relating to examination of such designs in OHIM but also other procedures like invalidities and appeals. Such determination has not yet been made as a prior financial analysis is required. To undertake such an analysis, the major conditions of the accession to the Hague Agreement will have to be examined in detail. The Commission also needs to have a better idea as to the possible number of invalidities and appeals international designations could generate and thus the level of work involved for the OHIM.

On the basis of these studies, the Commission will propose an amendment of the Fees Regulation which will contain the level and structure of the fees to be fixed for the designation of the European Community through the Geneva Act.

(iii) Article 17(3)(c) of the Geneva Act obliges each Contracting Party to notify the Director-General of the International Bureau of the maximum duration of protection provided by its law. Article 12 of the Community Design Regulation provides for the maximum duration of protection of 25 years. The European Community shall notify the Director-General accordingly.

Declarations are not relevant or should not be made on other issues as foreseen in the Geneva Act and the Common Rules. Several of these possible declarations are not relevant for the European Community because they concern specific features of national legislation unknown in or not applicable to the Community Design Regulation, or because they are only relevant for examining offices.⁸ Possible declarations on the effect of change of ownership and on exchange of documents do require a further explanation.

- According to Article 16(2) of the Geneva Act, any contracting party may, in a declaration, notify the Director-General of WIPO that a recording of change of ownership in the International Register shall not have the same effect as a recording in its own Register until it has received the statement or documents specified in that declaration. However, in order to keep the international system as simple and efficient as possible, the Community should not submit such a declaration. Thus the international register will have full and direct effect in the EU.
- Article 10(5)(a) of the Geneva Act specifies that the Office of each Contracting Party may notify the International Bureau that it wishes to receive a copy of each

at the time of filing of the international application, with an exception in the case of a request for deferment of publication. See Rule 12 of the Common Regulations.

⁸ These issues concern the deferred publication (Article 11); the unity of design (Article 13); certain views of the design required (Rule 9); special requirement concerning the applicant (Rule 8); security clearance (Rule 13); prohibition of self-designation (Article 14); mandatory contents of an international application (Article 5 and Rule 7); extension of time for notifying refusal and date from which industrial design is protected (Rule 18); common offices of several states (Article 19) and, indirectly, the language regime between the national office and the International Bureau (Rule 6).

international registration in which it has been designated immediately after the registration has been effected, along with any relevant statement, document or specimen accompanying the international registration. The Community should not require such copies since the examination as to the grounds for refusal (public policy, morality and definition of the design) can be carried out on the basis of the publication of the international registrations by the International Bureau. Consequently, there is no need for OHIM to receive complete files from WIPO.

6. Commentary on the Articles

Article 1

In Article 1 the Council is invited to approve the Geneva Act. The text of the Geneva Act is attached to this decision in all the official languages of the European Community.

Article 2

Article 2(1) specifies that following the adoption of this proposal, the President of the Council shall deposit the instrument of accession with the Director-General of WIPO, in accordance with Article 27 of the Geneva Act. In order to avoid any complications on the implementation of the Geneva Act within the European Community, it has been clarified that the instrument of accession may be adopted as from the date on which the Council and the Commission have adopted the necessary implementing measures (Council Regulation amending Regulation (EC) No 6/2002 on Community Designs; Commission Regulation amending the implementing Regulation 2245/2002; Commission Regulation amending the Fees Regulation 2245/2002).

The second paragraph specifies the declarations that shall be made in the instrument of accession.

Article 3

Following accession to the Geneva Act, the European Community will become a member of the Assembly of the Hague Union (Article 20 and 21 of the Geneva Act). This implies, for example, that the European Community may vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Act, and that the European Community shall not participate in the vote if any one of its Member States exercises its rights to vote, and *vice versa*.

The tasks of the Assembly are, amongst others, to deal with all matters concerning the maintenance and development of the Union and the implementation of the Geneva Act; give directions concerning the preparations for conferences of revision and decide the convocation of any such conference; and amend the Common Regulations under the Geneva Act.

In accordance with Article 300 of the Treaty, the European Commission shall represent the European Community in the Assembly of the Hague Union. The European Community delegations may also include representatives of the Office.

In view of the above and in order to avoid unnecessary cumbersome procedures whenever future meetings of the Assembly of the Hague Union take place, Article 3(1) of the proposal provides that the Council authorises the European Commission to represent the European Community at the future meetings of the Assembly of the Hague Union and to negotiate

matters, on behalf of the Community, which fall under the competence which the Assembly has pursuant to Article 21 of the Geneva Act. Article 3(2) specifies that the position of the European Community will be drawn up by the European Commission and the Member States within the competent Council working party or at on-the-spot meetings convened in the course of the work carried out within the framework of WIPO.

7. Supplementary measures to be taken in the context of the accession of the Community to the Geneva Act

The accession of the European Community to the Geneva Act requires several implementing measures at Community level.

First, the Community legislator has to provide rules which adapt the Community design system to the system of international applications under the Geneva Act. It is proposed that the measures giving effect to the accession of the European Community to the Geneva Act be incorporated in the Community Design Regulation by means of an amendment of existing provisions and addition of a new and separate title on “International Registration of Designs”.

Second, there is a need for modification of the implementing rules to give effect to the accession to the Geneva Act. This requires a modification of the Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing the Community Designs Regulation.⁹

Third, there is a need for modification of Commission Regulation (EC) No 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs.¹⁰ The amended Fees Regulation should establish the individual fee system for international registrations, in line with the declaration made in this Decision.

Since the European Community would become bound by the Geneva Act three months after the date on which it has deposited its instrument of accession, the necessary implementing measures should enter into force before the expiry of the three months period.

8. Conclusions

On the basis of the above, the Council is invited to adopt the attached decision approving, on behalf of the European Community, the Geneva Act, authorising the President of the Council to deposit the instrument of accession to the Geneva Act with the Director General of WIPO, and authorising the European Commission to represent the European Community at the meetings of the Assembly of the Hague Union to be held under the auspices of WIPO and to negotiate and approve matters, on behalf of the European Community, which fall under the competence of the Assembly.

⁹ OJ L 341 of 17.12.2002, p. 28.

¹⁰ OJ L 341 of 17.12.2002, p. 54.

Proposal for a

COUNCIL DECISION

approving the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 308, in conjunction with Article 300(2), first subparagraph, second sentence, and Article 300(3), first subparagraph, thereof,

Having regard to the proposal from the Commission¹¹,

Having regard to the opinion of the European Parliament¹²,

Having regard to the opinion of the European Economic and Social Committee¹³,

Whereas:

- (1) Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs¹⁴, which is based on Article 308 of the Treaty, aims to create a market which functions properly and offers conditions which are similar to those obtaining in a national market. In order to create a market of this kind and make it increasingly a single market, that Regulation created the Community design system whereby undertakings can by means of a single procedure obtain Community designs to which uniform protection is given and which produce their effects throughout the entire area of the Community.
- (2) Following preparations initiated and carried out by the World Intellectual Property Organization (WIPO) with the participation of the Member States which are members of the Hague Union, the Member States which are not members of the Hague Union and the European Community, the Diplomatic Conference, convened for that purpose at Geneva, adopted the Geneva Act of the Hague Agreement concerning the international registration of industrial designs (hereinafter referred to as the “Geneva Act”) on 2 July 1999.
- (3) The Geneva Act was adopted in order to introduce certain innovations to the system for the international deposit of industrial designs provided for in the London Act,

¹⁴ OJ C , , p. .

¹⁵ OJ C , , p. .

¹³ OJ C , , p. .

¹⁴ OJ L 3, 5.1.2002, p. 1. Regulation as amended by 2003 Act of Accession.

which had been adopted on 2 June 1934, and the Hague Act, which had been adopted on 28 November 1960.

- (4) The objectives of the Geneva Act are to extend the Hague system of international registration to new members, and to make the system more attractive to applicants. As compared to the London Act and the Hague Act, one of the main innovations is that an intergovernmental organisation which maintains an office authorized to grant protection to designs with effect in the territory of the organisation may become party to the Geneva Act.
- (5) The facility whereby an intergovernmental organisation which has a regional office for the registration of designs may become a party to the Geneva Act was introduced in order to allow, in particular, for the Community to accede to that Act, and hence, to the Hague Union.
- (6) The Geneva Act entered into force on 23 December 2003 and became operational on 1 April 2004. On 1 January 2003, the Office for the Harmonization in the Internal Market (Trade Marks and Designs) admitted applications for registered Community designs, the first date of filing being granted on 1 April 2003.
- (7) The Community design system and the international registration system as established by the Geneva Act are complementary. The Community design system provides for a complete and unified regional designs registration system which covers the whole territory of the Community. The Hague Agreement constitutes a treaty centralising the procedures for obtaining protection of designs in the territory of the designated Contracting Parties.
- (8) The establishment of a link would enable designers to obtain, through one single international application protection for their designs in the Community under the Community design system and in the territories of the Geneva Act inside and outside the Community.
- (9) Moreover, the establishment of a link between the Community design system and the international registration system under the Geneva Act will promote a harmonious development of economic activities, will eliminate distortions of competition, will be cost efficient and will increase the level of integration and functioning of the internal market. Therefore, the Community needs to accede to the Geneva Act in order to make the Community design system more attractive.
- (10) The Commission should be authorised to represent the Community in the Assembly of the Hague Union after the accession of the Community to the Geneva Act.
- (11) This Decision does not affect the right of the Member States to participate in the Assembly of the Hague Union with regard to their national designs.

.HAS DECIDED AS FOLLOWS

Article 1

The Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999 (hereinafter referred to as the Geneva

Act), is hereby approved on behalf of the Community with regard to the matters within its competence.

The text of the Geneva Act is attached to this Decision.

Article 2

1. The President of the Council is hereby authorised to deposit the instrument of accession with the Director-General of the World Intellectual Property Organization as from the date on which the Council and the Commission have adopted the measures which are necessary for the establishment of a link between Community design law and the Geneva Act.

2. The declarations which are attached to this Decision shall be made in the instrument of accession.

Article 3

1. The Commission is hereby authorised to represent the European Community at the meetings of the Hague Union Assembly held under the auspices of the World Intellectual Property Organization.

2. On all matters lying within the competence of the Community with regard to Community design, the Commission shall negotiate in the Hague Union Assembly on behalf of the Community and in accordance with the following arrangements:

(a) the position which the Community may adopt within the Assembly shall be prepared by the relevant Council working party or, if this is not possible, at on-the-spot meetings convened in the course of the work within the framework of the World Intellectual Property Organization;

(b) as regards decisions involving amendments to Regulation (EC) No 6/2002, or to any other act of the Council requiring unanimity, the Community position shall be adopted by the Council acting unanimously on a proposal from the Commission;

(c) as regards other decisions affecting Community design law, the Community position shall be adopted by the Council acting by a qualified majority on a proposal from the Commission.

Done at Brussels,

For the Council
The President

Geneva Act of July 2, 1999

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INTRODUCTORY PROVISIONS

Article 1

Abbreviated Expressions

For the purposes of this Act:

(i) “the Hague Agreement” means the Hague Agreement Concerning the International Deposit of Industrial Designs, henceforth renamed the Hague Agreement Concerning the International Registration of Industrial Designs;

(ii) “this Act” means the Hague Agreement as established by the present Act;

(iii) “Regulations” means the Regulations under this Act;

(iv) “prescribed” means prescribed in the Regulations;

(v) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883, as revised and amended;

(vi) “international registration” means the international registration of an industrial design effected according to this Act;

(vii) “international application” means an application for international registration;

(viii) “International Register” means the official collection of data concerning international registrations maintained by the International Bureau, which data this Act or the Regulations require or permit to be recorded, regardless of the medium in which such data are stored;

(ix) “person” means a natural person or a legal entity;

(x) “applicant” means the person in whose name an international application is filed;

(xi) “holder” means the person in whose name an international registration is recorded in the International Register;

(xii) “intergovernmental organization” means an intergovernmental organization eligible to become party to this Act in accordance with Article 27(1)(ii);

(xiii) “Contracting Party” means any State or intergovernmental organization party to this Act;

(xiv) “applicant’s Contracting Party” means the Contracting Party or one of the Contracting Parties from which the applicant derives its entitlement to file an international application by virtue of satisfying, in relation to that Contracting Party, at least one of the conditions specified in Article 3; where there are two or more Contracting Parties from which the applicant may, under Article 3, derive its entitlement to file an international application,

“applicant’s Contracting Party” means the one which, among those Contracting Parties, is indicated as such in the international application;

(xv) “territory of a Contracting Party” means, where the Contracting Party is a State, the territory of that State and, where the Contracting Party is an intergovernmental organization, the territory in which the constituent treaty of that intergovernmental organization applies;

(xvi) “Office” means the agency entrusted by a Contracting Party with the grant of protection for industrial designs with effect in the territory of that Contracting Party;

(xvii) “Examining Office” means an Office which *ex officio* examines applications filed with it for the protection of industrial designs at least to determine whether the industrial designs satisfy the condition of novelty;

(xviii) “designation” means a request that an international registration have effect in a Contracting Party; it also means the recording, in the International Register, of that request;

(xix) “designated Contracting Party” and “designated Office” means the Contracting Party and the Office of the Contracting Party, respectively, to which a designation applies;

(xx) “1934 Act” means the Act signed at London on June 2, 1934, of the Hague Agreement;

(xxi) “1960 Act” means the Act signed at The Hague on November 28, 1960, of the Hague Agreement;

(xxii) “1961 Additional Act” means the Act signed at Monaco on November 18, 1961, additional to the 1934 Act;

(xxiii) “Complementary Act of 1967” means the Complementary Act signed at Stockholm on July 14, 1967, as amended, of the Hague Agreement;

(xxiv) “Union” means the Hague Union established by the Hague Agreement of November 6, 1925, and maintained by the 1934 and 1960 Acts, the 1961 Additional Act, the Complementary Act of 1967 and this Act;

(xxv) “Assembly” means the Assembly referred to in Article 21(1)(a) or any body replacing that Assembly;

(xxvi) “Organization” means the World Intellectual Property Organization;

(xxvii) “Director General” means the Director General of the Organization;

(xxviii) “International Bureau” means the International Bureau of the Organization;

(xxix) “instrument of ratification” shall be construed as including instruments of acceptance or approval.

Article 2

Applicability of Other Protection Accorded by Laws of Contracting Parties and by Certain International Treaties

(1) [*Laws of Contracting Parties and Certain International Treaties*] The provisions of this Act shall not affect the application of any greater protection which may be accorded by the law of a Contracting Party, nor shall they affect in any way the protection accorded to works of art and works of applied art by international copyright treaties and conventions, or the protection accorded to industrial designs under the Agreement on Trade-Related Aspects of Intellectual Property Rights annexed to the Agreement Establishing the World Trade Organization.

(2) [*Obligation to Comply with the Paris Convention*] Each Contracting Party shall comply with the provisions of the Paris Convention which concern industrial designs.

CHAPTER I

INTERNATIONAL APPLICATION AND INTERNATIONAL REGISTRATION

Article 3

Entitlement to File an International Application

Any person that is a national of a State that is a Contracting Party or of a State member of an intergovernmental organization that is a Contracting Party, or that has a domicile, a habitual residence or a real and effective industrial or commercial establishment in the territory of a Contracting Party, shall be entitled to file an international application.

Article 4

Procedure for Filing the International Application

(1) [*Direct or Indirect Filing*] (a) The international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant's Contracting Party.

(b) Notwithstanding subparagraph (a), any Contracting Party may, in a declaration, notify the Director General that international applications may not be filed through its Office.

(2) [*Transmittal Fee in Case of Indirect Filing*] The Office of any Contracting Party may require that the applicant pay a transmittal fee to it, for its own benefit, in respect of any international application filed through it.

Article 5

Contents of the International Application

(1) [*Mandatory Contents of the International Application*] The international application shall be in the prescribed language or one of the prescribed languages and shall contain or be accompanied by

- (i) a request for international registration under this Act;
- (ii) the prescribed data concerning the applicant;
- (iii) the prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with paragraph (5), the international application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design;
- (iv) an indication of the product or products which constitute the industrial design or in relation to which the industrial design is to be used, as prescribed;
- (v) an indication of the designated Contracting Parties;
- (vi) the prescribed fees;
- (vii) any other prescribed particulars.

(2) [*Additional Mandatory Contents of the International Application*] (a) Any Contracting Party whose Office is an Examining Office and whose law, at the time it becomes party to this Act, requires that an application for the grant of protection to an industrial design contain any of the elements specified in subparagraph (b) in order for that application to be accorded a filing date under that law may, in a declaration, notify the Director General of those elements.

(b) The elements that may be notified pursuant to subparagraph (a) are the following:

- (i) indications concerning the identity of the creator of the industrial design that is the subject of that application;
- (ii) a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application;
- (iii) a claim.

(c) Where the international application contains the designation of a Contracting Party that has made a notification under subparagraph (a), it shall also contain, in the prescribed manner, any element that was the subject of that notification.

(3) [*Other Possible Contents of the International Application*] The international application may contain or be accompanied by such other elements as are specified in the Regulations.

(4) [*Several Industrial Designs in the Same International Application*] Subject to such conditions as may be prescribed, an international application may include two or more industrial designs.

(5) [*Request for Deferred Publication*] The international application may contain a request for deferment of publication.

Article 6

Priority

(1) [*Claiming of Priority*] (a) The international application may contain a declaration claiming, under Article 4 of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization.

(b) The Regulations may provide that the declaration referred to in subparagraph (a) may be made after the filing of the international application. In such case, the Regulations shall prescribe the latest time by which such declaration may be made.

(2) [*International Application Serving as a Basis for Claiming Priority*] The international application shall, as from its filing date and whatever may be its subsequent fate, be equivalent to a regular filing within the meaning of Article 4 of the Paris Convention.

Article 7

Designation Fees

(1) [*Prescribed Designation Fee*] The prescribed fees shall include, subject to paragraph (2), a designation fee for each designated Contracting Party.

(2) [*Individual Designation Fee*] Any Contracting Party whose Office is an Examining Office and any Contracting Party that is an intergovernmental organization may, in a declaration, notify the Director General that, in connection with any international application in which it is designated, and in connection with the renewal of any international registration resulting from such an international application, the prescribed designation fee referred to in paragraph (1) shall be replaced by an individual designation fee, whose amount shall be indicated in the declaration and can be changed in further declarations. The said amount may be fixed by the said Contracting Party for the initial term of protection and for each term of renewal or for the maximum period of protection allowed by the Contracting Party concerned. However, it may not be higher than the equivalent of the amount which the Office of that Contracting Party would be entitled to receive from an applicant for a grant of protection for an equivalent period to the same number of industrial designs, that amount being diminished by the savings resulting from the international procedure.

(3) [*Transfer of Designation Fees*] The designation fees referred to in paragraphs (1) and (2) shall be transferred by the International Bureau to the Contracting Parties in respect of which those fees were paid.

Article 8

Correction of Irregularities

(1) [*Examination of the International Application*] If the International Bureau finds that the international application does not, at the time of its receipt by the International Bureau, fulfill the requirements of this Act and the Regulations, it shall invite the applicant to make the required corrections within the prescribed time limit.

(2) [*Irregularities Not Corrected*] (a) If the applicant does not comply with the invitation within the prescribed time limit, the international application shall, subject to subparagraph (b), be considered abandoned.

(b) In the case of an irregularity which relates to Article 5(2) or to a special requirement notified to the Director General by a Contracting Party in accordance with the Regulations, if the applicant does not comply with the invitation within the prescribed time limit, the international application shall be deemed not to contain the designation of that Contracting Party.

Article 9

Filing Date of the International Application

(1) [*International Application Filed Directly*] Where the international application is filed directly with the International Bureau, the filing date shall, subject to paragraph (3), be the date on which the International Bureau receives the international application.

(2) [*International Application Filed Indirectly*] Where the international application is filed through the Office of the applicant's Contracting Party, the filing date shall be determined as prescribed.

(3) [*International Application with Certain Irregularities*] Where the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau.

Article 10¹⁵

International Registration, Date of the International Registration, Publication and Confidential Copies of the International Registration

(1) [*International Registration*] The International Bureau shall register each industrial design that is the subject of an international application immediately upon receipt by it of the international application or, where corrections are invited under Article 8, immediately upon receipt of the required corrections. The registration shall be effected whether or not publication is deferred under Article 11.

(2) [*Date of the International Registration*] (a) Subject to subparagraph (b), the date of the international registration shall be the filing date of the international application.

(b) Where the international application has, on the date on which it is received by the International Bureau, an irregularity which relates to Article 5(2), the date of the international registration shall be the date on which the correction of such irregularity is received by the International Bureau or the filing date of the international application, whichever is the later.

¹⁵ When adopting Article 10, the Diplomatic Conference understood that nothing in this Article precludes access to the international application or the international registration by the applicant or the holder or a person having the consent of the applicant or the holder.

(3) [*Publication*] (a) The international registration shall be published by the International Bureau. Such publication shall be deemed in all Contracting Parties to be sufficient publicity, and no other publicity may be required of the holder.

(b) The International Bureau shall send a copy of the publication of the international registration to each designated Office.

(4) [*Maintenance of Confidentiality Before Publication*] Subject to paragraph (5) and Article 11(4)(b), the International Bureau shall keep in confidence each international application and each international registration until publication.

(5) [*Confidential Copies*] (a) The International Bureau shall, immediately after registration has been effected, send a copy of the international registration, along with any relevant statement, document or specimen accompanying the international application, to each Office that has notified the International Bureau that it wishes to receive such a copy and has been designated in the international application.

(b) The Office shall, until publication of the international registration by the International Bureau, keep in confidence each international registration of which a copy has been sent to it by the International Bureau and may use the said copy only for the purpose of the examination of the international registration and of applications for the protection of industrial designs filed in or for the Contracting Party for which the Office is competent. In particular, it may not divulge the contents of any such international registration to any person outside the Office other than the holder of that international registration, except for the purposes of an administrative or legal proceeding involving a conflict over entitlement to file the international application on which the international registration is based. In the case of such an administrative or legal proceeding, the contents of the international registration may only be disclosed in confidence to the parties involved in the proceeding who shall be bound to respect the confidentiality of the disclosure.

Article 11

Deferment of Publication

(1) [*Provisions of Laws of Contracting Parties Concerning Deferment of Publication*] (a) Where the law of a Contracting Party provides for the deferment of the publication of an industrial design for a period which is less than the prescribed period, that Contracting Party shall, in a declaration, notify the Director General of the allowable period of deferment.

(b) Where the law of a Contracting Party does not provide for the deferment of the publication of an industrial design, the Contracting Party shall, in a declaration, notify the Director General of that fact.

(2) [*Deferment of Publication*] Where the international application contains a request for deferment of publication, the publication shall take place,

(i) where none of the Contracting Parties designated in the international application has made a declaration under paragraph (1), at the expiry of the prescribed period or,

(ii) where any of the Contracting Parties designated in the international application has made a declaration under paragraph (1)(a), at the expiry of the period notified in such declaration or, where there is more than one such designated Contracting Party, at the expiry of the shortest period notified in their declarations.

(3) [*Treatment of Requests for Deferment Where Deferment Is Not Possible Under Applicable Law*] Where deferment of publication has been requested and any of the Contracting Parties designated in the international application has made a declaration under paragraph (1)(b) that deferment of publication is not possible under its law,

(i) subject to item (ii), the International Bureau shall notify the applicant accordingly; if, within the prescribed period, the applicant does not, by notice in writing to the International Bureau, withdraw the designation of the said Contracting Party, the International Bureau shall disregard the request for deferment of publication;

(ii) where, instead of containing reproductions of the industrial design, the international application was accompanied by specimens of the industrial design, the International Bureau shall disregard the designation of the said Contracting Party and shall notify the applicant accordingly.

(4) [*Request for Earlier Publication or for Special Access to the International Registration*] (a) At any time during the period of deferment applicable under paragraph (2), the holder may request publication of any or all of the industrial designs that are the subject of the international registration, in which case the period of deferment in respect of such industrial design or designs shall be considered to have expired on the date of receipt of such request by the International Bureau.

(b) The holder may also, at any time during the period of deferment applicable under paragraph (2), request the International Bureau to provide a third party specified by the holder with an extract from, or to allow such a party access to, any or all of the industrial designs that are the subject of the international registration.

(5) [*Renunciation and Limitation*] (a) If, at any time during the period of deferment applicable under paragraph (2), the holder renounces the international registration in respect of all the designated Contracting Parties, the industrial design or designs that are the subject of the international registration shall not be published.

(b) If, at any time during the period of deferment applicable under paragraph (2), the holder limits the international registration, in respect of all of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international registration, the other industrial design or designs that are the subject of the international registration shall not be published.

(6) [*Publication and Furnishing of Reproductions*] (a) At the expiration of any period of deferment applicable under the provisions of this Article, the International Bureau shall, subject to the payment of the prescribed fees, publish the international registration. If such fees are not paid as prescribed, the international registration shall be canceled and publication shall not take place.

(b) Where the international application was accompanied by one or more specimens of the industrial design in accordance with Article 5(1)(iii), the holder shall submit the prescribed

number of copies of a reproduction of each industrial design that is the subject of that application to the International Bureau within the prescribed time limit. To the extent that the holder does not do so, the international registration shall be canceled and publication shall not take place.

Article 12

Refusal

(1) [*Right to Refuse*] The Office of any designated Contracting Party may, where the conditions for the grant of protection under the law of that Contracting Party are not met in respect of any or all of the industrial designs that are the subject of an international registration, refuse the effects, in part or in whole, of the international registration in the territory of the said Contracting Party, provided that no Office may refuse the effects, in part or in whole, of any international registration on the ground that requirements relating to the form or contents of the international application that are provided for in this Act or the Regulations or are additional to, or different from, those requirements have not been satisfied under the law of the Contracting Party concerned.

(2) [*Notification of Refusal*] (a) The refusal of the effects of an international registration shall be communicated by the Office to the International Bureau in a notification of refusal within the prescribed period.

(b) Any notification of refusal shall state all the grounds on which the refusal is based.

(3) [*Transmission of Notification of Refusal; Remedies*] (a) The International Bureau shall, without delay, transmit a copy of the notification of refusal to the holder.

(b) The holder shall enjoy the same remedies as if any industrial design that is the subject of the international registration had been the subject of an application for the grant of protection under the law applicable to the Office that communicated the refusal. Such remedies shall at least consist of the possibility of a re-examination or a review of the refusal or an appeal against the refusal.

(4)¹⁶ [*Withdrawal of Refusal*] Any refusal may be withdrawn, in part or in whole, at any time by the Office that communicated it.

Article 13

Special Requirements Concerning Unity of Design

(1) [*Notification of Special Requirements*] Any Contracting Party whose law, at the time it becomes party to this Act, requires that designs that are the subject of the same application

¹⁶ When adopting Article 12(4), Article 14(2)(b) and Rule 18(4), the Diplomatic Conference understood that a withdrawal of refusal by an Office that has communicated a notification of refusal may take the form of a statement to the effect that the Office concerned has decided to accept the effects of the international registration in respect of the industrial designs, or some of the industrial designs, to which the notification of refusal related. It was also understood that an Office may, within the period allowed for communicating a notification of refusal, send a statement to the effect that it has decided to accept the effects of the international registration even where it has not communicated such a notification of refusal.

conform to a requirement of unity of design, unity of production or unity of use, or belong to the same set or composition of items, or that only one independent and distinct design may be claimed in a single application, may, in a declaration, notify the Director General accordingly. However, no such declaration shall affect the right of an applicant to include two or more industrial designs in an international application in accordance with Article 5(4), even if the application designates the Contracting Party that has made the declaration.

(2) [*Effect of Declaration*] Any such declaration shall enable the Office of the Contracting Party that has made it to refuse the effects of the international registration pursuant to Article 12(1) pending compliance with the requirement notified by that Contracting Party.

(3) [*Further Fees Payable on Division of Registration*] Where, following a notification of refusal in accordance with paragraph (2), an international registration is divided before the Office concerned in order to overcome a ground of refusal stated in the notification, that Office shall be entitled to charge a fee in respect of each additional international application that would have been necessary in order to avoid that ground of refusal.

Article 14

Effects of the International Registration

(1) [*Effect as Application Under Applicable Law*] The international registration shall, from the date of the international registration, have at least the same effect in each designated Contracting Party as a regularly-filed application for the grant of protection of the industrial design under the law of that Contracting Party.

(2) [*Effect as Grant of Protection Under Applicable Law*] (a) In each designated Contracting Party the Office of which has not communicated a refusal in accordance with Article 12, the international registration shall have the same effect as a grant of protection for the industrial design under the law of that Contracting Party at the latest from the date of expiration of the period allowed for it to communicate a refusal or, where a Contracting Party has made a corresponding declaration under the Regulations, at the latest at the time specified in that declaration.

(b)¹⁷ Where the Office of a designated Contracting Party has communicated a refusal and has subsequently withdrawn, in part or in whole, that refusal, the international registration shall, to the extent that the refusal is withdrawn, have the same effect in that Contracting Party as a grant of protection for the industrial design under the law of the said Contracting Party at the latest from the date on which the refusal was withdrawn.

(c) The effect given to the international registration under this paragraph shall apply to the industrial design or designs that are the subject of that registration as received from the International Bureau by the designated Office or, where applicable, as amended in the procedure before that Office.

(3) [*Declaration Concerning Effect of Designation of Applicant's Contracting Party*] (a) Any Contracting Party whose Office is an Examining Office may, in a declaration, notify the

¹⁷ See footnote 16.

Director General that, where it is the applicant's Contracting Party, the designation of that Contracting Party in an international registration shall have no effect.

(b) Where a Contracting Party having made the declaration referred to in subparagraph (a) is indicated in an international application both as the applicant's Contracting Party and as a designated Contracting Party, the International Bureau shall disregard the designation of that Contracting Party.

Article 15

Invalidation

(1) [*Requirement of Opportunity of Defense*] Invalidation, by the competent authorities of a designated Contracting Party, of the effects, in part or in whole, in the territory of that Contracting Party, of the international registration may not be pronounced without the holder having, in good time, been afforded the opportunity of defending his rights.

(2) [*Notification of Invalidation*] The Office of the Contracting Party in whose territory the effects of the international registration have been invalidated shall, where it is aware of the invalidation, notify it to the International Bureau.

Article 16

Recording of Changes and Other Matters

Concerning International Registrations

(1) [*Recording of Changes and Other Matters*] The International Bureau shall, as prescribed, record in the International Register

(i) any change in ownership of the international registration, in respect of any or all of the designated Contracting Parties and in respect of any or all of the industrial designs that are the subject of the international registration, provided that the new owner is entitled to file an international application under Article 3,

(ii) any change in the name or address of the holder,

(iii) the appointment of a representative of the applicant or holder and any other relevant fact concerning such representative,

(iv) any renunciation, by the holder, of the international registration, in respect of any or all of the designated Contracting Parties,

(v) any limitation, by the holder, of the international registration, in respect of any or all of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international registration,

(vi) any invalidation, by the competent authorities of a designated Contracting Party, of the effects, in the territory of that Contracting Party, of the international registration in respect of any or all of the industrial designs that are the subject of the international registration,

(vii) any other relevant fact, identified in the Regulations, concerning the rights in any or all of the industrial designs that are the subject of the international registration.

(2) [*Effect of Recording in International Register*] Any recording referred to in items (i), (ii), (iv), (v), (vi) and (vii) of paragraph (1) shall have the same effect as if it had been made in the Register of the Office of each of the Contracting Parties concerned, except that a Contracting Party may, in a declaration, notify the Director General that a recording referred to in item (i) of paragraph (1) shall not have that effect in that Contracting Party until the Office of that Contracting Party has received the statements or documents specified in that declaration.

(3) [*Fees*] Any recording made under paragraph (1) may be subject to the payment of a fee.

(4) [*Publication*] The International Bureau shall publish a notice concerning any recording made under paragraph (1). It shall send a copy of the publication of the notice to the Office of each of the Contracting Parties concerned.

Article 17

Initial Term and Renewal of the International Registration and Duration of Protection

(1) [*Initial Term of the International Registration*] The international registration shall be effected for an initial term of five years counted from the date of the international registration.

(2) [*Renewal of the International Registration*] The international registration may be renewed for additional terms of five years, in accordance with the prescribed procedure and subject to the payment of the prescribed fees.

(3) [*Duration of Protection in Designated Contracting Parties*] (a) Provided that the international registration is renewed, and subject to subparagraph (b), the duration of protection shall, in each of the designated Contracting Parties, be 15 years counted from the date of the international registration.

(b) Where the law of a designated Contracting Party provides for a duration of protection of more than 15 years for an industrial design for which protection has been granted under that law, the duration of protection shall, provided that the international registration is renewed, be the same as that provided for by the law of that Contracting Party.

(c) Each Contracting Party shall, in a declaration, notify the Director General of the maximum duration of protection provided for by its law.

(4) [*Possibility of Limited Renewal*] The renewal of the international registration may be effected for any or all of the designated Contracting Parties and for any or all of the industrial designs that are the subject of the international registration.

(5) [*Recording and Publication of Renewal*] The International Bureau shall record renewals in the International Register and publish a notice to that effect. It shall send a copy of the publication of the notice to the Office of each of the Contracting Parties concerned.

Article 18

Information Concerning Published International Registrations

(1) [*Access to Information*] The International Bureau shall supply to any person applying therefor, upon the payment of the prescribed fee, extracts from the International Register, or information concerning the contents of the International Register, in respect of any published international registration.

(2) [*Exemption from Legalization*] Extracts from the International Register supplied by the International Bureau shall be exempt from any requirement of legalization in each Contracting Party.

CHAPTER II

ADMINISTRATIVE PROVISIONS

Article 19

Common Office of Several States

(1) [*Notification of Common Office*] If several States intending to become party to this Act have effected, or if several States party to this Act agree to effect, the unification of their domestic legislation on industrial designs, they may notify the Director General

(i) that a common Office shall be substituted for the national Office of each of them, and

(ii) that the whole of their respective territories to which the unified legislation applies shall be deemed to be a single Contracting Party for the purposes of the application of Articles 1, 3 to 18 and 31 of this Act.

(2) [*Time at Which Notification Is to Be Made*] The notification referred to in paragraph (1) shall be made,

(i) in the case of States intending to become party to this Act, at the time of the deposit of the instruments referred to in Article 27(2);

(ii) in the case of States party to this Act, at any time after the unification of their domestic legislation has been effected.

(3) [*Date of Entry into Effect of the Notification*] The notification referred to in paragraphs (1) and (2) shall take effect,

(i) in the case of States intending to become party to this Act, at the time such States become bound by this Act;

(ii) in the case of States party to this Act, three months after the date of the communication thereof by the Director General to the other Contracting Parties or at any later date indicated in the notification.

Article 20

Membership of the Hague Union

The Contracting Parties shall be members of the same Union as the States party to the 1934 Act or the 1960 Act.

Article 21

Assembly

(1) [*Composition*] (a) The Contracting Parties shall be members of the same Assembly as the States bound by Article 2 of the Complementary Act of 1967.

(b) Each member of the Assembly shall be represented in the Assembly by one delegate, who may be assisted by alternate delegates, advisors and experts, and each delegate may represent only one Contracting Party.

(c) Members of the Union that are not members of the Assembly shall be admitted to the meetings of the Assembly as observers.

(2) [*Tasks*] (a) The Assembly shall

(i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Act;

(ii) exercise such rights and perform such tasks as are specifically conferred upon it or assigned to it under this Act or the Complementary Act of 1967;

(iii) give directions to the Director General concerning the preparations for conferences of revision and decide the convocation of any such conference;

(iv) amend the Regulations;

(v) review and approve the reports and activities of the Director General concerning the Union, and give the Director General all necessary instructions concerning matters within the competence of the Union;

(vi) determine the program and adopt the biennial budget of the Union, and approve its final accounts;

(vii) adopt the financial regulations of the Union;

(viii) establish such committees and working groups as it deems appropriate to achieve the objectives of the Union;

(ix) subject to paragraph (1)I, determine which States, intergovernmental organizations and non-governmental organizations shall be admitted to its meetings as observers;

(x) take any other appropriate action to further the objectives of the Union and perform any other functions as are appropriate under this Act.

(b) With respect to matters which are also of interest to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) [*Quorum*] (a) One-half of the members of the Assembly which are States and have the right to vote on a given matter shall constitute a quorum for the purposes of the vote on that matter.

(b) Notwithstanding the provisions of subparagraph (a), if, in any session, the number of the members of the Assembly which are States, have the right to vote on a given matter and are represented is less than one-half but equal to or more than one-third of the members of the Assembly which are States and have the right to vote on that matter, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly which are States, have the right to vote on the said matter and were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(4) [*Taking Decisions in the Assembly*] (a) The Assembly shall therefore take its decisions by consensus.

(b) Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such a case,

(i) each Contracting Party that is a State shall have one vote and shall vote only in its own name, and

(ii) any Contracting Party that is an intergovernmental organization may vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Act, and no such intergovernmental organization shall participate in the vote if any one of its Member States exercises its right to vote, and *vice versa*.

(c) On matters concerning only States that are bound by Article 2 of the Complementary Act of 1967, Contracting Parties that are not bound by the said Article shall not have the right to vote, whereas, on matters concerning only Contracting Parties, only the latter shall have the right to vote.

(5) [*Majorities*] (a) Subject to Articles 24(2) and 26(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(b) Abstentions shall not be considered as votes.

(6) [*Sessions*] (a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, either at the request of one-fourth of the members of the Assembly or on the Director General's own initiative.

(c) The agenda of each session shall be prepared by the Director General.

(7) [*Rules of Procedure*] The Assembly shall adopt its own rules of procedure.

Article 22

International Bureau

(1) [*Administrative Tasks*] (a) International registration and related duties, as well as all other administrative tasks concerning the Union, shall be performed by the International Bureau.

(b) In particular, the International Bureau shall prepare the meetings and provide the secretariat of the Assembly and of such committees of experts and working groups as may be established by the Assembly.

(2) [*Director General*] The Director General shall be the chief executive of the Union and shall represent the Union.

(3) [*Meetings Other than Sessions of the Assembly*] The Director General shall convene any committee and working group established by the Assembly and all other meetings dealing with matters of concern to the Union.

(4) [*Role of the International Bureau in the Assembly and Other Meetings*] (a) The Director General and persons designated by the Director General shall participate, without the right to vote, in all meetings of the Assembly, the committees and working groups established by the Assembly, and any other meetings convened by the Director General under the aegis of the Union.

(b) The Director General or a staff member designated by the Director General shall be *ex officio* secretary of the Assembly, and of the committees, working groups and other meetings referred to in subparagraph (a).

(5) [*Conferences*] (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for any revision conferences.

(b) The International Bureau may consult with intergovernmental organizations and international and national non-governmental organizations concerning the said preparations.

(c) The Director General and persons designated by the Director General shall take part, without the right to vote, in the discussions at revision conferences.

(6) [*Other Tasks*] The International Bureau shall carry out any other tasks assigned to it in relation to this Act.

Article 23

Finances

(1) [*Budget*] (a) The Union shall have a budget.

(b) The budget of the Union shall include the income and expenses proper to the Union and its contribution to the budget of expenses common to the Unions administered by the Organization.

(c) Expenses not attributable exclusively to the Union but also to one or more other Unions administered by the Organization shall be considered to be expenses common to the Unions. The share of the Union in such common expenses shall be in proportion to the interest the Union has in them.

(2) [*Coordination with Budgets of Other Unions*] The budget of the Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) [*Sources of Financing of the Budget*] The budget of the Union shall be financed from the following sources:

- (i) fees relating to international registrations;
- (ii) charges due for other services rendered by the International Bureau in relation to the Union;
- (iii) sale of, or royalties on, the publications of the International Bureau concerning the Union;
- (iv) gifts, bequests and subventions;
- (v) rents, interests and other miscellaneous income.

(4) [*Fixing of Fees and Charges; Level of the Budget*] (a) The amounts of the fees referred to in paragraph (3)(i) shall be fixed by the Assembly on the proposal of the Director General. Charges referred to in paragraph 3(ii) shall be established by the Director General and shall be provisionally applied subject to approval by the Assembly at its next session.

(b) The amounts of the fees referred to in paragraph (3)(i) shall be so fixed that the revenues of the Union from fees and other sources shall be at least sufficient to cover all the expenses of the International Bureau concerning the Union.

(c) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(5) [*Working Capital Fund*] The Union shall have a working capital fund which shall be constituted by the excess receipts and, if such excess does not suffice, by a single payment made by each member of the Union. If the fund becomes insufficient, the Assembly shall decide to increase it. The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General.

(6) [*Advances by Host State*] (a) In the headquarters agreement concluded with the State on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such State shall grant advances. The

amount of those advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such State and the Organization.

(b) The State referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(7) [*Auditing of Accounts*] The auditing of the accounts shall be effected by one or more of the States members of the Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

Article 24

Regulations

(1) [*Subject Matter*] The Regulations shall govern the details of the implementation of this Act. They shall, in particular, include provisions concerning

- (i) matters which this Act expressly provides are to be prescribed;
- (ii) further details concerning, or any details useful in the implementation of, the provisions of this Act;
- (iii) any administrative requirements, matters or procedures.

(2) [*Amendment of Certain Provisions of the Regulations*] (a) The Regulations may specify that certain provisions of the Regulations may be amended only by unanimity or only by a four-fifths majority.

(b) In order for the requirement of unanimity or a four-fifths majority no longer to apply in the future to the amendment of a provision of the Regulations, unanimity shall be required.

(c) In order for the requirement of unanimity or a four-fifths majority to apply in the future to the amendment of a provision of the Regulations, a four-fifths majority shall be required.

(3) [*Conflict Between This Act and the Regulations*] In the case of conflict between the provisions of this Act and those of the Regulations, the former shall prevail.

CHAPTER III

REVISION AND AMENDMENT

Article 25

Revision of This Act

(1) [*Revision Conferences*] This Act may be revised by a conference of the Contracting Parties.

(2) [*Revision or Amendment of Certain Articles*] Articles 21, 22, 23 and 26 may be amended either by a revision conference or by the Assembly according to the provisions of Article 26.

Article 26

Amendment of Certain Articles by the Assembly

(1) [*Proposals for Amendment*] (a) Proposals for the amendment by the Assembly of Articles 21, 22, 23 and this Article may be initiated by any Contracting Party or by the Director General.

(b) Such proposals shall be communicated by the Director General to the Contracting Parties at least six months in advance of their consideration by the Assembly.

(2) [*Majorities*] Adoption of any amendment to the Articles referred to in paragraph (1) shall require a three-fourths majority, except that adoption of any amendment to Article 21 or to the present paragraph shall require a four-fifths majority.

(3) [*Entry into Force*] (a) Except where subparagraph (b) applies, any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of those Contracting Parties which, at the time the amendment was adopted, were members of the Assembly and had the right to vote on that amendment.

(b) Any amendment to Article 21(3) or (4) or to this subparagraph shall not enter into force if, within six months of its adoption by the Assembly, any Contracting Party notifies the Director General that it does not accept such amendment.

(c) Any amendment which enters into force in accordance with the provisions of this paragraph shall bind all the States and intergovernmental organizations which are Contracting Parties at the time the amendment enters into force, or which become Contracting Parties at a subsequent date.

CHAPTER IV

FINAL PROVISIONS

Article 27

Becoming Party to This Act

(1) [*Eligibility*] Subject to paragraphs (2) and (3) and Article 28,

(i) any State member of the Organization may sign and become party to this Act;

(ii) any intergovernmental organization which maintains an Office in which protection of industrial designs may be obtained with effect in the territory in which the constituting treaty of the intergovernmental organization applies may sign and become party to this Act, provided that at least one of the member States of the intergovernmental organization is a member of the Organization and provided that such Office is not the subject of a notification under Article 19.

(2) [*Ratification or Accession*] Any State or intergovernmental organization referred to in paragraph (1) may deposit

- (i) an instrument of ratification if it has signed this Act, or
- (ii) an instrument of accession if it has not signed this Act.

(3) [*Effective Date of Deposit*] (a) Subject to subparagraphs (b) to (d), the effective date of the deposit of an instrument of ratification or accession shall be the date on which that instrument is deposited.

(b) The effective date of the deposit of the instrument of ratification or accession of any State in respect of which protection of industrial designs may be obtained only through the Office maintained by an intergovernmental organization of which that State is a member shall be the date on which the instrument of that intergovernmental organization is deposited if that date is later than the date on which the instrument of the said State has been deposited.

(c) The effective date of the deposit of any instrument of ratification or accession containing or accompanied by the notification referred to in Article 19 shall be the date on which the last of the instruments of the States members of the group of States having made the said notification is deposited.

(d) Any instrument of ratification or accession of a State may contain or be accompanied by a declaration making it a condition to its being considered as deposited that the instrument of one other State or one intergovernmental organization, or the instruments of two other States, or the instruments of one other State and one intergovernmental organization, specified by name and eligible to become party to this Act, is or are also deposited. The instrument containing or accompanied by such a declaration shall be considered to have been deposited on the day on which the condition indicated in the declaration is fulfilled. However, when an instrument specified in the declaration itself contains, or is itself accompanied by, a declaration of the said kind, that instrument shall be considered as deposited on the day on which the condition specified in the latter declaration is fulfilled.

(e) Any declaration made under paragraph (d) may be withdrawn, in its entirety or in part, at any time. Any such withdrawal shall become effective on the date on which the notification of withdrawal is received by the Director General.

Article 28

Effective Date of Ratifications and Accessions

(1) [*Instruments to Be Taken into Consideration*] or the purposes of this Article, only instruments of ratification or accession that are deposited by States or intergovernmental organizations referred to in Article 27(1) and that have an effective date according to Article 27(3) shall be taken into consideration.

(2) [*Entry into Force of This Act*] this Act shall enter into force three months after six States have deposited their instruments of ratification or accession, provided that, according to the most recent annual statistics collected by the International Bureau, at least three of those States fulfil at least one of the following conditions:

(i) at least 3,000 applications for the protection of industrial designs have been filed in or for the State concerned, or

(ii) at least 1,000 applications for the protection of industrial designs have been filed in or for the State concerned by residents of States other than that State.

(3) [*Entry into Force of Ratifications and Accessions*] (a) Any State or intergovernmental organization that has deposited its instrument of ratification or accession three months or more before the date of entry into force of this Act shall become bound by this Act on the date of entry into force of this Act.

(b) Any other State or intergovernmental organization shall become bound by this Act three months after the date on which it has deposited its instrument of ratification or accession or at any later date indicated in that instrument.

Article 29

Prohibition of Reservations

No reservations to this Act are permitted.

Article 30

Declarations Made by Contracting Parties

(1) [*Time at Which Declarations May Be Made*] Any declaration under Articles 4(1)(b), 5(2)(a), 7(2), 11(1), 13(1), 14(3), 16(2) or 17(3)(c) may be made

(i) at the time of the deposit of an instrument referred to in Article 27(2), in which case it shall become effective on the date on which the State or intergovernmental organization having made the declaration becomes bound by this Act, or

(ii) after the deposit of an instrument referred to in Article 27(2), in which case it shall become effective three months after the date of its receipt by the Director General or at any later date indicated in the declaration but shall apply only in respect of any international registration whose date of international registration is the same as, or is later than, the effective date of the declaration.

(2) [*Declarations by States Having a Common Office*] Notwithstanding paragraph (1), any declaration referred to in that paragraph that has been made by a State which has, with another State or other States, notified the Director General under Article 19(1) of the substitution of a common Office for their national Offices shall become effective only if that other State or those other States makes or make a corresponding declaration or corresponding declarations.

(3) [*Withdrawal of Declarations*] Any declaration referred to in paragraph (1) may be withdrawn at any time by notification addressed to the Director General. Such withdrawal shall take effect three months after the date on which the Director General has received the notification or at any later date indicated in the notification. In the case of a declaration made under Article 7(2), the withdrawal shall not affect international applications filed prior to the coming into effect of the said withdrawal.

Article 31

Applicability of the 1934 and 1960 Acts

(1) [*Relations Between States Party to Both This Act and the 1934 or 1960 Acts*] This Act alone shall be applicable as regards the mutual relations of States party to both this Act and the 1934 Act or the 1960 Act. However, such States shall, in their mutual relations, apply the 1934 Act or the 1960 Act, as the case may be, to industrial designs deposited at the International Bureau prior to the date on which this Act becomes applicable as regards their mutual relations.

(2) [*Relations Between States Party to Both This Act and the 1934 or 1960 Acts and States Party to the 1934 or 1960 Acts Without Being Party to This Act*] (a) Any State that is party to both this Act and the 1934 Act shall continue to apply the 1934 Act in its relations with States that are party to the 1934 Act without being party to the 1960 Act or this Act.

(b) Any State that is party to both this Act and the 1960 Act shall continue to apply the 1960 Act in its relations with States that are party to the 1960 Act without being party to this Act.

Article 32

Denunciation of This Act

(1) [*Notification*] Any Contracting Party may denounce this Act by notification addressed to the Director General.

(2) [*Effective Date*] Denunciation shall take effect one year after the date on which the Director General has received the notification or at any later date indicated in the notification. It shall not affect the application of this Act to any international application pending and any international registration in force in respect of the denouncing Contracting Party at the time of the coming into effect of the denunciation.

Article 33

Languages of This Act; Signature

(1) [*Original Texts; Official Texts*] (a) This Act shall be signed in a single original in the English, Arabic, Chinese, French, Russian and Spanish languages, all texts being equally authentic.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in such other languages as the Assembly may designate.

(2) [*Time Limit for Signature*] This Act shall remain open for signature at the headquarters of the Organization for one year after its adoption.

Article 34

Depositary

The Director General shall be the depositary of this Act.

DECLARATION

on direct filing

The President of the Council, when depositing this instrument of accession with the Director-General of WIPO, shall attach the following declaration to the instrument of accession:

“The European Community declares that international applications may not be filed through its Office.”

DECLARATION

on the individual fee system

The President of the Council, when depositing this instrument of accession with the Director-General of WIPO, shall attach the following declaration to the instrument of accession:

“The European Community declares that, in connection with each international registration in which it is designed, and in connection with the renewal of any international registration resulting from such an international application, the prescribed designation fee referred to in Article 7 (1) of the Geneva Act shall be replaced by an individual designation fee, whose amount shall be: ”¹⁸

DECLARATION

on the duration of protection in the European Community

The President of the Council, when depositing this instrument of accession with the Director-General of WIPO, shall attach the following declaration to the instrument of accession:

“The European Community declares that the maximum duration of protection provided for by its law is 25 years.”

¹⁸ On the basis of a financial analysis of the impact of the accession of the European Community to the Geneva Act, the European Commission will propose an amendment to Commission Regulation (EC) No 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs (OJ L 341, 17.12.2002, p. 54).

LEGISLATIVE FINANCIAL STATEMENT

Policy area: Internal Market for Goods and Services

Activity: Prepare access of the European Community to the Geneva Act on the international registration of designs

TITLE OF ACTION: PROPOSAL FOR A COUNCIL DECISION APPROVING THE ACCESSION OF THE EUROPEAN COMMUNITY TO THE GENEVA ACT OF THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS, ADOPTED IN GENEVA ON 2 JULY 1999.

1. BUDGET LINE(S) + HEADING(S)

2. OVERALL FIGURES

2.1. Total allocation for action (Part B): € million for commitment

Not applicable

2.2. Period of application:

(start and expiry years)

Start: Date of entry into force

Expiry: Indefinite

2.3. Overall multiannual estimate of expenditure:

(a) Schedule of commitment appropriations/payment appropriations (financial intervention) *(see point 6.1.1)*

None

(b) Technical and administrative assistance and support expenditure *(see point 6.1.2)*

None

(c) Overall financial impact of human resources and other administrative expenditure *(see points 7.2 and 7.3)*

€ million (to three decimal places)

	2006	2007	2008	2009	2010	2011	Total
Commitments/ payments	0.054	0.054	0.054	0.054	0.054	0.054	0.324

TOTAL a+b+c							
Commitments	0.054	0.054	0.054	0.054	0.054	0.054	0.324
Payments	0.054	0.054	0.054	0.054	0.054	0.054	0.324

2.4. Compatibility with financial programming and financial perspective

[X] Proposal is compatible with existing financial programming.

Proposal will entail reprogramming of the relevant heading in the financial perspective.

Proposal may require application of the provisions of the Interinstitutional Agreement.

2.5. Financial impact on revenue:

[X] Proposal has no financial implications (involves technical aspects regarding implementation of a measure)

OR

Proposal has financial impact – the effect on revenue is as follows:

Not applicable

3. BUDGET CHARACTERISTICS

Type of expenditure		New	EFTA contribution	Contributions from applicant countries	Heading in financial perspective
Non-comp	Diff	NO	NO	NO	No 5

4. LEGAL BASIS

Articles 308 EC in conjunction with Article 300(2) EC and Article 300(3) EC

5. DESCRIPTION AND GROUNDS

5.1. Need for Community intervention

5.1.1. Objectives pursued

The objective of the proposal is to establish a link between the Community design system and the international registration system established under the Geneva Act of the Hague System. This link will enable designers to file a single international application at the International Bureau of WIPO designating, amongst other Contracting Parties, the European Community in order to obtain protection under the Community design system.

5.1.2. Measures taken in connection with ex ante evaluation

The European Community already showed its great interest in the Hague System when it decided to take an active part in the international negotiations which led to the Diplomatic Conference held in Geneva in 1999, when the new act was adopted. Organizations representing the potential users of both the Community design system and the international registration system repeatedly expressed their strong interest in establishing a link between the two systems. In 2004 the Commission launched a consultation with interested parties (Member States, business and professional organisations, and private companies) on the possible impact of business on the accession of the EC to the Hague System. An overwhelming majority of the responses, bordering on unanimity, supported the idea that the Community should accede in the near future to the Geneva Act.

5.1.3. Measures taken following ex post evaluation

Not applicable

5.2. Action envisaged and budget intervention arrangements

The proposed Decision authorizes the President of the Council to deposit the instrument of accession to the Geneva Act with the Director-General of WIPO, and includes declarations which shall be made in the instrument of accession. The proposal also authorizes the Commission to represent the Community in the Assembly of the Hague Union after the accession of the Community to the Geneva Act. No financial assistance is involved.

5.3. Methods of implementation

The Commission will need to negotiate in the Hague Union Assembly on behalf of the Community following coordination in the relevant Council working party or at on-the-spot meetings convened in the course of the work within the framework of WIPO.

6. FINANCIAL IMPACT

6.1. Total financial impact on Part B - (over the entire programming period)

Not applicable

6.2. Calculation of costs by measure envisaged in Part B (over the entire programming period)

Not applicable

7. IMPACT ON STAFF AND ADMINISTRATIVE EXPENDITURE

7.1. Impact on human resources

Types of post	Staff to be assigned to management of the action using existing and/or additional resources	Total	Description of tasks deriving from the action
---------------	---	-------	---

		Number of permanent posts	Number of temporary posts		
Officials or temporary staff	A	0,5 A	0	0,5 A	<i>If necessary, a fuller description of the tasks may be annexed.</i> Preparing for and attending meetings of Council and Parliament to negotiate the proposal through the adoption. Preparing for and participating in meetings of the Hague Union and coordinate positions with the Member States.
	B C				
Other human resources		0	0	0	
Total		0,5	0	0,5	

7.2. Overall financial impact of human resources

Type of human resources	Amount (€)	Method of calculation *
Officials	54.000	Annual costs per official: 108.000 €
Temporary staff		
Other human resources (specify budget line)		
Total	54.000	

The amounts are total expenditure for twelve months.

7.3. Other administrative expenditure deriving from the action

Not applicable

I.	Annual total (7.2 + 7.3)	€54.000
II.	Duration of action	2006-2011
III.	Total cost of action (I x II)	€324.000

8. FOLLOW-UP AND EVALUATION

8.1. Follow-up arrangements

Not applicable

8.2. Arrangements and schedule for the planned evaluation

On-going evaluation will be possible through monitoring the volume of international registrations in which the Community design system is designated.

9. ANTI-FRAUD MEASURES

No financial assistance is involved.

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52005PC0689

Title and reference

Proposal for a Council Regulation amending Regulation (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs {SEC(2005)1749}

/* COM/2005/0689 final - CNS 2005/0274 */

Text

ES	CS	DA	DE	ET	EL	EN	FR	IT	LV	LT	HU	MT	NL	PL	PT
html	html	html	html	html	html	html	html	html	html	html	html	html	html	html	html
pdf	pdf	pdf	pdf	pdf	pdf	pdf	pdf	pdf	pdf	pdf	pdf	pdf	pdf	pdf	pdf
doc	doc	doc	doc	doc	doc	doc	doc	doc	doc	doc	doc	doc	doc	doc	doc

Dates

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Classifications

- ▶ **EUROVOC descriptor:**
 - designs and models
 - industrial property
 - European trademark
 - Office for Harmonisation in the Internal Market
 - Community law
 - WIPO
 - EU relations

- ▶ **Directory code:**

17.20.00.00 **Law relating to undertakings / Intellectual property law**

▶ **Subject matter:**

Industrial and commercial property , External relations

Miscellaneous information

▶ **Author:**

European Commission

▶ **Form:**

Proposal for a regulation

▶ **Additional information:**

CNS 2005/0274

Procedure

▶ **Procedure number:**

CNS (2005) 0274

▶ **The European Commission - PreLex**

▶ **European Parliament - OEIL**

Relationship between documents

▶ **Treaty:**

European Community

▶ **Legal basis:**

12002E308

▶ **Earlier related instruments:**

31994R0040 Proposal to amend

32002R0006 Proposal to amend

52005SC1749 Relation

▶ **Select all documents mentioning this document**

Text

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Brussels, 22.12.2005

COM(2005)689 final

2005/0274 (CNS)

Proposal for a

COUNCIL REGULATION

amending Regulation (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs {SEC(2005)1749}

(presented by the Commission)

EXPLANATORY MEMORANDUM

1. Introduction

On 12 December 2001, the Council adopted Regulation (EC) No 6/2002 on Community Designs (hereinafter referred to as “the Community Designs Regulation”).[1]

The Community Designs Regulation establishes the Community design system, which provides for the acquisition of protection for designs with unitary effect for the whole territory of the Community. According to the Regulation, a design may be protected either by an unregistered Community design, if the design is made available to the public in the manner provided for in the Regulation, or by a registered Community design, if registered under the procedure provided for in the Regulation.

The Community Designs Regulation entrusts the Office for the Harmonization in the Internal Market (Trade Marks and Designs), hereinafter referred to as “the Office”, [2] to handle the administration of the Community design. On 1 January 2003, the Office enabled applications for registered Community designs with the first date of filing being granted on 1 April 2003.

On 23 December 2003, the 1999 Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999 (hereinafter referred to as “the Geneva Act”) entered into force. The Geneva Act allows designers to obtain design protection in a number of countries through a single international deposit. Thus, under the Geneva Act, a single international application filed with the International Bureau of the World Intellectual Property Organization (WIPO) replaces a whole series of applications which, otherwise, should have been effected with different national or regional Offices.

One of the main innovations of the Geneva Act is that intergovernmental organizations which have a regional office for the purpose of registering designs with effect in the territory in which the constituting treaty of the organization applies, may accede. This innovation was introduced into the Geneva Act with the specific intention of allowing the Community to adhere to the international registration system after the entry into force of the Community design system.

In order to prepare for the accession of the Community to the Geneva Act, the Commission has elaborated two proposals, which are jointly presented to the Council. The first Commission proposal relates to the accession of the Community to the Geneva Act.[3]

This second proposal contains the measures which are necessary to give effect to the accession of the Community to the Geneva Act.

2. The structure of the Commission proposal

It is proposed that the measures giving effect to the accession of the Community to the Geneva Act be incorporated in the Community Design Regulation through amendment of existing provisions and addition of a new Title XIa on "International Registration of Designs". [4]

In principle, the substantive provisions applying to the international registration designating the Community are the same as the provisions which apply to Community designs.

Thus, international registrations designating the European Community and Community designs shall both be subject to the same law relating to designs (Title II), both shall be objects of property (Title III), may be subject to an application for a declaration of invalidity (Title VI), an appeal shall lie from the decision of the Invalidity Division (Title VII), and the jurisdiction and procedures in legal actions relating to Community designs shall be the same for international registrations designating the European Community as for Community designs (Title IX).

For these reasons, the new Title XIa contains many cross-references to other Articles of the Regulation.

The inclusion of this new title in the Regulation facilitates access to all the provisions which apply to a design protected for the entire territory of the European Community, be it through the registration of the design as a Community design or be it through an international registration of the design designating the European Community under the Geneva Act.

By means of the proposed structure, implementing measures, such as laid down in Commission Regulations (EC) No 2245/2002[5], No 2246/2002[6] and No 216/96[7] will apply in principle *mutatis mutandis*. Where necessary, the Commission will amend them, for instance regarding the examination as to the grounds for refusal referred to in Article 106e of this proposal.

3. The Geneva Act

The Geneva Act forms part of the Hague System, which is based on the Hague Agreement Concerning the International Registration of Industrial Designs. This Agreement is constituted by three different Acts: the London Act of 1934, the Hague Act of 1960 and the Geneva Act of 1999. The three Acts are autonomous and coexist with respect to their substantive provisions. Contracting parties may decide to become party to only one, to two or to all three of the Acts. They automatically become member of the Hague Union which at present has 42 Contracting States, amongst which 12 EU Member States.[8]

The system of international registration of designs arose from a need for simplicity and economy. In effect, it enables design owners originating from a Contracting State to obtain protection of their designs with a minimum of formality and expense.

The international application can be filed in one language (English or French), upon payment of a single set of fees. The applicant has to designate the Contracting States in which protection is sought. An international application is normally sent directly to the International Bureau. Upon receipt, the International Bureau checks that the international application complies with the prescribed formal requirements and then publishes the application – or better, the registration - in the International Designs Bulletin (on WIPO's internet website). Following publication, each national Office must identify the international registrations in which they have been designated, in order to proceed with the substantive examination, if any, provided for by its own legislation.

Any substantive aspect of the protection (including in particular the substantive examination carried out by each Office, the assessment of the conditions of protection and the scope of that protection) is thus entirely a matter of the legislation of each designated Contracting Party.

As a result of that examination, the Office may notify to the International Bureau a refusal of protection for its territory. However, an international registration may not be refused on grounds of non-compliance with formal requirements. Such requirements must be considered as already satisfied, following the examination carried out by the International Bureau.

Once the international application has been accepted it produces the same effect in each of the countries designated as if the design had been deposited there directly. The international registration is therefore equivalent to a national right in terms of its scope of protection and enforcement. At the same time, the international registration facilitates the maintenance of protection: there is a single application to renew and one simple procedure for recording any changes (e.g. in ownership or address).

The adoption of the Geneva Act in 1999 had a twofold objective, namely:

- to make the Hague System more attractive for applicants and to extend the system to new members; to that end, the 1999 Act has introduced a number of features into the Hague system with a view to facilitating the accession to the Hague Union of countries which administer design examination systems (such as USA and Japan);
- to provide for the establishment of a link between the international registration system and regional systems by providing that intergovernmental organizations may become a party to the Act.

The second objective opens the door for the accession of the European Community to the Hague System. The territory of the EU would then be regarded as a single country for the purposes of the Agreement, with the Community design rules as the relevant domestic legislation. The OHIM would become the Office responsible for the substantive examination of international applications in which the Community has been designated.

The Geneva Act system became fully operational on 1 April 2004. On that date, the Geneva Act and the modernised Common Regulations under the Hague Agreement, which simplify the entire proceedings, became effective.

The Community design system and the international registration system as established by the Hague Agreement can be considered as being complementary. The Community design system provides for a complete and unified regional designs registration system which covers the whole territory of the European Union. The Hague Agreement constitutes a treaty centralizing the procedures for obtaining protection of designs in the territory of the designated Contracting Parties.

4. Legal basis

Since the rules giving effect to the accession of the European Community to the Hague Agreement are incorporated in the Regulation through the inclusion of a new and separate Title within that Regulation and an amendment of existing provisions in the Regulation, the legal basis for this proposal must be the same as the legal basis of the Regulation, i.e. Article 308 of the Treaty.

5. The Articles

Article 1, paragraph 1

Article 1, paragraph 1, modifies Article 25(1)(d) by adding “or by a design right registered under the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999 (...) and which has effect in the Community, or by an application for such a right” as a further earlier right available to be invoked as a ground of invalidity. Such an addition is needed to clarify that an international application or registration has the same value as prior design as a design right under national or Community design law.

Article 1, paragraph 2

The provisions giving effect to the accession of the European Community to the Geneva Act shall be incorporated in the Community Designs Regulation through inclusion of the new Title XIa on international registration of designs.

Section 1 – General provisions

Article 106a (Application of provisions)

As a general rule, Article 106a of this proposed amendment of the Regulation provides that in principle Council Regulation (EC) No 6/2002 on Community designs and the regulations implementing that Regulation shall apply to international registrations under the Geneva Act designating the Community.

Moreover, it is clarified that the International Register will take the place of the register maintained by the Office where international registrations designating the European Community are concerned. Any recording in the International Register related to an international registration designating the European Community shall have the same effects as if it had been made in the register maintained by the Office.

The same reasoning applies to publication: all publications in relation to an international application designating the Community shall be carried out by the International Bureau and shall have the same effects as publications by the Office. In addition, the reasoning applies to the language regime of Article 98 of the Regulation.

Section 2 – International Registrations Designating the European Community

Article 106b (Procedure for filing the international designation)

Article 4(1)(a) of the Geneva Act states that the international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant's Contracting party. However, according to Article 4(1)(b) of the Geneva Act, a Contracting Party may notify that international applications may not be filed through its Office.

The Hague system draws most of its advantages from its simplicity and the location of the receiving office seems to be of minor importance for the application of designs. The European Community should therefore exclude the filing of an application through the Office in order to avoid useless duplication of work. Direct filing at WIPO is also to be preferred in order to avoid confusion by applicants between applications for registering Community designs and applications for international registrations. Such confusion would be all the more problematic in case of payment of the basic fee for an international application, which has to be paid in any event directly to the International Bureau and which is payable at the time of filing. If applicants would erroneously pay the fee to OHIM, this Office would have to return the fee. It is significant that at present WIPO does not receive applications filed through national offices even from those Contracting Parties who would permit such a procedure.

For this reason, the Commission proposes that the Community, in its instrument of accession, declares that international applications may not be filed through its Office. Accordingly, Article 106b specifies that international applications pursuant to Article 4(1) of the Geneva Act indicating the Community shall be filed directly at the International Bureau.

Article 106c (Designation fees)

1. The Geneva Act provides in Article 7 that the prescribed fees shall include a standard designation fee that has to be paid for each designated Contracting Party. In addition, any Contracting Party which is an intergovernmental organisation may declare that, for each application and for each renewal of an international registration in which it is designated, the standard designation fee is replaced by an individual designation fee, whose amount shall be indicated in the declaration and can be changed in further declarations. The fixed amount may not be higher than the equivalent of the amount which the Contracting Party would be entitled to receive for a national application and renewal, that amount being diminished by the savings resulting from the international procedure.

2. The Commission proposes that the Community, in its instrument of accession, declares that the prescribed designation fees referred to in Article 7(1) of the Geneva Act in relation to the application and the renewal are replaced by individual designation fees. These fees are payable to the International Bureau and shall be transferred by the International Bureau to OHIM.

3. The Commission will also propose an amendment to Regulation (EC) No 2246/2002 on the fees payable by OHIM, where the amounts of the individual designation fees will be fixed, in accordance with the requirements of the referred Article 7(2) and Rule 28 of the Common Regulations.

Article 106d (Effects of international registration designating the Community)

Paragraph 1

Pursuant to Article 48 of the Community Designs Regulation, an application for a registered Community design shall be registered by the Office as a registered Community design provided the requirements are fulfilled that an application for a registered Community design must satisfy and to the extent that the application has not been refused by virtue of Article 47 of the Community Designs Regulation.

Pursuant to Article 47, an application for a registered Community design shall be refused where the Office notices grounds for non-registrability, i.e. where the design for which protection is sought does not correspond to the definition under Article 3(a), or is contrary to public policy or accepted principles of morality.

The provision of Article 106d of this proposed amendment of the Regulation ensures that the commencement of protection of an international registration designating the Community is subject to the same conditions as apply to a registered Community design, i.e. an international registration designating the European Community shall not have the effect of a Community design registration in the territory of the European Community before the Office could examine the international registration for the grounds of non-registrability.

Paragraph 2

Article 106d(2) of this proposed amendment of the Regulation stipulates that where the Office does not refuse the effects of an international registration designating the European Community in its territory pursuant to Article 12(2) of the Geneva Act, or where any such refusal has been withdrawn, the effects of the international registration shall commence with the date of its registration pursuant to Article 10(2) of the Geneva Act and the effects shall be the same as the effects of a registered Community design.

Paragraph 3

While there is no need to republish the international registrations which are recorded in the International Register in the Register of the Office, Article 106d(3) of this proposed amendment of the Regulation obliges the Office to provide information about the registrations under the Geneva Act designating the European Community. This could for instance be effectively done by creating on the OHIM website a hyperlink to the Hague System. The modalities should be laid down in the Implementing Regulation.

Article 106e (Grounds for refusal)

Paragraph 1

The grounds for refusal set forth in Article 106e of this proposed amendment of the Regulation are identical to the grounds of non-registrability pursuant to Article 47(1), thereby ensuring that an international registration designating the Community is subject to the same examination as applications for registered Community designs.

Paragraph 2

The provision of Article 106e of this proposed amendment of the Regulation guarantees the holder of an international registration designating the Community the right to submit observations or to renounce the international registration in respect to the European Community in compliance with Article 12(3)(b) of the Geneva Act.

The corresponding provision in Article 47(2) stipulates furthermore that an applicant for a registered Community design shall be allowed an amendment of the application. However, this further option cannot be applied to an international registration because the grounds for refusal pursuant to paragraph 1 may only be overcome by an amendment of the design in question whereas the Geneva Act does not provide for an amendment of the design of an international registration after the design has been registered in the International Register.

The regular procedure would be as follows: the Office will examine ex officio as to the grounds for refusal. If the Office, in carrying out this examination, notices a ground for refusal, it will notify the International Bureau, including the grounds on which the refusal is based. Such notification will be issued within the six months from the publication of the international registration (Rule 18(1) of the Common Regulations). The International Bureau, without delay, transmits a copy of the notification of refusal to the holder (Article 12(3) of the Geneva Act). Within the time limit specified by the Office in the notification the holder is allowed to renounce of the international registration in respect of the Community or to submit observations in order to overcome the grounds for refusal. In the course of the examination as to the grounds of refusal the holder and the Office communicate directly with each other. Where the holder overcomes the ground(s) for refusal, the Office shall withdraw the refusal and notify the International Bureau accordingly.

Paragraph 3

Article 106e(3) specifies that the conditions for the examination as to the grounds for refusal shall be laid down in the implementing regulation.

Article 106f (Invalidation of the effects of an international registration)

Paragraph 1

Article 106f of this proposed amendment of the Regulation implements Article 15(1) of the Geneva Act allowing for a declaration of

invalidity of the effects of an international registration in the territory of the European Community.

This provision ensures that a declaration of invalidity of the effects of an international registration in the territory of the European Community shall be subject to the same provisions as apply to an application for a declaration of invalidity of a registered Community design. Third parties may pursue a declaration of invalidity of the effects of an international registration in the Community either by means of an application submitted to the Office according to Article 52 or by a counterclaim before a Community design court according to Article 81(d).

In case of seeking invalidation of the effects before the Office, Titles VI and VII apply. In particular, the holder may submit observations to the application for a declaration of invalidity, pursuant to Article 31 of the Implementing Regulation. The final decision of the Invalidity Division is subject to appeal (Article 55(1) of the Community Designs Regulation).

In this respect, Article 15(1) of the Geneva Act is observed. This provision requires that invalidation of the effects of the international registration may not be pronounced without the holder having, in good time, been afforded the opportunity of defending his rights.

Paragraph 2

Article 15(2) of the Geneva Act requires the Office of the Contracting Party in whose territory the effects of the international registration have been invalidated, where it is aware of the invalidation, to notify it to the International Bureau. This obligation has been copied in Article 106f(2). It is obvious that the Office will be aware of the invalidity if this is the result of an invalidity procedure at the Office, or if a Community design court informs the Office on a declaration of invalidity, in accordance with Article 86 (4) of the Community Designs Regulation.

Article 2

Article 97 of the Community Designs Regulation specifies that unless otherwise provided in the title on supplementary provisions concerning the Office, Title XII of the Regulation on the Community trade mark shall apply to the Office with regard to its tasks under this Regulation. Title XII of the Regulation on the Community trade mark includes Article 134(3) on the Office's revenues. This provision has been modified in light of the accession to the Madrid Protocol which created a new source of revenues, being the "total fees payable under the Madrid Protocol referred to in Article 140 of this Regulation for an international registration designating the European Communities...".

A similar modification of the Community trade mark Regulation is needed following the accession of the EC to the Geneva Act. The fees payable under the Geneva Act should be included as a new source of revenues for the Office.

Article 3

The Community shall become bound by the Geneva Act three months after that date on which it has deposited its instrument of accession with the Director-General of the International Bureau.

In this respect, it should be recalled that Article 2 of the Commission's proposal for a Council Decision approving the accession of the European Community to the Geneva Act to which reference was made earlier provides that following the adoption of that decision by the Council, the Council may deposit that instrument of accession with the Director-General of the International Bureau from the date on which the Council adopted the necessary measures to give effect to the accession of the Community to the Geneva Act.

2005/0274 (CNS)

Proposal for a

COUNCIL REGULATION

amending Regulation (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 308 thereof,

Having regard to the proposal from the Commission[9],

Having regard to the opinion of the European Parliament[10],

Having regard to the opinion of the European Economic and Social Committee[11],

Whereas:

(1) Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs[12] created the Community design system whereby undertakings can by means of one procedural system obtain Community designs to which uniform protection is given and which produce their effects throughout the entire area of the Community.

(2) Following preparations initiated and carried out by the World Intellectual Property Organization (WIPO) with the participation of the Member States which are members of the Hague Union, the Member States which are not members of the Hague Union and the European Community, the Diplomatic Conference, convened for that purpose at Geneva, adopted the Geneva Act of the Hague Agreement concerning the international registration of industrial designs (hereinafter referred to as the "Geneva Act") on 2 July 1999.

(3) The Council, by Council Decision [...] approved the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs[13] and authorised the President of the Council to deposit the instrument of accession with the Director-General of WIPO as from the date on which the Council has adopted the measures which are necessary to give effect to the accession of the Community to the Geneva Act. This Regulation contains those measures.

(4) The appropriate measures should be incorporated in Regulation (EC) No 6/2002 through the inclusion of a new title on "International registration of designs".

(5) The rules and procedures relating to international registrations designating the Community should, in principle, be the same as the rules and procedures which apply to Community designs applications. According to this principle, an international registration designating the Community should be subject to the examination as to the grounds for non-registrability before it takes the same effect as a registered Community design. Likewise, an international registration having the same effect as a registered Community design should be subject to the same rules on invalidation as a registered Community design.

(6) Regulation (EC) No 2002/6 should therefore be amended accordingly.

(7) The accession of the Community to the Geneva Act will create a new source of revenues for the Office for the Harmonization in the Internal Market (Trade Marks and Designs). Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark[14]

should therefore be amended accordingly.

HAS ADOPTED THIS REGULATION:

Article 1

Regulation (EC) No 6/2002 is amended as follows:

1. Article 25(1)(d) is replaced by the following:

“(d) if the Community design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date

i) by a registered Community design or an application for such a design, or

ii) by a registered design right of a Member State, or by an application for such a right, or

iii) by a design right registered under the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999, hereinafter referred to as “the Geneva Act”, which was approved by Council Decision [...] [15] and which has effect in the Community, or by an application for such a right;”

2. The following title is inserted after title XI:

“TITLE XIa:

INTERNATIONAL REGISTRATION OF DESIGNS

SECTION 1

GENERAL PROVISIONS

Article 106a

Application of provisions

1. Unless otherwise specified in this title, this Regulation and any Regulations implementing this Regulation adopted pursuant to Article 109 shall apply, *mutatis mutandis*, to registrations in the international register maintained by the International Bureau of the World Intellectual Property Organization (hereinafter referred to as “international registration” and “the International Bureau”) designating the Community, under the Geneva Act.

2. Any recording of an international registration designating the Community in the International Register shall have the same effect as if it had been made in the register of Community designs of the Office, and any publication of an international registration designating the Community in the Bulletin of the International Bureau shall have the same effect as if it had been published in the Community Designs Bulletin.

SECTION 2

INTERNATIONAL REGISTRATIONS DESIGNATING THE COMMUNITY

Article 106b

Procedure for filing the international application

International applications pursuant to Article 4(1) of the Geneva Act shall be filed directly at the International Bureau.

Article 106c

Designation fees

The prescribed designation fees referred to in Article 7(1) of the Geneva Act are replaced by an individual designation fee.

Article 106d

Effects of international registration designating the European Community

1. An international registration designating the Community shall, from the date of its registration, have the same effect as an application for a registered Community design.
2. If no refusal has been notified or if any such refusal has been withdrawn, the international registration of a design designating the Community shall, from the date referred to in paragraph 1, have the same effect as the registration of a design as a registered Community design.
3. The Office shall provide information on international registrations referred to in paragraph 2, in accordance with the conditions laid down in the Implementing Regulation.

