

# BR/GT I/45 e/70

## 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 1 July 1970  
BR/GT I/45/70

Secretariat

W o r k i n g   D o c u m e n t  
for the draft Convention establishing a European System  
for the Grant of Patents  
put forward by the Chairman of Working Party I

Proposals on  
Articles 22 to 29 (24a to 30) and 124 to 128 (114 to 118),  
examination of which had been deferred in the First Preliminary Draft



K E Y

1962 Draft

indicates the Draft Convention relating to a European Patent Law, prepared by the EEC "Patents" Working Party and published in 1962.

EFTA Draft

indicates the European Free Trade Association Draft of an open European Patent Convention, forming the first Convention in the two-part scheme - Annex III to the EFTA Working Document 4/67 of 19 January 1967. This draft was based on the 1962 Draft.

1965 Draft

indicates the 1962 Draft, incorporating the amendments contained in Working Document 2335/IV/65-D of 22 January 1965, prepared by the EEC "Patents" Working Party.

1970 Draft

indicates the First Preliminary Draft of a Convention establishing a European System for the Grant of Patents.



+ in the columns headed "EFTA Draft"  
and "Chairman's proposal"

indicates that the text in the column immediately  
to the left is adopted without amendment, i.e. that  
the text of the 1962 Draft is adopted in the EFTA  
Draft, or that the text of the 1965 Draft is  
adopted in the Chairman's proposal.

\* before single paragraphs in the  
1965 Draft

indicates that the 1965 Draft is unchanged in  
relation to the 1962 Draft.

--- under the text in the columns  
headed "1965 Draft" and  
"1970 Draft"

indicates that the text thus underlined is deleted  
in the column headed "Chairman's proposal".

— under the text in the column  
headed "Chairman's proposal"

indicates that the text thus marked is new in relation  
to the 1965 Draft. Completely new paragraphs, however,  
are not underlined.

## Articles 22 to 29 (24a to 30)

## The patent application as an object of property

Introductory note:

In the first draft for this Chapter, the Working Party initially only drafted proposals for Article 22 (24a), on the unitary character of the European patent application, Article 23 (25), on the assignment of a European patent application and Article 28 (29), on the contractual licensing of a European patent application. In so doing, the Working Party was guided by the principle that, in contrast to the 1965 Draft, a European patent application may be assigned or give rise to rights not only in respect of all the designated States jointly, but also for just one or several of those States (Minutes of the 3rd Meeting: BR/12/69, points 90 to 94; see also Minutes of the 1st Meeting: BR/7/69, point 50 and the proposals submitted by the Netherlands delegation: BR/GT I/24/69, pp. 4 to 7).

The Working Party deferred examination of Articles 24 to 27 (26 to 28a) and 29 (30), relating to mortgaging, other rights in rem, distraint, continuing effect of rights and supplementary application of national law in legal transactions (Minutes of the 3rd Meeting - BR/12/69 - No. 92).

In the Chairman's view, these provisions, with the exception of Article 29, are no longer required. They were necessary in the 1965 Draft (cf. BR/GT I/2/69) merely to ensure unitary charges and consequent unitary exploitation of European patent applications and European patents as regards the entire territory of the Common Market. Such rules are therefore required only for the Second Convention.

The amendment to Article 22 is a necessary consequence of the deletion of Articles 24 to 27. As regards European patent applications for which the EEC member States are designated States, the principle that an application may be assigned and fees levied on it only in a unitary manner will also apply. The authority provided for in the First Convention is necessary to enable this matter to be dealt with in detail in the Second Convention.

Article 29 should not be deleted. This provision takes account of the fact that it would be impossible or undesirable to adopt a final ruling in the First Convention on a number of questions arising from legal transactions in connection with European patent applications. The national legislation of the Contracting States will have to be referred to when dealing with the legal questions left open in the First Convention. Article 29 is intended to provide an answer to the question of which national law should be applicable.

