

BR/GT I/79 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
submitted by the Chairman of the "Implementing Regulations" Sub-Committee of
Working Party I
for the Preliminary Draft Implementing Regulations to the Convention
establishing a European System for the Grant of Patents

STAGE REACHED IN THE WORK OF THE SUB-COMMITTEE
ON 17 NOVEMBER 1970

FIRST PRELIMINARY DRAFT PUBLISHED 1970 (F.P.D.)	DRAFT IMPLEMENTING REGULATIONS	NOTES BY SUB-COMMITTEE AND - OBSERVATIONS -
<p>Art. 1 - European system for grant of patents</p> <p>Art. 2 - European patent; Art. 3 - Territorial limitation; Art. 4 - European Patent Office.</p> <p>Art. 5 - Persons entitled to apply for European patent</p> <p>Arts. 6 to 8</p> <p>Arts. 9 to 11</p> <p>Art. 12 - Non-prejudicial disclosures</p> <p>Art. 13 - Inventive step</p>	<p>- <u>GENERAL PROVISIONS</u> -</p> <p>Re. Art. 1, No. 1 - Patent classification in use by EPO</p> <p>- None -</p> <p>- None -</p> <p>- None -</p> <p><u>SUBSTANTIVE PATENT LAW</u></p> <p>- None -</p> <p>Re. Art. 12, No. 1 - Disclosure of invention at international exhibition</p> <p>- None -</p>	<p><u>BR/42 and 43/70 - 14.7.70</u></p> <p>Attached to Art. 1 for the record - terminology of classification to be reviewed in light of conclusions of "Council of Europe/BIRPI" Working Party.</p> <p>Arts. 2 and 4 F.P.D. have been amended (see BR/48/70 - 23.9.70).</p> <p>Art. 5 F.P.D. has been amended (see BR/48/70) - Implementing regulation premature. After amendment to Art. 5, no regulation?</p> <p>- None -</p> <p>- None -</p> <p>- None -</p> <p>Second variant of Art. 13 F.P.D. has been deleted - deletion means Art. 21, para. 5 F.P.D. to be re-examined (BR/48/70).</p>

Art. 14 - Industrial application.

- None -

- None -

2

Art. 15 - Right to grant of European patent.

- None -

Question of joint inventions referred to Art. 22, but not yet dealt with.

Art. 16 - Patent applications by persons who are not entitled to apply.

Re. Art. 16, No. 1 - Suspension of proceedings for grant.

Art. 16 F.P.D. should be reviewed - Case of assignment - case of filing of a new application - choice - provisions similar to re. Art. 16, No. 1, for opposition proceedings - provision in first para. within scope of Convention? (see BR/GT I/78/70)

"

Re. Art. 16, No. 2 - Limitation of option to withdraw application for European patent.

See previous observations - limitation of option of applicant to dispose of application. (see BR/GT I/78/70)

Art. 17 - Right of inventor to be mentioned as such.

Re. Art. 17, No. 1 - Mention of inventor.

Para. 1 adjourned pending proposals by Sweden - mention of inventor during opposition proceedings - pre-supposes amendments to Art. 17 F.P.D. (see BR/GT I/78/70).

"

Re. Art. 17, No. 2 - Publication of mention of inventor.

See previous note - question of mentioning inventor in application referred to re. Art. 85 (not covered in proposal re. Art. 85 and referred to instructions by President of EPO). (See BR/GT I/78/70).

"

Re. Art. 17, No. 3 - Rectification or cancellation of designation of inventor.

See note under Re. Art. 17, No. 1 (see BR/GT I/78/70).

Arts. 18 to 20.

- None -

- None -

Art. 20a - Term of European patent.

- None -

New article added after F.P.D. (BR/48/70).

Art. 21 - European patents of addition.

"

"

Art. 22 - Unitary character of European patent application.

Assignment of a European patent application.

Arts. 24 to 27.

Art. 28 - Contractual licensing of a European patent application.

Re. Art. 21, No. 1 - Prohibition of conversion of an application for an independent patent.

Re. Art. 21, No. 2 - Dependency of a European patent of addition upon parent patents.

Re. Art. 21, No. 3 - Grant of a patent of addition where parent patent has been assigned to different persons in different countries.

Re. Art. 22, No. 1 - Procedure in event of European patent application being assigned to different persons in different countries.