Article 106e

Grounds for refusal

1. The Office shall communicate to the International Bureau a notification of refusal not later than six months from the date of publication of the international registration, if in carrying out an examination of an international registration, the Office notices that the design for which protection is sought does not correspond to the definition under Article 3(a), or is contrary to public policy or to accepted principles of morality.

The notification shall state the grounds on which the refusal is based.

2. The refusal of the effects of an international registration in the Community shall not become final before the holder has been allowed the opportunity of renouncing the international registration in respect of the Community or of submitting observations.
3. The conditions for the examination as to the grounds for refusal shall be laid down in the Implementing Regulation.

Article 106f

Invalidation of the effects of an international registration

1. The effects of an international registration in the Community may be declared invalid partly or in whole in accordance with the procedure in Titles VI and VII or by a Community design court on the basis of a counterclaim in infringement proceedings.
2. If the Office is aware of the invalidation, it shall notify it to the International Bureau."

Article 2

Article 134(3) of Regulation (EC) No 40/94 is replaced by the following:

"3. Revenue shall comprise, without prejudice to other types of income, total fees payable under the fees regulations, total fees payable under the Madrid Protocol referred to in Article 140 of this Regulation for an international registration designating the European Communities and other payments made to Contracting Parties to the Madrid Protocol, total fees payable under the Geneva Act referred to in Article 106c of Regulation (EC) No 2002/6 for an international registration designating the European Community and other payments made to Contracting Parties to the Geneva Act, and, to the extent necessary, a subsidy entered against a specific heading of the general budget of the European Communities, Commission section".

Article 3

This Regulation shall enter into force on the date on which the Geneva Act enters into force with respect to the European Community.

The date of entry into force of this Regulation shall be published in the Official Journal of the European Union .

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels,

For the Council

The President

LEGISLATIVE FINANCIAL STATEMENT

Policy area: Internal Market for Goods and Services Activity: Prepare measures which are necessary to give effect to the access of the European Community to the Geneva Act on the international registration of designs |

TITLE OF ACTION: PROPOSAL FOR A COUNCIL REGULATION AMENDING REGULATION (EC) NO 6/2002 AND (EC) NO 40/94 TO GIVE EFFECT TO THE ACCESSION OF THE EUROPEAN COMMUNITY TO THE GENEVA ACT OF THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS |

1. BUDGET LINE(S) + HEADING(S)

2. OVERALL FIGURES

2.1. Total allocation for action (Part B): € million for commitment

Not applicable

2.2. Period of application:

(start and expiry years)

Start: Date of entry into force

Expiry: Indefinite

2.3. Overall multiannual estimate of expenditure:

(a) Schedule of commitment appropriations/payment appropriations (financial intervention) (see point 6.1.1)

None

(b) Technical and administrative assistance and support expenditure (see point 6.1.2)

None

(c) Overall financial impact of human resources and other administrative expenditure (see points 7.2 and 7.3)

€ million (to three decimal places)

2006 | 2007 | 2008 | 2009 | 2010 | 2011 | Total |

Commitments/ payments | 0.054 | 0.054 | 0.054 | 0.054 | 0.054 | 0.054 | 0.324 |

TOTAL a+b+c |

Commitments | 0.054 | 0.054 | 0.054 | 0.054 | 0.054 | 0.054 | 0.324 |

Payments | 0.054 | 0.054 | 0.054 | 0.054 | 0.054 | 0.054 | 0.324 |

2.4. Compatibility with financial programming and financial perspective

Proposal is compatible with existing financial programming.

Proposal will entail reprogramming of the relevant heading in the financial perspective.

Proposal may require application of the provisions of the Interinstitutional Agreement.

2.5. Financial impact on revenue:

Proposal has no financial implications (involves technical aspects regarding implementation of a measure)

OR

Proposal has financial impact – the effect on revenue is as follows:

Not applicable

3. BUDGET CHARACTERISTICS

Type of expenditure | New | EFTA contribution | Contributions from applicant countries | Heading in financial perspective |

Non-comp | Diff | NO | NO | NO | No 5 |

4. LEGAL BASIS

Articles 308 EC

5. DESCRIPTION AND GROUNDS

5.1. Need for Community intervention

5.1.1. Objectives pursued

The proposal contains the measures which are necessary to give effect to the accession of the European Community to the Geneva Act. The appropriate measures should mainly be incorporated in Regulation (EC) No 6/2002 through the inclusion of a new title on "International registration of designs". The accession of the Community to the Geneva Act will create a new source of revenues for the Office for the Harmonization in the Internal Market (Trade Marks and Designs) - OHIM, and Regulation (EC) No 40/94 should therefore be amended accordingly.

5.1.2. Measures taken in connection with ex ante evaluation

The European Community already showed its great interest in the Hague System when it decided to take an active part in the international negotiations which led to the Diplomatic Conference held in Geneva in 1999, when the new act was adopted. Organizations representing the potential users of both the Community design system and the international registration system repeatedly expressed their strong interest in establishing a link between the two systems. In 2004 the Commission launched a consultation with interested parties (Member States, business and professional organisations, and private companies) on the possible impact on business of the accession of the EC to the Hague System. An overwhelming majority of the responses, bordering on unanimity, supported the idea that the Community should accede in the near future to the Geneva Act.

5.1.3. Measures taken following ex post evaluation

Not applicable

5.2. Action envisaged and budget intervention arrangements

The rules and procedures relating to international registrations designating the Community should, in principle, be the same as the rules and procedures which apply to Community designs applications. According to this principle, an international registration designating the Community should be subject to the examination as to the grounds for non-registrability before it takes the same effect as a registered Community design. Likewise, an international registration having the same effect as a registered Community design should be subject to the same rules on invalidation as a registered Community design. No financial assistance is involved.

5.3. Methods of implementation

OHIM will need to adapt its internal procedures and working methods in order to deal with the international applications at the International Bureau of WIPO in which the European Community is designated in order to obtain protection under the Community design

system. The Commission will need to negotiate in the Hague Union Assembly on behalf of the Community following coordination in the relevant Council working party or at on-the-spot meetings convened in the course of the work within the framework of WIPO.

6. FINANCIAL IMPACT

6.1. Total financial impact on Part B - (over the entire programming period)

Not applicable

6.2. Calculation of costs by measure envisaged in Part B (over the entire programming period)

Not applicable

7. IMPACT ON STAFF AND ADMINISTRATIVE EXPENDITURE

7.1. Impact on human resources

Types of post | Staff to be assigned to management of the action using existing and/or additional resources | Total | Description of tasks deriving from the action |

Number of permanent posts | Number of temporary posts |

Officials or temporary staff | A B C | 0,5 A | 0 | 0,5 A | If necessary, a fuller description of the tasks may be annexed. Coordination with OHIM. Preparing for and attending meetings of Council and Parliament to negotiate the proposal through the adoption. Preparing for and participating in meetings of the Hague Union and coordinate positions with the Member States. |

Other human resources | 0 | 0 | 0 |

Total | 0,5 | 0 | 0,5 |

7.2. Overall financial impact of human resources

Type of human resources | Amount (€) | Method of calculation * |

Officials Temporary staff | 54.000 | Annual costs per official: 108.00 € |

Other human resources (specify budget line) |

Total | 54.000 |

The amounts are total expenditure for twelve months.

7.3. Other administrative expenditure deriving from the action

Not applicable

The amounts are total expenditure for twelve months.

1 Specify the type of committee and the group to which it belongs.

I. Annual total (7.2 + 7.3) II. Duration of action III. Total cost of action (I x II) | €54.000 2006-2011 €324.000 |

8. FOLLOW-UP AND EVALUATION

8.1. Follow-up arrangements

Not applicable

8.2. Arrangements and schedule for the planned evaluation

On-going evaluation will be possible through monitoring the volume of international registrations in which the Community design system is designated.

9. ANTI-FRAUD MEASURES

No financial assistance is involved.

[1] OJ L 3, 5.1.2002, p.1.

[2] The OHIM is established by Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ L 11, 14.1.1994, p. 1.

[3] See COM (2005)

[4] A similar structure was followed at the amendment of the Community trademark Regulation in order to give effect to the accession of the European Community to the Madrid Protocol (Council Regulation (EC) No 1992/2003 of 2[5].8BLO[_fg...†‡^%o' • – μ ¶] Í Ü u7 October 2003 amending Regulation (EC) No 40/94, OJ L 296, 14.11.2003, p.1).

[6] Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs, OJ L 341, 17.12.2002, p. 28.

[7] Commission Regulation (EC) No 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs, OJ L 341, 17.12.2002, p. 54.

[8] Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs), OJ L 28, 6.2.1996, p. 11.

[9] Belgium, Estonia, France, Germany, Greece, Hungary, Italy, Latvia, Luxembourg, Netherlands, Slovenia, Spain. Five EU Member States – out of 18 countries in total - have become party to the Geneva Act (Estonia, Hungary, Latvia, Slovenia and Spain). Updates will be published on the WIPO website: www.wipo.int.

9 OJ C , , p. .

10 OJ C , , p. .

11 OJ C , , p. .

12 OJ L 3, 5.1.2002, p. 1. Regulation as amended by 2003 Act of Accession.

13 OJ L , , p. .

[10] OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Regulation (EC) 422/2004 (OJ L 70, 9.3.2004, p. 1).

[11] OJ L , , p. .

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COMMISSION OF THE EUROPEAN COMMUNITIES

Brussels, 22.12.2005
SEC(2005)1749

COMMISSION STAFF WORKING DOCUMENT

**PROPOSAL FOR A COUNCIL DECISION APPROVING THE ACCESSION OF THE
COMMUNITY TO THE GENEVA ACT OF THE HAGUE AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF DESIGNS,
ADOPTED IN GENEVA ON 2 JULY 1999**

**PROPOSAL FOR A COUNCIL REGULATION AMENDING REGULATION (EC)
NO 6/2002 AND (EC) NO 40/94 TO GIVE EFFECT TO THE ACCESSION OF THE
EUROPEAN COMMUNITY TO THE GENEVA ACT OF THE HAGUE
AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF
INDUSTRIAL DESIGNS**

IMPACT ASSESSMENT

{COM(2005)689 final}

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 - 5.4 Financial implications**
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ANNEXES

- 1. Analyses of the results of the Commission's consultation on the impact of the accession of the European Community to the Hague Agreement on International Designs (Summer 2004)**
- 2. Questionnaire on the impact of the accession of the European Community to the Hague Agreement on International Designs (January 2004)**

1. Background

1.1 Registration of designs

A design is the outward appearance of a product or part of it which results from the lines, contours, colour, shape, texture, materials and its ornamentation. The design or shape of a product can be synonymous with the branding and imaging of a company and is an asset with a monetary value. Protection for designs therefore encourages innovation and development of new products and investments in the production process.

Exclusive design rights enable a company to use the design in commerce, to take legal action against infringers and to claim damages. In the EU, designers wishing to exploit their design right have several options in terms of the territorial scope of protection.

First, designers can choose to apply for the registration of a national design, which would give them protection in the territory of the country concerned. However, identical designs may still be protected differently in the Member States, despite the fact that Directive 98/71/EC¹ contributes to remedying this situation by harmonising national design laws.

Second, designers can decide to make use of the system under Council Regulation (EC) No 6/2002² and apply for the registration of a Community design. The Community design provides for the acquisition of protection for designs with unitary effect for the whole territory of the European Community. The Office for the Harmonization in the Internal Market (OHIM) is responsible for administering the registration of Community designs.

A third option would be to lodge an application with the International Bureau of the World Intellectual Property Organization (WIPO) under the Hague System for the International Registration of Industrial Designs. Such application allows the obtaining of design protection in a selected number of countries through a single “international” deposit. Thus, under the Hague arrangement, a single international application filed with the International Bureau replaces a whole series of applications which, otherwise, should have been effected with different national (or regional) Offices.

1.2 The international registration system and its relationship with the Community design system

The present impact assessment covers options related to the establishment of a “link” between the international and the Community registration systems.

The Hague System is based on the Hague Agreement Concerning the International Registration of Industrial Designs. This Agreement is constituted by three different Acts: the London Act of 1934, the Hague Act of 1960 and the Geneva Act of 1999. The three Acts are autonomous and coexist with respect to their substantive provisions. Contracting parties may decide to become party to only one, to two or to all three of the Acts. They automatically

¹ Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, OJ L 289, 28.10.1998, p. 28.

² Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, OJ L 3, 5.1.2002, p. 3.

become member of the Hague Union which at present has 42 Contracting States, amongst which 12 EU Member States.³

The system of international registration of designs arose from a need for simplicity and economy. In effect, it enables design owners originating from a Contracting State to obtain protection of their designs with a minimum of formality and expense.

The international applications can be filed in one language (English or French), upon payment of a single set of fees. The applicant has to designate the Contracting States in which protection is sought. An international application is normally sent directly to the International Bureau. Upon receipt, the International Bureau checks that the international application complies with the prescribed formal requirements and then publishes the application – or better, the registration - in the *International Designs Bulletin* (on WIPO's internet website). Following publication, each national Office must identify the international registrations in which they have been designated, in order to proceed with the substantive examination, if any, provided for by its own legislation.

Any substantive aspect of the protection (including in particular the substantive examination carried out by each Office, the assessment of the conditions of protection and the scope of that protection) is thus entirely a matter of the legislation of each designated Contracting Party.

As a result of that examination, the Office may notify to the International Bureau a refusal of protection for its territory. However, an international registration may not be refused on grounds of non-compliance with formal requirements. Such requirements must be considered as already satisfied, following the examination carried out by the International Bureau.

Once the international registration has been accepted, it produces the same effect in each of the countries designated as if the design had been deposited there directly. The international registration is therefore equivalent to a national right in terms of its scope of protection and enforcement. At the same time, the international registration facilitates the maintenance of protection: there is a single deposit to renew and one simple procedure for recording any changes (e.g. in ownership or address).

The adoption of the Geneva Act in 1999 had a twofold objective, namely:

- to make the Hague System more attractive for applicants and to extend the system to new members; to that end, the 1999 Act has introduced a number of features into the Hague system with a view to facilitating the accession to the Hague Union of countries which administer design examination systems (such as USA and Japan);
- to provide for the establishment of a *link* between the international registration system and regional systems by providing that intergovernmental organizations may become a party to the Act.

The second objective opens the door for the accession of the Community to the Hague System. The territory of the EU would then be regarded as a single country for the purposes

³ Belgium, Estonia, France, Germany, Greece, Hungary, Italy, Latvia, Luxembourg, Netherlands, Slovenia, Spain. Five Member States – out of 18 countries in total - have become party to the Geneva Act (Estonia, Hungary, Latvia, Slovenia and Spain). Updates will be published on the WIPO website: www.wipo.int.

of the Geneva Act, with the Community design rules as the relevant domestic legislation. The OHIM would become the Office responsible for the substantive examination of international applications in which the Community has been designated.

The European Community already showed its great interest in the Hague System when it decided to take an active part in the international negotiations which led to the Diplomatic Conference held in Geneva in 1999, when the new act was adopted. In this context, it should be noted that, during the seven Committees of experts which took place for the adoption of a new Act of the Hague Agreement, as well as during the Diplomatic Conference having adopted the 1999 Act and during the 2003 process for adoption of the common regulations, organizations representing the potential users of both the Community designs system and the international registration system repeatedly expressed their strong interest in establishing a link between the two systems.

The Community design system and the international registration system as established by the Hague Agreement can be considered as being complementary. The Community design system provides for a complete and unified regional designs registration system which covers the whole territory of the European Union. The Hague Agreement constitutes a treaty centralizing the procedures for obtaining protection of designs in the territory of the designated Contracting Parties.

2. Problem identification

Unlike the Community design system, which does not impose conditions related to the origin of the applicant, the Hague Agreement contains an important restriction based on nationality or residence. The right to file for an international registration is reserved for nationals and residents of a state that is party to the Hague Agreement. Companies can only apply for international registration if they are established in a Contracting State.⁴

The fact that only nationals of contracting states can apply for international registration creates a distortion of competition in the internal market. The nationals, residents and companies of the 12 EU Member States that have become party to the Hague Agreement can apply for a single application and receive protection under the design laws of, potentially, all the other Contracting Parties including the other 11 EU Member States which have adhered to the Hague system. Designers from the 13 EU Member States that have not adhered to the Hague system do not have that option and cannot benefit from the system of international registration.

This distortion would become much less if a “link” between the Community design system and the Hague Agreement was established.

Participation of the Community in the Geneva Act would create the opportunity for all EU citizens and companies to opt for the international system. The differentiation between designers from EU Contracting States and EU non-Contracting States would be eliminated.

⁴ According to Article 3 of the Geneva Act, “any person that is a national of a state that is a Contracting Party or of a State member of an international organization that is a Contracting Party, or that has a domicile, a habitual residence of a real and effective or commercial establishment in the territory of a Contracting Party, shall be entitled to file an international application”.

In addition, it would enable industry in the European Union to obtain through one single international application protection for their designs in the EU under the Community design system and in the territories of Contracting Parties to the 1999 Geneva Act in- and outside the European Union. At present, even design owners from countries that have adhered to the Hague Agreement need to make two applications: one for the international registration and one for the Community design registration. The advantage of the “link” is that designers could apply for international protection of their designs, including protection under the Community design mechanism, through the filing of one international application under the Hague Agreement.

3. Objective of the proposals

The main objective is therefore to promote a harmonious development of economic activities and to eliminate distortions of competition by creating equal opportunities for the designers throughout the EU, providing them all with access to the benefits of the international registration of designs. Essential to achieve the objective is the creation of a “link” between the Community design system and the WIPO system on international registrations of designs. Besides, the link between the Community design system and the Geneva Act would mean that designers in the EU and innovators in other contracting parties may make use of the Geneva Act to obtain Community designs at the same time as obtaining design protection in individual States.

4. Policy options

The first option is that the EC adheres to the Geneva Act. The EC would then also become a member of the Hague Union. Within this option, a further reflection could be made on the timing of the accession: now or in the future.

The second option is not to adhere to the Geneva Act and to continue without a link between the EC system and the Hague arrangement. Applicants from the EU and from other Contracting Parties would not benefit from both the advantages of the international registration and of the uniform protection of the Community Design system in one single application.

A third option is that the EC should encourage or oblige all Member States to become a party to the Hague System. This route would have as an advantage that the national design systems of the Member States become subject to international registrations. While this would to a certain extent contribute to the described objective of creating a level playing field, it would not make optimal use of the EC system. There would still be no link between the (increasingly important) Community design system and the Hague system, which is one of the main aims of the Geneva Act. This option will therefore not be considered further.

An accession of the EC to the Geneva Act would in any case be in line with the principles of subsidiarity and proportionality. In terms of subsidiarity, the objective of the proposed action cannot be efficiently achieved by the Member States by reason of the effect of the link between the Community Design system and the international registration system, which can only be achieved at Community level. In terms of proportionality, the proposals do not go beyond what is necessary to achieve the objectives.

5. Assessment

5.1 The expected benefits of EC accession to the Geneva Act

In January 2004, the European Commission launched a consultation with interested parties on the possible impact on business of the accession of the EC to the Hague system. A questionnaire was prepared focusing on the impact of the introduction of a link between the Community design and the international registration system, the effects in terms of reduction of costs, the incentive to encourage the marketing of EU products in foreign countries, a quantitative estimate of the potential use of the system and any possible concerns as to the fact that foreign countries could use the system to designate the EU.

A total of 53 responses to the questionnaire were received from (16) Member States, business and professional organisations, and private companies. The questionnaire and an exhaustive analysis of the results of the consultation are attached to this document as annexes.

On the basis of the analysis, the principle arguments in favour of the accession can be summarized as follows:

- the international registration of designs would result in simplified registration procedures and IP portfolio management;
- there will be a saving of costs: the applicant does not need to provide translations of the documents nor to keep watch on the different deadlines for renewal of a great number of national applications, which differ from one State to another; he will avoid paying a series of national fees and fees to agents in different countries;⁵
- simplified procedures would facilitate access to protection in third countries, which would encourage EC companies to trade with these countries in the knowledge that their designs are protected;
- the accession of the European Community would offer the same opportunities to all EU citizens irrespective of whether they are nationals of a Member State that is or is not a contracting party to the Hague Agreement;
- all this would have a positive impact on research, development and innovation activities;
- the accession of the European Community would encourage other important commercial partners to adhere, such as USA, Japan, Korea and China.

The establishment of the link between the two systems is therefore bound to contribute to the development of conditions favourable to trade between the European Community and the third countries concerned.

⁵ According to a study carried out for the OHIM in 2002, the complexity of the bureaucratic process of registration in several countries is considered to be the largest barrier to design registration for companies. See “Prospective study about the design registration demand at a European Union level – Executive summary”, May 2002, p. 24 (study available at <http://oami.eu.int/en/design/pdf/3830000.pdf>).

5.2 The potential disadvantages of EC accession to the Geneva Act

It is difficult to conceive that the accession of the EC to the Geneva Act would have serious negative effects on the designers or other stakeholders, whether they are established within or outside the European Union. The great majority of the respondents to the questionnaire prepared by the European Commission is of the opinion that the accession would not have any negative effect. Nonetheless, some respondents observed *potential* disadvantages, even though they appear to be unfounded. Three of these potential disadvantages need further reflection.

First, it was stressed that less competitive companies would suffer from the opportunity that foreign companies will have of designating the EU through the Hague system.

This observation is not convincing. The aim of the accession should be to facilitate access to new markets, increasing the competitiveness of EU companies. Their competitiveness cannot be sacrificed in favour of the protection of non competitive companies. Besides those companies are already exposed to the competition of foreign companies, which can already register Community designs.

A second remark made in the consultation concerns the limited membership to the Geneva Act. It was stated that not many countries have acceded to the Geneva Act.

This may be true at present - even though there are already 18 Contracting Parties. However, the Geneva Act only became operational on 1 April 2004 and several countries are considering or preparing accession. In addition, the accession of the EC is likely to encourage other countries to accede to the system. In any event, the most interesting feature of the Geneva Act is its unlimited scope of membership which will potentially extend worldwide, including the most important trading partners of the EU, such as United States of America, Japan and others.

A third assumed negative impact would be that the fee which third countries companies will have to pay to designate the EC will be very competitive; this may encourage them to massively designate the EC - to the detriment of the position of EC companies.

Such an argument is difficult to understand. The Geneva Act gives the Contracting Parties the possibility to provide that an individual designation fee has to be paid when designating it. The fee must be proportionate to the amount which the Office of that Contracting Party would be entitled to receive from an applicant for a national grant. Therefore, the accession of the EC to the Geneva Act cannot as such harm EC companies as far as the level of fees is concerned. In general, it can be said that the attractiveness of the EC system works both for foreign and EC companies in an identical way.

5.3 The timing of possible EC accession to the Geneva Act

Since the adoption of the Geneva Act, the accession of the European Community has become more and more advantageous.

The system became fully operational on 1 April 2004. On that date, both the Geneva Act and the modernised Common Regulations under the Hague Agreement, which simplify the entire proceedings, came into force.

The system is also becoming more attractive for applicants because an increasing number of countries are preparing accession to the Geneva Act, therefore extending the geographical coverage. Accession of the United States may take place in the second half of 2005. As the United States were not party to any of the previous Acts, their accession to the Geneva Act amounts to a substantial extension of the scope of protection of international registrations. Other important trading partners such as Japan are also considering accession in the future. Accession of the EC in the near future would stimulate them to prepare accession as well.

From the side of the Community design system, the creation of the link is also timely. The OHIM has been receiving applications for registered Community designs since 1 January 2003 with the first date of filing being granted on 1 April 2003. Since then, it has obtained good experience in dealing with the examination of applications and registration of Community designs and the system is perceived to be a success. The OHIM is therefore well prepared for the establishment of a link between the international registration system and the Community system.

The EC accession to the Geneva Act should be considered in the near future. Both the Community design system and the international registration system have shown their value for designers. Postponing the establishment of a link between the Community design and the international registration system would only imply an unnecessary delay in achieving the objective of creating a level playing field and reducing costs for supranational operating designers.

Finally, the recent accession of the European Community to a similar WIPO system in the field of trade marks, the Protocol to the Madrid Agreement for the international registration of trade marks,⁶ constitutes an important precedent that should pave the way to accession to a system that is much simpler than the Protocol.

In short, there are good reasons for the EC to accede to the Geneva Act now. Both the OHIM system at EC level and the Geneva Act system at WIPO level function well; benefits for industry could be achieved earlier; the existing distortions of competition would be eliminated earlier and EC accession would encourage other trading partners to adhere in the short term.

5.4 Financial implications

The financial impact of the EC accession to the Geneva Act can be measured from the point of view of the applicants and in the context of OHIM.

The issue of cost savings for the applicant has already been addressed. There is no need to provide for translations of the documents, renewals can take place through a single deposit; the applicant will avoid paying a series of national fees in different currencies and fees to several agents in different countries.

The applicant will also not be faced with an increase of fees in comparison with fees payable for a Community design. The Geneva Act provides that, for international registrations, this amount may not exceed the amount equivalent to what the office concerned would be entitled

⁶ See Council Regulation (EC) No 422/2004 of 19 February 2004 amending Regulation (EC) No 40/94 on the Community trade mark, OJ L 70, 9.3.2004, p. 1.

to receive from the applicant in the case of an application, or a renewal, requested directly with that Office, that amount being reduced by the savings resulting from the international procedure.

Another principle under the Geneva Act is that the payment of a fee is remitted in full to the Office of the designated Contracting Party concerned. If the Community should decide to replace the prescribed designation fees by individual designation fees (see below), the economic consequences for OHIM are therefore neutral. The Office will, in principle, receive the same amount as the fees under the registration of the Community design, this amount being corrected by the savings as a result of the international procedure.

5.5 Operational choices

The Geneva Act allows for a number of declarations to be made by a Contracting Party wherein the Director General of the International Bureau is notified of certain conditions to be applied to an international registration designating the Contracting Party. In this context, the impact of the most relevant declarations that the European Community could make must be assessed.

First, the Geneva Act enables Contracting Parties to decide whether an application for an international registration may be filed, at the option of the applicant, either directly with the International Bureau or indirectly through OHIM.

The European Community should exclude the filing of an application through the Office in order to avoid confusion by applicants between applications for registering Community designs and applications for international registrations. Furthermore, the Hague System draws most of its advantages from its simplicity. Presently, even from those Contracting Parties who would permit such a procedure, WIPO hardly receives applications filed through national offices as users see no need to add a stage between themselves and the registration. Such a stage only increases the risk of loss of files. Moreover, the clarity of the system would be diluted if filing through OHIM was allowed. Those who wish to file for a registered Community design can do this directly at OHIM or through national offices, whereas if the international route is sought it should begin in Geneva.

Second, the European Community should decide whether in connection with any application for an international registration in which it is designated, and in connection with the renewal of any international registration resulting from such an application, the prescribed designation fees could be replaced by individual designation fees to be transferred to the Office.

In terms of income, the choice between the standard designation fee and the individual designation fee will have budgetary consequences for the Office. The Community should therefore take advantage of this option and determine its own individual designation fees. Such determination will have to be made on the basis of a number of elements. Fees will have to be sufficient to cover the costs incurred by the procedures relating to designs the protection of which is requested in the EU. This means not only the costs relating to examination of such designs in OHIM but also other procedures like invalidities and appeals. To undertake such a cost analysis, the impact of the major conditions of the accession to the Hague Agreement will have to be examined. The Commission also needs to have a better idea as to the possible number of invalidities and appeals international designations could generate and thus the level of work involved for the OHIM.

5.6 The impact of accession to the Geneva Act on the number of design registrations

It is difficult to predict the possible success of the Geneva Act and its linkage to the Community design system. As stated before, both systems have become operational in relatively recent times. The first filings for the registered Community design became possible on 1 April 2003. The Geneva Act came into force on 23 December 2003 and has been operational since 1 April 2004 with still a rather limited number of Contracting Parties.

However, it is fair to expect that an increasing number of applicants will make use of the international registration system.

First, the success of the Community design shows that applicants highly appreciate the possibility of securing protection for a number of countries by a single filing. Statistics show that since 1 April 2003 the OHIM registered and published in total 130.368 designs: 40,622 in 2003, 57,762 in 2004 and 52,709 in 2005 (until 30 September).⁷ These very promising results are much better than predicted. In a study carried out for the OHIM in 2002 it was estimated that applications for a total of between 13,275 and 17,169 Community designs would be deposited in 2003.⁸

Second, as was pointed out by some respondents in the survey organized by the Commission in 2004, the present statistics on the applications for a Community design could be used as a basis for predictions of the number of international registrations. According to the estimates provided by one national federation of industry, international registrations in which the EC would be designated could be 50-60% of present Community design applications for large companies. SME's would count for up to 10% of the present Community design applications. On the basis of 2004 statistics, this calculation would mean that in international registrations large companies would designate the EC for about 25,000 designs and the SME's for up to 4,887 designs. However, it should be noticed that these predictions will depend on the amount of fees that finally will be fixed for international registrations designating the EC.

Third, the statistics published by WIPO on the operation of the Hague Agreement show that, overall, between 1985 and 2001 there has been a steady increase of registered deposits, with a total number of almost 2 million designs contained in the registered deposits in 2004.⁹ The number of designs contained in the registered deposits dropped considerably between 2002 and 2004.¹⁰ A clear reason for this is that EC companies, together with Swiss companies the most important users of the Hague System, designate in particular EU Member States. In recent years, these applicants have switched to the Community design system. The EC accession to the Geneva Act would no doubt increase volumes again since both systems can be applied for in a single international application.

Fourth, the accession to the Geneva Act of important commercial partners such as USA and Japan, together with the simplification of the registration procedure, will undoubtedly also increase the total number of design applications.

⁷ See <http://oami.eu.int/en/office/stats.htm>.

⁸ See study carried out for the OHIM, referred to in footnote 5, p. 33.

⁹ See <http://www.wipo.int/hague/en/stat/>.

¹⁰ From 20,705 designs in 2002 the number decreased to 13,152 designs in 2003 and 8,943 designs in 2004.

5.7 The economic sectors concerned

The top ten classes of goods most designated under the Community design system are furnishing (12,6% of applications), packages and containers for the transport or handling of goods (8,4%), clothing (7,3%), sanitary etc. (6,2%), household goods (5,6%), lighting apparatus (5,4%), recording, communication or information retrieval equipment (5,3%), building units and constructing elements (4,7%), adornment (4,5%) and tools and hardware (4,5%).¹¹

A look at the major user countries shows that for the Community design, the major users are Germany (24,6%), Italy (14,8%), the USA (8,9), the UK (8,3%), France (7,7%), Spain (6,4%), Japan (4,0%), the Netherlands (4%), Denmark (2,6%) and Switzerland (2,5%).¹²

The top 20 users of the Community design system until July 2005 are Colgate-Palmolive (US), Nike (US), Villeroy & Boch (Germany), Arte Espina (Netherlands), DaimlerChrysler (Germany), Sony (Japan), Mattel (US), Rehau (Germany), Schwinn (Germany), Interior's (France), Choo (UK), Nokia (Finland), Mars (US), Westfälische Textil-Gesellschaft (Germany), Eglo Leuchten (Austria), Massive (Belgium), Casio (Japan), Ecco (Denmark), Procter & Gamble (US) and Henkel (Germany).

For the Hague System, in 2004 the ten most designated classes of goods were clocks and watches (22,6%), adornment (12,5%), travel goods etc. (12,1%), means of transport or hoisting (10,6%), clothing (6,1%), recording, communication or information retrieval equipment (5,8%), furnishing (5,2%), tools and hardware (4,8%), lighting apparatus (4,1%) and games etc. (4,0%). The major user countries of the Hague System in the period 2003-2004 are European: Germany, Switzerland, the Benelux countries, Italy and Spain, in that order. The same holds true for the most designated States: in 2004 these were Switzerland, Italy, Germany, France, Benelux and Spain, in that order.

The top twenty users of the Hague System in 2003 were: Swatch (Switzerland), Interior's (France), DaimlerChrysler (Germany), Hermès (France), Unilever (Netherlands), Nokia (Finland), Hans Grohe (Germany), Salomon (France), Volkswagen (Germany), Philips Electronics (Netherlands), Villeroy and Boch (Germany), Rehau (Germany) Henkel (Germany), Stekelenburg (Netherlands), Braun (Germany), Sanford (Germany), Fonkel (Netherlands), Tefal (France), Robert Bosch (Germany) and Siemens (Germany).¹³

The overview demonstrates that an improvement of the system by creating the link between the Community design system and the Hague arrangement would benefit a wide range of industrial sectors. In particular, it can be foreseen that the sectors of textile and furniture, cars, jewellery, sanitary and mobile phones will be amongst the most beneficial sectors of industry. The survey also shows that both large companies and SMEs will benefit from accession, a conclusion that has been confirmed in the consultation carried out by the Commission. Furthermore, the advantages will not only be felt by Community industries but also by industries of third countries.

¹¹ Cumulative statistics until 31 March 2005. The classification of goods takes place on the basis of the Locarno classification system.

¹² Cumulative statistics until 31 March 2005.

¹³ See http://www.wipo.int/edocs/prdocs/en/2004/wipo_pr_2004_376.html.

6. Conclusion

The assessment of the options leads to the conclusion that in order to best achieve the outlined objectives, the EC should adhere to the Geneva Act.

The establishment of a link between the Community design system and the international registration system of the Hague Union would promote a harmonious development of economic activities, will eliminate distortions of competition, will be cost efficient and will increase the level of integration within the internal market. The accession of the EC to the Geneva Act will therefore make the Community design system more attractive. Similar advantages cannot be achieved without accession.

The result of the consultation carried out by the Commission could hardly be more self-evident. An overwhelming majority of the responses, bordering on unanimity, supports the idea that the EC should accede in the near future to the Hague Agreement.

ANNEXES

- 1. Analyses of the results of the Commission's consultation on the impact of the accession of the European Community to the Hague Agreement on International Designs (Summer 2004)**
- 2. Questionnaire on the impact of the accession of the European Community to the Hague Agreement on International Designs (January 2004)**

Annex 1

Analyses of the results of the Commission's consultation on the impact of the accession of the European Community to the Hague Agreement on International Designs (Summer 2004)

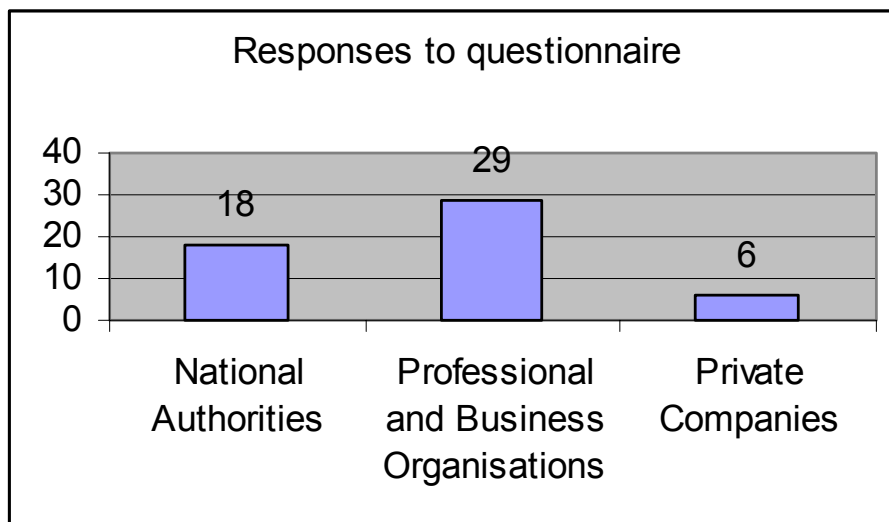
1. Introduction

On 30 January 2004 the European Commission (DG MARKET) launched a consultation, by means of a questionnaire sent to interested parties, on the possible impact on business of the accession of the European Community to the Hague system. The questionnaire focused on the impact of the introduction of a link between the Community design and the international registration system, the effects in terms of reduction of costs, the incentive to foster the marketing of EU products in foreign countries, a quantitative estimate of the potential use of the system and any possible concerns as to the fact that foreign countries could use the system to designate the EU.

All Member States (including the 10 new Member States) as well as some 90 business and professional organisations from Members States, Candidate Countries and two non-EC Countries (USA and Switzerland) were directly invited to submit their comments and opinions by the end of April. At the same time, the questionnaire was put on the Commission's website, inviting all interested parties to submit their views by the same deadline.

2. Response sources

A total of 53 replies to the questionnaire were received. They may be divided into three different groups: responses coming from national official authorities (including the Office for Harmonization in the Internal Market); responses from business and professional organisations; and replies from private companies.



Responses from national official authorities

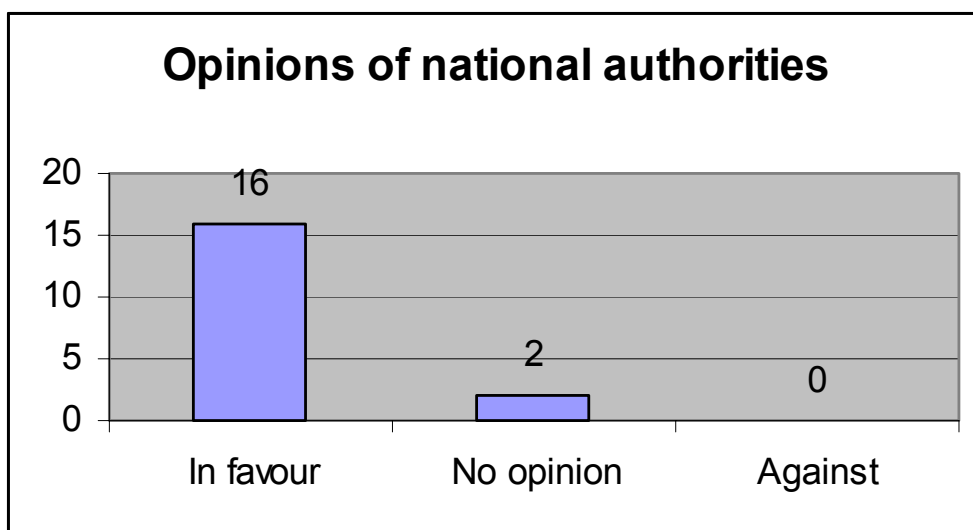
The following 16 Member States submitted their responses to the questionnaire, either *via* their Patent and Trademark Office or *via* their Ministry of Industry: Belgium, Cyprus, Czech Republic, Denmark, Germany, Hungary, Ireland, Italy, Luxembourg, the Netherlands, Poland, Portugal, Slovakia, Slovenia, Spain, and Sweden.

Furthermore, responses were received also from the Swiss Intellectual Property Office and from the Office for the Harmonization in the Internal Market.

It is important to point out that, at the moment when the survey was launched, only 10 out of the 25 Member States are contracting parties to the Hague Agreement. Seven out of those adherents sent their responses.

The very fact that 16 Member States answered the questionnaire on a subject in which only a part of them has experience shows a great interest in the accession of the European Community to the Hague Agreement.

Furthermore, 14 Member States support the accession of the EC to the Geneva Act. Two of them (Hungary and Sweden) consider it premature to give an opinion on this, although they stress that any mechanisms that facilitate access to protection in third countries could be seen as positive for EU design creators and rights holders. Also the Swiss Intellectual Property Office and the OHIM are in favour of the accession of the EC. Not a single Member State has shown its opposition to the accession.

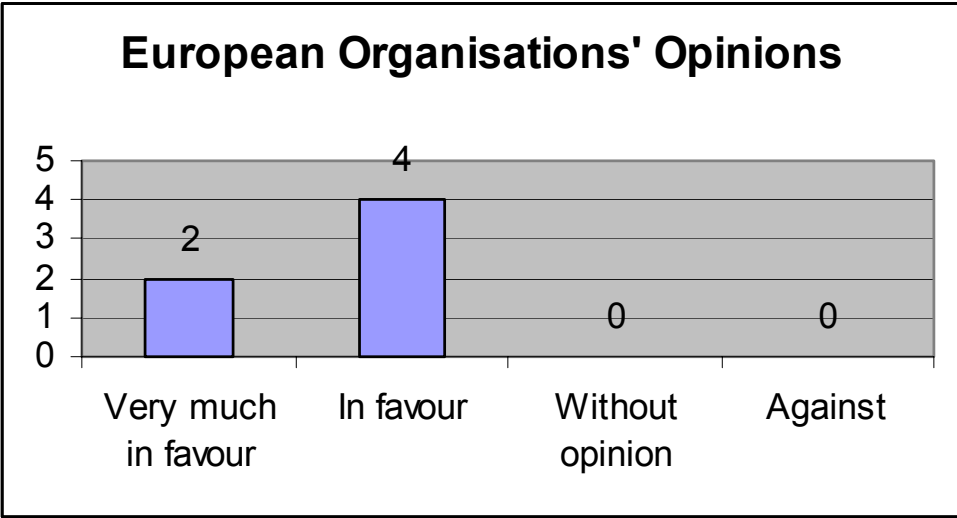


Responses from professional and business organisations

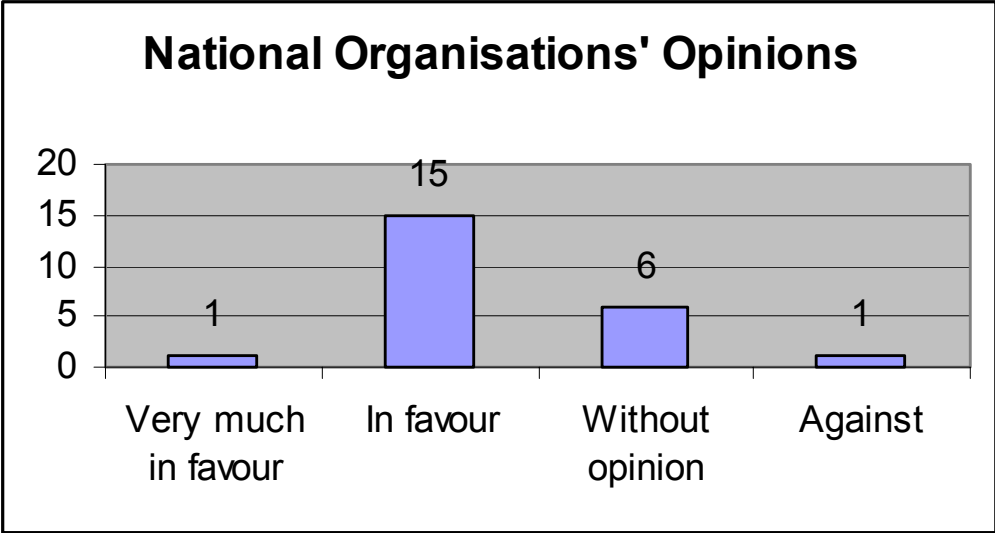
A total of 29 business and professional organisations answered, six of them representing industry and agents at a European-wide level (Association des Industries des Marques - AIM, The Bureau of European Designers Association - BEDA, European Community Trademark Association - ECTA, Fédération Européenne des Mandataires de l'Industrie en propriété Industrielle – FEMIPPI, The Association of European Trade Mark Owners – MARQUES, Union of and Employers' Confederations in Europe – UNICE).

The 23 nationally-based organisations (including the International Association for the Protection of Intellectual Property – AIPPI, the Association des Praticiens du Droit des Marques et des Modèles – APRAM, the Chartered Institute of Patent Agents – CIPA, the

Bundesverband der Deutschen Industrie – BDI, the Licensing Executives Society – LES, the Patentanwaltskammer, the Association of Swedish Patent Attorneys) represent 11 EU Member States (Belgium, Estonia, France, Germany, Greece, Italy, Latvia, Poland, Spain, Sweden and United Kingdom), plus Romania and Switzerland. The totality of the European organisations declared their support for the accession, two of them having also stressed to be very much in favour.



As to the nationally based organisations, 16 of them expressed their support for the accession, while 6 declared not to be able to take a definitive position. One negative answer came from the German Association of the Automotive Industry. However, two of the major German car producers (Daimler Chrysler and Volkswagen) have responded directly to the questionnaire giving their support to the accession.



Finally, only six answers were received from private companies. Such a low score should not be interpreted as a lack of interest by European companies involved in the design business. Instead, it could be explained by the fact that, in general, industries and agents have already expressed their views through the above mentioned business and professional organizations and therefore they have considered it redundant to file separate individual answers to the questionnaire. As a matter of fact, among the six answers received, three come from industries

and three from design agents. As to their geographical distribution, two are German, one is English, one Italian, one Danish and one Czech. All of them endorse the accession.

3 Response contents

The analyses of the answers to the questionnaire has shown that there is basically no difference in the arguments put forward in their responses by national authorities, business and professional organisations, and private companies. This allows to treat them all together, stressing possible differences whenever this appears to be necessary.

3.1. The nationals of which countries would benefit the most?

From a general point of view, it has been stressed that the accession would benefit companies from EU Member States which are currently contracting parties to the Geneva Act of the Hague Agreement as well as companies from Member States which are not contracting parties.

In fact, on the one hand, the EU accession will allow nationals of all Member States, including those that are not contracting parties to the Geneva Act¹⁴, to file an international deposit through the Hague system. On the other hand, the accession would also benefit the nationals of (the few) Members States that are already party to the Geneva Act. In this case, procedures will be simplified as it will be possible to seek the registration of a Community design and of other national designs by means of only one application at WIPO.

3.2. Which type of companies would benefit the most?

It appears from the answers received that both large companies and SMEs would benefit from the accession.

On the one hand, it is obvious that the companies that have the greater interest in the accession are those that operate world-wide and wish to protect their designs not only in the EU or individual EU Member States but also in non member countries.

On the other hand, the accession would entail simplified registration procedures and savings in the administration of design portfolios, which would greatly benefit SMEs with limited resources to handle registration proceedings in a variety of countries.

3.3. What would be the impact on EU design industry?

The stakeholders argue that the accession would have a positive impact on the EU design industry, mainly for the following reasons:

- The registration procedure would be simplified as one single application would be sufficient in order to seek protection in several (potentially unlimited) States, there would be no need to

¹⁴ It should be remembered that an international application can only designate countries which are bound by the same act as the applicant's State of origin. As the major commercial partners/competitors of the EU in the design field, as USA, Japan and Korea, are not likely to adhere to any other act than the Geneva Act, nationals of EU Member States which are not party to the Geneva Act will not be allowed to designate these countries (once they will have acceded), unless the European Community accedes to the Geneva Act.

appoint a representative in each of the designated States, no translation of the application (filed either in French or in English) would be required and only one set of fees would be paid in one currency (Swiss francs);

The above described simplification of the procedure would amount to a saving of costs;

The reduction of costs and simplification of procedure would encourage designers to seek protection outside the EU;

Competitiveness as well as research, development and innovation activities would be boosted as a consequence of a wider protection and of the potential to devote to those activities the money saved thanks to the simplified registration procedures.

However, all interested parties have stressed the fact that the current scope of the Geneva Act is limited to countries which are either EU Members (and can then already be covered filing directly at OHIM an application for a Community registered design) or countries of minor importance for the commercial penetration of EU companies (with the relevant exception of Switzerland).

In particular, the fact that the USA, Japan, China and Korea are not contracting parties to the Geneva Act does sap the majority of the interest in EU accession, which would represent only a limited added value to the current situation. Therefore, the impact on competitiveness would be of a lesser degree, until those countries enter the international registration system.

Nonetheless, it has been unanimously underlined that the accession of the EC would represent a major political step, which would urge also our commercial partners to accede to the Geneva Act. It was stressed that the same happened with respect to the Madrid Protocol for the international registration of trade marks.

Furthermore, the United States have already announced that it has started the internal steps necessary to launch the accession process.

3.4. What would be the main advantages and disadvantages?

Among the main advantages the foremost is the simplicity of the system, which would contribute to make easier to seek protection in third countries.

The great majority of the stakeholders believe that the accession would not have any negative effect on the European designers. Regarding the European Union's competitiveness at world level reference has been made to a statement of the Council of the European Union in the preamble of the Regulation on Community designs: "Enhanced protection for design not only promotes the contribution of individual designers to the sum of Community excellence in the field, but also encourages innovation and development of new products and investment in their production".

Moreover, it has been observed that the accession to the Geneva Act would not give rise to the problems that have characterized the accession to the Madrid Protocol.

More specifically, the problems of the linguistic regime and of the opting back clause that had blocked for many years the negotiations on EU accession to the Madrid Protocol will not exist in the case of the Geneva Act.

As regards the opting back, this problem cannot be raised in the present context for two reasons. Firstly, the Geneva Act, unlike the Madrid Protocol, does not allow subsequent designations. Secondly, in the Community design system, unlike the Community trademark system, no conversion into national designs is possible.

With regard to the language regime, it is important to remember the specific characteristic of the design system that the indication of the products to which the design is intended to be applied as well as the classification of the products do not affect the scope of protection of the design as such. This peculiarity, focusing on the sole reproduction of the design, unlike in the trademark system, removes any interest in the verbal elements of the design application. Furthermore, in the Madrid Protocol framework the linguistic problems stem from the fact that the international applications designating the EC are re-published in the Community trademarks Bulletin, while such a re-publication is not at all necessary in the Hague system, according to which the publication in the WIPO Gazette is a sufficient means of publicity. Contracting parties could re-publish international application if they wished to do so but, in practice, no country does this.

Nonetheless, in a very limited number of responses the possibility of some disadvantages exist has been evoked, namely:

- (a) applicants from countries where a novelty examination is carried out would take greater benefit than EU applicants, unless such countries come into line with the EU system (where there is no novelty assessment at the filing and registration stage);
- (b) less competitive companies will suffer from the possibility that third countries companies will have of designating the EU through the Hague system;
- (c) there is a limited membership to the Geneva Act;
- (d) the fee that third countries companies will have to pay to designate the EC will be so cheap as to encourage them to designate massively the EU;
- (e) the Hague system does not limit the number of views that can be filed for the same design, while the EC system foresees a limit of 7 views;
- (f) the Hague system does not allow assignments to a non-Hague national, limiting the commercial freedom and asset value.

The Commission believes that all these arguments are unfounded.

Sub (a). Companies from countries with a novelty examination system can already apply for the registration of a Community design, without any restriction. The accession to the Geneva Act would therefore not change this situation.

Sub (b). The aim of the accession should be to facilitate the accession to new markets, increasing the competitiveness of the EU companies. Their competitiveness cannot be sacrificed in favour of the protection of non competitive companies. Beside this, as we have explained sub (a), those companies are already exposed to the competition of foreign companies, which can already register Community designs.

Sub (c). As explained in paragraph 3.3, the accession of the EU is likely to urge other countries to accede the system, making it world-wide.

Sub (d). The Geneva Act gives the Contracting Parties the possibility to provide that an individual designation fee has to be paid when designating it. The fee must be proportionate to the amount which the Office of that Contracting Party would be entitled to receive from an applicant for a national grant. Therefore, the accession of the EC to the Geneva Act cannot as such harm EC companies as far as the level of fees is concerned. In general, it can be said that the attractiveness of the EC system works both for foreign and EC companies in an identical way.

Sub (e). This is a non-problem. Firstly, to fully reproduce an object there is no need to use more than seven views. Secondly, the OHIM already deals with applications containing more than seven views and its practice to discard the views exceeding the number of seven has raised no problems.

Sub (f). Finally, this argument is correct but it will lose its importance as fast as the most important commercial partners accede to the Geneva Act. In the meanwhile, it will be up to companies to evaluate their strategy and to check whether this can be an obstacle in using the international registration system.

3.5. How many international applications would be filed per year?

None of the concerned parties has been able to predict any estimate on this point. Nonetheless, it has been underlined that the accession of important commercial partners as USA and Japan, together with the simplification of the registration procedure, will without no doubt increase the total number of design application from EU design companies.

3.6. Would it be better to file applications directly at the WIPO International Bureau or via the OHIM?

The Hague system allows contracting parties to choose whether an international deposit can be filed only directly at WIPO or if an indirect deposit through the Office of origin would be possible.

Since very few applications are delivered personally, the location of the receiving office seems to be of minor importance. Whether an application is to be sent to Alicante or Geneva makes very little difference to the applicant.

Nonetheless, it seems the direct filing at WIPO should be preferred, avoiding useless duplication of work. This is notably true in the case of payment of the basic fee for an international application, which has to be paid in any event directly to the International Bureau and which is payable at the time of filing. Applicants might be misled and erroneously pay the fee to OHIM, the latter having to return the fee to the applicant.

4. Final considerations

The great number of responses sent by both Member States and business and professional organisations attest to the interest that the stakeholders attach to the accession of the European Community to the Hague Agreement. A less impressive number of responses were sent by

private companies active in the interested field, but this can easily be explained taking into consideration that private companies are also represented by the above mentioned business and professional organisations, which did massively participate in the consultation.

An overwhelming majority of the responses received, bordering on unanimity, support the idea that the European Community should accede in the near future to the Hague Agreement. The principle arguments brought in favour of the accession are: the international deposit of designs would result in simplifying registration procedures and portfolio management; the saving of costs would have a positive impact on research, development and innovation activities; simplified procedures would facilitate access to protection in third countries; the accession of the European Community would offer the same opportunities to all EU citizens irrespective of whether they are nationals of a Member State that is or is not a contracting party to the Hague Agreement; and the accession of the European Community would urge other important commercial partners to adhere, such as USA, Japan, Korea and China, making the system really world-wide and attractive.

The minor problems identified by a very limited number of subjects are, in the great majority of the cases, only the consequence of a misunderstanding of the system and cannot constitute valid reasons not to adhere to the Geneva Act.

Finally, the direct deposit at the International Bureau seems to be preferable to the indirect deposit through OHIM.

Annex 2

Questionnaire on the impact of the accession of the European Community to the Hague Agreement on International Designs (January 2004)

1. Introduction

The Hague Agreement Concerning the International Deposit of Designs offers owners of designs a simplified means of applying for protection of a design in several countries by submitting a single international application, replacing a whole series of applications, which, otherwise, would have had to be filed directly with each of the national offices concerned.

The European Community meets the conditions to become party to the Geneva Act (1999) of the Hague Agreement, which entered into force on December 23, 2003.

Whereas the Community design system provides for a complete and unified regional designs registration system which covers the whole territory of the European Union, the 1999 Act constitutes a treaty centralizing, with the International Bureau of WIPO, the procedures for obtaining protection of designs in the territory of the designated Contracting Parties.

On the other hand, any substantive aspect of the protection (including in particular the substantive examination carried out by each Office, the assessment of the conditions of protection and the scope of that protection) is entirely a matter of the legislation of each designated Contracting Party.

Therefore, both systems are complementary. The link between the Community design system and the 1999 Act implies that industry may make use of the Geneva Act to obtain Community designs at the same time as obtaining design protection in third States.

In other words, participation of the European Community in the 1999 Act would make it easier for design owners in the European Union to obtain protection for their designs in the European Union and in the territories of Contracting Parties to the 1999 Act outside the European Union through one single international application lodged at the International Bureau of WIPO.

To evaluate whether the Commission should initiate proposals to allow for accession of the European Community to the Geneva Act, the Commission would like to have the opinions and comments of the interested parties on the following questions:

2. Questionnaire

1. What, in your opinion, would be the impact, in your sector of activity or more generally, of the accession of the European Community to the Geneva Act (1999) of the Hague Agreement Concerning the International Deposit of Designs on:

- research and development activities and innovation in the field of design,*
- the European Union's competitiveness at world level?*

Where necessary, make a distinction according to the size of the company (large companies or SMEs) and the sectors concerned.

2. Which would be, in your opinion, the main advantages of the system as described in point 1 for the European Union companies? Would there be any disadvantages?

3. If the system described in point 1 was set up, how many international applications designating the European Community would you be likely to file per year?

In your opinion, what would be the total amount of international applications designating the European Community, coming either from a Member State or from a Third Country?

4. Would your reply to question 3 be different if the international application can not be filed through the Office for Harmonization of the Internal Market but only directly at the International Bureau?

5. On the basis of your replies to the previous questions, would you be in favour of the accession of the European Community to the Geneva Act as described in point 1?

6. If your reply to the previous question was negative, what changes would you suggest to make the system acceptable to you?

7. Do you have any further comments regarding the accession of the European Community to the Geneva Act?

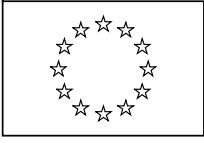
3. Timetable

This consultative document is being sent to main interested parties. It will also be available on the website of the European Commission's Internal Market DG at the following address: http://europa.eu.int/comm/internal_market/en/intprop/indprop/index.htm and on the site of the Office for Harmonization in the Internal Market at the following address: <http://oami.eu.int/en/default.htm>.

Replies to the questions must be sent to the European Commission's Directorate-General for the Internal Market, either by writing to the following address: **European Commission, DG Internal Market (MARKT/E/2), rue de la Loi, 200 (C100 5/027), B-1049 Bruxelles**, or by e-mail to MARKTE2@cec.eu.int.

All comments must reach the Commission by 18 April at the latest.

For any further information on this consultation, please contact Mr G. Bertoli (tel. +32 (0)2 298 56 40; e-mail giuseppe.bertoli@cec.eu.int)



EUROPEAN COMMISSION
Internal Market DG

Brussels, 1 March 2002

**Summary report of replies to the questionnaire on the impact of the Community utility model with a view to updating the Green Paper on protection by the utility model in the internal market
(SEC(2001)1307)**

Summary

On 26 July 2001, the Commission published a staff working paper entitled "Consultations on the impact of the Community utility model in order to update the Green Paper on the Protection of Utility Models in the Single Market" (SEC(2001)1307).

The consultation exercise yielded 47 responses, mainly from governments and ministries in the Member States, professional associations and companies. This figure is fairly modest compared to other consultation exercises launched by the Commission in similar fields.

Three-quarters of the contributors state their opposition to a Community utility model. The reasons are many and varied, including the risk of restricting competition and adversely affecting the competitiveness of European companies, less legal certainty, unsatisfactory criteria (level of inventiveness, etc.). Moreover, it is felt that the utility model would respond to a need for local, or even national protection, but would not be justified at Community level.

Of the contributors opposed to a Community utility model, a majority advocate abandoning any initiative on it, while a number would like to see a resumption of work on the Directive aiming to approximate Member States' legislation on this form of protection.

On the other hand, the interested parties in favour of a Community utility model believe that it would be a useful complement to the patent system. The creation of a Community utility model would be particularly important for SMEs, whose minor technological innovations often have only a short lifetime and have not yet benefited from protection.

Contents

1. Introduction: background
2. Features of a possible Community utility model
3. Analysis of the results of the consultation exercise
 - 3.1. General comments
 - 3.2. Substantive analysis
 - 3.2.1. General assessment
 - 3.2.2. Question-by-question analysis

1. INTRODUCTION: BACKGROUND

In 1995, the European Commission launched a wide-ranging consultation exercise on the need for Community action on utility models. It did so by means of a Green Paper on the Protection of Utility Models in the Single Market (COM(95)370 final). Several approaches were considered, including aligning national protection procedures and creating a Community protection right.

Most of the interested parties preferred the first option. Consequently, on 12 December 1997, the Commission presented a proposal for a Directive approximating the legal arrangements for the protection of inventions by utility model (COM(97)691 final). Following the opinion given by the Economic and Social Committee on this proposal on 27 May 1998 and the resolution adopted by the European Parliament on 12 March 1999, the Commission presented an amended proposal for a Directive on 25 June 1999 (COM(1999)309 final).

The work on this proposal was suspended in March 2000, because of the difficulty of reaching agreement on some basic problems raised by the proposal and the priority which the majority of Member States attached to a Community patent.

On 23 and 24 March 2001, however, the European Council in Stockholm, in the light of the conclusions of the European Councils of Lisbon and Feira, expressed concern about the modest progress which had been made with both the Community patent and the utility model. The Commission wished to bring its information up to date regarding the opinions of the interested parties on the introduction of a Community utility model.

On 26 July 2001, having received support from the Internal Market Council on 31 May 2001, the Commission published a staff working paper, "Consultations on the impact of the Community utility model in order to update the Green Paper on the Protection of Utility Models in the Single Market" (SEC(2001) 1307).

The interested parties were asked to submit their comments by 30 November 2001. The present note aims to identify the main results of the consultation exercise.

2. FEATURES OF A POSSIBLE COMMUNITY UTILITY MODEL

The interested parties expressed their views on the Commission's staff working paper, in particular point 4. It is appropriate at this juncture to recall the main features proposed for a Community utility model:

- Inventions of both products and methods would be protected (no requirement for defined or three-dimensional form).
- Inventions would need to satisfy the criteria of absolute novelty, suitability for industrial application and a certain degree of inventiveness, the latter being fixed at a level lower than for patents.
- Applications for a Community utility model would be subject only to a formal verification, and the utility model would be granted without prior examination of the conditions for obtaining protection with regard to novelty and inventive step.
- There would be no limit on the number of claims.

- A search report on the state of the art could be requested by the applicant or by third parties. The search report would be added to the file and would become compulsory in the event of legal proceedings.
- The rights conferred by a Community utility model would be identical to those conferred by a patent.
- The duration of protection would be a non-renewal maximum of ten-years from the date of filing of the application.
- Dual protection (application for a patent and for a utility model) would be permitted, but, in the event of a dispute, successive proceedings under both sets of protection arrangements would not be allowed.

Finally, the Community utility model would not replace national arrangements for the protection of utility models but, rather, would complement them.

3. ANALYSIS OF THE RESULTS OF THE CONSULTATION EXERCISE

3.1. General remarks

The European Commission received 47 written comments. This is a fairly modest number compared to other consultation exercises in similar fields, and in relation to the Green Paper of 1995, which attracted nearly 100 comments. It seems that, in the absence of major developments since the Green Paper, the "interested parties" were not particularly interested in expressing their views on the subject, as their positions had generally not changed much in the intervening period.

The answers fall into two groups: national (33 contributions) and multinational, e.g. from professional federations or trade associations (14 contributions). Although this distinction is not entirely watertight, it does make it possible to read the comments in the specific context in which they were made.

The interest aroused by this consultation exercise varied between Member States. The largest single number of replies was received from the United Kingdom (10), well ahead of France (five) and Germany (four) and Denmark (three). The Commission did not receive any comments from Belgium, Luxembourg or Portugal. It should be noted that Luxembourg, the United Kingdom and Sweden are the only three Member States not to have protection of the utility model type.

Nevertheless, these data should be analysed with some caution, because the consultation took different forms in the various Member States. In some, the interested parties were asked to make their views known to the Commission directly (as appears to have been the case in the UK, for example). Others preferred a single body to relay replies to the Commission (e.g. Spain and Sweden).

The contributions of organisations with a multinational character made it possible to obtain the opinion of companies of all sizes, including craftsmen, self-employed persons, SMEs and major companies. Some sectoral associations provided more specific insights into the consequences which a Community utility model would have on their respective sectors (e.g. the pharmaceutical, toy and sports industries).

In addition to these quantitative factors, the Commission notes the difficulty expressed by certain quarters of providing precise comments on several questions. The matters raised

in the Commission's working paper, particularly point 4, were sometimes judged too woolly (the objects liable for protection, the degree of inventiveness, etc.).

3.2. Substantive analysis

3.2.1. General assessment

Most of the interested parties are opposed to the introduction of a Community utility model. Of the 36 opponents, the majority wish the Commission to focus its efforts on adopting a Community patent.

Moreover, many fear that such a system would be in competition with the existing patent system, but without adequately addressing the needs of small and medium-sized enterprises. They believe that protection by utility model would often be sought for local purposes only.

A minority, however, is in favour of a Directive harmonising national legislation on the utility model as envisaged in the Commission's proposals of 1997 and 1999.

Those in favour of the working paper represent various sectors. It would therefore be wrong to state that the positive replies came from a specific category (institutional or commercial, small or large enterprises, etc.). Those in favour of a Community utility model believe that it would be a useful complement to a patent system which does little to meet the needs of certain companies, particularly SMEs.

3.2.2. Question-by-question analysis

This analysis is complicated to some extent by the fact that a number of comments were limited to an overall standpoint, without answering each question in detail.

Question 1

What, in your opinion, would be the impact, in your sector of activity or more generally, of the introduction of a Community utility model as described in point 4 on:

- research and development activities and innovation,*
- competition within the European Union,*
- the European Union's competitiveness at world level?*

Where necessary, make a distinction according to the size of company (large companies or SMEs) and the sectors concerned.

The first question is designed to gauge the likely effects of the introduction of a Community utility model, as described in point 4 of the working paper, in terms of research and development, innovation, competition within the European Union and the EU's competitiveness at world level.

As regards research and development, one-fifth of the answers suggest that the creation of a Community utility model would not have a major impact. Slightly less than half, on the other hand, state that it would have negative effects because of the resultant lack of legal certainty (cf. question 2).

Similarly, most respondents point out the harmful effects which introduction of a Community utility model would have on competition within the European Union and, more generally, on the competitiveness of European companies at world level. They repeatedly point to the risk of such an instrument being "hijacked" by large companies adopting an aggressive policy and filing an unconscionable number of applications. Moreover, they feel that the system described in point 4 of the working paper would strengthen the position of major companies in non-member countries, particularly America and Japan. They could easily make use of English-language documents used for registering their patent applications in the United States. This would harm the competitiveness of European companies. Such arrangements would have particularly negative repercussions for European SMEs and inventors: they would be significantly affected by barriers to entry to the single market, which represents their only market. The majority of contributors therefore state that a Community utility model, far from benefiting these companies, would be to their disadvantage.

The few replies which were in favour of a Community utility model, by contrast, stress the importance to SMEs of having a weapon of this kind in their arsenal, as the minor technological innovations which they tend to come up with often have a relatively short lifetime and have up till now not benefited from protection.

Question 2

What, in your opinion, would be the effect of a Community utility model on legal certainty for your company and for the European Union in general?

Next, the Commission wished to know the opinions of the interested parties about the impact which the creation of a Community utility model would have on their legal environment.

Most contributors say that the greatest weakness of the Community utility model is the lack of legal certainty. The principal reasons mentioned are the lack of prior examination, the non-obligatory character of searches, the lack of analysis of basic criteria (e.g. novelty, inventiveness, the required degree of which is often judged too low).

The proliferation of Community utility models would increase companies' costs. Risk analysis and the multiplication in the number of opposition procedures would be a drain on companies' resources, particularly the limited resources of small and medium-sized businesses. The advantages in terms of the speed of the registration procedure would thus be offset by the risks arising from a less certain legal environment.

This view is shared by some respondents who are generally in favour of a Community utility model. In order to mitigate these shortcomings, some respondents propose that a search report be made compulsory.

Question 3

If the system described in point 4 was set up, how many applications for utility models would you be likely to file per year?

In your opinion, what would be the total number of applications filed each year in the European Union?

The interested parties were asked to estimate the number of Community utility model applications likely to be filed per year if the system described in point 4 of the working paper were set up.

A large number of contributors pointed out the difficulty of giving precise figures. Several noted that the strategy adopted would depend on the cost and extent of the envisaged protection, but would also be influenced by the behaviour of competing companies.

There are basically two sets of views.

Some of the contributors stress that protection by utility model is sought mainly for national or even local territory, which means that a fairly limited number of applications would be filed at Community level.

However, the majority expect a large number of applications, most of them from non-European companies. The anticipated numbers range from a few dozen to a few hundred thousands for the European Union, on the assumption that the utility model has features which distinguish it from the patent.

Lastly, some commentators note that certain applications for Community utility models could be substitutes for or in addition to patent applications.

Question 4

Would the reply to question 3 be different if the registration for the Community utility model is made to a centralised office or to national patent offices? If so, please explain.

In the same vein, would the reply to question 3 be dependent upon the procedures, including those related to the linguistic regime:

- to be applied for filing and processing utility model applications; and/or*
- governing the grounds for opposition by third parties to granted utility models.*

If yes, please explain.

This question aimed to evaluate the importance attached by the interested parties to the place where Community utility models would be registered (a centralised office or national offices) and to procedures, including the language arrangements.

As regards the impact of centralised or decentralised registration, the answers were fairly muted: a quarter of the contributors do not think that this would have a major impact on the number of registrations.

Half of the contributors, however, argue that this would impact on the cost of the Community utility model and on the number of applications. There appears to be a difference of approach here between large companies on the one hand and SMEs on the other. Large companies generally prefer a centralised office, which would be more favourable in cost terms, although they recognise that decentralisation would make it possible to reduce the number of applications. Small and medium-sized enterprises lean more towards the option of national offices, which they perceive as being closer to them.

As regards procedures, most contributors state merely that costs must be kept under control.

The question of the language regime is widely thought to be crucial in terms of costs and the number of applications. The majority would prefer a restricted language regime akin to those in force at the Office for Harmonisation in the Internal Market (OHIM) or the European Patent Office (EPO), or even the use of a single language. A small number of contributors, on the other hand, feel that a procedure which could be conducted in all the official languages of the European Union would be more appropriate to the needs of applicants, especially small and medium-sized enterprises.

Question 5

On the basis of your replies to the previous questions, would you be in favour of the introduction in the European Union of a Community utility model as described in point 4?

This question aimed to summarise the position of the interested parties on the Community utility model as described in point 4 of the working paper.

Three-quarters of the contributors were against introduction of such an instrument. It should be pointed out, however, that the comments of ministries which had summarised the national answers reflect broadly favourable positions (Spain) or evenly balanced ones (Sweden) of the organisations consulted. Of all the multinational federations and associations which expressed an opinion, only two were in favour of this new instrument at Community level.

Question 6

If your reply to the previous question was negative because of the features described in point 4, what changes would you suggest to make the system acceptable to you?

Building on the previous question, the Commission wished to know which features of the proposed Community utility model the interested parties thought were unhelpful and what changes they wished to see.

Nearly one-quarter of all the organisations which were opposed to a Community utility model did not reply to this question. The majority consider this form of protection unsuited to the needs of European companies, whatever its features might be.

The comments are varied, but some suggestions crop up several times, such as those asking for:

- the criteria of novelty and inventiveness to be aligned with those of the patent;
- a shorter duration of protection;
- protection limited to the product described in the application, with no principle of equivalent effect;
- introduction of a prior examination;
- changes to the extent of protection.

Question 7

Have any new developments occurred since the Green Paper of 1995 which have led you to change your opinion on the Community utility model?

Please explain, as appropriate.

As its Green Paper dates from 1995, the Commission wished to know if any new developments had affected the interested parties' positions on the Community utility model.

The overwhelming majority, both among those who were in favour and those who were against the Community utility model, did not cite any relevant developments.

The main changes were legislative developments at Community or national level and the impact of those developments. This is particularly true of the proposal for a Directive on utility models of 1997 (COM(1997)691 final) and the amended proposal for a Directive of 1999 (COM(1999)309 final).

Question 8

Do you have any further comments regarding the Community utility model? If so, please give details.

The final question gave the interested parties an opportunity to make any comments which they thought relevant.

The comments are wide-ranging. Some contributors point out that this type of protection is of interest mainly at national or even local level, and that it should therefore not be provided at Community level. Some therefore ask for the abandonment of any initiative relating to the utility model at this level, believing that the Commission should focus its efforts on adopting the Community patent. Others would like to see a resumption of work to bring national laws on the utility model closer into line. Some interested parties are worried about the economic effects of a Community utility model.

Lastly, several respondents expressed the fear that a Community utility model might hinder the existing patent system and the establishment of technical standards, particularly with regard to the new information and communication technologies.

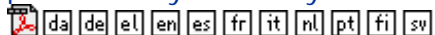
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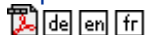
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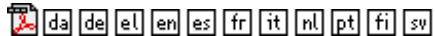
Industrial Property


→ [Industrial Property](#) → [Utility Model](#)

Utility Model

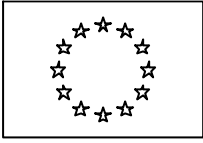
- 01.03.2002 [Summary report of replies to the questionnaire on the impact of the Community utility model with a view to updating the Green Paper on protection by the utility model in the internal market](#)


- 26.07.2001 [Consultations on the impact of the Community utility model in order to update the Green Paper on the Protection of utility Models in the Single Market \(COM\(95\)370 final\)](#)


- 30.06.1999 [Amended proposal for a Directive on the protection of inventions by utility model](#)


- 16.12.1997 [Commission presents a proposal for a Directive on the protection of technical inventions \(utility models\)](#)


 **Last update on** 16-05-2006



EUROPEAN COMMISSION

Brussels, 26.7.2001
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COMMISSION STAFF WORKING PAPER

**Consultations on the impact of the Community utility model in order to
update the Green Paper on the Protection of Utility Models in the
Single Market (COM(95)370 final)**

COMMISSION STAFF WORKING PAPER

Consultations on the impact of the Community utility model in order to update the Green Paper on the Protection of Utility Models in the Single Market (COM(95)370 final)

INTRODUCTION

In July 1995 the European Commission launched an exercise to consult interested parties in order to assess, on the basis of a number of possible options, the need for Community action in the field of utility models¹. Among the options put forward for a possible Community initiative in this field were the approximation of the national systems of protection and the creation of a Community system of protection.

The first option received the support of most of the parties consulted, while there was only limited support for the second. Consequently, the Commission presented a proposal for a Directive approximating the legal arrangements for the protection of inventions by utility model (COM(97)691). The Economic and Social Committee delivered its opinion on this proposal on 27 May 1998. The European Parliament adopted a legislative resolution on the proposal for a Directive on 12 March 1999, and the Commission presented an amended proposal for a Directive on 28 June 1999 (COM(1999)309).

Work on this amended proposal for a Directive has been suspended since March 2000, the majority of the Member States having considered that priority should be given to the Community patent.

In its conclusions, the Stockholm European Council on 23 and 24 March 2001 expressed its concern at the lack of progress on the Community patent and the utility model and urged the Council and the Commission to speed up their work in accordance with the Lisbon and Feira conclusions, with all due regard to the existing legislative framework.

As regards the amended proposal for a Directive, the situation remains unchanged compared with March 2000 and the suspension of work was recently confirmed.

In order to give appropriate effect to the conclusions of the European Council, the Commission has suggested updating the information it obtained from the interested parties on the possible creation of a Community utility model. On 31 March 2001 the Internal Market Council welcomed the Commission's intention of quickly organising consultations with a view to drawing up a basic document taking a closer look at the possible impact of a Community utility model in legal, practical and economic terms.

That is the purpose of this consultative document.

¹ Green Paper on the Protection of Utility Models in the Single Market, COM(95)370 final.

1. GENERAL

1.1. The concept of a utility model

A utility model is a registered right which confers on its proprietor exclusive protection for an invention. As with a patent, to be protected by a utility model, an invention must be new, involve an inventive step and lend itself to industrial application. The level of inventiveness required, however, is generally lower than that for patents. In addition, utility models are granted without prior examination to establish the conditions of novelty and degree of inventiveness that are required for obtaining protection. This means that protection can be obtained more quickly and at less cost than with a patent, but on the other hand it has less legal certainty.

1.2. Utility models in Europe and the world

At present, legal protection for inventions by means of utility models is available only at national level. With three exceptions – the United Kingdom, Sweden and Luxembourg – most EU Member States offer, under various names, utility-model protection. However, their legal systems vary widely. In the Member States that have utility-model protection the following designations are used:

Germany	:	Gebrauchsmuster
Austria	:	Gebrauchsmuster
Belgium	:	Brevet de courte durée/Octrooi van korte duur
Denmark	:	Brugsmodel
Spain	:	Modelo de utilidad
Finland	:	Hyödyllisyysmalli/Nyttighetsmodell
France	:	Certificat d'utilité
Greece	:	Πιστοποιητικό υπεδειγματούχου χρησιμότητας
Ireland	:	Short-term patent
Italy	:	Brevetto per modelli di utilità
Netherlands	:	Zesjarig octrooi
Portugal	:	Modelo de utilidade

This form of protection is also very widespread outside the European Union (Argentina, Australia, Brazil, Korea, Chile, China, Hungary, Japan, Poland etc.). The United States, on the other hand, has no such system of protection.

2. ADVANTAGES AND DISADVANTAGES

2.1. Advantages

Utility models are generally acknowledged to have the following advantages:

2.1.1. *Quick, simple registration*

It takes on average 6 months to grant a utility model, compared with 2 to 4 years for a patent, because as a rule there is no prior examination of novelty or inventive step. This first of all allows an applicant to get quick protection against copies and imitations, and this protection serves to strengthen the competitive position of companies, including SMEs, and improve the availability of their products, especially capital goods and consumer goods, on the market. Rapid registration also allows speedy economic exploitation of the invention, in particular through the granting of licences.

2.1.2. Flexible conditions for obtaining protection

Whereas, an inventive step and absolute novelty are required in order to obtain a patent, most systems of protection by utility model demand a lesser degree of inventiveness than that needed for a patent and provide for restrictions on novelty (e.g. in Spain, where only the national state of the art is taken into account), so that the conditions for obtaining a utility model are more flexible and easier to meet. The fact that the degree of inventiveness required is less than for a patent constitutes a major reason for seeking protection by utility model, since it means that inventions can be covered that represent minor technological advances, which are important not only for SMEs but also for large companies.

2.1.3. Low cost

In contrast to a patent, the utility model does not involve any investigation of novelty or inventive step, which makes it less expensive. This advantage is particularly important for companies that need protection that is as complete as possible against copies and imitations and have to apply for a large number of utility models. The question of cost is also a decisive element in the case of inventions whose commercial success is uncertain. This is especially true for SMEs, which do not for the most part have sufficient market information to forecast a new products' chances of success, whereas large companies have planning and forecasting tools that allow them to limit the risk of failure.

