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

Brussels, 18 November 1969
BR/GT I/22/69

- Secretariat -

Working document
for a Preliminary Draft Convention for a
European System for the Grant of Patents

put forward by the Chairman of Working Party I

Memorandum
on the re-publication of the European patent application

Article 96

At its first meeting, on 8 - 11 July 1969, in the context of discussions on the provisional protection conferred by the European patent application, the Working Party raised the question of how to distinguish more clearly between the publication of the European patent application after the expiry of a period of 18 months (Article 86a) and the publication of the claims, after examination, for the purpose of opening opposition proceedings (as in Article 96, up to the present). The Netherlands delegation suggested on this occasion that, as from its publication pursuant to Article 96, the patent application might be referred to by the term "provisional patent" (Minutes of 31 July 1969, point 42).

At its second meeting, on 14 - 17 October 1969, the Working Party discussed the question of the procedure to be adopted for the publication under Article 96 (Minutes of 12 November 1969, points 80 and 81). Three possibilities were considered :

- (a) publication of the allowable claims in the European Patent Bulletin (the Chairman's original proposal for Article 96 in working document BR/GT I/9/69),
- (b) publication of the allowable claims as a separate document with the principal bibliographic data concerning the application (new proposal put forward by the Chairman during the second meeting),
- (c) publication of a document containing, in addition to the bibliographic data, the description, the claims and any drawings relating to the application in the form regarded as acceptable (Netherlands proposal).

The Working Party first considered possibilities (a) and (b), and gave the preference to possibility (b), since the publication of a special document for the interested circles is more practical, without causing the Office any appreciable additional expense. After the Netherlands delegation had put the third possibility forward for discussion, the Working Party gave this solution a favourable reception. The Drafting Committee accordingly prepared a provisional draft for paragraph 2 of Article 96 (see BR/9/69 of 7 November 1969).

The Working Party was unable to reach any final conclusion as to whether, in solution (c), the subsequent publication of a specification in connection with the grant of the patent could be dispensed with, where no opposition is raised or where the opposition does not lead to any amendment. The Chairman agreed to prepare a study of the questions arising in this connection, on the basis of the German Patent Office's experience.

For this purpose, comparative figures have been calculated on the basis of proceedings before the German Patent Office. These comparative figures, which are only approximate, refer to 100 cases of publication after examination of the application (publication of the application in the form of the green "Auslegeschrift" of explanatory paper). The approximate figures give the following picture :

applications published after examination,	100
of which	
patent granted without opposition	72
opposition raised	<u>28</u>
of these 28 opposition proceedings,	
application withdrawn for patent refused	13
patent granted in amended form	12
patent granted without amendment	3*

According to the Chairman's information, the percentage of published patent applications which are opposed is higher for the German Patent Office than it is for other Patent Offices. The Working Party must therefore first consider whether, and in how far, the above experience of the German Patent Office is also relevant as regards the European Patent Office.

If the German experience is also taken as a basis for the European system for the grant of patents, it will be seen that in the event of solution (c) being adopted, 12 % of the European patent specifications would have to be re-set and re-printed in whole or in part.

*This proposition is small, in view of the fact that even minor changes, such as clarifying a claim, are deemed to be amendments.

Still applying the experience of the German Patent Office to the European system for the grant of patents, 75% (72% + 3%) of the "provisional patent specifications" will be identical with the "final patent specifications". As regards the European system for the grant of patents, the question now arising is whether in such cases, after the grant of the "final patent", a new specification should be published in the form of a reprint.

In such cases, the German Patent Office now issues a reprint of the specification (on white paper), even where the text of the latter does not differ from the "Auslegeschrift" (on green paper). The cost of such a reprint for the 75% of cases comes to about 16% of the cost of printing all the "Auslegeschriften" (100%). The cost is relatively low, because the type does not have to be re-set, leaving only costs for paper and printing proper to be paid.

The Working Party must therefore decide whether, in the event of the "provisional patent specification" under Article 96, paragraph 2, being identical with the "final patent specification",

- (a) a reprint will have to be made for the "final patent specification",
or :
- (b) the "provisional patent specification" will be deemed to be the final specification.

In the latter case, a notice to that effect would have to accompany the publication in the European Patent Bulletin of the grant of the patent.

The Chairman wishes to point out that in the event of solution (b) being adopted, it could not be seen from the European patent specification itself whether it was a final specification or only a provisional one.

