

# BR/GT I/67 e/70

## Travaux Préparatoires EPC 1973

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

Brussels, 5 November 1970  
BR/GT I/67/70

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- 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 regarding  
questions left open in the First Preliminary Draft

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Introductory note

In the "Provisional Agenda" for the 6th meeting of Working Party I (BR/GT I/62/70 of 29 September 1970) it was announced that, as regarded the questions left open in the First Preliminary Draft, the chairman would submit a working document at a later date. This is the working document referred to. It contains:

- I. Proposals for Articles 186 and 206;
- II. Proposals regarding the "List of questions remaining open";
- III. Other proposals.

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## I

Proposals for Articles 186 and 206

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Article 186Progressive expansion of the field of activity of the European Patent Office

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1962 Draft

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(1) Applications for European patents shall not be accepted before the day on which the European Patent Office opens. To begin with, the acceptance of patent applications shall be restricted to certain technical fields subsequently to be progressively extended to other fields.

(2) The date of the opening of the European Patent Office and the technical fields for which applications for European patents will be accepted shall be fixed by the Administrative Council on the recommendation of the President of the European Patent Office.

(3) The technical fields for which applications for European patents will be accepted shall be fixed with reference to the International Classification referred to in Article 62.



Proposal

(1) Applications for European patents may be filed with the European Patent Office from the date fixed by the Administrative Council on the recommendation of the President of the European Patent Office. To begin with, the examination of European patent applications pursuant to Article 88 may be restricted to certain areas of technology and subsequently be progressively extended to the remaining areas of technology.

(2) The Administrative Council may, on the recommendation of the President of the European Patent Office, further restrict the processing of a European patent application which cannot yet be examined pursuant to Article 88; however, examination shall in any event be made as to whether the European patent application meets the conditions set out in Article 68.

(3) - Transferred to the Implementing Regulations -

(4) If a European patent application cannot be further processed as the result of the procedure having been restricted pursuant to paragraph 1, second sentence, or paragraph 2, the European Patent Office shall inform the applicant that for this reason the application shall be deemed to have been withdrawn upon receipt of such notification, and shall advise him to proceed under Article 124.

Note:

The proposal governing the progressive extension of the European Patent Office is based, in paragraph 1, on the assumption that the European Patent Office will initially not be in a position for all patent applications to be examined pursuant to Article 88, but that, as under the PCT, it will be able to conduct the European system up to the obtaining of the report on the state of the art and the publication of the application.

Paragraph 2 makes provision for the case of the European Patent Office not being able initially to proceed so far with all European patent applications. The Administrative Council may therefore restrict the procedure for grant, as and when necessary. It may rule in particular that, for certain areas of technology, a report on the state of the art may not be obtained as long as the International Patents Institute is not in a position to draw up this report. Other restrictions may also prove necessary. It should be established however, that in any event the applicant will be granted a priority date for his European patent application.

Paragraph 4 lays down how to proceed with applications which cannot be further processed as the result of the procedure having been restricted. Basically, such applications are to be transferred to the national patent offices by means of the "procedure for conversion" laid down in Articles 124 et seq. Such applications cannot be left pending at the European Patent Office until the restrictions on proceedings are removed. There are various reasons for this, the main one being to

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Article 186 (continued)

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Proposal

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prevent a backlog of non-processed applications building up.

It has been decided not to make any specific reference to the refunding of fees already paid. It should go without saying that all fees which fall due should remain acquired by the European Patent Office, but that fees for proceedings which cannot be carried out should be refunded.

A number of other questions will have to be dealt with in the Implementing Regulations. These include fixing the areas of technology with reference to the International Classification and publication in the European Patent Bulletin of notice of any restrictions on procedure imposed or removed.

Article 206Application to national utility models

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1962 Draft

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The provisions of this Convention which relate to applications for national  
patents filed and to national patents granted in the Contracting States shall  
equally apply to national applications for utility models or to utility models  
deposited or registered in the Contracting States.

## Article 206

### National utility models and utility certificates

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#### Proposal

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Article 6, Article 61 paragraph 2, Article 76, Articles 124 to 128, Article 134, Article 163 and Article 207 shall apply mutatis mutandis to utility models and utility certificates and to applications for utility models and utility certificates registered or deposited in the Contracting States whose laws make provision for such models or certificates.

#### Note:

At the 5th meeting of Working Party I, on 7 to 11 September 1970, the Chairman announced that he would submit a new proposal for Article 206 to the Working Party.

