

# BR/GT I/49 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.



---

- Secretariat -

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

Proposals for amending the First Preliminary Draft Convention  
on the basis of the decisions taken by the Inter-governmental Conference  
after consultation of non-governmental international organisations  
at the 3rd meeting of the Conference, on 21 to 23 April 1970



## Introductory note

This working document contains proposals by the Chairman of Working Party I for amendments to the First Preliminary Draft Convention establishing a European System for the Grant of Patents, to be made on the basis of the decisions taken by the Inter-governmental Conference at its third meeting held on 21 to 23 April 1970.

The decisions of the Conference are contained in the Minutes of the second part of this meeting (BR/40/70 of 25 May 1970). Following the example of these Minutes, the proposed amendments given below follow the order in which the main problems were discussed at the meeting of the Conference. The instructions to Working Party I are given on the left, with a reference to the above-mentioned Minutes.

Of the main problems put before the non-governmental international organisations for discussion, the Inter-governmental Conference decided to amend the 1970 Draft in respect of the following only for the present:

- Problem 1: Maximum solution
- Problem 2: Term of the European patent
- Problem 5: Consideration of prior European rights
- Problem 6: Patent abstract
- Problem 8: Publication of the original claims
- Problem 9: Deferred examination procedure
- Problem 10: Opposition proceedings
- Problem 11: Composition of the Examining Division in opposition proceedings

BR/GT I/49 e/70 cm

As regards the third main problem (access to the patent) and the seventh main problem (effect of priority right), the Conference reserved the option to examine these points again at its next meeting, when it could take account of any contacts made at the Washington Conference on the PCT. In the opinion of the Chairman, the Working Party should prepare for this examination, and proposals for Articles 5 and 73 have therefore been included in this working document.

The fourth main problem (Simultaneous protection) did not lead the Conference to make any amendments. As regards the twelfth main problem (request for opinion of the Enlarged Board of Appeal by the President of the European Patent Office), the opinions of the experts from the Ministries of Justice will first have to be heard; the same applies in respect of other Articles of the 1970 Draft.

K E Y

1965 Draft

indicates the Draft Convention relating to a European Patent Law, drawn up by the EEC "Patents" Working Party and published in 1962, updated to take into account the amendments contained in the EEC "Patents" Working Party's working document 2335/IV/65 of 22 January 1965.

1970 Draft

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

Strasbourg Convention

indicates the Convention on the Unification of Certain Points of Substantive Law on Patents for Invention, signed at Strasbourg on 27 November 1963.

Minutes

indicates the second part of the Minutes of the third meeting of the Inter-Governmental Conference for the Setting up of a European System for the Grant of Patents, held at Luxembourg on 21-23 April 1970 (BR/40/70).

PCT

indicates the Patent Co-operation Treaty, signed at Washington on 19 June 1970.

PCT Regulations

indicates the Regulations under the Patent Co-operation Treaty.



+ in the column headed "Chairman's proposal"	indicates that the text in the column to the left is adopted without amendment.
--- 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 underlined is new in relation to the 1965 Draft or the 1970 Draft. Completely new paragraphs are not, however, underlined.

Article 2

European Patent

---

Instructions to the Working Party

1970 Draft

---

/To/ prepare the texts required by the maximum solution, under which the validity of a European patent would be judged after grant in accordance with the provisions of Articles 9 to 14. A reserve clause for the application of grounds for revocation drawn from national law would be printed between square brackets, so that the Conference could reach a decision at a later date as to its retention or deletion;

/To/ examine the possibility of making provision in the Convention for the criteria of validity for national patents granted by national patent offices on the basis of national legislation to be made subject to the criteria laid down by the Convention."

Minutes, point 4, pages 2 and 3

Article 2 paragraph 2

(2) Subject to the provisions of this Convention 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. This shall apply in particular to the term of the patent, the grounds of revocation and the exercise of the rights attached to the patent.

## Article 2

### European patent

---

#### Chairman's proposal

---

#### Article 2, paragraph 2

(2) Subject to the provisions of this Convention 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 for by this Convention.

#### Note:

The newly introduced reservation mainly concerns Articles 133 (new) (Grounds for revocation) and 20a (new) (Term) which are proposed in pages 9 and 15 below. The "exercise of the rights attached to the patent" formerly mentioned in the second sentence as an example for the application of national law has been deleted. The application of national law follows in any case from the principle of Article 2 itself, and is also mentioned in Article 18.

With regard to the reserve clause envisaged by the Conference, reference should be made to Article 188a (new), paragraph 1a (see page 17).

The Chairman has not made any proposal in respect of the second paragraph of the instructions to the Working Party, since it would seem expedient for the Working Party first to decide on its position in principle as regards this problem.

Article 127

Grounds for revocation

---

Instructions to the Working Party

1965 Draft

---

See under <sup>11</sup>Article 2

(1) A final European patent shall be revoked, on request,

- (a) if the subject matter of the patent is not patentable within the terms of Articles 9 to 14 and having regard to Article 24, paragraphs 3 and 4,
- (b) if the description, claims and drawings do not satisfy the requirements of Article 70,
- (c) if, in the case of a patent of addition, its subject matter does not constitute a development, supplementing or change within the meaning of Article 24, paragraph 1, and if it does not satisfy the provisions of Article 13,
- (d) (deleted; see Article 207, paragraph 2).

(2) If the patent is only partially contrary to the provisions of the preceding paragraph, revocation shall be pronounced in the form of a corresponding limitation of the said patent.

