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Comment:

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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.

- Secretariat -

W o r k i n g D o c u m e n t

submitted by the Chairman of Working Party I

for the Draft of a Convention establishing a European System for the Grant of
Patents

Proposals for Articles 66, 68, 69, 77-81 and 85 of the Second Preliminary Draft
and for new Articles 76a, 76b and 160a

compared synoptically with

- the Second Preliminary Draft of a Convention establishing a European System for the Grant of Patents (published in 1971)
- the Patent Co-operation Treaty (PCT)
- the Regulations under the PCT.

KEY

Second Preliminary Draft

indicates the Second Preliminary Draft of a Convention establishing a European System for the Grant of Patents (published in 1971).

PCT

indicates the Patent Co-operation Treaty (PCT), signed in Washington on 19 June 1970.

PCT Regulations

indicates the Regulations under the Patent Co-operation Treaty, signed in Washington on 19 June 1970.

Imp. Reg.

indicates the First Preliminary Draft of the Implementing Regulations to the Convention establishing a European System for the Grant of Patents (published in 1971).

EPO

signifies the European Patent Office.

IIB

indicates the Institut International des Brevets (International Patent Institute).

+ on the right-hand page

indicates that the text on the left-hand page is adopted without amendment.

--- under the text on the left-hand page

indicates that the text thus underlined has been deleted on the right-hand page.

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indicates that the text thus underlined is new, in relation to the Second Preliminary Draft. Completely new paragraphs are not, however, underlined.

Introductory Note

1. In their observations on the First Preliminary Draft of a Convention establishing a European System for the Grant of Patents, the non-governmental international organisations made proposals for amending Articles 66, 77 to 80, 122 and 137, the particular purpose of which is the rationalisation of the procedure from the filing of the application to the issue of the report on the state of the art known as ("the package").

Working Party I examined these proposals at its meeting held from 26 to 28 January 1971 and recommended that the Inter-Governmental Conference should either reject or remit to Working Party I for further examination those proposals which had not already been taken into account in the Second Preliminary Draft (see minutes of meeting in BR/94/71 of 6 April 1971, points 77 and 80, and recommendations by Working Party I in BR/100/71 of 24 March 1971). The Inter-Governmental Conference adopted the recommendations at its 4th Meeting, held from 20 to 28 April 1971 (see minutes of the Meeting in BR/125/71 of 7 July 1971, point 12, and note to Article 66 of the Second Preliminary Draft). According to the programme of work for Working Party I this mandate is to be executed at its 9th meeting, to be held from 11 to 22 October 1971 (see minutes of meeting in BR/94/71, point 83).

2. As the delegations to Working Party I have not, to date, submitted proposals for dealing with the "package", the Chairman himself has drawn up proposals in preparation for the 9th meeting. This working document contains his proposals for amending Articles 66, 68, 69, 77 to 81 and 85 of the Second Preliminary Draft, and for new Articles 76a, 76b and 160a.

The proposals take into account the proposals from the non-governmental international organisations mentioned in 1. above in so far as they provide

- (a) that the search fee should be paid with the filing fee;
- (b) that the report on the state of the art should be drawn up without examination for obvious deficiencies and the International Patent Institute should take a preliminary decision as to the unity of the invention;
- (c) that the International Patent Institute should transmit the report on the state of the art to the European Patent Office and the applicant simultaneously;
- (d) that the search report drawn up pursuant to Article 18 of the PCT should replace the report on the state of the art only when equivalent content is guaranteed.

3. In his proposals the Chairman has tried to comply with the desire expressed by the interested circles for an acceleration and rationalisation of the procedure up to the publication of the European application; he has tried to do so firstly by dispensing with the examination for obvious deficiencies, and secondly by assigning additional tasks to the International Patent Institute.

The elimination of the examination for obvious deficiencies is proposed because it is pointless unless it is carried out before the search, yet such a pre-examination presents an obstacle to the acceleration of the procedure. Another reason in favour of eliminating the examination for obvious deficiencies is that such pre-examination is alien to the Netherlands patent procedure, without this having caused difficulties. It is true that the new German patent law includes pre-examination of this nature - it took the idea from the 1962 Draft Convention relating to a European Patent Law -, but experience to date of this type of examination does not unconditionally advocate its introduction into the European system for the following reasons.