## CHAPTER V

The patent application as an object of property

Article 22 (24a)

Unitary character of the European patent application

---

1970 Draft

---

Subject to the provisions of any spécial agreement under Article 8, the European patent application may be assigned or give rise to rights for one or several of the designated States. Such assignment shall not affect the unity of the application in proceedings before the European Patent Office. The assignees in the different States shall be regarded as joint applicants for the purpose of these proceedings.

## Chapter V

The patent application as an object of property

### Article 22 (24a)

Unitary character of the European patent application

---

#### Chairman's proposal

---

(1) The European patent application may be assigned or give rise to rights for one or several of the designated States. Such assignment shall not affect the unity of the application in proceedings before the European Patent Office. The assignees in the different States shall be regarded as joint applicants for the purpose of these proceedings.

#### Note:

(2) Where a group of Contracting States make use of the powers conferred in Article 8, they may lay down that, in so far as they are designated, the European patent application may be assigned, mortgaged and subjected to distraint only in respect of all of these Contracting States and only in accordance with the provisions of the special agreement.

See introductory note to Articles 22 to 29.

## Article 23 (25)

## Assignment of a European Patent Application

---

1970 Draft

---

(1) The assignment of a European patent application shall be made in writing and shall require the signature of the parties to the contract.

(2) The assignment shall be recorded in the Register of European Patents at the request of the interested party or one of the interested parties on production either of the original or of a certified copy of the assignment deed, or of official documents verifying the assignment, or of such extracts from such deed or documents as suffice to establish the assignment. The request shall not be considered as made until such time as the fee prescribed for this purpose by the Regulations concerning fees made pursuant to this Convention has been paid.

(3) The European Patent Office shall retain one copy of the documents referred to in paragraph 2 and shall allow access to these documents on request, after the fee referred to in Article ..... has been paid.

(4) The assignment shall not have effect vis-à-vis the European Patent Office until after it has been recorded in the Register of European Patents. It shall only become effective to the extent to which it is verified by the documents referred to in paragraph 2.

Article 23

Assignment of a European Patent Application

---

Chairman's proposal

---

- no change: as in 1970 Draft -



- Article 24 (26) Mortgaging of a European patent application
- Article 25 (27) Other rights in rem with respect to a European patent application
- Article 26 (28) Distraint of a European patent application
- Article 27 (28a) Continuing effect of rights in respect of a European patent application

Chairman's proposal:

Deleted; see introductory note to Articles 22 to 29

## Article 28 (29)

## Contractual licensing of a European patent application

---

1970 Draft

---

(1) A European patent application may be licensed for the whole or part of the territories of the designated Contracting States.

(2) Paragraphs 2 and 3 of Article 23 shall apply to the grant or assignment of a licence in respect of a European patent application.

Article 28 (29)

Contractual licensing of a European patent application

---

Chairman's proposal

---

- no change; as in 1970 Draft -

## Article 30

## Supplementary application of national law in legal transactions

---

1965 Draft

---

(1) In so far as this Convention does not itself contain rules directly governing legal transactions concerning European patents, the law to be applied shall be the national law referred to by ~~this~~ Convention. Failing such reference, the law to be applied shall be that agreed upon by the parties or, in the case of a transaction involving only one party, the law designated by such initiating party. In the event of failure to agree upon or to designate the relevant law, or if such agreement or designation cannot be enforced by the court before which the matter has been brought, the relevant law shall be determined in accordance with the rules of private international law applicable in the State of the court in question.

(2) If private international law refers to the *lex rei sitae*, the relevant law shall be the law of the Contracting State on whose territory the proprietor of the European patent is ordinarily resident or has his registered place of business. If the proprietor is neither resident nor has his registered place of business on the territory of one of the Contracting States, the relevant law shall be the law of the Contracting State in which the agent has been appointed or an address for service chosen in accordance with the terms of Article 172. If no agent has been appointed and no such address chosen, the relevant law shall be the law of the Contracting State in which the European Patent Office is located.