PART VII

REVOCATION OF THE EUROPEAN PATENT

Article 133 new (127)  
Grounds for revocation

---

Chairman's proposal

---

(1) A European patent may only be revoked in a Contracting State with effect on its territory, subject to the provisions of paragraph 3,

- (a) if the subject matter of the patent is not patentable within the terms of Articles 9 to 14, and having regard to Article 21, paragraph 5,
- (b) if the description, claims and drawings do not satisfy the requirements of Article 71,
- (c) if, in the case of a patent of addition, its subject matter does not constitute an improvement, development or supplementing within the meaning of Article 21, paragraph 1, and if it does not satisfy the provisions of Article 13,
- (d) if the protection conferred by the European patent extends beyond the content of the filed European patent application, or if the protection conferred by the patent has, contrary to Article 104, been extended during opposition proceedings.

(2) +

Note:

It seemed expedient to include as grounds for revocation not only the requirements in respect of the patent, within the terms of Articles 9 to 14, as expressly decided by the Inter-governmental Conference, but also those contained under (b) and (c) of the 1965 Draft, namely inadequate disclosure and lack of inventiveness where the content of the patent represents no supplement to existing knowledge.

It is, moreover, proposed to include as a ground for revocation that in Article 57 (127), paragraph 1(d) of the second Convention. This is the case referred to here in the first half sentence of (d): this is the case in which the subject matter of the European patent extends beyond the content of the filed European patent application. Such a case may, in particular, occur where the European patent application has not been filed in one of the languages mentioned in Article 34 (1) but in another language, in accordance with Article 34 (2), and is only translated into one of the languages mentioned in Article 34 (1) later. The European patent would then be revocable to the extent to which its subject matter was not originally contained in the application, but was the result of "excessive translation". The proposal, in addition to this case, deals with that covered by Article 104 (second half of (d)). The latter is the case where, within the meaning of Article 104,



---

Chairman's proposal

---

unauthorized extension of the protection conferred by the patent occurs during opposition proceedings.

In contrast to the 1965 Draft, it has not here been stated that the European patent may be revoked "on request". This feature of the law governing procedure has been left to the national law. Again, it has not been expressly stated that revocation procedure is to be based on national law. This should be obvious.





Article 134 new

Prior national rights

---

Chairman's proposal

---

Note:

If, a national patent or application for a national patent has been made public on or after the priority date of a European patent, in one of the Contracting States, and if the national patent or the application for a national patent has an earlier priority date than that of the European patent, the European patent shall, in that Contracting State, be treated, with regard to the prior national right, exactly as if it were a national patent.

The 1970 Draft does not so far contain any provisions concerning the effects of prior national rights on the European patent. In the event of the maximum solution being adopted, a provision covering this matter would appear expedient. The provision has been adapted from Article 9 of the First Preliminary Draft of the second Convention.

14  
Problem 2: Term of the European patent

Article 23

Term of the European patent

---

Instructions to the Working Party

1962/1965 Draft

---

"~~To~~7 prepare a text laying down a uniform term for the European patent, and comprising a reservation clause to be printed between square brackets."

A European patent shall cease to be valid on a date not later than twenty years from the date of filing the application.

Minutes, page 3, point 8

Article 20a new (23)

Term of the European patent

---

Chairman's proposal

---

Note:

As regards the reserve clause stipulated by the  
Conference, cf. Article 188a (new), paragraph 1(b).

---

Instructions to the Working Party

Strasbourg Convention

---

See under Article 2 and Article 20a new (23)

Article 12

1. ~~Notwithstanding anything in this Convention, each Contracting Party may, at the time of signature or when depositing its instrument of ratification, acceptance or accession, temporarily reserve, for the limited period stated below, the right:~~

- ~~(a) not to provide for the grant of patents in respect of food and pharmaceutical products, as such, and agricultural or horticultural processes other than those to which paragraph (b) of Article 2 applies;~~
- ~~(b) to grant valid patents for inventions disclosed within the six months preceding the filing of the application, either, apart from the case referred to in paragraph 4 (b) of Article 4, by the inventor himself, or, apart from the case referred to in paragraph 4 (a) of Article 4, by a third party as a result of information derived from the inventor.~~

2. ~~The limited period referred to in paragraph 1 of this Article shall be ten years in the case of sub-paragraph (a) and five years in the case of sub-paragraph (b). It shall start from the entry into force of this Convention for the Contracting Party considered.~~

3. Any Contracting Party which makes a reservation under this Article shall withdraw the said reservation as soon as circumstances permit. Such withdrawal shall be made by notification addressed to the Secretary-General of the Council of Europe and shall take effect one month from the date of receipt of such notification.

Article 188a new

Reservations

---

Chairman's proposal

---

(1) Each Contracting State may, at the time of signature or when depositing its instruments of ratification or accession, reserve, for the limited period stated below, the right to provide

- (a) that, by derogation from Article 133, European patents in respect of food and pharmaceutical products, as such, and agricultural or horticultural processes other than those to which Article 10 (b) applies, shall, in accordance with the provisions applicable to national patents, be ineffective or revocable;
- (b) that, by derogation from Article 20a, European patents shall have a term shorter than twenty years, in accordance with the provisions applicable to national patents.

(2) The limited period referred to in paragraph 1 shall be ten years. It shall start from the entry into force of this Convention.

(3) Any Contracting State that makes a reservation under this Article shall withdraw this reservation as soon as circumstances permit. Such withdrawal shall be made by notification addressed to ... and shall take effect one month from the date of receipt of such notification.