2.1.4. Temporary protection pending the grant of a patent

When an invention is eligible for protection under both systems, the quick registration of utility models makes it possible to cover the relatively long period it takes to grant a patent with prior examination. This temporary protection is of particular use in Member States where patents are subject to a full examination of novelty and inventive step and the procedure for granting a patent is thus a fairly long process.

The economic importance of protection by utility model is not the same for all businesses but depends on what is in the interest of each company. The interests of SMEs lie mainly in the savings to be made in terms of cost, time and administrative burden. Moreover, because of their limited financial and human resources, these companies' research and development activities often lead to technical inventions involving only a minor inventive step which do not

necessarily meet the conditions for patent protection. It is mostly a question of technical improvements which, as they accumulate and interact, have just as great an impact on the technology used in the sector concerned as do inventions in the strict sense.

The utility model may also be used in certain industries where there is a constant need for innovation, particularly in the form of minor technical inventions. The main sectors concerned are machinery construction, the electrical industry, precision engineering and optics, the toy industry and motor vehicle construction.

2.2. Disadvantages

Certain interested parties expressed doubts as to the economic value of protection by utility model, particularly for SMEs. The main supposed disadvantages of protection by utility model can be summarised as follows:

2.2.1. Too much legal uncertainty resulting in major costs

Legal uncertainty, arising from the lack of any prior examination of the basic conditions, could be harmful to SMEs. When they make improvements to a product or process, SMEs could come up against a utility model granted without any examination to someone else, resulting in costly litigation or even the loss of the sums they have invested in the improvements in question. Consequently, there would have to be additional expenditure on monitoring utility models, besides the need to assess them as regards validity and counterfeiting.

2.2.2. Risk of the proliferation of unexamined rights

Europe would open up its market to its main competitors without any reciprocity, and would be in danger of being swamped by foreign applications to be granted a right that is not examined, the validity of which can be tested only through litigation and which can be granted to practically all new products in view of the very low level of inventiveness required to obtain protection.

2.2.3. Negative impact on the whole system of patents in Europe

The utility model could even have a negative impact on the patent system in Europe, because it would lower the threshold of protection and institute a parallel system that would be cheaper but poorer. In addition, in the long term that could lower the standards of protection in Europe, thereby devaluing years of effort to provide Europe with appropriate standards for the protection of intellectual property. Lastly, the position of European companies vis-à-vis their competitors, mainly in the United States and Japan, could be seriously affected, since non-European companies could find this form of protection interesting in order to occupy the field in the EU in the face of their local competitors. In this connection it should be pointed out that some 300 000 patent applications are filed on average each year in the United States and some 450 000 in Japan.

2.2.4. Harmful effects for SMEs

The advantages of the utility model would in principle benefit all companies, not just SMEs. In practice it is likely to be used, to the detriment of SMEs, by those who already operate in the single market and are familiar with the system of intellectual property, with the consequence that large (European, Japanese or American) companies would find it easier to protect their products with utility models and thus block access to the market for European SMEs.

It must be said that none of the disadvantages described above has been observed in the Member States where protection by utility model is in place. Furthermore, the vast majority of users of utility models are local users who generally have little interest in protection at EU level.

3. POSITION OF THE INTERESTED PARTIES IN 1995 CONCERNING THE COMMUNITY UTILITY MODEL

In the 1995 consultation, about a third of the replies to the Green Paper were in favour of a Regulation setting up a Community utility model. The majority of the replies rejected this possibility for the following reasons:

- a single right would be too costly; a Regulation setting up a Community utility model would have to be based on Article 308 of the EC Treaty, which implies unanimity in the Council; in that context it would be difficult to imagine a possible solution to the question of translations; if the utility model had to be translated, for example, into the 11 official languages, that would mean completely exorbitant costs in relation to the needs of industry for quick, flexible and cheap protection;
- a single right would not correspond to the real needs of industry, particularly in the field of minor inventions; protection by utility model is rarely sought in more than 3 to 5 Member States and never in the whole EU.

4. POSITION OF THE COMMISSION'S SERVICES ON A POSSIBLE COMMUNITY UTILITY MODEL

According to the Commission's services, if there is to be a Community utility model it should have the following principal features:

- protection by a Community utility model would be available for inventions of both products and processes (no requirement for defined or three-dimensional form);
- inventions eligible for protection by a Community utility model would be new, inventive and suitable for industrial application;
- the level of inventiveness required would be lower than for patents;
- novelty would be absolute (defined in relation to the state of the art at international level);
- an application for a Community utility model would be subject to only a formal verification, and the utility model would be granted without any prior examination of the conditions for obtaining protection with regard to novelty and inventive step;
- there would be no limit on the number of claims;

- a search report on the state of the art could be requested by the applicant or by third parties; the search report would be added to the file and would become compulsory in the event of legal proceedings;
- the rights conferred by a Community utility model would be identical to those conferred by a patent;
- the duration of protection would be limited to a non-renewable maximum of 10 years from the date of filing of the application;
- dual protection, allowing one and the same invention to form the subject-matter of a patent application and a utility model application, would be permitted, but in the event of dispute, successive proceedings under both sets of protection arrangements would not be allowed.

Finally, it has to be stated that the Community utility model would not replace national arrangements for the protection of utility models but, rather, would complement them.

5. QUESTIONNAIRE

In the light of the above considerations, the Commission would like to have the opinions and comments of the interested parties on the following questions:

1. *What, in your opinion, would be the impact, in your sector of activity or more generally, of the introduction of a Community utility model as described in point 4 on:*
 - *research and development activities and innovation,*
 - *competition within the European Union,*
 - *the European Union's competitiveness at world level?*

Where necessary, make a distinction according to the size of company (large companies or SMEs) and the sectors concerned.
2. *What, in your opinion, would be the effect of a Community utility model on legal certainty for your company and for the European Union in general?*
3. *If the system described in point 4 was set up, how many applications for utility models would you be likely to file per year?*

In your opinion, what would be the total number of applications filed each year in the European Union?
4. *Would the reply to question 3 be different if the registration for the Community utility model is made to a centralised office or to national patent offices? If so, please explain.*

In the same vein, would the reply to question 3 be dependant upon the procedures, including those related to the linguistic regime:

 - *to be applied for filing and processing utility model applications; and/or*
 - *governing the grounds for opposition by third parties to granted utility models.*

If yes, please explain.

5. *On the basis of your replies to the previous questions, would you be in favour of the introduction in the European Union of a Community utility model as described in point 4?*
6. *If your reply to the previous question was negative because of the features described in point 4, what changes would you suggest to make the system acceptable to you?*
7. *Have any new developments occurred since the Green Paper of 1995, which have led you to change your opinion on the Community utility model?*

Please explain, as appropriate.
8. *Do you have any further comments regarding the Community utility model? If so, please give details.*

6. TIMETABLE

This consultative document is being sent to the main interested parties. It will also be available on the website of the European Commission's Internal Market DG at the following address:

http://europa.eu.int/comm/internal_market/en/intprop/indprop/index.htm.

Replies to the questions must be sent to the European Commission's Directorate-General for the Internal Market, either by writing to the following address: **European Commission, DG Internal Market (MARKT/E/2), rue de la Loi, 200 (C100 5/109), B-1049 Bruxelles**, or by e-mail to MARKT E2@cec.eu.int.

All comments must reach the Commission by **30 November 2001** at the latest.

For any further information on this consultation, please contact Mr P. Ravillard (tel. +32-2/295.27.69; fax +32-2/299.31.04; e-mail patrick.ravillard@cec.eu.int).



COMMISSION OF THE EUROPEAN COMMUNITIES

Brussels, 12.07.1999
COM(1999) 309 final /2

97/0356 (COD)

CORRIGENDUM

***Le présent texte annule et
remplace intégralement celui du
COM (1999) 309 final du 25.06.1999.
Le présent corrigendum ne
concerne que la version anglaise.***

Amended proposal for a

EUROPEAN PARLIAMENT AND COUNCIL DIRECTIVE

**approximating the legal arrangements for the protection of inventions by utility
model**

(presented by the Commission in accordance with Article 250(2)
of the EC Treaty)

EXPLANATORY MEMORANDUM

GENERAL

On 12 December 1997, the Commission submitted to the European Parliament and the Council a proposal for a Directive approximating the legal arrangements for the protection of inventions by utility model.¹

The Economic and Social Committee adopted its opinion on 27 May 1998².

In its Opinion, adopted at first reading during the part-session from 8 to 12 March 1999, the European Parliament approved the Commission's proposal subject to 34 amendments³. Parliament did not question the Commission's approach and the main features of the utility model as described in the original proposal were retained, i.e. the level of inventiveness required is not as great as it is in the case of patents, the substantive conditions for protectability are not subject to a preliminary examination and the protection period is limited to 10 years.

Parliament proposes that the Directive should define utility models with reference to structures, mechanisms or configurations, thereby excluding processes and substances from the scope of the Directive. On the other hand, it proposes including inventions involving computer programs. Another important proposal in the Parliament Opinion concerns the inventive step, which need not be as great as that required for a patent, by analogy with the European Patent Convention. Parliament's opinion also contains proposals aimed at increasing the legal certainty of utility models by extending the right to request a search report on the state of the art to third parties and making such reports obligatory in some cases. Parliament also proposes introducing a "one-stop shopping procedure", whereby applicants would need to lodge an application in only one Member State, which would then be responsible for forwarding the application to the other Member States in which protection is required. It also proposes an opposition procedure so that disputes can be settled more quickly than if they were referred to the courts. Finally, Parliament proposes reducing the fees payable by small and medium-sized firms, individual inventors and universities by 50% and extending the grounds for revocation to cases in which the proprietor of the utility model was not entitled to it.

The aim of this amended proposal is to take account as far as possible of the amendments proposed by the European Parliament, most of which contribute towards clarifying the text of the original proposal.

The Commission was able to accept 25 amendments proposed by the European Parliament, 20 in their entirety (Nos 3, 4, 5, 7, 9, 11, 13, 14, 19, 20, 21, 22, 25, 27, 28, 29, 31, 32, 33, and 34) possibly with a few minor modifications of a technical nature, and five in part (Nos 2, 6, 8, 10, and 26). It was unable to accept nine of the proposed amendments (Nos 1, 12, 15, 16, 17, 18, 23, 24 and 30).

¹ OJ C 36 of 3.2.98, p. 13.

² OJ C 235 of 27.7.98, p. 26.

³ Not yet published.

The amendments proposing the introduction of a "one-stop shopping procedure" (Nos 1, 6 (in part) and 17) were rejected on the grounds that this would go beyond the scope of the Directive, which was aimed at aligning the national provisions on utility models that most directly affected the operation of the Single Market, since a procedure of this kind does not correspond to a need expressed by the economic operators concerned in connection with the consultation initiated with the Green Paper of 1995. Furthermore, the introduction of a procedure of this kind would give rise to legal and practical difficulties and would not solve the problem of translations, for example. The workload of the national offices resulting from the administration of such a procedure should also be borne in mind. The Commission could, however, as part of the monitoring of the Directive and in the light of experience, look into the possibility of introducing a procedure of this kind should the need become apparent.

Amendment 18 - for an opposition procedure - was rejected on the grounds that it too goes beyond the scope of the harmonisation that is the aim of this Directive. This is a procedural question that should be left to the Member States in accordance with the principle of proportionality. As in the case of "one-stop shopping", the possibility of a procedure of this kind could be examined in connection with the monitoring of the Directive.

Several other amendments were also rejected, including those directly or indirectly concerning the field of application of the Directive (Nos 2 (in part), 6 (in part), 8, 23, and 24). These amendments propose excluding substances or processes from the scope of the Directive. This is an outmoded approach, however. It emerged from the consultation in connection with the Green Paper of 1995 that the vast majority of the parties concerned were in favour of substances and processes being included in the scope of utility models. Moreover, the "three-dimensional" requirement underlying the exclusion of substances and processes was becoming a thing of the past in the legislation of the various Member States, only four of which nowadays apply it as a condition for the granting of protection by means of a utility model.

The amendment proposing that the fees payable by small and medium-sized firms, individual inventors and universities should be reduced by 50% (No 12) was also rejected on the grounds that, although it reflects concerns that are laudable, it has no place in a Directive on harmonisation since the financial implications for the Member States would go beyond the scope of the Directive. The underlying principle has, however, been expressed in one of the recitals.

Other amendments rejected by the Commission include No 15, which calls for additional preliminary checks, since this calls into question the principle of not examining the substantive conditions for protectability. The amendments specifying "a practical or technical advantage" as a new condition for the granting of protection were also rejected (Nos 6 (in part), 10 and 16). This would constitute a new requirement for obtaining protection, whereas the technical or practical advantage should rather be regarded as explaining the reasons for the inventive step.

Finally, Amendment 30, according to which the subject-matter of the utility model is not protectable if the proprietor of the utility model is not entitled to obtain it, was also rejected, since in this case the genuine inventor would definitively lose his right to the utility model as the invention could no longer be regarded as new. Revocation

is therefore not desirable; instead, transfer to the genuine inventor should be permissible.

EXAMINATION OF THE RECITALS

General

In order to facilitate reading of the modified proposal, each recital has been numbered. Three recitals have been modified in the light of Parliament's Opinion and a new one has been added (see table below).

Recitals	Amendments
6	12
13	2 (in part)
14	3
19 (new)	4

Specific

Recital 6 has been expanded to take account of Amendment 12 concerning the reduction of the fees payable by small and medium-sized firms, individual inventors and universities.

The change to Recital 13 corresponds to Amendment 2 (in part), taking account of the deletion of the phrase excluding inventions involving computer programs.

The change to Recital 14 corresponds to Amendment 3 concerning the extension to third parties of the right to request a search report.

The new Recital 19 corresponds to Amendment 4 concerning the monitoring of this Directive by the Commission three years after its implementation in the Member States.

EXAMINATION OF THE PROVISIONS

General

On the basis of the European Parliament's Opinion, 20 Articles or paragraphs have been modified and three new Articles inserted into the amended proposal. These concern other forms of protection (Article 22), subsidiary application (Article 26) and monitoring of the Directive (Article 28). Modifications of a technical nature have also been made to Articles 18(1) and 27(1). In order to facilitate reading of the amendments in conjunction with the Articles to which they refer, the following correspondence table has been drawn up:

Articles	Amendments
1	6 (in part)
3(1) (ex (2))	34
3(2) (new)	7
4	8 (in part)
5(3)	9
6	6 (in part) and 10
8(1)	11
13(2) (deleted)	14
16(1)	19
16(3)	20
16(4)	21
18(1)	-
19(2)	22
20(1)	26
20(2)	26
20(4)	25
20(7) (new)	26
22 (new)	5
23 (ex 22)(2)	27
23 (ex 22)(3)	28
25 (ex 24)(1(a))	29
25 (ex 24)(2)	31
26 (new)	32
27(1)	-
28	33

Specific

Article 1

The title "Definitions" has been replaced by "Definition" in order to take account of the changes made to the contents of the article.

Article 1(1)

This paragraph has been modified to take account (in part) of Parliament's Amendment 6. It incorporates the principle set out in Article 3(1) of the original proposal concerning protectable inventions, specifying that the inventions covered may relate to substances or processes. The Commission rejects the reference to "a configuration, structure or mechanism" on the grounds that this would exclude substances and processes. Similarly, the reference to a practical or technical advantage, or another benefit to the user, for example in the field of education or entertainment, has not been incorporated here but transferred to Article 6, as an explanation of the concept of "inventive step".

Article 1(2)

Article 1(2) partly corresponds to Article 1 of the original proposal, but, in accordance with Parliament's proposed Amendment 6, the list of national names has been included to help interpretation.

Article 3

The title has been changed, since the contents of the original first paragraph of this article have been transferred to Article 1(1), so that the new Article 3 refers only to exceptions.

Article 3(1)

The original first paragraph has been deleted in view of the new definition incorporated into Article 1. The new Article 3(1) therefore corresponds to the old Article 3(2). Parliament's Amendment 34, to the effect that games should be eligible for utility model protection if they meet the requirements, has been incorporated into point (c).

Article 3(2)

This new paragraph, which corresponds to Parliament's Amendment 7, is based on the corresponding provisions of the European Patent Convention (Article 52(3)). Its purpose is to exclude from utility model protection only those items referred to as such in the previous paragraph.

Article 4

The title of Article 4 has been amended to distinguish it from that of Article 3 and to make it more appropriate to the contents of this Article, which deals with inventions that may not be protected by utility models. The deletion of point (d) - inventions involving computer programs - corresponds to Parliament's Amendment 8 (part).

Inventions involving computer programs may therefore be protected by utility models provided they meet the requirements set out in the Directive.

Article 5

Article 5(3)

The purpose of this modification is to make it clear that the contents of patent applications, in accordance with Parliament's Amendment 9, are considered as comprised in the state of the art, and that previous applications must cover the same territory as the application for a utility model if they are to be considered as comprised in the state of the art.

Article 6

This Article is the result of a combination of Parliament's Amendments 6 and 10.

Article 6(1)

This paragraph incorporates the idea behind Parliament's Amendment 10 - that an invention involves an inventive step if, having regard to the state of the art, it is not very obvious to a person skilled in the art. This wording, based on the definition of an inventive step set out in Article 56 of the European Patent Convention, makes it possible to establish that an inventive step is an essential requirement for utility model protection. However, the use of the word "very" indicates that the inventive step is not as great as that required for a patent. Similar wording can be found in national legislation on utility models. This article also incorporates the idea embodied in Parliament's Amendment 6 to the effect that the invention must exhibit an advantage.

Article 6(2)

The second paragraph of Article 6 goes into the concept of "advantage" referred to in the previous paragraph in terms of the aspects mentioned in Parliament's Amendment 6, i.e. a practical or technical advantage for use or manufacture of the product or process in question, or another benefit to the user, for example in the field of education or entertainment. The "other benefit" mentioned here makes it possible for the directive to cover, in particular, games and toys.

Article 8

Article 8(1)

The addition of the word "only", which corresponds to Parliament's Amendment 11, makes it possible to strictly limit the items that an application for a utility model must contain.

Article 13

Article 13(2) (deleted)

The purpose of Article 13(2) in the original proposal was to limit the number of claims to what was strictly necessary in view of the nature of the invention.

According to the Parliament (Amendment 14), this wording was too subjective and would probably have given rise to discrepancies between national legislation on this matter. It thought that claims should preferably be covered by Article 25 (revocation).

Article 16

Article 16(1)

The purpose of the modification, which corresponds to Parliament's Amendment 19, is to extend the right to request a search report to any interested party at their own cost. This modification increases legal certainty.

Article 16(3)

The addition, which corresponds to Parliament's Amendment 20, stipulates that the report must be added to the file - in other words, be made available to the public as an integral part of the documentation accompanying the granting of the utility model. This increases transparency and legal certainty.

Article 16(4)

The changes correspond to Parliament's Amendment 21 and stipulate that the Member States are obliged, and no longer merely entitled, to make a search report compulsory in the event of legal proceedings, unless the utility model has already been the subject of a search report. These changes are also in line with the wishes of the Economic and Social Committee.

Article 18

The title has been changed to take account of the rewording of the first paragraph of this article.

Article 18(1)

The purpose of the modification is to specify that this provision concerns the right of priority within a Member State. It also expands the original proposals by introducing the possibility for the applicant to change his application for a patent into an application for a utility model.

Article 19

Article 19(2)

The addition, which corresponds to Parliament's Amendment 22, stipulates that renewal of a utility model, on expiry of the first period of six months, shall not be granted unless a request for a search report has been made in respect of the invention concerned. The idea is to increase legal certainty by preventing unexamined utility models from remaining in force for too long.

Article 20

Article 20(1)

The deletion of the word "registered", in line with Parliament's Amendment 26, must be considered in the light of the new Article 20(7), according to which the utility model shall take full effect at the time when the grant is published.

Article 20(2)

As in the previous paragraph, the deletion of the word "registered", in line with Parliament's Amendment 26, must be considered in the light of the new Article 20(7), according to which the utility model shall take full effect at the time when the grant is published.

Article 20(4)

The purpose of these changes is to expand the concept of transfer, in accordance with Parliament's Amendment 25, and similarly to permit the transfer of utility model applications.

Article 20(7) (new)

This new paragraph, which corresponds to Parliament's Amendment 26, specifies the time at which utility models shall take full effect. This new provision is important, since the original proposal contained no provisions on this question.

Article 22 (new)

The purpose of this new article, which incorporates Parliament's Amendment 5 - expanding it by means of a minor technical modification to cover the topography of semi-conductor products - is to specify the relationship between utility models and other forms of protection.

Article 23

Article 23(2)

The change, which corresponds to Parliament's Amendment 27, withdraws the option left open to the Member States in the original proposal. With the new wording, a utility model which has been granted is deemed to be ineffective where a patent relating to the same invention has been granted and published. This change is also in line with the wishes of the Economic and Social Committee.

Article 23(3)

The change, which corresponds to Parliament's Amendment 28, takes account of the changes to the previous paragraph.

Article 25

Article 25(1)(a)

The change, which corresponds to Parliament's Amendment 29, takes account of the new version of Article 1.

Article 25(2)

The change, which corresponds to Parliament's Amendment 31, stipulates that limitation of a utility model in the form of an amendment to the claims, the description or the drawings is possible only if the national law so allows.

Article 26 (new)

This new article, which incorporates Parliament's Amendment 32 by means of a few minor technical modifications, makes it possible for national legislation on patents to be applied in the absence of specific national provisions applicable to utility models. This allows for reference to be made to patent law for procedural aspects so as to avoid the need to create specific procedures.

Article 27

Article 27(1)

The change regarding transposal is based on existing provisions in other Directives.

Article 28 (new)

This new article, which incorporates Parliament's Amendment 32 by means of a few minor technical modifications, provides for monitoring of the Directive by the Commission, as provided for in other Directives in force in the field of industrial property rights.

Amended proposal for a

EUROPEAN PARLIAMENT AND COUNCIL DIRECTIVE

approximating the legal arrangements for the protection of inventions by utility model

(Text with EEA relevance)

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community and in particular Article 95 thereof,

Having regard to the proposal from the Commission,⁴

Having regard to the opinion of the Economic and Social Committee⁵,

Acting in accordance with the procedure laid down in Article 251 of the Treaty⁶,

- (1) Whereas the Treaty commits the Community and Member States to creating the conditions for Community industry to be competitive and to promoting a better exploitation of the industrial potential of innovation, research and technological development policies;
- (2) Whereas technical inventions play an important role in that they make available improved, better quality products which are particularly effective in terms of, for example, ease of application or use, or which confer a practical or industrial advantage compared with the state of the art;
- (3) Whereas, because of differences between Member States' utility model laws, an invention may not be protected throughout the Community, at least not in the same way or for the same length of time, a state of affairs which is incompatible with a transparent, obstacle-free single market; whereas it is therefore necessary, with a view to the establishment and proper functioning of the single market, to approximate Member States' laws in this area;
- (4) Whereas it is important in this context to employ every possible means of increasing the competitiveness of Community industry in the field of research and development;

⁴ OJ C 36 of 3.2.98, p. 13.

⁵ OJ C 235 of 27.7.98, p. 26.

⁶ European Parliament Opinion of 12 March 1999.

- (5) Whereas small and medium-sized firms play a strategic role in relation to innovation and rapid response to market requirements;
- (6) Whereas there is a need for placing at the disposal of firms, and in particular small and medium-sized firms and researchers, an instrument which is cheap, rapid and easy to evaluate and apply; *whereas the fees should therefore be as reasonable as possible for small firms, individual inventors and universities;*
- (7) Whereas utility model protection is better suited than patent protection to technical inventions involving a specific level of inventiveness;
- (8) Whereas technical inventions should be suitably protected throughout the Community;
- (9) Whereas, in accordance with the principle of proportionality, the approximation may be limited to those national provisions which have the most direct impact on the functioning of the single market;
- (10) Whereas, if the objectives of the approximation are to be attained, the conditions for obtaining and retaining the rights conferred by a registered utility model should in principle be the same in all Member States; whereas to that end an exhaustive list of the requirements which a technical invention must satisfy if it is to be protected by a utility model must be drawn up;
- (11) Whereas these requirements are for the most part the same as those for patent protection; whereas the level of inventiveness required must nevertheless be different to allow for the specific nature of technical inventions protectable by utility model;
- (12) Whereas utility model protection must be available both to products and to processes;
- (13) *Whereas it is necessary to exclude from utility model protection not only those inventions which are normally excluded from patentability but also, in order to meet the needs of the industries concerned, inventions relating to chemical or pharmaceutical substances or processes;*
- (14) *Whereas a utility model application must satisfy requirements similar to those for patents; whereas, however, a utility model application gives rise only to a check to ensure that the formal conditions for protectability are satisfied without any preliminary examination to establish novelty or inventive step; whereas it may form the subject-matter of a search report on the state of the art only at the request of the applicant or any other interested party;*
- (15) Whereas it is essential, in order to safeguard the proper functioning of the single market and ensure that competition is not distorted, that registered utility models should henceforth confer upon their proprietor the same protection in all Member States and that the period of protection should be identical; whereas this period may not exceed 10 years;
- (16) Whereas the nature and scope of the rights conferred by a utility model must be spelled out; whereas the principle of Community exhaustion of rights must

apply in accordance with the case-law of the Court of Justice of the European Communities, but the principle of international exhaustion must be expressly excluded;

(17) Whereas rules must also be laid down on dual protection by patent and by utility model, and on the lapse and revocation of utility models;

(18) Whereas all Member States of the Community are bound by the Paris Convention for the Protection of Industrial Property; whereas the Community and all Member States are bound by the Agreement on Trade-related Aspects of Intellectual Property Rights concluded under the auspices of the World Trade Organisation; whereas the provisions of this Directive must be in complete harmony with those of the Paris Convention and of the above-mentioned Agreement; whereas Member States' other obligations stemming from the Convention and the Agreement are not affected by this Directive,

(19) Whereas the application of this Directive should be monitored and it should be kept up to date in order to safeguard, in the context of utility models, the proper functioning of the internal market and innovation by Community enterprises; whereas the Commission should propose the measures necessary for this purpose, which should include specific steps to facilitate and reduce the cost of registering utility models in more than one Member State,

HAVE ADOPTED THIS DIRECTIVE:

CHAPTER ONE

GENERAL PROVISIONS

Article 1

Definition

1. In accordance with the provisions of this Directive, utility model protection shall be available for new inventions involving products or processes that involve an inventive step and are susceptible of industrial application.

2. The following names are used in the Member States:

Belgium: Brevet de courte durée/Octrooi van korte duur

Denmark: Brugsmode

Germany: Gebrauchsmuster

Greece: Πιστοποιητικό υποδειγματός χρησιμότητας

Spain: Modelo de utilidad

France:	Certificat d'utilité
Ireland:	Short-term patent
Italy:	Brevetto per modelli di utilità
Netherlands:	Zesjarig octrooi
Austria:	Gebrauchsmuster
Portugal:	Modelo de utilidade
Finland:	Nyttighetsmodellagen

Article 2

Subject

This Directive seeks to approximate Member States' laws, regulations and administrative provisions on the protection of inventions by utility model.

CHAPTER II

SCOPE OF THE UTILITY MODEL

Article 3

Exceptions to protection

1. The following in particular shall not be regarded as inventions that are eligible for utility model protection:
 - (a) discoveries, scientific theories and mathematical methods;
 - (b) aesthetic creations;
 - (c) schemes, rules and methods for performing mental acts or doing business;
 - (d) presentations of information.
2. The items referred to in paragraph 1, shall be excluded from utility model protection only to the extent that the application for utility model protection relates to those items as such.

Article 4

Non-protectable inventions

Utility models shall not be granted in respect of:

- (a) inventions the exploitation of which would be contrary to public policy or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all Member States;
- (b) inventions relating to biological material;
- (c) inventions relating to chemical or pharmaceutical substances or processes;

Article 5

Novelty

1. An invention shall be considered to be new if it does not form part of the state of the art.
2. The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the utility model application.
3. Additionally, the content of utility model and patent applications as filed in the Member State concerned or which designate that Member State, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.

Article 6

Inventive step

1. For the purposes of this Directive, an invention shall be considered as involving an inventive step if it exhibits an advantage and, having regard to the state of the art, is not very obvious to a person skilled in the art.
2. The advantage referred to in the previous paragraph must be a practical or technical advantage for the use or manufacture of the product or process in question, or another benefit to the user, for example in the field of education or entertainment.

Article 7

Industrial application

1. An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.
2. Surgical or therapeutic treatment procedures applicable to the human body or to the bodies of animals and diagnostic procedures which are carried out on the human body or the bodies of animals shall not be considered to be

inventions susceptible of industrial application within the meaning of paragraph 1.

CHAPTER III

UTILITY MODEL APPLICATIONS

Article 8

Requirements of the application

1. A utility model application shall contain only:

- (a) a request for the grant of a utility model;
- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract.

2. A utility model application shall be subject to the payment of a filing fee and, where appropriate, a search fee.

Article 9

Date of filing

The date of filing of a utility model application shall be the date on which documents filed by the applicant contain:

- (a) an indication that a utility model is sought;
- (b) information identifying the applicant;
- (c) a description and one or more claims.

Article 10

Designation of the inventor

The utility model application shall designate the inventor. If the applicant is not the inventor or is not the sole inventor, the designation shall contain a statement indicating the origin of the right to the utility model.

Article 11

Unity of invention

The utility model application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Article 12

Disclosure of the invention

The utility model application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Article 13

The claims

The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

Article 14

The abstract

The abstract shall merely serve for use as technical information. It may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought nor for the purpose of applying Article 5(3).

Article 15

Examination as to formal requirements

1. The competent authority with which a utility model application has been lodged shall examine whether the application satisfies the formal requirements of Articles 8 and 10 and shall check whether it contains a description and an abstract.
2. If a date of filing cannot be accorded, the competent authority shall give the applicant an opportunity to correct the deficiencies in accordance with such conditions and within such period as it may fix. If the deficiencies are not remedied in due time, the application shall not be dealt with as a utility model application.
3. The competent authority referred to in paragraph 1 shall not carry out any examination to establish whether the requirements of Articles 5, 6 and 7 have been met.

Article 16

Search report

1. If a utility model application has been accorded a date of filing and is not deemed to have been withdrawn, the competent authority with which the application has been lodged shall, at the request of the applicant or any other interested party and at their own cost, draw up on the basis of the claims a

search report covering the relevant state of the art, with due regard to the description and any drawings.

2. The competent authority with which the application has been lodged may entrust the task of drawing up the search report to any authority which it considers competent to do so.
3. Immediately after it has been drawn up, the search report shall be transmitted to the applicant together with copies of any cited documents. The search report shall be made available to the public as part of the documentation accompanying the granting of the utility model.
4. In the provisions which they adopt in order to comply with this Directive, Member States shall provide that a search report is compulsory in the event of legal proceedings being brought to enforce the rights conferred by the utility model, unless it has already been the subject of a previous search report.

Article 17

Priority right

1. Any person who has duly filed an application for a utility model or a patent in or for one of the Member States, such State being a party to the Paris Convention for the Protection of Industrial Property, or his successors in title, shall enjoy, for the purpose of filing a utility model application in respect of the same invention in one or more other Member States a right of priority during a period of twelve months from the date of filing of the first application.
2. Any filing that is equivalent to a regular national filing under the domestic law of the Member State where it was made or under bilateral or multilateral agreements shall be recognised as giving rise to a right of priority.
3. By a regular national filing is meant any filing that is sufficient to establish the date on which the application was filed in the Member State concerned, whatever may be the outcome of the application.

Article 18

Internal priority and transformation

1. Any person who has duly filed a patent application in a Member State shall enjoy a right of priority during a period of twelve months for the purpose of filing a utility model application or changing his patent application into an application for a utility model in the same Member State in respect of the same invention, unless priority has already been claimed for the patent application.
2. The provisions of Article 17(2) and (3) shall apply *mutatis mutandis*.

CHAPTER IV

EFFECTS OF THE UTILITY MODEL

Article 19

Duration of protection

1. The duration of the utility model shall be six years from the date of filing of the application.
2. Six months before the period indicated in paragraph 1 elapses, the right-holder may submit to the competent authority an application for renewal of the utility model for a period of two years. This renewal shall not be granted unless a request for a search report has been made in respect of the invention concerned.
3. Six months before the period indicated in paragraph 2 elapses, the right-holder may submit a second and last application for renewal for a maximum period of two years.
4. In no circumstances may utility model protection last for more than ten years from the date of filing of the application.

Article 20

Rights conferred

1. Where the subject-matter of a utility model is a product, the utility model shall confer on its proprietor the right to prevent third parties not having his consent from making, using, offering for sale, selling, or importing for these purposes that product.
2. Where the subject-matter of a utility model is a process, the utility model shall confer on its proprietor the right to prevent third parties not having his consent from using the process and from using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.
3. The rights conferred by a utility model in accordance with paragraphs 1 and 2 shall not extend to:
 - (a) acts done privately and for non-commercial purposes;
 - (b) acts done for experimental purposes relating to the subject-matter of the protected invention.
4. The proprietor of or applicant for a utility model shall have the right to assign, or transfer, the utility model or application by any legally recognised means and to conclude licensing agreements.

5. Member States may provide limited exceptions to the exclusive rights conferred by a utility model, provided that such exceptions do not unreasonably conflict with a normal exploitation of the utility model and do not unreasonably prejudice the legitimate interests of the proprietor of the utility model, taking account of the interests of third parties.
6. Where the law of a Member State allows for use of the subject-matter of a utility model other than that allowed under paragraph 5 without the authorisation of the right-holder, including use by the government or third parties authorised by the government, the provisions applicable to patents for similar use shall be complied with.
7. The right conferred by the utility model shall take full effect at the time when the grant is published.

Article 21

Community exhaustion of rights

1. The rights conferred by a utility model shall not extend to acts concerning a product covered by that utility model which are done after that product has been put on the market in the Community by the right-holder or with his consent.
2. The rights conferred by a utility model shall, however, extend to acts concerning a product covered by that utility model which are done after that product has been put on the market outside the Community by the right-holder or with his consent.

Article 22

Relationship with other forms of protection

The provisions of this Directive shall be without prejudice to any provisions of Community law or of the law of the Member State concerned relating to design rights, other distinctive signs, copyright, patents, typefaces, topography of semi-conductor products, civil liability or unfair competition.

CHAPTER V

DUAL PROTECTION, LAPSE AND REVOCATION

Article 23

Dual protection

1. The same invention may form the subject-matter, simultaneously or successively, of a patent application and a utility model application.
2. A utility model which has been granted shall be deemed to be ineffective where a patent relating to the same invention has been granted and published.

3. Member States shall take appropriate measures to prevent the proprietor, in the event of his rights being infringed, from instituting successive proceedings under both protection regimes.

Article 24

Lapse

A utility model shall lapse:

- (a) at the end of the period laid down in Article 19;
- (b) if its proprietor surrenders it;
- (c) if the fees referred to in Article 8(2) have not been paid in due time.

Article 25

Revocation

1. An application for revocation of a utility model may be filed only on the grounds that:
 - (a) the subject-matter of the utility model is not protectable pursuant to Articles 1(1) and 3 to 7 of this Directive;
 - (b) the utility model does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
 - (c) the subject-matter of the utility model extends beyond the content of the utility model application as filed;
 - (d) the protection conferred by the utility model has been extended.
2. If the grounds for revocation affect the utility model only partially, revocation shall be pronounced in the form of a corresponding limitation of the utility model. If the national law permits, the limitation may be effected in the form of an amendment to the claims, the description or the drawings.

Article 26

Secondary application

In the absence of specific provisions applicable to utility models, these shall be governed, mutatis mutandis, by the provisions laid down for patents for invention provided they are not incompatible with the specific characteristics of utility models.

CHAPTER VI

FINAL PROVISIONS

Article 27

Transposal

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive not later than two years after the date of its publication in the Official Journal of the European Communities. They shall immediately inform the Commission thereof.

When Member States adopt these provisions, these shall contain a reference to this Directive or shall be accompanied by such reference at the time of their official publication. The procedure for such reference shall be adopted by the Member States.

2. Member States shall inform the Commission of the main provisions of national law which they adopt in the field governed by this Directive.

Article 28

Monitoring of the Directive

Within three years of the deadline for transposal laid down in Article 27, the Commission shall inform the European Parliament and the Council of the results of the application of the Directive and whether it should be adapted in order to safeguard, in the context of utility models, the proper functioning of the internal market and innovation by Community undertakings. It shall also propose any measures it deems necessary to improve it.

Article 29

Entry into force

This Directive shall enter into force on the twentieth day following that of its publication in the Official Journal of the European Communities.

Article 30

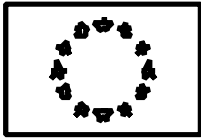
Addressees

This Directive is addressed to the Member States.

Done at Brussels,

For the European Parliament
The President

For the Council
The President



COMMISSION OF THE EUROPEAN COMMUNITIES

Proposal for a

EUROPEAN PARLIAMENT AND COUNCIL DIRECTIVE

approximating the legal arrangements for the protection of inventions by utility model

(presented by the Commission)

EXPLANATORY MEMORANDUM

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EXPLANATORY MEMORANDUM

INTRODUCTION

- 1 A utility model is a registered right which confers exclusive protection for a technical invention. It resembles a patent in that the invention must be new it must possess “novelty” and must display a measure of inventive achievement it must involve an “inventive step”, though generally the level of inventiveness required is not as great as it is in the case of patents. Unlike patents, utility models are granted as a rule without a preliminary examination to establish novelty and inventive step. This means that protection can be obtained more rapidly and cheaply, but that the protection conferred is less secure.
- 2 In July 1995 the Commission presented a Green Paper on the protection of utility models in the single market.¹ The purpose of the Green Paper was to stimulate a wideranging debate on the need for Community action in this area given the impact which differences between national laws have on the smooth functioning of the single market, and to propose various options from which the Commission might choose in the light of the comments made.
- 3 Community action in this field would first of all make it possible to make the free movement of goods resulting from minor technical inventions in the Community more transparent and prevent differences between national laws or the lack of such laws from causing distortions of competition. Secondly, such action would improve the legal environment for Community firms, engaged as they are in an ongoing process of innovation and adaptation, and thus enhance their competitiveness in the world market through the protection of their inventions by utility model a device particularly attuned to serving the needs of small and mediumsized enterprises (SMEs).
- 4 This initiative is one of the measures envisaged in the first action plan for innovation in Europe, which was presented by the Commission in November 1996² with a view to establishing a framework favourable to innovation. It is stated in that action plan that the Commission will decide in the light of comments on its Green Paper on utility models whether to propose Community legislation in this field.
- 5 All the interested circles have played an active part in the debate. Nearly 90 contributions have been sent in response to the Green Paper, a sign of how

¹ Document COM(95) 370 final of 19 July 1995.

² “Innovation for growth and employment”, Document COM(96) 589 final of 20 November 1996, point 2.6.

important this issue is to all concerned. The European Parliament and the Economic and Social Committee have also made known their views on the subject. Hearings have been held by the Commission, including one attended by European trade associations on 23 September 1996 and another attended by Member States' experts on 4 November 1996, to assess the need for a Community initiative on utility models and to identify the content of such an initiative.

- 1 The exercise has revealed a real need for the protection of inventions by utility model in the Community, especially in certain industries (e.g. toy manufacture, clock and watchmaking, optics, microtechnology and micromechanics) and on the part of SMEs, patent protection being unsuited to certain types of invention such as minor technical inventions.
- 2 The majority of business circles concerned have come out in favour of a Community initiative in this field consisting in a harmonisation of national laws, including the introduction of a system of utility model protection in those Member States where there is none.

PART ONE: BRINGING ABOUT A SINGLE MARKET IN THE PROTECTION OF INVENTIONS BY UTILITY MODEL

A. HARMONISING NATIONAL RULES ON UTILITY MODEL PROTECTION

- 1 The primary objective of this proposal is to harmonise at Community level the effective protection afforded to technical inventions by national laws and in so doing to ensure the smooth functioning of the single market. Such inventions are currently covered by different protection rules where indeed such rules exist from one Member State of the Community to another.
- 2 These differences between protection arrangements, including the lack of any protection in some Member States, may discourage an inventor or a small firm from seeking protection in other Member States. The table below shows, for the period 1987/90 and for a few selected Member States, the average annual number of utility model applications from residents in the home country compared with the number of applications from other EC countries.³

	Applications from residents	Applications from nonresidents
Germany	13 608	1 494
Belgium	177	73
Spain	3 519	394
Greece	269	57
Portugal	56	45

(Source: Industrial Property Statistics, publications A and B, WIPO, and Belgian Patent Office)

According to a survey of businesses and independent inventors carried out as part of a general survey by the Ifo Institute of the economic impact of utility

³ There are no data on Greece for 1987, the utility model having been introduced in that country that year by Law No 1733/1987.

model protection in the European Union,⁴ the fact that the number of applications from other Member States is so small is due to the difficulties standing in the way of

⁴ Survey by the Ifo Institute of the economic impact of utility model protection in the European Union, Munich, May 1994.

crossborder applications. The differences between laws are so many administrative hurdles to be cleared by applicants, with difficulty in the case of independent inventors and SMEs, and they thus hamper industrial innovation and the completion of the single market.

- 1 Harmonisation will make it possible for equivalent national systems of utility model protection to coexist. A person applying for a utility model will be assured of finding an equivalent property right in the other Member States and will no longer come up against different sets of rules. If he seeks protection in another Member State, he will know what its scope is and what essential requirements have to be met in order to qualify for such protection. Harmonisation will also make it possible to reduce costs and simplify applications for protection in other Member States.
- 2 The approximation of national laws must necessarily include substantive provisions defining the scope of the present proposal and governing the matter for which protection is sought, the conditions with which applications must comply, the extent and duration of the protection, the exhaustion of rights and the grounds for lapse and revocation. The approximation of these provisions will help to reduce the number of conflicts and the resulting damage to the single market.

B. INTRODUCING RULES ON UTILITY MODEL PROTECTION IN THOSE COUNTRIES WHERE THERE ARE NONE

- 1 The approximation of the laws of the Member States of the Community will oblige those Member States which have no system of protection of inventions by utility model to endow themselves with this form of protection. This will be the case with the United Kingdom, Luxembourg and Sweden.
- 2 A survey of British firms and independent inventors carried out as part of the Ifo Institute's general survey referred to above has revealed the existence of a marked economic interest, especially among SMEs, in this new form of protection, supplementing as it does patent protection.

C. FACILITATING THE FREE MOVEMENT OF GOODS

- 1 Article 3(c) of the EC Treaty provides that the activities of the Community are to include an internal (i.e. single) market characterised by the abolition, as between Member States, of obstacles to, among other things, the free movement of goods. Article 7a of the Treaty provides that the internal market is to comprise an area without internal frontiers in which the free movement of goods is ensured. The national systems for the protection of inventions by utility model produce effects, however, which are entirely confined to the territory of the Member State in respect of which the protection is granted.

- 2 The utility model is a right which forms part of the protection of industrial and commercial property as referred to in Article 36 of the EC Treaty. The Court of Justice of the European Communities has had occasion to interpret Articles 30 and 36 of the EC Treaty in the light of the free movement of goods and has held that, whilst the Treaty does not affect the existence of rights recognised by the legislation of a Member State in matters of industrial and commercial property, the exercise of these rights may nevertheless, depending on the circumstances, be affected by the prohibitions in the Treaty, since derogations from the free movement of goods are admitted of only to the extent that they are justified for the purpose of safeguarding rights which constitute the specific subjectmatter of such property.⁵
- 3 Most Member States have their own system for the protection of inventions by utility model. Others, such as the United Kingdom, Luxembourg and Sweden, have decided to do without utility model protection altogether. These differences between systems of protection are outside the control of the rightholder and force him to avoid markets in which he cannot obtain equivalent protection for his invention.
- 4 The differences between national systems of protection make it more difficult, moreover, to obtain crossborder protection for inventions in the single market. According to a survey of firms and independent inventors carried out as part of the abovementioned general survey by the Ifo Institute, 50% on average of all firms questioned have experienced serious or some difficulties with crossborder applications for utility models in the single market, while 32% fell into the “don’t knows” category, so great are the differences between the various systems.

The extent of protection varies considerably from one national system to another, and an invention which qualifies for protection in one Member State may not qualify, at least not on the same terms, in another. This is the case, for example, with the inventive step, the level of inventiveness required in order that an invention might qualify for utility model protection. Some Member States (e.g. Belgium and France) require the same inventive step as for a patent, while others (Greece, Italy and Spain) are willing to accept a smaller inventive step. But even within those Member States in which a smaller inventive step is acceptable, “smaller” may be interpreted in many different ways. The condition as to novelty likewise does not have the same scope in all Member States. In Spain, for example, novelty is determined by reference to

⁵ See, for example, Case 192/73 *Van Zuylen Frères v Hag AG* [03.07.1974] ECR 731, and Case 15/74 *Centrafarm v Sterling Drug* [31.10.1974] ECR 1147.

the domestic state of the art, while in the other Member States the criterion adopted is that of the international state of the art, albeit with restrictions in some cases (Germany and Portugal).

The same applies to the duration, or term, of protection. This may be six years (e.g. Belgium and France), seven years (Greece), eight years (Finland), ten years (e.g. Austria, Denmark and Germany) or more (e.g. in Portugal, where the term is renewable indefinitely). This means that an invention may no longer be protected in one Member State, whereas in another it continues to enjoy protection for a longer period.

Procedure, including the application procedure, also differs from one Member State to another. In some cases, a preliminary examination is carried out to check for novelty and inventive step (Belgium and France), while in most other cases the only check that is carried out is one to ensure that the formal conditions for protectability are satisfied. All this uncertainty acts as a brake on the free movement of goods in the single market.

- 1 The differences which exist between national protection systems thus have an indirect effect on trade between Member States and on firms' capacity to treat the single market as just that, a single setting in which to do business. This state of affairs leads to a lack of transparency, and it does nothing to make the movement of goods any freer.

D. AVOIDING DISTORTIONS OF COMPETITION IN THE SINGLE MARKET

- 1 Article 3(g) of the EC Treaty calls for the establishment of a system ensuring that competition in the internal market is not distorted. This objective ties in with the phrase in Article 2 which requires "a harmonious and balanced development of economic activities" throughout the Community. If businesses are to take advantage of the fundamental freedoms laid down in the Treaty, the intellectual property rules must allow fair competition between them.
- 2 For businesses, and in particular for independent inventors and SMEs, the differences which exist at present between national protection systems and the consequent need for legal or expert advice are a source of administrative difficulty and a major cost factor. This restricts innovative activity on the part of businesses, isolates them and distorts competition. It may well be that businesses define their commercial policy in Member States' domestic markets on the basis of the protection their products are

afforded there. From the consumer's point of view, it follows that the products resulting from technical inventions may not be available throughout the Community.

The differences mentioned in point 16 also have a direct impact on competition in the single market.

- 1 In those Member States which require the same inventive step for a utility model as for a patent, adequate protection is unavailable for inventions incorporating only a small inventive step with the result that products may be copied or imitated with impunity. The position is even worse in those Member States where there is no utility model protection.
- 2 Copies and imitations are as a rule cheaper to make than the originals on which they are based. In those Member States in which the level of protection is low or nonexistent, a copy or an imitation may therefore have a bigger share of the market than the original. And in those countries where there is a high level of protection, it may well be that, as the single market becomes more and more integrated, counterfeit goods may be imported more easily.
- 3 This state of affairs is incompatible with the Community's objective of shielding the rights stemming from the creative efforts of European researchers and inventors and the substantial investment carried out by European businesses in this area from infringement by third parties. It, too, distorts competition. To restore the balance, businesses operating in the single market must be assured of a level playing field.

E. THE NEED FOR ACTION AT COMMUNITY LEVEL

- 1 There is a need among business circles, and especially among certain sectors of industry and SMEs, for protection at Community level of technical inventions by utility model. This need cannot be satisfied by action taken solely at the level of each Member State. Harmonisation of Member States' laws at Community level is therefore necessary. This will make it possible for one and the same invention to be protected in an identical manner throughout the Community.
- 2 In accordance with the principle of proportionality laid down in Article 3b of the EC Treaty, however, the measures envisaged must be proportionate to the primary objective pursued, namely that of making the functioning of the single market more transparent. The harmonisation of national laws, including the introduction of a

system of protection in those Member States where none yet exists, will therefore not have to cover every aspect of national laws affording inventions protection by utility model, but instead will have to be confined to approximating those essential provisions which have the most direct impact on the functioning of the single market.

- 1 The aim is not therefore to create, at Community level, a Community right to utility model protection which would make it possible to obtain protection for one and the same territory covering all Member States through a single application to a common office in accordance with a single procedure and a single law. Nor is the aim to introduce mutual recognition of national systems whereby a utility model registered in one Member State can produce effects in the other Member States if the applicant so requests. Both these approaches aroused only limited interest on the part of the sectors of business and industry concerned in the course of the consultation exercise set in train by the Commission with the Green Paper.

PART TWO: ECONOMIC NEEDS IN THE LIGHT OF THE COMMUNITY OBJECTIVES

A. THE ECONOMIC SIGNIFICANCE OF UTILITY MODEL PROTECTION

1. Utilisation of the utility model in the Community and the reasons therefor

- 1 The rate of utilisation of the utility model in the Community is a good instrument for measuring its economic significance to businesses. As far as national applications for protection are concerned, the number of applications in those countries which have a system of protection requiring a small inventive step is higher than in those countries which require the same inventive step as for a patent (e.g. 12 000 annual applications on average in Germany compared with only a few hundred a year in France). As far as crossborder applications are concerned, their number is very small owing to the difficulties caused by the heterogeneous nature of the various utility model systems in the Community.
- 2 As regards possible trends in the behaviour of applicants for utility models in the Community, a survey of patent agents carried out as part of the abovementioned general survey by the Ifo Institute has shown that an increase in applications for protection is likely in the event of the law in force being fundamentally changed. Simplification of the conditions for obtaining protection would lead in particular to more frequent recourse to the utility model irrespective of the size of the business concerned.

The sounding of opinions among the business community carried out by the Commission on the basis of the Green Paper has revealed, moreover, that there is a real economic need for the protection of technical inventions by utility model, especially on the part of SMEs and in certain industries (e.g. toy manufacture, clock and watchmaking, etc.).

- 1 The reasons given for seeking utility model protection, these being the features of this form of protection, are as follows:
 - quick, simple registration: an applicant has to wait an average of six months for a utility model compared with anything from two to four years for a patent, because as a rule no examination has to be carried out to establish novelty and inventive step. This enables, firstly, the applicant to be protected within a short space of time against copies and imitations, thereby consolidating the competitive position

of businesses, in particular SMEs, and helping to improve the quality of their products, especially capital and consumer goods, through marketing. Secondly, rapid registration may lead to rapid commercialisation of the invention, whether under licence or by the applicant himself.

- Flexible conditions for obtaining protection: whereas in the case of a patent the invention must involve an inventive step and be absolutely new, most utility model systems require a different level of inventiveness and less than absolute novelty (e.g. in Spain, where only the domestic state of the art is taken into account), with the result that the requirements for obtaining a utility model are more flexible and less stringent. The lower inventive step requirement is an important reason for seeking utility model protection as this makes it possible to cover inventions representing small technological advances, these being important not only to SMEs but also to large firms.
- Low cost: unlike patents, utility models are granted without any preliminary examination to establish novelty and inventive step. This makes them cheaper to obtain than patents. This is especially important to firms seeking to protect themselves as comprehensively as possible against the danger of copying and imitation, as they have to apply for a large number of utility models. Cost is also a decisive factor in the case of inventions the commercial success of which is uncertain. This is especially true in the case of SMEs, which tend not to have enough information on markets to be able to gauge the sales prospects of new products, whereas big companies can make use of tried and tested planning and forecasting machinery to help them limit the risk of failure.
- Temporary protection pending the grant of a patent: rapid registration means that a utility model can be used to bridge the relatively long period which passes before a patent, involving as it may a preliminary examination, is granted, always supposing that the invention qualifies for both forms of protection. Temporary protection is useful mainly in countries where a comprehensive examination is carried out in order to establish novelty and inventive step before a patent is granted and where the procedure is therefore fairly long.

2. The significance of utility models compared with patents

- 1 The significance of national systems of protection by utility model as compared with protection by patent depends primarily on the way the system is designed. A comparison of figures for applications for national patents (not registered with the European Patent Office), European patents and utility models in four Member States of the Community for the period 1987-91, except in the case of Italy where the only figures available were those for the period 1987-89 concerning applications for national patents and utility models (see table below), shows that, in those countries where the inventive step required for a utility model is smaller than what is needed for a patent (e.g. Germany, Italy and Spain), the number of applications for utility model protection is greater than in those countries where the inventive step requirement is the same as that for a patent (e.g. France).

Number of applications for patents/utility models by country selected	Applications for national patents	Applications for European patents	Applications for utility models
Germany	88 271	55 672	61 057
Spain	7 306	1 017	17 260
France	31 209	22 350	1 771
Italy	10 369	9 927	10 890

(Source: European Patent Office, Epidos/Inpadoc, position at 9.7.1993; Ifo patent statistics; and Ifo Institute Calculations)

- 1 This state of affairs is due to the fact that, in the systems where the inventive step looked for is smaller, the requirements which must be satisfied in order to qualify for protection are lower. Each of the two types of right therefore has its own *raison d'être*.
- 2 Utility model systems with the same requirements as patents have less appeal because they are in competition with patents, which many applicants prefer because of their greater security.

3. The significance of utility model protection by reference to the size of the firm or industry

- 1 Utility model protection is not equally important to all firms: it depends where the

firm's interests lie. A study carried out in Germany,⁶ but whose findings are applicable to all Member States of the Community, has shown that, while large firms with a turnover in excess of ECU 1.25 billion are interested in the utility model, there is higher demand for utility models among firms with an annual turnover of less than ECU 5 million. The interest shown by SMEs⁷ is due primarily to the savings in terms of cost, time and administration.

- 1 Owing to their limited financial and human resources, such firms' research and development activities often result in technical inventions involving a small inventive step which do not necessarily satisfy the requirements for patent protection. More often than not the inventions amount to technical improvements which, by their number and interaction, have just as big an impact as inventions proper on the technology used in the sector concerned.
- 2 According to studies⁸ carried out on the basis of utility model applications in the Community, the utility model is used in a number of industrial sectors in which there is a permanent need for innovation, especially in the form of minor technical inventions. The main sectors concerned are mechanical engineering, electrical engineering, precision instruments and optics and the automotive industry.

B. ENHANCING THE COMPETITIVENESS OF FIRMS AND PROMOTING RESEARCH AND DEVELOPMENT

1. The utility model and the competitiveness of firms

- 1 Clearly, a sustained inventive activity places firms at an advantage technologically and is an important factor from the point of view of their competitiveness. For a number of years now, the competitiveness of firms has been at the forefront of European policy. The capacity to innovate as a catalyst of competitiveness has

⁶ Study of the problems of the German patent system in relation to the innovative activities of industry, carried out in 1989 by the Ifo Institute for the Federal Ministry of Economic Affairs.

⁷ Commission Recommendation No 96/280/EC of 3 April 1996 concerning the definition of small and medium-sized enterprises defines SMEs as being enterprises which have fewer than 250 employees and have either an annual turnover not exceeding ECU 40 million or an annual balance sheet total not exceeding ECU 27 million, and which are not owned as to 25% or more of the capital or the voting rights by one enterprise or jointly by several enterprises falling outside the definition of an SME or a small enterprise (OJ No L 107, 30 April 1996).

⁸ European Patent Office, Vienna Suboffice, position at 8 January 1993, and survey of firms in Denmark, *AIPPI Yearbook* 1986, 14.

formed an integral part of European industrial policy since the early 1990s.⁹

- 1 Looked at from this point of view, owing to the features which distinguish it from the patent, such as the speed and simplicity of filing applications for protection, the utility model is an independent instrument of competitiveness at the service of firms, in particular SMEs, helping to safeguard or improve their market position and facilitate the economic and commercial exploitation of technical inventions.
- 2 The vast majority of industrial firms and independent inventors have indicated, in response to a survey carried out in a number of selected Member States as part of the abovementioned general survey by the Ifo Institute, that, among the positive effects of the utility model, an improved market position clearly occupies pride of place irrespective of company size. Business people are aware that they can hold on to a competitive lead only if they are able to keep their competitors from copying or imitating them for a certain time through effective legal protection measures such as the utility model.

Through their innovations in products and processes, they seek to display originality and to distance themselves from the competition, so that customers develop a positive image of their technological capability. The protection of inventions by utility model may thus help to strengthen the competitive position of European businesses in the world market.

2. Innovation

- 1 Innovation,¹⁰ in the sense of a number of technical improvements, is vital to industrial enterprises. Firms must constantly improve or renew their products if they are to keep or increase market shares. The development of new products improves firms' competitiveness regardless of the industrial sector concerned. The innovative activity of the European Community is not at present exploited sufficiently compared with that of its main trading partners, the United States and Japan. In the European Community, the share of GDP devoted to research, industry's research expenditure,

⁹ See e.g. Commission Communication to the Council and the European Parliament of 16 November 1990 on industrial policy, document COM(90) 556 final.

¹⁰ See the Commission's Green Paper on innovation, document COM(95) 688 final.

research expenditure per head of population, and the total number of research workers compared with the active population are lower than in Japan and the US.

The protection of inventions by utility model is a significant means of promoting technical innovation within European firms. As the European Parliament has stated:¹¹ “Legal protection of industrial property promotes innovative activity in the EU. It is important to ease the way from idea to product”.

- 1 While large firms do not consider that inventive activities can be developed much further beyond the mere renewal of products and that product life cycles cannot be shortened, SMEs, on the other hand, acknowledge that they must step up their inventive activities if they are to face up to the stiffer competition. Utility model protection therefore seems suited to small technological advances with a relatively short lifetime which are likely to develop in future. SMEs, which account for more than 99% of all European firms, 66% of all jobs and 65% of turnover in the European Community, will be the first to benefit.

¹¹ Report on the Green Paper presented by the Commission on the protection of utility models in the single market, document EP 214.304/def. of 26 June 1996.

PART THREE: THE INTERESTS AT STAKE AND FORESEEABLE TRENDS

A. THE POSITION WITH REGARD TO INDUSTRIAL COMPANIES AND INDEPENDENT INVENTORS

1 In a survey carried out in 1993 in five Member States of the Community, companies and independent inventors showed considerable interest in a specific form of protection for their minor technical inventions supplementing patent protection but subject to less stringent conditions, involving no preliminary examination and being less costly and of shorter duration (see table below).

Interest in utility model protection (as a percentage of the replies received)				
	Considerable	Moderate	Little	Don't know
By selected Member State				
Germany	46	30	16	8
Spain	41	25	12	22
France	22	51	13	13
Italy	26	42	19	13
United Kingdom	32	25	34	9
By size of firm				
Up to 100 employees	41	34	12	13
101 - 500 employees	48	28	17	7

501 - 1 000 employees	29	37	24	10
Over 1 000 employees	27	32	38	3
All classes	39	32	20	9

(Source: Ifo Institute survey in selected EU countries in 1993; European Commission calculations, 1994)

- 1 It is clear from this table that a fairly strong need is felt by firms for protection of this type. On average 39% of the firms questioned said they would be very interested, 32% said they would be moderately interested, and only 20% would have little interest. The breakdown by size of firm shows that interest in such protection is greatest among firms with up to 500 employees, while interest is somewhat lower among companies with over 1 000 employees.
- 2 The survey also shows that, regardless of what sales they may have at present in the single market, industrial companies and independent inventors want at least to keep open the option of expanding their market in the future, and are to a large extent interested in EUwide utility model protection for that reason.

B. CHANGES IN PRODUCT LIFE CYCLES, TIMES TO MARKET AND THE LIFETIMES OF INVENTIONS

- 1 Major changes are likely to occur in the near future, making it even more necessary to seek flexible forms of protection such as that by utility model. Product life cycles are shrinking worldwide, that is to say timelags between invention, marketing and the next generation of products are growing shorter. This shortening of product life cycles creates a need for rapidly obtainable protection; it is less important that the protection obtained should last for a long time, except in a number of industries such as pharmaceuticals.

In Japan, this phenomenon manifests itself in a special way. According to a survey by the Japan Institute of Intellectual Property,¹² the marketing of articles protected by utility model very often begins in the interval between application and publication. In the United States, according to a survey by the US Patent Office,¹³

¹² *Questionnaire relating to Legal Protection of the Fruits of R&D*, Japan Institute of Intellectual Property, 1991.

¹³ *Business Week, Science & Technology*, 3 August 1992, CHI Research Inc.

there is a tendency for new inventions to be developed more rapidly in all industries apart from fuel, food, chemicals and pharmaceuticals. The average lifetime of an invention today is not more than six years.

- 1 If one tries to bring these shorter product life cycles and invention lifetimes into relation with the industries which make most use of utility model protection (e.g. mechanical engineering, electrical engineering and the automotive industry), one finds a striking degree of correlation. It takes on average four years to obtain a

European patent. If we compare this figure with the average lifetime of inventions, we can conclude that demand for a form of protection which can be obtained quickly for shortlived inventions, separately from patent protection, will increase. The utility model provides the best way of meeting this demand.

C. CHANGES IN SPENDING ON RESEARCH AND DEVELOPMENT

- 1 Research and development (“R&D”) has become a focus of economic research. However, a survey of companies and independent inventors carried out as part of the abovementioned general survey by the Ifo Institute suggests that, especially in the case of hightech industries and big companies, R&D spending will increase little in future. Thus in mechanical engineering, vehicles and accessories, electrical engineering, precision instruments and optics and medical engineering, between 50% and 58% of respondents felt that the level of R&D spending would remain the same. Given the intensive efforts to cut costs currently being made in all branches of industry, a stable level of R&D spending is nevertheless to be welcomed.
- 2 There is, however, scope for increasing R&D spending, for example in the packaging and materials handling industry, in the wood products and furniture industry, and among manufacturers of domestic appliances. The inventions which will be made as a result will require suitable protection. This trend suggests that utility model protection will indeed grow more important in future.

PART FOUR: THE ACTION PROPOSED

A. THE UTILITY MODEL IN PRACTICE

- 1 A utility model is a registered right which confers exclusive protection for a technical invention. It differs from a design right in that the latter protects the external form of an object and not the underlying invention. It resembles a patent in that the invention must be new it must possess “novelty” and must display a measure of inventive achievement it must involve an “inventive step”, though generally the level of inventiveness required is not as great as it is in the case of patents. Unlike patents, utility models are granted without a preliminary examination to establish novelty and inventive step. This means that protection can be obtained more rapidly and cheaply, but that the protection conferred is less secure.

However, as the European Parliament has stated,¹⁴ “the imperfect legal certainty inherent in utility model protection should not be considered as an obstacle to its introduction in Community law given that the advantages of this protection outweigh its inconveniences”.

- 1 Utility model protection is at present entirely a matter of domestic law. In three Member States (the United Kingdom, Luxembourg and Sweden) no form of utility model protection exists. The other Member States, where such protection does exist, have different systems, which call the rights they confer by a variety of names: “utility model”, “utility certificate”, “sixyear patent”, “shortterm patent”, “petty patent”, “utility model certificate”, etc. As one might imagine from the range of terms used, the systems diverge widely, but they all provide protection for technical inventions alongside what is available under patent law. All the schemes in existence are intended to boost the innovative capacity of companies.
- 2 These differences between national systems are inconsistent with the objectives of free movement of goods and undistorted competition in the single market, and they discourage innovative activity in European companies. A high level of innovative activity gives a business a technological advantage, which is an important factor in its competitiveness.

¹⁴ Report on the Green Paper presented by the Commission on the protection of utility models in the single market, document EP 214.304/def. of 26 June 1996.

- 1 Interest in the protection of inventions by utility model has increased in the Community in recent years. A system of protection was thus introduced recently in five Member States of the Community (Ireland, Denmark, Greece, Austria and Finland), with the result that there is now such a system in twelve of the fifteen Member States.
- 2 This proposal for a Directive seeks to harmonise the basic rules governing *inter alia* the protectable matter, the requirements for protectability, and the extent and duration of protection; it does not introduce any single set of filing arrangements or provide for the setting up of a body with special responsibility for granting utility models at Community level. It does mean, however, that those Member States which do not yet have any system of utility model protection will have to introduce one into their domestic law.

The requirement that an invention must be embodied in threedimensional form, such as is to be found in some national protection systems (e.g. Finland, Greece, Italy, Portugal and Spain), has not been included as it does not correspond to present needs. This makes it possible to bring processes within the scope of the proposal. Biological material, chemical or pharmaceutical substances and inventions involving computer programs are expressly excluded from protection by the Directive itself.

- 1 As a result of the harmonisation, an applicant for a utility model will be sure to find an equivalent property right in every Member State and will no longer be confronted with a multitude of different regulations. If he seeks protection in another Member State, he will already be familiar with the basic requirements for obtaining it and with its scope. The arrangements will help to reduce costs and simplify applications for protection in other Member States, and in so doing stimulate innovation.
- 2 In order to limit the lack of legal certainty due to the granting of too many rights without any preliminary examination to establish novelty and inventive step, this proposal contains a list of exclusions from protectability comprising *inter alia* biological material, chemical or pharmaceutical substances or processes and computer programs. It places a limit on the duration of protection and provides for the drawing up of a search report at the applicant's request or, where a Member State so provides, in the event of legal proceedings being brought to enforce the rights conferred by the utility model. It does not rule out the possibility for Member States to provide for the payment of a larger fee for renewal of the property right.

B. LEGAL BASIS

- 1 The maintenance of different national systems of utility model protection in the Community is likely to hinder the free movement of goods and distort competition in the single market. Approximation of the basic national rules governing utility models will help to make the functioning of the single market more transparent, encourage innovation and technical progress at Community level and promote the movement of goods between Member States.
- 2 A harmonisation of national laws also reflects the interest shown by the sectors of business and industry concerned, which are largely in favour of harmonising national laws on utility model protection by means of a directive and introducing a system of protection in those Member States where one does not yet exist.
- 3 The Commission proposes that Article 100a of the EC Treaty be taken as the legal basis for this proposal. This was done in the case of other directives aligning national laws on intellectual and industrial property.¹⁵ This choice of legal basis has been sanctioned by the Court of Justice on a number of occasions.¹⁶

¹⁵ See e.g. Directive 89/104/EEC approximating the laws of the Member States relating to trade marks (OJ No L 40, 11.2.1989, p. 1); Directive 93/98/EEC harmonising the term of protection of copyright and certain related rights (OJ No L 290, 24.11.1993, p. 9); and Directive 96/9/EC on the legal protection of databases (OJ No L 77, 27.3.1996, p. 20).

¹⁶ See Opinion 1/94, Competence of the Community to conclude international agreements concerning services and the protection of intellectual property [15.11.1994] ECR I5267, and Case C350/92 *Spain v Council* [13.07.1995] ECR I1985.

PART FIVE: EXAMINATION OF THE PROVISIONS

- 1 The various national systems of utility model protection include provisions based on national patent law which correspond to the provisions of the European Patent Convention. For the sake of consistency, a number of articles in this proposal are also based on the corresponding provisions of that Convention.

Article 1

- 1 The concept of utility model must be clearly defined by reference to the various concepts employed in the Member States. It should be noted, however, that the Belgian and Dutch terms used are not the official ones but are taken from draft legislation. The definition will enable Member States to know precisely which domestic provisions are affected by this Directive.

Article 2

- 1 This article determines the proposal's object. The proposal seeks to approximate Member States' laws, regulations and administrative provisions on utility model protection. Those Member States which have no utility model system will accordingly have to introduce one along the lines of this Directive.

Article 3

- 1 This article specifies which inventions are protectable by utility model. Protectable inventions are inventions which are susceptible of industrial application, which are new and which involve an inventive step. The following are not regarded as inventions: discoveries, scientific theories and mathematical methods; aesthetic creations; schemes, rules and methods for performing mental acts, playing games or doing business; and presentations of information.

Article 4

- 1 This article sets out the exclusions from protectability by utility model. Besides the traditional exception concerning public policy and morality, a number of other things are excluded, namely: inventions relating to biological matter; inventions relating to chemical or pharmaceutical substances or processes; and inventions involving computer programs. The exclusion of biological, chemical and pharmaceutical inventions is justified by the fact that such matters, substances or processes call for lengthy preparation before being placed on the market and should therefore be given patent protection, which lasts longer than utility model protection. What is more, these sectors are complex ones in which property rights involving no examination as to novelty or inventive step are out of place. The exclusion of inventions involving computer programs is due to the fact that such inventions are

currently protected either by patent (inventions relating to software) or by copyright (computer programs as such).

Article 5

- 1 This article explains what is meant by novelty. An invention is considered to be new if it does not form part of the state of the art. In keeping with most national utility model systems, the novelty of an invention is to be determined by reference to the international state of the art (absolute novelty). The state of the art comprises everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the utility model. Additionally, the content of utility model applications as filed, of which the dates of filing are prior to the date of the application for the utility model concerned and which were published on or after that date, are considered as comprised in the state of the art.

Article 6

- 1 This article explains what is meant by inventive step for the purposes of this Directive. Here, an invention is considered as involving an inventive step if, in the utility model application, the applicant indicates clearly and convincingly that, compared with the state of the art, it exhibits either particular effectiveness in terms of, for example, ease of application or use, or a practical or industrial advantage. This wording is designed to cover the wide variety of situations which are provided for in the various national systems and are encountered in practice and which, as a rule, involve a different inventive step from that which is required in the case of a patent. Examples are an invention making it possible to solve a technical problem and an invention relating to the effectiveness or ease of use of a product in that it increases the product's usefulness by making it more effective and easier to use.

Article 7

- 1 This article explains what is meant by an invention "susceptible of industrial application". An invention is so considered if it can be made or used in any kind of industry, including agriculture. Surgical or therapeutic treatment procedures applicable to the human body or the bodies of animals and diagnostic procedures which are carried out on the human body or the bodies of animals are not considered to be inventions susceptible of industrial application.

Article 8

- 1 Paragraph 1 of this article specifies the requirements which must be satisfied by a utility model application. Paragraph 2 stipulates that the application will be subject to the payment of a filing fee and, where appropriate, a search fee. The latter is payable only where a search report is drawn up at the applicant's request. Member States remain free to provide that the fees payable at the end of the first period of validity should be sufficiently high to dissuade utility model proprietors from retaining their rights where these are no longer of any commercial value.

Article 9

- 1 This article concerns the date of filing of a utility model application. The date of filing of the application is the date on which documents filed by the applicant contain an indication that a utility model is sought, information identifying the applicant, and a description and one or more claims.

Article 10

- 1 This article provides that the utility model application must designate the inventor. If the applicant is not the inventor or is not the sole inventor, the designation must contain a statement indicating the origin of the right to the utility model.

Article 11

- 1 This article on unity of invention stipulates that the utility model application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Article 12

- 1 This article on disclosure of the invention provides that the utility model application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Article 13

- 1 This article stipulates that the claims must define the matter for which protection is sought and that they must be clear and concise and be supported by the description. It stipulates, further, that the number of claims must be limited to that which is

strictly necessary having regard to the nature of the invention. This requirement makes it possible to limit the extent of the protection so as to compensate for the lack of any preliminary examination.

Article 14

- 1 This article on the abstract provides that the abstract is to serve merely for use as technical information and that it may not be taken into account for any other purpose such as, for example, interpreting the scope of the protection sought.

Article 15

- 1 This article on examination as to formal requirements provides that the examination must be confined to the formal requirements of Articles 8 and 10 of this Directive and that it may not cover the novelty, inventive step or industrial application of an invention.

Article 16

- 1 This article on the search report stipulates that the search report is to be drawn up only at the request of the applicant and that the task of drawing up the report may be entrusted to any authority deemed competent by the competent authority with which the application has been filed. Member States may provide that a search report is compulsory in the event of legal proceedings being brought to enforce the rights conferred by the utility model.

Article 17

- 1 This article on the priority right is based on paragraphs A and C of Article 4 of the Paris Convention. Any person who has duly filed an application for a utility model or a patent in one of the Member States, such State being a party to the Paris Convention, is to enjoy, for the purpose of filing a utility model application in the other Member States, a right of priority during a period of 12 months from the date of filing of the first application.

Article 18

- 1 This article seeks to permit a person who has filed a patent application, while the procedure is under way and for a limited period, to file in the same Member State, in addition to or in lieu of his patent application, an application for a utility model. This option must, of course, be ruled out where priority has been claimed for the patent application. The general provisions concerning the right of priority are applicable here.

Article 19

- 1 Unlike in the case of patents, where the term of protection is 20 years, the duration of the utility model is fixed at six years from the date of filing of the application. It may be renewed for two successive periods of two years, but may not exceed a maximum period of ten years from the date of filing of the application. The difference compared with the patent is marked in view of the short lifetime of technical inventions and the different level of inventiveness involved.

Article 20

- 1 Paragraphs 1 and 2 concern the rights conferred by the utility model where the protected matter is a product or a process. The provisions are based on Article 28(1) of the Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPs) concluded under the auspices of the World Trade Organisation. Paragraph 3 concerns limitation of the effects of the utility model and is based on the relevant provisions of points (a) and (b) of Article 27 of the Community Patent Convention. Paragraph 4, which is based on Article 28(2) of the TRIPs Agreement, provides that the proprietor of a utility model has the right to assign it or transfer it by succession and to conclude licensing agreements. Paragraph 5 is based on Article 30 of the TRIPs Agreement. It stipulates that Member States may provide limited exceptions to the exclusive rights conferred by a utility model, provided that such exceptions do not unreasonably conflict with a normal exploitation of the utility model and do not unreasonably prejudice the legitimate interests of the proprietor of the utility model, taking account of the interests of third parties. Lastly, paragraph 6 provides that, where the law of a Member State allows for use other than that authorised under paragraph 5 without the authorisation of the rightholder (e.g. in the event of compulsory licences), the provisions applicable to patents for similar use must be complied with. The aim is to render the conditions laid down in Article 31 of the TRIPs Agreement applicable by analogy to utility models.

Article 21

- 1 This article on Community exhaustion of rights incorporates, in paragraph 1, the principle set forth in Article 28 of the Community Patent Convention. The rights conferred by a utility model do not extend to acts concerning a product covered by that utility model which are done after that product has been put on the market in the Community by the rightholder or with his consent. By marketing the protected product in a Member State, the rightholder has been able to benefit from the economic conditions which accompany the exclusivity he enjoys, and he has thus exhausted his parallel rights to protection in the

other Member States. To avoid any ambiguity, paragraph 2 states that the principle of international exhaustion is ruled out, which means that the rights conferred by the utility model do extend to acts concerning a product covered by that utility model after that product has been put on the market outside the Community by the rightholder or with his consent.

Article 22

- 1 Paragraph 1 of this article, which is concerned with dual protection, allows one and the same invention to form the subjectmatter, simultaneously or successively, of a patent application and a utility model application. Such dual protection is worthwhile where the user wishes to obtain temporary protection pending the grant of a patent, where he is not sure that the inventive step is sufficient for a patent, or where he wishes to be particularly well protected by two different systems for the same invention. So as not to place the rightholder in too strong a position, however, Member States may provide that a utility model which has been granted is deemed to be ineffective where a patent relating to the same invention has been granted and published (paragraph 2). Where they avail themselves of this opportunity, the Member States concerned must at least take appropriate measures to ensure that, where his rights are infringed, the rightholder cannot initiate successive proceedings under both sets of protection arrangements (paragraph 3). This provision is intended to prevent successive proceedings from being brought by a rightholder who, having failed to win his patent action, might seek to bring a fresh action on the strength of the utility model, or vice versa.

Article 23

- 1 This article on lapse of the utility model is based on the relevant provisions of Article 50 of the Community Patent Convention. The utility model lapses at the end of the period prescribed, if its proprietor surrenders it, or if the filing fee and any search fee have not been paid in due time.

Article 24

- 1 This article on the grounds for revocation of the utility model is based on the relevant provisions of Article 56 of the Community Patent Convention. An application for revocation may be filed only on the following grounds: the subjectmatter of the utility model is not protectable; the utility model does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art; the subjectmatter of the utility model extends beyond the content of the application as filed; and the protection conferred has been extended.

Article 25

- 1 This proposal must be transposed into national law by 31 December 1999. Member States must inform the Commission thereof immediately. When Member States adopt the necessary provisions, these are to contain a reference to this Directive or are to be accompanied by such reference at the time of their official publication. Member States must communicate to the Commission the provisions of national law thus adopted.

Article 26

- 1 This article provides that, in accordance with Article 191(1) of the EC Treaty, the Directive is to enter into force on the twentieth day following that of its publication in the Official Journal of the European Communities.

Article 27

- 1 This article provides that the Directive is addressed to the Member States, including those which do not have any system of utility model protection.

