

# BR/GT I/74 e/70

## Travaux Préparatoires EPC 1973

### Comment:

The collection represents purely an internal research tool for the purpose of Directorate Patent Law of the European Patent Office. No guarantee can be given for its completeness or correctness.

The documents produced before 1969 cannot be provided in English as this was not an official language in the period before that date. These documents therefore are provided in French and German.



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

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- Secretariat -

Brussels, 22 December 1970  
BR/GT I/74/70

Proposals by the German Delegation for  
amending the Convention establishing a European  
System for the Grant of Patents in the light  
of the final version of the Patent Co-operation  
Treaty (PCT)

BR/GT I/74 e/70 lor/RT/pc



INTRODUCTORY NOTE

At the meeting held from 8 to 11 September 1970, the Chairman of Working Party I asked the German delegation to examine the First Preliminary Draft of a Convention establishing a European System for the Grant of Patents, with a view to establishing what amendments are necessary in the light of the final version of the Patent Co-operation Treaty. The German delegation submits the attached list of the amendments it considers necessary, together with a brief explanation and, in each case, the relevant provisions of the Convention and of the PCT. Additions may be made to this list when the work of the "Implementing Regulations" Sub-Committee has been completed.

Text of the Convention  
establishing a European System  
for the Grant of Patents (1970  
Draft) (First Preliminary Draft  
and BR/48/70 of 23/9/1970)

Text of the relevant  
provisions of the PCT  
and of the Regulations  
under the PCT

Nature of the amendment

Proposed text

1. Preamble,

Note

Cf. Proposal by the Chair-  
man of Working Party I in  
BR/GT I/67/70 of 5 November  
1970, Page 15.

Preamble,

Note

Cf. Proposal by the Chair-  
man of Working Party I in  
BR/GT I/67/70 of 5 November  
1970, Page 15.

2. Article 9, paragraph 2

(1) ...

(2) Inventions within the  
meaning of paragraph 1  
shall in particular  
exclude:

(a) scientific and  
mathematical theories  
~~as such;~~

~~.....~~  
(d) ~~commercial, financial~~  
~~or book-keeping~~  
~~methods, the rules of~~  
~~playing games and other~~  
~~systems, in so far as~~  
~~they are of a purely~~  
~~intellectual nature;~~

(e) ~~therapeutic or surgical~~  
~~methods for treatment~~  
~~of the human or animal~~  
~~body, and diagnostic~~  
~~methods.~~

Regulations under the PCT

39.1 Definition

No International Searching  
Authority shall be required  
to search an international  
application if, and to the  
extent to which, its subject  
matter is any of the following:

(i) scientific and mathematical  
theories,  
.....

(iii) schemes, rules or methods  
of doing business, per-  
forming purely mental  
acts or playing games,

(iv) methods for treatment of  
the human or animal body  
by surgery or therapy, as  
well as diagnostic methods,  
.....

Article 9 of the 1970  
Draft and Rule 39.1 of  
the Regulations under  
the PCT differ in  
substance. However,  
alignment of sub-  
paragraphs (a), (d)  
and (e) with the  
corresponding provisions  
in Rule 39.1 of the  
Regulations under the  
PCT is desirable, as  
the same objects are  
evidently intended.

Article 9, paragraph 2

(1) ...

(2) Inventions within  
the meaning of paragraph  
1 shall in particular  
exclude:

(a) scientific and  
mathematical  
theories;

(d) schemes, rules or  
methods of doing  
business, performing  
purely mental acts  
or playing games;

(e) methods for treatment  
of the human or  
animal body by  
surgery or therapy,  
as well as diagnostic  
methods.

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provisions of the PCT  
and of the Regulations  
under the PCT

Nature of the amendment

Proposed text

### 3. Article 11

#### Novelty

(1) ...

(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing the application for a European patent.

