

BR/GT I/13 e/69

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

Brussels, 30 September 1969
BR/GT I/13/69

- Secretariat -

N O T E

As agreed at the meeting of Working Party I held from 8 - 11 July 1969 at Luxembourg, the British delegation has transmitted to the Secretariat a memorandum on the Branch Examining Offices of the European Patent Office [cf. doc. BR/7/69 pages 25 to 27, paragraph 55_7.

The members of Working Party I will find the text of this memorandum enclosed.

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European Patent Office
Branch Examining Offices

Memorandum by the United Kingdom Delegation

1. At the meeting of the Working Party in Luxembourg from 8th - 11th July, 1969, the United Kingdom delegation undertook to prepare a paper setting out the United Kingdom opinions on the location of branch offices for the purposes of examination, with particular reference to examination of applications filed in the English language. This paper assumes that the European Patent Office headquarters will not be located in a country where the native language is English.

2. Applications in the English language

The annual filing rate of such applications is impossible to predict with any hope of accuracy, depending as it does on the view applicants take of the utility of the system compared with separate national applications, and, of course, on accessibility. We think however that when the system is fully applied to all arts and has reached general acceptance among applicants and their professional advisers, the annual number of applications in the English language from all sources could be about 21,000 based on the level of inventive activity prevailing in 1967 and, allowing for the current rate of increase in inventive activity - this could be of the order of 30,000 by 1980. We think that the professional staff needed to deal with this latter input would be of the order of 300 including supervisory and judicial staff. There would also have to be a substantial number of ancillary staff.

3. The means of launching the system

Although the system must be launched gradually it is important that it should be seen to be effective and that it should attract sufficient work to make it immediately viable. In achieving this the receipt of an adequate number of English language applications is clearly of the greatest importance. This in turn depends upon the confidence with which the users of the international patent system, and more especially their professional advisers view the new arrangements. The latter will almost certainly view them with some caution and will probably be very ready to find good reason for such caution. In particular they will wish to be satisfied of the qualifications of the Examiners for dealing with patent claims written in English - bearing in mind that the precise wording of these is of enormous importance in determining the scope of the patentees' rights. They will also be concerned to know that there are sufficient people with such qualifications to ensure that delays are avoided.

4.

The patents issuing from the European Patent Office are to become national patents justiciable in national courts, and a great deal can, therefore, depend on the precise interpretation placed on individual words. We believe that, to examine fully satisfactorily patent applications, the professional staff should either have as their mother tongue the language of the specifications or a command of that language of the very highest standards. As far as the English language is concerned, we know from experience of the difficulty created by the lack of mother-tongue English in Examiners. We have also experienced much obscurity in convention applications where the translation has been made by technical people whose native language is not English. We accept of course that it would be possible to recruit Examiners, whose mother tongue

is other than English, with an adequate command of English but we are very doubtful if sufficient can be obtained. It might be possible to train people to the desired standard but the time and cost involved would, we believe, prohibit this. We also believe that English-speaking applicants and their professional advisers would not have the same confidence in the staff of the Office, especially at judicial level, if they were not to have English as their mother tongue or a total command of the language, and an Examiner who had not might be at a disadvantage in his dealings with such applicants and agents. As far as we are aware examination, as distinct from searching, has never been carried out on a large scale by Examiners whose native language has differed from the language of the applications.

5. Source of professional staff.

We think that, in practice, the main source of staff with English as their mother tongue is likely to be the United Kingdom. Initially, the European Patent Office will need to be staffed by a substantial number of experienced Examiners transferred from existing national Patent Offices. As far as English language Examiners are concerned, this means, effectively, transfer from the United Kingdom Office. Once the European Patent Office is established recruitment will be largely confined to young graduates who will be committing themselves to a lifetime in the place where the European Patent Office is situated.

6. Location of examination of English-language applications

We believe that considerable time might elapse before a sufficient number of suitably experienced British subjects could be found to undertake permanent posting abroad. We consider, therefore, that the problems involved in recruiting

and retaining English-speaking Examiners are such that on practical grounds examination of English-language applications should be carried out in a European English-speaking country. Of these there are only two, the United Kingdom or the Republic of Ireland.

7. Facilities of a United Kingdom branch Office

We would expect the branch office to have full access to the facilities of the United Kingdom Patent Office and the National Science libraries. One of the facilities offered by the latter is an unrivalled technical periodical collection which currently takes 20,000 periodical titles. We believe that existing United Kingdom Examiners would be willing to join a branch of the European Office, in the United Kingdom, and they would be particularly valuable in training newly recruited staff. The United Kingdom Office has some 70 supervisory examining staff all of whom are experienced in responsible decision-making in matters of patent practice and administration and about a third of whom are experienced in judicial work in relation to patents and are trusted by those who practise before the United Kingdom Office; doubtless some of these would be prepared to serve in the branch office.

8. Costs

The existence of a branch office would no doubt increase somewhat the cost of the overheads of the European Patent Office and give rise to additional costs for staff travel and communications between head office and the branch. This extra cost would be offset by the saving on expatriation allowances to staff serving abroad. The overall cost to the applicant would also be less.

9. Uniformity of practice

At first sight uniformity of practice between the main and branch offices might seem difficult to attain. We agree that uniformity is important. However, uniformity in national Offices between blocks of Examiners is not maintained primarily by physical proximity but by the use of common precedent and common practice instructions. For the European Patent Office these would be laid down by the Boards of Appeal and the central administration of the Office respectively. The latter necessarily would present a uniform code of practice. Steps would have to be taken to ensure a high degree of uniformity in the decisions of the former. To some extent this is guaranteed by the fact that the Boards would be applying a single uniform law.

10. Movement of personnel

Apart from the members of the Boards of Appeal, arrangements could be made for other personnel at each office to spend working periods at the other offices and heads of the branches would need to meet periodically with the head of the Office.

11. Further searches

The Office would examine on the basis of a search made by the I.I.B. In some few cases it may be that amendment of the specification after search makes a further search necessary, or at least a matter for consideration. In our view no attempt should be made to equip the main or branch offices to carry out such further searches. Direct links with the I.I.B. should provide rapid contact with the examining group in the I.I.B. who carried out the original search and who are in the best position to make a completion search in the most uniform and economical way.

12. Other languages

In this paper we have presented the case for a branch office dealing with English language applications. We have no reason to believe that the case is not equally strong for separate location of branches dealing with French and German. If, however, it is felt that the staffing and other factors mentioned above would permit both French and German language applications being dealt with at a head Office situated in one of the E.E.C. countries, we should not wish to object. This is a practical matter on which other countries should pronounce.

13. Timing

We believe that the case for launching the European Patent System on the basis of branch examining offices is so strong that it should be so organised from the start. An alternative would be to attempt to organise it on the basis of a single central Office, setting up branches only if staffing difficulties were encountered. This alternative is unsatisfactory in that in our view there is no certainty that all the complications of a tri-lingual Office can be overcome. Moreover, if the system got off to a bad start, a rescue operation would take some years to have effect. In either case, some amendment of Article 33 will be necessary, either by fixing the location of one or more examining branches or by allowing for them to be set up by decision of the Administrative Council in the same way as the branches for information and liaison.