Article 29 (30)

Supplementary application of national law in legal transactions

---

Chairman's proposal

---

(1) + (Patent applications)

Notes:

1. See introductory note to Articles 22 to 29.

(2) If private international law refers to the *lex rei sitae*, the relevant law shall be the law of the Contracting State on whose territory the applicant is ordinarily resident or has his registered place of business. If the applicant is neither resident nor has his registered place of business on the territory of one of the Contracting States, the relevant law shall be the law of the Contracting State in which an agent has been appointed /or an address for service chosen/ in accordance with the provisions of Article ..... . If no agent has been appointed /and no such address chosen/, the relevant law shall be the law of the Contracting State in which the European Patent Office is located.

2. The decision on whether the relevant law referred to in sentences 2 and 3 of paragraph 2 shall be the law of the Contracting State on whose territory an address for service has been chosen, will depend on the wording to be adopted by Working Party I for the Article of the First Preliminary Draft corresponding to Article 172 of the 1965 Draft.

BR/GT I/45 e/70/rti:RT/cm

Articles 124 to 128 (114 to 118)

Conversion of a European patent application into a national application

Introductory note:

The Working Party had, until now, deferred examination of this group of Articles, which was included in the 1962/65 Draft. The Chairman of the Working Party proposes that these provisions, suitably adapted, be included in the First Preliminary Draft. Allowing for transfer from the European to the national system for the grant of patents reduces, for the applicant, any risks arising from the new and unaccustomed European system for the grant of patents. With regard to the risk involved in the grant of patents, these provisions would make simultaneous protection and parallel proceedings before the European Patent Office and national patent offices superfluous.

CHAPTER IV  
CONVERSION INTO NATIONAL APPLICATION

Article 114

Application of national procedure

---

Preliminary Draft 1962

EFTA Draft

1965 Draft

---

(1) Upon the request of the applicant for a European patent or of the proprietor of a provisional European patent, the central industrial property offices of the Contracting States will apply the procedure for the grant of a national patent, based upon the European filing which, by virtue of Article 75, is equivalent to a national filing.

(2) The application for conversion must be made within a period of three months, calculated either from the refusal or withdrawal of an application for a European patent, or from its cancellation or surrender. The right conferred by the said Article will lapse if the application is not submitted within the prescribed period.

(1) Upon request of the applicant for or proprietor of a European patent, the central industrial property office of any Contracting State covered by the application or patent will apply the procedure for the grant of a national patent, based upon the European filing which, by virtue of Article 75, is equivalent to a national filing.

(2) The application for conversion must be made within a period of three months, calculated either from the refusal or withdrawal of an application for a European patent, or from its cancellation or surrender, or from the date of withdrawal of such State from those covered by the application or Patent. The right conferred by the said Article will lapse if the application is not submitted within the prescribed time.

(1)\* Upon the request of the applicant for a European patent or of the proprietor of a provisional ~~European patent, the central industrial property offices of the Contracting States shall apply the procedure for the grant of a national patent, based upon the European filing which, by virtue of Article 75, is equivalent to a national filing.~~

(2) The application must be made within a period of three months after the European patent application has been refused or withdrawn or the provisional European patent ~~has lapsed as a result of surrender or cancellation. The right conferred by Article 75 shall lapse if the application is not submitted within the prescribed period.~~

## CHAPTER IV

### CONVERSION OF THE EUROPEAN PATENT APPLICATION INTO A NATIONAL APPLICATION

#### Article 124 (114)

##### Application of national procedure

---

##### Chairman's proposal

---

(1) Upon the request of the applicant for a European patent, the central industrial property offices of the Contracting States in which the European patent application is, by virtue of Article 76, paragraph 1, equivalent to a regular national filing, shall apply the procedure for the grant of a national patent.

