

# BR/GT I/12 e/69

## Travaux Préparatoires EPC 1973

### Comment:

The collection represents purely an internal research tool for the purpose of Directorate Patent Law of the European Patent Office. No guarantee can be given for its completeness or correctness.

The documents produced before 1969 cannot be provided in English as this was not an official language in the period before that date. These documents therefore are provided in French and German.



INTER-GOVERNMENTAL CONFERENCE  
FOR THE SETTING UP OF A EUROPEAN  
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 29 September 1969  
BR/GT I/12/69

---

- Secretariat -

N O T E

The members of Working Party I will find enclosed the draft report on Articles 1 to 30 of the Preliminary Draft Convention on a European system for the grant of patents, prepared, as agreed during the meeting of Working Party I from 8 - 11 July 1969 at Luxembourg, by Mr. ARMITAGE (British delegation) [cf. doc. BR/7/69 page 2, paragraph 2, sub-paragraph 2\_7.

The attention of the members of the Working Party is drawn to the fact that this draft report is subject to revision in the light of any subsequent discussions affecting Articles 1 to 30 or of any comments which members of the Working Party may express at the next meeting.

---

BR/GT I/12 e/69 ern/PA/mk



Draft Convention for a European System for  
the Grant of Patents

Draft report on Articles 1-30

Article 1 raised the fundamental question whether the work should aim at providing only a common system of rules and procedure for granting patents effective in the member States (the "minimum" approach) or whether it should go further and provide in addition a common law for judging the validity of the patents when granted (the "maximum" approach). While the working party was generally in sympathy with the objective of harmonising the laws on validity, it felt that it was more prudent to adopt the "minimum" approach to the drafting as it was considered to require too much from acceding States to oblige them either to amend their national tests of validity or to apply to patents granted through the European route tests different from those applied to national patents. It was also suggested that the "cold harmonisation" effect would probably induce States for whom patents had been granted on one set of rules to avoid judging their validity on a different set of rules ; thus they would be encouraged to amend their national laws to conform with the tests applied in granting European patents. It was also suggested that if there was strong pressure for the maximum solution to be adopted, the draft could perhaps be altered.

Article 2 points out the main distinctions between the present draft and the earlier (1965) draft. Under the earlier draft a provisional patent was granted on the application when published and was "confirmed" after examination. The same

concept was retained in the EFTA Draft except that the confirmed or "final" patents were in effect independent national patents. The present draft drops the concept of a provisional patent. On publication there is simply a published European patent application. European patents are granted only after examination and then have the effect of and are subject to the same conditions as national patents in the countries affected.

Thus, the grant of a European patent is equivalent to the grant of a bundle of national patents each of which is subject only to the jurisdiction of the competent authorities of the respective State and to the law of that State. This contrasts with the old draft which resulted in the grant of an international and autonomous patent. Under the present draft the international character is restricted to the application before grant. The unitary character of a European application ~~vis-à-vis~~ the European Patent Office is dealt with separately in Article 24a.

Under the new system it will be neither necessary nor desirable to require an applicant to cover all member States in one application. Article 2A provides for designating some or all of the member States. It is left open whether an applicant should be allowed to designate a single State.

Contrary to the earlier draft there is no Article 4 setting up a Patent Court. It is proposed to deal with appeals of patent applications by an appeal body other than a court and to use other means for dealing with disputes etc. which under the earlier draft were dealt with by the Patent Court.

Article 5, defining "accessibility" or entitlement to apply, has been drafted in accordance with the Brussels memorandum and follows as closely as possible the wording of

Articles 2 and 3 of the Paris Convention. The question arises as to who is to decide whether a particular country meets the conditions of this Article. Paragraph 5 of the Brussels memorandum of 17th March, 1969, states that the question will be decided by "judicial review" and that the judicial authority could possibly be within the European Patent Office. This should be determined by later Articles7.

Article 7 of the 1965 draft prohibited simultaneous protection of a given invention by a national patent and a European patent. There was some support for retaining this as a harmonising act, but the majority favoured the present draft which leaves the matter to national law.

Article 8 was retained on the understanding that it applies only to past commitments at the time of joining the Convention.

Article 8a permits the EEC countries to ensure that the European patent is unitary as far as the Common Market is concerned and must cover all or none of the EEC countries.

Article 9(1) defines the basic requirements for patentability as in Article 1 of the 1963 Strasbourg Convention on Substantive Patent Law. For the avoidance of doubt it is considered desirable to set out in Article 9(2) a non-exhaustive list of exclusions which follow as far as possible the corresponding provisions in Rule 39 of the PCT Regulations. Computer programs are not, for the present, specifically excluded, since their patentability is still a subject of controversy. This does not, however, mean that they are necessarily considered to be inventions within the meaning of Article 9(1).

Article 10 (exceptions to patentability) simply follows Article 2 of the Strasbourg Convention.

