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Travaux Préparatoires EPC 1973

Comment:

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

Brussels, 15 October, 1970
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- Secretariat -

PROPOSAL BY THE SWISS DELEGATION

Re: Article 66 no. 3, paragraph (4)
(dependent claims)

Regulations for the fulfilment of the Convention
relating to the European System for the
Grant of Patents

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The PCT Rule of Procedure taken up in Document BR/GT I/52/70, page 27, concerning paragraph (4), letters a) has two parts having the following tenor:

Part 1: "Any claim which includes all the features of one or more other claims ("dependent claim") shall do so by a reference at the beginning to the other claim or claims and shall then state the additional features claimed".

Part 2: "Any dependent claim which refers to more than one claim ("multiple dependent claim") shall refer to such claims only in the form of an alternative. Multiple dependent claims shall not serve as a basis for any other multiple dependent claim".

According to part 1, a dependent claim can refer cumulatively to several other claims. For example: "Device according to the claims 1, 4 and 6, characterised"

In such an example, the device claimed shows, besides the additional features stated after the word "characterised", all the features mentioned in the claims 1, 4 and 6. The reference or cumulative dependence has the advantage of clearness and can avoid the repetition of features already appearing in the preceding claims, thus attaining shorter claims. This is an advantage as well as for the searcher as for the examiner and for the reader of the patent specification. Such cumulative references are actually found in the patent specifications of a number of countries among which are included Germany (Federal Republic), France, the Netherlands, Austria, Switzerland and Sweden.

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According to part 2, on the contrary, claims which refer to several other claims are only allowed if the reference is made in the form of an alternative. A reference according to the cumulative form allowed as such by part 1 is thus not allowed by part 2. This part 2 is thus in contradiction with part 1.

An alternative reference, in opposition to a cumulative reference, allows the coverage of as many variants as there are terms in the alternative. For example, under the following terms:

"Device according to one of the claims 3 to 5"

a claim covers the three objects defined by the following claims:

"Device according to claim 3"

"Device according to claim 4"

"Device according to claim 5"

An alternative reference allows the reduction in the number of claims. It can, however, when the number of variants covered is large and especially when the number of combinations which can be formed is no longer easily recognisable, render more tedious the research and more ponderous the tasks of the examiners. In specifications containing claims with an alternative reference such as "according to one or more of the preceding claims" the number of possible combinations can become very great. If there are 5 preceding claims, the number of combinations reaches 25, for 10 claims this number becomes 175 and for 20 claims not far from 2500. The number of combinations becomes equally difficult to recognise when the claims covered by an alternative reference are themselves referred alternatively to other claims. Because of this, a limitative clause has been provided in part 2 of the PCT text specifying

that multiple dependent claims shall not serve as a basis for any other multiple dependent claim. The PCT text is not satisfactory for the European countries and is in itself contradictory. In consequence, it forbids the use of cumulative references which are in themselves clear and unequivocal and allows, on the contrary, the use of alternative references which are apt, because of numerous variants, to lack the necessary clearness.

Starting from the principle, vouchered for by the majority of the working groups, that tentative rules of application should be formulated which are in accordance with the rules of the PCT and answer at the same time the needs of the European system for the granting of patents but which are equally sufficiently broad, we present for paragraph (4)a the following proposed draft:

Proposition:

(4)a Any claim which shall include all the features of one or more preceding claims (dependent claim) must include at the beginning a reference to that or those other claims and shall then state the additional features claimed.

a bis A dependent claim can refer in an alternative manner to one or other of several claims so long as the number of claims covered by this alternative reference is limited in such a manner that research and examination are still quite feasible and that these claims do not themselves equally refer in an alternative manner to other claims.

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Observations relating to this proposal:

The new paragraph a bis allows, in the same way as rule 6.4 a of the PCT an alternative reference with, however, limitations which include as well the limitation actually provided for in the last phrase of this rule. It does not forbid the use of a cumulative reference, which is allowed by paragraph a) and utilised by various European Patent Offices. These limitations are of capital importance, as an intense use of alternative references must be reckoned with in order to reduce the total sum of the payable tax.

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