

BR/GT I/78 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.

- Secretariat -

Working document
for Draft Implementing Regulations
to the Convention establishing a European System for the Grant of Patents
put forward by the Chairman of the
"Implementing Regulations" sub-Committee of Working Party I

Re. Article 16, Nos. 1 bis and 2 bis
Re. Article 17, Nos. 1, 2 and 3
Re. Article 21, No. 3
Re. Article 22, No. 1
Re. Article 66, No. 5

P R O P O S A L

(1) If, during the examination of an opposition lodged against a European patent, proof is provided to the European Patent Office that proceedings have been instituted for the purpose of establishing that a person referred to in Article 15, paragraph 1, of the Convention, other than the proprietor of the patent, is entitled to the European patent, the European Patent Office shall stay the proceedings for examination of the opposition, unless the person who claims to be entitled to the European patent consents to the continuation of such proceedings. Such consent must be notified in writing to the European Patent Office; it shall be irrevocable.

(2) If the proof referred to in paragraph 1 is provided during the opposition period, the European Patent Office shall stay proceedings for the examination of oppositions lodged against the European patent, subject to the consent referred to in paragraph 1.

(3) Where proof is provided to the European Patent Office that a final decision has been given in favour of the proprietor of the patent in the proceedings concerning entitlement to the European patent, proceedings for examination of the opposition shall be resumed with the said proprietor. If the decision is in favour of the person who claimed to be entitled to the European patent, the proceedings shall not be resumed before the expiry of a suitable period.

(4) Notification of the suspension or resumption of the proceedings shall be entered in the Register of European Patents and published in the European Patent Bulletin.

Notes

1. The purpose of this Article is to apply to opposition proceedings provisions similar to those of Article (Re. Article 16, No. 1), in accordance with Note 1 to that Article. If the above proposal is adopted, the said Note should be deleted.
2. Adoption of the proposed Article pre-supposes an amendment to Article 16 of the First Preliminary Draft, in order to extend that Article to cover opposition proceedings (see reports, point 30, paragraph 2).

Limitation of the option to surrender a European patent

P R O P O S A L

As from the receipt by the European Patent Office of notification that proceedings have been instituted under Article (Re. Article 16, No. 1 bis), the European patent may not be surrendered in any of the Contracting States, save with the consent of the person who instituted the said proceedings. If, after a period of one month from receipt of notification, proof that such proceedings have been instituted has not been provided, the proprietor of the patent shall recover his right to surrender the said patent until such time as this proof is provided.

Notes

1. The purpose of this Article is to apply to opposition proceedings provisions similar to those of Article (Re. Article 16, No. 2), in accordance with Note 1 to that Article. Adoption of the above proposal would entail deletion of the said note.
2. Adoption of the proposed Article pre-supposes an amendment to Article 16 of the First Preliminary Draft, in order to extend the provisions of that Article to cover opposition proceedings.

P R O P O S A L

(1) The inventor may only be designated before the European Patent Office by the proprietor of or applicant for the European patent. Such designation may be effected at any time prior to the end of the opposition period or, where an opposition has been lodged, prior to the time when such opposition gives rise to a final decision.

(2) Unchanged

(3) Unchanged

Notes

1. This Article is intended to replace the Article appearing under the same number in BR/42/70. Paragraph 1 is amended so as to extend the provisions contained in the earlier text to cover opposition proceedings.
2. The proposed Article pre-supposes an amendment to Article 16 to the First Preliminary Draft.
3. Adoption of the proposed Article would entail the deletion of Note 2 to the present Article (Re. Article 17, No. 1).

Re* Article 17

Nos. 2 and 3

Publication of the mention of the inventor

Rectification or cancellation of the designation of an inventor

Note

The extension of the provisions of these two Articles to cover opposition proceedings
(See the notes to each of these Articles in BR/GT I/ /70 would not appear to involve any
amendment to their present text.

Grant of a patent of addition to assignees
of the applicant for or proprietor of a parent patent

P R O P O S A L

(1) The person or persons entered in the Register of European Patents as proprietors of the parent European patent shall be deemed to be the proprietors of that patent, within the meaning of Article 21, paragraph 3, of the Convention, for the purposes of the grant of a European patent of addition.

(2) If proof is provided to the European Patent Office that the parent European patent has been the subject of one or more assignments in all or in some of the Contracting States, such assignments being subject to opposition before the central industrial property authorities of the States in question, the assignee or assignees in the Contracting States in respect of which the patent of addition is granted shall be deemed to be the proprietors of the parent European patent, within the meaning of Article 21, paragraph 3, of the Convention, for the purposes of the grant of the patent of addition.