Articles 11 and 12 follow closely the novelty rules of Article 4 of the Strasbourg Convention. Article 11(3), by a substantial majority view of the working party, adopts the option provided by the Strasbourg Article 4(3) according to which conflicts between copending applications are resolved by treating the whole contents of the earlier application as part of the prior art as of its priority date. This means that the later invention must be novel in relation to anything disclosed in the earlier application. The question whether it needs to show an inventive step over the earlier disclosure is dealt with in Article 13. The formula adopted in Article 11(3) is of course more severe than that adopted in, for example, the U.K. German and French laws which adopt the test of prior claiming. It is to be observed that it may be possible for an applicant to withdraw his European application and retain only a particular national application if he is in a position where he could get a national patent but not a European one. This could apply not only where the national law is less strict but also in a case where the earlier European application covers some only of the countries covered by the later application (see Article 11(4)). Conflict between a European application and a national application will be left to be resolved nationally, after grant of the European patent.

Article 13 presents two alternatives which differ only to the extent to which prior European applications, under Article 11(3), are to be taken into account in assessing inventive step. According to the first variant, the Article 11(3) documents are to be ignored altogether,

i.e. simple novelty suffices, however trivial the difference. According to the second variant, any Article 11(3) document can only be considered on its own, separately from the rest of the prior art, in the light of the knowledge available to the "man skilled in the art" who is deemed to be judging the question. The second variant thus requires something more than simple novelty : it should exclude trivial differences and common substitutions. Neither variant, however, permits Article 11(3) documents to be associated with other individual elements of the prior art, whether other Article 11(3) documents or published material.

Article 14 (industrial application) follows Article 3 of the Strasbourg Convention.

Article 15 of the 1965 draft had the effect of partially unifying national law on the right to a patent by laying down that the right to a European patent shall belong to the inventor or his assignee, subject to national law on employed inventors. The working party considered that a complete unification on this point was not practicable at this point in time since the law on employed inventors varies greatly from country to country. On the other hand, if Article 16 is to be effective in procedure before the European Patent Office, it is necessary for Article 15 to provide a unique answer to the question of who is entitled to a European patent. The choice in Article 15 therefore appeared to be to state either that the entitlement to a patent is a matter of national law in each State or that it shall be determined by the national law of one particular State. The working party chose the second alternative, the particular national law in question being the one "governing the invention". Note - this is subject to reconsideration later<sup>7</sup>.

By paragraph (2) of Article 15 the European Patent Office will make no investigation into the applicant's entitlement to apply. Nor will it receive a complaint of unlawful obtaining of the invention as in Article 16(1) and (2) of the 1965 draft. It will, however, under Article 16(3) as now drafted act on a final decision by a competent court or authority that some person other than the applicant is entitled, under Article 15, to the patent. In that case the application in suit is considered withdrawn and its priority will be transferred to a new application for the same invention filed by the other person. The draft permits the new application to include matter not present in the disclosure of the original application, but such added matter would not benefit from the priority of the original application. [Note : to be reconsidered later]7.

Article 17 follows the 1965 draft. Under Article 4ter of the Paris Convention, the inventor has a right to be mentioned as such in the patent. The European Patent Office will not adjudicate on a claim by a person to be the inventor. The inventor will, however, have the right to seek a court order as to his inventorship and the applicant will then be obliged to mention him in his application. This Article can, therefore, be considered as creating a new civil right in each member country.

Article 18 of the 1965 draft is omitted since European patents are, under Article 2(2a), effectively national patents or group patents under Article 8a).

In conformity with the "minimum" approach referred to in connection with Article 1, the resolution of conflicts between European patents and national patents, neither of which is published prior art relative to the other, is left

to national action, e.g. in revocation proceedings.  
Article 19 of the 1965 draft is therefore omitted.

Article 20 may be considered repetitive having regard to Article 2(2a). The general view of the working party was, however, that its retention is justified, Article 2 setting out the general principle and Article 20 dealing with a specific aspect which goes with Articles 20bis and 20ter as a natural sequence.

Article 20bis defines the rights conferred on publication of the application before examination. The memorandum requires that some protection is granted at that stage. The draft, while establishing, as a principle, in paragraph (1) that full patent protection should be given, allows (paragraph 2) any State to reserve the right to give more restricted protection and to make it depend (paragraph 4) on the availability of the patent claims in a particular language. Protection is, in any case, governed (paragraph 3) by the scope of the granted patent.

Article 20ter (rights on publication after examination) follows the pattern of Article 20bis but without the reservation on restricted protection.

Article 21 follows Article 8 of the Strasbourg Convention. Some members of the working party were anxious to ensure that there would be uniform interpretation of the claims in all member States, but no agreement could be reached on any more precise formulation than that of the Strasbourg text.

Articles 22 and 23 of the 1965 draft were omitted as being matters for national law under the "minimum" approach



to the Convention. However, it was noted that if all member States were prepared to accept a term of 20 years, this could be incorporated in the draft.

Article 24 follows the principles of the 1965 draft but has been redrafted having in mind the text developed in the draft Council of Europe proposals for further unification. It is to be noted that the scope for patents of addition will be quite small having regard to the time limit for application mentioned in paragraph (1).

Articles 24a - 30. These Articles have been left for further study in another working party which should include some legal experts. Some members of the working party, however, expressed doubts as to the need for Articles 25-30 at all. As to Article 24a a view was expressed that an applicant should be free to assign the rights to the patent when granted to different persons for different States. This could be done by allowing separate applications in respect of each assignee, or by naming them separately on one application ; or partial assignments could be registered after application. It would be essential, however, that one person or group of persons remained nominated as authorised to prosecute the application before the European Patent Office. Further consideration will be given to this, which would require amendment of Article 24a.

---