Re. Art. 23, No. 1 - Examination of request for recording of assignment. (In R.E.P.).

- None -

Re. Art. 28, No. 1 - Recording and cancellation of an entry concerning grant or assignment of a licence (in R.E.P.).

- None -

- None -

Provisions to be drafted later, pending re-examination Art. 21 (3) F.P.D. (see BR/GT I/78/70).

To be drafted later - provisions for application to assignees in different countries considered as joint applicants (see BR/GT I/78/70). Art. 22 F.P.D. has been amended (BR/48/70).

- None -

None - Arts. 24 to 27, not drafted in F.P.D., have been deleted (BR/48/70).

To be reviewed - insert in Re. Art. 28, No. 1 provisions of Re. Art. 26 F.P.D. 1964 adapted to licensing as deleted in Convention (Art. 24 F.P.D. 1970) - question of fees covered in two different documents (Convention and Implementing Regulations) - Art. 28 (2) F.P.D. deleted but redrafted in amended form in Art. 28a (BR/48/70) - amendment of references and title of re. Art. 28, No. 1?

Art. 28a - Entry of licences and rights in respect of a European patent application in R.E.P.

- None -

See previous note, end - on deletion Art. 28 (2) F.P.D. and new Art. 28a (BR/48/70).

Art. 29 - Supplementary application of national law in legal transactions.

- None -

Text of Art. 29 (not drafted in F.P.D.) in BR/48/70 - does not seem to require implementing regulations.

EUROPEAN PATENT OFFICE

Arts. 30 to 33

- None -

- None -

Art. 34 - Languages

Re. Art. 34, No. 1 - Legal authenticity and time limit for filing of translation of application.

None - Art. 34 (5) F.P.D. has been amended (BR/48/70).

"

Re. Art. 34, No. 2 - Reduction of fees.

To be reviewed - details to be drafted later and reference to Rules relating to Fees for percentage of reduction.

"

Re. Art. 34, No. 3 - Use of language of proceedings.

- None -

"

Re. Art. 34, No. 4 - Derogation from provisions concerning language of proceedings in written proceedings.

- None -

"

Re. Art. 34, No. 5 - Derogations from provisions concerning language of proceedings in oral proceedings.

Para. 3 to be reviewed after examination by W.P.I. of articles on evidence and measures for taking evidence (Art. 154, BR/48/70 and Implementing Regulations re. Art. 154?).

"

Re. Art. 34, No. 6 - Change of language of proceedings.

- None -

"

Re. Art. 34, No. 7 - Language of applications for patents of addition.

- None -

Art. 34 - Languages

Re. Art. 34, No. 8 - Language used in event of division of European patent applications.

- None -

"

Re. Art. 34, No. 9 - Language used in event of division of European patents.

Drafting adjourned: division in opposition proceedings?

Arts. 35 to 52

- None -

Art. 53 - The Departments

Re. Art. 53, No. 1 - Allocation of duties to Examining Sections and Examining Divisions.

- None -

- None -

"

Re. Art. 53, No. 2 - Allocation of duties to Boards of Appeal.

- None -

"

Re. Art. 53, No. 3 - Classifying of European patent applications and of European patents.

None, but see note to re. Art. 1, No. 1 F.P.D.

"

Re. Art. 53, No. 4 - Administrative structure of EPO.

- None -

Art. 54 - Examining Section.

Re. Art. 54, No. 1 - Special Examining Section for fixing of costs of proceedings.

To be reviewed once Art. 54 has been reviewed by W.P.I.

Arts. 55 to 58

- None -

Art. 59 - Register of European Patents.

Re. Art. 59, No. 1 - Particulars to be entered in R.E.P.

- None -

List of particulars to be reviewed in light of final text of Convention and provisions of PCT - question of entering particulars during opposition period and opposition proceedings pending.

Art. 60 - Publications of EPO.

- None -

Make provision for publication in Official Journal of EPO of Convention texts in force and situation of States vis-à-vis these texts (W.P.II, BR/48/70 and BR/53/70, 6 and 8 October 1970).

Art. 61

- None -

- None -

Art. 62 - Requests for information.

Re. Art. 62, No. 1 - Communications between EPO and authorities of Contracting States.

- None -

"

Re. Art. 62, No. 2 - Communication of files to third parties by Courts or Public Prosecutors' Offices of Contracting States.

