

# **BR/GT I/113 e/71**

## **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, 21 September 1971  
BR/GT I/113/71

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- Secretariat -

NOTE

The delegations to Working Party I will find annexed a note from the United Kingdom delegation concerning the Second Preliminary Draft Convention and containing a number of observations and proposals which it would like Working Party I to examine at its meeting to be held from 12 to 22 October 1971.

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NOTE BY THE UNITED KINGDOM DELEGATION

This note contains comments and proposals concerning certain Articles of the second preliminary draft of the Convention for discussion at the October meeting of Working Party I. The delegation wishes to reserve the right to comment later on the "package", Articles 153-155 and, if necessary following the September meeting of Working Party I, on Article 16. We also have other points, mainly of a drafting nature, which will be raised at the October meeting.

Article 9

It is evident that the treatment of animals to improve the quality or quantity of the product is patentable under paragraph 1 and we do not think a practical distinction can be made between such treatment and veterinary treatment. We think the reference to animals should therefore be deleted from paragraph 2(e).

We agree in substance with paragraph 2(f) but would prefer to make the position clear by re-drafting it to read as follows :

"(f) Designs or arrangements which serve only to present information and in which the only novelty lies in the information presented".

We also agree in substance with paragraph 2(g), but believe that this needs to be expanded to define what is covered by a computer program and also to make clear that patents

shall not be granted for methods (e.g. a method of programming computers) or apparatus (e.g. a computer when programmed in a certain way) where the only novelty is to be found in the program itself. Paragraph 2(g) might read as follows:

"(g) Computer programs (that is, a set of instructions for controlling the sequence of operations of a data processing system) and methods or apparatus in which the only novelty lies in the computer program employed".

Finally, we point out that though we are agreeable to establishing in paragraph 2 a non-exhaustive list of subject matter which is excluded from the concept of "invention", we also believe that it should be made possible for this list to be fairly easily revised in order to remove any uncertainties which may arise and also to meet future technical developments. At some stage therefore we would hope that paragraph 2 can be transferred to the Implementing Regulations, as in the case of the PCT.

#### Article 10

The scope of the reference to "essentially biological processes" is not clear and it may well be difficult to distinguish between an "essentially biological" process and a process which is not essentially biological, or between a macro-biological process and a micro-biological process. In any case, we see no reason why any biological process, other than for the treatment of the human body, should be specifically excluded by the Convention. It seems preferable to leave

it for the European Patent Office to decide on the facts of the case whether a process is an invention within the meaning of Article 9, paragraph 1. We suggest therefore that paragraph (b) should be revised to read:

"(b) Plant or animal varieties".

Articles 33, 58 & 160

Now that the main features of the proposed European patent system have been developed, we consider that it would be useful to carry out a survey with a view to getting some clearer idea as to the likely use of the system and particularly its growth rate. This might be conducted sometime in 1972 by the Secretariat, national patent offices and interested organisations. It should extend to the USA.

We do not agree with Article 160; it would be a defeatist policy to start off the European system with a long deferred examination period and, if this were done, there would be likely to be considerable difficulties in reducing the period later on. We think Article 160 should be amended so that the Administrative Council may, if necessary, increase the Article 88(2) period up to a maximum of 2 years. If the latter were agreed, the Administrative Council should also be authorised to reduce any such extended period.

In any event, we think it would be wise to include some other provision on which the Administrative Council could fall back if circumstances dictate the need to do so. We have doubts that sufficient examiners of the required competence can be recruited to serve in a European Patent Office located

in any one State. Should these doubts turn out to be justified, the future of the European system would be endangered and we feel that provision should be made now to cater for this contingency. We therefore suggest that Article 33 (2) should be amended by removing the restriction that branch offices which the Administrative Council might establish shall only be for information or liaison.

In connection with the transitional period we would point out that under the terms of Articles 55 to 58 there would in practice have to be 14 members of the Board of Appeal and the Enlarged Board of Appeal for a period of 5 years. In our view it is unlikely that this number would be fully employed at least during the first few years of operation of the system and we think the Administrative Council should have power to make ad hoc appointments in the transitional period. We therefore propose a new Article 160a as follows:

"During a transitional period, the expiry of which shall be determined by the Administrative Council, the Administrative Council shall have power to suspend operation of Article 58 (1) and (2) and make such other arrangements as may be necessary."