In 1970 the German Patent Office objected to 2.6% of the patent applications filed during the year in the course of examination for obvious deficiencies. On the basis of these objections 5.25% of the applications to which objections were made, i.e. 0.14% of all patent applications filed, were rejected. The most frequent objection was occasioned by obvious lack of unity in the subject-matter of the application. This accounted for 41.7% of the cases. If it is assumed that such figures are also to be expected in the European system for the grant of patents and if, in accordance with the proposed procedure, the International Patent Institute is to make the preliminary decision as to unity, in less than 1% only of the applications would the examination

for obvious deficiencies lead to the rejection of the application. In view of the importance likely to be attached to a European patent and the care with which applications will probably be filed, the percentage will certainly be no higher. The Chairman is therefore of the opinion that the examination for obvious deficiencies may be dispensed with in the interests of the rationalisation and acceleration of the procedure.

In this connection further tasks would be assigned to the International Patent Institute in order to avoid the use of technical examiners in proceedings up to the publication of the European application.

The International Patent Institute is to classify the application provisionally and make a preliminary decision as to the unity of the application, dealing directly with the applicant. This transfer of duties would moreover result in the International Patent Institute assuming the same rôle in the European system for the grant of patents as it already plays as an International Searching Authority in the PCT procedure.

4. The Chairman's proposals would bring about the following changes in the procedure up to the publication of the application:

- (i) The present fee for obtaining the report on the state of the art would be combined with the filing fee.
- (ii) The European Patent Office would send the International Patent Institute a set of the application documents for the purpose of drawing up the report on the state of the art as soon as the date of filing has been established, the fees for filing and obtaining the report on the state of the art have been paid,

the abstract has been submitted and, in the case referred to in Article 34, paragraph 2, the translation of the patent application has been filed.

- (iii) The International Patent Institute would draw up the report on the state of the art or establish in a declaration that significant enquiries into the state of the art cannot be made. At the same time as it draws up the report on the state of the art, the International Patent Institute would provisionally classify the European patent application and specify the final content of the abstract.
- (iv) Should the International Patent Institute consider that the application lacks unity, it would draw up a report on the state of the art in respect of those parts of the application relating to the invention first referred to in the claims, and a further report or reports in respect of the other parts, provided that the applicant has paid the fees required for this purpose to the European Patent Office.
- (v) The International Patent Institute would, within the time limit specified in the Implementing Regulations, send the European Patent Office and the applicant the report on the state of the art or the declaration that significant inquiries on the state of the art cannot be made, and the final content of the abstract.
- (vi) While the International Patent Institute is examining the report on the state of the art, the European Patent Office would be examining the application for formal

deficiencies. If the application were to be discontinued after the documents have been sent to the International Patent Institute, the European Patent Office would notify the International Patent Institute of the fact.

(vii) There would be no examination for obvious deficiencies.

5. This working document does not take into account the proposals of the non-governmental international organisations to the effect that the International Patent Institute should be assigned tasks requiring acts of sovereignty, nor those to the effect that the departments of the European Patent Office that examine for novelty should be combined for organisational purposes with those of the International Patent Institute that draw up the report on the state of the art.

Apart from the fact that it was considered unnecessary to adopt these proposals for the purpose of rationalising the European system for the grant of patents, the proposals may well meet with difficulties because the International Patent Institute is supported by some only of the Contracting States to the First Convention, and the Hague Agreement concerning the establishment of an International Patents Bureau serves purposes different from those served by the First Convention. Moreover, the opinions on this question requested by the Inter-Governmental Conference from the delegations of the Contracting States which are also parties to the Hague Agreement should be awaited (see minutes of meeting in BR/125/71 of 7 July 1971, point 46).

6. In connection with the Articles covered in this working document, Article 137 is also to be re-examined, as stated in the note to Article 66.

The Chairman of Working Party I has not made a proposal for this Article because the Netherlands delegation has already submitted a proposal (see BR/GT I/104/71 of 15 January 1971), which Working Party I has decided to deal with in connection with the proposals from the non-governmental international organisations (see minutes of meeting in BR/94/71 of 6 April 1971, point 46).

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Article 66

Requirements of the application

(1) An application for a European patent shall contain:

- (a) a request for the grant of a European patent;
- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract.

(2) - deleted - [Cf. Article 68, sub-paragraph (c)]_7

(3) An application for a European patent shall be subject to the payment of the filing fee prescribed by the Rules relating to Fees adopted pursuant to the Convention. This fee must be paid within one month after the filing date.

