

BR/GT I/75 e/70

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Comment:

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- Secretariat -

"IMPLEMENTING REGULATIONS" SUB-COMMITTEE
OF WORKING PARTY I

Subject: Observations by the Institut International des
Brevets on the regulations "Re Article 70, N° 1"

The Institut International des Brevets, being directly concerned by the application of the regulations relating to unity of invention, in particular by those relating to claims of different categories, would like to offer the following observations to the sub-committee:

1. The I.I.B. is of opinion that it is fitting in the first place to clarify the relation existing between the text of Article 70 of the Convention and the provisions of the Implementing Regulations relating to it. In this regard it seems to be neither desirable nor correct to construe the latter as rules for interpreting the text of the Convention to which they refer and word them accordingly. In reality, every plurality of independent claims can relate to several general inventive concepts, irrespective of the categories involved.

BR/GT I/75 e/70 prk

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On the other hand, it seems to be impossible to say a priori that a particular series of claims included in one and the same application of necessity implies the existence of several inventive concepts. The I.I.B. concludes therefore that the subject matter of regulation N° 1 Re Article 70 is related to but not identical with that of Article 70 of the Convention. In consequence, the point of view of the United Kingdom delegation that "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" (BR/GT I/G4/70) seems to be applicable not only to the provisionally adopted text but also to any enumeration of different categories of claims, even more restrictive, in so far as it is to be construed as a rule for interpreting the text of the Convention.

The I.I.B. is of the opinion, however, that such a consequence could easily be avoided by wording the text of the implementing regulations in such a way as to draw a clear distinction between the object of the regulations and the object of Article 70. To this end, the introductory phrase of the regulation N° 1 Re Article 70 could be formulated as follows:

"Without prejudice to Article 70 of the Convention, an application for a European Patent may include more particularly:"

Formulating the text of the implementing regulations in this way would moreover avoid the risk of its being held void in so far as it proved to be in conflict with or modifying the text of the Convention, the regulations being subordinate to the Convention.

2. In view of the fact that the object of the regulation N° 1 Re Article 70 can be neither to interpret nor to modify the scope of Article 70 of the Convention, the I.I.B. is of opinion that its prime purpose is to guarantee that the number and diversity of the claims allowable in one and the same application do not exceed reasonable limits.

It is interesting in this connection that the few national laws that contain provisions on this matter are essentially more limiting than the provisional text adopted by the sub-committee. Thus, the Nordic legislation provides in Section 15 that an application may contain a main claim relating to a product, and in addition claims relating to one single apparatus and/or one single process for making this product. Alternatively, a main claim relating to a process may be accompanied by claims relating to a single apparatus designed for carrying out this process.

Analogously, section 52 of the Swiss patent law, while allowing a greater variety of possible claims, limits the number to four.

In view of the foregoing, the I.I.B. has difficulty in believing that it is opportune to introduce regulations that not only appear excessive in comparison with existing texts adopted at national and international level but also allow the inclusion in one and the same application of a very great variety of claims, theoretically unlimited in number. On the contrary, it would seem to be in the interests both of the official bodies and of the applicants to apply identical criteria to international applications filed under the PCT and applications for European patents.

While associating itself with the other arguments already advanced by the United Kingdom and Swedish delegations, the I.I.B. is therefore in agreement, on the question of the enumeration of the independent claims of different categories that may be included in one and the same application, with the proposal of these delegations that aims at harmonising regulation N° 1 Re Article 70 with rule 13.2 of the implementing regulations of the Patent Co-operation Treaty.

BR/GT I/75 e/70 prk

