

BR/GT I/64 e/70

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Comment:

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- Secretariat -

"IMPLEMENTING REGULATIONS" SUB-COMMITTEE
OF WORKING PARTY I

Subject : Observations by the United Kingdom delegation
on "Re Article 70, N° 1"

The United Kingdom has given careful consideration to the text of this Regulation as agreed on the last day of the second meeting of the Sub-committee on 15th-18th September, 1970. At the meeting the United Kingdom reserved its position as it wished to consider further whether the provisions of the Regulation could put an undue load on the IIB.

It is noted that the Regulation is not subject to the provisions of Article 70 but is a guide to the interpretation of that Article. If the provisions of the Regulation would permit claims which would not be linked by a single inventive concept, it follows that it would extend the meaning of Section 70. If it should extend the meaning, this inevitably means that the IIB is in difficulty because they would have to search more than one inventive concept, presumably for the one search fee because Article 79 (5) to (7) must be construed as subject to Article 70 when interpreted by the Regulation being

considered. Also the European Patent Office will be examining, publishing and incurring other expenses in relation to a plurality of inventive concepts while receiving only one set of application etc. fees, one series of application renewal fees, and, in the long run, its share of only one set of patent renewal fees.

The United Kingdom has concluded that the draft Regulation does permit claims relating to more than one inventive concept in the same application. It has no basic objection to sub-paragraphs (a) and (b) whether considered cumulatively or alternatively. It also has no basic objection to (c) when it is an alternative to (a) and/or (b) but considers that multiplicity of inventive concept may arise when (c) is cumulative with either (a) or (b) of both.

The difficulty arises because a typical method claim includes explicitly or implicitly three factors : (i) the starting materials; (ii) the operations performed on (i); and (iii) the resulting product. One or more of these factors may be an inventive concept in its own right. Sub-paragraphs (a) and (b) considered cumulatively therefore include the method of making a product involving factors (i), (ii) and (iii), the product which is factor (iii), and the use of the product, typically a method, the starting material of which will be the factor (iii) and which will include two other factors, (iv) and (v), which are the operations performed in this second method and its end product respectively. Independent claims to the method, and use therefore include in aggregate factors (i) to (v) but each of them includes (iii) explicitly or implicitly and can be fairly regarded as relating to a single inventive concept.

If sub-paragraph (c) be now applied cumulatively, the claims will include an independant claim directed to apparatus specially designed for carrying out either the operations involved in producing (iii) or the operations involved in using (iii). This apparatus may therefore be directed to factor (ii) or factor (iv) and can thus relate to an inventive concept different from the only one which links the claims permissible under sub-paragraphs (a) and/or (b) i.e. factor (iii). This might involve a quite separate search.

This can be shown by an example. An application is assumed to include five independant claims.

- I. A method of making substance (iii) from substance (i) by a series of operations (ii) including cracking substance (i) under certain physical conditions, fractionally distilling the result and subjecting one fraction to chemical substitution under other physical conditions.
- II. The substance (iii).
- III. A method of producing corrosion-resistant steel strip (v) by a series of operations (iv) involving spraying continuously moving strip to a certain thickness with substance (iii) in certain conditions of temperature, pressure and inert atmosphere.
- IV. Apparatus for carrying out the operations (ii) including cracking apparatus, a fractional still, a treating chamber, appropriate interconnecting means, and means to maintain the desired physical conditions in the cracking apparatus and the treating chamber.

V. Apparatus for carrying out the operations (iv) including means for moving strip material continuously through a chamber, a spray head within the chamber, means for controlling the flow of liquid to the head at such a rate as to form the desired thickness on the strip, means for maintaining a gaseous atmosphere in the chamber different from ambient, and means for maintaining special conditions of temperature and pressure within the chamber.

Under the proposed draft these five claims could be included in the same application but quite clearly claims IV and V relate to inventive concepts quite different from that which constitutes the link (the substance (iii)) between claims I to III and three separate searches will have to be made.

The UK is therefore unable to agree with the draft regulation in question on this broad ground.

It is also considered that it would be preferable to replace the references in sub-paragraphs (a) to (c) to "at least an independent claim" by "one independent claim", thus removing the implication that, while only one claim is permissible to a product, more than one are permissible for a method of making it or a method of using it (sub-paragraphs (a) and (b)), and, while only one independent claim is permissible for a method, more than one are permissible to apparatus for carrying it out (sub-paragraph (c)). It would be preferable

if all references were in the singular and then the regulation Re Article 70 n° 2 would apply to all categories of claim where necessary.

The effect of the above is that in the UK view the regulation in question should read in terms of Rule 13.2 of the PCT. It is noted that a similar idea was embodied in both variants of Article A drafted by the Committee of Experts of the Council of Europe in 1968 (EXP/Brev. (68) 2, pages 34 to 36).
