

# BR/GT I/100 e/71

## Travaux Préparatoires EPC 1973

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INTER-GOVERNMENTAL CONFERENCE  
FOR THE SETTING UP OF A EUROPEAN  
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 15 January 1971

BR/GT I/100/71

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- Secretariat -

NOTE

Subject: Note from the French delegation concerning Article 64

The delegations to Working Party I will find attached a note from the French delegation on a new draft of Article 64 of the Preliminary Draft Convention establishing a European system for the Grant of Patents.

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ANNEX

N O T E

from the French delegation on

a new draft of Article 64  
of the Preliminary Draft Convention  
establishing a European system for  
the Grant of Patents

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1. Article 64, paragraph 1, of the above-mentioned Preliminary Draft provides that an application for a European patent may be filed either at the European Patent Office or at the national office of one of the Contracting States. Paragraph 2 of the same Article nevertheless allows a restriction to be made in this respect, providing that "Any Contracting State may prescribe that a person having his registered place of business or his ordinary residence within its territory ... may not file an application for a European patent otherwise than as provided for in paragraph 1 (b)" (1).

Should the Contracting States take the steps referred to above, these provisions will give rise to the following situations:

- (a) a natural person who in fact normally lives or works within the territory of one Contracting State, but has his legal residence within the territory of another Contracting State, will not be able to file an application for a European patent at the national office of the State in which he lives; he will be obliged to carry

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(1) That is, at the national office of the State in question.

out this filing at the national office of the State of his legal residence - to which he may only be attached by a purely legal and more or less fictitious link, which moreover may sometimes be difficult to establish.

- (b) an application for a European patent intended to protect an invention originating in an industrial or scientific establishment which does not possess the status of a legal person and is situated within the territory of one Contracting State but belongs to a company whose registered place of business is within the territory of another Contracting State, will not be able to be filed at the national office of the State within which the establishment is situated. It will have to be filed at the national office of the State where the company has its registered place of business.

- 2. It is pointed out that such provisions would result in the creation, as regards inventions of interest for security purposes, of a law peculiar to the European patent which, in the cases indicated in 1 above, would override the national legislative provisions governing the subject in certain of the Contracting States, which provide that any invention of interest for security purposes may not be communicated to a foreign country without the authorisation of the competent national authorities<sup>(1)</sup> - as is the case in France - or even that any patent application, whatever its subject, must be filed in the first instance at the national office.

- 3. As a result of these findings, it would appear necessary to find a formula:

(a) which is not likely to prejudice the prerogatives enjoyed

.../...

- (1) which, where there is doubt as to whether or not an invention is of interest for security purposes, would lead to the patent application being filed in the first instance with the national office.

by the Contracting States, pursuant to their internal legislation, as regards inventions of interest for defence purposes;

- (b) whose wording is such as to allow great flexibility in the exercise of these prerogatives.

This two-fold objective would seem to be achieved by the following wording of Article 64 of the Preliminary Draft (1):

"(1) unchanged

(2) The provisions of paragraph 1 shall not preclude the application of legislative or regulatory provisions which, in the Contracting States, either:

- (a) govern inventions of interest to national security, or
- (b) prohibit the direct filing in a foreign country of any patent application or make such filing subject to prior authorisation.

For the purposes of the application of these provisions, filing with the European Patent Office shall be considered as a filing made in a foreign country for each of the Contracting States.

(3) In the event of failure to observe the national provisions referred to in paragraph 2(b) ... (rest unchanged)".

It should be noted, in connection with the new wording of paragraph 2, that it is not for the European Patent Office to determine whether or not an invention for which a patent application has been filed is of interest to national defence, it is, however, relatively easy for it to ascertain whether the internal legislation of the State concerned prohibits

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(1) Cf. document No. 8 of 1 December 1970: Proposal by the French delegation.





any initial filing abroad or makes it subject to prior authorisation; this explains the new wording proposed for paragraph 3.

4. It should also be noted that the concept of "residence" appearing in the PCT and defined in the Regulations under the PCT does not coincide with the concepts of "residence" and "registered place of business" appearing in Article 64 of the Preliminary Draft Convention, since Rule 18 of the Regulations under the PCT defines the residence of a legal person in terms of a real and effective industrial and commercial establishment, and not of a registered place of business.

Retaining the present text of Article 64, paragraph 2, would therefore lead to difficulties in its application, since, pursuant to Article 2(xii) of the PCT, the European Patent Office may have to act as a national office, and may thus find itself faced with two different definitions of residence for legal persons.

5. Finally, it should be recalled - and it is an essential point - that Article 27 (8) of the PCT lays down that: "Nothing in this Treaty and the Regulations is intended to be construed as limiting the freedom of any Contracting State to apply measures deemed necessary for the preservation of its national security ..."

The new wording proposed for Article 64 of the Preliminary Draft Convention therefore also has the advantage of according with the text of the PCT which gives the Contracting States complete freedom in the matter.