Notes

1. Paragraph 1 relates to cases in which property of the parent patent undergoes no change subject to opposition before the European Patent Office between the grant of that patent and grant of the patent of addition. The "persons entered in the Register of European Patents" referred to in the said paragraph may be either the initial applicant or applicants, or the assignees of the application. In such cases, the latter may have acquired either the undivided or divided property of the said application (see article 22 of the Convention).
2. It would be advisable to question whether this paragraph is necessary and whether these provisions are not implicit in Article 21 (3) of the First Preliminary Draft.
3. Paragraph (2) refers to the case of the assignment of the parent European patent (and no longer to that of the application), before the grant of the patent of addition. Under the present provisions of the First Preliminary Draft, assignments affecting a European patent are not notified to the European Patent Office, even during opposition proceedings. It is, moreover, a moot point as to whether provisions to this effect would not be desirable. Whatever the case, the paragraph in question only refers to "national" proof of the assignment, such proof not being defined, since it will tend to vary according to the law of the Contracting States in question.
4. Other implementing provisions will perhaps have to be adopted if the Convention (see Note on Article 21 (3)) is to contain provisions on the right to apply for a European patent of addition after an assignment of the parent patent application to different proprietors in accordance with Article 22 of the Convention.

Re. Article 22

No. 1

Procedure in the event of a European patent application
being assigned to different persons in different countries

- deleted -

Note : See note to this Article in BR/42/70.

It would not appear necessary to provide any Implementing Regulations on this point. The only question which seems to arise is that of how the different persons making the European patent application are to be represented before the European Patent Office. The provisions (of a general nature) of Article ... (Re. Article 161, No. 10) (BR/GT I/63/70, page 77) would seem to settle this question.

Form and content of the abstract

P. C. T.

P R O P O S A L

Rule 8.1 - Contents and Form of the Abstract

(a) The abstract shall consist of the following:

(i) a summary of the disclosure as contained in the description, the claims, and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention;

(ii) where applicable, the chemical formula which, among all the formulae contained in the international application, best characterises the invention.

(b) The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English).

(c) The abstract shall not contain statements on the alleged merits or value of the claimed invention or on its speculative application.

(1) The abstract shall indicate the title of the invention.

(2) The abstract shall indicate clearly and as concisely as possible the technical field to which the invention pertains, the technical problem which it is intended to solve, the principle of the solution which it provides to the problem and the principal applications of the invention. It shall, where applicable, contain the chemical formula, which, among those contained in the application, best characterises the invention. It shall not contain statements on the alleged merits or value of the invention or on its speculative application.

(3) The abstract shall not, in principle, contain more than one hundred and fifty words.

Rule 3.3 - Check List

- (a) The printed form shall contain a list which, when filled in, will show:
- (iii) the number of that figure of the drawings which the applicant suggests should accompany the abstract when the abstract is published on the front page of the pamphlet and in the Gazette; in exceptional cases, the applicant may suggest more than one figure.

Rule 8.1 - Contents and Form of the Abstract

- (d) Each main technical feature mentioned in the abstract and illustrated by a drawing in the international application shall be followed by a reference sign, placed between parentheses.

Rule 8.2 - Failure to Suggest a Figure to be Published with the Abstract

If the applicant fails to make the indication referred to in Rule 3.3 (a) (iii), or if the International Searching Authority finds that a figure or figures other than that figure or those figures suggested by the applicant would, among all the figures of all the drawings, better characterise the invention, it shall indicate the figure or figures which it so considers. Publications by the International Bureau shall then use the figure or figures so indicated by the International Searching Authority. Otherwise, the figure or figures suggested by the applicant shall be used in the said publications.

- (4) If the European patent application contains drawings, the applicant shall indicate the figure or, exceptionally, the figures of the drawings which he suggests should accompany the abstract when the abstract is published. The European Patent Office may decide to publish one or more other figures if it considers that they better characterise the invention. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by a reference sign, placed between parentheses.

Rule 8.3 - Guiding Principles in Drafting

The abstract shall be so drafted that it can efficiently serve as a scanning tool for purposes of searching in the particular art, especially by assisting the scientist, engineer or researcher in formulating an opinion on whether there is a need for consulting the international application itself.

- (5) The abstract shall be so drafted that it constitutes an efficient instrument for purposes of selection in the particular technical field, particularly by making it possible to assess whether there is a need for consulting the patent application itself.

Notes:

- (1) The term "summary" which appears in certain provisions of the Draft Implementing Regulations is replaced here by "abstract", the term used in the First Preliminary Draft Convention.
- (2) The square brackets in paragraph 11 of Article ... (Re. Article 66, No. 7) should be deleted.