Note:

The proposal is adapted from Article 12 of the Convention on the Unification of Certain Points of Substantive Law on Patents for Invention signed at Strasbourg on 27 November 1963.

In the proposal, the words "in accordance with the provisions applicable to national patents" have been inserted to make it clear that the reservation may only be applied in respect of European patents if the restrictions concerned apply to national patents.

Article 5

Persons entitled to apply for a European patent

---

Instructions to the Working Party

1970 Draft

---

"The Conference agreed to retain the text of Article 5 as published in the First Preliminary Draft. It reserved the right to re-examine this question at its next meeting, in the light of such contracts as might be made in the meantime at the Washington Conference."

Minutes, page 3, point 9

(1) An application for a European patent may be made by any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it, possessing the nationality of one of the Contracting States or who is domiciled in or has a real and effective industrial or commercial establishment in the territory of one of the Contracting States.

(2) An application for a European patent may also be made by any natural or legal person or any body equivalent to a legal person by virtue of the law governing it, possessing the nationality of a non-Contracting State, or who is domiciled in or who has a real and effective industrial or commercial establishment in the territory of a non-Contracting State, in so far as the legislation of such State grants to nationals of the Contracting States the same advantages as regards the protection of inventions as it grants to nationals of the said State, and in particular in so far as it does not subject the grant of a patent to conditions which can only be met in the territory of the State in question. Provided that this shall not apply to the provisions of the legislation of non-Contracting States relating to judicial and administrative procedure and to jurisdiction, and to the designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property.

## Article 5

### Persons entitled to apply for a European Patent

---

#### Chairman's proposal

---

An application for a European patent may be made by any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it.

- deleted -

#### Note:

According to Article 45 (1) of the Patent Cooperation Treaty (PCT) signed at Washington on 19 June 1970, the first Convention can in principle only permit the grant of a European patent via the PCT route if European patents may be obtained by any person entitled to apply for an international patent under the PCT. To take account of this provision of the PCT in the first Convention, there are potentially two solutions:

1. A third paragraph must be added to Article 5 of the 1970 Draft, providing that, by derogation from Article 5 (2) all persons entitled to apply for patents under the PCT shall, without restriction, be entitled to apply for a European patent, or
2. any person shall, without restriction, have the right to apply for a European patent.

The Chairman proposes that the second solution be chosen for the First Convention.

Article 13

Inventive step

---

Instructions to the Working Party

1970 Draft

---

"The Conference agreed, although certain delegations pointed out the difficulties that might be caused thereby, to support provisionally the unanimous opinion expressed by the non-governmental international organisations, namely that the first variant of Article 13 should be adopted".

Minutes, page 4, point 11

1st variant

An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

2nd variant

An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, each of these documents is to be considered separately in deciding whether there has been an inventive step.



Article 13  
Inventive step

---

Chairman's proposal

---

1st variant

+

2nd variant

- deleted -

Article 66 (68)

Requirements of the application

---

Instructions to the Working Party

1970 Draft

---

"The Conference instructed Working Party I to prepare the text of a clause, to be printed between square brackets, providing for an abstract to be attached to the application. This abstract should, in principle, be addressed to the European Patent Office, at the same time as the application, and at latest before publication of the latter. The abstract, which would be checked by the IIB, would not leave any legal effect, however".

Minutes, page 5, point 15, paragraph 1

Further documentation:

Article 3 (2) and (3) of the PCT  
Rules 8 and 38 of the Regulations under the PCT

(1) An application for a European patent shall contain:

- (a) a request for the grant of a European patent;
- (b) a description of the invention;
- (c) one or more claims defining the protection applied for;
- (d) any drawings referred to in the description or the claims;

(2) The application shall be written in one of the languages referred to in Article 34, paragraphs 1 and 2.

(3) An application for a European patent shall be subject to the payment of the filing fee prescribed in the Rules relating to fees adopted pursuant to this Convention. This fee must be paid within one month after the filing date.

## Article 66 (68)

## Requirements of the application

---

Chairman's proposal

---

(1) +

Note:

(a) +

(b) +

(c) +

(d) +

/(e) an abstract/

(2) +

(3) +

/(4) The only purpose of the abstract is to give technical information and it cannot be considered for any other purposes, particularly for interpreting the extent of the protection sought7.

Paragraph 4 corresponds word for word to Article 3 (3) of the PCT.

Details about the form and content of the abstract (e.g. special paper, length about 50-100 words)

BR/GT I/49 e/70 cm

---

Chairman's proposal

---

should be included in the Implementing Regulations. The Implementing Regulations should, as far as possible, be based on Rule 8 of the PCT Regulations.

In the interests of the harmonization of this Convention with the PCT, the Chairman proposes that, it be laid down, to correspond with Article 14 (1)(a)(iv) of the PCT, that the abstract must in principle be filed together with the application.

Problem 6: Patent abstract

## Article 77 (76)

Examination of the European patent application for  
formal and obvious deficiencies

---

Instructions to the Working Party

1970 Draft

---

See under Article 66

(1) The examining Section shall determine whether an application for a European patent complies with the requirements of Articles 66 to 68.

(2) When an application for a European patent has been validly made, the Section shall examine:

- (a) whether, by its nature, the subject matter of the application is obviously not an invention within the meaning of Article 9;
- (b) whether the invention is obviously not patentable by virtue of Article 10;
- (c) whether the invention is obviously not susceptible of industrial application within the meaning of Article 14;
- (d) whether the application is obviously not contrary to Articles 70 and 71;
- (e) whether the application satisfies the requirements regarding form laid down in the Implementing Regulations to this Convention and whether the contents of the description, claims and drawings are obviously not contrary to the relevant provisions of the Implementing Regulations;
- (f) whether, in the case of an application for a patent of addition, the subject of that application is obviously not an improvement, development or supplementing within the meaning of Article 21, paragraph 1.