Proposal for a

EUROPEAN PARLIAMENT AND COUNCIL DIRECTIVE

approximating the legal arrangements for the protection of inventions by utility model

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community and in particular Article 100a thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the Economic and Social Committee,

Acting in accordance with the procedure laid down in Article 189b of the Treaty,

Whereas the Treaty commits the Community and Member States to creating the conditions for Community industry to be competitive and to promoting a better exploitation of the industrial potential of innovation, research and technological development policies;

Whereas technical inventions play an important role in that they make available improved, better quality products which are particularly effective in terms of, for example, ease of application or use, or which confer a practical or industrial advantage compared with the state of the art;

Whereas, because of differences between Member States' utility model laws, an invention may not be protected throughout the Community, at least not in the same way or for the same length of time, a state of affairs which is incompatible with a transparent, obstaclefree single market; whereas it is therefore necessary, with a view to the establishment and proper functioning of the single market, to approximate Member States' laws in this area;

Whereas it is important in this context to employ every possible means of increasing the competitiveness of Community industry in the field of research and development;

Whereas small and mediumsized firms play a strategic role in relation to innovation and rapid response to market requirements;

Whereas there is a need for placing at the disposal of firms, and in particular small and mediumsized firms and researchers, an instrument which is cheap, rapid and easy to evaluate and apply;

Whereas utility model protection is better suited than patent protection to technical inventions involving a specific level of inventiveness;

Whereas technical inventions should be suitably protected throughout the Community;

Whereas, in accordance with the principle of proportionality, the approximation may be limited to those national provisions which have the most direct impact on the functioning of the single market;

Whereas, if the objectives of the approximation are to be attained, the conditions for obtaining and retaining the rights conferred by a registered utility model should in principle be the same in all Member States; whereas to that end an exhaustive list of the requirements which a technical invention must satisfy if it is to be protected by a utility model must be drawn up;

Whereas these requirements are for the most part the same as those for patent protection; whereas the level of inventiveness required must nevertheless be different to allow for the specific nature of technical inventions protectable by utility model;

Whereas utility model protection must be available both to products and to processes;

Whereas it is necessary to exclude from utility model protection not only those inventions which are normally excluded from patentability but also, in order to meet the needs of the industries concerned, inventions relating to chemical or pharmaceutical substances or processes and inventions involving computer programs;

Whereas a utility model application must satisfy requirements similar to those for patents; whereas, however, a utility model application gives rise only to a check to ensure that the formal conditions for protectability are satisfied without any preliminary examination to establish novelty or inventive step; whereas it may form the subjectmatter of a search report on the state of the art only at the applicant's request;

Whereas it is essential, in order to safeguard the proper functioning of the single market and ensure that competition is not distorted, that registered utility models should henceforth confer upon their proprietor the same protection in all Member States and that the period of protection should be identical; whereas this period may not exceed 10 years;

Whereas the nature and scope of the rights conferred by a utility model must be spelled out; whereas the principle of Community exhaustion of rights must apply in accordance with the caselaw of the Court of Justice of the European Communities, but the principle of international exhaustion must be expressly excluded;

Whereas rules must also be laid down on dual protection by patent and by utility model, and on the lapse and revocation of utility models;

Article 2

Object

This Directive seeks to approximate Member States' laws, regulations and administrative provisions on the protection of inventions by utility model.

CHAPTER II

SCOPE OF THE UTILITY MODEL

Article 3

Protectable inventions

1. Utility models shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.
2. The following in particular shall not be regarded as inventions within the meaning of paragraph 1:
 - (a) discoveries, scientific theories and mathematical methods;
 - (b) aesthetic creations;
 - (c) schemes, rules and methods for performing mental acts, playing games or doing business;
 - (d) presentations of information.

Article 4

Exclusions from protectability

Utility models shall not be granted in respect of:

- a) inventions the exploitation of which would be contrary to public policy or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all Member States;
- b) inventions relating to biological material;
- c) inventions relating to chemical or pharmaceutical substances or processes;
- d) inventions involving computer programs.

Article 5

Novelty

1. An invention shall be considered to be new if it does not form part of the state of the art.
2. The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the utility model application.
3. Additionally, the content of utility model applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.

Article 6

Inventive step

For the purposes of this Directive, an invention shall be considered as involving an inventive step if, in the utility model application, the applicant indicates clearly and convincingly that, compared with the state of the art, it exhibits either

- (a) particular effectiveness in terms of, for example, ease of application or use; or
- (b) a practical or industrial advantage.

Article 7

Industrial application

1. An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.
2. Surgical or therapeutic treatment procedures applicable to the human body or to the bodies of animals and diagnostic procedures which are carried out on the human body or the bodies of animals shall not be considered to be inventions susceptible of industrial application within the meaning of paragraph 1.

CHAPTER III

UTILITY MODEL APPLICATIONS

Article 8

Requirements of the application

1. A utility model application shall contain:

- (a) a request for the grant of a utility model;
- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract.

2. A utility model application shall be subject to the payment of a filing fee and, where appropriate, a search fee.

Article 9

Date of filing

The date of filing of a utility model application shall be the date on which documents filed by the applicant contain:

- (a) an indication that a utility model is sought;
- (b) information identifying the applicant;
- (c) a description and one or more claims.

Article 10

Designation of the inventor

The utility model application shall designate the inventor. If the applicant is not the inventor or is not the sole inventor, the designation shall contain a statement indicating the origin of the right to the utility model.

Article 11

Unity of invention

The utility model application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Article 12

Disclosure of the invention

The utility model application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Article 13

The claims

1. The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.
2. The number of claims shall be limited to that which is strictly necessary having regard to the nature of the invention.

Article 14

The abstract

The abstract shall merely serve for use as technical information. It may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought nor for the purpose of applying Article 5(3).

Article 15

Examination as to formal requirements

1. The competent authority with which a utility model application has been lodged shall examine whether the application satisfies the formal requirements of Articles 8 and 10 and shall check whether it contains a description and an abstract.
2. If a date of filing cannot be accorded, the competent authority shall give the applicant an opportunity to correct the deficiencies in accordance with such conditions and within such period as it may fix. If the deficiencies are not remedied in due time, the application shall not be dealt with as a utility model application.
3. The competent authority referred to in paragraph 1 shall not carry out any examination to establish whether the requirements of Articles 5, 6 and 7 have been met.

Article 16

Search report

1. If a utility model application has been accorded a date of filing and is not deemed to be withdrawn, the competent authority with which the application has been lodged shall, at the applicant's request, draw up on the basis of the claims a search report covering the relevant state of the art, with due regard to the description and any drawings.
2. The competent authority with which the application has been lodged may entrust the task of drawing up the search report to any authority which it considers competent to do so.
3. Immediately after it has been drawn up, the search report shall be transmitted to the applicant together with copies of any cited documents.

4. In the provisions which they adopt in order to comply with this Directive, Member States may provide that a search report is compulsory in the event of legal proceedings being brought to enforce the rights conferred by the utility model.

Article 17

Priority right

1. Any person who has duly filed an application for a utility model or a patent in or for one of the Member States, such State being a party to the Paris Convention for the Protection of Industrial Property, or his successors in title, shall enjoy, for the purpose of filing a utility model application in respect of the same invention in one or more other Member States a right of priority during a period of twelve months from the date of filing of the first application.

2. Any filing that is equivalent to a regular national filing under the domestic law of the Member State where it was made or under bilateral or multilateral agreements shall be recognised as giving rise to a right of priority.

3. By a regular national filing is meant any filing that is sufficient to establish the date on which the application was filed in the Member State concerned, whatever may be the outcome of the application.

Article 18

Internal priority

1. Any person who has duly filed a patent application shall enjoy, for the purpose of filing a utility model application in respect of the same invention, a right of priority during a period of twelve months, unless priority has already been claimed for the patent application.

2. The provisions of Article 17(2) and (3) shall apply *mutatis mutandis*.

CHAPTER IV

EFFECTS OF THE UTILITY MODEL

Article 19

Duration of protection

1. The duration of the utility model shall be six years from the date of filing of the application.

2. Six months before the period indicated in paragraph 1 elapses, the rightholder may submit to the competent authority an application for renewal of the utility model for a period of two years.

3. Six months before the period indicated in paragraph 2 elapses, the rightholder may submit a second and last application for renewal for a maximum period of two years.

4. In no circumstances may utility model protection last for more than ten years from the date of filing of the application.

Article 20

Rights conferred

1. Where the subjectmatter of a registered utility model is a product, the utility model shall confer on its proprietor the right to prevent third parties not having his consent from making, using, offering for sale, selling, or importing for these purposes that product.

2. Where the subjectmatter of a registered utility model is a process, the utility model shall confer on its proprietor the right to prevent third parties not having his consent from using the process and from using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.

3. The rights conferred by a utility model in accordance with paragraphs 1 and 2 shall not extend to:

(a) acts done privately and for noncommercial purposes;

(b) acts done for experimental purposes relating to the subjectmatter of the protected invention.

4. The proprietor of a utility model shall have the right to assign, or transfer by succession, the utility model and to conclude licensing agreements.

5. Member States may provide limited exceptions to the exclusive rights conferred by a utility model, provided that such exceptions do not unreasonably conflict with a normal exploitation of the utility model and do not unreasonably prejudice the legitimate interests of the proprietor of the utility model, taking account of the interests of third parties.

6. Where the law of a Member State allows for use of the subjectmatter of a utility model other than that allowed under paragraph 5 without the authorisation of the rightholder, including use by the government or third parties authorised by the government, the provisions applicable to patents for similar use shall be complied with.

Article 21

Community exhaustion of rights

1. The rights conferred by a utility model shall not extend to acts concerning a product covered by that utility model which are done after that product or has

been put on the market in the Community by the rightholder or with his consent.

2. The rights conferred by a utility model shall, however, extend to acts concerning a product covered by that utility model which are done after that product has been put on the market outside the Community by the rightholder or with his consent.

CHAPTER V

DUAL PROTECTION, LAPSE AND REVOCATION

Article 22

Dual protection

1. The same invention may form the subjectmatter, simultaneously or successively, of a patent application and a utility model application.
2. Member States may provide that a utility model which has been granted is deemed to be ineffective where a patent relating to the same invention has been granted and published.
3. Member States which do not exercise the option referred to in the preceding paragraph shall take appropriate measures to prevent the proprietor, in the event of his rights being infringed, from instituting successive proceedings under both sets of protection arrangements.

Article 23

Lapse

A utility model shall lapse:

- (a) at the end of the period laid down in Article 19;
- (b) if its proprietor surrenders it;
- (c) if the fees referred to in Article 8(2) have not been paid in due time.

Article 24

Revocation

1. An application for revocation of a utility model may be filed only on the grounds that:
 - (a) the subjectmatter of the utility model is not protectable pursuant to Articles 3 to 7 of this Directive;
 - (b) the utility model does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

- (c) The subjectmatter of the utility model extends beyond the content of the utility model application as filed;
 - (d) the protection conferred by the utility model has been extended.
2. If the grounds for revocation affect the utility model only partially, revocation shall be pronounced in the form of a corresponding limitation of the utility model. The limitation may be effected in the form of an amendment to the claims, the description or the drawings.

CHAPTER VI

FINAL PROVISIONS

Article 25

Transposal

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive by 31 December 1999. They shall immediately inform the Commission thereof.

When Member States adopt these provisions, these shall contain a reference to this Directive or shall be accompanied by such reference at the time of their official publication. The procedure for such reference shall be adopted by the Member States.

2. Member States shall inform the Commission of the main provisions of national law which they adopt in the field governed by this Directive.

Article 26

Entry into force

This Directive shall enter into force on the twentieth day following that of its publication in the Official Journal of the European Communities.

Article 27

Addressees

This Directive is addressed to the Member States.

Done at Brussels,

For the European Parliament

The President

For the Council

The President

FINANCIAL STATEMENT

TITLE

Proposal for a European Parliament and Council Directive approximating the legal arrangements for the protection of inventions by utility model.

DESCRIPTION OF MEASURE

The purpose of the measure is to enhance the competitiveness of firms, in particular SMEs, and promote innovation by approximating Member States' laws, regulations and administrative provisions on utility model protection and by introducing such protection in those Member States where there is none.

The measure has no financial implications for the Community budget.

THE IMPACT OF THE PROPOSAL ON BUSINESS

(with special reference to SMEs)

1. WHY IS COMMUNITY LEGISLATION NECESSARY?

To harmonise at Community level Member States' provisions on utility models and to introduce such arrangements in those Member States where there are none, by pursuing the following objectives:

- (a) to improve the functioning of the single market in products resulting in particular from minor technical inventions by ensuring their free movement;
- (b) to prevent the distortions of competition which SMEs seeking to innovate are currently faced with;
- (c) to ensure that all firms and independent inventors enjoy better protection for their technical inventions through the approximation of national laws in this area;
- (d) to improve the competitiveness of European industry by supporting European research.

2. WHO WILL BE AFFECTED BY THE PROPOSAL?

All sectors of industry will in theory be affected. According to surveys carried out among business people, however, the sectors most affected are mechanical engineering, electrical engineering, precision instruments and optics and the automotive industry. On the other hand, some sectors, such as the chemical and pharmaceutical industries, will, at their request, not be affected by the proposal.

SMEs, especially those which innovate, will be particularly affected by the proposal.

3. WHAT WILL BUSINESS HAVE TO DO TO COMPLY WITH THE PROPOSAL?

Utility model protection will be granted to those firms which request it, provided all the requirements are met. Utility model applications are to be filed with the competent authorities (in practice, national patent offices). A filing fee, the amount of which is a matter for Member States' competent authorities will be payable.

4. WHAT ECONOMIC EFFECTS IS THE PROPOSAL LIKELY TO HAVE?

(a) On employment

Harmonisation of the national rules governing utility model protection will constitute, for innovative firms, an incentive to maintain, or even increase, their investment in research and development. It will help to establish a legal framework suited to the protection of innovation especially in the area of technical inventions, and will therefore have a favourable impact on employment, notably in the research field.

(b) On investment and the creation of new businesses

Harmonisation of utility model protection should increase the likelihood that the firms concerned will recover their costs and will thus encourage them to invest. The patent being the best means of encouraging research, it is clear that the utility model, which complements it in the case of minor technical inventions, will be regarded as an incentive to research in industry.

(c) On the competitiveness of businesses

Harmonisation will mean that SMEs and independent inventors will no longer have to cope with different protection systems in the Community and that there will be less need to consult industrial property experts or legal advisers. This will help resolve many an insurmountable administrative or financial difficulty. Full rein may thus be given to firms' inventiveness, strengthening their competitive position both domestically and internationally.

5. DOES THE PROPOSAL CONTAIN MEASURES TO TAKE ACCOUNT OF THE SPECIFIC SITUATION OF SMEs?

The measures contained in the proposal are specifically targeted at SMEs with a view both to improving their competitiveness by reducing the cost of protecting their inventions and to promoting technical innovation at their level.

6. CONSULTATION

In July 1995 the Commission drew up and published a Green Paper on the protection of utility models in the single market.¹⁷ It received nearly 90 replies from a whole range of interested parties. The European Parliament and the Economic and Social Committee

¹⁷ Document COM(95) 370 final of 19 July 1995.

have also had the opportunity to make known their views on the subject.¹⁸ In addition, the Commission held a hearing attended by European trade associations on 23 September 1996 and a meeting with Member States' experts on 4 November of that year to sound out their opinions.

¹⁸ EP: document EP 214.304/def. of 26 June 1996; ESC: document ESC 1372/95 of 26 February 1996.

**Commission Regulation (EC) No 1654/2005
of 10 October 2005
amending Regulation (EC) No 874/2004 laying down public policy rules concerning the
implementation and functions of the.eu Top Level Domain and the principles governing registration
(Text with EEA relevance)**

Commission Regulation (EC) No 1654/2005

of 10 October 2005

amending Regulation (EC) No 874/2004 laying down public policy rules concerning the implementation and functions of the.eu Top Level Domain and the principles governing registration

(Text with EEA relevance)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain [1], and in particular Article 5(1) thereof,

Having consulted the European Registry for Internet domains designated by Commission Decision 2003/375/EC [2],

Whereas:

- (1) Commission Regulation (EC) No 874/2004 [3] implements Regulation (EC) No 733/2002 by laying down the public policy rules concerning the implementation and functions of the.eu Top Level Domain and the principles governing registration.
- (2) Article 8 of Regulation (EC) No 874/2004 implements the public policy rules concerning geographical concepts by providing for a procedure to permit Member States, candidate countries and all the members of the European Economic Area to request the registration or the reservation of their name by their national governments. That provision does not fully guarantee the geopolitical and linguistic diversity of the European Union and the interest of both Member States and European citizens. This calls for the Commission to amend Regulation (EC) No 874/2004 accordingly.
- (3) The measures provided for in this Regulation are in accordance with the opinion of the Communications Committee established by Article 22(1) of Directive 2002/21/EC of the European Parliament and of the Council of 7 March 2002 on a common regulatory framework for electronic communications networks and services (Framework Directive) [4],

HAS ADOPTED THIS REGULATION:

Article 1

Commission Regulation (EC) No 874/2004 shall be amended as follows:

1. Article 8 shall be replaced by the following:

"Article 8

Reservation of names by countries and alpha-2 codes representing countries

1. The list of names set out in the Annex to this Regulation shall only be reserved or registered as second level domain names directly under the .eu TLD by the countries indicated in the list.

2. Alpha-2 codes representing countries shall not be registered as second level domain names directly under the.eu TLD.";
2. in Article 12(1), the first subparagraph shall be replaced by the following:
"Phased registration shall not start before the requirement of the first paragraph of Article 6 is fulfilled.";
3. the Annex to this Regulation is added.

Article 2

This Regulation shall enter into force on the day of its publication in the Official Journal of the European Union.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 10 October 2005.

For the Commission

Viviane Reding

Member of the Commission

[1] OJ L 113, 30.4.2002, p. 1.

[2] OJ L 128, 24.5.2003, p. 29.

[3] OJ L 162, 30.4.2004, p. 40.

[4] OJ L 108, 24.4.2002, p. 33.

ANNEX

1. List of names per country and the countries that can register them

AUSTRIA

1. österreich
2. oesterreich
3. republik-österreich
4. republik-oesterreich
5. afstria
6. dimokratia-afstria
7. østrig
8. republikken-østrig
9. oestrig
10. austria

-
11. republic-austria
 12. republica-austria
 13. autriche
 14. république-autriche
 15. oostenrijk
 16. republiek-oostenrijk
 17. republica-austria
 18. itävalta
 19. itävallan-tasavalta
 20. itaevalta
 21. österrike
 22. oesterrike
 23. republik-österrike
 24. rakousko
 25. republika-rakousko
 26. repubblica-austria
 27. austrija
 28. republika-austrija
 29. respublika-austrija
 30. ausztria
 31. Osztrak-Köztársaság
 32. Republika-Austriacka
 33. rakusko
 34. republika-rakusko
 35. avstrija
 36. republika-avstrija
 37. awstrija
 38. republika-awstrija
 39. republikösterreich
 40. republikoesterreich
 41. dimokratiaafstria
 42. republikkenøstrig
 43. republicaustria
 44. republicaaustria

-
45. républiqueautriche
 46. repubblicaaustria
 47. republiekoostenrijk
 48. republicaaustria
 49. tasavaltaitävalta
 50. republikösterrike
 51. republikarakousko
 52. republikaaustrija
 53. respublikaaustrija
 54. OsztrakKöztarsasag
 55. RepublikaAustriacka
 56. republikarakusko
 57. republikaavstrija
 58. republikaawstrija
 59. aostria
 60. vabariik-aostria
 61. vabariikaostria
- BELGIUM**
1. belgie
 2. belgie
 3. belgique
 4. belgien
 5. belgium
 6. bēlgica
 7. belgica
 8. belgio
 9. belgia
 10. belgija
 11. vlaanderen
 12. wallonie
 13. wallonie
 14. brussel
 15. vlaamse-gemeenschap
 16. franse-gemeenschap

-
17. duitstalige-gemeenschap
 18. vlaams-gewest
 19. waals-gewest
 20. brussels-hoofdstedelijk-gewest
 21. flandre
 22. bruxelles
 23. communauté-flamande
 24. communaute-flamande
 25. communauté-française
 26. communaute-francaise
 27. communaute-germanophone
 28. communauté-germanophone
 29. région-flamande
 30. region-flamande
 31. région-wallonne
 32. region-wallonne
 33. région-de-bruxelles-capitale
 34. region-de-bruxelles-capitale
 35. flandern
 36. wallonien
 37. bruessel
 38. brüssel
 39. flaemische-gemeinschaft
 40. flämische-gemeinschaft
 41. franzoesische-gemeinschaft
 42. französische-gemeinschaft
 43. deutschsprachige-gemeinschaft
 44. flaemische-region
 45. flämische-region
 46. wallonische-region
 47. region-bruessel-hauptstadt
 48. region-brüssel-hauptstadt
 49. flanders
 50. wallonia

-
51. brussels
 52. flemish-community
 53. french-community
 54. german-speaking-community
 55. flemish-region
 56. walloon-region
 57. brussels-capital-region
 58. flandes
 59. valonia
 60. bruselas
 61. comunidad-flamenca
 62. comunidad-francesa
 63. comunidad-germanofona
 64. comunidad-germanofona
 65. region-flamenca
 66. region-flamenca
 67. region-valona
 68. region-valona
 69. region-de-bruselas-capital
 70. region-de-bruselas-capital
 71. fiandre
 72. valloniam
 73. communita-fiamminga
 74. comunità-fiamminga
 75. communita-francese
 76. comunità-francese
 77. communita-di-lingua-tesca
 78. comunità-di-lingua-tesca
 79. regione-fiamminga
 80. regione-vallonia
 81. regione-di-bruxelles-capitale
 82. flandres
 83. bruxelas
 84. comunidade-flamenga

-
85. comunidade-francofona
 86. comunidade-germanofona
 87. regio-flamenga
 88. regio-flamenga
 89. regio-vala
 90. regio-vala
 91. regio-de-bruxelas-capital
 92. regio-de-bruxelas-capital
 93. vallonien
 94. bryssel
 95. flamlaendskt-spraakomraade
 96. fransktalande-spraakomraade
 97. tysktalande-spraakomraade
 98. flamlaenska-regionen
 99. vallonska-regionen
 100. bryssel-huvustad
 101. det-flamske-sprogsamfund
 102. det-franske-sprogsamfund
 103. det-tysktalende-sprogsamfund
 104. den-flamske-region
 105. den-vallonske-region
 106. regionen-bruxelles-hovedstadsomraadet
 107. flanderi
 108. flaaminkielinen-yhteiso
 109. ranskankielinen-yhteiso
 110. saksankielinen-yhteiso
 111. flanderin-alue
 112. vallonian-alue
 113. brysselin-alue
 114. flandry
 115. valonsko
 116. brusel
 117. vlamske-spolecenstvi
 118. francouzske-spolecenstvi

-
119. germanofonni-spolecenstvi
 120. vlamsky-region
 121. valonsky-region
 122. region-brusel
 123. flandrija
 124. valonija
 125. bruselj
 126. flamska-skupnost
 127. frankofonska-skupnost
 128. germanofonska-skupnost
 129. flamska-regija
 130. valonska-regija
 131. regija-bruselj

CYPRUS

1. cypem
2. cyprus
3. cyprus
4. kypros
5. chypre
6. zyperm
- 7.
8. cipro
9. chipre
10. chipre
11. cypem
12. anchipír
13. kypr
14. küpros
15. ciprus
16. kipras
17. kipra
18. ipru
19. cypr
20. ciper

-
21. cyprus
 22. kibris
 23. republikkencypern
 24. republiekcyprus
 25. republicofcyprus
 26. kyproksentasavalta
 27. republiquedechypre
 28. republikzypern
 - 29.
 30. repubblicadicipro
 31. republicadechipre
 32. republicadechipre
 33. cypersrepublik
 34. poblachtnacipíre
 35. kyperskarepublika
 36. küprosevabariik
 37. ciprusiköztársaság
 38. kiprorepublika
 39. kiprasrepublika
 40. republikata'ipru
 41. republikacypryjska
 42. republikaciper
 43. cyperskarepublika
 44. kibriscumhuriyeti
- CZECH REPUBLIC**
1. ceska-republika
 2. den-tjekkiske-republik
 3. tschechische-republik
 4. tsehhi-vabariik
 5. -
 6. czech-republic
 7. repulica-checa
 8. republique-tcheque
 9. repubblica-ceca

-
10. cehijas-republika
 11. cekijos-respublika
 12. cseh-koztarsasag
 13. repubblica-ceka
 14. tsjechische-republiek
 15. republika-czeska
 16. repubblica-checa
 17. ceska-republika
 18. ceska-republika
 19. tsekin-tasavalta
 20. tjeckiska-republiken
 21. ceskarepublika
 22. dentjekkiskerepublik
 23. tschechischerepublik
 24. tsehhivabariik
 - 25.
 26. czechrepublic
 27. repulicachecca
 28. republiquetcheque
 29. repubblicacecca
 30. cehijasrepublika
 31. cekijosrepublika
 32. csehkoztarsasag
 33. repubblicacecca
 34. tsjechischerepubliek
 35. republikaczeska
 36. repulicachecca
 37. ceskarepublika
 38. ceskarepublika
 39. tsekintasavalta
 40. tjeckiskarepubliken
 41. czech
 42. cesko
 43. tjeckiet

-
44. tschechien
 45. tsehhi
 - 46.
 47. czechia
 48. chequia
 49. tchequie
 50. cechia
 51. cehija
 52. cekija
 53. csehország
 54. tsjechie
 55. czechy
 56. chequia
 57. ceska
 58. tsekinmaa
 59. tjeckien
 60. cechy
 61. eska-republika
 62. tsehhi-vabariik
 63. republica-checa
 64. republique-tcheque
 65. ehijas-republika
 66. cseh-köztársaság
 67. republica-checa
 68. eska-republika
 69. eskarepublika
 70. tsehhivabariik
 71. republicacheca
 72. republiquetcheque
 73. ehijasrepublika
 74. csehköztársaság
 75. republicacheca
 76. eskarepublika
 77. esko

-
78. tsjechie
 79. tsehhi
 80. chequia
 81. tchequie
 82. ehija
 83. csehorszag
 84. eska
 85. echy

DENMARK

1. danemark
2. denemarken
3. danmark
4. denmark
5. tanska
- 6.
7. danimarca
8. dinamarca
9. dänemark
10. dansko
11. taani
12. danija
13. dnija
14. id-danimarka
15. dania
16. danska
17. dania

ESTONIA

1. eesti
2. estija
3. estland
4. estonia
5. estonia
6. estonie
7. estonija

8. estonja

9.

10. igaunija

11. viro

FINLAND

1. suomi

2. finland

3. finska

4. finsko

5. fiinlândia

6. finlandia

7. finlandja

8. finnorszag

9. suomija

10. somija

11. finlande

12.

13. soomi

14. finnland

15. finsko

FRANCE

1. francia

2. francie

3. frankrig

4. frankreich

5. prantsusmaa

6.

7. gallia

8. france

9. france

10. francia

11. francija

12. pranczija

13. prancuzija

-
14. franciaország
 15. franciaország
 16. francia
 17. frankrijk
 18. francia
 19. frança
 20. francuzsko
 21. francuzsko
 22. francija
 23. ranska
 24. frankrike
 25. französische-republik
 26. französische-republik
 27. französische_republik
 28. franzosischerepublik
 29. franzosische-republik
 30. franzosische_republik
 31. franzoesischerepublik
 32. franzoesische-republik
 33. franzoesische_republik
 34. frenchrepublic
 35. french-republic
 36. french_republic
 37. republiquefrançaise
 38. republique-française
 39. republique_française
 40. républiquefrançaise
 41. république-française
 42. république_française
 43. republiquefrancaise
 44. republique-francaise
 45. republique_francaise
 46. républiquefrancaise
 47. république-francaise

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48. république_francaise
 49. alsace
 50. auvergne
 51. aquitaine
 52. basse-normandie
 53. bassenormandie
 54. bourgogne
 55. bretagne
 56. centre
 57. champagne-ardenne
 58. champagneardenne
 59. corse
 60. franche-comte
 61. franche-comté
 62. franchecomte
 63. franchecomté
 64. haute-normandie
 65. hautenormandie
 66. ile-de-France
 67. ile-de-France
 68. iledeFrance
 69. iledeFrance
 70. languedoc-roussillon
 71. languedocroussillon
 72. limousin
 73. lorraine
 74. midi-pyrenees
 75. midi-pyrénées
 76. midipyrenees
 77. midipyrénées
 78. nord-pas-de-calais
 79. nordpasdecalais
 80. paysdelaloire
 81. pays-de-la-loire

-
82. picardie
 83. poitou-charentes
 84. poitoucharentes
 85. provence-alpes-cote-d-azur
 86. provence-alpes-côte-d-azur
 87. provencealpescotedazur
 88. provencealpescôtedazur
 89. rhone-alpes
 90. Rhône-alpes
 91. rhonealpes
 92. Rhônealpes
 93. guadeloupe
 94. guyane
 95. martinique
 96. reunion
 97. réunion
 98. mayotte
 99. saint-pierre-et-miquelon
 100. saintpierreetmiquelon
 101. polynesie-française
 102. polynésie-française
 103. polynesie-francaise
 104. polynésie-francaise
 105. polynesiefrançaise
 106. polynésiefrançaise
 107. polynesiefrancaise
 108. polynésiefrancaise
 109. nouvelle-caledonie
 110. nouvelle-calédonie
 111. nouvellecaledonie
 112. nouvellecalédonie
 113. wallis-et-futuna
 114. wallisetfutuna
 115. terres-australes-et-antarctiques-françaises

116. terres-australes-et-antarctiques-françaises
117. terresaustralesetantarctiquesfrançaises
118. terresaustralesetantarctique-françaises
119. saint-barthélemy
120. saintbarthélemy
121. saint-barthelemy
122. saintbarthelemy
123. saint-martin
124. saintmartin

GERMANY

1. deutschland
2. federalrepublicofgermany
3. bundesrepublik-deutschland
4. bundesrepublikdeutschland
5. allemagne
6. republiquesfederalde'allemagne
7. alemanna
8. republicafederaldealemania
9. germania
10. republicafederaledigermania
11. germany
12. federalrepublicofgermany
13. tyskland
14. forbundsrepublikkentyskland
15. duitsland
16. bondsrepubliekduitsland
17. nemecko
18. spolkovarepublikanemecko
19. alemanha
20. republicafederaldaalemanha
21. niemczech
22. republikafederalnaniemiec
23. németország
24. németországiszövetségiköztársaság

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25. vokietijos
 26. vokietijosfederacinerespublika
 27. vacija
 28. vacijasfederativarepublika
 29. däitschland
 30. bundesrepublikdäitschland
 31. germanja
 32. republikafederalitagermanja
 33. gearmaine
 34. poblachtchnaidhmenagearmaine
 35. saksamaa
 36. saksamaaliitvabariik
 37. nemcija
 38. zweznarepublikanemcija
 - 39.
 40. saksa
 41. saksanliittotasavalta
 42. Baden-Württemberg
 43. Bavaria
 44. Bayern
 45. Berlin
 46. Brandenburg
 47. Bremen
 48. Hamburg
 49. Hessen
 50. Lower-Saxony
 51. Mecklenburg-Western-Pomerania
 52. Mecklenburg-Vorpommern
 53. niedersachsen
 54. nordrhein-Westfalen
 55. northrhine-Westphalia
 56. Rheinland-Pfalz
 57. Rhineland-Palatinate
 58. Saarland

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59. Sachsen
 60. Sachsen-Anhalt
 61. Saxony
 62. Saxony-Anhalt
 63. Schleswig-Holstein
 64. Thüringen
 65. Thuringia
 66. Baden-Wuerttemberg
 67. bade-wurtemberg
 68. le-bade-wurtemberg
 69. Baden-Wurttemberg
 70. BadenWürttemberg
 71. BadenWuerttemberg
 72. badewurtemberg
 73. lebadewurtemberg
 74. BadenWurttemberg
 75. Baviera
 76. Bavière
 77. Freistaat-Bayern
 78. FreistaatBayern
 79. Free-State-of-Bavaria
 80. Stato-Libero-di-Baviera
 81. Etat-Libre-Bavière
 82. Brandebourg
 83. Brandeburgo
 84. Brandenburgii
 85. freieundhansestadthamburg
 86. freie-und-hansestadt-hamburg
 87. freiehansestadthamburg
 88. freie-hansestadt-hamburg
 89. hansestadt-hamburg
 90. hansestadthamburg
 91. stadthamburg
 92. stadt-hamburg

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93. hamburg-stadt
 94. hamburg
 95. landhamburg
 96. land-hamburg
 97. hamburku
 98. hampuriin
 99. hamborg
 100. hamburgo
 101. hambourg
 102. amburgo
 103. hamburgu
 104. hanbao
 105. hamburuku
 106. hamburk
 107. hesse
 108. hassia
 109. nordrheinwestfalen
 110. northrhinewestphalia
 111. northrhine-westfalia
 112. northrhinewestfalia
 113. rhenanie-du-nord-westphalie
 114. rhenaniedunordwestphalie
 115. lasaxe
 116. sachsen
 117. sajonia
 118. sajonia
 119. saksen
 120. saksimaa
 121. saksio
 122. saksonia
 123. saksonijos
 124. saka
 125. saska
 126. sasko

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127. sassonia
 128. saxe
 129. saxonía
 130. saxonía
 131. szaszország
 132. szaszország
 - 133.
 - 134.
 135. freistaat-sachsen
 136. sorben
 137. serbja
 138. Sorben-Wenden
 139. Wenden
 140. lausitzer-sorben
 141. domowina

GREECE

1. Grecia
2. Graekenland
3. Griechenland
4. Hellas
5. Greece
6. Grece
7. Grecia
8. Griekenland
9. Grecia
10. Kreikka
11. Grekland
12. Recko
13. Kreeka
14. Graecia
15. Graikija
16. Gorogország
17. Grecja
18. Grecja

19. Grecko

20. Grcija

HUNGARY

1. magyarkoztarsasag

2. republicofhungary

3. republicuedehongrie

4. republikungarn

5. republicadehungria

6. repubblicadiungheria

7. republicadahungria

8. ungerskarepubliken

9. unkarintasavalt

10. denungarskerepublik

11. derepublikhongarije

12. republikawegierska

13. ungarivabariik

14. ungarijasrepublika

15. vengrijosrepublika

16. magyarország

17. hungary

18. hongrie

19. ungarn

20. hungria

21. ungheria

22. unger

23. unkari

24. hongarije

25. wegry

26. madarsko

27. ungari

28. ungarija

29. vengrija

30. magyarköztarsasag

31. magyarország

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32. madarskarepublika
 33. republikamadzarska
 34. madzarsko
 - 35.
 - 36.
 37. nyugatdunantul
 38. középdunantul
 39. déldunantul
 40. középmagyarország
 41. északmagyarország
 42. északalföld
 43. délföld
 44. nyugatdunantul
 45. kozepdunantul
 46. deldunantul
 47. kozepmagyarország
 48. eszakmagyarország
 49. eszakalfold
 50. delalfold
- IRELAND
1. irlandia
 2. irsko
 3. irland
 4. iirimaa
 5. ireland
 6. irlande
 7. irlandia
 8. rija
 9. Airija
 10. Irorszag
 11. L-Irlanda
 12. i
 13. ierland
 14. irlandia

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15. Irsko
 16. irska
 17. irlanti
 18. irland
 19. .irlande
 - 20.
 21. irlande
 22. republicofireland
 23. eire
- ITALY
1. Repubblica-Italiana
 2. RepubblicaItaliana
 3. Italia
 4. Italy
 5. Italian
 6. Italien
 7. Italija
 8. Italia
 9. Italie
 10. Italien
 11. Italie
 12. Italie
 13. Olaszország
 14. Itlija
 15. Woły
 - 16.
 17. Italja
 18. Taliansko
 19. Itaalia
 20. Abruzzo
 21. Basilicata
 22. Calabria
 23. Campania
 24. Emilia-Romagna

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25. Friuli-VeneziaGiulia
 26. Lazio
 27. Liguria
 28. Lombardia
 29. Marche
 30. Molise
 31. Piemonte
 32. Puglia
 33. Sardegna
 34. Sicilia
 35. Toscana
 36. Trentino-AltoAdige
 37. Umbria
 38. Valled'Aosta
 39. Veneto
- LATVIA
- 1.
 2. Lettorszag
 3. Latvja
 4. Letland
 5. Lotwa
 6. Letonia
 7. Lotyssko
 8. Latvija
 9. Lettland
 10. Latvia
 11. Lotyssko
 12. Letland
 13. Lettland
 14. Lati
 15. Letonia
 16. Lettonie
 17. Lettonia
 18. Republicoflatvia

19. Latvijkajarespublika

LITHUANIA

1. lietuva

2. leedu

3. liettua

4. litauen

5. lithouania

6. lithuania

7. litouwen

8. lituania

9. lituanie

10. litva

11. litvan

12. litvania

13. litvanya

14. litwa

15. litwanja

16. liettuan

17. litevska

18. lietuvos

19. litwy

20. litovska

21. aukstaitija

22. zemaitija

23. dzukija

24. suvalkija

25. suduva

26. lietuvos-respublika

27. lietuvos_respublika

28. lietuvosrepublika

29. republic-of-lithuania

30. republic_of_lithuania

31. republiclithuania

32. republicoflithuania

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33. republique-de-lituanie
 34. republique_de_lituanie
 35. republiquelituanie
 36. republiquedelituanie
 37. republica-de-lituania
 38. republica_de_lituania
 39. republicalituania
 40. republicadelituania
 41. litovskajarespublika
 42. litovskaja-respublika
 43. litovskaja_respublika
 44. litauensrepublik
 45. litauens-republik
 46. litauens_republic
 47. republiklitauen
 48. republik-litauen
 49. republic_litauen
 - 50.
 51. --
 52. __
 - 53.
 54. --
 55. __
 56. repubblicadilituania
 57. repubblica-di-lituania
 58. repubblica_di_lituania
 59. republieklitouwen
 60. republiek-litouwen
 61. republiek_litouwen
 62. republicadalituania
 63. republica-da-lituania
 64. republica_da_lituania
 65. liettuantasavalta
 66. liettuan-tasavalta

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67. liettuan_tasavalta
 68. republikenLitauen
 69. republiken-litauen
 70. republiken_litauen
 71. litevskarepublika
 72. litevska-republika
 73. litevska_republika
 74. leeduvabariik
 75. leedu-vabariik
 76. leedu_vabariik
 77. lietuvarepublika
 78. lietuvarepublika
 79. lietuvarepublika
 80. litvanköztarsasag
 81. litvan-köztarsasag
 82. litvan_köztarsasag
 83. republikatallitwanja
 84. republika-tal-litwanja
 85. republika_tal_litwanja
 86. republikalitwy
 87. republika-litwy
 88. republika_litwy
 89. litovskarepublika
 90. litovska-republika
 91. litovska_republika
 92. republikalitva
 93. republika-litva
 94. republika_litva

LUXEMBOURG

1. luxembourg
2. luxemburg
3. letzebuerg

MALTA

1. malta

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2. malte
 3. melita
 4. republicofmalta
 5. republic-of-malta
 6. therepublicofmalta
 7. the-republic-of-malta
 8. repubblikatamalta
 9. repubblika-ta-malta
 10. maltarepublic
 11. maltarepubblika
 12. gozo
 13. ghawdex

NETHERLANDS

1. nederland
2. holland
3. thenetherlands
4. netherlands
5. lespaysbas
6. hollande
7. dieniederlande
8. lospaisesbajos
9. holanda

POLAND

1. rzeczpospolitapolska
2. rzeczpospolita_polska
3. rzeczpospolita-polska
4. polska
5. polonia
6. lenkija
7. poland
8. polen
9. pologne
10. polsko
11. poola

12. puola

PORTUGAL

1. republicaportuguesa

2. portugal

3. portugalia

4. portugalia

5. portugali

6. portugalska

7. portugalsko

8. portogallo

9. portugalija

10. portekiz

11.

12. portugle

13. aveiro

14. beja

15. braga

16. bragança

17. castelobranco

18. coimbra

19. evora

20. faro

21. guarda

22. leiria

23. lisboa

24. portalegre

25. porto

26. santarem

27. setubal

28. vianadocastelo

29. viseu

30. vilareal

31. madeira

32. açores

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33. alentejo
 34. algarve
 35. altoalentejo
 36. baixoalentejo
 37. beiraalta
 38. beirabaixa
 39. beirainterior
 40. beiralitoral
 41. beiratransmontana
 42. douro
 43. dourolitoral
 44. entredouroeminho
 45. estremadura
 46. minho
 47. ribatejo
 48. tras-os-montes-e-alto-douro
 49. acores

SLOVAKIA

1. slowakische-republik
2. republique-slovaque
3. slovaki-dimokratia
4. slovenska-republika
5. slovakiske-republik
6. slovaki-vabariik
7. slovakian-tasavalta
8. slovaki-dimokratia
9. slovaki-dimokratia
10. szlovak-koztarsasag
11. slovak-republic
12. repubblica-slovacca
13. slovaki-jas-republika
14. slovaki-jos-respublika
15. repubblica-slovacka
16. slowaakse-republiek

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17. republika-slowacka
 18. republica-eslovaca
 19. slovaska-republika
 20. republica-eslovaca
 21. slovakiska-republiken
 22. β-
 23. slowakischerepublik
 24. republikeslovaque
 25. slovenskarepublika
 26. slovakiskerepublik
 27. slovakivabariik
 28. slovakiantasavalta
 29. szlovakkoztarsasag
 30. slovakrepublic
 31. repubblicaslovacca
 32. slovakijasrepublika
 33. slovakijosrepublika
 34. repubblikaslovakka
 35. slowaakserepubliek
 36. republikaslowacka
 37. republicaeslovaca
 38. slovaskarepublika
 39. republicaeslovaca
 40. slovakiskarepubliken
 41. β
 42. slowakei
 43. slovaquie
 44. slovakia
 45. slovensko
 46. slovakiet
 47. slovakkia
 48. szlovakia
 49. slovacchia
 50. slovakija

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51. slowakije
 52. slowacija
 53. eslovaquia
 54. slovaska
 55. ß
 56. slovakiem
 57. république-slovaque
 58. slovenska-republika
 59. szlovak-köztarsasag
 60. slovkijos-respublika
 61. republika-sowacka
 62. republica-eslovaca
 63. slovaka-republika
 64. slovaka-republika
 65. ludveldid-slovakia
 66. républiqueslovaque
 67. slovenskarepublika
 68. szlovakköztarsasag
 69. slovkijosrespublika
 70. republikasowacka
 71. republicaeslovaca
 72. slovakarepublika
 73. slovakarepublika
 74. ludveldidslovakia
 75. szlovakia
 76. slovkija
 77. sowacija
 78. slovaka
 79. slovaka
- SLOVENIA**
1. slovenija
 2. slovenia
 3. slowenien
 4. slovenie

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5. la-slovenie
 6. laslovenie
 7. eslovenia
 8. republikaslovenija
 9. republika-slovenija
 10. republicofslovenia
 11. republic-of-slovenia
 12. szlovenia
 13. szlovenkoztarsasag
 14. szloven-koztarsasag
 15. repubblicadislovenia
 16. repubblica-di-slovenia

SPAIN

1. españa
2. reinodeespana
3. reino-de-espana
4. espagne
5. espana
6. espanha
7. espanja
8. espanya
9. hispaania
10. hiszpania
11. ispanija
12. spagna
13. spain
14. spanielsko
15. spanien
16. spanija
17. spanje
18. reinodeespaña
19. reino-de-españa
20. panielsko
21. spnija

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22. panija
 23. panilsko
 24. espainia
 25. ispania
 - 26.
 27. andalucia
 28. andalucía
 29. andalousie
 30. andalusia
 31. andalusien
 32. juntadeandalucia
 33. juntadeandalucía
 34. aragon
 35. aragon
 36. gobiernodearagon
 37. gobiernoaragon
 38. principadodeasturias
 39. principaudasturies
 40. asturias
 41. asturies
 42. illesbalears
 43. islasbaleares
 44. canarias
 45. gobiernodecanarias
 46. canaryisland
 47. kanarischeinseln
 48. cantabria
 49. gobiernodecantabria
 50. castillalamanca
 51. castilla-lamanca
 52. castillayleon
 53. castillayleon
 54. juntadecastillayleon
 55. juntadecastillayleon

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56. generalitatdecatalunya
 57. generalitatdecataluña
 58. catalunya
 59. cataluña
 60. katalonien
 61. catalonia
 62. catalogna
 63. catalogne
 64. cataloni
 65. katalonias
 66. catalunha
 67. kataloniens
 68. katalonian
 69. catalonie
 70. extremadura
 71. comunidadautonomadeextremadura
 72. comunidadautonomadeextremadura
 73. xuntadegalicia
 74. comunidadautonomadegalicia
 75. comunidaautonomadegalicia
 76. comunidadeautonomadegalicia
 77. comunidadeautonomadegalicia
 78. larioja
 79. gobiernodelarioja
 80. comunidadmadrid
 81. madridregion
 82. regionmadrid
 83. madrid
 84. murciaregion
 85. murciaregion
 86. murciaregione
 87. murciaregiao
 88. regiondemurcia
 89. regiondemurcia

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90. regionofmurcia
 91. regionvonmurcia
 92. regionedimurcia
 93. regiaodomurcia
 94. navarra
 95. nafarroa
 96. navarre
 97. navarracomunidadforal
 98. nafarroaforukomunitatea
 99. nafarroaforuerkidegoa
 100. communauteforaledenavarre
 101. communautéforaledenavarre
 102. foralcommunityofnavarra
 103. paisvasco
 104. paísvasco
 105. euskadi
 106. euskalherria
 107. paisbasc
 108. basquecountry
 109. paysbasque
 110. paesebasco
 111. baskenland
 112. paisbasco
 - 113.
 114. gobiernovasco
 115. euskojauraritza
 116. governbasc
 117. basquegovernment
 118. gouvernementbasque
 119. governobasco
 120. baskischeregierung
 121. baskitschebestuur
 - 122.
 123. comunidad-valenciana

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124. comunidadvalenciana
 125. comunitat-valenciana
 126. comunitatvalenciana
 127. ceuta
 128. gobiernoceuta
 129. melilla
 130. gobiernomelilla

SWEDEN

1. suecia
2. reinodesuecia
3. sverige
4. kongerietsverige
5. schweden
6. königreichschweden
7. konigreichschweden
- 8.
- 9.
10. sweden
11. kingdomofsweden
12. suède
13. suede
14. royaumesuède
15. royaumesuede
16. svezia
17. regnodisvezia
18. zweden
19. koninkrijkzweden
20. suécia
21. reinodasuécia
22. reinodasuecia
23. ruotsi
24. ruotsinkuningaskunta
25. konungariketsverige
26. védsko

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27. rootsi
 28. svedija
 29. svédország
 30. svedország
 31. l-isvezja
 32. szweja
 33. vedska
 34. svedska

UNITED KINGDOM

1. unitedkingdom
 2. united-kingdom
 3. united_kingdom
 4. greatbritain
 5. great-britain
 6. great_britain
 7. britain
 8. cymru
 9. england
 10. northernireland
 11. northern-ireland
 12. northern_ireland
 13. scotland
 14. wales
2. List of names per country and the countries that can reserve them

BULGARIA

- 1.
2. bulgaria
3. bulharsko
4. bulgarien
5. bulgaaria
- 6.
7. bulgarie
8. bulgarija
9. bulgarije

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10. bolgarija
 11. republicofbulgaria
 12. the-republic-of-bulgaria
 13. the_republic_of_bulgaria
 14. republic-of-bulgaria
 15. republic_of_bulgaria
 16. republicbulgaria
 17. republic-bulgaria
 18. republic_bulgaria
 19. repubblicadibulgaria
 20. repubblica-di-bulgaria
 21. repubblica_di_bulgaria
 22. repubblicabulgaria
 23. repubblica-bulgaria
 24. repubblica_bulgaria
 25. republikbulgarien
 26. republik-bulgarien
 27. republik_bulgarien
 28. bulgaariavabariik
 29. bulgaaria-vabariik
 30. bulgaaria_vabariik
 - 31.
 32. --
 33. ___
 34. republiekbulgarije
 35. republiek-bulgarije
 36. republiek_bulgarije
 37. republikabolgarija
 38. republika-bolgarija
 39. republika_bolgarija
 40. republikabulgaria
 41. republika-bulgaria
 42. republika_bulgaria
 43. bulharskarepublica

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44. bulharska-republica
 45. bulharska_republica
 46. republiqubulgarie
 47. republique-bulgarie
 48. republique_bulgarie
 49. republicabulgarija
 50. republica-bulgrija
 51. republica_bulgrija
 52. republikabulgaria
 53. republika-bulgaria
 54. republika_bulgaria
 55. republicabulgaria
 56. republica-bulgaria
 57. republica_bulgaria
 58. bulgarja
 59. blgarija
 60. bulgariantasavalta
 61. bulgarian-tasavalta
 62. bulgarian_tasavalta
 63. republikenbulgarien
 64. republiken-bulgarien
 65. republiken_bulgarien
 66. repulicabulgaria
 67. repulica-bulgaria
 68. repulica_bulgaria
 69. köztarsasagbulgaria
 70. köztarsasag-bulgaria
 71. köztarsasag_bulgaria

CROATIA

1. croatia
2. kroatia
3. kroatien
4. kroatien
5. croazia

-
6. kroatien
 7. croacia
 8. croatie
 9. horvatorszag
 10. horvatorszag
 11. kroatie
 12. kroatie
 13. chorwacja
 - 14.
 15. chorvatsko
 16. charvatsko
 17. horvaatia
 18. kroaatia
 19. croacia
 20. croacia
 21. horvtija
 22. horvatija
 23. kroatija
 24. kroazja
 25. chorvatsko
 26. chrovatsko
 27. hrvaka
 28. hrvaska
- ICELAND
1. arepublicadeislândia
 2. deijslanrepubliek
 3. deijslanrepubliek
 4. derepubliekvanijslan
 5. derepubliekvanijslan
 6. iceland
 7. icelandrepublic
 8. iepublikaislande
 9. ijsland
 10. island

-
11. islanda
 12. islande
 13. islandia
 14. islândia
 15. islandica
 16. islandrepublik
 17. islandskylisejnik
 18. islannintasavalta
 19. islanti
 20. izland
 21. ísland
 22. íslenskalu=veldi=
 23. köztarsasagizland
 24. larepublicadiislanda
 25. larepublicadeislandia
 26. larépubliquedislande
 27. lislande
 28. lu=veldi=ísland
 29. puklerkaislandska
 30. rahvavabariikisland
 31. republicadiislanda
 32. republikataisland
 33. republicoficeland
 34. republikaisland
 35. republikaislandia
 36. republikavisland
 37. republikkenisland
 38. republikvonisland
 39. republicadeislandia
 40. republicadeislândia
 41. républiquedislande
 - 42.
 - 43.

LIECHTENSTEIN

1. fyrstendømmetliechtenstein
2. fürstentumliechtenstein
3. principalityofliechtenstein
4. liechtensteinivürstiriki
5. liechtensteininruhtinaskunta
6. principautédeliechtenstein
- 7.
8. furstadæmisinsliechtensteins
9. principatodelliechtenstein
10. lichtenteinokunigaiktyst
11. lihtenteinasfirstiste
12. prinipalitàtal-liechtenstein
13. vorstendomliechtenstein
14. fyrstedømmetliechtenstein
15. ksistwoliechtenstein
16. principadodoliechtenstein
17. furstendömetliechtenstein
18. lichtentajnskékníeatstvo
19. kneevinolihtentajn
20. principadodeliechtenstein
21. lichtentejnskékníectví
22. lichtensteinihercegség

NORWAY

1. norge
2. noreg
3. norway
4. norwegen
5. norvege
6. norvège
7. noruega
8. norvegia
9. norvégia
10. norsko
11. norsko

-
12. norra
 13. norja
 14. norvegija
 15. norvija
 16. noorwegen
 17. ß
 18. norvegja
 19. norveja
 20. norveska
 21. norveka
 22. norwegia
 23. norga

ROMANIA

1. românia
2. romania
3. roumanie
4. rumänien
5. rumanien
6. rumanía
7. rumænien
8. roménia
9. romênia
10. romenia
11. rumunia
12. rumunsko
13. romunija
14. rumanija
15. rumunija
16. rumeenia
- 17.
18. romania
19. rumanija
20. roemenie

TURKEY

1. turkiye
 2. türkiye
 3. turkiyecumhuriyeti
 4. türkiyecumhuriyeti
-

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**Commission Regulation (EC) No 874/2004
of 28 April 2004**

laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration (Text with EEA relevance)

Commission Regulation (EC) No 874/2004

of 28 April 2004

laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration

(Text with EEA relevance)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain(1), and in particular Article 5(1) thereof,

Having consulted the Registry in accordance with Article 5(1) of Regulation (EC) No 733/2002,

Whereas:

- (1) The initial implementation stages of the .eu Top Level Domain (TLD), to be created pursuant to Regulation (EC) No 733/2002, have been completed by designating a legal entity, established within the Community to administer and manage the .eu TLD Registry function. The Registry, designated by Commission Decision 2003/375/EC(2), is required to be a non-profit organisation that should operate and provide services on a cost covering basis and at an affordable price.
- (2) Requesting a domain name should be possible through electronic means in a simple, speedy and efficient procedure, in all official languages of the Community, through accredited registrars.
- (3) Accreditation of registrars should be carried out by the Registry following a procedure that ensures fair and open competition between Registrars. The accreditation process should be objective, transparent and non-discriminatory. Only parties who meet certain basic technical requirements to be determined by the Registry should be eligible for accreditation.
- (4) Registrars should only accept applications for the registration of domain names filed after their accreditation and should forward them in the chronological order in which they were received.
- (5) To ensure better protection of consumers' rights, and without prejudice to any Community rules concerning jurisdiction and applicable law, the applicable law in disputes between registrars and registrants on matters concerning Community titles should be the law of one of the Member States.
- (6) Registrars should require accurate contact information from their clients, such as full name, address of domicile, telephone number and electronic mail, as well as information concerning a natural or legal person responsible for the technical operation of the domain name.
- (7) The Registry policy should promote the use of all the official languages of the Community.
- (8) Pursuant to Regulation (EC) No 733/2002, Member States may request that their official name and the name under which they are commonly known should not be registered directly under .eu TLD otherwise than by their national government. Countries that are expected to join the European Union later than May 2004 should be enabled to block their official names and the names under which they are commonly known, so that they can be registered at a later date.

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- (9) A Member State should be authorised to designate an operator that will register as a domain name its official name and the name under which it is commonly known. Similarly, the Commission should be authorised to select domain names for use by the institutions of the Community, and to designate the operator of those domain names. The Registry should be empowered to reserve a number of specified domain names for its operational functions.
 - (10) In accordance with Article 5(2) of Regulation (EC) No 733/2002, a number of Member States have notified to the Commission and to other Member States a limited list of broadly-recognised names with regard to geographical and/or geopolitical concepts which affect their political or territorial organisation. Such lists include names that could either not be registered or which could be registered only under the second level domain in accordance with the public policy rules. The names included in these lists are not subject to the first-come first-served principle.
 - (11) The principle of first-come-first-served should be the basic principle for resolving a dispute between holders of prior rights during the phased registration. After the termination of the phased registration the principle of first come first served should apply in the allocation of domain names.
 - (12) In order to safeguard prior rights recognised by Community or national law, a procedure for phased registration should be put in place. Phased registration should take place in two phases, with the aim of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights. The Registry should ensure that validation of the rights is performed by appointed validation agents. On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name. Allocation of that name should then take place on a first-come, first-served basis if there are two or more applicants for a domain name, each having a prior right.
 - (13) The Registry should enter into an appropriate escrow agreement to ensure continuity of service, and in particular to ensure that in the event of re-delegation or other unforeseen circumstances it is possible to continue to provide services to the local Internet community with minimum disruption. The Registry should also comply with the relevant data protection rules, principles, guidelines and best practices, notably concerning the amount and type of data displayed in the WHOIS database. Domain names considered by a Member State court to be defamatory, racist or contrary to public policy should be blocked and eventually revoked once the court decision becomes final. Such domain names should be blocked from future registrations.
 - (14) In the event of the death or insolvency of a domain name holder, if no transfer has been initiated at the expiry of the registration period, the domain name should be suspended for 40 calendar days. If the heirs or administrators concerned have not registered the name during that period it should become available for general registration.
 - (15) Domain names should be open to revocation by the Registry on a limited number of specified grounds, after giving the domain name holder concerned an opportunity to take appropriate measures. Domain names should also be capable of revocation through an alternative dispute resolution (ADR) procedure.
 - (16) The Registry should provide for an ADR procedure which takes into account the international best practices in this area and in particular the relevant World Intellectual Property Organization (WIPO) recommendations, to ensure that speculative and abusive registrations are avoided as far as possible.
 - (17) The Registry should select service providers that have appropriate expertise on the basis of objective, transparent and non-discriminatory criteria. ADR should respect a minimum of uniform procedural rules, similar to the ones set out in the Uniform Dispute Resolution Policy adopted

by the Internet Corporation of Assigned Names and Numbers (ICANN).

- (18) In view of the impending enlargement of the Union it is imperative that the system of public policy rules set up by this Regulation enter into force without delay.
- (19) The measures provided for in this Regulation are in accordance with the opinion of the Communications Committee established by Article 22(1) of Directive 2002/21/EC of the European Parliament and of the Council(3),

HAS ADOPTED THIS REGULATION:

CHAPTER I SUBJECT MATTER

Article 1

Subject matter

This Regulation sets out the public policy rules concerning the implementation and functions of the.eu Top Level Domain (TLD) and the public policy principles on registration referred to in Article 5(1) of Regulation (EC) No 733/2002.

CHAPTER II PRINCIPLES ON REGISTRATION

Article 2

Eligibility and general principles for registration

An eligible party, as listed in Article 4(2)(b) of Regulation (EC) No 733/2002, may register one or more domain names under.eu TLD.

Without prejudice to Chapter IV, a specific domain name shall be allocated for use to the eligible party whose request has been received first by the Registry in the technically correct manner and in accordance with this Regulation. For the purposes of this Regulation, this criterion of first receipt shall be referred to as the "first-come-first-served" principle.

Once a domain name is registered it shall become unavailable for further registration until the registration expires without renewal, or until the domain name is revoked.

Unless otherwise specified in this Regulation, domain names shall be registered directly under the.eu TLD.

Domain name registration shall be valid only after the appropriate fee has been paid by the requesting party.

Domain names registered under the.eu TLD shall only be transferable to parties that are eligible for registration of.eu domain names.

Article 3

Requests for domain name registration

The request for domain name registration shall include all of the following:

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- (a) the name and address of the requesting party;
 - (b) a confirmation by electronic means from the requesting party that it satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002;
 - (c) an affirmation by electronic means from the requesting party that to its knowledge the request for domain name registration is made in good faith and does not infringe any rights of a third party;
 - (d) an undertaking by electronic means from the requesting party that it shall abide by all the terms and conditions for registration, including the policy on the extra-judicial settlement of conflicts set out in Chapter VI.

Any material inaccuracy in the elements set out in points (a) to (d) shall constitute a breach of the terms of registration.

Any verification by the Registry of the validity of registration applications shall take place subsequently to the registration at the initiative of the Registry or pursuant to a dispute for the registration of the domain name in question, except for applications filed in the course of the phased registration procedure under Articles 10, 12, and 14.

Article 4

Accreditation of registrars

Only registrars accredited by the Registry shall be permitted to offer registration services for names under the.eu TLD.

The procedure for the accreditation of registrars shall be determined by the Registry and shall be reasonable, transparent and non-discriminatory, and shall ensure effective and fair conditions of competition.

Registrars are required to access and use the Registry's automated registration systems. The Registry may set further basic technical requirements for the accreditation of registrars.

The Registry may ask registrars for advance payment of registration fees, to be set annually by the Registry based on a reasonable market estimate.

The procedure, terms of accreditation of registrars and the list of accredited registrars shall be made publicly available by the Registry in readily accessible form.

Each registrar shall be bound by contract with the Registry to observe the terms of accreditation and in particular to comply with the public policy principles set out in this Regulation.

Article 5

Provisions for registrars

Without prejudice to any rule governing jurisdiction and applicable law, agreements between the Registrar and the registrant of a domain name cannot designate, as applicable law, a law other than the law of one of the Member States, nor can they designate a dispute-resolution body, unless selected by the Registry pursuant to Article 23, nor an arbitration court or a court located outside the Community.

A registrar who receives more than one registration request for the same name shall forward those requests to the Registry in the chronological order in which they were received.

Only applications received after the date of accreditation shall be forwarded to the Registry.

Registrars shall require all applicants to submit accurate and reliable contact details of at least one natural or legal person responsible for the technical operation of the domain name that is requested.

Registrars may develop label, authentication and trustmark schemes in order to promote consumer confidence in the reliability of information that is available under a domain name that is registered by them, in accordance with applicable national and Community law.

CHAPTER III LANGUAGES AND GEOGRAPHICAL CONCEPTS

Article 6

Languages

Registrations of .eu domain names shall start only after the Registry has informed the Commission that the filing of applications for the registration of .eu domain names and communications of decisions concerning registration is possible in all official languages of the Community, hereinafter referred to as "official languages".

For any communication by the Registry that affects the rights of a party in conjunction with a registration, such as the grant, transfer, cancellation or revocation of a domain, the Registry shall ensure that these communications are possible in all official languages.

The Registry shall perform the registration of domain names in all the alphabetic characters of the official languages when adequate international standards become available.

The Registry shall not be required to perform functions using languages other than the official languages.

Article 7

Procedure for reserved geographical and geopolitical names

For the procedure of raising objections to the lists of broadly recognised names in accordance with the third subparagraph of Article 5(2) of Regulation (EC) No 733/2002, objections shall be notified to the members of the Communications Committee established by Article 22(1) of Directive 2002/21/EC and to the Director-General of the Commission's Directorate-General Information Society. The members of the Communications Committee and the Director-General may designate other contact points for these notifications.

Objections and designations of contact points shall be notified in the form of electronic mail, delivery by courier or in person, or by postal delivery effected by way of registered letter and acknowledgement of receipt.

Upon the resolution of any objections, the Registry shall publish on its web site two lists of names. The one list shall contain the list of names that the Commission shall have notified as "not registrable". The other list shall contain the list of names that the Commission shall have notified to the Registry as "registrable only under a second level domain".

Article 8

Country names and alpha-2 codes representing countries

Member States (and acceding countries) may request that their official name and the name under which they are commonly known in one or more of the official languages (of the Community as extended in May 2004) shall not be registered directly under the.eu TLD by any person other than their national government. To that end, each Member State (or acceding country) shall send the Commission, within two months following the entry into force of this Regulation, a list of those names requiring to be reserved, as well as a designation of the body that will represent the national government in registering the names.

The Commission shall notify the Registry of the names that shall be reserved and the bodies that represent the national governments in registering the names.

Candidate countries that are not due to join the European Union in May 2004 and member countries of the European Economic Area that are not Member States may request that their official name and the name under which they are commonly known in their own language and in any of the official languages as from May 2004 shall not be registered directly under the.eu TLD. To that end, those countries may send the Commission, within two months following entry into force of this Regulation, a list of those names which are not to be registered.

The Commission shall notify the Registry of the names that shall not be registered.

Alpha-2 codes representing countries shall not be used to register domain names directly under the.eu TLD.

Article 9

Second level domain name for geographical and geopolitical names

Registration of geographical and geopolitical concepts as domain names in accordance with Article 5(2)(b) of Regulation (EC) No 733/2002 may be provided for by a Member State that has notified the names. This may be done under any domain name that has been registered by that Member State.

The Commission may ask the Registry to introduce domain names directly under the.eu TLD for use by the Community institutions and bodies. After the entry into force of this Regulation and not later than a week before the beginning of the phased registration period provided for in Chapter IV, the Commission shall notify the Registry of the names that are to be reserved and the bodies that represent the Community institutions and bodies in registering the names.

CHAPTER IV PHASED REGISTRATION*Article 10*

Eligible parties and the names they can register

1. Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of. eu domain starts.

"Prior rights" shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.

"Public bodies" shall include: institutions and bodies of the Community, national and local governments, governmental bodies, authorities, organisations and bodies governed by public law, and international and intergovernmental organisations.

2. The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists.

3. The registration by a public body may consist of the complete name of the public body or the acronym that is generally used. Public bodies that are responsible for governing a particular geographic territory may also register the complete name of the territory for which they are responsible, and the name under which the territory is commonly known.

Article 11

Special characters

As far as the registration of complete names is concerned, where such names comprise a space between the textual or word elements, identity shall be deemed to exist between such complete names and the same names written with a hyphen between the word elements or combined in one word in the domain name applied for.

Where the name for which prior rights are claimed contains special characters, spaces, or punctuations, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten.

Special character and punctuations as referred to in the second paragraph shall include the following:

~ @ >REFERENCE TO A GRAPHIC> \$ % ^ & * () + = < > { } [...] | \ / : ; ' , . ?

Without prejudice to the third paragraph of Article 6, if the prior right name contains letters which have additional elements that cannot be reproduced in ASCII code, such as ä, é or ñ, the letters concerned shall be reproduced without these elements (such as a, e, n), or shall be replaced by conventionally accepted spellings (such as ae). In all other respects, the domain name shall be identical to the textual or word elements of the prior right name.

Article 12

Principles for phased registration

1. Phased registration shall not start before 1 May 2004 and only when the requirement of the first paragraph of Article 6 is fulfilled and the period provided for in Article 8 has expired.

The Registry shall publish the date on which phased registration shall start at least two months in advance and shall inform all accredited Registrars accordingly.

The Registry shall publish on its website two months before the beginning of the phased registration a detailed description of all the technical and administrative measures that it shall use to ensure a proper, fair and technically sound administration of the phased registration period.

2. The duration of the phased registration period shall be four months. General registration of domain names shall not start prior to the completion of the phased registration period.

Phased registration shall be comprised of two parts of two months each.

During the first part of phased registration, only registered national and Community trademarks, geographical indications, and the names and acronyms referred to in Article 10(3), may be applied for as domain names by holders or licensees of prior rights and by the public bodies mentioned in Article 10(1).

During the second part of phased registration, the names that can be registered in the first part as well as names based on all other prior rights can be applied for as domain names by holders of prior rights on those names.

3. The request to register a domain name based on a prior right under Article 10(1) and (2) shall include a reference to the legal basis in national or Community law for the right to the name, as well as other relevant information, such as trademark registration number, information concerning publication in an official journal or government gazette, registration information at professional or business associations and chambers of commerce.

4. The Registry may make the requests for domain name registration subject to payment of additional fees, provided that these serve merely to cover the costs generated by the application of this Chapter. The Registry may charge differential fees depending upon the complexity of the process required to validate prior rights.

5. At the end of the phased registration an independent audit shall be performed at the expense of the Registry and shall report its findings to the Commission. The auditor shall be appointed by the Registry after consulting the Commission. The purpose of the audit shall be to confirm the fair, appropriate and sound operational and technical administration of the phased registration period by the Registry.

6. To resolve a dispute over a domain name the rules provided in Chapter VI shall apply.

Article 13

Selection of validation agents

Validation agents shall be legal persons established within the territory of the Community. Validation agents shall be reputable bodies with appropriate expertise. The Registry shall select the validation agents in an objective, transparent and non-discriminatory manner, ensuring the widest possible geographical diversity. The Registry shall require the validation agent to execute the validation in an objective, transparent and non-discriminatory manner.

Member States shall provide for validation concerning the names mentioned in Article 10(3). To that end, the Member States shall send to the Commission within two months following entry into force of this Regulation, a clear indication of the addresses to which documentary evidence is to be sent for verification. The Commission shall notify the Registry of these addresses.

The Registry shall publish information about the validation agents at its website.

Article 14

Validation and registration of applications received during phased registration

All claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists.

The Registry, upon receipt of the application, shall block the domain name in question until validation has taken place or until the deadline passes for receipt of documentation. If the Registry receives more than one claim for the same domain during the phased registration period, applications shall be dealt with in strict chronological order.

The Registry shall make available a database containing information about the domain names applied for under the procedure for phased registration, the applicants, the Registrar that submitted the application, the deadline for submission of validation documents, and subsequent claims on the names.

Every applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question. The documentary evidence shall be submitted to a validation agent indicated by the Registry. The applicant shall submit the evidence in such a way that it shall be received by the validation agent within forty days from the submission of the application for the domain name. If the documentary evidence has not been received by this deadline, the application for the domain name shall be rejected.

Validation agents shall time-stamp documentary evidence upon receipt.

Validation agents shall examine applications for any particular domain name in the order in which the application was received at the Registry.

The relevant validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name. If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this.

If the validation agent finds that prior rights exist regarding the application for a particular domain name that is first in line, he shall notify the Registry accordingly.

This examination of each claim in chronological order of receipt shall be followed until a claim is found for which prior rights on the name in question are confirmed by a validation agent.

The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs.

CHAPTER V RESERVATIONS, WHOIS DATA AND IMPROPER REGISTRATIONS

Article 15

Escrow agreement

1. The Registry shall, at its own expense, enter into an agreement with a reputable trustee or other escrow agent established within the territory of the Community designating the Commission as the beneficiary of the escrow agreement. The Commission shall give its consent to that agreement

before it is concluded. The Registry shall submit to the escrow agent on a daily basis an electronic copy of the current content of the.eu database.

2. The agreement shall provide that the data shall be held by the escrow agent on the following terms and conditions:

- (a) the data shall be received and held in escrow, undergoing no procedure other than verification that it is complete, consistent, and in proper format, until it is released to the Commission;
- (b) the data shall be released from escrow upon expiration without renewal or upon termination of the contract between the Registry and the Commission for any of the reasons described therein and irrespectively of any disputes or litigation between the Commission and the Registry;
- (c) in the event that the escrow is released, the Commission shall have the exclusive, irrevocable, royalty-free right to exercise or to have exercised all rights necessary to re-designate the Registry;
- (d) if the contract with the Registry is terminated the Commission, with the cooperation of the Registry, shall take all necessary steps to transfer the administrative and operational responsibility for the.eu TLD and any reserve funds to such party as the Commission may designate: in that event, the Registry shall make all efforts to avoid disruption of the service and shall in particular continue to update the information that is subject to the escrow until the time of completion of the transfer.

Article 16

WHOIS database

The purpose of the WHOIS database shall be to provide reasonably accurate and up to date information about the technical and administrative points of contact administering the domain names under the.eu TLD.

The WHOIS database shall contain information about the holder of a domain name that is relevant and not excessive in relation to the purpose of the database. In as far as the information is not strictly necessary in relation to the purpose of the database, and if the domain name holder is a natural person, the information that is to be made publicly available shall be subject to the unambiguous consent of the domain name holder. The deliberate submission of inaccurate information, shall constitute grounds for considering the domain name registration to have been in breach of the terms of registration.

Article 17

Names reserved by the Registry

The following names shall be reserved for the operational functions of the Registry:

eurid.eu, registry.eu, nic.eu, dns.eu, internic.eu, whois.eu, das.eu, coc.eu, eurethix.eu, eurethics.eu, euthics.eu

Article 18

Improper registrations

Where a domain name is considered by a Court of a Member State to be defamatory, racist or contrary to public policy, it shall be blocked by the Registry upon notification of a Court decision and shall be revoked upon notification of a final court decision. The Registry shall block from future registration those names which have been subject to such a court order for as long as such order remains valid.

Article 19

Death and winding up

1. If the domain name holder dies during the registration period of the domain name, the executors of his or her estate, or his or her legal heirs, may request transfer of the name to the heirs along with submission of the appropriate documentation. If, on expiry of the registration period, no transfer has been initiated, the domain name shall be suspended for a period of 40 calendar days and shall be published on the Registry's website. During this period the executors or the legal heirs may apply to register the name along with submission of the appropriate documentation. If the heirs have not registered the name during that 40-day period, the domain name shall thereafter become available for general registration.

2. If the domain name holder is an undertaking, a legal or natural person, or an organisation that becomes subject to insolvency proceedings, winding up, cessation of trading, winding up by court order or any similar proceeding provided for by national law, during the registration period of the domain name, then the legally appointed administrator of the domain name holder may request transfer to the purchaser of the domain name holders assets along with submission of the appropriate documentation. If, on expiry of the registration period, no transfer has been initiated, the domain name shall be suspended for a period of forty calendar days and shall be published on the registry's website. During this period the administrator may apply to register the name along with submission of appropriate documentation. If the administrator has not registered the name during that 40-day period, the domain name shall thereafter become available for general registration.

CHAPTER VI REVOCATION AND SETTLEMENT OF CONFLICTS

Article 20

Revocation of domain names

The Registry may revoke a domain name at its own initiative and without submitting the dispute to any extrajudicial settlement of conflicts, exclusively on the following grounds:

- (a) outstanding unpaid debts owed to the Registry;
- (b) holder's non-fulfilment of the general eligibility criteria pursuant to Article 4(2)(b) of Regulation (EC) 733/2002;
- (c) holder's breach of the terms of registration under Article 3.

The Registry shall lay down a procedure in accordance with which it may revoke domain names on these grounds. This procedure shall include a notice to the domain name holder and shall afford him an opportunity to take appropriate measures.

Revocation of a domain name, and where necessary its subsequent transfer, may also be effected in accordance with a decision issued by an extrajudicial settlement body.

Article 21

Speculative and abusive registrations

1. A registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where that name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it:

- (a) has been registered by its holder without rights or legitimate interest in the name; or
- (b) has been registered or is being used in bad faith.

2. A legitimate interest within the meaning of point (a) of paragraph 1 may be demonstrated where:

- (a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;
- (b) the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law;
- (c) the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law.

3. Bad faith, within the meaning of point (b) of paragraph 1 may be demonstrated, where:

- (a) circumstances indicate that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognised or established by national and/or Community law or to a public body; or
- (b) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognised or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that:
 - (i) a pattern of such conduct by the registrant can be demonstrated; or
 - (ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or
- (iii) in circumstances where, at the time the ADR procedure was initiated, the holder of a domain name in respect of which a right is recognised or established by national and/or Community law or the holder of a domain name of a public body has declared his/its intention to use the domain name in a relevant way but fails to do so within six months of the day on which the ADR procedure was initiated;

- (c) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or
 - (d) the domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognised or established by national and/or Community law or a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the holder of a domain name; or
 - (e) the domain name registered is a personal name for which no demonstrable link exists between the domain name holder and the domain name registered.
4. The provisions in paragraphs 1, 2 and 3 may not be invoked so as to obstruct claims under national law.

Article 22

Alternative dispute resolution (ADR) procedure

1. An ADR procedure may be initiated by any party where:

- (a) the registration is speculative or abusive within the meaning of Article 21; or
- (b) a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002.

2. Participation in the ADR procedure shall be compulsory for the holder of a domain name and the Registry.

3. A fee for the ADR shall be paid by the complainant.

4. Unless otherwise agreed by the parties, or specified otherwise in the registration agreement between registrar and domain name holder, the language of the administrative proceeding shall be the language of that agreement. This rule shall be subject to the authority of the panel to determine otherwise, having regard to the circumstances of the case.

5. The complaints and the responses to those complaints must be submitted to an ADR provider chosen by the complainant from the list referred to in the first paragraph of Article 23. That submission shall be made in accordance with this Regulation and the published supplementary procedures of the ADR provider.

6. As soon as a request for ADR is properly filed with the ADR provider and the appropriate fee is paid, the ADR provider shall inform the Registry of the identity of the complainant and the domain name involved. The Registry shall suspend the domain name involved from cancellation or transfer until the dispute resolution proceedings or subsequent legal proceedings are complete and the decision has been notified to the Registry.

7. The ADR provider shall examine the complaint for compliance with its rules of procedure, with the provisions of this Regulation and with Regulation (EC) No 733/2002, and, unless non-compliance is established, shall forward the complaint to the respondent within five working days following receipt of the fees to be paid by the complainant.

8. Within 30 working days of the date of receipt of the complaint the respondent shall submit a response to the provider.

9. Any written communication to a complainant or respondent shall be made by the preferred means stated by the complainant or respondent, respectively, or in the absence of such specification electronically via the Internet, provided that a record of transmission is available.

All communications concerning the ADR procedure to the holder of a domain name that is subject to an ADR procedure shall be sent to the address information that is available to the Registrar that maintains the registration of the domain name in accordance with the terms and conditions of registration.

10. Failure of any of the parties involved in an ADR procedure to respond within the given deadlines or appear to a panel hearing may be considered as grounds to accept the claims of the counterparty.

11. In the case of a procedure against a domain name holder, the ADR panel shall decide that the domain name shall be revoked, if it finds that the registration is speculative or abusive as defined in Article 21. The domain name shall be transferred to the complainant if the complainant applies for this domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002.

In the case of a procedure against the Registry, the ADR panel shall decide whether a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002. The ADR panel shall decide that the decision shall be annulled and may decide in appropriate cases that the domain name in question shall be transferred, revoked or attributed, provided that, where necessary, the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002 are fulfilled.

The decision of the ADR panel shall state the date for implementation of the decision.

Decisions of the panel are taken by simple majority. The alternative dispute panel shall issue its decision within one month from the date of receipt of the response by the ADR provider. The decision shall be duly motivated. The decisions of the panel shall be published.

12. Within three working days after receiving the decision from the panel, the provider shall notify the full text of the decision to each party, the concerned registrar(s) and the Registry. The decision shall be notified to the Registry and the complainant by registered post or other equivalent electronic means.

13. The results of ADR shall be binding on the parties and the Registry unless court proceedings are initiated within 30 calendar days of the notification of the result of the ADR procedure to the parties.

Article 23

Selection of providers and panellists for alternative dispute resolution

1. The Registry may select ADR providers, who shall be reputable bodies with appropriate expertise in an objective, transparent and non-discriminatory manner. A list of the ADR providers shall be published on the Registry's website.