Article 35a (3) should be amplified to refer to this new Article.

Article 65

It is not clear that the European Patent Office will be able to deem the application to be withdrawn in the circumstances referred to in paragraph (5). This is because Re Article 64 No 2 does not require the national office to transmit to the European Patent Office sufficient information for the Office to determine the "date of filing" or the priority date. In order to avoid this difficulty it would appear that Re Article 64 No 2 should be extended to require the national office to inform the European Patent Office as to the priority date claimed and as to the date(s) when the information and documents referred to in Article 68 has been received.

Article 75

Under the provisions of Article 11, cases will arise in which an examiner will have to determine whether the priority date of a prior European application or patent is earlier than the priority date of the application he is examining. He will not be able to do this unless the file of the prior application or patent contains the priority document and the examiner who dealt with the earlier case may have had no cause to request the filing of this document. Moreover, it is always desirable to have the priority document on file so that third parties can assess for themselves the relative priorities of concurrent cases, particularly if they are potential opponents. National offices also need to be able to

obtain priority documents in order to resolve any conflict between European applications and patents and national applications and patents. It may be noted that once an application has been withdrawn or refused or a patent granted, there is no means available to the EPO enabling it to obtain the related priority documents.

For these reasons we consider that paragraph (2) should oblige an applicant to file a copy of his first application rather than leaving it to the examiner to require a copy if he needs it. The priority document should be required to be filed not later than 4 months after the filing date of the European application. An exception should be made in respect of PCT applications for European patents. In these cases, the European Patent Office should invoke PCT Rule 17.2.

We also think that the Examiner should be empowered to require the filing of earlier applications if it appears to him that the application whose priority is claimed is not the first foreign application, (e.g. it may be a U.S. continuation in part application).

As priority may be claimed in respect of filings in any State which is party to the Paris Convention or which satisfies the conditions of Article 73(5), the priority document may be in a language other than one of the official languages of the European Patent Office. In order to facilitate the work of the European Patent Office in such cases, the applicant should be required to file a certified translation of the priority document into the language of the

proceedings. In PCT cases, the applicant should be required to furnish a certified translation of the priority document into the language of the proceedings within 4 months after the expiry of the PCT Article 22 or 39 time limit.

Article 76

We think that paragraph (1) should be amended to make clear that a European application has the effect of a national application in each designated State as from its date of filing (cf PCT Article 11(3)).

Articles 81, 94 and 83a

The effect of Article 81(1)(b) is to prevent an applicant from filing a divisional application on his own volition before he has received the search report on the original application. As we see it, this could not only delay proceedings, but, in a case where the original application discloses but does not claim a second invention, would result in the loss of provisional protection for this invention until some time later when the divisional application is published. Possibly the restriction imposed by Article 81(1)(b) is intended for the consistency with the idea, embraced in Article 82, that amendments at the applicant's request should not generally be allowed until after the search report has been issued.

We do of course agree with this concept, but we do not think it should be applied to the situation where an applicant wishes to protect, by means of a divisional application, matter which is contained in a previously filed application. Although prescribed by the present text of the Convention we can see no reason why the filing of a divisional application should necessitate previous or simultaneous limitation of the original application.

It is pointed out, moreover, that Article 94 may in any case be used to frustrate the apparent intention behind the restriction of Article 81(1)(b). Provided the applicant has requested examination, he does not have to await the search report on the original application. We see no good reason why a request for examination should govern the procedure in respect of divisional applications. Even if a request for examination has been made there is still no possibility of checking the applications at this stage since it is clear from Article 54(1) that proceedings are not transferred to the Examining Division until the search report on the original application has been received.

We consider the reference to a notice of abandonment in Article 81(2) to be obscure and we have some difficulty in understanding how it works in practice. Apart from this, it seems pointless to require limitation since at this stage of the procedure there is no way of checking it and we note also that there is no sanction for failure to comply with these provisions. Article 94, rightly in our view, does not contain the provisions to be found in Article 81(2).