#### Regulations under the PCT 64.1 Prior Art

- (a) For the purposes of Article 33 (2) and (3), everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) shall be considered prior art provided that such making available occurred prior to the relevant date.
- (b) For the purposes of paragraph (a), the relevant date will be: ...

The PCT Rule differs in substance from Article 11, paragraph 2, of the Convention, by reason of the limitation to written disclosure. Alignment should not be attempted.



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and of the Regulations  
under the PCT

Nature of the amendment

Proposed text

4. Article 13

Inventive step

An invention shall be  
considered as involving an  
inventive step if it is not  
obvious having regard to the  
state of the art .....

Article 33, Paragraph 3, PCT

(3) For the purposes of the  
international preliminary  
examination, a claimed  
invention shall be considered  
to involve an inventive step  
if, having regard to the prior  
art as defined in the  
Regulations, it is not, at the  
prescribed relevant date,  
obvious to a person skilled in  
the art.

Complete alignment with  
Article 33 (3) of the  
PCT does not seem  
necessary. Equivalence  
in substance only could  
be obtained by inserting  
the words "to a person  
skilled in the art".

Article 13

Inventive step

An invention shall  
be considered as  
involving an  
inventive step if,  
having regard to  
the state of the  
art, it is not  
obvious to a person  
skilled in the art.

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and of the Regulations  
under the PCT

Nature of the amendment

Proposed text

5. Article 14

Industrial application

An invention shall be  
considered as susceptible of  
industrial application if it  
can be made or used in any  
kind of industry, including  
agriculture.

Article 33, PCT

The International Preliminary  
Examination

.....  
(4) For the purposes of the  
international preliminary  
examination, a claimed invention  
shall be considered industrially  
applicable if, according to its  
nature, it can be made or used  
(in the technological sense) in  
any kind of industry. "Industry"  
shall be understood in its  
broadest sense, as in the Paris  
Convention for the Protection of  
Industrial Property.

In the interests of  
international harmonis-  
ation, Article 14 of  
the Convention could be  
aligned with Article 33  
(4) of the PCT as far as  
possible.

An invention  
shall be con-  
sidered industri-  
ally applicable if,  
according to its  
nature, it can be  
made or used - in  
the technological  
sense - in any  
kind of industry.  
"Industry" shall be  
understood in its  
broadest sense, as  
in the Paris  
Convention for the  
Protection of  
Industrial  
Property.

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Text of the relevant  
provisions of the PCT  
and of the Regulations  
under the PCT

Nature of the amendment

Proposed text

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6. Article 117, paragraph 1

(1) The Patent Co-operation  
Treaty of ... , hereinafter  
referred to as "the  
Co-operation Treaty", shall be  
applied in accordance with the  
provisions of this Chapter.

---

Insertion of the date  
of signing.

Article 117,  
paragraph 1

(1) The Patent  
Co-operation Treaty  
of 19 June 1970,  
hereinafter  
referred to as "the  
Co-operation Treaty",  
shall be applied in  
accordance with the  
provisions of this  
Chapter.

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Text of the relevant  
provisions of the PCT  
and of the Regulations  
under the PCT

Nature of the amendment

Proposed text

7. Article 118

Functions of the European Patent  
Office in the context of the  
Patent Co-operation Treaty

.....  
(2) Subject to the provisions  
set out below, the European  
Patent Office shall act as an  
International Preliminary  
Examining Authority within the  
meaning of Chapter II of the  
Co-operation Treaty, once that  
Chapter has entered into force  
for at least one Contracting  
State to this Convention, and  
all other conditions laid down by  
the Co-operation Treaty and by  
this Convention for the performance  
of the functions of an International  
Preliminary Examining Authority have  
been met.

Article 31, PCT

Demand for International  
Preliminary Examination

- .....  
(2) (a) Any applicant who is  
a resident or national,  
as defined in the  
Regulations, of a  
Contracting State  
bound by Chapter II,  
and whose inter-  
national application  
has been filed with the  
receiving Office of or  
acting for such State,  
may make a demand for  
international prelimin-  
ary examination.
- (b) The Assembly may decide  
to allow persons  
entitled to file  
international  
applications to make a  
demand for international  
preliminary examination  
even if they are resi-  
dents or nationals of a  
State not party to this  
Treaty or not bound by  
Chapter II.