BR/50 and 51/70 of 5 and 7.10.70

- None -

"

Re. Art. 62, No. 3 - Expenditure in respect of communications between EPO and authorities of Contracting States.

Additional provisions to be drafted to apply to Art. 180 (BR/48/70)?

Art. 63 - Letters rogatory.

Re. Art. 63, No. 1 - Procedure for letters rogatory.

References to Hague Convention of 1 March 1954 to be checked and provision to be reviewed with government legal experts.

APPLICATION FOR EUROPEAN PATENTS

Art. 64 - Filing of the application.

Re. Art. 64, No. 1 - Filing of European patent applications.

- None -

"

Re. Art. 64, No. 2 - Date of filing of documents concerning European patent applications.

Question of depositing documents in letter-box of an office on a day when office is closed to be examined with questions regarding time limits (Re. Art. 155, No. 2, but does not seem to have been specifically intended here).

"

Re. Art. 64, No. 4 - (BR/GT I/52/70 - proposal) - Filing of European patent applications with competent authorities of Contracting States.

Pending, particularly in view of the questions connected with national defence - Articles 64 and 65 F.P.D. should be re-examined in this connection.

Art. 65 - Forwarding of applications for European patents.

Art. 66 - Requirements of application.

"

"

"

"

"

"

"

Re. Art. 65, No. 1 - (BR/GT I/52/70 - proposal) - Non-transmission of European patent applications.

Re. Art. 66, No. 1 - Form and content of request for grant of a patent.

Re. Art. 66, No. 2 - Content of description.

Re. Art. 66, No. 3 - Form and content of claims.

Re. Art. 66, No. 4 - Form of drawings.

Re. Art. 66, No. 5 - Form of content of summary (abstract?).

Re. Art. 66, No. 6 - Prohibited matter.

Re. Art. 66, No. 7 - General provisions governing presentation of application documents.

Re. Art. 66, No. 8 - Documents filed subsequently.

As previous note.

It should be possible for some of these provisions to be amended on instructions by President of EPO - general provision to be made? Para. 2 (e) to be reviewed - question of division of patent during opposition proceedings. Para. 2 (i) to be reviewed with government legal experts - question of authorisations of agents, Art. 173 (BR/48/70) and of common representative (re. Art. 161 - notifications, not yet examined) Para. 2 (k) "summary" or "abstract"? (BR/48/70).

- None -

Para. 1: Implementing Regulation or provision to be inserted in Convention? Para. 4 (a): to be reviewed - and new proposal by Swiss delegation (BR/GT I/67/70, 15.10.70) and working document by General Rapporteur (BR/GT I/72/70).

- None -

Proposal to be submitted by Chairman (see BR/GT I/78/70).

- None -

(Summary, abstract?). Para. 11 to be reviewed with Re. Art. 64, No. 5.

- None -

Art. 66 - Requirements of application.

"

"

Arts. 67 and 68

Art. 69 - Failure to pay filing fee or to provide a translation.

Art. 70 - Unity of invention.

"

Art. 71 - Disclosure of the invention.

Arts. 72 to 76

Re. Art. 66, No. 9 - Form and number of copies of documents furnished during proceedings.

Re. Art. 66, No. 10 - Signing of documents.

Re. Art. 66, No. 11 - (BR/GT I/52/70 - proposal) Payment of fees.

- None -

Re. Art. 69, No. 1 - Notification sent to applicant informing him that his patent application is deemed to be withdrawn.

Re. Art. 70, No. 1 - Claims in different categories.

Re. Art. 70, No. 2 - Claims in same category.

Re. Art. 71, No. 1 - Number of claims.

- None -

- None -

- None -

Provision referred to Fees Subcommittee.

- None -

See note in F.P.D. to Art. 69 - provision attached to Art. 69 for record - differences of views and discussion postponed to later meeting - written proposal submitted by German delegation (18.9.70) and see re. Art. 71, No. 1.

Problem to be reconsidered. Observations by the United Kingdom delegation in BR/GT I/64/70, 15.10.70 and by Swedish delegation 22.10.70 and by IIB (BR/GT I/75/70, 10.11.70).

- None -

Questions of "withdrawal" of application in case of non-payment of claims fees to be reviewed with re. Art. 69, No. 1.

Art. 73 F.P.D. amended by BR/48/70. No Implementing Regulations for Art. 75 F.P.D. as provisions explicit.