This proposal excludes its applicability to all those provisions in the Convention which it does not expressly mention, but which do refer to national patent applications and national patents. These are: Article 2 paragraph 2, Article 18, first sentence, together with Article 19 paragraphs 1 and 2, Article 20a, paragraph 2, Article 21 paragraph 6 and Article 188a paragraph 1. Mentioning Article 73 paragraph 1, however, would be superfluous, as this provision refers explicitly to utility models and utility certificates. Following the example of Article 73, this proposal refers not only to utility models but also to utility certificates.

The States taking part in the Conference whose laws make provision for utility models or utility certificates are at present: Germany (Gebrauchsmuster), France (certificat d'utilité), Italy (modello di utilità), Portugal (modelo de utilidade) and Spain (modelo de utilidad).

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## II.

The Chairman has submitted the following proposals and remarks with regard to the "List of questions remaining open" (BR/GT I/50/70 of 22 July 1970) drawn up by the Secretariat which indicates the subject-matter and reference documents for the respective Articles.

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Article	Proposal	Remarks
Preamble	<p><u>Amendment to Note on Preamble:</u></p> <p>The preamble should indicate that this Convention constitutes between the Contracting States a special agreement within the meaning of Article 15 of the Paris Convention of 20 March 1883 for the Protection of Industrial Property, last revised at <u>Stockholm on 14 July 1967</u>, and a <u>regional patents treaty</u> within the meaning of <u>Article 45, paragraph 1</u>, of the Patent Co-operation Treaty of <u>19 June 1970</u>.</p>	<p>It is probably still too early to draw up the complete text of the Preamble. However, the Drafting Committee should amend the note contained in the First Preliminary Draft to correspond with this proposal.</p>
2 para. 2	<p>Delete both remarks under Article 2, paragraph 2.</p>	<p>These questions have been settled by Articles 2, paragraph 2, 133, 134, 188a (maximum solution) and 20a and 188a (term), which were adopted at the last meeting.</p>
5	<p>Delete remark under Article 5</p>	<p>This question has been settled by Article 5 as adopted at the last meeting.</p>
6 (former 7)	<p><u>Completion of Article 6:</u></p> <p>It shall be a matter for the Contracting States to decide whether, and on what terms, the protection given to an invention by a <u>European patent application</u> or a <u>European patent</u> and the protection given by a <u>national patent application</u> or a <u>national patent</u> may be enjoyed simultaneously, in so far as the invention originates from one and the same inventor.</p>	<p>The Chairman proposes that Article 6 be extended to European patent applications and national patent applications.</p>

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Article	Proposal	Remarks
11, paragraph 4		Examination should be postponed until the expected observations on Article 11(3) by the non-governmental international organisations are discussed.
13	<p><u>Note to Article 13, 2nd sentence:</u></p> <p>The Inter-governmental Conference has only provisionally adopted the rule laid down in Article 13, 2nd sentence</p>	
17		The Working Party is to decide whether this question should be further discussed at this stage.
former 19 (deleted)	Delete footnote 1 to Chapter III of Part II	This question has been settled by Article 13 <sup>4</sup> adopted at the last meeting.
21 (former 24)	<p><u>Note to Article 21:</u></p> <p>It should be examined whether, in the case of Article 13, 2nd sentence, being finally adopted, the system of European patents of addition should be retained</p>	The Working Party deleted the 2nd variant of Article 13 at its meeting of September and pointed out in a Note that the deletion of this 2nd variant of Article 13 meant that paragraphe 5 of Article 21 must be re-examined (BR/48/70, Page 10)
21 (former 24) paragraph 3	Delete the note	This question should be transferred to the "Implementing Regulations" sub-Committee, which has left Re. Article 21, No. 3, blank for this purpose (BR/42/70).

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Article	Proposal	Remarks
21 (former 24) paragraph 7	Delete the note	The time chosen is the latest possible. Should conversion not take place until the time of the communication referred to in Article 97 (1), the Examining Division must again examine the inventive step by including the former parent patent in the state of the art. Applicants should take into account the resultant delay in granting the patent, since it will be caused by their own belated statement of conversion.
23 (former 25)	Delete the note and add <u>paragraph 5</u> as follows:  (5) Paragraphs 2 and 4 shall apply mutatis mutandis to the assignment of a European patent which takes place during the opposition period and, as the case may be, before the conclusion of opposition proceedings	
24 (former 26) to 29 (former 30)	Delete the notes to Articles 28 and 29 in the 1970 Draft.	This question has been settled by the deletion of Articles 24 to 27 and the adoption of Articles 28 to 29 at the last meeting. The note to Articles 24 to 27 has been deleted on page 16 of BR/48/70.
33		The question has been settled by the statement by the United Kingdom delegation at the last meeting.