2. A dispute which is submitted to the ADR procedure shall be examined by arbitrators appointed to a panel of one or three members.

The panellists shall be selected in accordance to the internal procedures of the selected ADR providers. They shall have appropriate expertise and shall be selected in an objective, transparent and non-discriminatory manner. Each provider shall maintain a publicly available list of panellists

and their qualifications.

A panellist shall be impartial and independent and shall have, before accepting appointment, disclosed to the provider any circumstances giving rise to justifiable doubt as to their impartiality or independence. If, at any stage during the administrative proceedings, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the panellist, that panellist shall promptly disclose such circumstances to the provider.

In such event, the provider shall appoint a substitute panellist.

CHAPTER VII FINAL PROVISIONS

Article 24

Entry into force

This Regulation shall enter into force on the day of its publication in the Official Journal of the European Union.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 28 April 2004.

For the Commission

Erkki Liikanen

Member of the Commission

- (1) OJ L 113, 30.4.2002, p. 1.
- (2) OJ L 128, 24.5.2003, p. 29.
- (3) OJ L 108, 24.4.2002, p. 33.

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**Regulation (EC) No 733/2002 of the European Parliament and of the Council
of 22 April 2002
on the implementation of the.eu Top Level Domain (Text with EEA relevance)**

Regulation (EC) No 733/2002 of the European Parliament and of the Council
of 22 April 2002

on the implementation of the.eu Top Level Domain

(Text with EEA relevance)

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 156 thereof,

Having regard to the proposal from the Commission(1),

Having regard to the opinion of the Economic and Social Committee(2),

Following consultation of the Committee of the Regions,

Acting in accordance with the procedure laid down in Article 251 of the Treaty(3),

Whereas:

- (1) The creation of the.eu Top Level Domain (TLD) is included as one of the targets to accelerate electronic commerce in the e-Europe initiative as endorsed by the European Council at its meeting in Lisbon on 23 and 24 March 2000.
- (2) The communication from the Commission to the Council and the European Parliament on the organisation and management of the Internet refers to the creation of the.eu TLD and the Council resolution of 3 October 2000 on the organisation and management of the Internet(4) charges the Commission to encourage the coordination of policies in relation to the management of the Internet.
- (3) TLDs are an integral part of the Internet infrastructure. They are an essential element of the global interoperability of the World Wide Web ("WWW" or "the Web"). The connection and presence permitted by the allocation of domain names and the related addresses allow users to locate computers and websites on the Web. TLDs are also an integral part of every Internet e-mail address.
- (4) The.eu TLD should promote the use of, and access to, the Internet networks and the virtual market place based on the Internet, in accordance with Article 154(2) of the Treaty, by providing a complementary registration domain to existing country code Top Level Domains (ccTLDs) or global registration in the generic Top Level Domains, and should in consequence increase choice and competition.
- (5) The.eu TLD should improve the interoperability of trans-European networks, in accordance with Articles 154 and 155 of the Treaty, by ensuring the availability of.eu name servers in the Community. This will affect the topology and technical infrastructure of the Internet in Europe which will benefit from an additional set of name servers in the Community.
- (6) Through the.eu TLD, the Internal market should acquire higher visibility in the virtual market place based on the Internet. The.eu TLD should provide a clearly identified link with the Community, the associated legal framework, and the European market place. It should enable undertakings, organisations and natural persons within the Community to register in a specific domain which will make this link obvious. As such, the.eu TLD will not only be a key building block for electronic commerce in Europe but will also support the objectives of Article 14 of the Treaty.

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- (7) The.eu TLD can accelerate the benefits of the information society in Europe as a whole, play a role in the integration of future Member States into the European Union, and help combat the risk of digital divide with neighbouring countries. It is therefore to be expected that this Regulation will be extended to the European Economic Area and that amendments may be sought to the existing arrangements between the European Union and European third countries, with a view to accommodating the requirements of the.eu TLD so that entities in those countries may participate in it.
 - (8) This Regulation is without prejudice to Community law in the field of personal data protection. This Regulation should be implemented in compliance with the principles relating to privacy and the protection of personal data.
 - (9) Internet management has generally been based on the principles of non-interference, self-management and self-regulation. To the extent possible and without prejudice to Community law, these principles should also apply to the.eu ccTLD. The implementation of the.eu TLD may take into consideration best practices in this regard and could be supported by voluntary guidelines or codes of conduct where appropriate.
 - (10) The establishment of the.eu TLD should contribute to the promotion of the European Union image on the global information networks and bring an added value to the Internet naming system in addition to the national ccTLDs.
 - (11) The objective of this Regulation is to establish the conditions of implementation of the.eu TLD, to provide for the designation of a Registry and establish the general policy framework within which the Registry will function. National ccTLDs are not covered by this Regulation.
 - (12) The Registry is the entity charged with the organisation, administration and management of the.eu TLD, including maintenance of the corresponding databases and the associated public query services, the accreditation of Registrars, the registration of domain names applied for by accredited Registrars, the operation of the TLD name servers and the dissemination of TLD zone files. Public query services associated with the TLD are referred to as "Who is" queries. "Who is"-type databases should be in conformity with Community law on data protection and privacy. Access to these databases provides information on a domain name holder and is an essential tool in boosting user confidence.
 - (13) After publishing a call for expressions of interest in the Official Journal of the European Communities, the Commission should, on the basis of an open, transparent and non-discriminatory selection procedure, designate a Registry. The Commission should enter into a contract with the selected Registry which should specify the conditions applying to the Registry for the organisation, administration and management of the.eu TLD and which should be limited in time and renewable.
 - (14) The Commission, acting on behalf of the Community, has requested the delegation of the EU code for the purpose of creating an Internet ccTLD. On 25 September 2000, the Internet Corporation for Assigned Names and Numbers (ICANN) issued a resolution providing that "alpha-2 codes are delegable as ccTLDs only in cases where the ISO 3166 Maintenance Agency, on its exceptional reservation list, has issued a reservation of the code that covers any application of ISO 3166-1 that needs a coded representation in the name of the country, territory or area involved". Such conditions are met by the EU code which is therefore "delegable" to the Community.
 - (15) ICANN is at present responsible for coordinating the delegation of codes representing ccTLD to Registries. The Council resolution of 3 October 2000 encourages the implementation of the principles applied to ccTLD Registries adopted by the Governmental Advisory Committee (GAC). The Registry should enter into a contract with ICANN respecting the GAC principles.

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- (16) The adoption of a public policy addressing speculative and abusive registration of domain names should provide that holders of prior rights recognised or established by national and/or Community law and public bodies will benefit from a specific period of time (a "sunrise period") during which the registration of their domain names is exclusively reserved to such holders of prior rights recognised or established by national and/or Community law and public bodies.
- (17) Domain names should not be revoked arbitrarily. A revocation may, however, be obtained in particular should a domain name be manifestly contrary to public order. The revocation policy should nevertheless provide for a timely and efficient mechanism.
- (18) Rules should be adopted on the question of bona vacantia to address the status of domain names the registration of which is not renewed or which, for example because of succession law, are left without holder.
- (19) The new.eu TLD registry should not be empowered to create second-level domains using alpha-2 codes representing countries.
- (20) Within the framework established by this Regulation, the public policy rules concerning the implementation and functions of the.eu TLD and the public policy principles on registration, various options including the "first come, first served" method should be considered when registration policy is formulated.
- (21) When reference is made to interested parties, provision should be made for consultation encompassing, in particular, public authorities, undertakings, organisations and natural persons. The Registry could establish an advisory body to organise such consultation.
- (22) The measures necessary for the implementation of this Regulation, including criteria for the selection procedure of the Registry, the designation of the Registry, as well as the adoption of public policy rules, should be adopted in accordance with Council Decision 1999/468/EC of 28 June 1999 laying down the procedures for the exercise of implementing powers conferred on the Commission(5).
- (23) Since the objective of the proposed action, namely to implement the.eu TLD, cannot be sufficiently achieved by the Member States and can therefore, by reason of the scale and effects of the action, be better achieved at Community level, the Community may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty. In accordance with the principle of proportionality as set out in that Article, this Regulation does not go beyond what is necessary in order to achieve that objective,

HAVE ADOPTED THIS REGULATION:

Article 1

Objective and scope

1. The objective of this Regulation is to implement the.eu country code Top Level Domain (ccTLD) within the Community. The Regulation sets out the conditions for such implementation, including the designation of a Registry, and establishes the general policy framework within which the Registry will function.
2. This Regulation shall apply without prejudice to arrangements in Member States regarding national ccTLDs.

Article 2

Definitions

For the purposes of this Regulation:

- (a) "Registry" means the entity entrusted with the organisation, administration and management of the.eu TLD including maintenance of the corresponding databases and the associated public query services, registration of domain names, operation of the Registry of domain names, operation of the Registry TLD name servers and dissemination of TLD zone files;
- (b) "Registrar" means a person or entity that, via contract with the Registry, provides domain name registration services to registrants.

Article 3

Characteristics of the Registry

1. The Commission shall:

- (a) establish, in accordance with the procedure referred to in Article 6(3), the criteria and the procedure for the designation of the Registry;
- (b) designate, in accordance with the procedure referred to in Article 6(2), the Registry after publishing a call for expressions of interest in the Official Journal of the European Communities and after the procedure for such call has been completed;
- (c) enter into, in accordance with the procedure referred to in Article 6(2), a contract which shall specify the conditions according to which the Commission supervises the organisation, administration and management of the.eu TLD by the Registry. The contract between the Commission and the Registry shall be limited in time and renewable.

The Registry may not accept registrations until the registration policy is in place.

- 2. The Registry shall be a non-profit organisation, formed in accordance with the law of a Member State and having its registered office, central administration and principal place of business within the Community.
- 3. Having obtained the prior consent of the Commission, the Registry shall enter into the appropriate contract providing for the delegation of the.eu ccTLD code. To this effect the relevant principles adopted by the Governmental Advisory Committee shall be taken into account.
- 4. The.eu TLD Registry shall not act itself as Registrar.

Article 4

Obligations of the Registry

- 1. The Registry shall observe the rules, policies and procedures laid down in this Regulation and the contracts referred to in Article 3. The Registry shall observe transparent and non-discriminatory procedures.

2. The Registry shall:

- (a) organise, administer and manage the.eu TLD in the general interest and on the basis of principles of quality, efficiency, reliability and accessibility;
- (b) register domain names in the.eu TLD through any accredited.eu Registrar requested by any:
 - (i) undertaking having its registered office, central administration or principal place of business within the Community, or
 - (ii) organisation established within the Community without prejudice to the application of national law, or
 - (iii) natural person resident within the Community;
- (c) impose fees directly related to costs incurred;
- (d) implement the extra-judicial settlement of conflicts policy based on recovery of costs and a procedure to resolve promptly disputes between domain name holders regarding rights relating to names including intellectual property rights as well as disputes in relation to individual decisions by the Registry. This policy shall be adopted in accordance with Article 5(1) and take into consideration the recommendations of the World Intellectual Property Organisation. The policy shall provide adequate procedural guarantees for the parties concerned, and shall apply without prejudice to any court proceeding;
- (e) adopt procedures for, and carry out, accreditation of.eu Registrars and ensure effective and fair conditions of competition among.eu Registrars;
- (f) ensure the integrity of the databases of domain names.

Article 5

Policy framework

1. After consulting the Registry and following the procedure referred to in Article 6(3), the Commission shall adopt public policy rules concerning the implementation and functions of the.eu TLD and the public policy principles on registration. Public policy shall include:

- (a) an extra-judicial settlement of conflicts policy;
- (b) public policy on speculative and abusive registration of domain names including the possibility of registrations of domain names in a phased manner to ensure appropriate temporary opportunities for the holders of prior rights recognised or established by national and/or Community law and for public bodies to register their names;
- (c) policy on possible revocation of domain names, including the question of bona vacantia,
- (d) issues of language and geographical concepts;
- (e) treatment of intellectual property and other rights.

2. Within three months of the entry into force of this Regulation, Member States may notify to the Commission and to the other Member States a limited list of broadly-recognised names with regard to geographical and/or geopolitical concepts which affect their political or territorial organisation that may either:

- (a) not be registered, or

(b) be registered only under a second level domain according to the public policy rules.

The Commission shall notify to the Registry without delay the list of notified names to which such criteria apply. The Commission shall publish the list at the same time as it notifies the Registry.

Where a Member State or the Commission within 30 days of publication raises an objection to an item included in a notified list, the Commission shall take measures, in accordance with the procedure referred to in Article 6(3), to remedy the situation.

3. Before starting registration operations, the Registry shall adopt the initial registration policy for the.eu TLD in consultation with the Commission and other interested parties. The Registry shall implement in the registration policy the public policy rules adopted pursuant to paragraph 1 taking into account the exception lists referred to in paragraph 2.

4. The Commission shall periodically inform the Committee referred to in Article 6 on the activities referred to in paragraph 3 of this Article.

Article 6

Committee

1. The Commission shall be assisted by the Communications Committee established by Article 22(1) of Directive 2002/21/EC of the European Parliament and of the Council of 7 March 2002 on a common regulatory framework for electronic communications networks and services (Framework Directive)(6). Until the Communications Committee is established pursuant to Decision 1999/468/EC, the Commission shall be assisted by the Committee established by Article 9 of Council Directive 90/387/EEC of 28 June 1990 on the establishment of the internal market for telecommunication services through the implementation of open network provision(7).

2. Where reference is made to this paragraph, Articles 3 and 7 of Decision 1999/468/EC shall apply, having regard to the provisions of Article 8 thereof.

3. Where reference is made to this paragraph, Articles 5 and 7 of Decision 1999/468/EC shall apply, having regard to the provisions of Article 8 thereof.

The period laid down in Article 5(6) of Decision 1999/468/EC shall be set at three months.

4. The Committee shall adopt its rules of procedure.

Article 7

Reservation of rights

The Community shall retain all rights relating to the.eu TLD including, in particular, intellectual property rights and other rights to the Registry databases required to ensure the implementation of this Regulation and the right to re-designate the Registry.

Article 8

Implementation report

The Commission shall submit a report to the European Parliament and the Council on the implementation, effectiveness and functioning of the.eu TLD one year after the adoption of this Regulation and thereafter every two years.

Article 9

Entry into force

This Regulation shall enter into force on the day of its publication in the Official Journal of the European Communities.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Luxembourg, 22 April 2002.

For the European Parliament

The President

P. Cox

For the Council

The President

M. Arias Cañete

- (1) OJ C 96 E, 27.3.2001, p. 333.
- (2) OJ C 155, 29.5.2001, p. 10.
- (3) Opinion of the European Parliament of 4 July 2001 (OJ C 65 E, 14.3.2002, p. 147), Council Common Position of 6 November 2001 (OJ C 45 E, 19.2.2002, p. 53) and Decision of the European Parliament of 28 February 2002 (not yet published in the Official Journal). Council Decision of 25 March 2002.
- (4) OJ C 293, 14.10.2000, p. 3.
- (5) OJ L 184, 17.7.1999, p. 23.
- (6) OJ L 108, 24.4.2002, p. 33.
- (7) OJ L 192, 24.7.1990, p. 1. Directive as last amended by Directive 97/51/EC of the European Parliament and of the Council (OJ L 295, 29.10.1997, p. 23).

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[IMPORTANT LEGAL NOTICES](#)

de en fr

Industrial Property

[↔ Industrial Property ↔ Domain Name](#)

Domain Name

For the last few years the European Commission has worked very hard on the creation of the TLD (top level domain) “.eu”. In 1999, following requests from the industry and Internet stakeholders in Europe, the European Commission initiated the process to create the .EU domain name as part of the eEurope Action Plan approved by the European Council in Feira (Portugal).

This initiative resulted in the adoption, on 22 April 2002, of the Council Regulation ([EC](#)) No 733/2002 on the Implementation of the Internet Level Domain ".eu" . This Regulation paved the way for the creation of the .eu TLD, intended to be the response of the European Union to the increasing importance of electronic commerce in particular and the information society in general, as an element of competitiveness and growth.

The intention of the .eu TLD is not to replace the existing national ccTLDs in the EU, but to complement them and to give its users the additional option of having a pan-European Internet identity for their web sites and e-mail addresses. The .eu TLD will however be managed and operated by a private sector, the Registry, a non-profit organisation.

The Commission Regulation ([EC](#)) No 874/2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration, was adopted on 28 April 2004 (including an Alternative Dispute Resolution (ADR) Policy) to be implemented by the Registry.

It will be run by a private, non-profit organization known as [EURid](#).

[More information](#)



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Strategy for the enforcement of intellectual property rights in third countries

Strategy for the enforcement of intellectual property rights in third countries

(2005/C 129/03)

INTRODUCTION

Violations of intellectual property rights (IPR) continue to increase, having reached, in recent years, industrial proportions. This happens despite the fact that, by now, most of the WTO members have adopted legislation implementing minimum standards of IPR enforcement. It is, therefore, essential for the European Union to increasingly focus on vigorous and effective implementation of the enforcement legislation.

This Strategy intends to be a contribution to the improvement of the situation in third countries. It is a logical sequence of recent initiatives like the Enforcement Directive [1], that will harmonize enforcement legislation within the European Union, and the revision of the Customs Regulation [2], that provides action against counterfeit or pirated goods at the Community's border.

The purposes of the Strategy are to:

- Provide a long-term line of action for the Commission with the goal of achieving a significant reduction of the level of IPR violations in third countries;
- Describe, prioritise and coordinate the mechanisms available to the Commission services for achieving their goal [3];
- Inform right-holders and other entities concerned of the means and actions already available and to be implemented, and raise their awareness for the importance of their participation.
- Enhance cooperation with right-holders and other private entities concerned, by seeking their input on the identification of priorities and establishing public-private partnerships in fields like technical assistance, information to the public, etc.

This Strategy does not intend to:

- Impose unilateral solutions to the problem - It is clear that, ultimately, any proposed solutions will only be effective if they are prioritised and considered to be important by the recipient country. The Commission is ready to assist in the creation of such conditions.
- Propose a one-size-fits-all approach to promoting IPR enforcement - It will be necessary to have a flexible approach that takes into account different needs, level of development, membership or not of the World Trade Organisation (WTO), and main problems in terms of IPR (country of production, transit or consumption of infringing goods) of the countries in question.
- Copy other models of IPR enforcement or create alliances against certain countries - The Commission is ready and willing to improve cooperation and to create synergies with countries sharing its concerns and facing similar problems. It is, however, important that this strategy remains primarily focussed on positive and constructive efforts.

PROPOSED ACTIONS TO ADDRESS THE PROBLEM

1. Identifying the priority countries

It is important to identify a limited number of countries on which the efforts of the Commission in the framework of the present strategy should be concentrated (cf. Annex I, section 4). The human and financial resources allocated to the enforcement of IPR [4] being limited, it is unrealistic to pretend that our action can extend equally to all, or even most, of the countries where piracy

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and counterfeiting occur. Therefore, a mechanism to assess which are the most problematic countries/regions, or those where the action of the Community is most urgently required, will be an essential tool for the successful implementation of this strategy.

At the end of 2002, the Commission launched a survey to assess the situation in third countries regarding violations and enforcement of IPR [5]. By identifying with more accuracy the problems, the survey provided a diagnostic that allowed the Commission to develop the present strategy. At the same time, it gave substantial information to help identify those countries on which the priorities should be focused and to which the bulk of our limited resources should be allocated.

Specific actions:

- Put in place a mechanism that will periodically conduct an exercise similar to the "Survey on Enforcement of Intellectual Property Rights in Third Countries", based on a questionnaire distributed to entities like Commission Delegations, Embassies of Member States, right-holders and associations, Chambers of Commerce, etc. Replies will be analysed and results made available to the public. Such results, in conjunction with other reliable sources of information available to the Commission [6], should be the basis for renewing the list of the priority countries for the subsequent period.

2. Multilateral/Bilateral agreements

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) [7] has a detailed chapter dedicated to the setting of minimum standards of IPR enforcement and technical cooperation. It also provides for a structure responsible for monitoring the implementation of the provisions of the Agreement and for consultation between Members, i.e. the TRIPs Council. Finally, it puts in place a dispute prevention and settlement mechanism. These characteristics make TRIPs one of the most adequate and effective instruments to address problems related to IPR violations.

The numerous bilateral agreements established by the European Community contain a chapter dedicated to IP. This chapter usually establishes that a very high standard of protection of IP (including the enforcement thereof) must be achieved. Most agreements also include a clause allowing for technical cooperation in this field. These clauses must be carefully monitored and effectively implemented, notably with respect to the more "problematic" countries.

The institutional structures of these multilateral and bilateral agreements (TRIPs Council, Association Councils, the World Intellectual Property Organisation - WIPO, etc.) can be used to monitor and discuss legislation and enforcement problems from a very early stage. They allow for a structured political dialogue and can act as fora to submit new initiatives or to act as "early warning" for arising problems, before there is a need to adopt stricter measures.

It is also envisaged to make the enforcement clauses in future bilateral or bi-regional agreements more operational and to clearly define what the EU regards as the highest international standards in this area and what kind of efforts it expects from its trading partners.

Specific actions:

- The EU will consult other trading partners regarding the possibility of launching an initiative in the TRIPs Council highlighting the fact that the implementation of TRIPs requirements in national laws has proven to be insufficient to combat piracy and counterfeiting, and that the TRIPs Agreement itself has several shortcomings.
- For example, the TRIPs Council could consider in the future a number of actions to tackle the situation, including the extension of the obligation to make available customs measures to goods in transit and for export [8].
- Ensure a continued effort in the monitoring of the TRIPs compliance of legislation, in particular

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in the "priority" countries.

- Revisit the approach to the IPR chapter of bilateral agreements, including the clarification and strengthening of the enforcement clauses. Although in designing the rules for each specific negotiation it is important to take into account the situation and the capacity of our partners, instruments such as the new EU Directive harmonising the enforcement of IPR within the Community, as well as the new customs' Regulation on counterfeit and pirated goods may constitute an important source of inspiration and a useful benchmark.

- Raise more systematically enforcement concerns at Summit meetings and in the Councils/Committees created in the framework of these bilateral agreements. In order to allow the Commission to obtain an effective reaction from its counterparts, it is essential that it receives credible and detailed information from right-holders, either directly or via the EC Delegation or the embassies of the Member States in the countries concerned.

3. Political dialogue

The Commission must make clear to its trading partners that effective protection of IP, at least at the level set in TRIPs, is absolutely essential, and that the first step for fighting piracy and counterfeiting is an adequate level of enforcement at the source, i.e. in the countries where these goods are produced and exported. The Commission will also emphasize that effective enforcement is in most cases of mutual interest, be it for health or consumer reasons, or more broadly for these countries attractiveness to foreign investment. In its contacts, at different levels with the authorities of the countries concerned, the Commission must strongly convey the message that it is willing to assist them in raising the level of enforcement, but also that it will not refrain from using the instruments at its disposal in cases where deficient enforcement is harming its right-holders.

In addition, the Commission is increasing its cooperation with countries heavily affected by this type of practices and that share the Community's concerns, like Japan. This will result in an increased exchange of information and even in participation in joint initiatives in third countries. In addition, such "joint ventures" should produce a rationalisation of resources between countries sharing identical concerns and pursuing parallel initiatives.

Finally, the EC Delegations in the "problematic" countries can play an important role, by establishing close links with the local enforcement entities, with the Community right-holders operating in these countries and with the embassies of EU Member States and other countries concerned.

Specific actions:

- The message "improve your enforcement" should be repeated, as frequently and at as high a level as possible, in the Commission's contacts with authorities of the countries in question and in all appropriate fora, notably the WTO and WIPO. It must be perceived as a priority concern.

- This commitment to include IPR enforcement in the political dialogue is illustrated by the following initiatives:

- At the EU - Japan Summit of 2003, the Commission and Japan agreed to establish an improved dialogue in a number of areas, including IPR. An "EU - Japan Joint Initiative for IPR Enforcement in Asia" was established, focusing on elements like (a) the close follow-up of the progress of Asian countries in the field; (b) coordinating technical assistance programmes and responsibilities; (c) enhancing EU-Japan efforts to raise awareness in the fight against piracy and counterfeiting and to promote the strengthening of IPR enforcement; (d) exploring the possibility to cooperate in other areas of IPR. The initiative is implemented by an Annual Work Plan containing specific activities.

- The Commission and China agreed in the margins of the 2003 EU-China Summit to hold, at least

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once a year, a "EU-China Dialogue on Intellectual Property". Among other issues, the discussions should focus on efforts to combat piracy and counterfeiting, institutional reforms, enforcement-related areas such as central and sub-central enforcement by customs, police, administrative and judiciary bodies, public awareness of consumers and right-holders. The first meeting took place in October 2004.

- Basic training will be provided to officials in priority Delegations so that they can offer a minimum of information to entities with enforcement problems. The idea is to create some networking between Commission officials in Delegations and to establish closer teamwork between Delegations and the Headquarters. Teamwork will facilitate the compilation of information and the definition of targeted actions for the different countries and/or for a regional approach.

4. Incentives/Technical cooperation

Most of the countries with deficient enforcement will claim a lack of resources and the existence of more pressing priorities than protecting IP rights. IP enforcement is a complex and multi-disciplinary activity. It involves drafting legislation, training judges, police forces, customs officials and other experts, setting up agencies or task-forces, public awareness raising, etc. Most of these needs can be, and to some extent already have been, addressed by the Commission via technical cooperation programmes, but it is important to do more and better.

Technical assistance is an activity favoured by the EU for its contribution towards poverty alleviation and development. It is thus important to show that adequate IPR enforcement can contribute to this goal by making a link with investment opportunities, transfer of technology and know-how, protection of traditional knowledge, improvement of health and safety standards, etc.

It will be necessary to have a flexible approach that takes into account the recipient country's different needs, level of development, membership or not of the World Trade Organisation (WTO), and main problems in terms of IPR (country of production, transit or consumption of fake goods). Any cooperation programmes will only be effective if they are prioritised and indeed felt as important in the recipient country.

It is also relevant to share information and to ensure a minimum level of synergy between the main providers of technical assistance, such as WIPO, the World Customs Organisation (WCO), the Member States and third countries like Japan, the US and others.

Finally, the following difficulties must be stressed:

- (a) In most cases, technical cooperation is "demand driven", i.e. it requires a request by the beneficiary of the action. It is important to turn it into a "dialogue driven" request, by discussing its importance and benefits for the recipient.
- (b) It is a mid to long-term solution, with few immediate results. However, the present strategy is a long term one, and adequate enforcement is a goal that will not be achieved only by immediate actions, in particular in the case of least-developed countries, not yet bound by TRIPs requirements.
- (c) Implementing the programmes implies a complex administrative process. This is why further strengthening coordination between the Commission services responsible for the different aspects of IPR enforcement and between the Commission and third parties is an essential component of the present strategy.

Specific actions:

- Ensure that, at least, the countries identified as priorities are given the option to include intellectual property in the trade-related technical assistance programmes or to obtain specific IP programmes.
- In particular, the Commission would like to extend technical assistance to Latin America, since

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it is a region where enforcement can certainly be improved and where no programme is in place.

- There are a number of programmes that cover IPR. Some, like ECAP [9] I and II, for the ASEAN countries, or even the recently concluded EU-China IPR programme are specifically destined to provide assistance on IPR. Others are generally designed to cover trade related issues, but may include IPR among their objectives - WTO II [10] and Small Project Facility [11], for China; technical cooperation programmes under the framework of the Cotonou Agreement for the African, Caribbean and Pacific (ACP) countries; or the CARDS [12] programme, for the countries of the Balkans. The Commission will ensure that the component of IPR enforcement is adequately covered by these programmes.

- In the case of "production" countries, the focus in any cooperation programmes must shift from assistance in drafting legislation to a more enforcement-oriented strategy, including training programmes for judges, police, and customs.

- It must be pointed out that this practice is already being successfully implemented in the specific field of customs (DG TAXUD). There are a number of customs cooperation agreements that, inter alia, cover an essential tool of IPR enforcement (customs controls of fake goods). These agreements with countries like India and China (a new one is soon to be concluded) produce positive results in terms of training and of passing on our experience and methods to these countries. Furthermore, they illustrate how one can build on the existing TRIPs requirements (cf. the control of exports and goods in transit, in addition to the control of imports). It is likely that a similar agreement may be established with Japan still in 2004.

- Exchange ideas and information with other key providers of technical cooperation, like WIPO, the US, Japan and certain EU Member States, with the aim of avoiding duplication of efforts and sharing of best-practices.

- Improve the dialogue mechanisms with: (a) the WCO (under the coordination of DG TAXUD) to assess the compatibility of their technical assistance with our positions and the complementarity with our programmes; (b) WIPO and other providers of assistance (the European Patent Office, the Office of the EU Trademarks and Designs, etc.) to share information and to better coordinate strategies.

- Technical cooperation is also an important element of the TRIPs Agreement (Article 67) and it "fits" into the objectives of the Doha Development Agenda. It can be considered to take an enforcement-oriented initiative in this framework.

5. Dispute Settlement/Sanctions

No rule can be really effective without the threat of a sanction. Countries where IP violations are systematic, and where no government action to address the problem is effectively taken, could be publicly identified. As a last resort, consideration should be given to resorting to dispute settlement mechanisms provided for in multilateral and bilateral agreements.

The existing Trade Barriers Regulation (TBR) mechanism [13] could be a starting-point. TBR is a legal instrument that gives the right to Community enterprises and industries to lodge a complaint, which obliges the Commission to investigate and evaluate whether there is evidence of violation of international trade rules resulting in adverse trade effects. The result is that the procedure will lead to either a mutually agreed solution to the problem or recourse to dispute settlement.

The TBR has a broad scope of application, covering not only goods but also, to some extent, intellectual property rights and services, when the violation of rules concerning these rights has an impact on trade between the EC and a third country.

Resort to other trade related mechanisms could also be considered. For instance, the EU includes

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similar instruments in an increasing number of bilateral agreements that will be triggered in cases of non-compliance with the required high(est) standards of IP protection.

Deficient enforcement derives more frequently from the way the rules are (not) de facto implemented by the competent authorities than from an absence of legislation or a blatant contradiction of legislation with TRIPs requirements. However, when such deficiencies become systemic, they can substantiate a dispute settlement case.

Specific actions:

- Remind right-holders of the possibility to make use of the TBR mechanism in cases of evidence of violation of TRIPs or of the high(est) standards as agreed in bilateral agreements between the EC and third countries. This mechanism is launched by the lodging of a complaint.
- The Commission is ready, in clearly justified cases, to make ex officio use of the WTO dispute settlement mechanism and of the similar dispute settlement tools included in our bilateral agreements in case of non-compliance with the mutually accepted standards of IP protection.
- Consider other mechanisms which could be used to reduce the level of IPR violations in third countries.

6. Creation of public-private partnerships

There are numerous companies and associations which have been active in the fight against piracy/counterfeiting for many years. They constitute an invaluable source of information, but also a key partner for any awareness raising initiatives. Some of these entities are already present, and very active, in most problematic countries.

Other than the specific actions now proposed, there are within the Commission other examples of initiatives to create public-private partnerships that are directly or indirectly linked with IPR enforcement.

One of these projects involved the creation of Innovation Relay Centres, to support companies dealing with transfers of technology [14]. This project includes people with extensive experience in the IPR area (licensing, transfer of IP rights, etc) and could be used to collect information about enforcement problems in third countries. So far the network only covers the EU, but consideration is being given to extending it to third countries. There is a pilot project with an office in Chile.

There is also already in place the "IPR Help-Desk" [15], a project sponsored by the Commission to support creativity and innovation. The purpose of the Help-Desk is not to handle complaints but to provide information to the EU industry. It may therefore give guidance to companies facing violations of their rights in third countries.

Finally, the Commission has a long experience of involving private operators in their seminars and training programmes covering, in particular, border enforcement of IPR.

Specific actions:

- Support the creation of local IP networks involving companies, associations and chambers of commerce. This practice is already being implemented in certain key countries and will be actively supported by DG TRADE.
- Improve cooperation with companies and associations that are active in the fight against piracy/counterfeiting, inter alia by exchanging information about future initiatives and ensuring the cross-participation of experts from the Commission and from private entities in events organised by the other party.

7. Awareness raising/Drawing on our own experience

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Providing better information to the public is another very relevant dimension of the Strategy. This can be divided into the following components:

- (a) Raising the awareness of users/consumers in third countries. This must be done from two perspectives:
 - (a) to promote the benefits of IPR in terms of promotion of creativity, investment, transfer of technology, protection of traditions and quality;
 - (b) to inform about the dangers of IPR violations to public health, consumer protection, public security, etc.
- (b) Raising the awareness of right-holders. Again from two different perspectives:
 - (a) the risks incurred by trading in certain countries where IPR enforcement is ineffective and the minimum precautions that must be adopted, like registering the IP right in those countries (frequently, small and medium sized companies do not even apply for the protection of their intellectual property in third countries where they are producing or selling their goods);
 - (b) the need to use the means available in these third countries to enforce their rights. Countries which are members of the WTO (with the exception of least-developed countries) must have implemented minimum standards of IP protection and enforcement since 2000. It is clear that the first steps to protect and enforce IPRs must be taken by the right-holders themselves, and that they must use, to the maximum extent, the available mechanisms before being entitled to legitimately complain about the effectiveness of such protection and enforcement.

Specific actions:

- The Commission does not have the resources to pursue alone extensive awareness raising campaigns in third countries. However, this activity could be implemented by some of the abovementioned means, i.e. by inclusion in existing technical cooperation programmes and by public-private partnerships.
- The Commission services sponsored the drafting of a "Guidebook on Enforcement of Intellectual Property Rights". This Guidebook is mainly intended to assist public authorities of developing and least developed countries in their efforts to put in place systems and procedures for the effective enforcement of IPR. In particular, the guidebook considers the most common difficulties confronting those countries in the enforcement of IPR and provides guidance on how to achieve effective and long-lasting protection for such rights. The guidebook identifies useful resources which may be of assistance to authorities and right-holders facing difficulties.
- The Guidebook will be publicly available through the Commission website.

8. Institutional cooperation

The Commission services responsible for the different aspects of IPR enforcement will step up their coordination and cooperation with a view to enhancing the role of the Commission. Without creating an additional layer of bureaucracy, it is necessary to:

- (a) further improve information exchange and coordination between the services in charge of the different aspects of IPR enforcement;
- (b) simplify the identification and the access of external entities (right-holders, third country authorities, etc.) to the service responsible for the specific issue concerning them.

Specific actions:

- Inter-service meetings will be regularly organised to follow up the initiatives being implemented in the framework of the present strategy and to discuss the results obtained, as well as the inclusion of new initiatives. Furthermore, increased cooperation between the services involved with technical assistance issues will be introduced in order to promote IPR enforcement-related assistance to relevant third countries.
- In order to help third parties understand the distribution of tasks among the different Commission

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services:

- A new Commission webpage will be created, presenting: (a) the existing legislation to enforce IPR; (b) a vademecum on enforcement, including the Commission contact points for the various types of IP rights and aspects of their enforcement, as well as links to the various web-pages of the different services dealing with it.

- Cross-links will be inserted in the existing web-pages of each service dealing with certain aspects of IPR or certain sectors.

- Ensure coordination with other Commission initiatives linked with IPR, such as the Innovation Relay Centres and the IPR Help-Desk, and their effective contribution to the objective of the present Strategy by collecting and distributing information vis-à-vis the private sector.

[1] Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004, is available at:http://europa.eu.int/eur-lex/pri/en/oj/dat/2004/l_195/l_19520040602en00160025.pdf

[2] Council Regulation (EC) No 1383/2003 of 22 July 2003, is available at:http://europa.eu.int/comm/taxation_customs/customs/counterfeit_piracy/files/co_unterfeit_en.pdf

[3] This Strategy has no direct supplementary financial implications on the budget of the European Commission.

[4] Reference to intellectual property rights in this paper is made in its wider meaning, i.e., including copyright and related rights, but also trademarks, patents, designs, geographical indications, undisclosed information, etc.

[5] The complete results of the "Survey on Enforcement of Intellectual Property Rights in Third Countries", including a detailed report per country, for all the countries for which sufficient information was received, are available at:http://europa.eu.int/comm/trade/issues/sectoral/intell_property/survey_en.htm

[6] A valuable source of information about the origin, the itinerary and the nature of counterfeit and pirated goods destined to, or in transit via the Community are the annual statistics about the goods originating from third countries seized by Customs at the Community border. The report is released by DG TAXUD. The figures for 2003 can be found at:http://europa.eu.int/comm/taxation_customs/customs/counterfeit_piracy/index_en.htm

[7] Agreement on Trade-Related Aspects of Intellectual Property, Annex 1C to the Agreement establishing the World Trade Organisation (TRIPs, Marrakesh 1994).

[8] Article 51 of the TRIPs Agreement only stipulates the obligation for Members to have in place customs measures for imported goods.

[9] EC-ASEAN IPR Programme comprises a regional and a national component and covers all areas of IPR. It has a value of EUR 5 million. An additional EUR 2 million is planned, to take account of the inclusion of Laos, Cambodia and Vietnam. The project started in 2000 and has a duration of 5 years

[10] WTO II is the largest WTO related support programme in China, with a value of EUR 15 million over 5 years - to which China has indicated willingness to contribute with an additional 30 %. A chapter on IPR will be proposed. The programme should be launched before the end of 2004.

[11] Project designed to support small initiatives in China. With a total value of EUR 9,6 million, and a duration of 5 years, the initiatives are demand-driven, but the inclusion of IPR related projects will be actively encouraged.

[12] In the framework of the Community Assistance for Reconstruction, Development and Stabilisation (CARDS) programme for the Western Balkans, a project called "Industrial and Intellectual Property

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Rights" was launched in July 2003. The project will have a duration of 36 months and a value of EUR 2,25 million.

[13] Council Regulation (EC) No 3286/94 of 22 December 1994 laying down Community procedures in the field of the common commercial policy in order to ensure the exercise of the Community's rights under international trade rules, in particular those established under the auspices of the WTO.<http://europa.eu.int/comm/trade/issues/respectrules/tbr/legis/adgreg06a.htm>

[14] This project is managed by DG ENTR. For more information see:<http://europa.eu.int/comm/enterprise/innovation/networks.htm>

irc

[15] <http://www.ipr-helpdesk.org>

ANNEX I

BACKGROUND

1. What is the problem?

The TRIPs Agreement establishes for the first time a single, comprehensive, multilateral set of rules covering all kinds of IPR. It contains also a detailed chapter setting minimum standards of IPR enforcement to be adopted by all members of the WTO.

However, despite the fact that, by now, most of the WTO members have adopted legislation implementing such minimum standards [1], the levels of piracy and counterfeiting continue to increase every year. These activities have, in recent years, assumed industrial proportions, because they offer considerable profit prospects with often a limited risk for the perpetrators.

It has thus become clearly insufficient to limit the efforts of the EC to merely monitoring the creation of general legislative frameworks in WTO member countries. It is essential that the EC increasingly focuses on vigorous and effective implementation of the enforcement legislation.

"37. The European Council calls upon the Commission and Member States to improve exploitation of intellectual property rights by taking forward measures against counterfeiting and piracy, which discourages the development of a market for digital goods and services; to protect patents on **computer implemented inventions**..."

[3] made a strong call for the increase in the fight against piracy and counterfeiting. As a consequence, the Commission (DG JAI) intends to launch a legislative initiative in 2004 in the form of a proposal for a Council Framework Decision on approximation of national legislation and sanctions on counterfeiting and piracy.

The situation is, however, different outside the borders of the Community. The internal instruments available to Community right-holders in the case of violations of their rights within the Community or in the case of imports of fake goods into the EU are not usable when these violations occur in third countries and the resulting goods are either consumed domestically or exported to other third countries. Although such violations occur outside, they directly affect Community right-holders.

2. Why and how much does it matter? To whom?

(a) European Community

Violation of IPR, which is reflected in the presence on the market of increasing volumes of pirated

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and counterfeit goods, has a very negative impact in a number of different areas. The Community, being a market that traditionally invests heavily in IP-protected goods and services and receives considerable added-value for this effort, is particularly affected by poor enforcement of IP, even when it takes place in third countries, and even if the pirated/counterfeit goods or services are not destined for the Community market. These are some of the adverse effects of IP violations:

Economic and social: Deprives right-holders of the revenue from their investment in R&D, marketing, creative effort, quality control, etc. Negatively affects market-share, sales volume, reputation, employment and ultimately the viability of certain IP-based activities/companies. High levels of IPR violations also discourage foreign investment and transfer of technology.

Health and consumer protection: Pirated and counterfeit goods are usually produced by anonymous entities that pay no heed to health, safety and quality requirements and provide no after-sales assistance, guarantees, operating instructions, etc... Illustrating this problem are growing seizures of fake medications, food (and even bottled water), car and plane parts, electrical appliances and toys.

Public order and security: A growing concern in recent years is the increased involvement of criminal organisations and sometimes even of terrorist groups in major international trafficking of counterfeit and pirated goods. This is explained by the particularly lucrative nature of these activities and by the lower risk [4] compared with other lucrative criminal activities. The scale of the problem and the sums of money involved render the situation regarding piracy as complex to tackle as drug trafficking or money laundering. Europol, Interpol and a number of police forces in the Community have created departments dealing specifically with it.

Fiscal: Being an illegal and clandestine practice by nature, and having lower prices it frequently deprives the state from tax revenue (VAT, revenue taxes, customs duties). This issue is particularly sensitive in countries where there are economic sectors under strict state control, like tobacco, alcoholic drinks, fuel, etc.

(b) Third countries

Why should third countries with little tradition in the IPR field, a restricted number of right-holders, and sometimes with a significant share of its industry and commerce benefiting from the violations, care?

The reply to this question is not entirely different from the one given for the Community (see above). The consequences of IPR violations in terms of consumer and health protection, organised crime and loss of fiscal revenue are relatively obvious and directly felt both in the Community and in the third countries where such violations predominantly occur. Consequently, these countries (should) have an immediate interest in combating piracy and counterfeiting.

Regarding the first point however (economic and social consequences), some will say that by enforcing the protection of IP rights held by Community companies, third countries will not obtain any direct benefit. It would appear, on the contrary, that they are using their resources to protect the investment of foreign entities (an argument frequently raised by certain countries). To counter this reasoning, the EC must get across the message that effective enforcement of IP rights (even if these belong to third parties) is an essential tool to attract foreign investment and the transfer of technology and know-how, as well as to protect local right-holders in developing and least-developed countries who are already suffering the misappropriation of their intellectual property [5]. It is a matter of good governance and international credibility, not to mention the need to comply with WTO and other international and bilateral commitments. In the mid-to-long term, it will also encourage domestic authors, inventors and investors and contribute to the development of these countries.

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Under-estimating the value of intellectual property rights contributes to ineffective enforcement. To enhance this aspect of the intellectual property rights system, it would be useful for some (fast) developing countries to assess the value of the industries based primarily on intellectual property rights [6]. This could lead to an appreciation of the value of intellectual property rights in terms of a country's economic environment, as well as in respect to economic, social and cultural growth and development.

There are, however, recent examples of countries where the emergence of a competitive and increasingly sophisticated economy is making evident the need to efficiently protect IP against domestic and external violations.

In some of the most "problematic" countries the authorities appear to be fully aware of the importance of IPR for the development of the country and domestic right-holders demand enforcement of IPR as rigorously as foreign right-holders. The problem is that the piracy/counterfeiting industry is an important element of their economy. It is therefore clear that there is a broader picture which cannot be tackled merely under the IP angle. Only a comprehensive policy involving authorities at national, regional and local level can provide a solution.

3. Which IP rights are violated and which sectors are most affected?

Most of them. One frequent misconception is that piracy and counterfeiting mainly affect some luxury, sports and clothing brands, music and software CDs/DVDs, and little else. The reality is that virtually every IP is being violated on a considerable scale and that the variety of fake products ranges from cereal boxes to plants and seeds, from aeroplane spare parts to sunglasses, from cigarettes to medications, from AA batteries to entire petrol stations. Big software producers are as likely to be harmed as small makers of a certain type of tea. The annual statistics published by the Commission's customs services regarding the number and the nature of seized pirated and counterfeit goods originating from third countries provide detailed and reliable information about the dimension and the growth of the problem [7].

The Commission considers that the vast majority of the problems affecting holders of the different types of intellectual property rights are common and consequently, are most effectively addressed by an integrated strategy. The strategy now proposed aims at improving enforcement against violations of all kinds of IP (copyright, trademarks, geographical indications, patents, designs, etc.).

4. How to define the "priority" countries?

There are several different criteria to define the most problematic countries in terms of enforcement of IPR [8]. These can be split into: (a) source countries; (b) transit countries, and (c) target countries. For each of these groups of countries, the type of measures most adequate to address the situation will differ.

(a) Source countries

These are the countries where production of pirated and counterfeit goods, both for domestic consumption and for export, reaches worrying dimensions. In cases of digital piracy via the internet, the origin of the IPR violation can be particularly difficult to detect.

In these countries it is particularly important to improve the effectiveness and the coordination of the police, the courts, the customs and the administration in general. It is also essential to ensure that the legal framework provides for deterrent sanctions.

(b) Transit countries

For the full picture, one should, however, not focus exclusively on countries violating IPR due to the massive production of counterfeited products occurring in their territories, but also on

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those often acting as a hub. This category includes countries appearing as major places of origin of fake goods seized in the Community, the problem occurring mainly because of the flow of fake products in transit and not because of domestic production of such goods. The large volume of goods originating in these countries is nevertheless indicative of deficient enforcement, at least at the level of border controls. Organised crime networks will take advantage of such weaknesses to establish different traffic routes, hiding the real origin of the goods.

Improving the availability of border measures and the effectiveness of customs authorities in particular regarding the transit of goods should help to substantially reduce the volume of traffic.

(c) Target countries

It is also important to consider, in any strategy to reduce the violations of IPR, the countries identified as the main final destinations of exports of fake goods or serving primarily as a market for such products.

Substantial volumes of sales of fake goods occur in almost all countries. The difficulty of defining countries that are main markets for pirated goods is that it is a very widespread problem, albeit for a variety of (sometimes contradictory) reasons: because they are too poor to buy IP-protected products, because such practice is accepted or at least not condemned, because they produce them in large quantities, because there is sometimes no way to distinguish between real and fake, or because fakes are cheaper. This is why it is necessary to concentrate resources on the main markets of the legitimate Community right-holders most affected by IPR violations.

Dealing with the consumption of pirated and counterfeit goods requires an effort in terms of building up public awareness about the negative impact and the risks of such practice. It also requires more effective customs controls of imported goods and a more effective reaction by the police and courts against those networks and individuals involved in large scale trading in such goods.

5. What is the situation in the Community?

Generally speaking, the Community and its Member States are acknowledged for protecting and enforcing IPR to very high standards, as the *acquis*, and in particular the recent efforts described in point 1 above, can demonstrate. Also in practical terms, reports like the one published annually by DG TAXUD [9] give a clear idea of the results achieved by the authorities of each Member State in terms of seizures of fake goods at the borders.

However, within the Community the level of enforcement is different among Member States. Some Member States still need to do more towards improving the current situation and cutting down remaining production and sale of pirated or counterfeit goods. The new Directive harmonising the enforcement of intellectual property rights within the Community will help to improve the situation.

6. Who are the key actors of IPR enforcement in the Commission?

Different Directorates-General (DGs) of the Commission are competent as regards the distinct aspects of IPR enforcement. In simple terms:

- DG Trade handles the external dimension (multilateral and bilateral) of the issue, i.e. enforcement in third countries. It also represents the European Community at the WTO and notably at the TRIPs Council.
- DG Internal Market (MARKT) is responsible for EU intellectual and industrial property policy and legislation and represents and leads negotiations on behalf of the European Community in various committees in WIPO. DG MARKT was the author of the above mentioned Enforcement Directive.
- DG Agriculture (AGRI) is responsible for internal and external EU policy and for EU legislation concerning geographical indications in agriculture and leads negotiations in these matters

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- DG Taxation and Customs Union (TAXUD) regulates the enforcement of IPR at the Community's external borders. DG TAXUD drafted the above mentioned Customs Regulation.
- DG Justice and Home Affairs (JAI) has shared regulatory responsibilities when IPR enforcement is linked with law enforcement both within and outside the Community. Specific "field" operations in the same area will be handled by the European Anti-Fraud Office (OLAF).
- DG Development (DEV) and DG External Relations (RELEX) coordinate, both centrally and via the EU Delegations in third countries, Community assistance to developing countries and least-developed countries, including in the area of Trade, while the Europe Aid Cooperation Office (AIDCO) manages any technical assistance programmes.
- Finally, DG Enterprise (ENTR), as manager of the IPR Help Desk [10], and with its close contacts with the industry (i.e. with a very important number of IP right-holders), is a key partner.

This is a very crucial point for the efficacy of the present Strategy. DG TRADE and other DGs with external responsibilities have an important and well defined role in terms of improving the enforcement of IPR in third countries. However, the most "operational" responsibilities of the fight against piracy and counterfeiting lie with Member States or with other DGs. The most visible and/or immediate results in this fight will always be achieved by the customs authorities, the police, national courts, the harmonisation of laws and procedures and the creation of information exchange mechanisms at Community level. In these (mainly domestic) areas DG TRADE can only provide a limited contribution. The situation is, however, different with regard to enforcement in third countries. In this case, DG TRADE and the Commission services with external responsibilities in these matters, with the cooperation of the EC Delegations in third countries, can certainly play a key role in achieving the implementation of the tasks proposed in the present Strategy.

[1] Least Developed Countries have until 2006, at least, to adapt their legislation to the TRIPs requirements.

[2] Copy available upon request sent to MARKT-E4@cec.eu.int

[3]

[4] In many countries other very lucrative criminal activities like drug trafficking carry considerable risks (even the death penalty) and are combated with considerable resources, while the trafficking of fake goods is seen as a relatively harmless practice.

[5] Cf. the cases of counterfeits of certain brands of rice wine in China or of a well-known local fish sauce brand in Vietnam.

[6] The Commission services published a study in 2003 entitled The economic importance of copyright (http://www.europa.eu.int/comm/internal_market/en/intprop/index.htm). Some countries, such as the USA and Finland produce such documents, namely for the copyright industries ("Copyright industries in the US Economy - Stephen E. Siwek & Gale Mosteller, prepared for the International Intellectual Property Alliance and The Economic Importance of Copyright Industries in Finland, the Finnish Copyright Society").

[7] http://europa.eu.int/comm/taxation_customs/customs/counterfeit_piracy/index_en.htm

[8] "Priority countries" can be identified on the basis of the following criteria:

- Information received from Community right-holders and other sources (Delegations, etc.) regarding IPR violations.
- Data regarding customs seizures of fake goods at the Community's borders.
- Relevance of the countries in terms of actual or potential volume of trade with the Community. The inclusion of a country in one or more of the categories reflects the level of relevance of

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the situation in that particular country from the Community perspective. Countries with reduced importance in terms of trade were not considered a priority. In any event, the situation in this area is constantly changing, therefore it will require continuous monitoring and updating.

[9] http://europa.eu.int/comm/taxation_customs/customs/counterfeit_piracy/index_en.htm

[10] <http://www.ipr-helpdesk.org/index.htm>

Strategy for the enforcement of intellectual property rights in third countries

(2005/C 129/03)

INTRODUCTION

Violations of intellectual property rights (IPR) continue to increase, having reached, in recent years, industrial proportions. This happens despite the fact that, by now, most of the WTO members have adopted legislation implementing minimum standards of IPR enforcement. It is, therefore, essential for the European Union to increasingly focus on vigorous and effective implementation of the enforcement legislation.

This Strategy intends to be a contribution to the improvement of the situation in third countries. It is a logical sequence of recent initiatives like the Enforcement Directive [1], that will harmonize enforcement legislation within the European Union, and the revision of the Customs Regulation [2], that provides action against counterfeit or pirated goods at the Community's border.

The purposes of the Strategy are to:

- Provide a long-term line of action for the Commission with the goal of achieving a significant reduction of the level of IPR violations in third countries;
- Describe, prioritise and coordinate the mechanisms available to the Commission services for achieving their goal [3];
- Inform right-holders and other entities concerned of the means and actions already available and to be implemented, and raise their awareness for the importance of their participation.
- Enhance cooperation with right-holders and other private entities concerned, by seeking their input on the identification of priorities and establishing public-private partnerships in fields like technical assistance, information to the public, etc.

This Strategy does not intend to:

- Impose unilateral solutions to the problem - It is clear that, ultimately, any proposed solutions will only be effective if they are prioritised and considered to be important by the recipient country. The Commission is ready to assist in the creation of such conditions.
- Propose a one-size-fits-all approach to promoting IPR enforcement - It will be necessary to have a flexible approach that takes into account different needs, level of development, membership or not of the World Trade Organisation (WTO), and main problems in terms of IPR (country of production, transit or consumption of infringing goods) of the countries in question.
- Copy other models of IPR enforcement or create alliances against certain countries - The Commission is ready and willing to improve cooperation and to create synergies with countries sharing its concerns and facing similar problems. It is, however, important that this strategy remains primarily focussed on positive and constructive efforts.

PROPOSED ACTIONS TO ADDRESS THE PROBLEM

1. Identifying the priority countries

It is important to identify a limited number of countries on which the efforts of the Commission in the framework of the present strategy should be concentrated (cf. Annex I, section 4). The human and financial resources allocated to the enforcement of IPR [4] being limited, it is unrealistic to pretend that our action can extend equally to all, or even most, of the countries where piracy and counterfeiting occur. Therefore, a mechanism to assess which are the most problematic countries/regions, or those where the action of the Community is most urgently required, will be an essential tool for the successful implementation of this strategy.

At the end of 2002, the Commission launched a survey to assess the situation in third countries regarding violations and enforcement of IPR [5]. By identifying with more accuracy the problems, the survey provided a diagnostic that allowed the Commission to develop the present strategy. At the same time, it gave substantial information to help identify those countries on which the priorities should be focused and to which the bulk of our limited resources should be allocated.

Specific actions:

- Put in place a mechanism that will periodically conduct an exercise similar to the "Survey on Enforcement of Intellectual Property Rights in Third Countries", based on a questionnaire distributed to entities like Commission Delegations, Embassies of Member States, right-holders and associations, Chambers of Commerce, etc. Replies will be analysed and results made available to the public. Such results, in conjunction with other reliable sources of information available to the Commission [6], should be the basis for renewing the list of the priority countries for the subsequent period.

2. Multilateral/Bilateral agreements

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) [7] has a detailed chapter dedicated to the setting of minimum standards of IPR enforcement and technical cooperation. It also provides for a structure responsible for monitoring the implementation of the provisions of the Agreement and for consultation between Members, i.e. the TRIPs Council. Finally, it puts in place a dispute prevention and settlement mechanism. These characteristics make TRIPs one of the most adequate and effective instruments to address problems related to IPR violations.

The numerous bilateral agreements established by the European Community contain a chapter dedicated to IP. This chapter usually establishes that a very high standard of protection of IP (including the enforcement thereof) must be achieved. Most agreements also include a clause allowing for technical cooperation in this field. These clauses must be carefully monitored and effectively implemented, notably with respect to the more "problematic" countries.

The institutional structures of these multilateral and bilateral agreements (TRIPs Council, Association Councils, the World Intellectual Property Organisation - WIPO, etc.) can be used to monitor and discuss legislation and enforcement problems from a very early stage. They allow for a structured political dialogue and can act as fora to submit new initiatives or to act as "early warning" for arising problems, before there is a need to adopt stricter measures.

It is also envisaged to make the enforcement clauses in future bilateral or bi-regional agreements more operational and to clearly define what the EU regards as the highest international standards in this area and what kind of efforts it expects from its trading partners.

Specific actions:

- The EU will consult other trading partners regarding the possibility of launching an initiative in the TRIPs Council highlighting the fact that the implementation of TRIPs requirements in national laws has proven to be insufficient to combat piracy and counterfeiting, and that the TRIPs Agreement itself has several shortcomings.

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- For example, the TRIPs Council could consider in the future a number of actions to tackle the situation, including the extension of the obligation to make available customs measures to goods in transit and for export [8].
 - Ensure a continued effort in the monitoring of the TRIPs compliance of legislation, in particular in the "priority" countries.
 - Revisit the approach to the IPR chapter of bilateral agreements, including the clarification and strengthening of the enforcement clauses. Although in designing the rules for each specific negotiation it is important to take into account the situation and the capacity of our partners, instruments such as the new EU Directive harmonising the enforcement of IPR within the Community, as well as the new customs' Regulation on counterfeit and pirated goods may constitute an important source of inspiration and a useful benchmark.
 - Raise more systematically enforcement concerns at Summit meetings and in the Councils/Committees created in the framework of these bilateral agreements. In order to allow the Commission to obtain an effective reaction from its counterparts, it is essential that it receives credible and detailed information from right-holders, either directly or via the EC Delegation or the embassies of the Member States in the countries concerned.

3. Political dialogue

The Commission must make clear to its trading partners that effective protection of IP, at least at the level set in TRIPs, is absolutely essential, and that the first step for fighting piracy and counterfeiting is an adequate level of enforcement at the source, i.e. in the countries where these goods are produced and exported. The Commission will also emphasize that effective enforcement is in most cases of mutual interest, be it for health or consumer reasons, or more broadly for these countries attractiveness to foreign investment. In its contacts, at different levels with the authorities of the countries concerned, the Commission must strongly convey the message that it is willing to assist them in raising the level of enforcement, but also that it will not refrain from using the instruments at its disposal in cases where deficient enforcement is harming its right-holders.

In addition, the Commission is increasing its cooperation with countries heavily affected by this type of practices and that share the Community's concerns, like Japan. This will result in an increased exchange of information and even in participation in joint initiatives in third countries. In addition, such "joint ventures" should produce a rationalisation of resources between countries sharing identical concerns and pursuing parallel initiatives.

Finally, the EC Delegations in the "problematic" countries can play an important role, by establishing close links with the local enforcement entities, with the Community right-holders operating in these countries and with the embassies of EU Member States and other countries concerned.

Specific actions:

- The message "improve your enforcement" should be repeated, as frequently and at as high a level as possible, in the Commission's contacts with authorities of the countries in question and in all appropriate fora, notably the WTO and WIPO. It must be perceived as a priority concern.
- This commitment to include IPR enforcement in the political dialogue is illustrated by the following initiatives:
 - At the EU - Japan Summit of 2003, the Commission and Japan agreed to establish an improved dialogue in a number of areas, including IPR. An "EU - Japan Joint Initiative for IPR Enforcement in Asia" was established, focusing on elements like (a) the close follow-up of the progress of Asian countries in the field; (b) coordinating technical assistance programmes and responsibilities; (c) enhancing EU-Japan efforts to raise awareness in the fight against piracy and counterfeiting

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and to promote the strengthening of IPR enforcement; (d) exploring the possibility to cooperate in other areas of IPR. The initiative is implemented by an Annual Work Plan containing specific activities.

- The Commission and China agreed in the margins of the 2003 EU-China Summit to hold, at least once a year, a "EU-China Dialogue on Intellectual Property". Among other issues, the discussions should focus on efforts to combat piracy and counterfeiting, institutional reforms, enforcement-related areas such as central and sub-central enforcement by customs, police, administrative and judiciary bodies, public awareness of consumers and right-holders. The first meeting took place in October 2004.

- Basic training will be provided to officials in priority Delegations so that they can offer a minimum of information to entities with enforcement problems. The idea is to create some networking between Commission officials in Delegations and to establish closer teamwork between Delegations and the Headquarters. Teamwork will facilitate the compilation of information and the definition of targeted actions for the different countries and/or for a regional approach.

4. Incentives/Technical cooperation

Most of the countries with deficient enforcement will claim a lack of resources and the existence of more pressing priorities than protecting IP rights. IP enforcement is a complex and multi-disciplinary activity. It involves drafting legislation, training judges, police forces, customs officials and other experts, setting up agencies or task-forces, public awareness raising, etc. Most of these needs can be, and to some extent already have been, addressed by the Commission via technical cooperation programmes, but it is important to do more and better.

Technical assistance is an activity favoured by the EU for its contribution towards poverty alleviation and development. It is thus important to show that adequate IPR enforcement can contribute to this goal by making a link with investment opportunities, transfer of technology and know-how, protection of traditional knowledge, improvement of health and safety standards, etc.

It will be necessary to have a flexible approach that takes into account the recipient country's different needs, level of development, membership or not of the World Trade Organisation (WTO), and main problems in terms of IPR (country of production, transit or consumption of fake goods). Any cooperation programmes will only be effective if they are prioritised and indeed felt as important in the recipient country.

It is also relevant to share information and to ensure a minimum level of synergy between the main providers of technical assistance, such as WIPO, the World Customs Organisation (WCO), the Member States and third countries like Japan, the US and others.

Finally, the following difficulties must be stressed:

- (a) In most cases, technical cooperation is "demand driven", i.e. it requires a request by the beneficiary of the action. It is important to turn it into a "dialogue driven" request, by discussing its importance and benefits for the recipient.
- (b) It is a mid to long-term solution, with few immediate results. However, the present strategy is a long term one, and adequate enforcement is a goal that will not be achieved only by immediate actions, in particular in the case of least-developed countries, not yet bound by TRIPs requirements.
- (c) Implementing the programmes implies a complex administrative process. This is why further strengthening coordination between the Commission services responsible for the different aspects of IPR enforcement and between the Commission and third parties is an essential component of the present strategy.

Specific actions:

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- Ensure that, at least, the countries identified as priorities are given the option to include intellectual property in the trade-related technical assistance programmes or to obtain specific IP programmes.
 - In particular, the Commission would like to extend technical assistance to Latin America, since it is a region where enforcement can certainly be improved and where no programme is in place.
 - There are a number of programmes that cover IPR. Some, like ECAP [9] I and II, for the ASEAN countries, or even the recently concluded EU-China IPR programme are specifically destined to provide assistance on IPR. Others are generally designed to cover trade related issues, but may include IPR among their objectives - WTO II [10] and Small Project Facility [11], for China; technical cooperation programmes under the framework of the Cotonou Agreement for the African, Caribbean and Pacific (ACP) countries; or the CARDS [12] programme, for the countries of the Balkans. The Commission will ensure that the component of IPR enforcement is adequately covered by these programmes.
 - In the case of "production" countries, the focus in any cooperation programmes must shift from assistance in drafting legislation to a more enforcement-oriented strategy, including training programmes for judges, police, and customs.
 - It must be pointed out that this practice is already being successfully implemented in the specific field of customs (DG TAXUD). There are a number of customs cooperation agreements that, inter alia, cover an essential tool of IPR enforcement (customs controls of fake goods). These agreements with countries like India and China (a new one is soon to be concluded) produce positive results in terms of training and of passing on our experience and methods to these countries. Furthermore, they illustrate how one can build on the existing TRIPs requirements (cf. the control of exports and goods in transit, in addition to the control of imports). It is likely that a similar agreement may be established with Japan still in 2004.
 - Exchange ideas and information with other key providers of technical cooperation, like WIPO, the US, Japan and certain EU Member States, with the aim of avoiding duplication of efforts and sharing of best-practices.
 - Improve the dialogue mechanisms with: (a) the WCO (under the coordination of DG TAXUD) to assess the compatibility of their technical assistance with our positions and the complementarity with our programmes; (b) WIPO and other providers of assistance (the European Patent Office, the Office of the EU Trademarks and Designs, etc.) to share information and to better coordinate strategies.
 - Technical cooperation is also an important element of the TRIPs Agreement (Article 67) and it "fits" into the objectives of the Doha Development Agenda. It can be considered to take an enforcement-oriented initiative in this framework.

5. Dispute Settlement/Sanctions

No rule can be really effective without the threat of a sanction. Countries where IP violations are systematic, and where no government action to address the problem is effectively taken, could be publicly identified. As a last resort, consideration should be given to resorting to dispute settlement mechanisms provided for in multilateral and bilateral agreements.

The existing Trade Barriers Regulation (TBR) mechanism [13] could be a starting-point. TBR is a legal instrument that gives the right to Community enterprises and industries to lodge a complaint, which obliges the Commission to investigate and evaluate whether there is evidence of violation of international trade rules resulting in adverse trade effects. The result is that the procedure will lead to either a mutually agreed solution to the problem or recourse to dispute settlement.

The TBR has a broad scope of application, covering not only goods but also, to some extent, intellectual

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property rights and services, when the violation of rules concerning these rights has an impact on trade between the EC and a third country.

Resort to other trade related mechanisms could also be considered. For instance, the EU includes similar instruments in an increasing number of bilateral agreements that will be triggered in cases of non-compliance with the required high(est) standards of IP protection.

Deficient enforcement derives more frequently from the way the rules are (not) de facto implemented by the competent authorities than from an absence of legislation or a blatant contradiction of legislation with TRIPs requirements. However, when such deficiencies become systemic, they can substantiate a dispute settlement case.

Specific actions:

- Remind right-holders of the possibility to make use of the TBR mechanism in cases of evidence of violation of TRIPs or of the high(est) standards as agreed in bilateral agreements between the EC and third countries. This mechanism is launched by the lodging of a complaint.
- The Commission is ready, in clearly justified cases, to make ex officio use of the WTO dispute settlement mechanism and of the similar dispute settlement tools included in our bilateral agreements in case of non-compliance with the mutually accepted standards of IP protection.
- Consider other mechanisms which could be used to reduce the level of IPR violations in third countries.

6. Creation of public-private partnerships

There are numerous companies and associations which have been active in the fight against piracy/counterfeiting for many years. They constitute an invaluable source of information, but also a key partner for any awareness raising initiatives. Some of these entities are already present, and very active, in most problematic countries.

Other than the specific actions now proposed, there are within the Commission other examples of initiatives to create public-private partnerships that are directly or indirectly linked with IPR enforcement.

One of these projects involved the creation of Innovation Relay Centres, to support companies dealing with transfers of technology [14]. This project includes people with extensive experience in the IPR area (licensing, transfer of IP rights, etc) and could be used to collect information about enforcement problems in third countries. So far the network only covers the EU, but consideration is being given to extending it to third countries. There is a pilot project with an office in Chile.

There is also already in place the "IPR Help-Desk" [15], a project sponsored by the Commission to support creativity and innovation. The purpose of the Help-Desk is not to handle complaints but to provide information to the EU industry. It may therefore give guidance to companies facing violations of their rights in third countries.

Finally, the Commission has a long experience of involving private operators in their seminars and training programmes covering, in particular, border enforcement of IPR.

Specific actions:

- Support the creation of local IP networks involving companies, associations and chambers of commerce. This practice is already being implemented in certain key countries and will be actively supported by DG TRADE.
- Improve cooperation with companies and associations that are active in the fight against piracy/counterfeiting, inter alia by exchanging information about future initiatives and ensuring the cross-participation

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of experts from the Commission and from private entities in events organised by the other party.

7. Awareness raising/Drawing on our own experience

Providing better information to the public is another very relevant dimension of the Strategy. This can be divided into the following components:

- (a) Raising the awareness of users/consumers in third countries. This must be done from two perspectives:
 - (a) to promote the benefits of IPR in terms of promotion of creativity, investment, transfer of technology, protection of traditions and quality;
 - (b) to inform about the dangers of IPR violations to public health, consumer protection, public security, etc.
- (b) Raising the awareness of right-holders. Again from two different perspectives:
 - (a) the risks incurred by trading in certain countries where IPR enforcement is ineffective and the minimum precautions that must be adopted, like registering the IP right in those countries (frequently, small and medium sized companies do not even apply for the protection of their intellectual property in third countries where they are producing or selling their goods);
 - (b) the need to use the means available in these third countries to enforce their rights. Countries which are members of the WTO (with the exception of least-developed countries) must have implemented minimum standards of IP protection and enforcement since 2000. It is clear that the first steps to protect and enforce IPRs must be taken by the right-holders themselves, and that they must use, to the maximum extent, the available mechanisms before being entitled to legitimately complain about the effectiveness of such protection and enforcement.

Specific actions:

- The Commission does not have the resources to pursue alone extensive awareness raising campaigns in third countries. However, this activity could be implemented by some of the abovementioned means, i.e. by inclusion in existing technical cooperation programmes and by public-private partnerships.
- The Commission services sponsored the drafting of a "Guidebook on Enforcement of Intellectual Property Rights". This Guidebook is mainly intended to assist public authorities of developing and least developed countries in their efforts to put in place systems and procedures for the effective enforcement of IPR. In particular, the guidebook considers the most common difficulties confronting those countries in the enforcement of IPR and provides guidance on how to achieve effective and long-lasting protection for such rights. The guidebook identifies useful resources which may be of assistance to authorities and right-holders facing difficulties.
- The Guidebook will be publicly available through the Commission website.

8. Institutional cooperation

The Commission services responsible for the different aspects of IPR enforcement will step up their coordination and cooperation with a view to enhancing the role of the Commission. Without creating an additional layer of bureaucracy, it is necessary to:

- (a) further improve information exchange and coordination between the services in charge of the different aspects of IPR enforcement;
- (b) simplify the identification and the access of external entities (right-holders, third country authorities, etc.) to the service responsible for the specific issue concerning them.

Specific actions:

- Inter-service meetings will be regularly organised to follow up the initiatives being implemented in the framework of the present strategy and to discuss the results obtained, as well as the inclusion of new initiatives. Furthermore, increased cooperation between the services involved with technical

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assistance issues will be introduced in order to promote IPR enforcement-related assistance to relevant third countries.

- In order to help third parties understand the distribution of tasks among the different Commission services:
- A new Commission webpage will be created, presenting: (a) the existing legislation to enforce IPR; (b) a vademecum on enforcement, including the Commission contact points for the various types of IP rights and aspects of their enforcement, as well as links to the various web-pages of the different services dealing with it.
- Cross-links will be inserted in the existing web-pages of each service dealing with certain aspects of IPR or certain sectors.
- Ensure coordination with other Commission initiatives linked with IPR, such as the Innovation Relay Centres and the IPR Help-Desk, and their effective contribution to the objective of the present Strategy by collecting and distributing information vis-à-vis the private sector.

[1] Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004, is available at:http://europa.eu.int/eur-lex/pri/en/oj/dat/2004/l_195/l_19520040602en00160025.pdf

[2] Council Regulation (EC) No 1383/2003 of 22 July 2003, is available at:http://europa.eu.int/comm/taxation_customs/customs/counterfeit_piracy/files/co_unterfeit_en.pdf

[3] This Strategy has no direct supplementary financial implications on the budget of the European Commission.

[4] Reference to intellectual property rights in this paper is made in its wider meaning, i.e., including copyright and related rights, but also trademarks, patents, designs, geographical indications, undisclosed information, etc.

[5] The complete results of the "Survey on Enforcement of Intellectual Property Rights in Third Countries", including a detailed report per country, for all the countries for which sufficient information was received, are available at:http://europa.eu.int/comm/trade/issues/sectoral/intell_property/survey_en.htm

[6] A valuable source of information about the origin, the itinerary and the nature of counterfeit and pirated goods destined to, or in transit via the Community are the annual statistics about the goods originating from third countries seized by Customs at the Community border. The report is released by DG TAXUD. The figures for 2003 can be found at:http://europa.eu.int/comm/taxation_customs/customs/counterfeit_piracy/index_en.htm

[7] Agreement on Trade-Related Aspects of Intellectual Property, Annex 1C to the Agreement establishing the World Trade Organisation (TRIPs, Marrakesh 1994).

[8] Article 51 of the TRIPs Agreement only stipulates the obligation for Members to have in place customs measures for imported goods.

[9] EC-ASEAN IPR Programme comprises a regional and a national component and covers all areas of IPR. It has a value of EUR 5 million. An additional EUR 2 million is planned, to take account of the inclusion of Laos, Cambodia and Vietnam. The project started in 2000 and has a duration of 5 years

[10] WTO II is the largest WTO related support programme in China, with a value of EUR 15 million over 5 years - to which China has indicated willingness to contribute with an additional 30 %. A chapter on IPR will be proposed. The programme should be launched before the end of 2004.

[11] Project designed to support small initiatives in China. With a total value of EUR 9,6 million, and a duration of 5 years, the initiatives are demand-driven, but the inclusion of IPR related

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projects will be actively encouraged.

[12] In the framework of the Community Assistance for Reconstruction, Development and Stabilisation (CARDS) programme for the Western Balkans, a project called "Industrial and Intellectual Property Rights" was launched in July 2003. The project will have a duration of 36 months and a value of EUR 2,25 million.

[13] Council Regulation (EC) No 3286/94 of 22 December 1994 laying down Community procedures in the field of the common commercial policy in order to ensure the exercise of the Community's rights under international trade rules, in particular those established under the auspices of the WTO.<http://europa.eu.int/comm/trade/issues/respectrules/tbr/legis/adgreg06a.htm>

[14] This project is managed by DG ENTR. For more information see:<http://europa.eu.int/comm/enterprise/innovation/networks.htm>

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[15] <http://www.ipr-helpdesk.org>

ANNEX I

BACKGROUND

1. What is the problem?

The TRIPs Agreement establishes for the first time a single, comprehensive, multilateral set of rules covering all kinds of IPR. It contains also a detailed chapter setting minimum standards of IPR enforcement to be adopted by all members of the WTO.

However, despite the fact that, by now, most of the WTO members have adopted legislation implementing such minimum standards [1], the levels of piracy and counterfeiting continue to increase every year. These activities have, in recent years, assumed industrial proportions, because they offer considerable profit prospects with often a limited risk for the perpetrators.

It has thus become clearly insufficient to limit the efforts of the EC to merely monitoring the creation of general legislative frameworks in WTO member countries. It is essential that the EC increasingly focuses on vigorous and effective implementation of the enforcement legislation.

"37. The European Council calls upon the Commission and Member States to improve exploitation of intellectual property rights by taking forward measures against counterfeiting and piracy, which discourages the development of a market for digital goods and services; to protect patents on [computer implemented inventions...](#)"

[3] made a strong call for the increase in the fight against piracy and counterfeiting. As a consequence, the Commission (DG JAI) intends to launch a legislative initiative in 2004 in the form of a proposal for a Council Framework Decision on approximation of national legislation and sanctions on counterfeiting and piracy.

The situation is, however, different outside the borders of the Community. The internal instruments available to Community right-holders in the case of violations of their rights within the Community or in the case of imports of fake goods into the EU are not usable when these violations occur in third countries and the resulting goods are either consumed domestically or exported to other third countries. Although such violations occur outside, they directly affect Community right-holders.

2. Why and how much does it matter? To whom?

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(a) European Community

Violation of IPR, which is reflected in the presence on the market of increasing volumes of pirated and counterfeit goods, has a very negative impact in a number of different areas. The Community, being a market that traditionally invests heavily in IP-protected goods and services and receives considerable added-value for this effort, is particularly affected by poor enforcement of IP, even when it takes place in third countries, and even if the pirated/counterfeit goods or services are not destined for the Community market. These are some of the adverse effects of IP violations:

Economic and social: Deprives right-holders of the revenue from their investment in R&D, marketing, creative effort, quality control, etc. Negatively affects market-share, sales volume, reputation, employment and ultimately the viability of certain IP-based activities/companies. High levels of IPR violations also discourage foreign investment and transfer of technology.

Health and consumer protection: Pirated and counterfeit goods are usually produced by anonymous entities that pay no heed to health, safety and quality requirements and provide no after-sales assistance, guarantees, operating instructions, etc... Illustrating this problem are growing seizures of fake medications, food (and even bottled water), car and plane parts, electrical appliances and toys.

Public order and security: A growing concern in recent years is the increased involvement of criminal organisations and sometimes even of terrorist groups in major international trafficking of counterfeit and pirated goods. This is explained by the particularly lucrative nature of these activities and by the lower risk [4] compared with other lucrative criminal activities. The scale of the problem and the sums of money involved render the situation regarding piracy as complex to tackle as drug trafficking or money laundering. Europol, Interpol and a number of police forces in the Community have created departments dealing specifically with it.

Fiscal: Being an illegal and clandestine practice by nature, and having lower prices it frequently deprives the state from tax revenue (VAT, revenue taxes, customs duties). This issue is particularly sensitive in countries where there are economic sectors under strict state control, like tobacco, alcoholic drinks, fuel, etc.

(b) Third countries

Why should third countries with little tradition in the IPR field, a restricted number of right-holders, and sometimes with a significant share of its industry and commerce benefiting from the violations, care?

The reply to this question is not entirely different from the one given for the Community (see above). The consequences of IPR violations in terms of consumer and health protection, organised crime and loss of fiscal revenue are relatively obvious and directly felt both in the Community and in the third countries where such violations predominantly occur. Consequently, these countries (should) have an immediate interest in combating piracy and counterfeiting.

Regarding the first point however (economic and social consequences), some will say that by enforcing the protection of IP rights held by Community companies, third countries will not obtain any direct benefit. It would appear, on the contrary, that they are using their resources to protect the investment of foreign entities (an argument frequently raised by certain countries). To counter this reasoning, the EC must get across the message that effective enforcement of IP rights (even if these belong to third parties) is an essential tool to attract foreign investment and the transfer of technology and know-how, as well as to protect local right-holders in developing and least-developed countries who are already suffering the misappropriation of their intellectual property [5]. It is a matter of good governance and international credibility, not to mention the need to comply with WTO and

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other international and bilateral commitments. In the mid-to-long term, it will also encourage domestic authors, inventors and investors and contribute to the development of these countries.