EXAMINATION, GRANT AND OPPOSITION

Arts. 77 and 78

Art. 79 - Obtaining of report on state of art.

Arts. 80 and 81

Arts. 82 and 83 - Amendment of claims and of documents

Art. 84

Art. 85 - Publication of a European patent application.

Art. 85 - Publication of a European patent application.

Arts. 86 and 87

- None -

Re. Art. 79 (Drawing up reports on state of art).

- None -

- None -

- None -

Re. Art. 85, No. 1 - Details to be included in publication of a European patent application (deleted)

Re. Art. 85, No. 1 - Publication of European patent applications and of specification of a European patent.

- None -

- None -

To be drafted - examination of Note by IIB of 12.10.70 on rules governing report on state of art and notes to Re. Art. 79. Art. 79 F.P.D. amended by BR/48/70: see para. 4 (a) new.

- None -

Conditions governing amendments to be prescribed by President of EPO.

- None -

(Art. 85 F.P.D. amended by BR/48/70). Wording and title of re. Art. 85, No. 1 amended at meeting of 20.10.70 to cover Arts. 98 and 107 F.P.D. - see re. Art. 85, No. 1 below.

BR/59/70 and BR/60/70 of 9 and 16 November 1970

Replaces re. Art. 85, No. 1 above. Data prescribed by President of EPO. Attached to Art. 85 only for the record.

- None -

Art. 88 - Request for examination.

"

"

Arts. 89 to 96

Art. 97 - Grant of the European patent.

Art. 97a new - Translation of European patent. (BR/48/70)

Art. 98 - Publication of a European patent.

Art. 99 - Certificate for a European patent.

Art. 100 - Translation of specifications..

Re. Art. 88, No. 1 - Form of the request for examination.

Re. Art. 88, No. 2 - Refusal of a request for examination.

Re. Art. 88, No. 3 - Continuation of procedure for grant where a request made by a third party is invalid.

- None -

Re. Art. 97 - (Oral proceedings during grant proceedings).

- None -

- None -

Re. Art. 99 - Certification of copies of the European patent certificate.

- None -

(Art. 88 F.P.D. amended by BR/48/70). Representation before EPO not compulsory for a third party making a request for examination who does not have a residence in one of the Contracting States. Exception to be made explicitly in re. Art. 172?

- None -

Para. 1 possibly to be reviewed for purpose of drawing up a general provision for continuation of examination under all circumstances except withdrawal of the application. Need for a general provision in the Convention on question of legal incapacity before EPO?

- None -

(Art. 97 F.P.D. amended by BR/48/70). Provision to be inserted in Convention concerning oral proceedings before EPO during grant proceedings or general provision combining all provisions concerning hearings and oral proceedings. In the latter case, proposal attached to Art. 97 for convenience.

- None -

See note to Art. 100.

See note to Re. Art. 85, No. 1.

- None -

None. (Art. 100 F.P.D. amended by BR/48/70: costs of publication of the translation - sanction).

.../...

Provisions of Art. 100 F.P.D.
amended and replaced by Art. 97a
new and Art. 100 amended.

Art. 101 - Opposition.	Re. Art. 101, No. 1 - Form of notice of opposition.	(Art. 101 F.P.D. amended by BR/48/70). Question of transfer to Implementing Regulations of provision in second sentence of Art. 101 (1) (notice of opposition given in writing). Re-examine para. c, reference to ... (Art. 101 a, new), not yet drafted.
"	Re. Art. 101, No. 2 - Requests for documents.	- None -
"	Re. Art. 101, No. 3 - Rejection of the notice of opposition as inadmissible.	See note 2 to Art. 101 F.P.D. (Opposition Division).
"	Re. Art. 101, No. 4 - Continuation ex officio of opposition proceedings.	See previous note and question of representation, Art. 172.
Art. 102 to 105	- None -	- None -
Art. 106 - Hearings before the Examining Division.	Re. Art. 106, No. 1 - Participation of the other parties at a hearing.	- None -
Arts. 107 to 110	- None -	- None -
Art. 111 - Time limit and form of appeal.	Re. Art. 111, No. 1 - Content of appeal.	- None -
Art. 112 - Interlocutory revision.	Art. 112, No. 1 - Reimbursement of appeal fees.	- None -
Art. 113 - Examination of appeals.	Re. Art. 113, No. 1 - Observations by the parties.	- None -
"	Re. Art. 113, No. 2 - Waiving of right to participate.	- None -
"	Re. Art. 113, No. 3 - Application of certain provisions.	See note to Re. Art. 115, No. 1

Art. 114 - Hearings on appeal.