(2) The application must be made within a period of three months after the European patent applications has been refused or withdrawn or has been deemed to have been withdrawn. The right mentioned in Article 76 shall lapse if the application is not submitted within the prescribed period.

##### Note:

1. Having regard to the modified aims of the First Convention, the situation with reference to Article 76 (1) is now that the national procedure may be applied only in those Contracting States which have been designated in the European patent application in accordance with the provisions of Article 67.
2. In view of the fact that an application for conversion, especially in the case of the withdrawal of a European patent application, may be made shortly before publication of the latter pursuant to Article 85, the question arises of whether the system of national publication after 18 months is not likely to be affected in this manner and whether this should not be counteracted by certain restrictive measures with regard to the date of filing the application for conversion.

## Article 115

## Application for conversion

Preliminary Draft 1962	EFTA Draft	1965 Draft
(1) The application referred to in Article 114 shall be accompanied:	(1) The application referred to in Article 114 shall be accompanied:	(1) The application referred to in Article <u>114</u> shall be accompanied;
(a) by a copy of the application for a European patent, duly certified by the European Patent Office and of any documents received by that Office under Article 77, paragraph 1, and Article 81, and of a priority claim in respect of any earlier application; (b) by a copy of the novelty report, if any;	(a) +   (b) +	(a) by a copy of the application for a European patent, duly certified by the European Patent Office, and of any documents received by that Office under Article 77, paragraph 1, and Article <u>81</u> , and of any earlier application; (b) by a copy of the report on the state of the art, if any;
(c) by a certificate from the European Patent Office: (i) indicating the date upon which the application for the European patent was refused or withdrawn, or upon which the European provisional patent was cancelled or surrendered;	(c) by a certificate from the European Patent Office: (i) indicating the date upon which the application for the European patent was refused or withdrawn, or upon which the European patent was cancelled or surrendered or upon which the State in question was withdrawn from those covered by the application.	(c) by a certificate from the European Patent Office, (i)**indicating the date upon which the European patent application was refused or withdrawn, or upon which the <u>provisional European patent was cancelled or surrendered</u> ;

Article 125 (115)  
Application for conversion

---

Chairman's proposal

---

(1) ... Article 124

(a) + ... Article 78, paragraph 2 and Article 83

(b) +

(c) +

(i) indicating the date upon which the European patent application was  
refused or withdrawn, or upon which it was deemed to have been withdrawn;

(i)<sup>1)</sup> indicating the Contracting States designated in accordance with  
Article 67;

Article 115 contd. (2nd page)

1962 Draft	EFTA Draft	1965 Draft
(ii) indicating the latest claims which the applicant has established in the course of proceedings before the European Patent Office, apart from any which he may previously have abandoned;	(ii) +	(ii) - deleted -
(iii) specifying the elements of the state of the art, other than those mentioned in the novelty report, which were cited by the European Patent Office;	(iii) +	(iii) specifying the elements of the state of the art, other than those mentioned in the report on the state of the art, which were cited by the European Patent Office;
(d) by the fees payable on application for a national patent, or by proof of their payment.	(d) +	(d)* by the fees payable on application for a national patent, or by proof of their payment.

---

Chairman's proposal

---

(ii) - deleted -

Note:

1. As far as the Chairman was able to ascertain, the provision in paragraph c(ii) was deleted by the drafting committee of the "Patents" Working Party in connection with the deletion of the last sentence of Article 116 of the 1962 Draft (cf. page 26)

(iii) +

(d) +

(1a) Paragraph 1 shall be applicable to European patent applications which, under the terms of Article 65, paragraph 5, have not reached the European Patent Office, with the proviso that the certified copy referred to under (a) and the certificate referred to under (c), must be issued by the national central industrial property office with whom the European patent application has been filed. If application is made to the national central property office with whom the European patent application has been filed, the documents referred to in the first sentence need not be submitted; such application must, however, contain sufficient information to enable the patent application to be identified.