We take the view that there should be no bar on the filing of divisional applications in the period between the filing of the original application and the start of the examination pursuant to Article 88. Moreover, there should be no requirement that the filing of a divisional application is conditional on prior or simultaneous limitation of the original application.

It follows that there should be a single Article dealing with divisional applications. This Article should necessarily include a provision ensuring that before grant amendments are made to avoid overlap of protection between the original and divisional applications. It seems to us that such a provision is missing from the present draft.

We propose therefore that Articles 81 and 94 should be replaced by a single Article as follows:

"1 A European patent application may be divided out of another European patent application:

- (a) at the request of the applicant; nevertheless, after the start of the examination proceedings the division may be made only if the Examining Division considers it to be justified;
- (b) on the invitation of the Examining Section or Examining Division, if the requirements of Article 70 are not met.

2 The claims of the application and any divisional application shall exclude the matter protected by any of the other applications. Where possible, the description and drawings of each application shall relate only to the matter protected by that application. However, when it is necessary for an application to describe the matter protected by another application, it shall include a cross-reference to that other application.

3 A divisional application shall be deemed to be filed on the date of the original application and shall have the benefit of any right to priority, in so far as its subject matter does not extend beyond what was disclosed in the original application as filed.

4 The filing fee referred to in Article 66, paragraph 3, must be paid in respect of each divisional application within a period of one month after the filing thereof."

Paragraph 3 of our proposal corresponds to Article 81(4) of the draft. As we understand it, this permits a divisional application to proceed to grant even though it contains matter which was not in the original application as filed. We think that this is not consistent with the general philosophy inherent in Articles 83a and 104 and would give rise to difficulties for third parties in ascertaining the dates accorded to various parts of the application. We think it should be made clear that a divisional application which contains more than what was in the original application as filed should not be

allowed to proceed to grant. We suggest that this may be done by amending Article 83a to read :

"A European patent application shall not .... as filed, or if the application is a divisional application, beyond the content of the original application as filed."

#### Article 88

In view of the short period in which a third party may request examination, we consider that third party requests should be abolished.

We further propose that applicants shall be permitted to request examination only after the receipt of the report on the state of the art. Since an examination fee has to be paid, it is likely that most applicants will await the search report. In any case, examination cannot proceed until after the report has been received.

#### Article 93

This Article is not consistent with Article 92 in that it implies that examination shall begin on expiry of the period referred to in Article 92 (1) even though the applicant has not indicated that he wishes to proceed with his application. Moreover, contrary to Article 92 (2), it appears to suggest that examination will not take place unless the applicant has commented on the search report and on any

observations sent to him. Finally, Article 93 seems to ignore the case where the applicant requests examination after receiving the search report. We think therefore that this Article should be revised to read as follows :

"1 The Examining Division shall commence the examination of the European patent application :

- (a) on receipt of a request for examination made by the applicant after the report on the state of the art has been communicated to him ; or
- (b) if the request for examination was made by the applicant before the report on the state of the art had been communicated to him, or, if the request was not made by the applicant himself, on receipt within the period prescribed under Article '92, paragraph 1, of a statement from the applicant that he wishes to proceed further with his application.

2 Only the applicant shall take part in the proceedings before the Examining Division."

#### Article 95

We propose deletion from paragraph 2 of the words "indicating all the reasons against the grant of the European Patent."

These words impose unnecessary restriction on the Examining Division since there will be cases where it will be futile and time-wasting to indicate all the reasons against grant.

Articles 101, 101b, 102 and 103

Reading Article 101(3) and 101b(1) in chronological order, it appears that the admissibility or otherwise of the opposition notice is determined after the actions required by Article 101(3). This could mean the proprietor of the patent being invited to present observations on a clearly unsatisfactory opposition notice which may never be admitted.

Articles 101(3), 102 and 103 refer to "observations" made by the proprietor. We think it must be intended by these Articles that the proprietor may also propose amendments but, in this connection, we observe that the terms of Article 95(1) distinguish between observations and amendments.