Under-estimating the value of intellectual property rights contributes to ineffective enforcement. To enhance this aspect of the intellectual property rights system, it would be useful for some (fast) developing countries to assess the value of the industries based primarily on intellectual property rights [6]. This could lead to an appreciation of the value of intellectual property rights in terms of a country's economic environment, as well as in respect to economic, social and cultural growth and development.

There are, however, recent examples of countries where the emergence of a competitive and increasingly sophisticated economy is making evident the need to efficiently protect IP against domestic and external violations.

In some of the most "problematic" countries the authorities appear to be fully aware of the importance of IPR for the development of the country and domestic right-holders demand enforcement of IPR as rigorously as foreign right-holders. The problem is that the piracy/counterfeiting industry is an important element of their economy. It is therefore clear that there is a broader picture which cannot be tackled merely under the IP angle. Only a comprehensive policy involving authorities at national, regional and local level can provide a solution.

3. Which IP rights are violated and which sectors are most affected?

Most of them. One frequent misconception is that piracy and counterfeiting mainly affect some luxury, sports and clothing brands, music and software CDs/DVDs, and little else. The reality is that virtually every IP is being violated on a considerable scale and that the variety of fake products ranges from cereal boxes to plants and seeds, from aeroplane spare parts to sunglasses, from cigarettes to medications, from AA batteries to entire petrol stations. Big software producers are as likely to be harmed as small makers of a certain type of tea. The annual statistics published by the Commission's customs services regarding the number and the nature of seized pirated and counterfeit goods originating from third countries provide detailed and reliable information about the dimension and the growth of the problem [7].

The Commission considers that the vast majority of the problems affecting holders of the different types of intellectual property rights are common and consequently, are most effectively addressed by an integrated strategy. The strategy now proposed aims at improving enforcement against violations of all kinds of IP (copyright, trademarks, geographical indications, patents, designs, etc.).

4. How to define the "priority" countries?

There are several different criteria to define the most problematic countries in terms of enforcement of IPR [8]. These can be split into: (a) source countries; (b) transit countries, and (c) target countries. For each of these groups of countries, the type of measures most adequate to address the situation will differ.

(a) Source countries

These are the countries where production of pirated and counterfeit goods, both for domestic consumption and for export, reaches worrying dimensions. In cases of digital piracy via the internet, the origin of the IPR violation can be particularly difficult to detect.

In these countries it is particularly important to improve the effectiveness and the coordination of the police, the courts, the customs and the administration in general. It is also essential to ensure that the legal framework provides for deterrent sanctions.

(b) Transit countries

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For the full picture, one should, however, not focus exclusively on countries violating IPR due to the massive production of counterfeited products occurring in their territories, but also on those often acting as a hub. This category includes countries appearing as major places of origin of fake goods seized in the Community, the problem occurring mainly because of the flow of fake products in transit and not because of domestic production of such goods. The large volume of goods originating in these countries is nevertheless indicative of deficient enforcement, at least at the level of border controls. Organised crime networks will take advantage of such weaknesses to establish different traffic routes, hiding the real origin of the goods.

Improving the availability of border measures and the effectiveness of customs authorities in particular regarding the transit of goods should help to substantially reduce the volume of traffic.

(c) Target countries

It is also important to consider, in any strategy to reduce the violations of IPR, the countries identified as the main final destinations of exports of fake goods or serving primarily as a market for such products.

Substantial volumes of sales of fake goods occur in almost all countries. The difficulty of defining countries that are main markets for pirated goods is that it is a very widespread problem, albeit for a variety of (sometimes contradictory) reasons: because they are too poor to buy IP-protected products, because such practice is accepted or at least not condemned, because they produce them in large quantities, because there is sometimes no way to distinguish between real and fake, or because fakes are cheaper. This is why it is necessary to concentrate resources on the main markets of the legitimate Community right-holders most affected by IPR violations.

Dealing with the consumption of pirated and counterfeit goods requires an effort in terms of building up public awareness about the negative impact and the risks of such practice. It also requires more effective customs controls of imported goods and a more effective reaction by the police and courts against those networks and individuals involved in large scale trading in such goods.

5. What is the situation in the Community?

Generally speaking, the Community and its Member States are acknowledged for protecting and enforcing IPR to very high standards, as the *acquis*, and in particular the recent efforts described in point 1 above, can demonstrate. Also in practical terms, reports like the one published annually by DG TAXUD [9] give a clear idea of the results achieved by the authorities of each Member State in terms of seizures of fake goods at the borders.

However, within the Community the level of enforcement is different among Member States. Some Member States still need to do more towards improving the current situation and cutting down remaining production and sale of pirated or counterfeit goods. The new Directive harmonising the enforcement of intellectual property rights within the Community will help to improve the situation.

6. Who are the key actors of IPR enforcement in the Commission?

Different Directorates-General (DGs) of the Commission are competent as regards the distinct aspects of IPR enforcement. In simple terms:

- DG Trade handles the external dimension (multilateral and bilateral) of the issue, i.e. enforcement in third countries. It also represents the European Community at the WTO and notably at the TRIPs Council.
- DG Internal Market (MARKT) is responsible for EU intellectual and industrial property policy and legislation and represents and leads negotiations on behalf of the European Community in various committees in WIPO. DG MARKT was the author of the above mentioned Enforcement Directive.

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- DG Agriculture (AGRI) is responsible for internal and external EU policy and for EU legislation concerning geographical indications in agriculture and leads negotiations in these matters
- DG Taxation and Customs Union (TAXUD) regulates the enforcement of IPR at the Community's external borders. DG TAXUD drafted the above mentioned Customs Regulation.
- DG Justice and Home Affairs (JAI) has shared regulatory responsibilities when IPR enforcement is linked with law enforcement both within and outside the Community. Specific "field" operations in the same area will be handled by the European Anti-Fraud Office (OLAF).
- DG Development (DEV) and DG External Relations (RELEX) coordinate, both centrally and via the EU Delegations in third countries, Community assistance to developing countries and least-developed countries, including in the area of Trade, while the Europe Aid Cooperation Office (AIDCO) manages any technical assistance programmes.
- Finally, DG Enterprise (ENTR), as manager of the IPR Help Desk [10], and with its close contacts with the industry (i.e. with a very important number of IP right-holders), is a key partner.

This is a very crucial point for the efficacy of the present Strategy. DG TRADE and other DGs with external responsibilities have an important and well defined role in terms of improving the enforcement of IPR in third countries. However, the most "operational" responsibilities of the fight against piracy and counterfeiting lie with Member States or with other DGs. The most visible and/or immediate results in this fight will always be achieved by the customs authorities, the police, national courts, the harmonisation of laws and procedures and the creation of information exchange mechanisms at Community level. In these (mainly domestic) areas DG TRADE can only provide a limited contribution. The situation is, however, different with regard to enforcement in third countries. In this case, DG TRADE and the Commission services with external responsibilities in these matters, with the cooperation of the EC Delegations in third countries, can certainly play a key role in achieving the implementation of the tasks proposed in the present Strategy.

[1] Least Developed Countries have until 2006, at least, to adapt their legislation to the TRIPs requirements.

[2] Copy available upon request sent to MARKT-E4@cec.eu.int

[3]

[4] In many countries other very lucrative criminal activities like drug trafficking carry considerable risks (even the death penalty) and are combated with considerable resources, while the trafficking of fake goods is seen as a relatively harmless practice.

[5] Cf. the cases of counterfeits of certain brands of rice wine in China or of a well-known local fish sauce brand in Vietnam.

[6] The Commission services published a study in 2003 entitled The economic importance of copyright (http://www.europa.eu.int/comm/internal_market/en/intprop/index.htm). Some countries, such as the USA and Finland produce such documents, namely for the copyright industries ("Copyright industries in the US Economy - Stephen E. Siwek & Gale Mosteller, prepared for the International Intellectual Property Alliance and The Economic Importance of Copyright Industries in Finland, the Finnish Copyright Society").

[7] http://europa.eu.int/comm/taxation_customs/customs/counterfeit_piracy/index_en.htm

[8] "Priority countries" can be identified on the basis of the following criteria:

- Information received from Community right-holders and other sources (Delegations, etc.) regarding IPR violations.
- Data regarding customs seizures of fake goods at the Community's borders.

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- Relevance of the countries in terms of actual or potential volume of trade with the Community. The inclusion of a country in one or more of the categories reflects the level of relevance of the situation in that particular country from the Community perspective. Countries with reduced importance in terms of trade were not considered a priority. In any event, the situation in this area is constantly changing, therefore it will require continuous monitoring and updating.

[9] http://europa.eu.int/comm/taxation_customs/customs/counterfeit_piracy/index_en.htm

[10] <http://www.ipr-helpdesk.org/index.htm>

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Counterfeiting and piracy: Commission proposes criminal law provisions to combat intellectual property offences

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Brussels, 26 April 2006

Counterfeiting and piracy: Commission proposes criminal law provisions to combat intellectual property offences

The Commission has today adopted a proposal for a directive to combat intellectual property offences that amends the proposal approved by it on 12 July 2005. It is thus responding to the Court ruling of 13 September 2005 in Case C-176/03, according to which the criminal law provisions necessary for the effective implementation of Community law are a matter for Community law^[1]. Accordingly, the proposal for a Council framework decision to strengthen the criminal law framework to combat intellectual property offences^[2] has been withdrawn and its provisions incorporated into the amended proposal for a directive.

According to Commission Vice-President Franco Frattini, who is responsible for justice, freedom and security matters, the new provisions proposed by the Commission represent the criminal law dimension of the fight against counterfeiting and piracy in Europe. Effective approximation of Member States' criminal legislation in this field is the minimum needed to pursue together a major campaign aimed at eradicating these phenomena, which are causing serious harm to the economy. Nowadays, criminal organisations are focusing on these activities, which are often more lucrative than other forms of trafficking and on which the authorities do not crack down as much. Counterfeiters and pirates undermine legitimate businesses and pose a threat to innovation. What is more, in many cases the counterfeit goods are prejudicial to public health and safety. For the most recent statistics on counterfeiting listed by Member State please see the link:

http://europa.eu.int/comm/taxation_customs/customs/customs_controls/counterfeit_piracy/statistics/index_en.htm

The proposed measures are designed to bring Member States' criminal legislation more closely into alignment and to improve European cooperation so as to combat more effectively counterfeiting and piracy, which are frequently committed by criminal organisations, often pose a risk to health and safety, and seriously harm the interests of many sectors in the European economy.

The arrangements will have to be applied to all types of intellectual property right infringements. In the directive, all intentional infringements of an intellectual property right on a commercial scale, including attempting, aiding and abetting such infringements, are treated as criminal offences. The minimum sentence is a term of four years' imprisonment where the infringement is committed under the aegis of a criminal organisation or carries a serious risk to the health and safety of individuals. The amount of the fine will have to be at least EUR 100 000 or EUR 300 000 where there is a link with a criminal organisation or any risk to health and safety. Member States may impose heavier penalties or fines.

[1] <http://curia.eu.int/jurisp/cgi-bin/form.pl?lang=fr&Submit=Rechercher&docj=docj&numaff=C-176%2F03&datefs=2005-09-13&datefe=&nomusuel=Commission&domaine=&mots=&resmax=100>

[2] http://www.cc.cec/home/dgserv/sg/sgvista/i/sgv2/repo/repo.cfm?institution=COMM&doc_to_browse=COM/2005/0276&refresh_session=YES

Amended proposal for a Directive of the European Parliament and of the Council on criminal measures aimed at ensuring the enforcement of intellectual property rights

[pic] | COMMISSION OF THE EUROPEAN COMMUNITIES |

Brussels, 26.4.2006

COM(2006) 168 final

2005/0127 (COD)

Amended proposal for a

DIRECTIVE OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL

on criminal measures aimed at ensuring the enforcement of intellectual property rights

(presented by the Commission)

EXPLANATORY MEMORANDUM

JUSTIFICATION FOR THE PROPOSAL

This proposal for a Directive amends the proposal for a Parliament and Council Directive on criminal measures aimed at ensuring the enforcement of intellectual property rights (2005/0127 COD). It puts into effect the Communication from the Commission of 23 November 2005 (COM(2005) 583 final) on the implications of the Court's judgment of 13 September 2005 (Case C [176/03](#) Commission v Council). It was held in that judgment that provisions of criminal law required for the effective implementation of Community law come under the EC Treaty. The Commission states in its Communication that it will make the necessary changes to pending proposals as and when required. It specifically mentions the proposal for a Parliament and Council Directive on criminal measures aimed at ensuring the enforcement of intellectual property rights and the proposal for a Council Framework Decision to strengthen the criminal law framework to combat intellectual property offences (COM(2005) 276 final). Consequently, the proposal for a Framework Decision has been withdrawn and a proposal drawn up amending the proposal for a Directive on criminal measures.

The provisions in the proposal for a Framework Decision relating to penalties and extended powers of confiscation have now been incorporated in the new proposal for a Directive.

The only provisions that have not been taken over are those relating to jurisdiction and the coordination of proceedings, contained in Article 5 of the proposal for a Framework Decision. The Commission plans to take a horizontal approach to this subject under its Green Paper on conflicts of jurisdiction and the principle of *ne bis in idem* in criminal proceedings, adopted on 23 December 2005 [1]. It does not consider it essential to lay down specific arrangements for the protection of intellectual property.

Counterfeiting and piracy, and infringements of intellectual property in general, are a constantly growing phenomenon which nowadays has an international dimension, since they are a serious threat to national economies and governments. The disparities between the national systems of penalties, apart from hampering the proper functioning of the internal market, make it difficult to combat counterfeiting and piracy effectively. In addition to the economic and social consequences, counterfeiting and piracy also pose problems for consumer protection, particularly when health and safety are at stake. Increasing use of the Internet enables pirated products to be distributed instantly around the globe. Finally, this phenomenon appears to be increasingly linked to organised crime. Combating this phenomenon is therefore of vital importance for the Community. Counterfeiting and pirating have become lucrative activities in the same way as other large-scale criminal activities such as drug trafficking. There are high potential profits to be made without risk of serious legal penalties.

Additional provisions to strengthen and improve the fight against counterfeiting and piracy are therefore necessary to supplement Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights. In addition to the civil and administrative measures, procedures and remedies provided for in Directive 2004/48/EC, criminal penalties also constitute, in appropriate cases, a means of enforcing intellectual property rights[2].

A start was made on harmonisation with the entry into force of the TRIPS agreement which lays down minimum provisions on means of enforcing trade-related intellectual property rights. These include the implementation of criminal procedures and criminal penalties, but there are still major disparities in the legal situation in the Community which do not allow the holders of intellectual property rights to benefit from an equivalent level of protection throughout the Community. As regards criminal penalties, there are considerable differences, particularly as regards the level of punishment laid down by national legislation.

As regards impact on fundamental rights, it should be emphasised that the direct objective of this initiative is to implement Article 17(2) of the Charter of Fundamental Rights which states that Intellectual property shall be protected; it does this by approximation of legislation while respecting the different legal traditions and systems of the Member States as well as other fundamental rights and principles recognised by the Charter. The level of sentences has been chosen pursuant to the seriousness of the different forms of wrongful conduct, in accordance with Article 49(3) of the Charter to the effect that sentences should not be disproportionate to the offence.

Since this objective may be better achieved at Community level, the Community may take measures in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty.

Content of the proposal

Article 1

This Article sets out the subject-matter and scope of the Directive, which concerns the measures necessary to ensure the enforcement of intellectual property rights. As in Directive 2004/48/EC on the enforcement of intellectual property rights, the expression "intellectual property rights" encompasses all intellectual property rights. Just like Article 17(2) of the Charter of Fundamental Rights of the European Union, which provides that intellectual property shall be protected, this is a horizontal measure.

The Directive is to apply to any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member States, in the same way as Directive 2004/48/EC. Commission statement 2005/295/EC on Article 2 of Directive 2004/48/EC lists these rights, with the aim of providing greater legal certainty regarding the scope of the Directive[3]. The Directive is to apply without prejudice to more stringent provisions in the Member States.

Article 2

This Article defines the concept of a legal person for the purposes of the Directive.

Article 3

This Article obliges Member States to consider all intentional infringements of an intellectual property right on a commercial scale as a criminal offence. It also covers attempting, aiding or abetting and inciting such offences. The commercial scale criterion is borrowed from Article 61 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), concluded on 15 April 1994 and signed by all the members of the World Trade Organisation. Article 61 obliges Members to provide for criminal procedures and penalties to be applied at least in cases of wilful trademark counterfeiting or copyright piracy on a commercial scale. Remedies available shall include imprisonment and/or monetary fines sufficient to provide a deterrent, consistently with the level of penalties applied for crimes of a corresponding gravity. In appropriate cases, remedies available shall also include the seizure, forfeiture and destruction of the infringing goods and of any materials and implements the predominant use of which has been in the commission of the offence. Members may provide for criminal procedures and penalties to be applied in other cases of infringement of intellectual property rights, in particular where they are committed wilfully and on a commercial scale.

The infringement must be intentional, that is to say that the act must be deliberate, whether it is an actual infringement, an attempt at infringement, or aiding and abetting or inciting such an offence. This does not affect specific liability systems such as the system laid down for Internet service providers in Articles 12 to 15 of Directive 2000/31/EC on electronic commerce[4].

Article 4

This article concerns the nature of penalties: besides imprisonment for natural persons, the Directive lays down a range of penalties to be imposed on both natural and legal persons, such as fines and the seizure of goods belonging to the offender, including the infringing goods and the materials, implements or media used predominantly for the manufacture or distribution of the goods in question. Other penalties are provided for specific cases: destruction of infringing goods and goods principally used in the manufacture of the goods in question, total or partial closure, on either a permanent or a temporary basis, of the establishment or shop primarily used to commit the infringement. Provision is also made for a permanent or temporary ban on engaging in commercial activities, placement under judicial supervision or judicial winding-up, and a ban on access to public assistance or subsidies. Finally, the publication of judicial decisions is provided for. This can serve as a means of dissuasion and as a channel of information both for right holders and for the public at large.

Article 5

This article concerns the level of criminal penalties: offences must incur a maximum term of at least four years' imprisonment when they are committed under the aegis of a criminal organisation. The same applies where the offences carry a health or safety risk. The threshold of four years' imprisonment was chosen because it broadly corresponds to the criterion used to identify a serious offence. It is the threshold selected in Joint Action 98/733/JHA and in the proposal for a Council Framework Decision on the fight against organised crime (COM(2005) 6 final) and in the United Nations Convention against Organised Transnational Crime. For natural persons or legal entities who commit the offences listed in Article 3, the penalties include criminal and non-criminal fines to a maximum of at least EUR 100 000 for cases other than the most serious cases and to a maximum of at least EUR 300 000 for offences carried out under the aegis of a criminal organisation or which carry a health or safety risk. It must be possible for this factor to be taken into account

where the risk is deemed to be present, even where the dangerous product has not yet caused any damage. A risk to personal health or safety exists where the counterfeit product placed on the market directly exposes people to a risk of illness or accident.

Article 6

This article provides for the full or partial confiscation of goods belonging to persons convicted of offences committed in the circumstances set out in Article 5. It refers to the provisions of Article 3 of Council Framework Decision 2005/212/JHA of 24 February 2005 on Confiscation of Crime-Related Proceeds, Instrumentalities and Property [5].

Article 7

The Framework Decision of 13 June 2002 provides the structure needed to set up joint investigation teams. To facilitate criminal investigations into intellectual property offences, the Member States must allow the holders of intellectual property rights concerned, or their representatives, and experts to assist the investigations carried out by these teams. It is very difficult to carry out investigations in this area and it is often essential to have the active participation of the victims, of representatives of the holder of the intellectual property rights or of experts in order to reach conclusions, and in particular to establish that products have been counterfeited. In the event of doubt, the victims or their representatives will thus be able to confirm rapidly whether the products discovered in an investigation have indeed been counterfeited. This will facilitate the search by joint investigation teams for evidence of intellectual property offences. Member States have a good deal of latitude in this regard.

Article 8

The purpose of this article is to ensure that investigations into, or prosecution of, counterfeiting and piracy offences are not dependent on a report or accusation made by a person subjected to the offence, at least if the acts were committed in the territory of the Member State. Such a measure is necessary to ensure that the conditions are right for carrying out investigations into intellectual property offences. It is often the case that stocks of suspected counterfeit products are discovered, but it is sometimes difficult to contact or even identify quickly the holder of the rights in the internal market. The victims of counterfeiting may be located in any part of the Community territory and may be small or medium-sized enterprises and not just large enterprises selling well-known products. Investigations would be hampered if a prior complaint by the victim were required. Intellectual property offences are often committed without the knowledge of the holder of the rights, and the absence of a complaint does not amount to negligence on the victim's part.

Article 9

This Article concerns the measures for transposing the Directive into the internal law of the Member States. The deadline of eighteen months is modelled on the provisions of other Directives.

Article 10

This Article lays down that the Directive enters into force on the twentieth day following its publication in the Official Journal, pursuant to the provisions of Article 254(1) of the EC Treaty.

Article 11

This Article lays down that this Directive is addressed to the Member States.

2005/0127 (COD)

Amended proposal for a

DIRECTIVE OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL

on criminal measures aimed at ensuring the enforcement of intellectual property rights

(Text with EEA relevance)

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 95 thereof,

Having regard to the proposal from the Commission[6],

Having regard to the opinion of the European Economic and Social Committee[7],

Having regard to the opinion of the Committee of the Regions[8],

Acting in accordance with the procedure laid down in Article 251 of the Treaty[9],

- (1) The Green Paper on the fight against counterfeiting and piracy in the Single Market presented by the Commission on 15 October 1998 noted that counterfeiting and piracy had grown into an international phenomenon with major repercussions at economic and social level and in terms of consumer protection, especially as regards public health and safety. An action plan was drawn up as part of the follow-up to the Green Paper and was included in a communication on the same subject from the Commission to the Council, the European Parliament and the Economic and Social Committee on 30 November 2000.
- (2) In its conclusions, the Brussels European Council of 20 and 21 March 2003 invited the Commission and the Member States to improve exploitation of intellectual property rights by taking forward measures against counterfeiting and piracy.
- (3)(1) At international level, all Member States, as well as the Community itself, as regards matters within its competence, are bound by the Agreement on Trade-Related Aspects of Intellectual Property (the "TRIPS Agreement"), concluded in the framework of the World Trade Organisation and approved by Council Decision 94/800/EC[10]. The TRIPS Agreement contains, in particular, provisions on criminal matters which are common standards applicable at international level, but the disparities between Member States are still too great, and they do not permit effective combating of intellectual property offences, particularly the most serious ones. This causes a loss of confidence in the Internal Market in business circles, with a consequent reduction in investment in innovation and creation.
- (4) The Commission also adopted in November 2004, an Intellectual Property Rights Enforcement

Strategy towards third countries.

(5)(2) Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights[11] lays down measures, procedures and civil and administrative remedies. A sufficiently dissuasive set of penalties applicable throughout the Community is needed to make the provisions laid down in this Directive complete. Certain criminal provisions need to be harmonised so that counterfeiting and piracy in the internal market can be combated effectively. The Community legislator has the power to take the criminal-law measures that are necessary to guarantee the full effectiveness of the rules it lays down on the protection of intellectual property.

(6) Building on the Commission Communication on a customs response to counterfeiting and piracy adopted in October 2005 [12] , the Council has adopted a Resolution on 13 March 2006, whereby it underlines that the Lisbon Strategy objectives "can only be achieved through a well-functioning internal market with adequate measures to encourage investment in the knowledge-based economy and recognises the threat posed by the serious growth in counterfeiting and piracy to the Union's knowledge-based economy and in particular to health and safety (...)".

(7) The level of sentencing for natural and legal persons who have committed such offences must be harmonised. In particular, the rules on prison sentences, fines and confiscation must be harmonised.

(8) Provisions must be laid down to facilitate criminal investigations. The Member States must ensure that the holders of intellectual property rights concerned, or their representatives, and experts are allowed to assist the investigations carried out by joint investigation teams.

(9) To facilitate investigations or criminal proceedings concerning intellectual property offences, these may not be dependent on a report or accusation made by a person subjected to the offence.

(10)(3) This Directive does not affect specific liability systems such as that laid down for Internet service providers in Articles 12 to 15 of Directive 2000/31/EC on electronic commerce[13].

(11)(4) As the objective of this Directive cannot be achieved adequately by the Member States acting alone and could better be achieved by action at Community level, the Community may take measures in accordance with the principle of subsidiarity as declared by Article 5 of the Treaty establishing the European Community. In accordance with the principle of proportionality, as set out in that Article, this Directive does not go beyond what is necessary in order to achieve that objective.

(12)(5) This Directive respects fundamental rights and observes the principles recognised by the Charter of Fundamental Rights of the European Union. In particular, this Directive seeks to ensure full respect for intellectual property, in accordance with Article 17(2) of the Charter,

HAVE ADOPTED THIS DIRECTIVE:

Article 1

Objective and scope

This Directive lays down the criminal measures necessary to ensure the enforcement of intellectual property rights.

These measures shall apply to intellectual property rights provided for in Community legislation and/or national legislation in the Member States.

Article 2

Definition

For the purposes of this Directive, legal person means any legal entity having such status under the applicable national law, except for States or any other public bodies acting in the exercise of their prerogative of public power, as well as public international organisations.

Article 3

Offences

Member States shall ensure that all intentional infringements of an intellectual property right on a commercial scale, and attempting, aiding or abetting and inciting such infringements, are treated as criminal offences.

Article 4

Nature of penalties

1. For the offences referred to in Article 3, the Member States shall provide for the following penalties:

- a) for natural persons: custodial sentences;
- b) for natural and legal persons:
 - i) fines;
 - ii) confiscation of the object, instruments and products stemming from infringements or of goods whose value corresponds to those products.

2. For the offences referred to in Article 3, the Member States shall provide that the following penalties are also available in appropriate cases:

- (a) destruction of the goods infringing an intellectual property right;
- (b) total or partial closure, on a permanent or temporary basis, of the establishment used primarily to commit the offence;
- (c) a permanent or temporary ban on engaging in commercial activities;
- (d) placing under judicial supervision;
- (e) judicial winding-up;
- (f) a ban on access to public assistance or subsidies;
- (g) publication of judicial decisions.

Article 5

Level of penalties

3. Each Member State shall take the necessary measures to ensure that, when committed by natural persons, the offences referred to in Article 3 are punishable by a maximum sentence of at least four years' imprisonment when committed under the aegis of a criminal organisation within the meaning of Framework Decision.... on the fight against organised crime, or where they carry a health or safety risk.

4. Member States shall take the necessary measures to ensure that, when committed by natural persons or legal entities, the offences referred to in Article 3 are punishable by effective, proportionate and dissuasive penalties. These penalties shall include criminal and non-criminal fines:

- (a) to a maximum of at least EUR 100 000 for cases other than the most serious cases;
- (b) to a maximum of at least EUR 300 000 for cases referred to in paragraph 1.

Article 6

Extended powers of confiscation

The Member States shall take the necessary measures to allow the total or partial confiscation of goods belonging to convicted natural or legal persons in accordance with Article 3 of Framework Decision 2005/212/JHA of 24 February 2005 on Confiscation of Crime-Related Proceeds, Instrumentalities and Property, at least where the offences are committed under the aegis of a criminal organisation, within the meaning of Framework Decision.... on the fight against organised crime, or where they carry a health or safety risk.

Article 7

Joint investigation teams

The Member States must ensure that the holders of intellectual property rights concerned, or their representatives, and experts, are allowed to assist the investigations carried out by joint investigation teams into the offences referred to in Article 3.

Article 8

Initiation of criminal proceedings

Member States shall ensure that the possibility of initiating investigations into, or prosecution of, offences covered by Article 3 are not dependent on a report or accusation made by a person subjected to the offence, at least if the acts were committed in the territory of the Member State.

Article 59

Transposal

5. Member States shall bring into force the provisions necessary to comply with this Directive

by..... at the latest [eighteen months after the date of its adoption]. They shall forthwith communicate to the Commission the text of those provisions and a correlation table between those provisions and this Directive. When Member States adopt these provisions, they shall contain a reference to this Directive or shall be accompanied by such reference at the time of their official publication. The procedure for such reference shall be adopted by Member States.

6. Member States shall communicate to the Commission the provisions of national law which they adopt in the field covered by this Directive.

Article 610

Entry into force

This Decision shall enter into force on the day following its publication in the Official Journal of the European Union.

Article 711

This Directive is addressed to the Member States.

Done at Brussels,

For the European Parliament For the Council

The President The President

[1] COM(2005) 696 final.

[2] Recital 28 to Directive 2004/48/EC of 29 April 2004 states that "in addition to the civil and administrative measures, procedures and remedies provided for under this Directive, criminal sanctions also constitute, in appropriate cases, a means of ensuring the enforcement of intellectual property rights."

[3] OJ L 94, 13.4.2005, p. 37.

[4] OJ L 178, 17.7.2000, p. 1.

[5] OJ L 68, 15.3.2005, p. 49.

[6] OJ C [...], [...], p. [...].

[7] OJ C [...], [...], p. [...].

[8] OJ C [...], [...], p. [...].

[9] OJ C [...], [...], p. [...].

[10] OJ L 336, 23.12.1994, p. 1.

[11] OJ L 195, 2.6.2004, p. 16.

[12] COM(2005) 479 final of 11.10.2005

[13] OJ L 178, 17.7.2000, p. 1.

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Communication from the Commission to the European Parliament and the Council on the implications of the Court's judgment of 13 September 2005 (Case C 176/03 Commission v Council) /* COM/2005/0583 final */

[pic] | COMMISSION OF THE EUROPEAN COMMUNITIES |

Brussels, 23.11.2005

COM(2005) 583 final

COMMUNICATION FROM THE COMMISSION TO THE EUROPEAN PARLIAMENT AND THE COUNCIL

on the implications of the Court's judgment of 13 September 2005 (Case C-176/03 Commission v Council)

COMMUNICATION FROM THE COMMISSION TO THE EUROPEAN PARLIAMENT AND THE COUNCIL

on the implications of the Court's judgment of 13 September 2005 (Case C-176/03 Commission v Council)

1. The judgment of 13 September 2005 in Case C-176/03 Commission v Council clarifies the distribution of powers between the first and third pillars as regards provisions of criminal law. This clarification removes any doubts about a question which has long been controversial. The Commission's aim with this Communication is to explain the conclusions to be drawn from it. A list of the instruments affected by the implications of the judgment is in the annex . One of the aims of this Communication is to suggest a method to correct the situation with regard to texts which were, in the light of the Court's ruling, not adopted on the proper legal basis. It also aims at setting the direction of the future use of the Commission's right of initiative.

1. CONTENT AND SCOPE OF THE JUDGMENT OF 13 SEPTEMBER 2005 IN CASE C-176/03 (COMMISSION V COUNCIL)

1.1. Content of the judgment of 13 September 2005 in Case C-176/03

2. The Commission had asked the Court to annul Council Framework Decision 2003/80/JHA of 27 January 2003 on the protection of the environment through criminal law[1], which required the Member States to provide for criminal sanctions in the case of the offences against environmental law set out in the Framework Decision, on the grounds that the power to impose such an obligation on the Member States is a matter for a Community instrument and the Commission had in fact proposed the adoption of such an instrument[2].

3. The Court found that although "as a general rule, neither criminal law nor the rules of criminal procedure fall within the Community's competence"[3], "the last-mentioned finding does not prevent the Community legislature, when the application of effective, proportionate and dissuasive criminal penalties by the competent national authorities is an essential measure for combating serious environmental offences , from taking measures which relate to the criminal law of the Member States which it considers necessary in order to ensure that the rules which it lays down on environmental protection are fully effective "[4].

4. Consequently, Articles 1 to 7 of the Framework Decision – which deal with the definition of offences, the principle of the obligation to impose criminal penalties, the rules on participation and instigation, the level of penalties, accompanying penalties and the specific rules on the liability of legal persons – which, "on account of both their aim and their content", "have as their main purpose the protection of the environment", "could have been properly adopted on the basis of Article 175 EC"[5]. "In those circumstances, the entire framework decision, being indivisible, infringes Article 47 EU as it encroaches on the powers which Article 175 EC confers on the Community"[6], and should be annulled. Art 47 EU establishes the primacy of

Community law over Title VI of the TEU.

5. It should be noted that the Court went further than the proposals of its Advocate-General, who took the view that the Community legislature had the power to establish the principle of the use of criminal penalties against serious environmental offences but not to lay down in detail and in concrete terms what the arrangements should be.

1.2. Scope of the judgment of 13 September 2005

6. The Court refers in its analysis to the traditional criterion of the aim and content of the act in order to establish whether the legal basis is correct. In this case, the Community policy concerned is environmental protection. However the judgment lays down principles going far beyond the case in question. The same arguments can be applied in their entirety to the other common policies and to the four freedoms (freedom of movement of persons, goods, services and capital).

7. However, the judgment makes it clear that criminal law as such does not constitute a Community policy, since Community action in criminal matters may be based only on implicit powers associated with a specific legal basis. Hence, appropriate measures of criminal law can be adopted on a Community basis only at sectoral level and only on condition that there is a clear need to combat serious shortcomings in the implementation of the Community's objectives and to provide for criminal law measures to ensure the full effectiveness of a Community policy or the proper functioning of a freedom.

8. From the point of view of subject matter, in addition to environmental protection the Court's reasoning can therefore be applied to all Community policies and freedoms which involve binding legislation with which criminal penalties should be associated in order to ensure their effectiveness.

9. The Court makes no distinction according to the nature of the criminal law measures. Its approach is functional. The basis on which the Community legislature may provide for measures of criminal law is the necessity to ensure that Community rules and regulations are complied with.

10. The Commission will have to determine, when submitting proposals, whether this test of necessity, is met on a case by case basis. When for a given sector, the Commission considers that criminal law measures are required in order to ensure that Community law is fully effective, these measures may, depending on the needs of the sector in question, include the actual principle of resorting to criminal penalties, the definition of the offence - that is, the constituent element of the offence - and, where appropriate the nature and level of the criminal penalties applicable^[7], or other aspects relating to criminal law. It is the specific requirement of the Community policy or freedom in question which constitutes the link with the legal basis of the EC Treaty which provides the justification for such measures. Again it is on a case by case basis, depending on necessity, that the Commission will determine the degree of Community involvement in the criminal field, whilst giving priority as much as possible to horizontal measures not specific to the relevant sector. Thus, Member States' freedom to choose the penalties they apply may be limited by the Community legislature, if the effectiveness of Community law so requires.

2. EFFECTS OF THE COURT JUDGMENT

2.1. General situation following the judgment

11. The clarification by the Court judgment of the distribution of powers between the first and the third pillar has led to the following situation:

- The provisions of criminal law required for the effective implementation of Community law are a matter for the TEC. This system brings to an end the double-text mechanism (directive or regulation and framework decision) which has been used on several occasions in the past. In other words, either a criminal law provision specific to the matter in hand is needed to ensure the effectiveness of Community law, and it is adopted under the first pillar only, or there does not appear to be a need to resort to the criminal law at Union level - or there are already adequate horizontal provisions - and specific legislation is not introduced at European level.

- The horizontal criminal law provisions aimed at encouraging police and judicial cooperation in the broad sense, including measures on the mutual recognition of judicial decisions, measures based on the principle of availability, and measures on the harmonisation of criminal law in connection with the creation of the area of freedom, security and justice not linked to the implementation of Community policies or fundamental freedoms, fall within Title

VI of the TEU. Specifically, it follows from the judgment of the Court that those aspects of criminal law and criminal procedure which require a horizontal approach do not in principle fall within the scope of Community law. This would normally be the case for questions linked to general rules of criminal law and criminal procedure as well as those related to police and judicial cooperation in criminal matters.

2.2. Consistency of the Union's criminal law policy

Although the Community legislature may use the criminal law to achieve its objectives, it may do so only if two conditions – necessity and consistency - are met.

12. Necessity. Any use of measures of criminal law must be justified by the need to make the Community policy in question effective. In principle, responsibility for the proper application of Community law lies with the Member States. In some cases, however, it is necessary to direct the action of the Member States by specifying explicitly (i) the type of behaviour which constitutes a criminal offence and/or (ii) the type of penalties to be applied and/or (iii) other criminal-law measures appropriate to the area concerned. Checks must be carried out to establish necessity and the observance of the principles of subsidiarity and proportionality at each of these stages.

13. Consistency. The criminal-law measures adopted at sectoral level on a Community basis must respect the overall consistency of the Union's system of criminal law, whether adopted on the basis of the first or the third pillar, to ensure that criminal provisions do not become fragmented and ill-matched. If a sector seems to require specific rules in order to implement the objectives of the EC Treaty, the relationship between these specific rules and the horizontal rules should if necessary be clarified. Care must also be taken to ensure that the Member States or the persons concerned are not required to comply with conflicting obligations. When using its right of initiative, the Commission will take the utmost care to ensure that this consistency is preserved. Parliament and the Council must also take account of this requirement in their own internal organisation.

2.3. Consequences of the judgment for acts adopted and proposals pending.

14. As a result of the Court's judgment the framework decisions in annex are entirely or partly incorrect, since all or some of their provisions were adopted on the wrong legal basis. It is important for a number of reasons to regularise these texts quickly by re-establishing the correct legal bases. Firstly, even when the period for lodging an appeal has expired the institutions have a duty to restore their legality. This duty lies in the first instance with the Commission, as the guardian of the Treaties and the only body with the power to propose Community acts. However, an equal responsibility rests with the European Parliament and the Council, which are responsible for adopting these acts. The second reason concerns the imperatives of legal security, since the wrong legal basis of the framework decisions could, in some cases, undermine the national implementing legislation.

15. The Commission decided on 23 November to appeal to the Court of Justice for the annulment of the Council Framework Decision 2005/667/JHA of 12 July 2005 to strengthen the criminal-law framework for the enforcement of the law against ship-source pollution. This is the only case where the Commission has had the possibility to introduce an appeal for annulment for reasons of procedural deadlines. In this case, the Commission considers that from a legal point of view the decision to appeal would complete the package of appropriate measures to correct the situation in relation to the above mentioned framework decision. Ensuring that the rights of the Commission are preserved, the appeal seeks to restore legality and provide the necessary legal certainty. The appeal will be withdrawn once the proposal aiming at correcting the legal basis for the framework decision in question is adopted.

16. There are several ways in which existing law can be rectified in the light of the judgment. One approach would be to review the existing instruments with the sole purpose of bringing them into line with the distribution of powers between the first and the third pillar as laid down in the Court judgment. In such a case, the Commission's proposals would not contain any provisions which differed in substance from those of the acts adopted, even where the Commission felt that these acts were not satisfactory. This option offers a quick and easy solution. It allows the substance of Community legislation to remain unchanged and ensures legal certainty with regard to provisions that are important to the realisation of an area of freedom, security and justice. This solution would work only if Parliament and the Council agree not to open discussions of substance during this special procedure. Such an approach accordingly requires the prior agreement of the three institutions.

17. If such an agreement could not be reached, the Commission would make use of its power

of proposal in order not only to restore the correct legal bases to acts which have been adopted but also to prioritise substantive solutions in line with what it judges the Community interest to be.

18. This alternative is redundant in the case of pending proposals. The Commission will therefore make the necessary changes to its proposals as and when required. These proposals will then follow the full decision-making procedure applicable to their legal basis.

19. A list of the acts adopted and pending proposals potentially affected by the Court Decision and which require amendment is attached to this communication.

ANNEX

List of texts affected by the CJEC judgment in Case C- 176/03

Text | Legal basis to be used (TEC) |

Acts adopted |

Act annulled: Council Framework Decision 2003/80/JHA of 27 January 2003 on the protection of the environment through criminal law (OJ L 29, 5.2.2005, p. 55) | Article 175(1)[8] |

Council framework Decision of 29 May 2000 on increasing protection by criminal penalties and other sanctions against counterfeiting in connection with the introduction of the euro (OJ L 140, 14.6.2000, p. 1) and Council Framework Decision of 6 December 2001 amending Framework Decision 2000/383/JHA on increasing protection by criminal penalties and other sanctions against counterfeiting in connection with the introduction of the euro (OJ L 329, 14.12.2001, p 3). | Article 123(4) |

Council Framework Decision 2001/413/JHA combating fraud and counterfeiting of non-cash means of payment (OJ L 149, 2.6.2001, p. 1) | Article 57(2) and Article 95 |

Council Directive 91/308/EEC of 10 June 1991 on prevention of the use of the financial system for the purpose of money laundering (OJ L 166, 28.6.1991, p. 77) and Council Framework Decision 2001/500/JHA of 26 June 2001 on money laundering, the identification, tracing, freezing, seizing and confiscation of instrumentalities and the proceeds of crime (OJ L 182, 5.7.2001, p.1) and | Article 47(2) and Article 95 |

Directive defining the facilitation of unauthorised entry, transit and residence and Council framework Decision on the strengthening of the penal framework to prevent the facilitation of unauthorised entry, transit and residence of 28 November 2002 (OJ L 328, 5.12.2002, pp. 17 and 1). | Articles 61(a) and 63(3)(b) |

Council Framework Decision 2003/568/JHA of 22 July 2003 on combating corruption in the private sector (OJ L 192, 31.7.2003, p. 54) | Article 95 |

Council Framework Decision 2005/222/JHA of 24 February 2005 on attacks against information systems (OJ L 69, 16.3.2005, p. 67) | Article 95 |

Directive 2005/35/EC of the European Parliament and of the Council of 7 September 2005 on ship-source pollution and on the introduction of penalties for infringements and Council Framework Decision 2005/667/JHA of 12 July 2005 to strengthen the criminal-law framework for the enforcement of the law against ship-source pollution (OJ L 255, 30.9.2005, pp. 11 and 164) | Article 80(2) [] |

Proposals pending[9] |

Proposal for a Directive of the European Parliament and of the Council on the criminal-law protection of the Community's financial interests (PIF), (OJ C 240E, 28.8.2001, p. 125)[10] | Article 280(4) |

Proposal for a European Parliament and Council Directive on criminal measures aimed at ensuring the enforcement of intellectual property rights and for a Council framework decision to strengthen the criminal law framework to combat intellectual property offences (COM (2005) 276 final) | Article 95 |

[1] OJ L 29, 5.2.2003, p. 55.

[2] Proposal for a Directive of the European Parliament and of the Council on the protection of the environment through criminal law (COM (2001) 139 of 13 March 2001, OJ C 180 E, 26.6.2001, and amended proposal (COM (2002) 544)).

[3] Paragraph 47

[4] Paragraph 48

[5] Paragraph 51

[6] Paragraph 53

[7] In particular, by reference to the four levels of approximation of penalties habitually used following conclusions of the JHA Council meeting of 24 and 25 April 2002).

[8] Using this legal basis, the Commission had tabled a proposal for a Directive on the protection of the environment through criminal law (COM (2001) 139 of 13.3.2001, OJ C 180 E, 26.6.2001) and amended proposal (COM (2002) 544).

[9] For the record: Proposal for a Council Framework Decision on combating racism and xenophobia (COM proposal of 29.11.2001, OJ C 75 E, 23.6.2002, p. 269): the text of the proposed framework decision is in conformity with the distribution of powers between the pillars as set out in the Court judgment of 13 September 2005. If it was planned to introduce criminal penalties to combat discrimination, however, a Directive on the basis of Article 13 TEU would be necessary.

- Initiative of the Hellenic Republic with a view to adopting a Council Framework Decision concerning the prevention and control of trafficking in human organs and tissues (OJ C 100, 26.4.2003, p.27), currently stalled, and the initiative of the Federal Republic of Germany with a view to the adoption of a Council Framework Decision on criminal law protection against fraudulent or other unfair anti-competitive conduct in relation to the award of public contracts in the common market (OJ C 253, 4.9.2000, p 3).

[10] The situation here is different in that the conventions on the protection of the European Community's financial interests are not directly called into question as a result of the judgment. Nevertheless, none of these instruments (the convention and the three protocols) has been ratified by all 25 Member States.

**Judgment of the Court (Grand Chamber)
of 13 September 2005**

Commission of the European Communities v Council of the European Union. Action for annulment - Articles 29 EU, 31(e) EU, 34 EU and 47 EU - Framework Decision 2003/80/JHA - Protection of the environment - Criminal penalties - Community competence - Legal basis - Article 175 EC. Case C-176/03.

In Case C-176/03,

APPLICATION for annulment pursuant to Article 35 EU brought on 15 April 2003,

Commission of the European Communities, represented by M. Petite, J.F. Pasquier and W. Bogensberger, acting as Agents, with an address for service in Luxembourg,

applicant,

supported by:

European Parliament, represented by G. Garzon Clariana, H. Duintjer Tebbens and A. Baas, and M. Gomez-Leal, acting as Agents, with an address for service in Luxembourg,

intervener,

v

Council of the European Union, represented by J.C. Piris, J. Schutte and K. Michoel, acting as Agents, with an address for service in Luxembourg,

defendant,

supported by:

Kingdom of Denmark, represented by J. Molde, acting as Agent,

Federal Republic of Germany, represented by W.D. Plessing and A. Dittrich, acting as Agents,

Hellenic Republic, represented by E.M. Mamouna and M. Tassopoulou, acting as Agents, with an address for service in Luxembourg,

Kingdom of Spain, represented by N. Díaz Abad, acting as Agent, with an address for service in Luxembourg,

French Republic, represented by G. de Bergues, F. Alabrune and E. Puisais, acting as Agents,

Ireland, represented by D. O'Hagan, acting as Agent, and P. Gallagher, E. Fitzsimons SC and E. Regan BL, with an address for service in Luxembourg,

Kingdom of the Netherlands, represented by H.G. Sevenster and C. Wissels, acting as Agents,

Portuguese Republic, represented by L. Fernandes and A. Fraga Pires, acting as Agents,

Republic of Finland, represented by A. Guimaraes-Purokoski, acting as Agent, with an address for service in Luxembourg,

Kingdom of Sweden, represented by A. Kruse, K. Wistrand and A. Falk, acting as Agents,

United Kingdom of Great Britain and Northern Ireland, represented by C. Jackson, acting as Agent, and R. Plender QC,

interveners,

THE COURT (Grand Chamber),

composed of V. Skouris, President, P. Jann, C.W.A. Timmermans, A. Rosas, R. Silva de Lapuerta

and A. Borg Barthet, Presidents of Chambers, R. Schintgen (Rapporteur), N. Colneric, S. von Bahr, J. N. Cunha Rodrigues, G. Arestis, M. Ilei and J. Malenovsku, Judges,

Advocate General: D. Ruiz-Jarabo Colomer,

Registrar: K. Sztranc, Administrator,

having regard to the written procedure and further to the hearing on 5 April 2005,

after hearing the Opinion of the Advocate General at the sitting on 26 May 2005,

gives the following

Judgment

On those grounds, the Court (Grand Chamber) hereby:

1. Annuls Council Framework Decision 2003/80/JHA of 27 January 2003 on the protection of the environment through criminal law;
2. Orders the Council of the European Union to pay the costs;
3. Orders the Kingdom of Denmark, the Federal Republic of Germany, the Hellenic Republic, the Kingdom of Spain, the French Republic, Ireland, the Kingdom of the Netherlands, the Portuguese Republic, the Republic of Finland, the Kingdom of Sweden, the United Kingdom of Great Britain and Northern Ireland and the European Parliament to bear their own costs.

1. By its application the Commission of the European Communities is seeking annulment of Council Framework Decision 2003/80/JHA of 27 January 2003 on the protection of the environment through criminal law (OJ 2003 L 29, p. 55; the framework decision').

Legal framework and background

2. On 27 January 2003, on the initiative of the Kingdom of Denmark, the Council of the European Union adopted the framework decision.
3. Based on Title VI of the Treaty on European Union, in particular Articles 29 EU, 31(e) EU and 34(2)(b) EU, as worded prior to the entry into force of the Treaty of Nice, the framework decision constitutes, as is clear from the first three recitals in its preamble, the instrument by which the European Union intends to respond with concerted action to the disturbing increase in offences posing a threat to the environment.
4. The framework decision lays down a number of environmental offences, in respect of which the Member States are required to prescribe criminal penalties.
5. Thus, Article 2 of the framework decision, entitled 'Intentional offences', provides:

Each Member State shall take the necessary measures to establish as criminal offences under its domestic law

- (a) the discharge, emission or introduction of a quantity of substances or ionising radiation into air, soil or water which causes death or serious injury to any person;
- (b) the unlawful discharge, emission or introduction of a quantity of substances or ionising radiation into air, soil or water which causes or is likely to cause their lasting or substantial deterioration or death or serious injury to any person or substantial damage to protected monuments, other protected objects, property, animals or plants;
- (c) the unlawful disposal, treatment, storage, transport, export or import of waste, including hazardous waste, which causes or is likely to cause death or serious injury to any person or

substantial damage to the quality of air, soil, water, animals or plants;

- (d) the unlawful operation of a plant in which a dangerous activity is carried out and which, outside the plant, causes or is likely to cause death or serious injury to any person or substantial damage to the quality of air, soil, water, animals or plants;
- (e) the unlawful manufacture, treatment, storage, use, transport, export or import of nuclear materials or other hazardous radioactive substances which causes or is likely to cause death or serious injury to any person or substantial damage to the quality of air, soil, water, animals or plants;
- (f) the unlawful possession, taking, damaging, killing or trading of or in protected wild fauna and flora species or parts thereof, at least where they are threatened with extinction as defined under national law;
- (g) the unlawful trade in ozone-depleting substances,
when committed intentionally.'

6. Article 3 of the framework decision, entitled 'Negligent offences', provides:

Each Member State shall take the necessary measures to establish as criminal offences under its domestic law, when committed with negligence, or at least serious negligence, the offences enumerated in Article 2.'

7. Article 4 of the framework decision states that each Member State is to take the necessary measures to ensure that participating in or instigating the conduct referred to in Article 2 is punishable.

8. Article 5(1) of the framework decision provides that the penalties thus laid down must be effective, proportionate and dissuasive' including, at least in serious cases, penalties involving deprivation of liberty which can give rise to extradition'. Article 5(2) adds that the criminal penalties may be accompanied by other penalties or measures'.

9. Article 6 of the framework decision governs the liability, as the result of an act or omission, of legal persons and Article 7 sets out the sanctions to which they are to be subject, which include criminal or non-criminal fines and may include other sanctions'.

10. Finally, Article 8 of the framework decision concerns jurisdiction and Article 9 deals with prosecutions brought by a Member State which does not extradite its own nationals.

11. The Commission objected in the various Council bodies to the legal basis relied on by the Council to require the Member States to impose criminal penalties on persons committing environmental offences. In its submission, the correct legal basis in that respect was Article 175(1) EC and it had indeed put forward, on 15 March 2001, a proposal for a Directive of the European Parliament and of the Council on the protection of the environment through criminal law (OJ 2001 C 180 E, p. 238, the proposed directive'), based on Article 175 EC, the annex to which listed the Community law measures to which the offences set out in Article 3 of the proposal relate.

12. On 9 April 2002, the European Parliament expressed its view on both the proposed directive, at first reading, and on the draft framework decision.

13. It concurred with the Commission's view of the scope of the Community's competence, whilst calling on the Council (i) to use the framework decision as a measure complementing the directive that would take effect in relation to the protection of the environment through criminal law solely in respect of judicial cooperation and (ii) to refrain from adopting the framework decision before adoption of the proposed directive (see texts adopted by the Parliament on 9 April 2002 bearing references A50099/2002 (first reading) and A50080/2002).

14. The Council did not adopt the proposed directive, but the fifth and seventh recitals to the framework decision are worded as follows:

- (5) The Council considered it appropriate to incorporate into the present Framework decision a number of substantive provisions contained in the proposed Directive, in particular those defining the conduct which Member States have to establish as criminal offences under their domestic law.

...

- (7) The Council has considered this proposal but has come to the conclusion that the majority required for its adoption by the Council cannot be obtained. The said majority considered that the proposal went beyond the powers attributed to the Community by the Treaty establishing the European Community and that the objectives could be reached by adopting a Framework-Decision on the basis of Title VI of the Treaty on European Union. The Council also considered that the present Framework Decision, based on Article 34 of the Treaty on European Union, is a correct instrument to impose on the member States the obligation to provide for criminal sanctions. The amended proposal submitted by the Commission was not of a nature to allow the Council to change its position in this respect.'

15. The Commission appended the following statement to the minutes of the Council meeting at which the framework decision was adopted:

The Commission takes the view that the Framework Decision is not the appropriate legal instrument by which to require Member States to introduce sanctions of a criminal nature at national level in the case of offences detrimental to the environment.

As the Commission pointed out on several occasions within Council bodies, it considers that in the context of the competences conferred on it for the purpose of attaining the objectives stated in Article 2 of the Treaty establishing the European Community, the Community is competent to require the Member States to impose sanctions at national level - including criminal sanctions if appropriate - where that proves necessary in order to attain a Community objective.

This is the case for environmental matters which are the subject of Title XIX of the Treaty establishing the European Community.

Furthermore, the Commission points out that its proposal for a Directive on the protection of the environment through criminal law has not been appropriately examined under the codecision procedure.

If the Council adopts the Framework Decision despite this Community competence, the Commission reserves all the rights conferred on it by the Treaty.'

The action

16. By order of the President of the Court of 29 September 2003, the Kingdom of Denmark, the Federal Republic of Germany, the Hellenic Republic, the Kingdom of Spain, the French Republic, Ireland, the Kingdom of the Netherlands, the Portuguese Republic, the Republic of Finland, the Kingdom of Sweden and the United Kingdom of Great Britain and Northern Ireland, on the one hand, and the Parliament, on the other, were granted leave to intervene in support of the form of order sought by the Council and the Commission respectively.

17. By order of 17 March 2004, the President of the Court dismissed the application brought by the European Economic and Social Committee for leave to intervene in support of the form of order sought by the Commission.

Arguments of the parties

18. The Commission challenges the Council's choice of Article 34 EU, in conjunction with Articles 29 EU and 31(e) EU, as the legal basis for Articles 1 to 7 of the framework decision. It submits that the purpose and content of the latter are within the scope of the Community's powers on the environment, as they are stated in Article 3(1) EC and Articles 174 to 176 EC.

19. Although it does not claim that the Community legislature has a general competence in criminal matters, the Commission submits that the legislature is competent, under Article 175 EC, to require the Member States to prescribe criminal penalties for infringements of Community environmental protection legislation if it takes the view that that is a necessary means of ensuring that the legislation is effective. The harmonisation of national criminal laws, in particular of the constituent elements of environmental offences to which criminal penalties attach, is designed to be an aid to the Community policy in question.

20. The Commission recognises that there is no precedent in this area. It relies, however, in support of its argument, on the case-law of the Court concerning the duty of loyal cooperation and the principles of effectiveness and equivalence (see, *inter alia*, Case 50/76 *Amsterdam Bulb* [1977] ECR 137, paragraph 33, Case C186/98 *Nunes and de Matos* [1999] ECR I4883, paragraphs 12 and 14, and the order of 13 July 1990 in Case C2/88 *IMM Zwartveld and Others* [1990] ECR I3365, paragraph 17).

21. Likewise, a number of regulations adopted in the sphere of fisheries and transport policy either require the Member States to bring criminal proceedings or impose restrictions on the types of penalties which those States may impose. The Commission refers, in particular, to two Community measures which require the Member States to introduce penalties which are necessarily criminal in nature, although that qualification has not been expressly employed (see Article 14 of Council Directive 91/308/EEC of 10 June 1991 on prevention of the use of the financial system for the purpose of money laundering (OJ 1991 L 166, p. 77) and Articles 1 to 3 of Council Directive 2002/90/EC of 28 November 2002 defining the facilitation of unauthorised entry, transit and residence (OJ 2002 L 328, p. 17)).

22. In addition, the Commission submits that the framework decision must in any event be annulled in part on the ground that Articles 5(2), 6 and 7 thereof leave the Member States free to prescribe penalties other than criminal penalties, even to choose between criminal and other penalties, which undeniably falls within the Community's competence.

23. However, the Commission does not maintain that the framework decision as a whole should have been the subject-matter of a directive. In particular, it does not dispute that Title VI of the Treaty on European Union is the appropriate legal basis for the provisions of the decision which deal with jurisdiction, extradition and prosecutions of persons who have committed offences. However, given that those provisions are incapable of existing independently, it must apply for annulment of the framework decision in its entirety.

24. The Commission also puts forward a ground of challenge alleging abuse of process. In that regard, it relies on the fifth and seventh recitals in the preamble to the framework decision, which show that the choice of an instrument under Title VI of the Treaty was based on considerations of expediency, since the proposed directive had failed to obtain the majority required for its adoption because a majority of Member States had refused to recognise that the Community had the necessary powers to require the Member States to prescribe criminal penalties for environmental offences.

25. The Parliament concurs with the Commission's arguments. It submits, more specifically, that the Council confused the Community's power to adopt the proposed directive and the power, not claimed by the Community, to adopt the framework decision in its entirety. The matters upon which the Council relies in support of its argument are, in reality, considerations of expediency concerning the choice

of whether or not to impose solely criminal penalties, considerations which should have been dealt with in the legislative procedure on the basis of Articles 175 EC and 251 EC.

26. The Council and the Member States which have intervened in these proceedings, with the exception of the Kingdom of the Netherlands, submit that, as the law currently stands, the Community does not have power to require the Member States to impose criminal penalties in respect of the conduct covered by the framework decision.

27. Not only is there no express conferral of power in that regard, but, given the considerable significance of criminal law for the sovereignty of the Member States, there are no grounds for accepting that this power can have been implicitly transferred to the Community at the time when specific substantive competences, such as those exercised under Article 175 EC, were conferred on it.

28. Articles 135 EC and 280 EC, which expressly reserve to the Member States the application of national criminal law and the administration of justice, confirm that interpretation.

29. That interpretation is also borne out by the fact that the Treaty on European Union devotes a specific title to judicial cooperation in criminal matters (see Articles 29 EU, 30 EU and 31(e) EU), which expressly confers on the European Union competence in criminal matters, in particular as regards the determination of the constituent elements of the relevant offences and penalties. The Commission's position is therefore contradictory, since it amounts, on the one hand, to claiming that the authors of the Treaty on European Union and the EC Treaty intended to confer by implication on the Community competence in criminal matters and, on the other, to disregarding the fact that the same authors expressly attributed such a competence to the European Union.

30. None of the judgments or secondary legislation to which the Commission refers lends support to its argument.

31. First, the Court has never obliged the Member States to adopt criminal penalties. According to its case-law, it is certainly the responsibility of the Member States to ensure that infringements of Community law are penalised under conditions, both procedural and substantive, which are analogous to those applicable to infringements of national law of a similar nature and importance, and the penalty must, moreover, be effective, dissuasive and proportionate to the infringement; furthermore, the national authorities must proceed with respect to infringements of Community law with the same diligence as that which they bring to bear in implementing corresponding national laws (see, in particular, Case 68/88 *Commission v Greece* [1989] ECR 2965, paragraphs 24 and 25). However, the Court has not held, either expressly or by implication, that the Community is competent to harmonise the criminal laws applicable in the Member States. It has rather held that the choice of penalties is a matter for the Member States.

32. Second, legislative practice is in keeping with that interpretation. The various pieces of secondary legislation restate the traditional form of words, by virtue of which effective, proportionate and dissuasive sanctions' are to be prescribed (see, for example, Article 3 of Directive 2002/90), but do not call into question the freedom of the Member States to choose between proceeding under administrative or criminal law. On the rare occasions when the Community legislature has specified that the Member States are to bring criminal or administrative proceedings, it has merely stated expressly the choice which was open to them in any event.

33. Furthermore, whenever the Commission has proposed to the Council that a Community measure having implications for criminal matters be adopted, the Council has detached the criminal part of that measure so that it may be dealt with in a framework decision (see Council Regulation (EC) No 974/98 of 3 May 1998 on the introduction of the euro (OJ 1998 L 139, p. 1), which had to be supplemented by Council Framework Decision 2000/383/JHA of 29 May 2000 on increasing protection

by criminal penalties and other sanctions against counterfeiting in connection with the introduction of the euro (OJ 2000 L 140, p. 1); see also Directive 2002/90, supplemented by Council Framework Decision 2002/946/JHA of 28 November 2002 on the strengthening of the penal framework to prevent the facilitation of unauthorised entry, transit and residence (OJ 2002 L 328, p. 1)).

34. In this instance, regard being had to both its purpose and content, the framework decision concerns the harmonisation of criminal law. The mere fact that it seeks to combat environmental offences is not such as to found the Community's competence. In fact, the framework decision supplements Community law on environmental protection.

35. In addition, the Council contends that the plea alleging abuse of process is based on an incorrect reading of the preamble to the framework decision.

36. The Kingdom of the Netherlands, whilst supporting the form of order sought by the Council, adopts a slightly more qualified argument than the Council. It contends that, in exercising the powers conferred on it by the EC Treaty, the Community may require the Member States to provide for the possibility of punishing certain conduct under national criminal law, provided that the penalty is inseparably linked to the relevant substantive Community provisions and that it can actually be shown that imposing penalties under criminal law in that way is necessary for the achievement of the objectives of the Treaty in the area concerned (see Case C240/90 *Germany v Commission* [1992] ECR I5383). That could be the case if the enforcement of a harmonising rule based, for example, on Article 175 EC gave rise to a need for criminal penalties.

37. Conversely, if it is apparent from the content and nature of the proposed measure that it is intended essentially to bring about a general harmonisation of criminal laws and that the system of penalties is not inseparably linked to the area of Community law concerned, Articles 29 EU, 31(e) EU and 34(2)(b) EU are the correct legal basis for the measure. That is the case in this instance. It is clear from the purpose and content of the framework decision that it is intended, generally, to secure harmonisation of criminal laws in the Member States. The fact that rules adopted under the EC Treaty may be concerned is not decisive.

Findings of the Court

38. Article 47 EU provides that nothing in the Treaty on European Union is to affect the EC Treaty. That requirement is also found in the first paragraph of Article 29 EU, which introduces Title VI of the Treaty on European Union.

39. It is the task of the Court to ensure that acts which, according to the Council, fall within the scope of Title VI of the Treaty on European Union do not encroach upon the powers conferred by the EC Treaty on the Community (see Case C170/96 *Commission v Council* [1998] ECR I-2763, paragraph 16).

40. It is therefore necessary to ascertain whether Articles 1 to 7 of the framework decision affect the powers of the Community under Article 175 EC inasmuch as those articles could, as the Commission maintains, have been adopted on the basis of the last-mentioned provision.

41. On that point, it is common ground that protection of the environment constitutes one of the essential objectives of the Community (see Case 240/83 *ADBHU* [1985] ECR 531, paragraph 13, Case 302/86 *Commission v Denmark* [1988] ECR 4607, paragraph 8, Case C213/96 *Outokumpu* [1998] ECR I1777, paragraph 32). In that regard, Article 2 EC states that the Community has as its task to promote a high level of protection and improvement of the quality of the environment' and, to that end, Article 3(1)(l) EC provides for the establishment of a policy in the sphere of the environment'.

42. Furthermore, in the words of Article 6 EC [e]nvironmental protection requirements must be

integrated into the definition and implementation of the Community policies and activities', a provision which emphasises the fundamental nature of that objective and its extension across the range of those policies and activities.

43. Articles 174 EC to 176 EC comprise, as a general rule, the framework within which Community environmental policy must be carried out. In particular, Article 174(1) EC lists the objectives of the Community's action on the environment and Article 175 EC sets out the procedures to be followed in order to achieve those objectives. The Community's powers are, in general, exercised in accordance with the procedure laid down in Article 251 EC, following consultation of the Economic and Social Committee and the Committee of the Regions. However, in relation to certain spheres referred to in Article 175(2) EC, the Council takes decisions alone, acting unanimously on a proposal from the Commission after consulting the Parliament and the two abovementioned bodies.

44. As the Court has previously held, the measures referred to in the three indents of the first subparagraph of Article 175(2) EC all imply the involvement of the Community institutions in areas such as fiscal policy, energy policy or town and country planning policy, in which, apart from Community policy on the environment, either the Community has no legislative powers or unanimity within the Council is required (Case C36/98 *Spain v Council* [2001] ECR I779, paragraph 54).

45. Moreover, it must be borne in mind that, according to the Court's settled case-law, the choice of the legal basis for a Community measure must rest on objective factors which are amenable to judicial review, including in particular the aim and the content of the measure (see, *inter alia*, Case C-300/89 *Commission v Council* [1991] ECR I-2867, *Titanium dioxide*, paragraph 10, and Case C336/00 *Huber* [2002] ECR I7699, paragraph 30).

46. As regards the aim of the framework decision, it is clear both from its title and from its first three recitals that its objective is the protection of the environment. The Council was concerned at the rise in environmental offences and their effects which are increasingly extending beyond the borders of the States in which the offences are committed', and, having found that those offences constitute a threat to the environment' and a problem jointly faced by the Member States', concluded that a tough response' and concerted action to protect the environment under criminal law' were called for.

47. As to the content of the framework decision, Article 2 establishes a list of particularly serious environmental offences, in respect of which the Member States must impose criminal penalties. Articles 2 to 7 of the decision do indeed entail partial harmonisation of the criminal laws of the Member States, in particular as regards the constituent elements of various criminal offences committed to the detriment of the environment. As a general rule, neither criminal law nor the rules of criminal procedure fall within the Community's competence (see, to that effect, Case 203/80 *Casati* [1981] ECR 2595, paragraph 27, and Case C226/97 *Lemmens* [1998] ECR I3711, paragraph 19).

48. However, the last-mentioned finding does not prevent the Community legislature, when the application of effective, proportionate and dissuasive criminal penalties by the competent national authorities is an essential measure for combating serious environmental offences, from taking measures which relate to the criminal law of the Member States which it considers necessary in order to ensure that the rules which it lays down on environmental protection are fully effective.

49. It should also be added that in this instance, although Articles 1 to 7 of the framework decision determine that certain conduct which is particularly detrimental to the environment is to be criminal, they leave to the Member States the choice of the criminal penalties to apply, although, in accordance with Article 5(1) of the decision, the penalties must be effective, proportionate and dissuasive.

50. The Council does not dispute that the acts listed in Article 2 of the framework decision

include infringements of a considerable number of Community measures, which were listed in the annex to the proposed directive. Moreover, it is apparent from the first three recitals to the framework decision that the Council took the view that criminal penalties were essential for combating serious offences against the environment.

51. It follows from the foregoing that, on account of both their aim and their content, Articles 1 to 7 of the framework decision have as their main purpose the protection of the environment and they could have been properly adopted on the basis of Article 175 EC.

52. That finding is not called into question by the fact that Articles 135 EC and 280(4) EC reserve to the Member States, in the spheres of customs cooperation and the protection of the Community's financial interests respectively, the application of national criminal law and the administration of justice. It is not possible to infer from those provisions that, for the purposes of the implementation of environmental policy, any harmonisation of criminal law, even as limited as that resulting from the framework decision, must be ruled out even where it is necessary in order to ensure the effectiveness of Community law.

53. In those circumstances, the entire framework decision, being indivisible, infringes Article 47 EU as it encroaches on the powers which Article 175 EC confers on the Community.

54. There is therefore no need to examine the Commission's argument that the framework decision should in any event be annulled in part in so far as Articles 5(2), 6 and 7 leave the Member States free also to provide for penalties other than criminal penalties, even to choose between criminal penalties and other penalties, matters allegedly falling undeniably within the Community's competence.

55. In the light of all the foregoing, the framework decision must be annulled.

Costs

56. Under Article 69(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the Commission has applied for costs and the Council has been unsuccessful, the Council must be ordered to pay the costs. Pursuant to the first paragraph of Article 69(4), the interveners in these proceedings must bear their own costs.

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PROCEDU Application for annulment - successful
ADVGEN Ruiz-Jarabo Colomer
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**Council Resolution
of 13 March 2006
on a customs response to latest trends in counterfeiting and piracy**

Council Resolution

of 13 March 2006

on a customs response to latest trends in counterfeiting and piracy

(2006/C 67/01)

THE COUNCIL OF THE EUROPEAN UNION,

1. RECALLING the objectives set by the Lisbon Strategy, as relaunched by the European Council of 22 and 23 March 2005, for the Union "to renew the basis of its competitiveness, increase its growth potential and its productivity and strengthen social cohesion, placing the main emphasis on knowledge, innovation and the optimisation of human capital";

2. UNDERLINING that the strategic objective set by the European Council can only be achieved through a well-functioning internal market with adequate measures to encourage investment in the knowledge-based economy;

3. RECOGNISES the threat posed by the serious growth in counterfeiting and piracy to the Union's knowledge-based economy and in particular to health and safety, as well as the key responsibility of customs in protecting the economy and consumers from this threat;

4. EMPHASIZES that efficient and uniform customs controls to protect legitimate business from unfair competition and knowledge theft are essential to protect Community interests and to counter the risk of distortion of competition. With customs being responsible for the large majority of fake goods seized and having seen customs seizures in the EU increase in the last five years by more than 1000 %, further practical improvements in customs controls will strengthen the protection offered to the economy and consumers;

5. STRESSES the need to ensure that customs controls and co-operation measures provide maximum protection to the economy and consumers from this dangerous traffic and RECOGNISES that this represents a major challenge which requires improved customs techniques. Meeting this challenge represents, at the same time, a valuable contribution toward promoting fair trade, safeguarding Community and national revenues, protecting consumers and combating organised crime and money laundering;

6. WELCOMES the Commission Communication on a customs response to counterfeiting and piracy [1] (hereinafter the Communication), in particular

- the concrete actions to improve customs controls, in particular via the increased exchange of risk management techniques and information, and to strengthen international co-operation, notably with main exporting countries and relevant international organisations;

- the need to build and promote a strong customs-business partnership, based on commitment from both sides, in tackling the problem of counterfeit and pirated goods;

- the approach taken to tackling the growing problem of fake goods, in particular those which pose a health and safety risk, via a comprehensive EU Action Plan building on the Communication's concrete actions;

7. INVITES the Commission to

- present appropriate proposals to support the implementation of the approach set out in the Communication, paying special attention to enhancing the information exchange both between customs and between customs and operators involved in combating counterfeiting and piracy;

- to report on the implementation of the Communication and the actions set out therein as part of the annual report foreseen in Article 23 of Council Regulation (EC) No 1383/2003 [2];

8. INVITES the Commission and the Member States, within their respective competencies, to implement the comprehensive approach set out in the Communication thereby further improving customs controls and co-operation in order to combat the growing menace of counterfeiting and piracy.

[1] COM(2005) 479 final.

[2] Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights, OJ L 196, 2.8.2003, p. 7.

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**Council Regulation (EC) No 1383/2003
of 22 July 2003**

**concerning customs action against goods suspected of infringing certain intellectual property rights
and the measures to be taken against goods found to have infringed such rights**

Council Regulation (EC) No 1383/2003

of 22 July 2003

concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 133 thereof,

Having regard to the proposal from the Commission,

Whereas:

- (1) To improve the working of the system concerning the entry into the Community and the export and re-export from the Community of goods infringing certain intellectual property rights introduced by Council Regulation (EC) No 3295/94 of 22 December 1994 laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods(1), conclusions should be drawn from experience of its application. In the interests of clarity, Regulation (EC) No 3295/94 should be repealed and replaced.
- (2) The marketing of counterfeit and pirated goods, and indeed all goods infringing intellectual property rights, does considerable damage to law-abiding manufacturers and traders and to right-holders, as well as deceiving and in some cases endangering the health and safety of consumers. Such goods should, in so far as is possible, be kept off the market and measures adopted to deal effectively with this unlawful activity without impeding the freedom of legitimate trade. This objective is consistent with efforts under way at international level.
- (3) In cases where counterfeit goods, pirated goods and, more generally, goods infringing an intellectual property right originate in or come from third countries, their introduction into the Community customs territory, including their transshipment, release for free circulation in the Community, placing under a suspensive procedure and placing in a free zone or warehouse, should be prohibited and a procedure set up to enable the customs authorities to enforce this prohibition as effectively as possible.
- (4) Customs authorities should also be able to take action against counterfeit goods, pirated goods and goods infringing certain intellectual property rights which are in the process of being exported, re-exported or leaving the Community customs territory.
- (5) Action by the customs authorities should involve, for the period necessary to determine whether suspect goods are indeed counterfeit goods, pirated goods or goods infringing certain intellectual property rights, suspending release for free circulation, export and re-export or, in the case of goods placed under a suspensive procedure, placed in a free zone or a free warehouse, in the process of being re-exported with notification, introduced into the customs territory or leaving that territory, detaining those goods.
- (6) The particulars of the application for action, such as its period of validity and form, need to be defined and harmonised in all Member States. The same applies to the conditions governing the acceptance of applications by the customs authorities and the service designated to receive, process and register them.

- (7) Even where no application has yet been lodged or approved, the Member States should be authorised to detain the goods for a certain period to allow right-holders to lodge an application for action with the customs authorities.
- (8) Proceedings initiated to determine whether an intellectual property right has been infringed under national law will be conducted with reference to the criteria used to establish whether goods produced in that Member State infringe intellectual property rights. This Regulation does not affect the Member States' provisions on the competence of the courts or judicial procedures.
- (9) To make the Regulation easier to apply for customs administrations and right-holders alike, provision should also be made for a more flexible procedure allowing goods infringing certain intellectual property rights to be destroyed without there being any obligation to initiate proceedings to establish whether an intellectual property right has been infringed under national law.
- (10) It is necessary to lay down the measures applicable to goods which have been found to be counterfeit, pirated or generally to infringe certain intellectual property rights. Those measures should not only deprive those responsible for trading in such goods of the economic benefits of the transaction and penalise them but should also constitute an effective deterrent to further transactions of the same kind.
- (11) To avoid disrupting the clearance of goods carried in travellers' personal baggage, it is appropriate, except where certain material indications suggest commercial traffic is involved, to exclude from the scope of this Regulation goods that may be counterfeit, pirated or infringe certain intellectual property rights when imported from third countries within the limits of the duty-free allowance accorded by Community rules.
- (12) In the interests of this Regulation's effectiveness, it is important to ensure the uniform application of the common rules it lays down and to reinforce mutual assistance between the Member States and between the Member States and the Commission, in particular by recourse to Council Regulation (EC) No 515/97 of 13 March 1997 on mutual assistance between the administrative authorities of the Member States and cooperation between the latter and the Commission to ensure the correct application of the law on customs and agricultural matters(2).
- (13) In the light of the experience gained in the implementation of this Regulation, inter alia, consideration should be given to the possibility of increasing the number of intellectual property rights covered.
- (14) The measures necessary for the implementation of this Regulation should be adopted in accordance with Council Decision 1999/468/EC of 28 June 1999 laying down the procedures for the exercise of implementing powers conferred on the Commission(3).
- (15) Regulation (EC) No 3295/94 should be repealed,

HAS ADOPTED THIS REGULATION:

CHAPTER I SUBJECT MATTER AND SCOPE

Article 1

1. This Regulation sets out the conditions for action by the customs authorities when goods are suspected of infringing an intellectual property right in the following situations:

- (a) when they are entered for release for free circulation, export or re-export in accordance with Article 61 of Council Regulation (EC) No 2913/92 of 12 October 1992 establishing the Community

Customs Code(4);

- (b) when they are found during checks on goods entering or leaving the Community customs territory in accordance with Articles 37 and 183 of Regulation (EEC) No 2913/92, placed under a suspensive procedure within the meaning of Article 84(1)(a) of that Regulation, in the process of being re-exported subject to notification under Article 182(2) of that Regulation or placed in a free zone or free warehouse within the meaning of Article 166 of that Regulation.

2. This Regulation also fixes the measures to be taken by the competent authorities when the goods referred to in paragraph 1 are found to infringe intellectual property rights.

Article 2

1. For the purposes of this Regulation, "goods infringing an intellectual property right" means:

(a) "counterfeit goods", namely:

- (i) goods, including packaging, bearing without authorisation a trademark identical to the trademark validly registered in respect of the same type of goods, or which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the trademark-holder's rights under Community law, as provided for by Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trademark(5) or the law of the Member State in which the application for action by the customs authorities is made;
- (ii) any trademark symbol (including a logo, label, sticker, brochure, instructions for use or guarantee document bearing such a symbol), even if presented separately, on the same conditions as the goods referred to in point (i);
- (iii) packaging materials bearing the trademarks of counterfeit goods, presented separately, on the same conditions as the goods referred to in point (i);

(b) "pirated goods", namely goods which are or contain copies made without the consent of the holder of a copyright or related right or design right, regardless of whether it is registered in national law, or of a person authorised by the right-holder in the country of production in cases where the making of those copies would constitute an infringement of that right under Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs(6) or the law of the Member State in which the application for customs action is made;

(c) goods which, in the Member State in which the application for customs action is made, infringe:

- (i) a patent under that Member State's law;
- (ii) a supplementary protection certificate of the kind provided for in Council Regulation (EEC) No 1768/92(7) or Regulation (EC) No 1610/96 of the European Parliament and of the Council(8);
- (iii) a national plant variety right under the law of that Member State or a Community plant variety right of the kind provided for in Council Regulation (EC) No 2100/94(9);
- (iv) designations of origin or geographical indications under the law of that Member State or Council Regulations (EEC) No 2081/92(10) and (EC) No 1493/1999(11);
- (v) geographical designations of the kind provided for in Council Regulation (EEC) No 1576/89(12).