Article 77 (76)

Examination of the European patent application  
for formal and obvious deficiencies

---

Chairman's proposal

---

Note:

It is suggested that formal examination be extended to  
the content of the abstract.

(1) +

(2) +

(a) +

(b) +

(c) +

(d) +

(e) whether the application satisfies the  
requirements regarding form laid down  
in the Implementing Regulations to this  
Convention and whether the contents  
of the description, claims, drawings  
and /the abstract/are obviously not  
contrary to the relevant provisions of the  
Implementing Regulations;

(f) +

Article 79 (78)

Obtaining of report on the state of the art

---

Instructions to the Working Party

1970 Draft

---

See under Article 66

Article 79, paragraph 3

(3) On the date of payment of the fee or, if the latter has already been paid, on concluding the examination, the Examining Section shall request the International Patent Institute at The Hague to supply a report on the state of the art and shall transmit to it the documents of the application for the European patent.



Article 79 (78)

Obtaining of report on the state of the art

---

Chairman's proposal

---

Article 79, paragraph 3

(3) On the date of payment of the fee or, if the latter has already been paid, on concluding the examination, the Examining Section shall request the International Patent Institute at The Hague to supply a report on the state of the art and shall transmit to it the documents of the application for the European patent. The International Patent Institute at The Hague shall also determine the definitive contents of the abstract.

Note:

The proposal corresponds to the provisions of Rule 38.2 (b) of the Regulations under the PCT.

The details of this task of the International Patent Institute at The Hague should be incorporated in the Implementing Regulations, on the basis of Rule 38 of the PCT Regulations.

Problem 7: Effects of priority right

## Article 74 (73)

## Effect of priority right

---

Instructions of the Working Party1970 Draft

---

"The Conference agreed to retain the text of the note to Article 74 of the First Preliminary Draft. It will re-examine the matter at its next meeting, in the light of any contacts made at the Washington Conference."

Minutes, page 5, point 16

The right of priority shall have the effect that the date of the first filing shall count as the date of filing the application for a European patent for the purposes of Article 11, paragraphs 2 and 3, and Article 15, paragraph 1.

Note to Article 74

The question will be re-examined later whether to deny for prior art purposes in relation to another application or patent the priority date claimed in European applications which are based on applications filed in States which do not, in their national laws, make the priority date of foreign patent applications effective also for prior art purposes, though as a general rule including the content of patent applications in the state of the art as from the date of filing.

Article 74 (73)

Effect of priority right

---

Chairman's proposal

---

+

Note:

The Chairman proposes that, in view of the discussions of Working Party IV of the Principal Committee I of the Washington Conference on the PCT, the note to Article 74 be deleted.

- deleted -

Problem 8: Publication of the original claims

Article 85 (86a)

Publication of a European patent application

---

Instructions to the Working Party

1970 Draft

---

"Publication of the patent claims in the three languages of the Convention at the same time as the publication of the application, and publication of the original claims in the language in which the application was filed."

Minutes, page 6, point 17

Article 85, paragraph 3

(3) If before such publication, the European patent application has been divided pursuant to Article 81, or the claims amended pursuant to Article 82, the original patent claims shall be included in the publication in addition to the new or amended claims.

## Article 85 (86a)

### Publication of a European patent application

---

#### Chairman's proposal

---

#### Article 85, paragraph 3

(3) If before such publication, the European patent application has been divided pursuant to Article 81, or the claims amended pursuant to Article 82, the original patent claims shall be included in the publication in addition to the new or amended claims. The original patent claims shall be published only in the language in which the European patent application was filed or into which it was translated in accordance with Article 34, paragraph 2.

#### Note:

There is no need to regulate the publication of the patent claims in the three languages of the Convention in Article 85 (3), since this is already provided for by Article 34, (5) second half sentence.

It should be examined later whether it would not be better to include the whole of paragraph 3 in the Implementing Regulations.

Article 79 (78)

Obtaining of report on the state of the art

---

Instructions to the Working Party

1

1970 Draft

---

"Fixing a time limit of three months for the IIB to draw up the report on the state of the art."

Minutes, page 7, point 20, second paragraph, sub-section (ii)

---

Relevant PCT texts

---

Article 18, paragraph 1 PCT

(1) The international search report shall be established within the prescribed time limit and in the prescribed form.

Rule 42.1 of the PCT Regulations

All agreements concluded with International Searching Authorities shall provide for the same time limit for establishing the international search report or the declaration referred to in Article 17(2)(a). The time limit shall not exceed 3 months from the receipt of the search copy by the International Searching Authority, or 9 months from the priority date, whichever time limit expires later.

Article 79, paragraphs 3 and 4

(3) On the date of payment of the fee or, if the latter has already been paid, on concluding the examination, the Examining Section shall request the International Patent Institute at The Hague to supply a report on the state of the art and shall transmit to it the documents of the application for the European patent.

(4) The report on the state of the art shall be drawn up on the basis of the claims, with due regard to the description and the drawings, if any.

Article 79 (78)

Obtaining of report on the state of the art

---

Chairman's proposal

---

Article 79, paragraphs 3 and 4

(3) +

Note:

The amendments to be made should be adapted from the PCT. The time limit should be laid down in the Implementing Regulations on the model of Rule 42.1 of PCT Regulations.