Art. 115 - Decision in respect of appeals.

Arts. 116 to 123

Arts. 124 to 128

Art. 129

Art. 130 - Payment of renewal fees.

"

FIRST PRELIMINARY DRAFT NOT
PUBLISHED 1970 (BR/48/70)

Arts. 133 and 134

Re. Art. 114, No. 1 - Conduct of hearings.

Re. Art. 115, No. 1 - Form of decision of Board of Appeal.

- None -

- None -

RENEWAL OF EUROPEAN PATENT APPLI-
CATIONS AND EUROPEAN PATENTS

- None -

Re. Art. 130, No. 1 - Renewal fees in respect of patents of addition which have become independent.

Re. Art. 130, No. 2 - Renewal fees in respect of applications for divisional European patents.

- None -

See note to Re. Art. 97. Provisions to be re-examined with government legal experts. Need to refer these provisions to internal rules of procedure of EPO?

Provisions of Art. 115 (3) of F.P.D. should be extended to cover opposition proceedings. See also note to Re. Art. 159, No. 3.

- None -

None; Arts. 124 to 128 not yet drafted (F.P.D. and BR/48/70).

- None -

Art. 130 F.P.D. to be lengthened to specify that renewal fees to be paid in advance?

- None -

- None -

Art. 153	- None -	- None -
Art. 154 - Investigation.	Re. Art. 154, No. 1 - Investigation by EPO.	Question who to take initiative for appearance of witnesses and experts still to be settled.
"	Re. Art. 154, No. 2 - Part payment of costs of taking evidence.	- None -
"	Re. Art. 154, No. 3 - Summons to give evidence.	See note to Re. Art. 154, No. 1.
"	Re. Art. 154, No. 4 - Commissioning experts.	- None -
"	Re. Art. 154, No. 5 - Hearing of witnesses and experts.	To be reviewed with (Art. 154 (5)).
"	Re. Art. 154, No. 6 - Payment of expenses of witnesses and experts.	Principle that each person to bear the costs which he has caused to be contained in a provision of the Convention?
"	Re. Art. 154, No. 7 - Conservation of evidence.	Opinions divided on the need for this provision.
Art. 155 - Time limits.	Re. Art. 155, No. 1 - Calculation of time limits.	- None -
"	Re. Art. 155, No. 2 - Extension of time limit.	- None -
Art. 156 - Observation of time limit, prevented by force majeure.	Re. Art. 156, No. 1 - Re-establishment of the rights of an applicant.	Application to be made in writing, see Art. ... (Re. Art. 88, No. 1) and note to Re. Art. 101, No. 1.
Art. 157 - Death of applicant or proprietor.	Re. Art. 157, No. 1 - Public notice.	Procedures to be determined by President of EPO.
Art. 158a	- None -	- None -

Art. 159 - Reference to general principles.

"

Re. Art. 159, No. 1 - Term and form of the summons.

- None -

"

Re. Art. 159, No. 2 - Minutes of hearings and preliminary investigations.

- None -

"

Re. Art. 159, No. 3 - Form of decisions of the EPO.

Combine provisions of Re. Art. 115, No. 1 and Re. Art. 159, No. 3 in a single article?

"

Re. Art. 159, No. 4 - Ex officio rectification.

- None -

"

Re. Art. 159, No. 5 - Notification of possibility of appeal.

- None -

"

Re. Art. 159, No. 6 - Issue of certified copies.

- None -

"

Re. Art. 159, No. 7 - Advance payment of fees (BR/GT I/63/70).

Referred to "Fees" Sub-Committee.

"

Re. Art. 159, No. 7 - Interruption of proceedings.

Examined, but not drafted.

"

Re. Art. 159, No. 8 - Belated observations.

Examined, but not drafted.

- None -

- None -

Art. 159a new

- None -

- None -

Art. 160

Arts. 161 to 198

Arts. 206 and 207

Arts. 208 to 217

Chairman's proposals (BR/GT I/63/70 and BR/GT I/65/70 of 6 and 9 October 1970) not yet examined.

- None -

Come under the scope of Working Party II.