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Article	Proposal	Remarks
34, paragraph 5 (former paragraph 4a)		This question seems to have been settled by Article 19 (4). See also Articles 97a and 100.
35		This question comes under the terms of reference of Working Party II and should be discussed at the first meeting of the Co-ordinating Committee (2 to 4 December 1970).
36.		See previous remark.
40	<p><u>Paragraph 4, 2nd sentence, new:</u></p> <p>In the event of the damage being caused by a branch of the European Patent Office as provided for in Article 33, paragraph 2, such disputes shall be decided by the courts having jurisdiction in the place at which that branch is located.</p>	
54 and 55		See the remark to Article 35. See also the proposal made by Working Party II in BR/33/70, page 2, note to C.
58		This question has been settled by the "Implementing Regulations" sub-Committee in Re. Article 53, No. 2 (BR/42/70).
Chapter IV of Part III	Delete footnote 1	This question has been settled by the "Implementing Regulations" sub-Committee in Re. Article 1, No. 1 (BR/41/70).

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Article	Proposal	Remarks
60 (former 61); See also Article 162		This question has been settled by Article 162, paragraph 4, as adopted at the last meeting.
65 (former 67)	Delete all square brackets (paragraphs 2,3 and 5) and the note to Article 65	<p>1. As regards the period of 14 months (point 29 of the reference document):</p> <p>The period laid down in Article 65, paragraph 3 (b), should now be acceptable to all the delegations, as the PCT lays down a forwarding period which is one month shorter (Rule 22.1 (a), 3rd sentence).</p> <p>2. As regards harmonisation with the PCT (point 30 of the reference document):</p> <p>Examination of the provisions in square brackets relating to time limits for international applications which are sent for filing, via national industrial property offices, to the European Patent Office as receiving office would appear to be superfluous. National Offices need not forward these applications to the European Patent Office within the time-limits laid down in Article 65, but, in accordance with the provisions of Article 120, paragraph 2: "in time for the latter to be able to comply in due time with the conditions for transmittal under the Co-operation Treaty".</p>
66 (former 68)	Delete the note	This question has been settled by the additions to Articles 66, 77 and 79 adopted at the last meeting.

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Article	Proposal	Remarks
67 (former 68a)	Delete the note	This question will be dealt with by the sub-Committee on "Rules relating to fees".
69 (former 68c)	Delete the note	The "Implementing Regulations" sub-Committee has already taken up this question. See the proposal by the Chairman of the sub-Committee Re. Article 69, No. 1 (BR/GT I/52/70), which will be discussed at the fourth meeting of the sub-Committee (23 to 27 November 1970) together with a proposed amendment by the German delegation.
73 (former 72) paragraph 5		This question has been settled by the amendments to Article 73, paragraphs 1 and 5, adopted at the last meeting.
74 (former 73)		This question has been settled by the decision taken at the last meeting to propose to the Conference that the note to Article 74 be deleted.
79 (former 78)	Delete the note	This question will be dealt with by the sub-Committee on "Rules relating to fees".
85 (former 86a)	Delete the note	This question has been settled by the addition to Article 34, paragraph 5, adopted at the last meeting.
88 and 89	Delete the note to Article 88	The terms of reference set out in the second paragraph of point 20 of the reference document.



Article	Proposal	Remarks
88 and 89 cont'd.		<p>(BR/40/70) have been covered by Articles 79 (4a), 88 (2) and 188b, which were adopted at the last meeting in connection with Problem 9. The notes to Articles 88 (2) and 89 (1) have been deleted on pages 32 and 98 of BR/48/70.</p> <p>The note to Article 88 and the question raised by the CNIPA mentioned in the third paragraph of point 20 of the reference document would seem to be rendered superfluous by the shortening of the period for making a request for examination (Article 88, paragraph 2).</p>
94 (former 94a)		See the proposal for Article 101b [paragraph 3] in BR/GT I/49/70, page 47.
95	<p><u>Article 95, paragraph 3, new:</u></p> <p>(3) If the applicant does not reply within the period laid down in paragraph 1, the European patent application shall be deemed to be withdrawn.</p>	
97 (former 96)		This question has been settled by the introduction of a belated opposition procedure.
100 (former 96c) paragraph 1		This question has been settled by Articles 97a and 100 as adopted at the last meeting.