The addition of  
paragraph 2(b) to  
Article 31 of the PCT,  
as decided by the  
Washington Conference,  
should be reflected  
by the addition of a  
second sentence to  
Article 118.(2). The  
European Patent Office  
should be able to  
conduct an inter-  
national preliminary  
examination on the  
basis of a decision  
by the Administrative  
Council even when the  
request is made by an  
applicant in a  
Contracting State not  
bound by Chapter II.

Article 118

(2) ...  
The Administrative  
Council may decide  
that the European  
Patent Office shall  
act as an Inter-  
national Preliminary  
Examining Authority  
within the meaning  
of Chapter II of  
the Co-operation  
Treaty where the  
Assembly of the  
International  
Patent Co-operation  
Union has decided  
that residents or  
nationals of a  
particular  
Contracting State  
may make a request  
for international  
preliminary examin-  
ation even though  
that Contracting  
State is not party  
to the Co-operation  
Treaty or is not  
bound by Chapter II.

Text of the Convention  
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Text of the relevant  
provisions of the PCT  
and of the Regulations  
under the PCT

Nature of the amendment

Proposed text

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8. Article 119

The European Patent Office  
as a receiving Office

(1) The European Patent  
Office may act as a  
receiving Office within the  
meaning of Article 2 (iv) of  
the Co-operation Treaty, ...

Article 2, PCT

Definitions

For the purposes of this  
Treaty and the Regulations  
and unless expressly stated  
otherwise:

.....  
(xv) "receiving Office"  
means the national  
Office or the inter-  
governmental organi-  
sation with which the  
international appli-  
cation has been filed;

"(iv)" should be replaced  
by "(xv)".

Article 119

The European  
Patent Office as  
a receiving Office

(1) The European  
Patent Office may  
act as a receiving  
Office within the  
meaning of  
Article 2 (xv) of  
the Co-operation  
Treaty ...

...

(3) Subject to the prior  
approval of the Administrative  
Council, the European Patent  
Office may also act as a  
receiving Office if the appli-  
cant is a national of a State  
in respect of which the Assembly  
of the International Patent  
Co-operation Union has appointed  
the European Patent Office as a  
competent receiving Office. The  
same shall apply if the appli-  
cant has his registered place  
of business or his residence in  
such State.

Article 9 PCT

The Applicant

.....  
(2) The Assembly may decide  
to allow the residents and  
the nationals

At the Washington  
Diplomatic Conference,  
Article 9 (2) of the  
PCT was restricted to  
nationals of States  
parties to the Paris  
Convention. This  
restriction should also  
be made in Article 119  
(3) of the Convention.

(3) Subject to the  
prior approval of  
the Administrative  
Council, the  
European Patent  
Office may also act  
as a receiving  
Office if the appli-  
cant is a national  
of a State party to  
the Paris Convention  
for the Protection  
of Industrial  
Property in respect  
of which the  
Assembly of the  
International Patent

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and of the Regulations  
under the PCT

Nature of the amendment

Proposed text

of any country party to  
the Paris Convention for  
the Protection of Indus-  
trial Property which is  
not party to this Treaty  
to file international  
applications.

Regulations under the PCT  
19.1 The Competent  
Receiving Office

.....

- (c) In connection with any  
decision made under  
Article 9 (2), the  
Assembly shall appoint  
the national Office or  
the inter-governmental  
organisation which  
will act as receiving  
Office for applicati-  
ons of residents or  
nationals of States  
specified by the Ass-  
embly. Such appoint-  
ment shall require  
the previous consent  
of the said national  
Office or intergovern-  
mental organisation.

has appointed the European  
Patent Office as a comp-  
etent receiving Office.  
The same shall apply if the  
applicant has his registered  
place of business or his  
residence in such State.