2. Paragraph 1a makes allowance for a peculiarity contained in Article 65 (5), i.e. cases in which the European patent application has not reached the European Patent Office at all. In that case the documents required may be issued by the national central industrial property office with which the application has remained.

Attention is drawn to the fact that the documents relating to a European patent application which is deemed to have been withdrawn pursuant to Article 65 (5), and whose conversion into a national application has been requested, can be forwarded to the national offices of the other Contracting States designated in accordance with Article 67 only 17 months after the European patent application has been filed or after the priority date; in such cases, national offices which publish national applications 18 months after the priority date will as a rule not be able to publish the converted European patent application within that period.

Article 115 contd. (3rd page)

---

Preliminary Draft 1962

## EFTA Draft

1965 Draft

---

(2) Each Contracting State may require a translation of the documents mentioned in paragraph 1, sub-paragraphs (a) and (c)(ii) in one of the official languages admitted by its central industrial property office, accompanied by an official certificate of conformity with the original text. The period allowed for the submission of these documents shall not be less than two months.

(2) +

(2) The national central industrial property office may, on request, grant an additional period for the submission of the documents referred to in paragraph 1.

(3) Each Contracting State may require a translation of the documents mentioned in paragraph 1 (a) into one of the official languages admitted by its central industrial property office, accompanied by an official certificate of conformity with the original text. The period allowed for the submission of these documents shall not be less than two months.

---

Chairman's proposal

---

(2) ... Paragraph 1 or 1a

(3) Each Contracting State may require a translation of the documents mentioned in paragraph 1(a) or of the certified copy mentioned in the first sentence of paragraph 1a or, in the case of the second sentence of paragraph 1(a), a translation of the documents in respect of the European patent application into one of the official languages admitted by its central industrial property office. The translation shall be accompanied by an official certificate of conformity with the original text. The period allowed for the submission of these documents shall not be less than two months.

## Article 116

## Validity of a national filing

1962 Draft

EFTA Draft

1965 Draft

The documents specified in Article 115, paragraph 1 (a), submitted under Article 114; and supported, where necessary, by the translation referred to in Article 115, paragraph 2, shall constitute a valid national filing, provided that they are accompanied by the document referred to in Article 115, paragraph 1 (b) or, failing this, provided that the national central industrial property office has certified that the formal requirements of a European patent application have been complied with. The claims of the national patent may not exceed in scope the claims referred to in Article 115, paragraph 1 (c) (ii).

+

(1) The documents specified in Article 115, paragraph 1(a), submitted under Article 114, and supported, where necessary, by the translation referred to in Article 115, paragraph 3, shall constitute a valid national filing, provided that they are accompanied by a copy of the report on the state of the art. Failing this, the documents referred to shall constitute a valid national filing only if the national central industrial property office has certified that the formal requirements of a European patent application have been complied with.

(2) It shall remain open to the Contracting States to decide that the protection sought by the claims of a national patent may not exceed in scope the claims published pursuant to Articles 85 or which remain in force after surrender pursuant to Article 124.

Article 126 (116)

Validity of national filing

---

Chairman's proposal

---

(1) + ... Article 125

... Article 124

... Article 125

Note:

This provision, which dates from 1962, gives expression to a number of ideas which recur in similar form in Articles 11 (4) and 27 (1) of the PCT. Under Article 11 (4) of the PCT, a valid international application has the effect in each country of destination of a regular national filing. Moreover, as far as the form and content of the international application are concerned, no country of destination may demand the fulfilment of any requirements other than those specified in the PCT and the PCT Regulations.

Under Article 126, a European patent application accompanied by a search report should be further dealt with by the national central industrial property offices without there being any need for renewed formal examination since such examination would already have been carried out by the European Patent Office. If no search report is as yet available, and if the national office has itself to conduct a search, it should be possible for it to carry out a new formal examination. In carrying out such examination, the national office should be bound by the requirements as to form laid down in the European Convention and its Implementing Regulations.