2. For the purposes of this Regulation, "right-holder" means:

(a) the holder of a trademark, copyright or related right, design right, patent, supplementary protection

certificate, plant variety right, protected designation of origin, protected geographical indication and, more generally, any right referred to in paragraph 1; or

(b) any other person authorised to use any of the intellectual property rights mentioned in point (a), or a representative of the right-holder or authorised user.

3. Any mould or matrix which is specifically designed or adapted for the manufacture of goods infringing an intellectual property right shall be treated as goods of that kind if the use of such moulds or matrices infringes the right-holder's rights under Community law or the law of the Member State in which the application for action by the customs authorities is made.

Article 3

1. This Regulation shall not apply to goods bearing a trademark with the consent of the holder of that trademark or to goods bearing a protected designation of origin or a protected geographical indication or which are protected by a patent or a supplementary protection certificate, by a copyright or related right or by a design right or a plant variety right and which have been manufactured with the consent of the right-holder but are placed in one of the situations referred to in Article 1(1) without the latter's consent.

It shall similarly not apply to goods referred to in the first subparagraph and which have been manufactured or are protected by another intellectual property right referred to in Article 2(1) under conditions other than those agreed with the right-holder.

2. Where a traveller's personal baggage contains goods of a non-commercial nature within the limits of the duty-free allowance and there are no material indications to suggest the goods are part of commercial traffic, Member States shall consider such goods to be outside the scope of this Regulation.

CHAPTER II APPLICATIONS FOR ACTION BY THE CUSTOMS AUTHORITIES

Section 1 Measures prior to an application for action by the customs authorities

Article 4

1. Where the customs authorities, in the course of action in one of the situations referred to in Article 1(1) and before an application has been lodged by a right-holder or granted, have sufficient grounds for suspecting that goods infringe an intellectual property right, they may suspend the release of the goods or detain them for a period of three working days from the moment of receipt of the notification by the right-holder and by the declarant or holder of the goods, if the latter are known, in order to enable the right-holder to submit an application for action in accordance with Article 5.

2. In accordance with the rules in force in the Member State concerned, the customs authorities may, without divulging any information other than the actual or supposed number of items and their nature and before informing the right-holder of the possible infringement, ask the right-holder to provide them with any information they may need to confirm their suspicions.

Section 2 The lodging and processing of applications for customs action

Article 5

1. In each Member State a right-holder may apply in writing to the competent customs department for action by the customs authorities when goods are found in one of the situations referred to in Article 1(1) (application for action).

2. Each Member State shall designate the customs department competent to receive and process applications for action.

3. Where electronic data interchange systems exist, the Member States shall encourage right-holders to lodge applications electronically.

4. Where the applicant is the right-holder of a Community trademark or a Community design right, a Community plant variety right or a designation of origin or geographical indication or a geographical designation protected by the Community, an application may, in addition to requesting action by the customs authorities of the Member State in which it is lodged, request action by the customs authorities of one or more other Member States.

5. The application for action shall be made out on a form established in accordance with the procedure referred to in Article 21(2); it must contain all the information needed to enable the goods in question to be readily recognised by the customs authorities, and in particular:

- (i) an accurate and detailed technical description of the goods;
- (ii) any specific information the right-holder may have concerning the type or pattern of fraud;
- (iii) the name and address of the contact person appointed by the right-holder.

The application for action must also contain the declaration required of the applicant by Article 6 and proof that the applicant holds the right for the goods in question.

In the situation described in paragraph 4 the application for action shall indicate the Member State or States in which customs action is requested as well as the names and addresses of the right-holder in each of the Member States concerned.

By way of indication and where known, right-holders should also forward any other information they may have, such as:

- (a) the pre-tax value of the original goods on the legitimate market in the country in which the application for action is lodged;
- (b) the location of the goods or their intended destination;
- (c) particulars identifying the consignment or packages;
- (d) the scheduled arrival or departure date of the goods;
- (e) the means of transport used;
- (f) the identity of the importer, exporter or holder of the goods;
- (g) the country or countries of production and the routes used by traffickers;
- (h) the technical differences, if known, between the authentic and suspect goods.

6. Details may also be required which are specific to the type of intellectual property right referred to in the application for action.

7. On receiving an application for action, the competent customs department shall process that

application and notify the applicant in writing of its decision within 30 working days of its receipt.

The right-holder shall not be charged a fee to cover the administrative costs occasioned by the processing of the application.

8. Where the application does not contain the mandatory information listed in paragraph 5, the competent customs department may decide not to process the application for action; in that event it shall provide reasons for its decision and include information on the appeal procedure. The application can only be re-submitted when duly completed.

Article 6

1. Applications for action shall be accompanied by a declaration from the right-holder, which may be submitted either in writing or electronically, in accordance with national legislation, accepting liability towards the persons involved in a situation referred to in Article 1(1) in the event that a procedure initiated pursuant to Article 9(1) is discontinued owing to an act or omission by the right-holder or in the event that the goods in question are subsequently found not to infringe an intellectual property right.

In that declaration the right-holder shall also agree to bear all costs incurred under this Regulation in keeping goods under customs control pursuant to Article 9 and, where applicable, Article 11.

2. Where an application is submitted under Article 5(4), the right-holder shall agree in the declaration to provide and pay for any translation necessary; this declaration shall be valid in every Member State in which the decision granting the application applies.

Article 7

Articles 5 and 6 shall apply *mutatis mutandis* to requests for an extension.

Section 3 Acceptance of the application for action

Article 8

1. When granting an application for action, the competent customs department shall specify the period during which the customs authorities are to take action. That period shall not exceed one year. On expiry of the period in question, and subject to the prior discharge of any debt owed by the right-holder under this Regulation, the department which took the initial decision may, at the right-holder's request, extend that period.

The right-holder shall notify the competent customs department referred to in Article 5(2), if his right ceases to be validly registered or expires.

2. The decision granting the right-holder's application for action shall immediately be forwarded to those customs offices of the Member State or States likely to be concerned by the goods alleged in the application to infringe an intellectual property right.

When an application for action submitted in accordance with Article 5(4) is granted, the period during which the customs authorities are to take action shall be set at one year; on expiry of the

period in question, the department which processed the initial application shall, on the right-holder's written application, extend that period. The first indent of Article 250 of Regulation (EEC) No 2913/92 shall apply *mutatis mutandis* to the decision granting that application and to decisions extending or repealing it.

Where an application for action is granted, it is for the applicant to forward that decision, with any other information and any translations that may be necessary, to the competent customs department of the Member State or States in which the applicant has requested customs action. However, with the applicant's consent, the decision may be forwarded directly by the customs department which has taken the decision.

At the request of the customs authorities of the Member States concerned, the applicant shall provide any additional information necessary for the implementation of the decision.

3. The period referred to in the second subparagraph of paragraph 2 shall run from the date of adoption of the decision granting the application. The decision will not enter into force in the recipient Member State or States until it has been forwarded in accordance with the third subparagraph of paragraph 2 and the right-holder has fulfilled the formalities referred to in Article 6.

The decision shall then be sent immediately to the national customs offices likely to have to deal with the goods suspected of infringing intellectual property rights.

This paragraph shall apply *mutatis mutandis* to a decision extending the initial decision.

CHAPTER III CONDITIONS GOVERNING ACTION BY THE CUSTOMS AUTHORITIES AND BY THE AUTHORITY COMPETENT TO DECIDE ON THE CASE

Article 9

1. Where a customs office to which the decision granting an application by the right-holder has been forwarded pursuant to Article 8 is satisfied, after consulting the applicant where necessary, that goods in one of the situations referred to in Article 1(1) are suspected of infringing an intellectual property right covered by that decision, it shall suspend release of the goods or detain them.

The customs office shall immediately inform the competent customs department which processed the application.

2. The competent customs department or customs office referred to in paragraph 1 shall inform the right-holder and the declarant or holder of the goods within the meaning of Article 38 of Regulation (EEC) No 2913/92 of its action and is authorised to inform them of the actual or estimated quantity and the actual or supposed nature of the goods whose release has been suspended or which have been detained, without being bound by the communication of that information to notify the authority competent to take a substantive decision.

3. With a view to establishing whether an intellectual property right has been infringed under national law, and in accordance with national provisions on the protection of personal data, commercial and industrial secrecy and professional and administrative confidentiality, the customs office or department which processed the application shall inform the right-holder, at his request and if known, of the names and addresses of the consignee, the consignor, the declarant or the holder of the goods and the origin and provenance of goods suspected of infringing an intellectual property right.

The customs office shall give the applicant and the persons involved in any of the situations referred to in Article 1(1) the opportunity to inspect goods whose release has been suspended or which have been detained.

When examining goods, the customs office may take samples and, according to the rules in force in the Member State concerned, hand them over or send them to the right-holder, at his express request, strictly for the purposes of analysis and to facilitate the subsequent procedure. Where circumstances allow, subject to the requirements of Article 11(1) second indent where applicable, samples must be returned on completion of the technical analysis and, where applicable, before goods are released or their detention is ended. Any analysis of these samples shall be carried out under the sole responsibility of the right-holder.

Article 10

The law in force in the Member State within the territory of which the goods are placed in one of the situations referred to in Article 1(1) shall apply when deciding whether an intellectual property right has been infringed under national law.

That law shall also apply to the immediate notification of the customs department or office referred to in Article 9(1) that the procedure provided for in Article 13 has been initiated, unless the procedure was initiated by that department or office.

Article 11

1. Where customs authorities have detained or suspended the release of goods which are suspected of infringing an intellectual property right in one of the situations covered by Article 1(1), the Member States may provide, in accordance with their national legislation, for a simplified procedure, to be used with the right-holder's agreement, which enables customs authorities to have such goods abandoned for destruction under customs control, without there being any need to determine whether an intellectual property right has been infringed under national law. To this end, Member States shall, in accordance with their national legislation, apply the following conditions:

- that the right-holder inform the customs authorities in writing within 10 working days, or three working days in the case of perishable goods, of receipt of the notification provided for in Article 9, that the goods concerned by the procedure infringe an intellectual property right referred to in Article 2(1) and provide those authorities with the written agreement of the declarant, the holder or the owner of the goods to abandon the goods for destruction. With the agreement of the customs authorities, this information may be provided directly to customs by the declarant, the holder or the owner of the goods. This agreement shall be presumed to be accepted when the declarant, the holder or the owner of the goods has not specifically opposed destruction within the prescribed period. This period may be extended by a further ten working days where circumstances warrant it;
- that destruction be carried out, unless otherwise specified in national legislation, at the expense and under the responsibility of the right-holder, and be systematically preceded by the taking of samples for keeping by the customs authorities in such conditions that they constitute evidence admissible in legal proceedings in the Member State in which they might be needed.

2. In all other cases, for example where the declarant, holder or owner objects to or contests the destruction of the goods, the procedure laid down in Article 13 shall apply.

Article 12

A right-holder receiving the particulars cited in the first subparagraph of Article 9(3) shall use that information only for the purposes specified in Articles 10, 11 and 13(1).

Any other use, not permitted by the national legislation of the Member State where the situation arose, may, on the basis of the law of the Member State in which the goods in question are located, cause the right-holder to incur civil liability and lead to the suspension of the application for action, for the period of validity remaining before renewal, in the Member State in which the events have taken place.

In the event of a further breach of this rule, the competent customs department may refuse to renew the application. In the case of an application of the kind provided for in Article 5(4), it must also notify the other Member States indicated on the form.

Article 13

1. If, within 10 working days of receipt of the notification of suspension of release or of detention, the customs office referred to in Article 9(1) has not been notified that proceedings have been initiated to determine whether an intellectual property right has been infringed under national law in accordance with Article 10 or has not received the right-holder's agreement provided for in Article 11(1) where applicable, release of the goods shall be granted, or their detention shall be ended, as appropriate, subject to completion of all customs formalities.

This period may be extended by a maximum of 10 working days in appropriate cases.

2. In the case of perishable goods suspected of infringing an intellectual property right, the period referred to in paragraph 1 shall be three working days. That period may not be extended.

Article 14

1. In the case of goods suspected of infringing design rights, patents, supplementary protection certificates or plant variety rights, the declarant, owner, importer, holder or consignee of the goods shall be able to obtain the release of the goods or an end to their detention on provision of a security, provided that:

- (a) the customs office or department referred to in Article 9(1) has been notified, in accordance with Article 13(1), that a procedure has been initiated within the period provided for in Article 13(1) to establish whether an intellectual property right has been infringed under national law;
- (b) the authority empowered for this purpose has not authorised precautionary measures before the expiry of the time limit laid down in Article 13(1);
- (c) all customs formalities have been completed.

2. The security provided for in paragraph 1 must be sufficient to protect the interests of the right-holder.

Payment of the security shall not affect the other legal remedies available to the right-holder.

Where the procedure to determine whether an intellectual property right has been infringed under national law has been initiated other than on the initiative of the holder of a design right, patent, supplementary protection certificate or plant variety right, the security shall be released if the person initiating the said procedure does not exercise his right to institute legal proceedings within 20 working days of the date on which he receives notification of the suspension of release or detention.

Where the second subparagraph of Article 13(1) applies, this period may be extended to a maximum of 30 working days.

Article 15

The conditions of storage of the goods during the period of suspension of release or detention shall be determined by each Member State but shall not give rise to costs for the customs administrations.

CHAPTER IV PROVISIONS APPLICABLE TO GOODS FOUND TO INFRINGE AN INTELLECTUAL PROPERTY RIGHT

Article 16

Goods found to infringe an intellectual property right at the end of the procedure provided for in Article 9 shall not be:

- allowed to enter into the Community customs territory,
- released for free circulation,
- removed from the Community customs territory,
- exported,
- re-exported,
- placed under a suspensive procedure or
- placed in a free zone or free warehouse.

Article 17

1. Without prejudice to the other legal remedies open to the right-holder, Member States shall adopt the measures necessary to allow the competent authorities:

- (a) in accordance with the relevant provisions of national law, to destroy goods found to infringe an intellectual property right or dispose of them outside commercial channels in such a way as to preclude injury to the right-holder, without compensation of any sort and, unless otherwise specified in national legislation, at no cost to the exchequer;
- (b) to take, in respect of such goods, any other measures effectively depriving the persons concerned of any economic gains from the transaction.

Save in exceptional cases, simply removing the trademarks which have been affixed to counterfeit goods without authorisation shall not be regarded as effectively depriving the persons concerned

of any economic gains from the transaction.

2. Goods found to infringe an intellectual property right may be forfeited to the exchequer. In that event, paragraph 1(a) shall apply.

CHAPTER V PENALTIES

Article 18

Each Member State shall introduce penalties to apply in cases of violation of this Regulation. Such penalties must be effective, proportionate and dissuasive.

CHAPTER VI LIABILITY OF THE CUSTOMS AUTHORITIES AND THE RIGHT-HOLDER

Article 19

1. Save as provided by the law of the Member State in which an application is lodged or, in the case of an application under Article 5(4), by the law of the Member State in which goods infringing an intellectual property right are not detected by a customs office, the acceptance of an application shall not entitle the right-holder to compensation in the event that such goods are not detected by a customs office and are released or no action is taken to detain them in accordance with Article 9(1).

2. The exercise by a customs office or by another duly empowered authority of the powers conferred on them in order to fight against goods infringing an intellectual property right shall not render them liable towards the persons involved in the situations referred to in Article 1(1) or the persons affected by the measures provided for in Article 4 for damages suffered by them as a result of the authority's intervention, except where provided for by the law of the Member State in which the application is made or, in the case of an application under Article 5(4), by the law of the Member State in which loss or damage is incurred.

3. A right-holder's civil liability shall be governed by the law of the Member State in which the goods in question were placed in one of the situations referred to in Article 1(1).

CHAPTER VII FINAL PROVISIONS

Article 20

The measures necessary for the application of this Regulation shall be adopted in accordance with the procedure referred to in Article 21(2).

Article 21

1. The Commission shall be assisted by the Customs Code Committee.

2. Where reference is made to this paragraph, Articles 4 and 7 of Decision 1999/468/EC shall apply.

The period laid down in Article 4(3) of Decision 1999/468/EC shall be set at three months.

Article 22

Member States shall communicate all relevant information on the application of this Regulation to the Commission.

The Commission shall forward this information to the other Member States.

The provisions of Regulation (EC) No 515/97 shall apply *mutatis mutandis*.

The details of the information procedure shall be drawn up under the implementing provisions in accordance with the procedure referred to in Article 21(2).

Article 23

On the basis of the information referred to in Article 22, the Commission shall report annually to the Council on the application of this Regulation. This report may, where appropriate, be accompanied by a proposal to amend the Regulation.

Article 24

Regulation (EC) No 3295/94 is repealed with effect from 1 July 2004.

References to the repealed Regulation shall be construed as references to this Regulation.

Article 25

This Regulation shall enter into force on the seventh day following that of its publication in the Official Journal of the European Union.

It shall apply with effect from 1 July 2004.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 22 July 2003.

For the Council

The President

G. Alemanno

- (1) OJ L 341, 30.12.1994, p. 8. Regulation as last amended by Regulation (EC) No 806/2003 (OJ L 122, 16.5.2003, p. 1).
- (2) OJ L 82, 22.3.1997, p. 1. Regulation as last amended by Regulation (EC) No 807/2003 (OJ L 122, 16.5.2003, p. 36).
- (3) OJ L 184, 17.7.1999, p. 23.

- (4) OJ L 302, 19.10.1992, p. 1. Regulation as last amended by Regulation (EC) No 2700/2000, of the European Parliament and of the Council (OJ L 311, 12.12.2000, p. 17).
- (5) OJ L 11, 14.01.1994, p. 1. Regulation as last amended by Regulation (EC) No 807/2003.
- (6) OJ L 3, 5.1.2002, p. 1.
- (7) OJ L 182, 2.7.1992, p. 1.
- (8) OJ L 198, 8.8.1996, p. 30.
- (9) OJ L 227, 1.9.1994, p. 1. Regulation as last amended by Regulation (EC) No 807/2003.
- (10) OJ L 208, 24.7.1992, p. 1. Regulation as last amended by Regulation (EC) No 806/2003.
- (11) OJ L 179, 14.7.1999, p. 1. Regulation as last amended by Regulation (EC) No 806/2003.
- (12) OJ L 160, 12.6.1989, p. 1. Regulation as last amended by Regulation (EC) No 3378/94 of the European Parliament and of the Council (OJ L 366, 31.12.1994, p. 1).

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**Corrigendum to Directive 2004/48/EC of the European Parliament and of the Council
of 29 April 2004
on the enforcement of intellectual property rights (OJ L 157, 30.4.2004)**

Corrigendum to Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (Official Journal of the European Union L 157 of 30 April 2004)

Directive 2004/48/EC should read as follows:

Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (Text with EEA relevance)

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 95 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Economic and Social Committee(1),

After consulting the Committee of the Regions,

Acting in accordance with the procedure laid down in Article 251 of the Treaty(2),

Whereas:

- (1) The achievement of the internal market entails eliminating restrictions on freedom of movement and distortions of competition, while creating an environment conducive to innovation and investment. In this context, the protection of intellectual property is an essential element for the success of the internal market. The protection of intellectual property is important not only for promoting innovation and creativity, but also for developing employment and improving competitiveness.
- (2) The protection of intellectual property should allow the inventor or creator to derive a legitimate profit from his/her invention or creation. It should also allow the widest possible dissemination of works, ideas and new know-how. At the same time, it should not hamper freedom of expression, the free movement of information, or the protection of personal data, including on the Internet.
- (3) However, without effective means of enforcing intellectual property rights, innovation and creativity are discouraged and investment diminished. It is therefore necessary to ensure that the substantive law on intellectual property, which is nowadays largely part of the *acquis communautaire*, is applied effectively in the Community. In this respect, the means of enforcing intellectual property rights are of paramount importance for the success of the Internal Market.
- (4) At international level, all Member States, as well as the Community itself as regards matters within its competence, are bound by the Agreement on trade-related aspects of intellectual property (the TRIPS Agreement), approved, as part of the multilateral negotiations of the Uruguay Round, by Council Decision 94/800/EC(3) and concluded in the framework of the World Trade Organisation.
- (5) The TRIPS Agreement contains, in particular, provisions on the means of enforcing intellectual property rights, which are common standards applicable at international level and implemented in all Member States. This Directive should not affect Member States' international obligations, including those under the TRIPS Agreement.
- (6) There are also international conventions to which all Member States are parties and which also contain provisions on the means of enforcing intellectual property rights. These include, in particular, the Paris Convention for the Protection of Industrial Property, the Berne Convention for the Protection of Literary and Artistic Works, and the Rome Convention for the Protection

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of Performers, Producers of Phonograms and Broadcasting Organisations.

- (7) It emerges from the consultations held by the Commission on this question that, in the Member States, and despite the TRIPS Agreement, there are still major disparities as regards the means of enforcing intellectual property rights. For instance, the arrangements for applying provisional measures, which are used in particular to preserve evidence, the calculation of damages, or the arrangements for applying injunctions, vary widely from one Member State to another. In some Member States, there are no measures, procedures and remedies such as the right of information and the recall, at the infringer's expense, of the infringing goods placed on the market.
- (8) The disparities between the systems of the Member States as regards the means of enforcing intellectual property rights are prejudicial to the proper functioning of the Internal Market and make it impossible to ensure that intellectual property rights enjoy an equivalent level of protection throughout the Community. This situation does not promote free movement within the internal market or create an environment conducive to healthy competition.
- (9) The current disparities also lead to a weakening of the substantive law on intellectual property and to a fragmentation of the internal market in this field. This causes a loss of confidence in the internal market in business circles, with a consequent reduction in investment in innovation and creation. Infringements of intellectual property rights appear to be increasingly linked to organised crime. Increasing use of the Internet enables pirated products to be distributed instantly around the globe. Effective enforcement of the substantive law on intellectual property should be ensured by specific action at Community level. Approximation of the legislation of the Member States in this field is therefore an essential prerequisite for the proper functioning of the internal market.
- (10) The objective of this Directive is to approximate legislative systems so as to ensure a high, equivalent and homogeneous level of protection in the internal market.
- (11) This Directive does not aim to establish harmonised rules for judicial cooperation, jurisdiction, the recognition and enforcement of decisions in civil and commercial matters, or deal with applicable law. There are Community instruments which govern such matters in general terms and are, in principle, equally applicable to intellectual property.
- (12) This Directive should not affect the application of the rules of competition, and in particular Articles 81 and 82 of the Treaty. The measures provided for in this Directive should not be used to restrict competition unduly in a manner contrary to the Treaty.
- (13) It is necessary to define the scope of this Directive as widely as possible in order to encompass all the intellectual property rights covered by Community provisions in this field and/or by the national law of the Member State concerned. Nevertheless, that requirement does not affect the possibility, on the part of those Member States which so wish, to extend, for internal purposes, the provisions of this Directive to include acts involving unfair competition, including parasitic copies, or similar activities.
- (14) The measures provided for in Articles 6(2), 8(1) and 9(2) need to be applied only in respect of acts carried out on a commercial scale. This is without prejudice to the possibility for Member States to apply those measures also in respect of other acts. Acts carried out on a commercial scale are those carried out for direct or indirect economic or commercial advantage; this would normally exclude acts carried out by end- consumers acting in good faith.
- (15) This Directive should not affect substantive law on intellectual property, Directive 95/46/EC of 24 October 1995 of the European Parliament and of the Council on the protection of individuals with regard to the processing of personal data and on the free movement of such data(4), Directive

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1999/93/EC of the European Parliament and of the Council of 13 December 1999 on a Community framework for electronic signatures(5) and Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the internal market(6).

- (16) The provisions of this Directive should be without prejudice to the particular provisions for the enforcement of rights and on exceptions in the domain of copyright and related rights set out in Community instruments and notably those found in Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs(7) or in Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society(8).
- (17) The measures, procedures and remedies provided for in this Directive should be determined in each case in such a manner as to take due account of the specific characteristics of that case, including the specific features of each intellectual property right and, where appropriate, the intentional or unintentional character of the infringement.
- (18) The persons entitled to request application of those measures, procedures and remedies should be not only the rightholders but also persons who have a direct interest and legal standing in so far as permitted by and in accordance with the applicable law, which may include professional organisations in charge of the management of those rights or for the defence of the collective and individual interests for which they are responsible.
- (19) Since copyright exists from the creation of a work and does not require formal registration, it is appropriate to adopt the rule laid down in Article 15 of the Berne Convention, which establishes the presumption whereby the author of a literary or artistic work is regarded as such if his/her name appears on the work. A similar presumption should be applied to the owners of related rights since it is often the holder of a related right, such as a phonogram producer, who will seek to defend rights and engage in fighting acts of piracy.
- (20) Given that evidence is an element of paramount importance for establishing the infringement of intellectual property rights, it is appropriate to ensure that effective means of presenting, obtaining and preserving evidence are available. The procedures should have regard to the rights of the defence and provide the necessary guarantees, including the protection of confidential information. For infringements committed on a commercial scale it is also important that the courts may order access, where appropriate, to banking, financial or commercial documents under the control of the alleged infringer.
- (21) Other measures designed to ensure a high level of protection exist in certain Member States and should be made available in all the Member States. This is the case with the right of information, which allows precise information to be obtained on the origin of the infringing goods or services, the distribution channels and the identity of any third parties involved in the infringement.
- (22) It is also essential to provide for provisional measures for the immediate termination of infringements, without awaiting a decision on the substance of the case, while observing the rights of the defence, ensuring the proportionality of the provisional measures as appropriate to the characteristics of the case in question and providing the guarantees needed to cover the costs and the injury caused to the defendant by an unjustified request. Such measures are particularly justified where any delay would cause irreparable harm to the holder of an intellectual property right.
- (23) Without prejudice to any other measures, procedures and remedies available, rightholders should have the possibility of applying for an injunction against an intermediary whose services are being used by a third party to infringe the rightholder's industrial property right. The conditions

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and procedures relating to such injunctions should be left to the national law of the Member States. As far as infringements of copyright and related rights are concerned, a comprehensive level of harmonisation is already provided for in Directive 2001/29/EC. Article 8(3) of Directive 2001/29/EC should therefore not be affected by this Directive.

- (24) Depending on the particular case, and if justified by the circumstances, the measures, procedures and remedies to be provided for should include prohibitory measures aimed at preventing further infringements of intellectual property rights. Moreover there should be corrective measures, where appropriate at the expense of the infringer, such as the recall and definitive removal from the channels of commerce, or destruction, of the infringing goods and, in appropriate cases, of the materials and implements principally used in the creation or manufacture of these goods. These corrective measures should take account of the interests of third parties including, in particular, consumers and private parties acting in good faith.
- (25) Where an infringement is committed unintentionally and without negligence and where the corrective measures or injunctions provided for by this Directive would be disproportionate, Member States should have the option of providing for the possibility, in appropriate cases, of pecuniary compensation being awarded to the injured party as an alternative measure. However, where the commercial use of counterfeit goods or the supply of services would constitute an infringement of law other than intellectual property law or would be likely to harm consumers, such use or supply should remain prohibited.
- (26) With a view to compensating for the prejudice suffered as a result of an infringement committed by an infringer who engaged in an activity in the knowledge, or with reasonable grounds for knowing, that it would give rise to such an infringement, the amount of damages awarded to the rightholder should take account of all appropriate aspects, such as loss of earnings incurred by the rightholder, or unfair profits made by the infringer and, where appropriate, any moral prejudice caused to the rightholder. As an alternative, for example where it would be difficult to determine the amount of the actual prejudice suffered, the amount of the damages might be derived from elements such as the royalties or fees which would have been due if the infringer had requested authorisation to use the intellectual property right in question. The aim is not to introduce an obligation to provide for punitive damages but to allow for compensation based on an objective criterion while taking account of the expenses incurred by the rightholder, such as the costs of identification and research.
- (27) To act as a supplementary deterrent to future infringers and to contribute to the awareness of the public at large, it is useful to publicise decisions in intellectual property infringement cases.
- (28) In addition to the civil and administrative measures, procedures and remedies provided for under this Directive, criminal sanctions also constitute, in appropriate cases, a means of ensuring the enforcement of intellectual property rights.
- (29) Industry should take an active part in the fight against piracy and counterfeiting. The development of codes of conduct in the circles directly affected is a supplementary means of bolstering the regulatory framework. The Member States, in collaboration with the Commission, should encourage the development of codes of conduct in general. Monitoring of the manufacture of optical discs, particularly by means of an identification code embedded in discs produced in the Community, helps to limit infringements of intellectual property rights in this sector, which suffers from piracy on a large scale. However, these technical protection measures should not be misused to protect markets and prevent parallel imports.
- (30) In order to facilitate the uniform application of this Directive, it is appropriate to provide

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for systems of cooperation and the exchange of information between Member States, on the one hand, and between the Member States and the Commission on the other, in particular by creating a network of correspondents designated by the Member States and by providing regular reports assessing the application of this Directive and the effectiveness of the measures taken by the various national bodies.

- (31) Since, for the reasons already described, the objective of this Directive can best be achieved at Community level, the Community may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty. In accordance with the principle of proportionality as set out in that Article, this Directive does not go beyond what is necessary in order to achieve that objective.
- (32) This Directive respects the fundamental rights and observes the principles recognised in particular by the Charter of Fundamental Rights of the European Union. In particular, this Directive seeks to ensure full respect for intellectual property, in accordance with Article 17(2) of that Charter,

HAVE ADOPTED THIS DIRECTIVE:

CHAPTER I

OBJECTIVE AND SCOPE

Article 1

Subject matter

This Directive concerns the measures, procedures and remedies necessary to ensure the enforcement of intellectual property rights. For the purposes of this Directive, the term "intellectual property rights" includes industrial property rights.

Article 2

Scope

1. Without prejudice to the means which are or may be provided for in Community or national legislation, in so far as those means may be more favourable for rightholders, the measures, procedures and remedies provided for by this Directive shall apply, in accordance with Article 3, to any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member State concerned.

2. This Directive shall be without prejudice to the specific provisions on the enforcement of rights and on exceptions contained in Community legislation concerning copyright and rights related to copyright, notably those found in Directive 91/250/EEC and, in particular, Article 7 thereof or in Directive 2001/29/EC and, in particular, Articles 2 to 6 and Article 8 thereof.

3. This Directive shall not affect:

- (a) the Community provisions governing the substantive law on intellectual property, Directive 95/46/EC, Directive 1999/93/EC or Directive 2000/31/EC, in general, and Articles 12 to 15 of Directive 2000/31/EC in particular;

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- (b) Member States' international obligations and notably the TRIPS Agreement, including those relating to criminal procedures and penalties;
- (c) any national provisions in Member States relating to criminal procedures or penalties in respect of infringement of intellectual property rights.

CHAPTER II

MEASURES, PROCEDURES AND REMEDIES

Section 1

General provisions

Article 3

General obligation

1. Member States shall provide for the measures, procedures and remedies necessary to ensure the enforcement of the intellectual property rights covered by this Directive. Those measures, procedures and remedies shall be fair and equitable and shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

2. Those measures, procedures and remedies shall also be effective, proportionate and dissuasive and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

Article 4

Persons entitled to apply for the application of the measures, procedures and remedies

Member States shall recognise as persons entitled to seek application of the measures, procedures and remedies referred to in this chapter:

- (a) the holders of intellectual property rights, in accordance with the provisions of the applicable law;
- (b) all other persons authorised to use those rights, in particular licensees, in so far as permitted by and in accordance with the provisions of the applicable law;
- (c) intellectual property collective rights-management bodies which are regularly recognised as having a right to represent holders of intellectual property rights, in so far as permitted by and in accordance with the provisions of the applicable law;
- (d) professional defence bodies which are regularly recognised as having a right to represent holders of intellectual property rights, in so far as permitted by and in accordance with the provisions of the applicable law.

Article 5

Presumption of authorship or ownership

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For the purposes of applying the measures, procedures and remedies provided for in this Directive,

- (a) for the author of a literary or artistic work, in the absence of proof to the contrary, to be regarded as such, and consequently to be entitled to institute infringement proceedings, it shall be sufficient for his/her name to appear on the work in the usual manner;
- (b) the provision under (a) shall apply *mutatis mutandis* to the holders of rights related to copyright with regard to their protected subject matter.

Section 2

Evidence

Article 6

Evidence

1. Member States shall ensure that, on application by a party which has presented reasonably available evidence sufficient to support its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, subject to the protection of confidential information. For the purposes of this paragraph, Member States may provide that a reasonable sample of a substantial number of copies of a work or any other protected object be considered by the competent judicial authorities to constitute reasonable evidence.

2. Under the same conditions, in the case of an infringement committed on a commercial scale Member States shall take such measures as are necessary to enable the competent judicial authorities to order, where appropriate, on application by a party, the communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information.

Article 7

Measures for preserving evidence

1. Member States shall ensure that, even before the commencement of proceedings on the merits of the case, the competent judicial authorities may, on application by a party who has presented reasonably available evidence to support his/her claims that his/her intellectual property right has been infringed or is about to be infringed, order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information. Such measures may include the detailed description, with or without the taking of samples, or the physical seizure of the infringing goods, and, in appropriate cases, the materials and implements used in the production and/or distribution of these goods and the documents relating thereto. Those measures shall be taken, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the rightholder or where there is a demonstrable risk of evidence being destroyed.

Where measures to preserve evidence are adopted without the other party having been heard, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether

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the measures shall be modified, revoked or confirmed.

2. Member States shall ensure that the measures to preserve evidence may be subject to the lodging by the applicant of adequate security or an equivalent assurance intended to ensure compensation for any prejudice suffered by the defendant as provided for in paragraph 4.

3. Member States shall ensure that the measures to preserve evidence are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if the applicant does not institute, within a reasonable period, proceedings leading to a decision on the merits of the case before the competent judicial authority, the period to be determined by the judicial authority ordering the measures where the law of a Member State so permits or, in the absence of such determination, within a period not exceeding 20 working days or 31 calendar days, whichever is the longer.

4. Where the measures to preserve evidence are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures.

5. Member States may take measures to protect witnesses' identity.

Section 3

Right of information

Article 8

Right of information

1. Member States shall ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by the infringer and/or any other person who:

- (a) was found in possession of the infringing goods on a commercial scale;
- (b) was found to be using the infringing services on a commercial scale;
- (c) was found to be providing on a commercial scale services used in infringing activities;

or

- (d) was indicated by the person referred to in point (a), (b) or (c) as being involved in the production, manufacture or distribution of the goods or the provision of the services.

2. The information referred to in paragraph 1 shall, as appropriate, comprise:

- (a) the names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or services, as well as the intended wholesalers and retailers;
- (b) information on the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the goods or services in question.

3. Paragraphs 1 and 2 shall apply without prejudice to other statutory provisions which:

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- (a) grant the rightholder rights to receive fuller information;
 - (b) govern the use in civil or criminal proceedings of the information communicated pursuant to this Article;
 - (c) govern responsibility for misuse of the right of information;
- or
- (d) afford an opportunity for refusing to provide information which would force the person referred to in paragraph 1 to admit to his/her own participation or that of his/her close relatives in an infringement of an intellectual property right;
- or
- (e) govern the protection of confidentiality of information sources or the processing of personal data.

Section 4

Provisional and precautionary measures

Article 9

Provisional and precautionary measures

1. Member States shall ensure that the judicial authorities may, at the request of the applicant:

- (a) issue against the alleged infringer an interlocutory injunction intended to prevent any imminent infringement of an intellectual property right, or to forbid, on a provisional basis and subject, where appropriate, to a recurring penalty payment where provided for by national law, the continuation of the alleged infringements of that right, or to make such continuation subject to the lodging of guarantees intended to ensure the compensation of the rightholder; an interlocutory injunction may also be issued, under the same conditions, against an intermediary whose services are being used by a third party to infringe an intellectual property right; injunctions against intermediaries whose services are used by a third party to infringe a copyright or a related right are covered by Directive 2001/29/EC;
- (b) order the seizure or delivery up of the goods suspected of infringing an intellectual property right so as to prevent their entry into or movement within the channels of commerce.

2. In the case of an infringement committed on a commercial scale, the Member States shall ensure that, if the injured party demonstrates circumstances likely to endanger the recovery of damages, the judicial authorities may order the precautionary seizure of the movable and immovable property of the alleged infringer, including the blocking of his/her bank accounts and other assets. To that end, the competent authorities may order the communication of bank, financial or commercial documents, or appropriate access to the relevant information.

3. The judicial authorities shall, in respect of the measures referred to in paragraphs 1 and 2, have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the rightholder and that the applicant's right is being infringed, or that such infringement is imminent.

4. Member States shall ensure that the provisional measures referred to in paragraphs 1 and 2 may, in appropriate cases, be taken without the defendant having been heard, in particular where any delay would cause irreparable harm to the rightholder. In that event, the parties shall be so informed

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without delay after the execution of the measures at the latest.

A review, including a right to be heard, shall take place upon request of the defendant with a view to deciding, within a reasonable time after notification of the measures, whether those measures shall be modified, revoked or confirmed.

5. Member States shall ensure that the provisional measures referred to in paragraphs 1 and 2 are revoked or otherwise cease to have effect, upon request of the defendant, if the applicant does not institute, within a reasonable period, proceedings leading to a decision on the merits of the case before the competent judicial authority, the period to be determined by the judicial authority ordering the measures where the law of a Member State so permits or, in the absence of such determination, within a period not exceeding 20 working days or 31 calendar days, whichever is the longer.

6. The competent judicial authorities may make the provisional measures referred to in paragraphs 1 and 2 subject to the lodging by the applicant of adequate security or an equivalent assurance intended to ensure compensation for any prejudice suffered by the defendant as provided for in paragraph 7.

7. Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures.

Section 5

Measures resulting from a decision on the merits of the case

Article 10

Corrective measures

1. Without prejudice to any damages due to the rightholder by reason of the infringement, and without compensation of any sort, Member States shall ensure that the competent judicial authorities may order, at the request of the applicant, that appropriate measures be taken with regard to goods that they have found to be infringing an intellectual property right and, in appropriate cases, with regard to materials and implements principally used in the creation or manufacture of those goods. Such measures shall include:

- (a) recall from the channels of commerce;
 - (b) definitive removal from the channels of commerce;
- or
- (c) destruction.

2. The judicial authorities shall order that those measures be carried out at the expense of the infringer, unless particular reasons are invoked for not doing so.

3. In considering a request for corrective measures, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.

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Article 11

Injunctions

Member States shall ensure that, where a judicial decision is taken finding an infringement of an intellectual property right, the judicial authorities may issue against the infringer an injunction aimed at prohibiting the continuation of the infringement. Where provided for by national law, non-compliance with an injunction shall, where appropriate, be subject to a recurring penalty payment, with a view to ensuring compliance. Member States shall also ensure that rightholders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe an intellectual property right, without prejudice to Article 8(3) of Directive 2001/29/EC.

Article 12

Alternative measures

Member States may provide that, in appropriate cases and at the request of the person liable to be subject to the measures provided for in this section, the competent judicial authorities may order pecuniary compensation to be paid to the injured party instead of applying the measures provided for in this section if that person acted unintentionally and without negligence, if execution of the measures in question would cause him/her disproportionate harm and if pecuniary compensation to the injured party appears reasonably satisfactory.

Section 6

Damages and legal costs

Article 13

Damages

1. Member States shall ensure that the competent judicial authorities, on application of the injured party, order the infringer who knowingly, or with reasonable grounds to know, engaged in an infringing activity, to pay the rightholder damages appropriate to the actual prejudice suffered by him/her as a result of the infringement.

When the judicial authorities set the damages:

- (a) they shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, which the injured party has suffered, any unfair profits made by the infringer and, in appropriate cases, elements other than economic factors, such as the moral prejudice caused to the rightholder by the infringement;
- or
- (b) as an alternative to (a), they may, in appropriate cases, set the damages as a lump sum on the basis of elements such as at least the amount of royalties or fees which would have been due if the infringer had requested authorisation to use the intellectual property right in question.

2. Where the infringer did not knowingly, or with reasonable grounds know, engage in infringing

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activity, Member States may lay down that the judicial authorities may order the recovery of profits or the payment of damages, which may be pre-established.

Article 14

Legal costs

Member States shall ensure that reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party, unless equity does not allow this.

Section 7

Publicity measures

Article 15

Publication of judicial decisions

Member States shall ensure that, in legal proceedings instituted for infringement of an intellectual property right, the judicial authorities may order, at the request of the applicant and at the expense of the infringer, appropriate measures for the dissemination of the information concerning the decision, including displaying the decision and publishing it in full or in part. Member States may provide for other additional publicity measures which are appropriate to the particular circumstances, including prominent advertising.

CHAPTER III

SANCTIONS BY MEMBER STATES

Article 16

Sanctions by Member States

Without prejudice to the civil and administrative measures, procedures and remedies laid down by this Directive, Member States may apply other appropriate sanctions in cases where intellectual property rights have been infringed.

CHAPTER IV

CODES OF CONDUCT AND ADMINISTRATIVE COOPERATION

Article 17

Codes of conduct

Member States shall encourage:

(a) the development by trade or professional associations or organisations of codes of conduct at

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Community level aimed at contributing towards the enforcement of the intellectual property rights, particularly by recommending the use on optical discs of a code enabling the identification of the origin of their manufacture;

- (b) the submission to the Commission of draft codes of conduct at national and Community level and of any evaluations of the application of these codes of conduct.

Article 18

Assessment

1. Three years after the date laid down in Article 20(1), each Member State shall submit to the Commission a report on the implementation of this Directive.

On the basis of those reports, the Commission shall draw up a report on the application of this Directive, including an assessment of the effectiveness of the measures taken, as well as an evaluation of its impact on innovation and the development of the information society. That report shall then be transmitted to the European Parliament, the Council and the European Economic and Social Committee. It shall be accompanied, if necessary and in the light of developments in the Community legal order, by proposals for amendments to this Directive.

2. Member States shall provide the Commission with all the aid and assistance it may need when drawing up the report referred to in the second subparagraph of paragraph 1.

Article 19

Exchange of information and correspondents

For the purpose of promoting cooperation, including the exchange of information, among Member States and between Member States and the Commission, each Member State shall designate one or more national correspondents for any question relating to the implementation of the measures provided for by this Directive. It shall communicate the details of the national correspondent(s) to the other Member States and to the Commission.

CHAPTER V

FINAL PROVISIONS

Article 20

Implementation

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive by 29 April 2006. They shall forthwith inform the Commission thereof.

When Member States adopt these measures, they shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such reference shall be laid down by Member States.

2. Member States shall communicate to the Commission the texts of the provisions of national law

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which they adopt in the field governed by this Directive.

Article 21

Entry into force

This Directive shall enter into force on the 20th day following that of its publication in the Official Journal of the European Union.

Article 22

Addressees

This Directive is addressed to the Member States.

Done at Strasbourg, 29 April 2004.

For the European Parliament

The President

P. Cox

For the Council

The President

M. Mc Dowell

- (1) OJ C 32, 5.2.2004, p. 15.
- (2) Opinion of the European Parliament of 9 March 2004 (not yet published in the Official Journal) and Council Decision of 26 April 2004 .
- (3) OJ L 336, 23.12.1994, p. 1.
- (4) OJ L 281, 23.11.1995, p. 31. Directive as amended by Regulation (EC) No 1882/2003 (OJ L 284, 31.10.2003, p. 1).
- (5) OJ L 13, 19.1.2000, p. 12.
- (6) OJ L 178, 17.7.2000, p. 1.
- (7) OJ L 122, 17.5.1991, p. 42. Directive as amended by Directive 93/98/EEC (OJ L 290, 24.11.1993, p. 9).
- (8) OJ L 167, 22.6.2001, p. 10.

Corrigendum to Directive [2004/48/EC](#) of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (Official Journal of the European Union L 157 of 30 April 2004)

Directive [2004/48/EC](#) should read as follows:

Directive [2004/48/EC](#) of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (Text with EEA relevance)

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THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 95 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Economic and Social Committee(1),

After consulting the Committee of the Regions,

Acting in accordance with the procedure laid down in Article 251 of the Treaty(2),

Whereas:

- (1) The achievement of the internal market entails eliminating restrictions on freedom of movement and distortions of competition, while creating an environment conducive to innovation and investment. In this context, the protection of intellectual property is an essential element for the success of the internal market. The protection of intellectual property is important not only for promoting innovation and creativity, but also for developing employment and improving competitiveness.
- (2) The protection of intellectual property should allow the inventor or creator to derive a legitimate profit from his/her invention or creation. It should also allow the widest possible dissemination of works, ideas and new know-how. At the same time, it should not hamper freedom of expression, the free movement of information, or the protection of personal data, including on the Internet.
- (3) However, without effective means of enforcing intellectual property rights, innovation and creativity are discouraged and investment diminished. It is therefore necessary to ensure that the substantive law on intellectual property, which is nowadays largely part of the *acquis communautaire*, is applied effectively in the Community. In this respect, the means of enforcing intellectual property rights are of paramount importance for the success of the Internal Market.
- (4) At international level, all Member States, as well as the Community itself as regards matters within its competence, are bound by the Agreement on trade-related aspects of intellectual property (the TRIPS Agreement), approved, as part of the multilateral negotiations of the Uruguay Round, by Council Decision 94/800/EC(3) and concluded in the framework of the World Trade Organisation.
- (5) The TRIPS Agreement contains, in particular, provisions on the means of enforcing intellectual property rights, which are common standards applicable at international level and implemented in all Member States. This Directive should not affect Member States' international obligations, including those under the TRIPS Agreement.
- (6) There are also international conventions to which all Member States are parties and which also contain provisions on the means of enforcing intellectual property rights. These include, in particular, the Paris Convention for the Protection of Industrial Property, the Berne Convention for the Protection of Literary and Artistic Works, and the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations.
- (7) It emerges from the consultations held by the Commission on this question that, in the Member States, and despite the TRIPS Agreement, there are still major disparities as regards the means of enforcing intellectual property rights. For instance, the arrangements for applying provisional measures, which are used in particular to preserve evidence, the calculation of damages, or the arrangements for applying injunctions, vary widely from one Member State to another. In some Member States, there are no measures, procedures and remedies such as the right of information and the recall, at the infringer's expense, of the infringing goods placed on the market.
- (8) The disparities between the systems of the Member States as regards the means of enforcing

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intellectual property rights are prejudicial to the proper functioning of the Internal Market and make it impossible to ensure that intellectual property rights enjoy an equivalent level of protection throughout the Community. This situation does not promote free movement within the internal market or create an environment conducive to healthy competition.

- (9) The current disparities also lead to a weakening of the substantive law on intellectual property and to a fragmentation of the internal market in this field. This causes a loss of confidence in the internal market in business circles, with a consequent reduction in investment in innovation and creation. Infringements of intellectual property rights appear to be increasingly linked to organised crime. Increasing use of the Internet enables pirated products to be distributed instantly around the globe. Effective enforcement of the substantive law on intellectual property should be ensured by specific action at Community level. Approximation of the legislation of the Member States in this field is therefore an essential prerequisite for the proper functioning of the internal market.
- (10) The objective of this Directive is to approximate legislative systems so as to ensure a high, equivalent and homogeneous level of protection in the internal market.
- (11) This Directive does not aim to establish harmonised rules for judicial cooperation, jurisdiction, the recognition and enforcement of decisions in civil and commercial matters, or deal with applicable law. There are Community instruments which govern such matters in general terms and are, in principle, equally applicable to intellectual property.
- (12) This Directive should not affect the application of the rules of competition, and in particular Articles 81 and 82 of the Treaty. The measures provided for in this Directive should not be used to restrict competition unduly in a manner contrary to the Treaty.
- (13) It is necessary to define the scope of this Directive as widely as possible in order to encompass all the intellectual property rights covered by Community provisions in this field and/or by the national law of the Member State concerned. Nevertheless, that requirement does not affect the possibility, on the part of those Member States which so wish, to extend, for internal purposes, the provisions of this Directive to include acts involving unfair competition, including parasitic copies, or similar activities.
- (14) The measures provided for in Articles 6(2), 8(1) and 9(2) need to be applied only in respect of acts carried out on a commercial scale. This is without prejudice to the possibility for Member States to apply those measures also in respect of other acts. Acts carried out on a commercial scale are those carried out for direct or indirect economic or commercial advantage; this would normally exclude acts carried out by end- consumers acting in good faith.
- (15) This Directive should not affect substantive law on intellectual property, Directive 95/46/EC of 24 October 1995 of the European Parliament and of the Council on the protection of individuals with regard to the processing of personal data and on the free movement of such data(4), Directive 1999/93/EC of the European Parliament and of the Council of 13 December 1999 on a Community framework for electronic signatures(5) and Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the internal market(6).
- (16) The provisions of this Directive should be without prejudice to the particular provisions for the enforcement of rights and on exceptions in the domain of copyright and related rights set out in Community instruments and notably those found in Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs(7) or in Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society(8).

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- (17) The measures, procedures and remedies provided for in this Directive should be determined in each case in such a manner as to take due account of the specific characteristics of that case, including the specific features of each intellectual property right and, where appropriate, the intentional or unintentional character of the infringement.
- (18) The persons entitled to request application of those measures, procedures and remedies should be not only the rightholders but also persons who have a direct interest and legal standing in so far as permitted by and in accordance with the applicable law, which may include professional organisations in charge of the management of those rights or for the defence of the collective and individual interests for which they are responsible.
- (19) Since copyright exists from the creation of a work and does not require formal registration, it is appropriate to adopt the rule laid down in Article 15 of the Berne Convention, which establishes the presumption whereby the author of a literary or artistic work is regarded as such if his/her name appears on the work. A similar presumption should be applied to the owners of related rights since it is often the holder of a related right, such as a phonogram producer, who will seek to defend rights and engage in fighting acts of piracy.
- (20) Given that evidence is an element of paramount importance for establishing the infringement of intellectual property rights, it is appropriate to ensure that effective means of presenting, obtaining and preserving evidence are available. The procedures should have regard to the rights of the defence and provide the necessary guarantees, including the protection of confidential information. For infringements committed on a commercial scale it is also important that the courts may order access, where appropriate, to banking, financial or commercial documents under the control of the alleged infringer.
- (21) Other measures designed to ensure a high level of protection exist in certain Member States and should be made available in all the Member States. This is the case with the right of information, which allows precise information to be obtained on the origin of the infringing goods or services, the distribution channels and the identity of any third parties involved in the infringement.
- (22) It is also essential to provide for provisional measures for the immediate termination of infringements, without awaiting a decision on the substance of the case, while observing the rights of the defence, ensuring the proportionality of the provisional measures as appropriate to the characteristics of the case in question and providing the guarantees needed to cover the costs and the injury caused to the defendant by an unjustified request. Such measures are particularly justified where any delay would cause irreparable harm to the holder of an intellectual property right.
- (23) Without prejudice to any other measures, procedures and remedies available, rightholders should have the possibility of applying for an injunction against an intermediary whose services are being used by a third party to infringe the rightholder's industrial property right. The conditions and procedures relating to such injunctions should be left to the national law of the Member States. As far as infringements of copyright and related rights are concerned, a comprehensive level of harmonisation is already provided for in Directive 2001/29/EC. Article 8(3) of Directive 2001/29/EC should therefore not be affected by this Directive.
- (24) Depending on the particular case, and if justified by the circumstances, the measures, procedures and remedies to be provided for should include prohibitory measures aimed at preventing further infringements of intellectual property rights. Moreover there should be corrective measures, where appropriate at the expense of the infringer, such as the recall and definitive removal from the channels of commerce, or destruction, of the infringing goods and, in appropriate cases, of the materials and implements principally used in the creation or manufacture of these goods.

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These corrective measures should take account of the interests of third parties including, in particular, consumers and private parties acting in good faith.

- (25) Where an infringement is committed unintentionally and without negligence and where the corrective measures or injunctions provided for by this Directive would be disproportionate, Member States should have the option of providing for the possibility, in appropriate cases, of pecuniary compensation being awarded to the injured party as an alternative measure. However, where the commercial use of counterfeit goods or the supply of services would constitute an infringement of law other than intellectual property law or would be likely to harm consumers, such use or supply should remain prohibited.
- (26) With a view to compensating for the prejudice suffered as a result of an infringement committed by an infringer who engaged in an activity in the knowledge, or with reasonable grounds for knowing, that it would give rise to such an infringement, the amount of damages awarded to the rightholder should take account of all appropriate aspects, such as loss of earnings incurred by the rightholder, or unfair profits made by the infringer and, where appropriate, any moral prejudice caused to the rightholder. As an alternative, for example where it would be difficult to determine the amount of the actual prejudice suffered, the amount of the damages might be derived from elements such as the royalties or fees which would have been due if the infringer had requested authorisation to use the intellectual property right in question. The aim is not to introduce an obligation to provide for punitive damages but to allow for compensation based on an objective criterion while taking account of the expenses incurred by the rightholder, such as the costs of identification and research.
- (27) To act as a supplementary deterrent to future infringers and to contribute to the awareness of the public at large, it is useful to publicise decisions in intellectual property infringement cases.
- (28) In addition to the civil and administrative measures, procedures and remedies provided for under this Directive, criminal sanctions also constitute, in appropriate cases, a means of ensuring the enforcement of intellectual property rights.
- (29) Industry should take an active part in the fight against piracy and counterfeiting. The development of codes of conduct in the circles directly affected is a supplementary means of bolstering the regulatory framework. The Member States, in collaboration with the Commission, should encourage the development of codes of conduct in general. Monitoring of the manufacture of optical discs, particularly by means of an identification code embedded in discs produced in the Community, helps to limit infringements of intellectual property rights in this sector, which suffers from piracy on a large scale. However, these technical protection measures should not be misused to protect markets and prevent parallel imports.
- (30) In order to facilitate the uniform application of this Directive, it is appropriate to provide for systems of cooperation and the exchange of information between Member States, on the one hand, and between the Member States and the Commission on the other, in particular by creating a network of correspondents designated by the Member States and by providing regular reports assessing the application of this Directive and the effectiveness of the measures taken by the various national bodies.
- (31) Since, for the reasons already described, the objective of this Directive can best be achieved at Community level, the Community may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty. In accordance with the principle of proportionality as set out in that Article, this Directive does not go beyond what is necessary in order to achieve that objective.

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(32) This Directive respects the fundamental rights and observes the principles recognised in particular by the Charter of Fundamental Rights of the European Union. In particular, this Directive seeks to ensure full respect for intellectual property, in accordance with Article 17(2) of that Charter,

HAVE ADOPTED THIS DIRECTIVE:

CHAPTER I

OBJECTIVE AND SCOPE

Article 1

Subject matter

This Directive concerns the measures, procedures and remedies necessary to ensure the enforcement of intellectual property rights. For the purposes of this Directive, the term "intellectual property rights" includes industrial property rights.

Article 2

Scope

1. Without prejudice to the means which are or may be provided for in Community or national legislation, in so far as those means may be more favourable for rightholders, the measures, procedures and remedies provided for by this Directive shall apply, in accordance with Article 3, to any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member State concerned.

2. This Directive shall be without prejudice to the specific provisions on the enforcement of rights and on exceptions contained in Community legislation concerning copyright and rights related to copyright, notably those found in Directive 91/250/EEC and, in particular, Article 7 thereof or in Directive 2001/29/EC and, in particular, Articles 2 to 6 and Article 8 thereof.

3. This Directive shall not affect:

- (a) the Community provisions governing the substantive law on intellectual property, Directive 95/46/EC, Directive 1999/93/EC or Directive 2000/31/EC, in general, and Articles 12 to 15 of Directive 2000/31/EC in particular;
- (b) Member States' international obligations and notably the TRIPS Agreement, including those relating to criminal procedures and penalties;
- (c) any national provisions in Member States relating to criminal procedures or penalties in respect of infringement of intellectual property rights.

CHAPTER II

MEASURES, PROCEDURES AND REMEDIES

Section 1

General provisions

Article 3

General obligation

1. Member States shall provide for the measures, procedures and remedies necessary to ensure the enforcement of the intellectual property rights covered by this Directive. Those measures, procedures and remedies shall be fair and equitable and shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

2. Those measures, procedures and remedies shall also be effective, proportionate and dissuasive and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

Article 4

Persons entitled to apply for the application of the measures, procedures and remedies

Member States shall recognise as persons entitled to seek application of the measures, procedures and remedies referred to in this chapter:

- (a) the holders of intellectual property rights, in accordance with the provisions of the applicable law;
- (b) all other persons authorised to use those rights, in particular licensees, in so far as permitted by and in accordance with the provisions of the applicable law;
- (c) intellectual property collective rights-management bodies which are regularly recognised as having a right to represent holders of intellectual property rights, in so far as permitted by and in accordance with the provisions of the applicable law;
- (d) professional defence bodies which are regularly recognised as having a right to represent holders of intellectual property rights, in so far as permitted by and in accordance with the provisions of the applicable law.

Article 5

Presumption of authorship or ownership

For the purposes of applying the measures, procedures and remedies provided for in this Directive,

- (a) for the author of a literary or artistic work, in the absence of proof to the contrary, to be regarded as such, and consequently to be entitled to institute infringement proceedings, it shall be sufficient for his/her name to appear on the work in the usual manner;
- (b) the provision under (a) shall apply *mutatis mutandis* to the holders of rights related to copyright with regard to their protected subject matter.

Section 2

Evidence

Article 6

Evidence

1. Member States shall ensure that, on application by a party which has presented reasonably available evidence sufficient to support its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, subject to the protection of confidential information. For the purposes of this paragraph, Member States may provide that a reasonable sample of a substantial number of copies of a work or any other protected object be considered by the competent judicial authorities to constitute reasonable evidence.

2. Under the same conditions, in the case of an infringement committed on a commercial scale Member States shall take such measures as are necessary to enable the competent judicial authorities to order, where appropriate, on application by a party, the communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information.

Article 7

Measures for preserving evidence

1. Member States shall ensure that, even before the commencement of proceedings on the merits of the case, the competent judicial authorities may, on application by a party who has presented reasonably available evidence to support his/her claims that his/her intellectual property right has been infringed or is about to be infringed, order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information. Such measures may include the detailed description, with or without the taking of samples, or the physical seizure of the infringing goods, and, in appropriate cases, the materials and implements used in the production and/or distribution of these goods and the documents relating thereto. Those measures shall be taken, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the rightholder or where there is a demonstrable risk of evidence being destroyed.

Where measures to preserve evidence are adopted without the other party having been heard, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether the measures shall be modified, revoked or confirmed.

2. Member States shall ensure that the measures to preserve evidence may be subject to the lodging by the applicant of adequate security or an equivalent assurance intended to ensure compensation for any prejudice suffered by the defendant as provided for in paragraph 4.

3. Member States shall ensure that the measures to preserve evidence are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if the applicant does not institute, within a reasonable period, proceedings leading to a decision on the merits of the case before the competent judicial authority, the period to be determined by the judicial authority ordering the measures where the law of a Member State so permits or, in the absence of such determination, within a period not exceeding 20 working days or 31 calendar

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days, whichever is the longer.

4. Where the measures to preserve evidence are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures.

5. Member States may take measures to protect witnesses' identity.

Section 3

Right of information

Article 8

Right of information

1. Member States shall ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by the infringer and/or any other person who:

- (a) was found in possession of the infringing goods on a commercial scale;
- (b) was found to be using the infringing services on a commercial scale;
- (c) was found to be providing on a commercial scale services used in infringing activities;

or

- (d) was indicated by the person referred to in point (a), (b) or (c) as being involved in the production, manufacture or distribution of the goods or the provision of the services.

2. The information referred to in paragraph 1 shall, as appropriate, comprise:

- (a) the names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or services, as well as the intended wholesalers and retailers;
- (b) information on the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the goods or services in question.

3. Paragraphs 1 and 2 shall apply without prejudice to other statutory provisions which:

- (a) grant the rightholder rights to receive fuller information;
- (b) govern the use in civil or criminal proceedings of the information communicated pursuant to this Article;
- (c) govern responsibility for misuse of the right of information;

or

- (d) afford an opportunity for refusing to provide information which would force the person referred to in paragraph 1 to admit to his/her own participation or that of his/her close relatives in an infringement of an intellectual property right;

or

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(e) govern the protection of confidentiality of information sources or the processing of personal data.

Section 4

Provisional and precautionary measures

Article 9

Provisional and precautionary measures

1. Member States shall ensure that the judicial authorities may, at the request of the applicant:

- (a) issue against the alleged infringer an interlocutory injunction intended to prevent any imminent infringement of an intellectual property right, or to forbid, on a provisional basis and subject, where appropriate, to a recurring penalty payment where provided for by national law, the continuation of the alleged infringements of that right, or to make such continuation subject to the lodging of guarantees intended to ensure the compensation of the rightholder; an interlocutory injunction may also be issued, under the same conditions, against an intermediary whose services are being used by a third party to infringe an intellectual property right; injunctions against intermediaries whose services are used by a third party to infringe a copyright or a related right are covered by Directive 2001/29/EC;
- (b) order the seizure or delivery up of the goods suspected of infringing an intellectual property right so as to prevent their entry into or movement within the channels of commerce.

2. In the case of an infringement committed on a commercial scale, the Member States shall ensure that, if the injured party demonstrates circumstances likely to endanger the recovery of damages, the judicial authorities may order the precautionary seizure of the movable and immovable property of the alleged infringer, including the blocking of his/her bank accounts and other assets. To that end, the competent authorities may order the communication of bank, financial or commercial documents, or appropriate access to the relevant information.

3. The judicial authorities shall, in respect of the measures referred to in paragraphs 1 and 2, have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the rightholder and that the applicant's right is being infringed, or that such infringement is imminent.

4. Member States shall ensure that the provisional measures referred to in paragraphs 1 and 2 may, in appropriate cases, be taken without the defendant having been heard, in particular where any delay would cause irreparable harm to the rightholder. In that event, the parties shall be so informed without delay after the execution of the measures at the latest.

A review, including a right to be heard, shall take place upon request of the defendant with a view to deciding, within a reasonable time after notification of the measures, whether those measures shall be modified, revoked or confirmed.

5. Member States shall ensure that the provisional measures referred to in paragraphs 1 and 2 are revoked or otherwise cease to have effect, upon request of the defendant, if the applicant does not institute, within a reasonable period, proceedings leading to a decision on the merits of the case before the competent judicial authority, the period to be determined by the judicial authority ordering the measures where the law of a Member State so permits or, in the absence of such determination, within a period not exceeding 20 working days or 31 calendar days, whichever is the longer.

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6.The competent judicial authorities may make the provisional measures referred to in paragraphs 1 and 2 subject to the lodging by the applicant of adequate security or an equivalent assurance intended to ensure compensation for any prejudice suffered by the defendant as provided for in paragraph 7.

7.Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures.

Section 5

Measures resulting from a decision on the merits of the case

Article 10

Corrective measures

1.Without prejudice to any damages due to the rightholder by reason of the infringement, and without compensation of any sort, Member States shall ensure that the competent judicial authorities may order, at the request of the applicant, that appropriate measures be taken with regard to goods that they have found to be infringing an intellectual property right and, in appropriate cases, with regard to materials and implements principally used in the creation or manufacture of those goods. Such measures shall include:

- (a) recall from the channels of commerce;
 - (b) definitive removal from the channels of commerce;
- or
- (c) destruction.

2.The judicial authorities shall order that those measures be carried out at the expense of the infringer, unless particular reasons are invoked for not doing so.

3.In considering a request for corrective measures, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.

Article 11

Injunctions

Member States shall ensure that, where a judicial decision is taken finding an infringement of an intellectual property right, the judicial authorities may issue against the infringer an injunction aimed at prohibiting the continuation of the infringement. Where provided for by national law, non-compliance with an injunction shall, where appropriate, be subject to a recurring penalty payment, with a view to ensuring compliance. Member States shall also ensure that rightholders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe an intellectual property right, without prejudice to Article 8(3) of Directive 2001/29/EC.

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Article 12

Alternative measures

Member States may provide that, in appropriate cases and at the request of the person liable to be subject to the measures provided for in this section, the competent judicial authorities may order pecuniary compensation to be paid to the injured party instead of applying the measures provided for in this section if that person acted unintentionally and without negligence, if execution of the measures in question would cause him/her disproportionate harm and if pecuniary compensation to the injured party appears reasonably satisfactory.

Section 6

Damages and legal costs

Article 13

Damages

1. Member States shall ensure that the competent judicial authorities, on application of the injured party, order the infringer who knowingly, or with reasonable grounds to know, engaged in an infringing activity, to pay the rightholder damages appropriate to the actual prejudice suffered by him/her as a result of the infringement.

When the judicial authorities set the damages:

- (a) they shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, which the injured party has suffered, any unfair profits made by the infringer and, in appropriate cases, elements other than economic factors, such as the moral prejudice caused to the rightholder by the infringement;

or

- (b) as an alternative to (a), they may, in appropriate cases, set the damages as a lump sum on the basis of elements such as at least the amount of royalties or fees which would have been due if the infringer had requested authorisation to use the intellectual property right in question.

2. Where the infringer did not knowingly, or with reasonable grounds know, engage in infringing activity, Member States may lay down that the judicial authorities may order the recovery of profits or the payment of damages, which may be pre-established.

Article 14

Legal costs

Member States shall ensure that reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party, unless equity does not allow this.

Section 7

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Publicity measures

Article 15

Publication of judicial decisions

Member States shall ensure that, in legal proceedings instituted for infringement of an intellectual property right, the judicial authorities may order, at the request of the applicant and at the expense of the infringer, appropriate measures for the dissemination of the information concerning the decision, including displaying the decision and publishing it in full or in part. Member States may provide for other additional publicity measures which are appropriate to the particular circumstances, including prominent advertising.

CHAPTER III

SANCTIONS BY MEMBER STATES

Article 16

Sanctions by Member States

Without prejudice to the civil and administrative measures, procedures and remedies laid down by this Directive, Member States may apply other appropriate sanctions in cases where intellectual property rights have been infringed.

CHAPTER IV

CODES OF CONDUCT AND ADMINISTRATIVE COOPERATION

Article 17

Codes of conduct

Member States shall encourage:

- (a) the development by trade or professional associations or organisations of codes of conduct at Community level aimed at contributing towards the enforcement of the intellectual property rights, particularly by recommending the use on optical discs of a code enabling the identification of the origin of their manufacture;
- (b) the submission to the Commission of draft codes of conduct at national and Community level and of any evaluations of the application of these codes of conduct.

Article 18

Assessment

1. Three years after the date laid down in Article 20(1), each Member State shall submit to the Commission a report on the implementation of this Directive.

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On the basis of those reports, the Commission shall draw up a report on the application of this Directive, including an assessment of the effectiveness of the measures taken, as well as an evaluation of its impact on innovation and the development of the information society. That report shall then be transmitted to the European Parliament, the Council and the European Economic and Social Committee. It shall be accompanied, if necessary and in the light of developments in the Community legal order, by proposals for amendments to this Directive.

2. Member States shall provide the Commission with all the aid and assistance it may need when drawing up the report referred to in the second subparagraph of paragraph 1.

Article 19

Exchange of information and correspondents

For the purpose of promoting cooperation, including the exchange of information, among Member States and between Member States and the Commission, each Member State shall designate one or more national correspondents for any question relating to the implementation of the measures provided for by this Directive. It shall communicate the details of the national correspondent(s) to the other Member States and to the Commission.

CHAPTER V

FINAL PROVISIONS

Article 20

Implementation

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive by 29 April 2006. They shall forthwith inform the Commission thereof.

When Member States adopt these measures, they shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such reference shall be laid down by Member States.

2. Member States shall communicate to the Commission the texts of the provisions of national law which they adopt in the field governed by this Directive.

Article 21

Entry into force

This Directive shall enter into force on the 20th day following that of its publication in the Official Journal of the European Union.

Article 22

Addressees

B28>32004L0048R(01)

This Directive is addressed to the Member States.

Done at Strasbourg, 29 April 2004.

For the European Parliament

The President

P. Cox

For the Council

The President

M. Mc Dowell

- (1) OJ C 32, 5.2.2004, p. 15.
- (2) Opinion of the European Parliament of 9 March 2004 (not yet published in the Official Journal) and Council Decision of 26 April 2004 .
- (3) OJ L 336, 23.12.1994, p. 1.
- (4) OJ L 281, 23.11.1995, p. 31. Directive as amended by Regulation (EC) No 1882/2003 (OJ L 284, 31.10.2003, p. 1).
- (5) OJ L 13, 19.1.2000, p. 12.
- (6) OJ L 178, 17.7.2000, p. 1.
- (7) OJ L 122, 17.5.1991, p. 42. Directive as amended by Directive 93/98/EEC (OJ L 290, 24.11.1993, p. 9).
- (8) OJ L 167, 22.6.2001, p. 10.

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STATEMENT BY THE COMMISSION**concerning Article 2 of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights**

(2005/295/EC)

Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights⁽¹⁾ states in Article 2(1) that the Directive applies to any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member State concerned.

The Commission considers that at least the following intellectual property rights are covered by the scope of the Directive:

- copyright,
- rights related to copyright,
- *sui generis* right of a database maker,
- rights of the creator of the topographies of a semiconductor product,
- trademark rights,
- design rights,
- patent rights, including rights derived from supplementary protection certificates,
- geographical indications,
- utility model rights,
- plant variety rights,
- trade names, in so far as these are protected as exclusive property rights in the national law concerned.

⁽¹⁾ OJ L 157, 30.4.2004, p. 45. Directive as corrected and republished in OJ L 195, 2.6.2004. p. 16.

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Proposed Directive on enforcement of intellectual property rights: frequently asked questions

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MEMO/03/20

Brussels, 30th January 2003

Proposed Directive on enforcement of intellectual property rights: frequently asked questions

(see also IP/03/144)

What are the main objectives of the proposed Directive?

The proposed Directive seeks to create a **level playing field** for the enforcement of intellectual property rights in different EU countries, by bringing enforcement measures into line across the EU, especially in those countries where the enforcement of intellectual property rights is currently weakest.

The proposal also aims to establish a general framework for the exchange of information between the responsible national authorities.

The proposed Directive maintains a balance between helping holders of intellectual property defend their rights and protecting users from unfair litigation (so-called rights of **due process**).

What is the main content of the proposed Directive?

The proposed Directive covers infringements of all intellectual property rights (both copyright and industrial property, such as trademarks or designs) which under European law have been harmonised within the EU.

It concentrates on infringements carried out for commercial purposes or which cause significant harm to rightholders.

The proposed Directive is based on best practice in the Member States. The measures it would extend throughout the EU include, among others, injunctions to halt the sale of counterfeit or pirate goods, provisional measures such as precautionary seizures of suspected offenders' bank accounts, evidence-gathering powers for judicial authorities and powers to force offenders to pay damages to rightholders to compensate for lost income.

What is the difference between counterfeiting and piracy?

The TRIPS Agreement on enforcement of intellectual property rights, negotiated in the World Trade Organisation, contains the following definitions:

"Counterfeit trademark goods shall mean any goods, including packaging, bearing without authorisation a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark and which thereby infringes the rights of the owner of the trademark in question under the law of the country of importation."

This can be interpreted as being something made in imitation of something else with the intent to deceive.

"Pirated copyright goods shall mean any goods which are copies made without the consent of the rightholder or person duly authorised by the rightholder in the country of production and which are made directly or indirectly from an article where the making of that copy would have constituted an infringement of a copyright or a related right under the law of the country of importation".

This can be interpreted as an illegal copy of something that already exists.

Why is the proposed Directive necessary given that most so-called counterfeiters and pirates are merely trying to cater for public demand for goods at affordable prices?

The proposed Directive deals with the **enforcement** of intellectual property rights and so it does not deal directly with the **substance** of IPRs (i.e. to what extent intellectual property is protected in law). That is already covered by an existing EU legal framework. (The measures concerned are listed in the annex to the proposed Directive).

However, it is obvious that a property right is not worth having if it is unenforceable. For example, there is little point being the legal owner of a car if there are no means available to stop people stealing it.

Intellectual property rights need to be protected and enforced within carefully defined limits, for reasons which vary according to the different types of intellectual property.

These reasons are, for the main rights concerned:

- for **patents**, the point is to protect the **inventive idea**. This allows the inventor to generate income from their invention which thus gives a powerful incentive for inventors to create new inventions. In addition, patents are published and so information about new technical developments can be disseminated to other people who can make use of them
- for **trade marks**, the point is to protect the **link between producer and product** e.g. the logo, packaging. This has two advantages, it allows consumers to identify the origin of the products they buy and hence choose the level of quality and safety they are prepared to pay for. Secondly, it gives a powerful incentive for rightholders to invest in their specific products and improve their quality and image.
- for **copyright**, the point is to protect the **expression** of a creative work such as a book, a piece of music, or a film. This allows the creator of the work and other rightholders, to market creative content. IP serves to make available such content on appropriate terms. It also stimulates future creation and ensures the availability of high quality content for others to enjoy. Put simply, if an artist could not participate actively in the marketing of his or her work and get a share of the financial benefits, they would in most cases not be able to create and invest in their creation. If an intermediary like a film or record company did not get paid, they would not be able to produce and distribute it. Many major works enjoyed by millions would never see the light of day.

Will the proposed Directive affect current definitions of "fair use" ?

No. The term "fair use" comes from American practice. However, all EU Member States have certain exceptions to the rights in place, including for private copying or library use, which would roughly correspond to the idea of fair use. The proposed Directive would not affect the scope of intellectual property law as established by existing EU and national law but only the enforcement of that law.

Will people still be able to lend CDs to a friend?

Yes. There is a framework of EU law in place which does not make private lending subject to copyright protection.

How would the proposed Directive affect copying of material in schools and libraries?

It would not (see also 'fair use' answer above).

Most Member States have exceptions in place in their national law regarding the copying of material in schools and libraries. In most cases therefore such use would be exempted from intellectual property rights and would not lead to an infringement in the first place.

Will this Directive mean that young people using file swapping software via their PCs will be held liable for IPR infringement?

The proposed Directive would **not** introduce tougher sanctions against individuals downloading the odd track for non-commercial purposes, though it would not stop Member State authorities from introducing and applying tougher laws.

The scope of this proposal covers infringements carried out for commercial purposes or which cause significant harm to the rightholder.

File swapping may be considered a copyright infringement depending on the national law in question.

This proposal only covers illegal acts, where authorisation has not been given by the rightholder or where the appropriate remuneration has not been paid for the use of that piece of intellectual property.

Exchanging illegal content over the internet is an illegal act, or an infringement of copyright if it relates to music files.

Although considerable injury to rightholders can be caused by an individual via his/her computer linked to the internet, it is not in the interest of rightholders to spend a lot of time and money in litigation to catch offenders who are simply sharing a few files with a handful of friends.

The proposed Directive aims to strike a fair balance between the interests of rightholders and legitimate users of intellectual property on the one hand and the wider opportunities the internet offers to consumers on the other, by focusing on commercial infringements or those which most damage rightholders' interests. It is *not* aimed at allowing the prosecution of large numbers of individuals using peer to peer (P2P) networks for casual file swapping.

For criminal sanctions to apply, the infringement must be 'serious'. An infringement is considered 'serious' if carried out intentionally and for commercial purposes.

Although the Directive also includes references to proportionality, i.e. for the punishment to fit the crime, it is up to national judges to decide on sentencing on a case by case basis.

Will this Directive mean that people buying a fake watch from a market stall will be held liable for IPR infringement ?

No. The act of buying is not subject to any intellectual property right.

How is this Directive compatible with TRIPS?

All EU Member States are bound by the rules of the TRIPS Agreement.

It is explicitly stated in the Directive that:

- none of its provisions in any way detracts from Member States' obligations under TRIPS;
- it does not set a limit on how far each Member State can go if it wants to go further than either TRIPS or indeed the provisions of the proposed Directive itself.

The proposed Directive goes further than TRIPS, particularly for those infringements which pose the greatest threats to rightholders, namely infringements of IPRs which are either committed for commercial reasons or which cause 'significant harm' to the rightholder.

These "TRIPS plus" elements are:

- a right of representation for collecting societies and trade associations

- a power for the authorities to seize documentary evidence relating to the suspected infringement (as well as the suspect goods themselves)
- an obligation for courts to provide information on the source of infringing goods ('right of information')
- "interlocutory injunctions" (in advance of a decision on the merits of a case) to prevent suspected offenders and also intermediaries from profiting from an infringement
- the seizure of offenders' bank accounts and other assets and profits to ensure payment of due damages
- the recall of infringing goods at the offender's own expense
- the choice for the rightholder of either lump sum damages (up to double normal royalties or licence fees) or compensation for lost profits
- payment of legal costs (and 'other expenses') by the offender where an infringement is established
- the publication of court decisions
- the winding up of companies found guilty of the most serious infringements
- the banning of machines used to produce counterfeit security features for goods covered by industrial property rights (e.g. trade marks).

In which Member States would this proposal make the biggest difference?

The proposed Directive would make a difference in all Member States. Apart from its specific provisions, the proposed Directive is also a **political signal** which will encourage national courts to apply sanctions and remedies more vigorously.

The more national laws within the EU are brought into line with one another, the more 'common ground' that is developed. These similarities will make it easier for cross-border litigation in the future.

The Directive is based on **existing best practice** and that is not the preserve of one single Member State. In addition, provisions in national law are often complex and fall within many different legislative acts, so the Commission is not in a position to give an authoritative overview of what currently applies where. The key point is that once this proposed Directive is implemented, there will be a single legal framework applicable across the EU.

But here are some examples of provisions of the proposed Directive and of Member States in which they already do or do not apply.

The notion of a **lump sum for damages** equivalent to double the licence fee (to cover for administrative expenses such as those caused by research and identification) exists in very few Member States, for example Greece, Ireland, Austria and the UK.