(4) The report on the state of the art shall be drawn up on the basis of the claims, with due regard to the description and the drawings, if any. It shall be drawn up within the time limit and in the form prescribed in the Implementing Regulations.

Article 88

Request for examination

---

Instructions to the Working Party

1970 Draft

---

To take into account:

"A two-stage system of examination;

Filing the request for examination against payment of the fee laid down for this purpose within a period of two years from filing the application, or, where appropriate, from the date of priority of the application; the request period might also be six months as from the receipt of publication of the IIB report on the state of the art;

Retention of the provision laying down that the request for examination may be filed at the same time as the application;

Deletion of the note to Article 88(2)..."

Minutes, page 7, point 20, second paragraph, sub-sections (i), (iii), (iv) and (v).

Article 88, paragraphs 1 and 2

(1) The European Patent Office shall examine, on request, whether a European patent application and the invention which forms the subject thereof meet the requirements of this Convention.

(2) Such a request may be made by the applicant or by any other person up to the end of two/five/seven years from the filing of the European patent application. ~~The request shall not be considered to be made until after the examination fee prescribed by the Rules relating to fees adopted pursuant to this Convention has been paid.~~

Note to Article 88 paragraph 2:

If the period referred to in paragraph 2 were to be long, it would be necessary to study the desirability of laying down procedures enabling third parties to introduce a request for examination on payment of a part only of the examination fee.



## Article 88

### Request for examination

---

#### Chairman's proposal

---

#### Article 88, paragraphs 1 and 2

(1) +

(2) Such a request may be made by the applicant or by any other person up to the end of six months after the receipt by the applicant of the report on the state of the art, pursuant to Article 80 and at least up to the expiry of a period of two years from the filing of the patent application or, if a priority has been claimed, from the date or earliest date of priority. The request shall not be considered to be made until after the examination fee prescribed by the Rules relating to fees adopted pursuant to the Convention has been paid.

- deleted -

#### Note:

The retention of the two-stage examination system already contained in the Convention, and of the possibility of making the request for examination simultaneously with the application, follows from maintaining the former paragraph 1 without amendment.

Paragraph 2 is adapted from the formulation of Article 85 (1), first sentence.

The earlier note to paragraph 2 shall be deleted.

Article 89 (88a)

Modification of the procedure by the Administrative Council

---

Instructions to the Working Party

1970 Draft

---

/To take into account./

"A transitional period during which the request period might be longer than that finally adopted in Article 88;

In that event, the Administrative Council would have the power to shorten the request period during the transitional period; but not to lengthen it.

Deletion of paragraphs 2 to 4 of Article 89."

Minutes, page 8, point 20, second paragraph, sub-sections (vi) and (vii).

(1) The Administrative Council may reduce or prolong the period laid down in Article 88, paragraph 2, for making a request for examination.

(2) In certain areas of technology, the Administrative Council may direct that applicants are to make a request for examination on the invitation of the European Patent Office, where such ruling is in the public interest.

(3) In certain areas of technology, the Administrative Council may direct that applicants are to make a request for examination on the invitation of the European Patent Office, when the work load of the European Patent Office permits of immediate examination in this area.

(4) Where a direction pursuant to paragraph 2 or 3 is in force, the European Patent Office shall invite the applicant to make a request for examination, and to pay the examination fee, within a period of six months. If the fee is not paid in due time, the European Patent application shall be deemed to be withdrawn.

Note to Article 89 (1)

This paragraph should be re-examined after the period laid down in Article 88, paragraph 2, has been fixed.

Article 188b new

Period within which a request for examination may be made during a  
transitional period

---

Chairman's proposal

---

(1) During a transitional period of ... years as from the entry into force of this Convention, the period laid down in Article 88, paragraph 2, within which a request for examination may be made, shall be three years after the receipt by the applicant of the report on the state of the art, pursuant to Article 80, and five years after filing the patent application or, if a priority has been claimed, as from the date or earliest date of priority.

(2) The Administrative Council may reduce the periods laid down in paragraph 1 above to the length of the periods laid down in Article 88, paragraph 2, before the expiry of the transitional period mentioned in paragraph 1 above. The decision to reduce these periods shall be published in the European Patent Bulletin.

(3) The reduced period within which the request for examination may be made shall only apply in respect of European patent applications filed after the expiry of the transitional period or after the date of publication of the decision of the Administrative Council.

Note:

The whole of Article 89 (88a) of the 1970 Draft and the note thereto are to be deleted.

- deleted -

Problem 10: Opposition proceedings

## Article 100 (96c)

## Translation of specifications

---

Instructions to the Working Party1970 Draft

---

"It was agreed, more precisely, to invite Working Party I to examine whether it would be possible to reduce the period laid down in Article 100 of the First Preliminary Draft for the translation of a patent into a language other than the official languages laid down by the Convention."

Minutes, page 8, point 21, second paragraph

Article 100, paragraph 1

(1) If the specification of a European patent has not been drawn up in one of the official languages of a Contracting State for which the European patent has been granted, that State may prescribe that the proprietor of the European patent must send to the national central industrial property office, within a period of not less than three months after the date of publication of the grant of the patent in the European Patent Bulletin:

(a) a translation of the specification into an official language of that State, or

(b) a fee for the preparation of an official translation of the specification into an official language of that State.