(2) It shall remain open to the Contracting States to decide that the protection sought by the claims of a national patent may not exceed in scope the claims published pursuant to Article 85.

## Article 117

## Notification and publication

## Preliminary Draft 1962

## EFTA Draft

## 1965 Draft

(1) A national central industrial property office is required to inform the European Patent Office of the receipt of any application submitted in accordance with Article 114, when the grant of the European provisional patent has been published. The application shall be entered in the European Register of Patents and published in the European Patent Bulletin.

(1) +

(1) The national central industrial property offices shall be required to inform the European Patent Office of the receipt of any application submitted in accordance with Article 114. Such application shall be entered ~~in~~ the Register of European Patents.

(2) The national central industrial property office shall publish the documents referred to in Article 115, paragraph 1 when, under national law, the documents relating to proceedings for a national patent can be so published. The specification of the national patent shall refer to the application for the European patent and, to the provisional European patent, if any.

(2) +

(2)\* The national central industrial property office shall publish the documents referred to in Article 115, paragraph 1, where under national law, the documents relating to proceedings for a national patent may be so published. The specification of the national patent shall refer to the application for the European patent and if any, to the provisional European patent.

Article 127 (117)

Notification and publication

---

Chairman's proposal

---

(1) The national central industrial property offices shall be required to inform the European Patent Office of the receipt of any application submitted in accordance with Article 124. Such application shall be entered in the Register of European Patents, provided the European patent application has been entered therein.

Note:

This amendment was necessary to take account of Article 59 (1), second sentence, and Article 85, (4).

(2) The national central industrial property office shall publish the documents referred to in Article 125, paragraphs 1 and 1(a) where, under national law, the documents relating to proceedings for a national patent may be so published. The specification of the national patent shall refer to the application for the European patent.

## Article 118

## Conversion of secret applications

Preliminary Draft 1962

EFTA Draft

1965 Draft

(1) In the event of an application for a European patent being subjected to secrecy in accordance with Article 67, paragraph (3), and upon the request of the applicant made within a period of three months calculated from the placing of the application on the secret list. Article 114 shall apply, subject to the provisions of national legislation relating to secret inventions. The request shall contain a reference to the application for the European patent upon which it is based, and shall be accompanied by the fees payable on application for a national patent, or by proof of payment thereof.

(2) A Contracting State may require a translation of an application for a European patent, under the conditions specified in Article 115, paragraph 2.

(3) The application for a European patent shall constitute a valid national filing in so far as it complies with the formal requirements laid down by the present Convention.

(1) +

(2) +

(3) +

(1) In the event of an application for a European patent being subjected to secrecy in accordance with Article 67, paragraph 3, and upon the request of the applicant, which must be submitted within a period of three months from the notification of the decision to make the application subject to secrecy, Article 114 shall apply, subject to the provisions of national legislation relating to the secrecy of inventions in the interests of the State. The request shall indicate the reference of the application for the European patent upon which it is based, and shall be accompanied by the fees payable on application for a national patent, or by proof of payment thereof.

(2) A Contracting State may require a translation of an application for a European patent, according to Article 115, paragraph 3.

(3) The application for a European patent shall constitute a valid national filing in so far as its form complies with the provisions of this Convention.

Article 128 (118)

Conversion of secret applications

---

Chairman's proposal

---

(1) In the event of an application for a European patent being subjected to secrecy, Articles 124 to 127 shall apply only subject to the provisions of national legislation relating to the secrecy of inventions in the interests of the State.

Note:

Article 128 covers all cases where a European patent application has been subjected to secrecy. As long as secrecy is maintained, subsequent filing in another Contracting State may be considered, provided agreement exists between the States concerned relating to the exchange of secret inventions. In addition, subsequent filing in other Contracting States may take place after the secrecy of the invention has been lifted in the country of origin.

The word "only" was inserted to emphasize the fact that Article 128 is an exceptional regulation.

(2) - deleted -

(3) - deleted -

