

BR/GT I/104 e/71

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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/104/71

- Secretariat -

NOTE

Subject: Note from the Netherlands delegation on the amalgamation
of the filing fee and the search fee

The delegations to Working Party I will find attached a
note from the Netherlands delegation on the amalgamation of
the filing fee and the search fee.

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NOTE FROM THE NETHERLANDS DELEGATION TO WORKING PARTY I

- I. Article 79, paragraph 1, of the Preliminary Draft (BR/70/70) lays down that after the summary examination provided for under Article 77, paragraph 2, the applicant shall be requested to pay a search fee before the IIB report on the state of the art, referred to in Article 79, paragraph 3, is drawn up. As the novelty search is compulsory, the question arises as to whether there are sufficient grounds for complicating the procedure in this way, as it necessarily involves a certain delay. If this question is answered in the negative, the procedure could be considerably simplified by dispensing with a separate search fee.

Obviously this problem is not exclusively a financial matter. Indeed Working Party IV has already pointed out that the elimination of the separate search fee can easily be compensated by fixing the other fees, and in particular the filing fee, at an appropriate level so that the total revenue remains unchanged. There is therefore no financial interest attached to the question, showing thus that it is a question of method falling entirely within the competence of Working Party I.

A separate search fee was introduced because the search is to be entrusted to an organisation distinct from the European Patent Office, i.e. the IIB, and because it would be desirable to free the European Patent Office from any possible financial complications connected with the search. This argument is based largely on the fact that the charge

for the IIB report is to be adapted to changes in the cost price, which would involve varying the filing fee if provision were not made for a separate search fee completely aligned on the cost of the IIB report.

This argument seems rather weak. If developments occur which change the cost price of the IIB report, it would not necessarily be true that these developments would leave the cost price of the services rendered by the European Patent Office unchanged. Because of this, fairly frequent changes will have to be made in the rates of all the fees levied by the European Patent Office, and the fact of having to adapt the level of the filing fee to variations in the cost of the IIB report in this operation is of little significance.

Another argument might be that the elimination of the separate search fee might mean that the single filing fee would have to be fixed at too high a level. But this argument is also weak, since the amount of the single filing fee may be lower, and probably much lower, than the sum of the two fees which would in any case have to be paid within quite a short space of time.

In addition, the countries that practise previous examination of patent applications have never felt the need to levy a separate search fee. There are, of course, exceptions, notably Germany and the Netherlands, but in these countries the reason for the introduction of a separate search fee is that the search is not compulsory, but entirely conditional upon the wishes of the applicant, who gives precise notification of his wishes by paying the separate search fee. For the European patent, on the other hand, the search is always compulsory and the argument does not therefore apply.

There would be yet another advantage in eliminating the separate search fee in certain cases where a supplementary search is deemed necessary. These are the cases referred to in Article 137, paragraph 2. Obviously the IIB will, justifiably, demand a certain price for such supplementary reports. But the problem of whether it is justified to make the applicant pay this price has not yet been satisfactorily solved. This difficulty may be avoided by eliminating the separate search fee. If this method were adopted, there would be no need to demand a supplementary fee, with the exception, of course, of cases in which the invention lacks unity, as referred to in Article 79, paragraph 5.

It should be noted that when the Conference of the 17 countries met in April last year, a request was made for the elimination of the separate search fee. This point of view has recently been adopted by FICPI (BR/45/70), EIRMA (BR/64/70), ICC (BR/65/70) and CNIPA (BR/74/70).

There is no doubt that the problem raised above is of the utmost importance for the European patent. Working Party I must therefore take a decision on this point, either by accepting the system of a single filing fee or by submitting an alternative solution to the Conference of the 17 countries. In both cases the text given below may be adopted.

Article 79: in place of paragraphs 1 to 3, the variant would read as follows (this is simply the first three lines of paragraph 1 and the last four lines of paragraph 3, paragraph 2 being omitted entirely⁽¹⁾):

(1) If the examination reveals that the invention and the application for a European patent meet the requirements

to be taken into consideration, in the examination, the Examining Section shall request the International Patent Institute at The Hague to supply a report on the state of the art and shall transmit to it the documents of the application for the European patent.

Article 81, paragraph 5: Add one sentence:

Where applicable, the additional fee paid pursuant to Article 79, paragraph 5, shall be subtracted from the total amount of these fees.

Article 137: Delete paragraphs 2 to 4.

II. If the single fee system is adopted, another question will arise, namely whether it is still worth retaining Article 122 of the Preliminary Draft.

This Article lays down the principle that the PCT search report shall take the place of the IIB report. This is a very far-fetching principle which goes well beyond the obligations imposed by the PCT itself. More seriously, an official statement of this nature comes at a time when no other country which is a party to the PCT has made such a statement or even expressed the intention of doing so.

It does not, albeit, seem necessary to omit the Article in question. The principle is valid in itself and possibly it will serve as an example to be followed. Perhaps at an appropriate moment there might even be agreements between the PCT search authorities which will ensure their co-operation and the harmonisation of their procedures. It would therefore be wise to allow for such a development, which would be highly desirable, by making possible a certain reduction in the filing fee for PCT applications. This could be done in the manner described below.

Article 122: Add a paragraph 3 as follows:

(3) The filing fee payable for a European patent application arising out of an international application as referred to in Article 2 of the Co-operation Treaty may be reduced by an appropriate percentage in the event of an agreement on the fee to be levied for an international search or an international-type search being concluded between the European Patent Office and the States in which the national administration is responsible for the international search referred to in Article 15 of the said Treaty.