9. (No provision)

PCT Regulations  
15.1 Basic Fee and  
Designation Fee

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau ("international fee") consisting of (i) a "basic fee", and (ii) as many "designation fees" as there are States designated in the international application provided that, where a regional patent is sought for certain designated States, only one designation fee shall be due for those States.

The obligation to pay the transmittal fee referred to in Rule 14.1 of the Regulations under the Patents Co-operation Treaty must be incorporated in the Convention.

The date of filing the application must be specified as the due date for payment of this fee, as the European Patent Office has no other possibility of ensuring its receipt. It should be noted that the European Patent Office must not necessarily be a designated Office.

Article 120

-----  
(3) Each international application shall be subject to the payment of the transmittal fee prescribed in the Rules relating to Fees adopted pursuant to this Convention. This fee shall be payable on the filing of the application.

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Text of the relevant  
provisions of the PCT  
and of the Regulations  
under the PCT

Nature of the amendment

Proposed text

10. Article 121

The European Patent Office  
as designated or  
elected Office

(1) The European Patent Office shall act as a designated Office within the meaning of Article 2 (ii) of the Co-operation Treaty for those Contracting States to this Convention which are designated in the international application if the applicant informs the receiving Office or, where appropriate, the International Bureau provided for in that Treaty, within twelve months of the priority date, that he wishes to obtain a European patent for these States.

Article 2, PCT

Definitions

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise;

...

(xiii) "designated Office" means the national Office of or acting for the State designated by the applicant under Chapter I of this Treaty;

Article 4, PCT

The Request

(1) The request shall contain:

...

(ii) the designation of the Contracting State or States in which protection for the invention is desired

In Article 121 (1), "(ii)" should be replaced by "(xiii)".

According to Article 4, paragraph 1 (ii), the request for an international application should indicate if the applicant wishes to obtain a regional patent rather than a national patent for certain of the designated States. Therefore, in paragraph 1, the words "within twelve months of the priority date" and "or where appropriate, the International Bureau provided for in that Treaty" should be deleted;

Article 121

The European Patent Office  
as a designated or elected  
Office

(1) The European Patent Office shall act as a designated Office within the meaning of Article 2 (xiii) of the Co-operation Treaty for those Contracting States to this Convention which are designated in the international application if the applicant informs the receiving Office in the international application that he wishes to obtain a European Patent for these States.



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provisions of the PCT  
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under the PCT

Nature of the amendment

Proposed text

on the basis of the international application ("designated States"); if for any designated State a regional patent is available and the applicant wishes to obtain a regional patent rather than a national patent, the request shall so indicate; if, under a treaty concerning a regional patent, the applicant cannot limit his application to certain of the States party to that treaty, designation of one of those States and the indication of the wish to obtain the regional patent shall be treated as designation of all the States party to that treaty;

the words "in the international application" should be inserted in paragraph 1. A special provision is also necessary for the case where a Contracting State makes use of the possibility provided for in the last part of Article 4, paragraph 1(ii).

The same shall apply if in the international application, the applicant designates a Contracting State of which the national law provides, in accordance with Article 4, paragraph 1 (ii), of the Co-operation Treaty, that designation of that State shall have the effect of the application being treated as an application for a regional patent.

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Text of the relevant  
provisions of the PCT  
and of the Regulations  
under the PCT

Nature of the amendment

Proposed Text

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if, under the national  
law of the designated  
State, the designation  
of that State has the  
effect of an applica-  
tion for a regional  
patent, the designat-  
ion of the said State  
shall be treated as an  
indication of the wish  
to obtain the regional  
patent;

---

(2) In so far as any group of  
Contracting States has made use  
of the authorisation under  
Article 8, such group may pre-  
scribe that it may only be  
designated as a whole and that  
the designation of some only of  
the States in the group shall  
be taken as the designation of  
all of these States,

