

BR/GT I/91 e/70

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, 5th January 1971
BR/GT I/91/71

- Secretariat -

WORKING DOCUMENT
PRESENTED BY THE INTERNATIONAL PATENT INSTITUTE

The Sub-Committee set up to draft the implementing regulations invited the International Patent Institute to propose a text by means of which the part of the invention to be searched may be determined, in case the applicant, in spite of lack of unity of the invention, should not have responded to the invitation made under Article 79 paragraph 5 of the preliminary draft.

The text proposed is as follows :

Re. Article 79

No.

Restriction of the search report to a part of the invention in
the application for a European Patent

If, in case of lack of unity of the invention, the applicant does not respond in due time to the invitation provided for in Article 79, paragraph 5 of the Convention,

the International Patent Institute establishes the report on the state of the art on that part of the application relating to the invention or plurality of inventions forming a single general inventive concept and occurring first in the claims.

The proposed provision allows for two possibilities.

According to the first possibility, the lack of unity of the invention is apparent before any search is made. In this case, the search of the state of the art will be extended to the general inventive concept occurring first in the claims, except when the application has been limited to a single invention, or when the additional tax has been paid.

According to the second possibility, the lack of unity of the invention is only revealed after searching on the state of the art. Such would be the case, for example, when the application contains claims relative to :

1. a product,
2. a process for the manufacture of that product,
3. the use of that product.

According to this provision, if in such a case, the search were to reveal that the product is known, it would be continued in respect of the process if the claim or claims relative thereto occurred before those relative to the use of the product.

The second possibility is not mentioned explicitly in this provision. Nevertheless, it appears that any provision

dealing explicitly with this possibility would be extremely difficult to draft, especially because it would acknowledge the competence of the International Patent Institute to express an opinion about the novelty of part of the application. It would seem advisable therefore to settle the details of this question in the working agreement that is to be concluded between the European Patent Office and the International Patent Institute.

The International Patent Institute takes the opportunity of drawing the attention of the Sub-Committee to the fact that Article 79 of the Convention does not deal with the questions as to which authority is competent for appreciating the lack of unity of the invention at this stage of the procedure, nor as to the consequences of differences of views between the International Patent Institute and the European Patent Office on this specific point. It should be remarked that according to Article 17, paragraph 3a of PCT, the searching Authority is the only competent Authority in this matter.

The Sub-Committee will have to decide as to whether this question should become a provision of the implementing regulations or whether it would be preferable to solve it in the agreement to be concluded between the European Patent Office and the International Patent Institute.