Article 100 (96c)

Translation of specifications

---

Chairman's proposal

---

Article 100, paragraph 1

(1) + one month

(a) +

(b) +

Note:

Reducing the time limits for submitting the translation by two months would appear possible if, following a proposal by the Danish delegation, the time between notification pursuant to Article 97, (1) first sentence, and the notification of the grant of the patent pursuant to Article 97 (4) is used for preparing the translation. On average, this period would amount to three to four months. And applicants have up to one month in which to pay the fees. A further two to three months would probably be taken up with the preparations for printing and the actual printing of the specifications. The grant of a patent cannot be published until the specification is ready (cf. Article 98 (1)).

Apart from that, the European Patent Office can, of course, speed up or delay printing of the specifications. It might be worth examining whether the Implementing Regulations should give an applicant the right to require the European Patent Office to suspend printing of the specifications until a certain date.

To enable the printing time to be used for preparing the translation, the Implementing Regulations should further lay down that at the time of notification pursuant to Article 97 (1), the possible need for translations pursuant to Article 100 must be pointed out to the applicant.

Problem 10: Opposition proceedings

## Article 101 (96d)

## Opposition

Instructions to the Working Party	1970 Draft
<p data-bbox="297 506 1120 624">"The Conference agreed to instruct Working Party I ..... to study the possibility of shortening the twelve month period at present provided for in the Preliminary Draft."</p> <p data-bbox="297 658 1019 688">Minutes, page 8, point 21, first paragraph</p>	<p data-bbox="1171 506 1839 535"><u>Article 101, paragraph 1, first sentence</u></p> <p data-bbox="1171 535 2112 654">(1) Within a period of twelve months from the date of the publication pursuant to Article 97, paragraph 4, any person may give notice to the European Patent Office of opposition to the European patent granted.</p>

Article 101 (96d)

Opposition

---

Chairman's proposal

---

Article 101, paragraph 1 (1)

(1) Within a period of ... months from the date of the publication pursuant to Article 97, paragraph 4, any person may give notice to the European Patent Office of opposition to the European patent granted.

Note:

The reduction of the period for translation pursuant to Article 100 in any case shortens the period of opposition from twelve to ten months. Whether, and by how much, the opposition period can be reduced further, will depend above all upon the time the Contracting States requiring a translation of the specifications will need for publishing such translation. It will be necessary to allow competitors a period of three months from the date of the publication of a translation to decide whether they wish to oppose a European patent or not. Following this, the opposition period would probably be between six and nine months. Whatever time limit will be decided upon by the Working Party, the possibility that in practice the periods will subsequently prove either too short or too long, cannot be excluded. For that reason, it would appear advisable to include a provision in the Convention allowing this period to be modified by a comparatively simple procedure. In this context, the Chairman would refer to the provisions of Article 47 (2) of the PCT, and suggests that the inclusion of a similar provision in the European Convention be considered.

Problem 10: Opposition proceedings

---

Instructions to the Working Party

1970 Draft

---

"The Conference agreed to maintain the provisions laid down in the Preliminary Draft and to instruct Working Party I to draw up such provisions as will still have to be laid down for opposition proceedings".

Note to Article 101

The grounds on which an opposition may be lodged, mainly those based on Articles 9 to 14, will need to be specified later.

Minutes, page 8, point 21, first paragraph



Article 101a (new)

Grounds for opposition

---

Chairman's proposal

---

Opposition may only be lodged on the grounds that

- (a) the subject matter of the patent is not patentable within the terms of Articles 9 to 14 and having regard to Article 21, paragraph 5,
- (b) the description, claims and drawings do not satisfy the requirements of Article 71,
- (c) in the case of a patent of addition, its subject matter does not constitute an improvement, development or supplementing within the meaning of Article 21, paragraph 1, and that it does not satisfy the provisions of Article 13,
- (d) the protection conferred by the European patent extends beyond the content of the filed European patent application.

Note:

The Chairman suggests that the grounds for opposition to be admitted be only those which bring into question the legal validity of a granted European patent. These are the grounds for revocation. The newly proposed Article 101a thus agrees with the new proposal for Article 133. The existence of an earlier national application is not included as a ground for opposition. This is dealt with separately by Article 134 (new) (cf. Problem 1).



Article 101b (new)

Examination of opposition

---

Chairman's proposal

---

(1) If the opposition is admissible, the Examining Division shall examine the facts; this examination shall not be restricted to the arguments or contentions of the parties concerned.

(2) The Examining Division may disregard fresh facts or evidence submitted by the parties concerned, which were not included in the statement of grounds for opposition or in the reply to the opposition.

/(3) Article 94 shall apply.7

Note:

This new Article 101b is intended to take account of the contents of the note to Article 105, since the principle that further official enquiries should be made also applies to the opposition proceedings.

Paragraphs 1 and 2 correspond to Article 113, (1) and (2) concerning appeal proceedings.

Paragraph 3 is shown in brackets because it need be included only in the event of the Working Party adopting the first variant for Article 105 below.

Problem 10: Belated opposition

## Article 105 (101)

## Decision in opposition proceedings

Instructions to the Working Party

1970 Draft

See Article 101a

Article 105, paragraphs 1 to 3

(1) If the Examining Division is of the opinion that the requirements referred to in Article ... have not been met, ~~it shall revoke the European patent.~~

(2) If the Examining Division is of the opinion that the requirements referred to in Article ... have been met, without any need to amend the specification, it shall reject the opposition.

(3) If the Examining Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the requirements referred to in Article ..., have been met, ~~it shall inform the parties that it intends to maintain~~ the European patent as amended and shall request the proprietor of the patent to pay, within a period of one month, the fee prescribed for the printing of the new specification by the Rules relating to fees adopted pursuant to this Convention. If the fee is not paid in due time, the European patent shall be revoked. When the fee for the printing of the new specification has been paid, the Examining Division shall decide to maintain the European patent as amended. The provisions of Article 20, paragraph 2, are applicable mutatis mutandis.