Article 4, paragraph 1  
(ii), PCT (see above)

Paragraph 2 must also  
make provision for the  
case where the national  
law of a State provides  
that designation of  
that State in an inter-  
national application  
has the effect

(2) In so far as any group  
of Contracting States has  
made use of the authorisa-  
tion under Article 8, such  
group may prescribe that  
it may only be designated  
as a whole and that the  
designation of some only  
of the States in the group  
shall be taken as the  
designation

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and of the Regulations  
under the PCT

Nature of the amendment

Proposed text

if the applicant has indicated  
that he wishes to obtain a  
European patent for the design-  
ated State or States of the group.

of the application being  
treated as an application  
for a regional patent. If,  
for example, Dutch law pro-  
vides in the future that  
designation of the Nether-  
lands is to be taken as an  
application for a European  
patent, the designation of  
the Netherlands in a PCT  
application must have the  
effect that all the other  
Member States of the EEC  
are considered to have been  
designated.

of all these States, if  
the applicant has indic-  
ated that he wishes to  
obtain a European patent  
for the designated State  
or States of the group.  
The same shall apply if  
the applicant designates  
one of the Contracting  
States in the group,  
whose national law provides  
that the designation of  
that State shall have the  
effect of the application  
being treated as an appli-  
cation for a regional  
patent.

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under the PCT

Nature of the amendment

Proposed text

(3) The European Patent Office shall act as an elected Office within the meaning of Article 2 (iii) of the Co-operation Treaty if the applicant has elected any of the designated States referred to in paragraph 1 or 2 for which Chapter II of that Treaty has entered into force.

Article 2, PCT

Definitions

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

.....  
(xiv) "elected Office" means the national Office of or acting for the State elected by the applicant under Chapter II of this Treaty;

Article 31

Demand for International Preliminary Examination

...

(2) (b) The Assembly may decide to allow persons entitled to file international applications

In paragraph 3, "(iii)" should be replaced by "(xiv)".

In addition, provision must be made for the European Patent Office being prepared to act as elected Office when the request for preliminary examination comes from a State for which the PCT has not entered into force and which is not bound by Chapter II of the PCT, but in respect of whose nationals the decision provided for in Article 31, paragraph 2(b) has been taken by the Assembly.

(3) The European Patent Office shall act as an elected Office within the meaning of Article 2 (xiv) of the Co-operation Treaty if the applicant has elected any of the designated States referred to in paragraph 1 or 2 for which Chapter II of that Treaty has become binding. The same shall apply where the applicant is a resident or national of a State which is not a party to the Co-operation Treaty or which is not bound by Chapter II of that Treaty,

Text of the Convention establishing a European System for the Grant of Patents (1970 Draft) (First Preliminary Draft and BR/48/70 of 23/9/1970)	Text of the relevant provisions of the PCT and of the Regulations under the PCT	Nature of the amendment	Proposed text
	to make a demand for international pre- liminary examination even if they are resid- ents or nationals of a State not party to this Treaty or not bound by Chapter II.		<u>provided that he is one of the persons whom the Assembly of the Inter- national Patent Co-operation Union has decided to allow, pursuant to Article 31, paragraph 2 (b), of the Co-operation Treaty, to make a request for international pre- liminary examination.</u>
	..... (4) (b) .... Applicants referred to in paragraph (2) (b) may elect only such Contracting States bound by Chapter II as have declared that they are pre- pared to be elected by such applicants.		

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Nature of the amendment

Proposed text

(4) The fee provided for in  
Article 67, paragraph 2, shall  
not be payable for inter-  
national applications.

Compare:

Article 66, paragraph 3

(3) An application for a  
European patent shall be sub-  
ject 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.

Regulations under the PCT

15.1 Basic Fee and  
Designation Fee

Each international  
application shall be  
subject to the payment  
of a fee for the benefit  
of the International  
Bureau ("international  
fee") consisting of:

- (i) a "basic fee" and
- (ii) as many "designation  
fees" as there are  
States designated in  
the international  
application, provided  
that, where a regional  
patent is sought for  
certain designated  
States, only one  
designation fee  
shall be due for  
those States.

