

# **BR/GT I/98 e/71**

## **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

Brussels, 11th January, 1971  
BR/GT I/98/71

---

- Secretariat -

NOTE

Subject: Note by the British delegation relating to Article 11,  
paragraph 4.

The delegations to Working Party I will find  
attached a note by the British delegation relating to  
Article 11, paragraph 4 of the First Preliminary Draft of a  
Convention establishing a European System for the Grant of  
Patents.

---

BR/GT I/98 e/71 prk

272

C

E

24

10

11

12

13

14

15

16

17

18

19

20

21

NOTE BY THE UNITED KINGDOM DELEGATION  
CONCERNING CONFLICTING EUROPEAN PATENT APPLICATIONS

1. At the last meeting of Working Party I, the United Kingdom delegation agreed to examine a problem which results from placing in the state of the art prior European patent applications which are unpublished at the filing date of the European patent application under examination - Article 11, paragraph (3).

2. Article 11, paragraph (4) provides that -  
"Paragraph 3 shall be applied only when a Contracting State designated in respect of the later patent application was also designated in respect of the earlier patent application as published under Article 85."

The terms of this paragraph cover cases in which a prior European patent application designates:-

- (a) all the Contracting States designated in the later application, or
- (b) one or some only of those States.

3. The effect of Article 11, paragraph (4) is quite clear. In case (a) the later application cannot proceed to grant unless the conflict with the prior application is removed by amendment. In case (b), grant would also have to be refused unless the applicant withdrew the designation of those States covered by the earlier patent application or amended the application to remove the conflict of subject-matter. It may be objected that this means that the



European Patent Office would be dealing out a harsher treatment than the national Office of any State that adopts Article 4(3) of the Strasbourg Convention of 1963 is allowed to do. In other words, the standard applied centrally before grant would be higher than that which can be applied nationally after grant. However, the reality of the situation is likely to be that practically all European applications will cover the EEC States and the United Kingdom and will differ from each other only in one or two designations of other States. Forcing the later applicant to amend would in these circumstances only have the result that some protection is lost in these other countries and it may be seriously questioned therefore whether it is worthwhile formulating some procedure to relieve the situation. It could be argued that the possible reduction of protection in one or two States is a risk which an applicant could be expected to take for the sake of getting protection in all States on a single application.

4. One form of relief that may be considered is to allow the later applicant the possibility not only of withdrawing the designation of the State or States designated in the earlier application but also of converting to a national application in any such State. This would mean that all Contracting States must be obliged to permit conversion in these cases, contrary to the decision of the Working Party at its last meeting that Article 124 should give States the option of allowing such conversions. This would not seem satisfactory because then all States would be forced to maintain a national procedure. In any case, it is not

unlikely that such conversions would occur fairly late in the life of the European application, thus creating uncertainty for third parties and difficult administrative and other problems for national patent offices. Moreover, since in practice the differences in the designations of the conflicting applications is likely to be in the coverage of European States other than the EEC and the UK, it does not seem satisfactory to proceed with the European application in respect of these designations and to hive off for national treatment the solid core of what, from the applicants' viewpoint, are probably the main designations, i.e. of the EEC and the UK. In this respect a subsidiary problem is what is the appropriate "national" treatment for the hived-off EEC applications; presumably the EEC countries would wish all such applications to be processed centrally. Thus the result would be a national UK application and two European applications, one for the EEC and one for the remaining designations. The last two would in effect be a "split" European application discussed in the next paragraph.

5. Another possibility would be to allow "splitting" of the later application. By this is meant that, if conflict with an earlier European application is discovered, the later applicant should have the possibility of dividing his application into 2 parts, one part covering the States designated in the earlier application and the other covering the remainder of the States originally designated. This would have the effect that the applicant obtains without further amendment a patent covering those States not designated in the earlier application, while the European Patent Office is nevertheless able to resolve the conflict with the earlier application so far as the States designated in

the earlier application are concerned. Although this solution is feasible where there is only one prior application to be considered, it clearly gives rise to many complications when there is conflict with two or more prior European applications designating different groups of Contracting States. In such cases, the original application would have to be split into several 'parts', each 'part' having different claims and possibly a different description. Further "splitting" may be necessary as a result of an opposition. In order to give effect to this solution no amendment of Article 11, paragraph (4) would be required, but a new Regulation would have to be drafted to deal with the procedure to be followed. In practice the several 'parts' of the application could bear the original application number and could be dealt with on the same file. It would seem unnecessary to require the payment of further application, search, examination and renewal fees - such payment may be difficult to justify anyway because "splitting" may have become necessary simply because the applicant fortuitously designates one more State than the earlier application - and it is thought that one set of grant and printing fees should be enough. A single European patent could be granted, the different specifications being printed and contained in a single pamphlet; in this case only one patent number would be needed. This might create confusion, however, and it may be advisable to grant separate European patents, using different numbers or the same number with different suffixes. Some re-drafting of the Articles and Regulations would also probably be required. Though "splitting" is clearly a complicated solution, it is evident that the complications are no greater

than for the conversion procedure when the application has to be dealt with separately for each of the States affected. Moreover, there is the obvious advantage that all the 'parts' would be dealt with centrally and in one language.

6. These two solutions assume no change in the wording of Article 11. For the sake of completeness, two other possibilities will now be considered. Firstly, Article 11, paragraph (4) could be amended so that it restricts the application of Article 11, paragraph (3) to cases in which the designations in the conflicting European patent applications are the same, i.e. case (a) of paragraph 2 above. This would mean that in case (b) above, no action could be taken by the European Patent Office to resolve the conflict. If the earlier application designates State A and the later application designates States A and B, a European patent on the later application could not be refused for lack of novelty over the contents of the earlier application. However, following the grant of the patent, the conflict could be dealt with nationally in accordance with the law of State A, having regard to the terms of Articles 133 and 134 as adopted by Working Party I in September. This solution may be regarded as contrary to the spirit of the Convention, particularly since it would have the practical effect that no action could be taken by the European Patent Office to resolve a clear conflict between two European patent applications simply because e.g. n countries are designated in the earlier and n + 1 countries are designated in the later. The Office would be compelled to grant a European patent notwithstanding the fact that it was well aware that this

patent was invalid in n countries. Such a result would seem to satisfy neither the States nor applicants.

7. The second possibility is to delete Article 11, paragraph (4). This would have the effect that an earlier European patent application may destroy the novelty of a later application, regardless of the designations in the two applications. This is even harsher than the effect referred to in paragraph 3, and is open to the same objections. Nevertheless, like paragraph 3, it is an easily workable solution and might be justified as a logical extension of the philosophy, inherent in Article 11, paragraph (3), that European patents are intended as a reward to the first person to take steps to disclose an invention to the public by filing a European patent application and that the subjective act of invention cannot itself lead to the valid grant of a patent. Moreover it would, in practice, probably result in unduly reduced protection in only a few of the States since, as stated in paragraph 3, it can be expected that every application will designate the bulk of the States parties to the Convention. However, it is very likely that such a solution would not meet with any favour by the interested organisations.
-