No sanction is provided in either Article 101(3) or Article 101b(1) against the proprietor who ignores the invitation of Article 101(3). According to Article 101b(1), the Opposition Division must go on to examine the facts even though, for example, the proprietor may have decided to relinquish the patent. This may be compared with Article 92(2).

Article 101b(2) refers to fresh material submitted by the parties concerned but does not stipulate that the opponent shall have the right of reply to the proprietor's observations made under Article 101(3) or give a time within which such a reply must be made.

We therefore suggest the following re-drafts :

Article 101

(1), (1a) and (2) Unchanged

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(3) The Opposition Division shall examine whether the notice of opposition complies with the provisions of this Convention and the implementing Regulations. If the opposition is admissible it shall notify the proprietor of the patent of the opposition lodged and shall invite him to reply to the opposition by presenting his observations and, where necessary, submitting amendments to the description, claims and drawings within a period to be fixed by the Division. Any observations and amendments shall be communicated to the other parties concerned who shall be invited to reply within a period to be fixed by the Division.

(4) If the proprietor does not indicate within the period fixed in paragraph 3 that he wish to maintain his patent, the patent shall be deemed to be revoked.

Note to Article 101 : Consequential amplification of the Regulation Re Article 145 No 11 will be necessary.

Article 101b

(1) Provided that the proprietor of the patent has indicated within the period fixed in Article 101, paragraph 3, that he wishes to maintain his patent, or, if the proprietor has submitted observations or amendments, the other parties concerned have replied or the period provided for this purpose in Article 101, paragraph 3, has expired, the Opposition Division shall examine the facts in so far as they lie ..... relief sought.

(2) Unchanged.

Article 102

If, after .... Article 95 paragraph 1 shall apply mutatis mutandis. The result of the examination and the observations of the proprietor of the patent, together with any amendments to the description, claims and drawings submitted by him, shall be communicated to the other parties concerned.

Article 103

The Opposition Division shall invite the other parties concerned to comment, with a period to be fixed by the Division, on the observations of the proprietor of the patent and any amendments to the description, claims and drawings submitted by him in so far as these contain .... reasons.

Article 125(2)

We would prefer to impose a time limit of one month for the transmission by the European Patent Office.

Article 127

In order to avoid the possibility of the filing Office transmitting a request for conversion to the other offices after a lengthy delay (e.g. after the application has been

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released from secrecy), we propose that the second sentence of Article 127 should be amended to read :

"The latter shall, subject to the provisions of national security, transmit within three months the request, together with ..... request."

### Article 133

While we agree with the maximum approach in so far as this concerns matter affecting validity and involving a technical content, we consider that it should be left open for national laws to prescribe that European patents may be revoked on other grounds on which it is not appropriate for the European Patent Office in examination or opposition proceedings to take a view. We refer particularly to cases in which a European patent has been granted to a person who wrongfully obtained the invention from another person. It should, in our view, be a matter for national law whether or not the wronged person should be able to seek revocation of the European patent. Similarly we think it should be open to the national laws to deal with abuse of monopoly by revoking European patents in those cases where a compulsory licence has failed. We also think that it should be possible to revoke a European patent on the ground that the patent was granted consequent to an action in bad faith by the applicant. We therefore propose the addition to Article 133 of a new paragraph (3) as follows :

"(3) Notwithstanding the provisions of paragraph 1, any provision in the laws of a Contracting State enabling revocation of a national patent

- (a) when the proprietor is not the inventor of his successor in title
- (b) when there has been a failure of a compulsory licence granted to prevent abuse of monopoly, or
- (c) when the applicant for the patent has acted in bad faith,

shall be applicable to European patents. The effect of such revocation shall be restricted to the territory of the Contracting State concerned.

#### Article 150

In view of the harsh sanction contained in paragraph (2), it is suggested that the qualification "as far as he is aware" should be inserted after "indicate" in paragraph 1. This appears necessary in order to protect the applicant who is an assignee of an invention and who is unaware that a prior national application has been made in respect of it.

It is also suggested that paragraph (2) should read "deemed to be withdrawn" rather than "refused". This amendment makes the terminology consistent with that used throughout the Convention for similar conclusions consequent upon the inaction of the applicant.

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