A reduction by half of the  
filing fee (Article 66,  
paragraph 3) payable in  
accordance with Article  
22 of the PCT in connec-  
tion with Article 117,  
paragraph 2, could be pro-  
vided for in view of the  
saving for the European  
Patent Office resulting  
from the preparatory work  
of the filing office. The  
following should also be  
noted:

Paragraph 4 was drawn up  
at a time when, under the  
PCT Draft, a separate desig-  
nation fee was to be paid  
for each designated State  
even when a regional patent

(4) For international  
applications only half  
of the fee provided for  
in Article 66, paragraph  
3 shall be payable/ and  
the fee provided for in  
Article 67, paragraph 2,  
shall be payable only for  
the designation of the  
second and each subsequent  
Contracting State.

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Nature of the amendment

Proposed text

was sought for a group of designated States. Under the final version of Rule 15.1 (ii) of the Regulations under the PCT only one designation fee of US \$12 is to be paid in such cases. In view of this, it does not now seem justified to exempt international applicants completely from paying the designation fee provided for in Article 67, paragraph 2, of the Convention. Paragraph 4 cannot be deleted completely as this would mean that the applicant would be unjustly burdened with the payment of an additional designation fee; under the European Convention he would have to pay a designation fee for each designated State and under the Regulations under the PCT he would have to pay a designation fee for all the designated States parties to the European Convention. The practical solution is that designation fees should be payable only for the second and each subsequent designation. The

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under the PCT

Nature of the amendment

Proposed text

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fact that the PCT designation  
fee and the European design-  
ation fee will be of diffe-  
rent amounts need not be taken  
into consideration here.



11. (No provision)

Article 25, paragraph  
(2)(a), PCT

(2)(a) Subject to the provisions of subparagraph (b), each designated Office shall, provided that the national fee (if any) has been paid and the appropriate translation (as prescribed) has been furnished within the prescribed time limit, decide whether the refusal, declaration, or finding, referred to in paragraph (1) was justified under the provisions of this Treaty and the Regulations, and, if it finds that the refusal or declaration was the result of an error or omission on the part of the receiving Office or that the finding was the result of an error or omission on the part of the International Bureau, it shall, as far as effects in the State of the designated Office are concerned, treat the international application as if such error or omission had not occurred.

The department of the European Patent Office which is to be competent to take decisions under Article 25 (2)(a) of the PCT must be specified.

Article 123 a (new)  
Decisions of the European  
Patent Office under Article  
25 (2) of the Patent Co-  
operation Treaty

The Boards of Appeal shall be competent to take decisions which the European Patent Office is required to take as a designated Office under Article 25 (2) (a) of the Patent Co-operation Treaty.

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Nature of the amendment

Proposed text

12. (No provision)

cf. Article 79  
Obtaining of report  
on the state of the art

.....

(5) If an additional report  
on the state of the art  
becomes necessary, by reason  
of lack of unity of the  
invention, the Examining  
Section shall invite the  
applicant, at his option,  
within a period of one month,  
either to restrict the appli-  
cation to one invention or  
to pay the additional fee  
prescribed by the Rules  
relating to fees adopted  
pursuant to the Convention.

(6) If the applicant does  
not restrict the application  
to one invention only or the  
fee provided for in paragraph  
5 is not paid in due time,  
the part of the application

Article 17 PCT

Procedure before the  
International Searching  
Authority

.....

(3) a) If the Inter-  
national Searching  
Authority considers  
that the international  
application does not  
comply with the require-  
ment of unity of invention  
as set forth in the Regu-  
lations, it shall invite  
the applicant to pay  
additional fees. The  
International Searching  
Authority shall establish  
the international search  
report on those parts of  
the international appli-  
cation which relate to the  
invention first mentioned  
in the claims ("main in-  
vention") and, provided

A provision must be  
inserted with a view  
to complementing the  
authorisation contained  
in Article 17 paragraph  
3 subparagraph b of the  
PCT.