Compensation to the rightholder for loss of profits does not exist in, for example Netherlands, Spain or the UK.

A right for judicial authorities to require disclosure of information on origins of products and distribution networks is already available in for example Belgium, Germany, Denmark, Luxembourg, the Netherlands and the UK.

There is nothing at present in any national law to prevent **professional organisations from initiating court proceedings** on behalf of rightholders, but the proposed Directive will formalise the situation.

The right for the authorities to seize documentary evidence exists in a number of Member States such as Germany, Spain, France and Ireland

Freezing injunctions (blocking of bank accounts and assets) exist in very few EU countries, for example the UK.

What figures are available for the impact of counterfeiting and piracy on the EU economy?

It is by definition very difficult to produce exact figures, as counterfeit and pirated goods fall outside the mainstream economy. But **counterfeiting** is estimated by industry sources to reduce EU GDP by 8 billion euros annually, with individual companies losing a total of between 45 and 65 billion euros.

Annual losses in revenue are estimated at 7.2 % for perfume and toiletries, 5.8 % for pharmaceuticals and 11.5 % for the toy and sports sector. ⁽¹⁾

40% of software in use worldwide is believed to be **pirated**, and 37% in the EU (= loss of revenue of 2.9 billion euros annually). ⁽²⁾

Worldwide, **36% of all music CDs and cassettes** sold are **pirated** (total sales of pirated goods is 5 billion units).

How much has piracy and counterfeiting increased recently?

The industry estimates that software piracy has increased by 3% in 2001 in the EU and is now at 37% of software in use.

The number of optical disks (CDs, DVDs etc) and cassettes seized by EU customs officers rose from 9 million items in 2000 to nearly 40 million items in 2001. (Illegal copies of optical discs and cassettes account for 42% of all items seized).

Why such an increase?

Technology is available which allows large scale perfect copying of software and optical disks and cassettes at extremely low cost.

This represents a very advantageous cost benefit ratio for those looking to get the highest profit with the lowest investment, easy and wide distribution and low risk of detection and penalty.

What is the link between this proposal and the Commission's proposal for a Regulation to strengthen customs' powers to act against counterfeited and pirate goods, presented on 20 January?

Both pieces of legislation cover the enforcement of intellectual property rights. The proposed Regulation on customs powers applies to seizure of suspected infringing goods at the EU's **external** borders (see IP/03/75) whereas the proposed Directive covers goods and services circulating **within** the EU.

In order to coordinate the EU's internal and external policies to enforce IPRs the two proposals have been presented within a short time of each other.

However, the two proposals have to undergo separate adoption procedures due to the different legal bases in the EC Treaty.

How would EU copyright and industrial property rights enforcement under the proposed Directive compare with that in third countries, e.g. the US?

Under US law, sanctions and remedies apply to all infringements including those committed by private persons. It may be tougher on file sharing activities, depending on interpretation by the courts.

All signatories, including EU Member States are bound by the TRIPS Agreement. That agreement is implemented through various provisions in EU and national law.

This proposed Directive is fully compatible with TRIPS and also contains certain elements of added value (see question on TRIPS compatibility above).

Does the Directive cover technology used to gain access to electronic pay services such as satellite TV?

No. The proposed Directive covers the enforcement of intellectual property rights, including that associated with the content used by TV stations, but not the "lock and key" technical conditional access devices pay-TV companies use to protect access to their services.

That technology is covered, irrespective of the intellectual property background, by the Conditional Access Directive (98/84/EC) on the legal protection of conditional access services. The Commission is currently preparing a communication on the implementation of this Directive.

Will this Directive impede the development of the internet, by for example allowing injunctions to be served on service providers?

The proposed Directive would not impede the legitimate development of the Internet. On the contrary, by improving security for all stakeholders, including rightholders, it would encourage the use of the Internet as a genuinely creative medium, as opposed to a tool for piracy, which means in effect the theft from rightholders of not only the financial remuneration on which they depend but also the right to control the distribution of the work they have created.

It must be possible for rightholders to pursue infringements of intellectual property rights regardless of the means by which those rights

are infringed or the form of the infringing material. The proposed Directive aims to strike a fair balance between the interests of rightholders and legitimate users of intellectual property on the one hand and the wider opportunities the internet offers to all its users on the other, by focusing on commercial infringements or those which most damage rightholders' interests.

Where injunctions *are* served on service providers, the injunctions will be limited in scope to preventing infringing acts and not those which are perfectly legal (such as the exchange of non-protected material). Judges will be bound to observe the principle of proportionality i.e. the measures applied will be appropriate to the scale of the infringement and will not go further than is necessary to prevent the infringement in question.

In the case of Internet service providers (ISPs, who provide Internet access services rather than P2P networks *per se* e.g. Yahoo, AOL), it is already established practice in the EU that, once informed of the presence of illegal material, ISPs disconnect illegal web sites (such as those that disseminate child pornography, racist material etc). There is therefore no reason why the same principle cannot apply to IPR infringements.

It is Internet offenders who themselves undermine the profitability and hence development of Internet services providing legal dissemination of IPR-protected material. E-Commerce will only be successful if Internet traders are able to make a legitimate profit on their activities. Internet-based offenders therefore retard the development of business on the Internet.

How would the system of "interlocutory injunctions" in the proposal work?

The proposed Directive envisages the use of interlocutory injunctions (among other measures) by Member States' courts to order intermediaries such as Internet service providers - to desist from participating in infringements of intellectual property rights. This measure applies for infringements 'for commercial purposes or which cause significant harm to the rightholder'. This does not prejudice the provisions on injunctions in Article 8(3) of the Directive on Copyright and Related Rights in the Information Society (2001/29/EC), which is already in force.

Similar measures have been used against peer-to-peer (P2P) networks in the US, most notably Napster. There are now a number of law suits in preparation or litigation, notably by the RIAA (Recording Industry Association of America) in the US regarding similar services such as Kazaa BV, Audiogalaxy, MP3Board, StreamCast Networks, Grokster and Madster.

The proposed Directive would curtail those peer to peer networks which seriously damage rightholders. How do those networks function?

Peer to peer (P2P) networks work by setting up an infrastructure which allows individual users (people at home or in the office connected to the Internet) to locate other users who have files they are interested in and then to download these files from the other user's computer via the Internet. These are often copyright-protected music or video files.

Some file sharing services therefore encourage users to infringe copyright. That is illegal and should be stopped.

Napster maintained a central database of the location of individual computer files (although it did not store the infringing files itself). It was thus possible for the rightholders to demonstrate that Napster had knowledge of the material which was being infringed and for the courts to order Napster to delete references from the database to protected material. In the case of Kazaa *et al*, this is more difficult as the relevant databases are generally stored on user's individual computers (Kazaa merely distributes the software which makes this

possible).

The revenues of P2P networks, such as Napster and Kazaa, do not normally come from direct charges made on users for downloading files. Instead, their services are normally free but users have to pass through web sites which carry advertising.

P2P networks therefore make money in only an indirect way from the content they provide access to (much as free circulation newspapers). Nevertheless it is the file sharing services which attract the users in the first place and are thus essential to the business model.

Does this Directive overprotect intellectual property by taking on board the most repressive legislation found in EU Member States?

It is not right to say that the proposal simply takes on board the most 'repressive' legislation of each EU country. The Directive takes on board the best measures already adopted in various EU countries. Those are not always the most draconian and there are a number of measures currently available in certain EU countries which have not been included.

The proposed Directive seeks to create a **level playing field** for the enforcement of intellectual property rights in different EU countries. It is therefore an essential part of the Directive that enforcement measures are in general strengthened, especially in those countries where the enforcement of intellectual property rights is currently weakest.

However, the proposed Directive also maintains a balance between helping holders of intellectual property defend their rights and protecting users from unfair litigation (so-called rights of **due process**).

What safeguards does the Directive provide against unfair litigation and damage caused to innocent parties as a result ?

The proposal has a number of **safeguard clauses**:

- the proposal restates the general principles of intellectual property rights law, namely that procedures should be fair, not unnecessarily complicated, slow or costly and should not create barriers to 'legitimate trade'
- any penalties applied to offenders should be '**effective, proportionate and deterrent**' i.e. the penalty should fit the crime
- where the Directive allows for seizure of suspect goods for evidence, the company or person whose goods have been seized can ask for a review of the seizure. Furthermore, the judge can make the rightholder pay a refundable guarantee which will be forfeit if the case brought is unfounded
- where the Directive allows for a court to force someone involved in handling infringing goods to reveal who they bought the illegal goods from, this can only be done under certain conditions (e.g. where this would not incriminate the person giving the information, so-called right to avoid **self-incrimination**)
- where the Directive allows for 'interlocutory injunctions' (an injunction in advance of a decision on the merits of the case), the company or person who has been ordered to stop participating in the suspected infringement can ask for a review of the

injunction. Furthermore, the judge can make the rightholder pay a refundable guarantee which will be forfeit if the case brought is unfounded. In this case, the judge can also order the rightholder to compensate the suspected offender who is found innocent for any loss they have suffered as a result of the injunction

- where the Directive allows for various measures following a decision on the merits of a case (e.g. recall, destruction of goods or disposal outside commercial channels), this will not be applied where the offender has acted in **good faith** (i.e. neither intentionally nor through negligence) and can agree a fair settlement with the rightholder whose rights have been infringed
- legal costs are awarded also to the alleged offender, if they are found to be innocent

The full text of the proposed Directive is available at:

http://www.europa.eu.int/comm/internal_market/en/intprop/news/index.htm

(1) Global Anti Counterfeiting Group, 29 June 2000, see <http://www.a-cg.com/archiv18.pdf>

(2) BSA (Business Software Alliance, annual report), see HYPERLINK <http://www.bsa.org/usa/press/newsreleases/2002-06-10.1129.phtml>
<http://www.bsa.org/usa/press/newsreleases/2002-06-10.1129.phtml>

**Council Regulation (EC) No 3295/94
of 22 December 1994**

**laying down measures to prohibit the release for free circulation, export, re-export or entry for a
suspensive procedure of counterfeit and pirated goods**

COUNCIL REGULATION (EC) No 3295/94 of 22 December 1994 laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 113 thereof,

Having regard to the proposal from the Commission (1),

Having regard to the opinion of the European Parliament (2),

Having regard to the opinion of the Economic and Social Committee (3),

Whereas Council Regulation (EEC) No 3842/86 of 1 December 1986 laying down measures to prohibit the release for free circulation of counterfeit goods (4) has been in force since 1 January 1988; whereas conclusions should be drawn from the experience gained during the early years of its implementation with a view to improving the operation of the system it set up;

Whereas the marketing of counterfeit goods and pirated goods causes considerable injury to law-abiding manufacturers and traders and to holders of the copyright or neighbouring rights and misleads consumers; whereas such goods should as far as possible be prevented from being placed on the market and measures should be adopted to that end to deal effectively with this unlawful activity without impeding to freedom of legitimate trade; whereas this objective is also being pursued through efforts being made along the same lines at international level;

Whereas, in so far as counterfeit or pirated goods and similar products are imported from third countries, it is important to prohibit their release for free circulation in the Community or their entry for a suspensive procedure and to set up an appropriate procedure enabling the customs authorities to act to ensure that such a prohibition can be properly enforced;

Whereas action by the customs authorities to prohibit the release for free circulation of counterfeit or pirated goods or their entry for a suspensive procedure should also apply to the export or re-export of such goods from the Community;

Whereas, as regards suspensive procedures and re-export subject to notification, action by the customs authorities will take place only where suspected counterfeit or pirated goods are discovered during a check;

Whereas the Community takes into account the terms of the GATT agreement on trade-related intellectual property issues, including a trade in counterfeit goods, in particular the measures to be taken at the frontier;

Whereas provision should be made that the customs authorities are empowered to take decisions on applications for action to be taken that are submitted to them;

Whereas action by the customs authorities should consist either in suspending the release for free circulation, export or re-export of goods suspected of being counterfeit or pirated or in detaining such goods when they are entered for a suspensive procedure or re-exported subject to notification for as long as is necessary to enable it to be determined whether the goods are actually counterfeit or pirated;

Whereas it is appropriate to authorize the Member States to detain the goods in question for a

certain period even before an application by the right holder has been lodged or approved in order to allow him to lodge an application for action by the customs authorities;

Whereas the competent authority should decide cases submitted to it by reference to the criteria which are used to determine whether goods produced in the Member State concerned infringe intellectual property rights; whereas Member States' provisions on the competence of the judicial authorities and procedures are not affected by this Regulation;

Whereas it is necessary to determine the measures to be applied to the goods in question where it is established that they are counterfeit or pirated; whereas those measures should not only deprive those responsible for trading in such goods of the economic benefits of the transaction and penalize them but also constitute an effective deterrent to further transactions of the same kind;

Whereas in order to avoid serious disruption to the clearing of goods contained in travellers' personal luggage, it is necessary to exclude from the scope of this Regulation goods which may be counterfeit or pirated which are imported from third countries within the limits laid down by Community rules in respect of relief from customs duty;

Whereas uniform application of the common rules laid down by this Regulation must be ensured and to that end a Community procedure must be established enabling measures implementing these rules to be adopted within appropriate periods and mutual assistance between the Member States, of the one part, and between the Member States and the Commission, of the other part, to be strengthened so as to ensure greater effectiveness;

Whereas it will be appropriate to consider the possibility of increasing the number of intellectual property rights covered by this Regulation in the light, inter alia, of the experience gained in its implementation;

Whereas Regulation (EEC) No 3842/86 should therefore be repealed,

HAS ADOPTED THIS REGULATION:

CHAPTER I General

Article 1

1. This Regulation shall lay down:

(a) the conditions under which the customs authorities shall take action where goods suspected of being counterfeit or pirated are:

- entered for free circulation, export or re-export,

- found when checks are made on goods placed under a suspensive procedure within the meaning of Article 84 (1) (a) of Council Regulation (EEC) No 2913/92 of 12 October 1992 establishing the Community Customs Code (5), or re-exported subject to notification; and

(b) the measures which shall be taken by the competent authorities with regard to those goods where it has been established that they are indeed counterfeit or pirated.

2. For the purposes of this Regulation:

(a) 'counterfeit goods' means:

- goods, including the packaging thereof, being without authorization a trade mark which is identical to the trade mark validly registered in respect of the same type of goods, or which cannot be distinguished

in its essential aspects from such trade mark, and which thereby infringes the rights of the holder of the trade mark in question under Community law or the law of the Member State in which the application for action by the customs authorities is made,

- any trade mark symbol (logo, label, sticker, brochure, instructions for use or guarantee document) whether presented separately or not, in the same circumstances as the goods referred to in the first indent,

- packaging materials bearing the trade marks of counterfeit goods, presented separately in the same circumstances as the goods referred to in the first indent;

- (b) 'pirated goods' means goods which are or embody copies made without the consent of the holder of the copyright or neighbouring rights, or of the holder of a design right, whether registered under national law or not, or of a person duly authorized by the holder in the country of production, where the making of those copies infringes the right in question under Community law or the law of the Member State in which the application for action by the customs authorities is made;
- (c) 'holder of a right' means the holder of a trade mark, as referred to in (a), and/or one of the rights referred to in (b), or any other person authorized to use the trade mark and/or rights, or their representative;
- (d) 'declaration for release for free circulation, for export or for re-export' means declarations made in accordance with Article 61 of Regulation (EEC) No 2913/92.

3. Any mould or matrix which is specifically designed or adapted for the manufacture of a counterfeit trade mark or of goods bearing such a trade mark or of pirated goods shall be treated as 'counterfeit or pirated goods', as appropriate, provided that the use of such moulds or matrices infringes the rights of the holder of a right under Community law or the law of the Member State in which the application for action by the customs authorities is made.

4. This Regulation shall not apply to goods which bear a trade mark with the consent of the holder of that trade mark or which are protected by a copyright or neighbouring right or a design right and which have been manufactured with the consent of the holder of the right but are placed in one of the situations referred to in paragraph 1 (a) without the latter's consent.

Nor shall it apply to goods referred to in the first subparagraph which have been manufactured or bear a trade mark under conditions other than those agreed with the holders of the rights in question.

CHAPTER II Prohibition of the release for free circulation, export, re-export or of the placing under a suspensive procedure of counterfeit goods and pirated goods

Article 2

The release for free circulation, export, re-export or placing under a suspensive procedure of goods found to be counterfeit or pirated on completion of the procedure provided for in Article 6 shall be prohibited.

CHAPTER III Application for action by the customs authorities

Article 3

1. In each Member State, the holder of a right may lodge an application in writing with the competent service of the customs authority for action by the customs authorities where the goods are placed in one of the situations referred to in

Article 1

(1) (a).

2. The application referred to in paragraph 1 shall include:

- a sufficiently detailed description of the goods to enable the customs authorities to recognize them,
- proof that the applicant is the holder of the right for the goods in question.

The holder of the right must also provide all other pertinent information available to him to enable the competent customs service to take a decision in full knowledge of the facts without, however, that information being a condition of admissibility of the application.

By way of indication, in the case of pirated goods, that information shall, wherever possible, include:

- the place where the goods are situated or the intended destination,
- particulars identifying the consignment or packages,
- the scheduled date of arrival or departure of the goods,
- the means of transport used,
- the identity of the importer, exporter or holder.

3. The application must specify the length of the period during which the customs authorities are requested to take action.

4. The applicant may be charged a fee to cover the administrative costs incurred in dealing with the application. The fee shall not be disproportionate to the service provided.

5. The competent customs service with which an application drawn up pursuant to paragraph 2 has been lodged shall deal with the application and shall forthwith notify the applicant in writing of its decision.

Where that service grants the application, the service shall specify the period during which the customs authorities shall take action. That period may, upon application by the holder of the right, be extended by the service which took the initial decision.

Any refusal to grant an application shall give the reasons for refusal and may form the subject of an appeal.

6. Member States may require the holder of a right, where his application has been granted, or where action as referred to in Article 1 (1) (a) has been taken pursuant to Article 6 (1), to provide a security:

- to cover any liability on his part vis-à-vis the persons involved in one of the operations referred to in Article 1 (1) (a) where the procedure initiated pursuant to Article 6 (1) is discontinued owing to an act or omission by the holder of the right or where the goods in question are subsequently found not to be counterfeit or pirated,

- to ensure payment of the costs incurred in accordance with this Regulation, in keeping the goods under customs control pursuant to Article 6.

7. The holder of the right shall be obliged to inform the service referred to in paragraph 1 should the right cease to be validly registered or should it expire.

8. Each Member State shall designate the service within the customs authority competent to receive and deal with the applications referred to in this Article.

Article 4

Where, in the course of checks made under one of the customs procedures referred to in Article 1 (1) (a) and before an application by the holder of the right has been lodged or approved, it appears evident to the customs office that goods are counterfeit or pirated, the customs authority may, in accordance with the rules in force in the Member States concerned, notify the holder of the right, where known, of a possible infringement thereof. The customs authority shall be authorized to suspend release of the goods or detain them for a period of three working days to enable the holder of the right to lodge an application for action in accordance with Article 3.

Article 5

The decision granting the application by the holder of the right shall be forwarded immediately to the customs offices of the Member State which are liable to be concerned with the goods alleged in the application to be counterfeit or pirated.

CHAPTER IV Conditions governing action by the customs authorities and by the authority competent to take a substantive decision

Article 6

1. Where a customs office to which the decision granting an application by the holder of a right has been forwarded pursuant to Article 5 is satisfied, after consulting the applicant where necessary, that goods placed in one of the situations referred to in Article 1 (1) (a) correspond to the description of the counterfeit or pirated goods contained in that decision, it shall suspend release of the goods or detain them.

The customs office shall immediately inform the service which dealt with the application in accordance with Article 3. That service or the customs office, shall forthwith inform the declarant and the person who applied for action to be taken. In accordance with national provisions on the protection of personal data, commercial and industrial secrecy and professional and administrative confidentiality, the customs office or the service which dealt with the application shall notify the holder of the right, at his request, of the name and address of the declarant and, if known, of those of the consignee so as to enable the holder of the right to ask the competent authorities to take a substantive decision. The customs office shall afford the applicant and the persons involved in any of the operations referred to in Article 1 (1) (a) the opportunity to inspect the goods whose release has been suspended or which have been detained.

When examining the goods the customs office may take samples in order to expedite the procedure.

2. The law in force in the Member State within the territory of which the goods are placed in one of the situations referred to in Article 1 (1) (a) shall apply as regards:

- (a) referral to the authority competent to take a substantive decision and immediate notification of the customs service or office referred to in paragraph 1 of that referral, unless referral is effected by that service or office;
- (b) reaching the decision to be taken by that authority. In the absence of Community rules in this regard, the criteria to be used in reaching that decision shall be the same as those used to determine whether goods produced in the Member State concerned infringe the rights of the holder. Reasons shall be given for decisions adopted by the competent authority.

Article 7

1. If, within 10 working days of notification of suspension of release or of detention, the customs office referred to in Article 6 (1) has not been informed that the matter has been referred to the authority competent to take a substantive decision on the case in accordance with Article 6 (2) or that the duly empowered authority has adopted interim measures, the goods shall be released, provided that all the customs formalities have been complied with and the detention order has been revoked.

This period may be extended by a maximum of 10 working days in appropriate cases.

2. In the case of goods suspected of infringing design rights, the owner, the importer or the consignee of the goods shall be able to have the goods in question released or their detention revoked against provision of a security, provided that:

- the customs service or office referred to in Article 6 (1) has been informed, within the time limit referred to in paragraph 1, that the matter has been referred to the authority competent to take a substantive decision referred to in said paragraph 1,
- on expiry of the time limit, the authority empowered for this purpose has not imposed interim measures, and
- all the customs formalities have been completed.

The security must be sufficient to protect the interests of the holder of the right. Payment of the security shall be without prejudice to the other remedies open to the holder of the right. Where the matter has been referred to the authority competent to take a substantive decision other than on the initiative of the holder of the right, the security shall be released if that person does not exercise his right to institute legal proceedings within 20 working days of the date on which he is notified of the suspension of release or detention. Where the second subparagraph of paragraph 1 applies, this period may be extended to a maximum of 30 working days.

3. The conditions governing storage of the goods during the period of suspension of release or detention shall be determined by each Member State.

CHAPTER V Provisions applicable to goods found to be counterfeit or pirated goods

Article 8

1. Without prejudice to the other rights of action open to the holder of a trade mark which is

found to have been counterfeited or the holder of a copyright or neighbouring right or of a design right which is found to have been pirated, Member States shall adopt the measures necessary to allow the competent authorities:

- (a) as a general rule, and in accordance with the relevant provisions of national law, to destroy goods found to be counterfeit or pirated, or dispose of them outside commercial channels in such a way as to preclude injury to the holder of the right, without compensation of any sort and at no cost to the exchequer;
- (b) to take, in respect of such goods, any other measures which effectively deprive the persons concerned of the economic benefits of the transaction.

The following in particular shall not be regarded as having such effect:

- re-exporting the counterfeit or pirated goods in the unaltered state,
- other than in exceptional cases, simply removing the trade marks which have been affixed to the counterfeit goods without authorization,
- placing the goods under a different customs procedure.

2. The counterfeit or pirated goods may be handed over to the exchequer. In that event, paragraph 1 (a) shall apply.

3. In addition to the information given pursuant to the second subparagraph of Article 6 (1) and under the conditions laid down therein, the customs office or the competent service shall inform the holder of the right, upon request, of the names and addresses of the consignor, of the importer or exporter and of the manufacturer of the goods found to be counterfeit or pirated and of the quantity of the goods in question.

CHAPTER VI Final provisions

Article 9

1. Save as provided by the law of the Member State in which the application is made, the acceptance of an application drawn up in accordance with Article 3 (2) shall not entitle the holder of a right to compensation where counterfeit or pirated goods are not detected by a customs office and are released or no action is taken to detain them in accordance with Article 6 (1).

2. Save as provided by the law of the Member State in which the application is made, exercise by a customs office or by another duly empowered authority of the powers conferred on them in regard to combating counterfeit or pirated goods shall not render them liable to the persons involved in the operations referred to in Article 1 (1) (a) or Article 4, in the event of their suffering loss or damage as a result of their action.

3. The civil liability of the holder of a right shall be governed by the law of the Member State in which the goods in question were placed in one of the situations referred to in Article 1 (1) (a).

Article 10

This Regulation shall not apply to goods of a non-commercial nature contained in travellers' personal

luggage within the limits laid down in respect of relief from customs duty.

Article 11

Moreover, each Member State shall introduce penalties to apply in the event of infringements of Article 2. Such penalties must be sufficiently severe to encourage compliance with the relevant provisions.

Article 12

The provisions necessary for the application of this Regulation shall be adopted in accordance with the procedure laid down in Article 13 (3) and (4).

Article 13

1. The Commission shall be assisted by the Committee set up under Article 247 of Regulation (EEC) No 2913/92.
2. The Committee shall examine any matter concerning implementation of this Regulation which its chairman may raise, either on his own initiative or at the request of the representative of a Member State.
3. The representative of the Commission shall submit to the Committee a draft of the measures to be taken. The Committee shall deliver its opinion on the draft within a time limit which the chairman may lay down according to the urgency of the measures to be taken. The opinion shall be delivered by the majority laid down in Article 148 (2) of the Treaty in the case of decisions which the Council is required to adopt on a proposal from the Commission. The votes of the representatives of the Member States within the Committee shall be weighted in the manner set out in that Article. The chairman shall not vote.
4. The Commission shall adopt measures which shall apply immediately. However, if the measures are not in accordance with the opinion of the Committee, they shall be communicated by the Commission to the Council forthwith. In the event:
 - the Commission shall defer application of the measures which it has decided for not more than three months from the date of their communication,
 - the Council, acting by a qualified majority, may take a different decision within the time limit provided for in the first indent.

Article 14

Member States shall communicate all relevant information on the application of this Regulation to the Commission.

The Commission shall communicate that information to the other Member States.

For the purpose of the application of this Regulation, the provisions of Regulation (EEC) No 1468/81 of 19 May 1981 on mutual assistance between the administrative authorities of the Member States and cooperation between the latter and the Commission to ensure the correct application of the law on customs or agricultural matters (6) shall apply *mutatis mutandis*.

The details of the information procedure shall be drawn up in the framework of the implementing provisions in accordance with Article 13 (2), (3) and (4).

Article 15

Within two years of the entry into force of this Regulation, the Commission shall, on the basis of the information referred to in Article 14, report to the European Parliament and the Council on the operation of the system particularly with regard to the economic and social consequences of counterfeiting and shall propose any amendments or additions required, within a period of two years from the implementation of this Regulation.

Article 16

Regulation (EEC) No 3842/86 shall be repealed as from the date of implementation of this Regulation.

Article 17

This Regulation shall enter into force on the third day following its publication in the Official Journal of the European Communities.

It shall apply from 1 July 1995.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 22 December 1994.

For the Council

The President

H. SEEHOFER

- (1) OJ No C 238, 2. 9. 1993, p. 9.
- (2) OJ No C 61, 28. 2. 1994.
- (3) OJ No C 52, 19. 2. 1994, p. 37.
- (4) OJ No L 357, 18. 12. 1986, p. 1.
- (5) OJ No L 302, 19. 10. 1992, p. 1.
- (6) OJ No L 144, 2. 6. 1981, p. 1. Regulation as last amended by Regulation (EEC) No 945/87 (OJ No L 90, 2. 4. 1987, p. 3).

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AUTHOR Council
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Amended by... 32003R0806..... Replacement ART 13 from 05/06/2003
Repealed by... 32003R1383.....

SUBSPREP

Amendment proposed by 51998PC0025.....
Amendment proposed by 52001PC0789(03).....
Amendment proposed by 52003PC0020..... Repeal

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SUB

Free movement of goods ; Industrial and commercial property

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Proposal Commission;Com 93/0329 Final
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**Commission Regulation (EC) No 1367/95
of 16 June 1995**

**laying down provisions for the implementation of Council Regulation (EC) No 3295/94 laying down
measures to prohibit the release for free circulation, export, re-export or entry for a suspensive
procedure of counterfeit and pirated goods**

COMMISSION REGULATION (EC) No 1367/95 of 16 June 1995 laying down provisions for the implementation of Council Regulation (EC) No 3295/94 laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 3295/94 of 22 December 1994 laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods, and in particular Articles 12, 13 and 14 thereof (1),

Whereas Regulation (EC) No 3295/94 introduced common rules with a view to prohibiting the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods and dealing effectively with the illegal marketing of such goods without impeding the freedom of legitimate trade;

Whereas the nature of the proof of ownership of intellectual property required by the second indent of the first subparagraph of Article 3 (2) of Regulation (EC) No 3295/94 should be established;

Whereas Article 14 of Regulation (EC) No 3295/94 provides that Member States are to communicate to the Commission all relevant information for applying that Regulation and that the Commission is to communicate that information to the other Member States; whereas the procedure for exchanging that information should be laid down;

Whereas Commission Regulation (EEC) No 3077/87 (2) should be repealed;

Whereas the measures provided for in this Regulation are in accordance with the opinion of the Customs Code Committee,

HAS ADOPTED THIS REGULATION:

Article 1

For the purposes of Article 1 (2) (c) of Regulation (EC) No 3295/94, hereinafter referred to as 'the basic Regulation' the holder of a right or any other person authorized to use the right may be represented by a natural or legal person; such a person includes a collecting society which has as its sole or principal purpose the management or administration of copyrights or neighbouring rights.

Article 2

The proof that the applicant holds one of the rights referred to in points (a) and (b) of Article 1 (2) of the basic Regulation, which must be submitted when applying for action in accordance with the second indent of the first subparagraph of Article 3 (2) of that Regulation, shall be as follows:

- (a) where the holder of the right applies himself:
- in the case of a right that is registered or for which an application has been lodged (trademark or design right): proof of registration with the relevant office or lodging of the application,
 - in the case of a copyright, neighbouring rights or design right that is unregistered or for which an application has not been lodged: any proof of authorship or of his status as original holder;
- (b) where the application is made by any other person authorized to use one of the rights referred to in points (a) and (b) of Article 1 (2) of the basic Regulation in addition to the proof required under (a) hereof: the document by virtue of which the person is authorized to use the right in question;
- (c) where a representative of the holder or of any other person authorized to use one of the rights referred to in points (a) and (b) of Article 1 (2) of the basic Regulation applies: in addition to the proof required under (a) and (b) hereof, proof of authorization to act.

Article 3

The pertinent information referred to in the second subparagraph of Article 3 (2) of the basic Regulation shall include particulars of the goods, notably their value and their packaging, plus any information that could help distinguish them from goods for which there is a protected right. Under the terms of the second subparagraph of Article 3 (2), this information should be as detailed as possible to enable the customs authorities, using risk analysis, to identify suspect consignments accurately and without excessive effort.

Article 4

If an application is lodged in accordance with Article 4 of the basic Regulation before expiry of the time-limit of three days, the time-limits referred to in Article 7 of the Regulation shall be counted from the day of receipt of the request for action.

If the customs authority suspends release of the goods or detains them in accordance with Article 4 of the basic Regulation, it shall forthwith inform the declarant.

Article 5

1. Each Member State shall, at the earliest opportunity, send the Commission details of:
 - (a) the laws, regulations or administrative provisions which it adopts in implementation of this Regulation. It shall likewise inform the Commission of any provisions of its national law which preclude informing the holder as provided for in the second subparagraph of Article 6 (1) and in Article 8 (3) of the basic Regulation;
 - (b) the competent customs department responsible for receiving and handling the holder's written application, referred to in Article 3 (8) of the basic Regulation.
2. To enable the Commission to monitor the effective application of the procedure laid down by

the basic Regulation and draw up, in due course, the report referred to in Article 15 thereof, each Member State shall send the Commission:

- (a) at the end of each calendar year, a list of all the written applications under Article 3 (1) of the basic Regulation, together with the name and address of the holder, a brief description of the goods and, where relevant, the trademark, and the action taken in response to the application;
- (b) at the end of each quarter, a list of specific cases in which goods have been detained or their release suspended. The information provided on each case must include:
 - the name and address of the holder of the right and a brief description of the goods and, where relevant, the trademark, and
 - the customs situation, country of consignment or destination, description, quantity and declared value of the goods the release of which has been suspended or which have been detained, and the date of such suspension or detention.

3. The Commission shall, in an appropriate manner, communicate to all Member States such information as it receives pursuant to this Article. Details of cases provided for in point (b) of paragraph 2 shall be sent quarterly to the Member States by the Commission.

4. Details communicated pursuant to paragraphs 1, 2 and 3 may be used only for the purposes established by the basic Regulation.

Article 6

Regulation (EEC) No 3077/87 is hereby repealed with effect from 1 July 1995.

Article 7

This Regulation shall enter into force on the third day following its publication in the Official Journal of the European Communities.

It shall apply from 1 July 1995.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 16 June 1995.

For the Commission Mario MONTI Member of the Commission

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**Council Regulation (EC) No 241/1999
of 25 January 1999**

amending Regulation (EC) No 3295/94 laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods

COUNCIL REGULATION (EC) No 241/1999 of 25 January 1999 amending Regulation (EC) No 3295/94 laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 113 thereof,

Having regard to the proposal from the Commission (1),

Having regard to the opinion of the European Parliament (2),

Having regard to the opinion of the Economic and Social Committee (3),

- (1) Whereas, pursuant to Article 15 of Regulation (EC) No 3295/94 (4), conclusions should be drawn from the experience gained during the early years of its implementation with a view to improving the operation of the system it set up;
- (2) Whereas the marketing of goods infringing patents or supplementary protection certificates for medicinal products as provided for in Council Regulation (EEC) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products (5) or supplementary protection certificates for plant protection products, as provided for in 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 (6) causes serious injury to their holders and constitutes an unfair and unlawful business activity; whereas such goods should as far as possible be prevented from being placed on the market and measures should be adopted to that end to deal effectively with this unlawful activity without impeding the freedom of legitimate trade; whereas this objective is also being pursued through efforts being made along the same lines at international level;
- (3) Whereas, in order to guarantee the integrity of the Community's external frontier, the customs authorities should be permitted to take action against goods infringing certain intellectual property rights and associated goods whatever their customs status; whereas the release for free circulation in the Community, entry for a suspensive procedure, re-export or placing in a free zone or free warehouse of such goods should therefore be prohibited; whereas moreover the customs authorities should be authorised to take action as soon as the said goods are brought into the Community;
- (4) Whereas, as regards suspensive procedures, free zones and free warehouses, re-export subject to notification and temporary storage, the customs authorities will act only where goods suspected to be goods infringing certain intellectual property rights are discovered during a check;
- (5) Whereas Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trademark (7) has established a system whereby right holders can, by means of a single procedure, obtain Community trade marks enjoying uniform protection and producing their effects throughout the Community;
- (6) Whereas to enhance the Community dimension of the said trade mark the administrative procedure for obtaining customs protection should be simplified;
- (7) Whereas the holders of such trade marks should have access to a system whereby the granting of a single application for action by the competent authority in one Member State can bind one

or more other Member States as well; whereas developments in the area of electronic data interchange in administrative procedures must be taken into consideration, in particular as far as the transmission of decisions and information is concerned;

- (8) Whereas a single period of validity should be set in the interests of the uniform application of such decisions in the Member States concerned,

HAS ADOPTED THIS REGULATION:

Article 1

Regulation (EC) No 3295/94 is hereby amended as follows:

1. the title shall be replaced by the following:

'Council Regulation (EC) No 3295/94 of 22 December 1994 laying down measures concerning the entry into the Community and the export and re-export from the Community of goods infringing certain intellectual property rights`;

2. Article 1 shall be replaced by the following:

'Article 1

1. This Regulation lays down:

- (a) the conditions under which the customs authorities shall take action where goods suspected of being goods referred to in paragraph 2(a) are:

- entered for free circulation, export or re-export, in accordance with Article 61 of Council Regulation (EEC) No 2913/92 of 12 October 1992 establishing the Community Customs Code (*),
- found in the course of checks on goods under customs supervision within the meaning of Article 37 of Council Regulation (EEC) No 2913/92, placed under a suspensive procedure within the meaning of Article 84(1)(a) of that Regulation, re-exported subject to notification or placed in a free zone or free warehouse within the meaning of Article 166 thereof;

and

- (b) the measures which shall be taken by the competent authorities with regard to those goods where it has been established that they are indeed goods referred to in paragraph 2(a).

2. For the purposes of this Regulation:

- (a) "goods infringing an intellectual property right" means

- "counterfeit goods", namely:
 - goods, including the packaging thereof, bearing without authorisation a trade mark which is identical to the trade mark validly registered in respect of the same type of goods, or which cannot be distinguished in its essential aspects from such trade mark, and which thereby infringes the rights of the holder of the trade mark in question under Community law or the law of the Member State where the application for action by the customs authorities is made,
 - any trade mark symbol (logo, label, sticker, brochure, instructions for use, guarantee document) whether presented separately or not, in the same circumstances as the goods referred to in the

first indent,

- packaging materials bearing the trade marks of counterfeit goods, presented separately in the same circumstances as the goods referred to in the first indent;
 - "pirated goods", namely: goods which are or embody copies made without the consent of the holder of the copyright or neighbouring rights, or of the holder of a design right, whether registered under national law or not, or of a person duly authorised by the holder in the country of production, where the making of those copies infringes the right in question under Community law or the law of the Member State in which the application for action by the customs authorities is made;
 - goods infringing, in the Member State in which the application for action by the customs authorities is made, a patent under the law of that Member State or a supplementary protection certificate as provided for by Council Regulation (EEC) No 1768/92 (***) or Regulation (EC) No 1610/96 of the European Parliament and of the Council (****);
- (b) "holder of a right" means the holder of a trade mark, a patent or a certificate and/or one of the rights referred to in (a), or any other person authorised to use that trademark, patent, certificate and/or right, or a representative thereof;
- (c) "Community trademark" means the trademark defined in Article 1 of Council Regulation (EC) No 40/94 (****);
- (d) "certificate" means the supplementary protection certificate provided for by Regulation (EEC) No 1768/92 or by Regulation (EC) No 1610/96.

3. Any mould or matrix which is specifically designed or adapted for the manufacture of a counterfeit trade mark or of goods bearing such a trade mark, for the manufacture of goods infringing a patent or a certificate or for the manufacture of pirated goods shall be treated as goods referred to in paragraph 2(a), provided that the use of such moulds or matrices infringes the rights of the holder of the right in question under Community law or the law of the Member State in which the application for action by the customs authorities is made.

4. This Regulation shall not apply to goods which bear a trade mark with the consent of the holder of that trade mark or which are protected by a patent or a certificate, by a copyright or neighbouring right or by a design right and which have been manufactured with the consent of the holder of the right but are placed in one of the situations referred to in paragraph 1(a) without the latter's consent.

It shall similarly not apply to goods referred to in the first subparagraph which have been manufactured or bear a trade mark under conditions other than those agreed with the holder of the rights in question.

(*) OJ L 302, 19. 10. 1992, p. 1.

(**) OJ L 182, 2. 7. 1992, p. 1.

(***) OJ L 198, 8. 8. 1996, p. 30.

(****) OJ L 11, 4. 1. 1994, p. 1.`;

3. the title of Chapter II shall be replaced by the following:

'Prohibition of the entry, release for free circulation, export, re-export, placing under a suspensive procedure, or placing in a free zone or free warehouse, of goods infringing certain intellectual property rights`;

4. Article 2 shall be replaced by the following:

'Article 2

The entry into the Community, release for free circulation, export, re-export, placing under a suspensive procedure or placing in a free zone or free warehouse of goods found to be goods referred to in Article 1(2)(a) on completion of the procedure provided for in Article 6 shall be prohibited.`;

5. Article 3 shall be amended as follows:

(a) the following two subparagraphs shall be added to paragraph 1:

'Where the applicant holds a Community trade mark, the application may seek action not only by the customs authorities of the Member State in which the application is lodged but by the customs authorities of one or more other Member States as well.

Where electronic data interchange systems exist, Member States may provide that the application for customs action can be made by using a data processing technique.`;

(b) the third subparagraph of paragraph 2 shall be replaced by the following:

'By way of indication, in the case of pirated goods or of goods infringing patents or certificates, that information shall, wherever possible, include:``;

(c) paragraphs 3 and 4 shall be replaced by the following:

'3. Save where the second subparagraph of paragraph 1 is applied, the application must specify the length of the period during which the customs authorities are requested to take action.

Applications under the second subparagraph of paragraph 1 shall indicate the Member State or States in which the customs authorities are requested to take action.

4. The applicant may be charged a fee to cover the administrative costs incurred in dealing with the application.

The applicant or his representative may also be charged a fee in each of the Member States where the decision granting the application is effective, to cover the costs incurred in implementing the said decision.

Such fees shall not be disproportionate to the service provided.`;

(d) the following third subparagraph shall be inserted in paragraph 5:

'Where an application is submitted under the second subparagraph of paragraph 1 the said period shall be set at one year, but may be extended for a further year, at the right-holder's request, by the service which took the original decision`;

(e) in the first indent of paragraph 6, the words 'counterfeit or pirated goods` shall be replaced by the words 'goods referred to in Article 1(2)(a)`;

(f) the following text shall be added as the last subparagraph of paragraph 6:

'Where an application is submitted under the second subparagraph of paragraph 1, the security shall be provided in each of the Member States in which it is required and the decision granting the application is effective.`;

(g) paragraph 7 shall be amended as follows:

'7. The holder of the right is required to inform the service referred to in paragraph 1 and, where appropriate, the service or services referred to in the second subparagraph of Article 5(2), if

his right should happen no longer to be validly registered or to have expired.`;

(h) the following paragraph 9 shall be added:

'9. Paragraphs 1 to 8 shall apply mutatis mutandis to the extension of the decision on the original application.`;

6. in Article 4, the words 'counterfeit or pirated goods` shall be replaced by the words 'goods referred to in Article 1(2)(a)`;

7. Article 5 shall be replaced by the following:

'Article 5

1. The decision granting the application by the holder of the right shall be forwarded immediately to the customs offices of the Member State which are liable to be concerned with the goods alleged in the application to be goods referred to in Article 1(2)(a).

2. Where an application is submitted under the second subparagraph of Article 3(1), the first indent of Article 250 of Regulation (EEC) No 2913/92 shall apply mutatis mutandis to the decision granting the said application and the decisions extending or repealing it.

When the decision granting the said application has been taken, it shall be up to the applicant to forward that decision together, where appropriate, with any other useful information and any translations to the customs-authority service referred to in the first subparagraph of Article 3(1) in the Member State or States where the applicant has requested that action be taken. However, with the agreement of the applicant, the information and translations may be forwarded directly by the customs-authority service which took the decision. The applicant shall provide additional information as deemed necessary for the execution of the decision, at the request of the customs authorities of the other Member States concerned.

The period referred to in the third subparagraph of Article 3(5) shall run from the date on which the decision granting the application was taken. The said decision shall not enter into force in the Member State or States to which it is addressed until the submission referred to in the second subparagraph has been made and, where appropriate, until the fee referred to in the second subparagraph of Article 3(4) has been paid and the security referred to in Article 3(6) has been provided. However, the period of validity of the said decision may not, in any circumstances, exceed the period of one year from the date of adoption of the decision granting the original application.

The said decision shall then be forwarded immediately to the national customs offices liable to be concerned with the alleged counterfeit goods to which it relates.

This paragraph shall apply mutatis mutandis to any decision to extend the original decision.`;

8. in the first subparagraph of Article 6(1), the words 'counterfeit or pirated goods` shall be replaced by the words 'goods referred to in Article 1(2)(a)`;

9. Article 7(2) shall be replaced by the following:

'2. In the case of goods suspected of infringing patents, certificates or design rights, the owner, importer or consignee of the goods shall be able to have the goods in question released or their detention revoked against provision of a security, provided that:

(a) the customs service or office referred to in Article 6(1) has been informed, within the time limit referred to in paragraph 1 of this Article, that the matter has been referred to the authority

competent to take a substantive decision referred to in the aforesaid paragraph 1;

- (b) on expiry of the time limit, the authority empowered for this purpose has not imposed interim measures; and
- (c) all the customs formalities have been completed.

The security must be sufficient to protect the interests of the holder of the right. Provision of the security shall be without prejudice to the other remedies open to the holder of the right. Where the matter has been referred to the authority competent to take a substantive decision other than on the initiative of the holder of the patent, certificate or design right, the security shall be released if that person does not exercise his right to institute legal proceedings within 20 working days of the date on which he is notified of the suspension of release or detention. Where the second subparagraph of paragraph 1 applies, this period may be extended to a maximum of 30 working days.;

10. the title of Chapter V shall be replaced by the following:

'Provisions applicable to goods found to be goods infringing an intellectual property right';

11. Article 8 shall be replaced by the following:

'Article 8

1. Without prejudice to the other forms of legal recourse open to the right-holder, Member States shall adopt the measures necessary to allow the competent authorities:

- (a) as a general rule, and in accordance with the relevant provisions of national law, to destroy goods found to be goods referred to in Article 1(2)(a), or dispose of them outside the channels of commerce in such a way as to preclude injury to the holder of the right, without compensation of any sort and without cost to the Exchequer;
- (b) to take, in respect of such goods, any other measures having the effect of effectively depriving the persons concerned of the economic benefits of the transaction.

Save in exceptional cases, simply removing the trademarks which have been affixed to the counterfeit goods without authorisation shall not be regarded as having such effect.

2. The goods referred to in Article 1(2)(a) may be handed over to the Exchequer. In that case, paragraph 1(a) shall apply.

3. In addition to the information given pursuant to the second subparagraph of Article 6(1) and under the conditions laid down therein, the customs office or the competent service shall inform the holder of the right, upon request, of the names and addresses of the consignor, of the importer or exporter and of the manufacturer of the goods found to be goods referred to in Article 1(2)(a) and of the quantity of the goods in question.;

12. in Article 9, paragraphs 1 and 2 shall be replaced by the following:

'1. Save as provided by the law of the Member State in which an application in accordance with Article 3(2) is lodged or, in the case of an application under the second subparagraph of Article 3(1), by the law of the Member State in which goods referred to in Article 1(2)(a) escape detection by a customs office, the acceptance of an application shall not entitle the holder of a right to compensation where such goods are not detected by a customs office and are released or no action is taken to detain them in accordance with Article 6(1).

2. Save as provided by the law of the Member State in which the application is made or, in the case of an application under the second subparagraph of Article 3(1), by the law of the Member State in which loss or damage is incurred, exercise by a customs office or by another duly empowered authority of the powers conferred on them in regard to taking measures against goods referred to in Article 1(2)(a) shall not render them liable towards the persons involved in the operations referred to in Article 1(1)(a) or Article 4, in the event of their suffering loss or damage as a result of their action.`;

13. in Article 11, the second sentence shall be replaced by the following:

'Such penalties shall be effective and proportionate and constitute an effective deterrent.`

Article 2

This Regulation shall enter into force on the day following its publication in the Official Journal of the European Communities.

This Regulation shall enter into force on 1 July 1999.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 25 January 1999.

For the Council

The President

J. FISCHER

- (1) OJ C 108, 7. 4. 1998, p. 63.
- (2) OJ C 210, 6. 7. 1998, p. 125.
- (3) OJ C 284, 14. 9. 1998, p. 3.
- (4) OJ L 341, 30. 12. 1994, p. 8.
- (5) OJ L 182, 2. 7. 1992, p. 1. Regulation as amended by the 1994 Act of Accession.
- (6) OJ L 198, 8. 8. 1996, p. 30.
- (7) OJ L 11, 14. 1. 1994, p. 1. Regulation as amended by Regulation (EC) No 3288/94 (OJ L 349, 31. 12. 1994, p. 83).

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SUB	Free movement of goods ; Industrial and commercial property
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PREPWORK	PR;COMM;CO 98/0025 FIN PACC;;JO C 210/98 P 125 AV;CES;JO C 284/98 P 3
MISCINF	ACC 92018
DATES	of document: 25/01/1999 of effect: 03/02/1999; Entry into force Date pub. + 1 See Art 2 of effect: 01/07/1999; Implementation See Art 2 end of validity: 30/06/2004; See 31994R3295

**Commission Regulation (EC) No 2549/1999
of 2 December 1999**

amending Regulation (EC) No 1367/95 laying down provisions for the implementation of Council Regulation (EC) No 3295/94 laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods

COMMISSION REGULATION (EC) No 2549/1999

of 2 December 1999

amending Regulation (EC) No 1367/95 laying down provisions for the implementation of Council Regulation (EC) No 3295/94 laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 3295/94 of 22 December 1994 laying down measures concerning the entry into the Community and the export and re-export from the Community of goods infringing certain intellectual property rights(1), as amended by Regulation (EC) No 241/1999(2),

Whereas:

- (1) In order to ensure a uniform form for applications for action related to a Community trade mark as defined in Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark(3), as amended by Regulation (EC) No 3288/94(4), it is necessary to determine the conditions of establishment, issue and use, required in order for the form to be easily recognised and used throughout the Community. It is appropriate for this purpose to establish the model to which that form must conform.
- (2) The form should be drawn up in one of the official languages of the Community.
- (3) Commission Regulation (EC) No 1367/95(5) should be amended accordingly.
- (4) The measures provided for in this Regulation are in accordance with the opinion of the Customs Code Committee established by Article 247 of Council Regulation (EEC) No 2913/92 of 12 October 1992 establishing the Community Customs Code(6), as last amended by Regulation (EC) No 955/1999 of the European Parliament and of the Council(7),

HAS ADOPTED THIS REGULATION:

Article 1

Regulation (EC) No 1367/95 is amended as follows:

1. The title is replaced by the following:

"Commission Regulation (EC) No 1367/95 of 16 June 1995 laying down provisions for the implementation of Council Regulation (EC) No 3295/94 laying down measures concerning the entry into the Community and the export and re-export from the Community of goods infringing certain intellectual property rights."

2. In Article 1, "For the purposes of Article 1(2)(c) of Regulation (EC) No 3295/94" is replaced by "For the purposes of Article 1(2)(b) of Regulation (EC) No 3295/94".

3. Article 2 is replaced by the following:

"Article 2

The evidence that the applicant holds an intellectual property right referred to in Article 1(2)(a) of the basic Regulation, which must be submitted when applying for action in accordance with the second indent of the first subparagraph of Article 3(2) of that Regulation, shall be as follows:

- (a) where the holder of the right makes himself the application:
- in the case of a right that is registered or for which an application has been lodged, proof of registration with the relevant office or lodging of the application,
 - in the case of a copyright, neighbouring right or design right which is not registered or for which an application has not been lodged, any evidence of authorship or of his status as original holder;
- (b) where the application is made by any other person authorised to use one of the rights referred to in Article 1(2)(a) of the basic Regulation, in addition to the proof required under point (a) of this Article, the document by virtue of which the person is authorised to use the right in question;
- (c) where a representative of the holder or of any other person authorised to use one of the rights referred to in Article 1(2)(a) of the basic Regulation applies, in addition to the proof required under points (a) and (b) of this Article, proof of authorisation to act."

4. The following Article 2a is inserted:

"Article 2a

1. The form on which the application for action referred to in Article 3(1), second subparagraph, of the basic Regulation, as well as the Decision granting the application referred to in Article 3(5) of the basic Regulation, shall conform to the specimen shown in the Annex to this Regulation.

Where additional pages are to be used, as referred to in the second subparagraph of paragraph 8, they shall be considered to be an integral part of the form.

The form shall be used in accordance with the provisions of the basic Regulation and of this implementing Regulation.

2. (a) the form shall be printed on white paper, without mechanical pulp, dressed for writing purposes and weighing not less than 55 g/m²;

(b) the forms shall measure 210 millimetres x 297 millimetres, with a maximum tolerance as to length of 5 mm less and 8 mm more.

3. Without prejudice to the implementation of the provisions set out in Article 3(1), third subparagraph, of the basic Regulation, Member States shall print or have printed forms which bear an indication of the name and address of the printer or a sign allowing its identification.

4. Forms shall be printed and filled out in an official language of the Community designated by the competent authorities of the Member State in which the application for action is submitted.

5. Except in the case where the form is made available to the applicant in an electronic format, at one or more publicly available sites directly accessible via a computer, the application for action form shall be provided, on request, by the appropriate service of the customs authority referred to in Article 3(1) of the basic Regulation.

6. Forms shall be filled in by mechanical means or legibly by hand; in the latter case, they shall be filled in using ink and in block capitals. Whatever the process used, forms shall not contain erasures, overwritten words or other alterations.

Should the form be completed by computer, it may subsequently be reproduced by private printing methods.

7. The form shall be composed of two copies:

- one copy, marked number 1, for the Member State to which the application for action is submitted, and
- one copy, marked number 2, for the holder of the Community trade mark.

8. The applicant shall complete boxes 1 to 9 of the form, sign both copies and attach to it the justification and other relevant information referred to in Article 3(2) of the basic Regulation.

Should the space in box 4 of the form be insufficient, the applicant may provide, on additional pages, further details to assist in the identification of the goods. In this case, the applicant shall indicate the number of additional pages used in the space provided in box 4 of the form.

9. The duly completed and signed form, accompanied by a number of extracts corresponding to the number of Member States indicated in box 8 of the form, as well as the evidence and information referred to in paragraph 8, shall be submitted to the appropriate service of the customs authority referred to in Article 3(1) of the basic Regulation.

10. When the appropriate service of the customs authority referred to in Article 3(1) of the basic Regulation approves an application for action, it shall indicate the final date of validity of the decision and affix its signature and stamp. The copy for the holder of the Community trade mark as well as the validated extracts shall then be returned to the applicant.

When the request for assistance is rejected by the appropriate service of the customs authority referred to in Article 3(1) of the basic Regulation, it shall indicate not only the reasons for the refusal, but also the contact details of the authority to which an appeal can be made and shall affix its stamp and signature. The copy for the holder of the Community trade mark shall then be returned to the interested party.

In all cases, the copy of the form for the Member State in which the application for action is submitted shall be retained and preserved in its files for at least two years from the date of issue.

11. Only in cases where the extract of a decision granting the application is addressed to the Member State(s) where the applicant has requested that action be taken in accordance with Article 5(2), second subparagraph, second sentence, the Member State which receives this extract shall complete without delay the part 'acknowledgement of receipt' of the form by indicating the date of receipt, and return a photocopy of this extract to the relevant authority indicated in box 3."

5. In Article 5, the following paragraph 5 shall be added:

"5. The Commission shall publish in the 'C' series of the Official Journal of the European Communities the list of the services within the customs authority which are referred to in Article 3(8) of the basic Regulation."

6. The text in the Annex to this Regulation is added as an Annex.

Article 2

This Regulation shall enter into force on the seventh day following that of its publication in the Official Journal of the European Communities.

It shall apply as from 1 July 1999.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 2 December 1999.

For the Commission

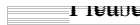
Frederik BOLKESTEIN

Member of the Commission

- (1) OJ L 341, 30.12.1994, p. 8.
- (2) OJ L 27, 2.2.1999, p. 1.
- (3) OJ L 11, 14.1.1994, p. 1.
- (4) OJ L 349, 31.12.1994, p. 83.
- (5) OJ L 133, 17.6.1995, p. 2.
- (6) OJ L 302, 19.10.1992, p. 1.
- (7) OJ L 119, 7.5.1999, p. 1.

ANNEX

"ANNEX



DOCNUM 31999R2549
AUTHOR European Commission

FORM	Regulation
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PUBREF	Official Journal L 308 , 03/12/1999 P. 0016 - 0022
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DATES	of document: 02/12/1999 of effect: 01/07/1999; Implementation See Art 2 of effect: 10/12/1999; Entry into force Date pub. + 7 See Art 2 end of validity: 30/06/2004; See 31995R1367

**Commission Regulation (EC) No 772/2004
of 27 April 2004
on the application of Article 81(3) of the Treaty to categories of technology transfer agreements
(Text with EEA relevance)**

Commission Regulation (EC) No 772/2004

of 27 April 2004

on the application of Article 81(3) of the Treaty to categories of technology transfer agreements

(Text with EEA relevance)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation No 19/65/EEC of 2 March 1965 on application of Article 85(3) of the Treaty to certain categories of agreements and concerted practices(1), and in particular Article 1 thereof,

Having published a draft of this Regulation(2),

After consulting the Advisory Committee on Restrictive Practices and Dominant Positions,

Whereas:

- (1) Regulation No 19/65/EEC empowers the Commission to apply Article 81(3) of the Treaty by Regulation to certain categories of technology transfer agreements and corresponding concerted practices to which only two undertakings are party which fall within Article 81(1).
- (2) Pursuant to Regulation No 19/65/EEC, the Commission has, in particular, adopted Regulation (EC) No 240/96 of 31 January 1996 on the application of Article 85(3) of the Treaty to certain categories of technology transfer agreements(3).
- (3) On 20 December 2001 the Commission published an evaluation report on the transfer of technology [block exemption](#) Regulation (EC) No 240/96(4). This generated a public debate on the application of Regulation (EC) No 240/96 and on the application in general of Article 81(1) and (3) of the Treaty to technology transfer agreements. The response to the evaluation report from Member States and third parties has been generally in favour of reform of Community competition policy on technology transfer agreements. It is therefore appropriate to repeal Regulation (EC) No 240/96.
- (4) This Regulation should meet the two requirements of ensuring effective competition and providing adequate legal security for undertakings. The pursuit of these objectives should take account of the need to simplify the regulatory framework and its application. It is appropriate to move away from the approach of listing exempted clauses and to place greater emphasis on defining the categories of agreements which are exempted up to a certain level of market power and on specifying the restrictions or clauses which are not to be contained in such agreements. This is consistent with an economics-based approach which assesses the impact of agreements on the relevant market. It is also consistent with such an approach to make a distinction between agreements between competitors and agreements between non-competitors.
- (5) Technology transfer agreements concern the licensing of technology. Such agreements will usually improve economic efficiency and be pro-competitive as they can reduce duplication of research and development, strengthen the incentive for the initial research and development, spur incremental innovation, facilitate diffusion and generate product market competition.
- (6) The likelihood that such efficiency-enhancing and pro-competitive effects will outweigh any

anti-competitive effects due to restrictions contained in technology transfer agreements depends on the degree of market power of the undertakings concerned and, therefore, on the extent to which those undertakings face competition from undertakings owning substitute technologies or undertakings producing substitute products.

- (7) This Regulation should only deal with agreements where the licensor permits the licensee to exploit the licensed technology, possibly after further research and development by the licensee, for the production of goods or services. It should not deal with licensing agreements for the purpose of subcontracting research and development. It should also not deal with licensing agreements to set up technology pools, that is to say, agreements for the pooling of technologies with the purpose of licensing the created package of **intellectual** property rights to third parties.
- (8) For the application of Article 81(3) by regulation, it is not necessary to define those technology transfer agreements that are capable of falling within Article 81(1). In the individual assessment of agreements pursuant to Article 81(1), account has to be taken of several factors, and in particular the structure and the dynamics of the relevant technology and product markets.
- (9) The benefit of the **block exemption** established by this Regulation should be limited to those agreements which can be assumed with sufficient certainty to satisfy the conditions of Article 81(3). In order to attain the benefits and objectives of technology transfer, the benefit of this Regulation should also apply to provisions contained in technology transfer agreements that do not constitute the primary object of such agreements, but are directly related to the application of the licensed technology.
- (10) For technology transfer agreements between competitors it can be presumed that, where the combined share of the relevant markets accounted for by the parties does not exceed 20 % and the agreements do not contain certain severely anti-competitive restraints, they generally lead to an improvement in production or distribution and allow consumers a fair share of the resulting benefits.
- (11) For technology transfer agreements between non-competitors it can be presumed that, where the individual share of the relevant markets accounted for by each of the parties does not exceed 30 % and the agreements do not contain certain severely anti-competitive restraints, they generally lead to an improvement in production or distribution and allow consumers a fair share of the resulting benefits.
- (12) There can be no presumption that above these market-share thresholds technology transfer agreements do fall within the scope of Article 81(1). For instance, an exclusive licensing agreement between non-competing undertakings does often not fall within the scope of Article 81(1). There can also be no presumption that, above these market-share thresholds, technology transfer agreements falling within the scope of Article 81(1) will not satisfy the conditions for exemption. However, it can also not be presumed that they will usually give rise to objective advantages of such a character and size as to compensate for the disadvantages which they create for competition.
- (13) This Regulation should not exempt technology transfer agreements containing restrictions which are not indispensable to the improvement of production or distribution. In particular, technology transfer agreements containing certain severely anti-competitive restraints such as the fixing of prices charged to third parties should be excluded from the benefit of the **block exemption** established by this Regulation irrespective of the market shares of the undertakings concerned. In the case of such hardcore restrictions the whole agreement should be excluded from the benefit of the **block exemption**.
- (14) In order to protect incentives to innovate and the appropriate application of **intellectual** property rights, certain restrictions should be excluded from the **block exemption**. In particular

exclusive grant back obligations for severable improvements should be excluded. Where such a restriction is included in a licence agreement only the restriction in question should be excluded from the benefit of the [block exemption](#).

- (15) The market-share thresholds, the non-exemption of technology transfer agreements containing severely anti-competitive restraints and the excluded restrictions provided for in this Regulation will normally ensure that the agreements to which the [block exemption](#) applies do not enable the participating undertakings to eliminate competition in respect of a substantial part of the products in question.
- (16) In particular cases in which the agreements falling under this Regulation nevertheless have effects incompatible with Article 81(3), the Commission should be able to withdraw the benefit of the [block exemption](#). This may occur in particular where the incentives to innovate are reduced or where access to markets is hindered.
- (17) Council Regulation (EC) No 1/2003 of 16 December 2002 on the implementation of the rules on competition laid down in Articles 81 and 82 of the Treaty(5) empowers the competent authorities of Member States to withdraw the benefit of the [block exemption](#) in respect of technology transfer agreements having effects incompatible with Article 81(3), where such effects are felt in their respective territory, or in a part thereof, and where such territory has the characteristics of a distinct geographic market. Member States must ensure that the exercise of this power of withdrawal does not prejudice the uniform application throughout the common market of the Community competition rules or the full effect of the measures adopted in implementation of those rules.
- (18) In order to strengthen supervision of parallel networks of technology transfer agreements which have similar restrictive effects and which cover more than 50 % of a given market, the Commission should be able to declare this Regulation inapplicable to technology transfer agreements containing specific restraints relating to the market concerned, thereby restoring the full application of Article 81 to such agreements.
- (19) This Regulation should cover only technology transfer agreements between a licensor and a licensee. It should cover such agreements even if conditions are stipulated for more than one level of trade, by, for instance, requiring the licensee to set up a particular distribution system and specifying the obligations the licensee must or may impose on resellers of the products produced under the licence. However, such conditions and obligations should comply with the competition rules applicable to supply and distribution agreements. Supply and distribution agreements concluded between a licensee and its buyers should not be exempted by this Regulation.
- (20) This Regulation is without prejudice to the application of Article 82 of the Treaty,

HAS ADOPTED THIS REGULATION:

Article 1

Definitions

1. For the purposes of this Regulation, the following definitions shall apply:

- (a) "agreement" means an agreement, a decision of an association of undertakings or a concerted practice;
- (b) "technology transfer agreement" means a patent licensing agreement, a know-how licensing agreement, a software copyright licensing agreement or a mixed patent, know-how or software copyright licensing

agreement, including any such agreement containing provisions which relate to the sale and purchase of products or which relate to the licensing of other **intellectual** property rights or the assignment of **intellectual** property rights, provided that those provisions do not constitute the primary object of the agreement and are directly related to the production of the contract products; assignments of patents, know-how, software copyright or a combination thereof where part of the risk associated with the exploitation of the technology remains with the assignor, in particular where the sum payable in consideration of the assignment is dependent on the turnover obtained by the assignee in respect of products produced with the assigned technology, the quantity of such products produced or the number of operations carried out employing the technology, shall also be deemed to be technology transfer agreements;

- (c) "reciprocal agreement" means a technology transfer agreement where two undertakings grant each other, in the same or separate contracts, a patent licence, a know-how licence, a software copyright licence or a mixed patent, know-how or software copyright licence and where these licences concern competing technologies or can be used for the production of competing products;
- (d) "non-reciprocal agreement" means a technology transfer agreement where one undertaking grants another undertaking a patent licence, a know-how licence, a software copyright licence or a mixed patent, know-how or software copyright licence, or where two undertakings grant each other such a licence but where these licences do not concern competing technologies and cannot be used for the production of competing products;
- (e) "product" means a good or a service, including both intermediary goods and services and final goods and services;
- (f) "contract products" means products produced with the licensed technology;
- (g) "**intellectual** property rights" includes industrial property rights, know-how, copyright and neighbouring rights;
- (h) "patents" means patents, patent applications, utility models, applications for registration of utility models, designs, topographies of semiconductor products, supplementary protection certificates for medicinal products or other products for which such supplementary protection certificates may be obtained and plant breeder's certificates;
- (i) "know-how" means a package of non-patented practical information, resulting from experience and testing, which is:
 - (i) secret, that is to say, not generally known or easily accessible,
 - (ii) substantial, that is to say, significant and useful for the production of the contract products, and
 - (iii) identified, that is to say, described in a sufficiently comprehensive manner so as to make it possible to verify that it fulfils the criteria of secrecy and substantiality;
- (j) "competing undertakings" means undertakings which compete on the relevant technology market and/or the relevant product market, that is to say:
 - (i) competing undertakings on the relevant technology market, being undertakings which license out competing technologies without infringing each others' **intellectual** property rights (actual competitors on the technology market); the relevant technology market includes technologies which are regarded by the licensees as interchangeable with or substitutable for the licensed technology, by reason of the technologies' characteristics, their royalties and their intended use,
 - (ii) competing undertakings on the relevant product market, being undertakings which, in the absence of the technology transfer agreement, are both active on the relevant product and geographic

market(s) on which the contract products are sold without infringing each others' **intellectual** property rights (actual competitors on the product market) or would, on realistic grounds, undertake the necessary additional investments or other necessary switching costs so that they could timely enter, without infringing each others' **intellectual** property rights, the(se) relevant product and geographic market(s) in response to a small and permanent increase in relative prices (potential competitors on the product market); the relevant product market comprises products which are regarded by the buyers as interchangeable with or substitutable for the contract products, by reason of the products' characteristics, their prices and their intended use;

- (k) "selective distribution system" means a distribution system where the licensor undertakes to license the production of the contract products only to licensees selected on the basis of specified criteria and where these licensees undertake not to sell the contract products to unauthorised distributors;
- (l) "exclusive territory" means a territory in which only one undertaking is allowed to produce the contract products with the licensed technology, without prejudice to the possibility of allowing within that territory another licensee to produce the contract products only for a particular customer where this second licence was granted in order to create an alternative source of supply for that customer;
- (m) "exclusive customer group" means a group of customers to which only one undertaking is allowed actively to sell the contract products produced with the licensed technology;
- (n) "severable improvement" means an improvement that can be exploited without infringing the licensed technology.

2. The terms "undertaking", "licensor" and "licensee" shall include their respective connected undertakings.

"Connected undertakings" means:

- (a) undertakings in which a party to the agreement, directly or indirectly:
 - (i) has the power to exercise more than half the voting rights, or
 - (ii) has the power to appoint more than half the members of the supervisory board, board of management or bodies legally representing the undertaking, or
- (iii) has the right to manage the undertaking's affairs;
- (b) undertakings which directly or indirectly have, over a party to the agreement, the rights or powers listed in (a);
- (c) undertakings in which an undertaking referred to in (b) has, directly or indirectly, the rights or powers listed in (a);
- (d) undertakings in which a party to the agreement together with one or more of the undertakings referred to in (a), (b) or (c), or in which two or more of the latter undertakings, jointly have the rights or powers listed in (a);
- (e) undertakings in which the rights or the powers listed in (a) are jointly held by:
 - (i) parties to the agreement or their respective connected undertakings referred to in (a) to (d), or
 - (ii) one or more of the parties to the agreement or one or more of their connected undertakings referred to in (a) to (d) and one or more third parties.

Article 2

Exemption

Pursuant to Article 81(3) of the Treaty and subject to the provisions of this Regulation, it is hereby declared that Article 81(1) of the Treaty shall not apply to technology transfer agreements entered into between two undertakings permitting the production of contract products.

This exemption shall apply to the extent that such agreements contain restrictions of competition falling within the scope of Article 81(1). The exemption shall apply for as long as the **intellectual** property right in the licensed technology has not expired, lapsed or been declared invalid or, in the case of know-how, for as long as the know-how remains secret, except in the event where the know-how becomes publicly known as a result of action by the licensee, in which case the exemption shall apply for the duration of the agreement.

Article 3

Market-share thresholds

1. Where the undertakings party to the agreement are competing undertakings, the exemption provided for in Article 2 shall apply on condition that the combined market share of the parties does not exceed 20 % on the affected relevant technology and product market.
2. Where the undertakings party to the agreement are not competing undertakings, the exemption provided for in Article 2 shall apply on condition that the market share of each of the parties does not exceed 30 % on the affected relevant technology and product market.
3. For the purposes of paragraphs 1 and 2, the market share of a party on the relevant technology market(s) is defined in terms of the presence of the licensed technology on the relevant product market(s). A licensor's market share on the relevant technology market shall be the combined market share on the relevant product market of the contract products produced by the licensor and its licensees.

Article 4

Hardcore restrictions

1. Where the undertakings party to the agreement are competing undertakings, the exemption provided for in Article 2 shall not apply to agreements which, directly or indirectly, in isolation or in combination with other factors under the control of the parties, have as their object:
 - (a) the restriction of a party's ability to determine its prices when selling products to third parties;
 - (b) the limitation of output, except limitations on the output of contract products imposed on the licensee in a non-reciprocal agreement or imposed on only one of the licensees in a reciprocal agreement;
 - (c) the allocation of markets or customers except:
 - (i) the obligation on the licensee(s) to produce with the licensed technology only within one or

more technical fields of use or one or more product markets,

- (ii) the obligation on the licensor and/or the licensee, in a non-reciprocal agreement, not to produce with the licensed technology within one or more technical fields of use or one or more product markets or one or more exclusive territories reserved for the other party,
 - (iii) the obligation on the licensor not to license the technology to another licensee in a particular territory,
 - (iv) the restriction, in a non-reciprocal agreement, of active and/or passive sales by the licensee and/or the licensor into the exclusive territory or to the exclusive customer group reserved for the other party,
 - (v) the restriction, in a non-reciprocal agreement, of active sales by the licensee into the exclusive territory or to the exclusive customer group allocated by the licensor to another licensee provided the latter was not a competing undertaking of the licensor at the time of the conclusion of its own licence,
 - (vi) the obligation on the licensee to produce the contract products only for its own use provided that the licensee is not restricted in selling the contract products actively and passively as spare parts for its own products,
 - (vii) the obligation on the licensee, in a non-reciprocal agreement, to produce the contract products only for a particular customer, where the licence was granted in order to create an alternative source of supply for that customer;
- (d) the restriction of the licensee's ability to exploit its own technology or the restriction of the ability of any of the parties to the agreement to carry out research and development, unless such latter restriction is indispensable to prevent the disclosure of the licensed know-how to third parties.
2. Where the undertakings party to the agreement are not competing undertakings, the exemption provided for in Article 2 shall not apply to agreements which, directly or indirectly, in isolation or in combination with other factors under the control of the parties, have as their object:
- (a) the restriction of a party's ability to determine its prices when selling products to third parties, without prejudice to the possibility of imposing a maximum sale price or recommending a sale price, provided that it does not amount to a fixed or minimum sale price as a result of pressure from, or incentives offered by, any of the parties;
 - (b) the restriction of the territory into which, or of the customers to whom, the licensee may passively sell the contract products, except:
 - (i) the restriction of passive sales into an exclusive territory or to an exclusive customer group reserved for the licensor,
 - (ii) the restriction of passive sales into an exclusive territory or to an exclusive customer group allocated by the licensor to another licensee during the first two years that this other licensee is selling the contract products in that territory or to that customer group,
 - (iii) the obligation to produce the contract products only for its own use provided that the licensee is not restricted in selling the contract products actively and passively as spare parts for its own products,
 - (iv) the obligation to produce the contract products only for a particular customer, where the licence was granted in order to create an alternative source of supply for that customer,
 - (v) the restriction of sales to end-users by a licensee operating at the wholesale level of trade,

- (vi) the restriction of sales to unauthorised distributors by the members of a selective distribution system;
- (c) the restriction of active or passive sales to end-users by a licensee which is a member of a selective distribution system and which operates at the retail level, without prejudice to the possibility of prohibiting a member of the system from operating out of an unauthorised place of establishment.
3. Where the undertakings party to the agreement are not competing undertakings at the time of the conclusion of the agreement but become competing undertakings afterwards, paragraph 2 and not paragraph 1 shall apply for the full life of the agreement unless the agreement is subsequently amended in any material respect.

Article 5

Excluded restrictions

1. The exemption provided for in Article 2 shall not apply to any of the following obligations contained in technology transfer agreements:

- (a) any direct or indirect obligation on the licensee to grant an exclusive licence to the licensor or to a third party designated by the licensor in respect of its own severable improvements to or its own new applications of the licensed technology;
- (b) any direct or indirect obligation on the licensee to assign, in whole or in part, to the licensor or to a third party designated by the licensor, rights to its own severable improvements to or its own new applications of the licensed technology;
- (c) any direct or indirect obligation on the licensee not to challenge the validity of **intellectual** property rights which the licensor holds in the common market, without prejudice to the possibility of providing for termination of the technology transfer agreement in the event that the licensee challenges the validity of one or more of the licensed **intellectual** property rights.

2. Where the undertakings party to the agreement are not competing undertakings, the exemption provided for in Article 2 shall not apply to any direct or indirect obligation limiting the licensee's ability to exploit its own technology or limiting the ability of any of the parties to the agreement to carry out research and development, unless such latter restriction is indispensable to prevent the disclosure of the licensed know-how to third parties.

Article 6

Withdrawal in individual cases

1. The Commission may withdraw the benefit of this Regulation, pursuant to Article 29(1) of Regulation (EC) No 1/2003, where it finds in any particular case that a technology transfer agreement to which the exemption provided for in Article 2 applies nevertheless has effects which are incompatible with Article 81(3) of the Treaty, and in particular where:

- (a) access of third parties' technologies to the market is restricted, for instance by the cumulative effect of parallel networks of similar restrictive agreements prohibiting licensees from using third parties' technologies;

- (b) access of potential licensees to the market is restricted, for instance by the cumulative effect of parallel networks of similar restrictive agreements prohibiting licensors from licensing to other licensees;
- (c) without any objectively valid reason, the parties do not exploit the licensed technology.

2. Where, in any particular case, a technology transfer agreement to which the exemption provided for in Article 2 applies has effects which are incompatible with Article 81(3) of the Treaty in the territory of a Member State, or in a part thereof, which has all the characteristics of a distinct geographic market, the competition authority of that Member State may withdraw the benefit of this Regulation, pursuant to Article 29(2) of Regulation (EC) No 1/2003, in respect of that territory, under the same circumstances as those set out in paragraph 1 of this Article.

Article 7

Non-application of this Regulation

1. Pursuant to Article 1a of Regulation No 19/65/EEC, the Commission may by regulation declare that, where parallel networks of similar technology transfer agreements cover more than 50 % of a relevant market, this Regulation is not to apply to technology transfer agreements containing specific restraints relating to that market.

2. A regulation pursuant to paragraph 1 shall not become applicable earlier than six months following its adoption.

Article 8

Application of the market-share thresholds

1. For the purposes of applying the market-share thresholds provided for in Article 3 the rules set out in this paragraph shall apply.

The market share shall be calculated on the basis of market sales value data. If market sales value data are not available, estimates based on other reliable market information, including market sales volumes, may be used to establish the market share of the undertaking concerned.

The market share shall be calculated on the basis of data relating to the preceding calendar year.

The market share held by the undertakings referred to in point (e) of the second subparagraph of Article 1(2) shall be apportioned equally to each undertaking having the rights or the powers listed in point (a) of the second subparagraph of Article 1(2).

2. If the market share referred to in Article 3(1) or (2) is initially not more than 20 % respectively 30 % but subsequently rises above those levels, the exemption provided for in Article 2 shall continue to apply for a period of two consecutive calendar years following the year in which the 20 % threshold or 30 % threshold was first exceeded.

Article 9

Repeal

Regulation (EC) No 240/96 is repealed.

References to the repealed Regulation shall be construed as references to this Regulation.

Article 10

Transitional period

The prohibition laid down in Article 81(1) of the Treaty shall not apply during the period from 1 May 2004 to 31 March 2006 in respect of agreements already in force on 30 April 2004 which do not satisfy the conditions for exemption provided for in this Regulation but which, on 30 April 2004, satisfied the conditions for exemption provided for in Regulation (EC) No 240/96.

Article 11

Period of validity

This Regulation shall enter into force on 1 May 2004.

It shall expire on 30 April 2014.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 27 April 2004.

For the Commission

Mario Monti

Member of the Commission

- (1) OJ 36, 6.3.1965, p. 533/65. Regulation as last amended by Regulation (EC) No 1/2003 (OJ L 1, 4.1.2003, p. 1).
- (2) OJ C 235, 1.10.2003, p. 10.
- (3) OJ L 31, 9.2.1996, p. 2. Regulation as amended by the 2003 Act of Accession.
- (4) COM(2001) 786 final.
- (5) OJ L 1, 4.1.2003, p. 1. Regulation as amended by Regulation (EC) No 411/2004 (OJ L 68, 6.3.2004, p. 1).

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