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Article	Proposal	Remarks
101 (former 96d)	Delete the three notes to Article 101	<ol style="list-style-type: none"> <li>1. 1970 Draft, note 1 See BR/GT I/49/70, page 45.</li> <li>2. 1970 Draft, note 2 See BR/GT I/49/70, pages 59 and 61.</li> <li>3. 1970 Draft, note 3. This question will be dealt with by the "Implementing Regulations" sub-Committee.</li> </ol>
104 (former 97b) and 83 (former 82)		Article 104 does not entail any amendment to Article 83 - as suggested in the reference document.
105 (former 101)	Delete the note	See BR/GT I/49/70, pages 49 and 51.

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Article 78, paragraph 5

The application may not be refused on grounds which have not previously been notified to the applicant in accordance with paragraph 2.

Article 96, paragraph 2

A European patent application may not be refused on grounds which have not previously been communicated to the applicant.

Article 105, paragraph 4

The European patent may not be revoked on grounds which have not previously been communicated to the proprietor.

Article 115, paragraph 5

The decision of the Board of Appeal may only be based on facts or evidence on which the parties concerned have had an opportunity to present their comments.



Article	Proposal	Remarks
105 (former 101) paragraph 4	<p><u>Article ... (before Article 153) new:</u></p> <p>Legal proceedings</p> <p>A decision before the European Patent Office may only be based on facts or evidence on which the parties concerned have had an opportunity to present their comments.</p> <p>Delete Articles 78 paragraph 5, 96 paragraph 2, 105 paragraph 4, and 115 paragraph 5 in the 1970 Draft.</p>	The proposed new Article should satisfy the requirements of the note in the reference document.
101 (former 96d) to 106 (former 102)	Delete both notes to Article 106	See BR/GT I/49/70, pages 55 and 57.
108 (former 105) paragraph 2		The interested circles have not been asked explicitly for their opinion on this point. The question should be left until it is taken up by the interested circles, if at all.
113 (former 110) and 122 (former 113f)	See proposal on page 33	

Article 82, paragraph 3 (Procedure prior to the introduction of the request for examination)

- (3) If the new or amended claims are obviously no longer covered by the report on the state of the art, the European Patent Office may request an additional report from the International Patent Institute at The Hague. In such an event the European Patent Office shall request the applicant to pay within one month the fee prescribed by the Rules relating to fees adopted pursuant to this Convention. If, within the period fixed, the additional fee has not been paid, the application shall be deemed to be withdrawn.

Article 93, paragraph 2 (Procedure for grant)

- (2) The Examining Division may obtain an additional report on the state of the art from the International Patent Institute at The Hague. If the Examining Division finds that the additional report is necessary because of amendments to the claims made by the applicant, it shall invite the applicant to pay within one month the additional fee prescribed by the Rules relating to fees adopted pursuant to this Convention. If, within the period fixed, the additional fee has not been paid, the application shall be deemed to be withdrawn.

Article 113, paragraph 3 (Appeals procedure)

- (3) The Board of Appeal may ask the Examining Section for further information concerning the state of the art or may obtain an additional report on the state of the art from the International Patent Institute at The Hague. If the Board of Appeal finds that the additional report is necessary because of amendments to the claims made by the applicant, it shall invite the applicant to pay within one month the additional fee prescribed by the Rules relating to fees adopted pursuant to this Convention. If the additional fee has not been paid within the period fixed, the application shall be deemed to be withdrawn.

Note to Article 113 (3):

The question whether it should be provided, who is to meet the cost of an additional report where this is not made necessary by amendments to the claims made by the applicant, but on account of other circumstances, will be re-examined later.

Article 122, paragraph 2 (PCT)

- (2) At any time, and in respect of any international application, the European Patent Office may obtain a supplementary report on the state of the art from the International Patent Institute at The Hague.

Note to Article 122 (2):

The question of the cost of the supplementary report on the state of the art must be considered further.

Additional report on the state of the art

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Proposal

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- (1) Notwithstanding Article 79, paragraph 5, the European Patent Office may at any time obtain an additional report on the state of the art from the International Patent Institute at The Hague, where it considers this to be expedient.
- (2) The cost of the report referred to in paragraph 1 shall be borne by the applicant or the proprietor of the patent:
  - (a) where the latter has made it necessary for such report to be obtained, in particular by amending the claims, or
  - (b) where the report is obtained in order to supplement an international search report as provided for in Article 122.
- (3) Where paragraph 2 is applicable, the European Patent Office shall request the applicant or the proprietor of the patent to pay within one month the additional fee prescribed by the Rules relating to fees adopted pursuant to this Convention. If the fee is not paid in due time, the European patent application shall be refused or the European patent shall be revoked.