Article 105 (101)

Decision in opposition proceedings

---

Chairman's proposal

---

Article 105 paragraphs 1 to 3

First variant

(1) If the Examining Division is of the opinion that a European patent and the invention to which it relates do not meet the requirements of this Convention, it shall revoke the European patent.

(2) If the Examining Division is of the opinion that a European patent and the invention to which it relates do meet the requirements of this Convention, it shall reject the opposition.

(3) If the Examining Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent in the opposition proceedings, the European patent and the invention to which it relates meet all requirements, it shall inform the parties that it intends to maintain the European patent as amended and shall request the proprietor of the patent to pay, within a period of one month, the fee prescribed for the printing of the new specification by the Rules relating to fees adopted pursuant to this Convention. If the fee is not paid in due time, the European patent shall be revoked. When the fee for the printing of the new patent specification has been paid, the Examining Division shall decide to maintain the European patent as amended. The provisions of Article 20, paragraph 2, are applicable mutatis mutandis.

Note:

Opposition procedure could take one of the following forms:

1. As with the classic opposition procedure prior to the grant of the patent, opposition proceedings could take the form of renewed examination proceedings, with the participation of third parties, in the course of which examination may be made as to whether all the requirements to be met, as examined by the Examining Division pursuant to Article 88 (1), have been met. If this method were to be adopted, the Examining Division would be able to mark all formal deficiencies (particularly linguistic shortcomings or faulty drafting of the claims) as well as any lack of unity of the invention protected. Opposition proceedings of this type would have the result that the European patent specification and the translations thereof pursuant to Article 100 would have to be amended in many cases, without there being any change in the extent of the protection conferred by the patent.

Article 105 (101) contd. page 2

---

Instructions to the Working Party1970 Draft

---

See under Article 101a

Article 105, paragraphs 1 to 3

(1) If the examining Division is of the opinion that the requirements referred to in Article ... have not been met, ~~it shall revoke the European patent.~~

(2) If the Examining Division is of the opinion that the requirements referred to in Article ... have been met, ~~without any need to amend the specification, it shall reject the~~ opposition.

(3). If the Examining Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the requirements referred to in Article ... have been met, ~~it shall inform the parties that it intends to maintain the European patent~~ as amended and shall request the proprietor of the patent to pay, within a period of one month, the fee prescribed for the printing of a new specification by the Rules relating to fees adopted pursuant to this Convention. If the fee is not paid in due time, the European patent shall be revoked. When the fee for the printing of the new specification has been paid, the Examining Division shall decide to maintain the European patent as amended. The provisions of Article 20, paragraph 2 are applicable mutatis mutandis.

---

Chairman's proposal

---

Article 105, paragraphs 1 to 3

Second variant

(1) If the Examining Division is of the opinion that the grounds for opposition mentioned in Article 101a prejudice the maintenance of a patent, it shall revoke the European patent.

(2) If the Examining Division is of the opinion that the grounds for opposition mentioned in Article 101a do not prejudice the maintenance of the patent, it shall reject the opposition, if there is no need to amend the specification.

(3) If the Examining Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the grounds for opposition mentioned in Article 101a do not prejudice the maintenance of the patent, it shall inform the parties that it intends to maintain the patent as amended and shall request the proprietor of the patent to pay, within a period of one month, the fee prescribed for the printing of a new specification by the Rules relating to fees adopted pursuant to this Convention. If the fee is not paid in due time, the European patent shall be revoked. When the fee for the printing of the new specification has been paid, the Examining Division shall decide to maintain the European patent as amended. The provisions of Article 20, paragraph 2, are applicable mutatis mutandis.

Note:

2. Opposition proceedings could take the form of revocation proceedings, with the provision that a European patent may be revoked or amended only if one of the grounds mentioned in Article 101a applies. In this connection, reference is made to the fact that the Examining Division is not limited, in opposition proceedings, to consideration of the grounds brought forward by the opposing party, but may itself re-examine a European patent as regards grounds for opposition (see also the preceding Article 101b). This form of proceedings should preclude both the claim of lack of unity and the division of the European patent on the request of the proprietor of the patent. It would probably result in fewer amendments to the European patent in opposition proceedings, and would also be reconcilable with the concept of belated opposition.

This is the basic problem which will have to be decided by the Working Party. For that reason, the Chairman has proposed a variant for each alternative.





Article 105a (new)

Effect of decision

---

Chairman's proposal

---

(1) Once the decision revoking the European patent has become final, the patent shall be deemed not to have had, as from the outset, the effects specified in Article 18.

(2) Paragraph 1 shall apply *mutatis mutandis* in so far as the European patent maintained as amended confers less protection than the granted European patent.

Note:

This new Article 105a proposes the retrospective effect of revocation. The text is similar to that of Article 128, (1) of the 1962/65 Draft. It remains to be seen whether there is any need for paragraph 2, or whether the provisions of that paragraph do not follow from a corresponding interpretation of paragraph 1.

Problem 10: Opposition proceedings

---

Instructions to the Working Party1970 Draft

---

See under Article 101a

Notes concerning opposition procedure (Articles 101 to 106), printed under Article 106:

1. It will have to be examined whether other provision should be made within the framework of the opposition procedure, concerning, particularly, surrender, lapse, the retrospective effect of revocation and the plurality of proprietors for different countries.
2. ... (see below)

Open questions concerning opposition proceedings

(see Notes under Article 106 of the 1970 Draft)

---

Chairman's proposal

---

With regard to Note 1 on the left, the Chairman proposes that the following paragraph 1a be inserted in Article 101:

(1a) The opposition shall cover the European patent in all the Contracting States in which it has effect. The proprietors in the various States shall be deemed to be joint proprietors for the purposes of opposition proceedings.