New Article 123 b

Incomplete search report

If the search report sub-  
mitted by the International  
Searching Authority following  
the procedure set forth in  
Article 17 paragraph 3 sub-  
paragraph a of the Co-operati  
Treaty does not cover the  
entire international appli-  
cation, Article 70 paragraphs  
5 and 6 applies; if the  
Examining Section considers  
as unjustified the opinion of  
the International Searching  
Authority that the applicatio  
is not uniform, it shall  
invite the applicant merely t

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Nature of the amendment

Proposed text

which is not covered by the  
search report shall be deemed  
to be withdrawn.

the required additional  
fees have been paid within  
the prescribed time limit,  
on those parts of the  
international application  
which relate to inventions  
in respect of which the said  
fees were paid.

pay the additional fees  
mentioned in Article 79 para-  
graph 5.

b) The national law of any  
designated State may provide  
that, where the national  
Office of that State finds  
the invitation, referred to  
in subparagraph (a), of the  
International Searching  
Authority justified and where  
the applicant has not paid  
all additional fees, those  
parts of the international  
application which consequently  
have not been searched shall,  
as far as effects in that  
State are concerned, be  
considered withdrawn unless  
a special fee is paid by  
the applicant to the national  
Office of that State.

13. (No provision)

Regulations under the PCT

68.3 Additional Fees

.....

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protest shall be examined by a three - member board or other special instance of the International Preliminary Examining Authority, or any competent higher authority, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee.

In case the European Patent Office should become an International Preliminary Examining Authority, a provision must be drafted stating to which department of the European Patent Office a protest against the levy of an additional fee for alleged lack of unity of invention. A new Article 123c should therefore be inserted.

Article 123 c (new)

Protest against an additional fee charged by the European Patent Office

The Boards of Appeal shall be responsible for deciding on a protest by the applicant against an additional fee charged by the European Patent Office for the international preliminary examination in accordance with Article 34, paragraph 3 (a) of the Co-operation Treaty

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Proposed Text

On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the elected Offices as an annex to the international preliminary examination report.

(d) The three - member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person who made the decision which is the subject of the protest.

Re. Rule 68.3 (d):

It can be assumed that any member of the Boards of Appeal who has taken part in the decision which is the subject of the protest, will state his partiality.

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**Nature of the amendment**

**Proposed text**

14. (No provision)

Article 34, PCT

Procedure before the  
International Preliminary  
Examining Authority

.....

(3) (a) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it may invite the applicant, at his option, to restrict the claims so as to comply with the requirement or to pay additional fees.

(b) The national law of any elected State may provide that, where the

It is proposed not to make use of the powers provided for in Article 34 (3) (a) and (b) of the PCT. The imposition of a special fee would involve disproportionately large administrative expenses. There is also no great advantage in considering extending the examination report to cover every part of the application by imposing a special fee, as the report only carries the weight of an expert opinion.

(No provision)

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applicant chooses to restrict the claims under subparagraph (a), those parts of the international application which, as a consequence of the restriction, are not to be the subject of international preliminary examination shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to the national Office of that State.

(c) If the applicant does not comply with the invitation referred to in subparagraph (a) within the prescribed time limit, the International Preliminary Examining Authority shall establish an international preliminary examination report on those parts of the international application which relate to what

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under the PCT

Nature of the amendment

Proposed text

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appears to be the main  
invention and shall indi-  
cate the relevant facts in  
the said report. The  
national law of any elected  
State may provide that,  
where its national Office  
finds the invitation of  
the International Prelimi-  
nary Examining Authority  
justified, those parts of  
the international application  
which do not relate to the  
main invention shall, as far  
as effects in that State are  
concerned, be considered  
withdrawn unless a special  
fee is paid by the applicant  
to that Office.