Notes:

- (1) This proposal should cover the question left open in connection with Article 113 and, especially, Article 122, and to be fully comprehensive, also covers Articles 82 (3) and 93 (2). It also provides for the possibility of obtaining an additional report on the state of the art for opposition proceedings; such an Article is so far lacking in the 1970 Draft.
- (2) If the proposal is adopted, Articles 82 (3), 93 (2) and 113 (3), with the exception of the first half of the first sentence ("The Board of Appeal may ask the Examining Section for further information concerning the state of the art"), the note to Article 113 (3) as well as Article 122 (2) and the note to that Article should be deleted.

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Article	Proposal	Remarks
116 (former 112a)		This question has been postponed by the Conference pending examination by government legal experts.
123 (former 113g) paragraph 4		This question should be referred to the "Implementing Regulations" sub-Committee.
124 to 128 (former 114 to 118)		See BR/GT I/45/70, page 17 et seq.
130 (former 120)		The suggested division of the combined renewal fee provided for in Article 129 into national renewal fees - possibly to be staggered - in respect of each Contracting State designated seems to have been rendered superfluous by the shortening of the period for making a request for examination. It should be examined whether this concept of division can be dispensed with.
former Article 123		This question has been settled by the deletion of Article 169 (Assistance) at the last meeting (BR/48/70, page 74).

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### III

#### Other Proposals

Two further proposals are included at this point:

1. a proposal to make one general provision governing hearings;
2. a proposal on the question of amendment by the Administrative Council of time limits laid down in the Convention.

Re. 1: As a result of the introduction of opposition proceedings and of the Opposition Division, Article 106 ("Hearings") covers only opposition proceedings. A similar provision should be made to cover proceedings prior to grant of the European patent. A provision governing hearings before the Enlarged Board of Appeal is also lacking. This would mean adding two further provisions to the three similar provisions which already exist (Articles 84, 106 and 114). It is proposed that one general provision should be made instead.

Re. 2: At the last meeting of the Working Party, the Chairman undertook to draw up such a proposal. This is submitted on page 41; it should, however, be dealt with by the Co-ordinating Committee.





Oral proceedings

1970 Draft

Proposal

Article 84 - Hearings before the Examining Section

The Examining Section shall give a hearing to the applicant either on its own initiative or at his request, where it considers this to be expedient. It must give a hearing to the applicant on his request if it proposes to give a decision refusing the application wholly or in part.

Article ... - Hearings in examination proceedings  
- lacking -

Article 106 - Hearings in opposition proceedings

A hearing shall take place either at the request of any party to the proceedings or at the instance of the Examining Division if it considers this to be expedient.

Article 114 - Hearings on appeal

A hearing on appeal shall take place at the request of any party to the proceedings or at the instance of the Board of Appeal if it considers this to be expedient.

Article ... - Hearings before the Enlarged Board  
of Appeal

- lacking -

(1) Oral proceedings shall take place either at the request of any party to the proceedings or at the instance of the European Patent Office if it considers this to be expedient.

(2) Oral proceedings shall take place before the Examining Section at the request of the applicant only where the Examining Section considers this to be expedient or where it envisages refusing the application wholly or in part.

Note

If the proposal is adopted, Articles 84, 106 and 114 should be deleted.

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Proposal

Remarks

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Addition to the provision on the powers of the Administrative Council drawn up by Working Party II (BR/33?70):

Article a, paragraph 1 (E)

(1) The Administrative Council shall be competent to:

A. to D. ...

E. amend all time limits laid down in this Convention independently of any revision under Article ... (Article a in BR/46/70). Notwithstanding Article 188b, this shall not apply to the time limit laid down in Article 88, paragraph 2.

At its fifth meeting on 7 to 11 September 1970, Working Party I reduced the period for giving notice of opposition in Article 101 (1) from 1 year to 9 months. The Working Party pointed out in this respect that by analogy with Article 47.2 of the PCT, the Administrative Council should be given powers to amend the time limits laid down in the Convention. The Chairman of Working Party I has accordingly submitted the proposal in the left-hand column for the attention of the Co-ordinating Committee. The only exception made to the powers to amend time limits is in respect of the time limit laid down in Article 88 (2). It was not considered necessary to make exceptions for the periods laid down in Article 73 (1) and Article 75 (2) as these periods are governed by the Paris Convention.

If the proposal is adopted, the provision drawn up by Working Party II on voting rules in the Administrative Council (Article m in BR/33/70) should specify whether the decisions to be taken under this proposal should be taken unanimously, by two-thirds majority or by simple majority. It is recommended that the decisions concerned in this proposal should require the same majority as that required in decisions to amend the Implementing Regulations. This would make amendments to time limits in both the Convention and the Implementing Regulations subject to the same requirements.