Note:

Of the open questions referred to in Note 1 under Article 106, the case of revocation is dealt with by the proposed Article 105a. Beyond that, no special provisions in respect of surrender and lapse due to non-payment of renewal fees would appear necessary.

The case of plurality of proprietors for different States is covered by the proposal on the left, relating to Article 101, paragraph 1a.

Problem 10: Opposition proceedings

---

Instructions to the Working Party1970 Draft

---

See under Article 101a

Notes concerning opposition proceedings (Articles 101 to 106), printed under Article 106:

1. ... (see above)
2. It will be necessary to study whether there should be some limitation of the possibility of engaging in national revocation actions on a European patent, or of deciding such actions, until time limit for opposition has expired or a final decision in an opposition has been given.

Open questions concerning opposition proceedings

(see Notes under Article 106 of the 1970 Draft)

---

Chairman's proposal

---

With regard to Note 2 on the left, the Chairman proposes the following new Article 107a:

Article 107a

Revocation proceedings concurrent with opposition proceedings

Anyone who has given notice of opposition to a European patent and has also lodged an application for revocation, may not, before the opposition proceedings have been finally concluded, base any action for revocation against the same patent on grounds he may put forward in the opposition proceedings.

Note:

The proposed Article 107a shown on the left is intended to prevent any third party from bringing one or several national actions for revocation in parallel to any opposition proceedings, while having no grounds on which to base his actions other than those brought forward in the opposition proceedings. The proposed provision does not prevent

- (a) the person lodging the opposition from bringing any national actions for revocation;
- (b) the continuation of national proceedings for revocation during opposition proceedings, in so far as the national proceedings are based on grounds which cannot be presented in the opposition proceedings (e.g. the existence of prior national rights or the prohibition of protection for pharmaceutical products during the limited period provided for in Article 188a);
- (c) the grounds brought forward in the course of the opposition proceedings from being brought forward again in the national revocation proceedings after the conclusion of the opposition proceedings.

Problem 11: Composition of the Examining Division in opposition proceedings

---

Instructions to the Working Party

1970 Draft

---

"The Conference directed Working Party I to draw up a provision under the terms of which an Examining Division must, for the purposes of giving a decision in opposition proceedings, consist of three members, two of whom had not taken part in the examination of the application."

Minutes, page 8, point 22, second paragraph

Article 53 (54)

The Departments

For implementing the procedures laid down in the Convention, the European Patent Office shall comprise:

- (a) Examining Sections and Divisions;
- (b) Boards of Appeal;
- (c) an Enlarged Board of Appeal.

Article 55 (56)

Examining Divisions

(1) An Examining Division shall be responsible for the examination of each application for a European patent from the time when an Examining Section ceases to be responsible under Article 54. An Examining Division shall also be responsible for hearing any oppositions.

(2) An Examining Division shall consist of three technical examiners. Nevertheless, the proceedings prior to a final decision will, as a general rule, be entrusted to one member of the Division. If the nature of the decision so requires, the Division 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.

---

Chairman's proposal

---

Article 53 (54)

The Departments

For implementing the procedures laid down in the Convention, the European Patent Office shall comprise:

- (a) Examining Sections, Examining Divisions and Opposition Divisions;
- (b) +
- (c) +

Article 55 (56)

Examining Divisions

(1) An Examining Division shall be responsible for the examination of each application for a European patent from the time when an Examining Section ceases to be responsible under Article 54.

(2) +

Note:

The Conference decided that the composition of the Division dealing with opposition shall differ from that of the Examining Division. Accordingly, it would seem appropriate to describe this new Division in the 1970 Draft as an "Opposition Division." The name of this Division should therefore be inserted in Article 53.

If the Working Party agrees to the setting up of a separate "Opposition Division", this term would have to be introduced in the Articles relating to opposition proceedings in place of the term "Examining Division". Corresponding editorial amendments would also have to be made in several other places in the 1970 Draft.





---

Chairman's proposal

---

Article 55a (new)  
Opposition Divisions

(1) An Opposition Division shall be responsible for decisions in respect of oppositions against a granted European patent.

(2) An Opposition Division shall consist of three technical examiners, two of whom shall not have taken part in the procedure for grant of the patent to which the opposition relates. Nevertheless, the proceedings prior to a final decision shall, as a general rule, be entrusted to one member of the Opposition Division.<sup>7</sup> If the nature of the decision so requires, the Opposition Division shall be enlarged by the addition of a legally qualified examiner who shall not have taken part in the procedure for grant of the patent. In the event of parity of votes, the vote of the Chairman of the Division shall be decisive.

Note:

Article 55a on the left is proposed for the Opposition Division.

The wording of paragraph 1 is similar to that of Article 56 (1) and Article 101 (1), first sentence.

The wording of paragraph 2 is similar to that of Article 55 (2). The underlined sentences are insertions. They are intended to ensure that the composition of the Examining Division, and that of the Opposition Division is different, in accordance with the wishes of the Conference.

The Working Party's attention is drawn particularly to the sentence in brackets. The Working Party should consider whether all the interim decisions in opposition proceedings are to be made by all the examiners jointly, or whether it would be sufficient in such cases, too, for preparatory decisions to be made by one examiner.