(4) The abstract merely serves the purpose of technical information and cannot be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought.

Note to Article 66:

This Article is to be re-examined in connection with Articles 77, 78, 79, 80, 122 and 137, particularly for the purpose of rationalising the procedure from the filing of the application to the issue of the report on the state of the art.

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Article 68

Date of filing

The date of filing of a European patent application shall be the date on which it satisfies the following conditions:

- (a) an indication is given that the application is for a European patent, and at least one Contracting State is designated in accordance with Article 67, paragraph 1;
- (b) information has been given identifying the applicant;
- (c) there are, in one of the languages referred to in Article 34, paragraphs 1 and 2, a description and claims, even though they do not comply with the other requirements of this Convention.

Chairman's Proposal

Article 66

Requirements of the application

(1) +

(a) +

(b) +

(c) +

(d) +

(e) +

(2) - deleted - (cf. Article 68, sub-paragraph (c))

(3) An application for a European patent shall be subject to the payment of the filing fee and the fee for the report on the state of the art prescribed by the Rules relating to Fees adopted pursuant to this Convention. These fees must be paid within one month after the filing date.

(4) - delete - (cf. Article 79, paragraph 2, second sentence).

Notes:

1. The amalgamation of the search fee and the filing fee suggested by the non-governmental international organisations is not necessary for the purposes of rationalising the procedure. It is sufficient to provide that both fees are payable within one month of the date of filing.

A separate demand for the fees also facilitates the procedure when the application is divided because of a lack of unity and the applicant has already paid the search fee before the division, and also when such a second search fee is wrongly demanded from the applicant (cf. Proposals for Article 79, paragraphs 4 and 5 and for Article 81, paragraph 5).

The separation of the filing and search fees is, moreover, in line with the principle laid down in the procedure under the PCT.

2. The content of what has hitherto been paragraph 4 is not in itself a requirement of the application. It is therefore proposed that the definition of the significance of the abstract be included in Article 79, which lays down that the International Patent Institute will determine the definitive contents of the

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Article 68

Date of filing

- +
- (a) +
- (b) +
- (c) there are, in one of the languages referred to in Article 34, paragraphs 1 and 2, a description, one or more claims and any drawings referred to in the description or the claims, even though these documents do not comply with the other requirements of this Convention.

Note:

The proposed sub-paragraph (c) contains a textual and a material alteration.

The textual alteration ("one or more claims") brings the text into line with Article 66, paragraph 1(c).

The material alteration concerns the inclusion of the drawings and corresponds to the Swiss proposal contained in BR/GT I/97/71 of 6 January 1971. It is true that the proposal was rejected by a majority at the 7th meeting of Working Party I, but this was only because it would have meant, as a result of paragraph 1 of Article 78, which has since been deleted, that the application would have had to have been refused on the grounds of not being filed in the proper manner if the drawings were not filed at the same time as the application (cf. BR/94/71 of 6 April 1971, point 17).

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The Swiss proposal has been reverted to because it is assumed that the search cannot take place until the date of filing has been established and that the examination for formal deficiencies and the search will take place parallel to each other, i.e. the examination for formal deficiencies will be undertaken by the European Patent Office at the same time as the search is being undertaken by the International Patent Institute. This means that the examination to ascertain whether the application contains drawings referred to in the description or the claims and the determination of the date of filing as a result of this examination must take place before the beginning of the examination for formal deficiencies.

The proposal for Article 68(c) and the related proposal on the introduction of a new Article 76a differ from the present solution in that the date of filing, in cases where the drawings are filed after the application or where the reference to the drawings is considered non-existent, will only have to be established once. This solution should harmonize with Article 14, paragraph 2, of the PCT.

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Article 69

Failure to pay the filing fee or to provide
a translation

An application for a European patent shall be deemed to be withdrawn:

- (a) if the fee provided for in Article 66, paragraph 3, has not been paid within the prescribed time limit, or
- (b) if the translation of the application, in the case provided for in Article 34, paragraph 2, has not been produced within the time limit referred to in that Article.

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Article 69

Failure to pay the fees required for the application
or to provide a translation

+

(a) if the fees provided for in Article 66, paragraph 3,
have not been paid within the prescribed time limit,
or

(b) +

Note:

Sub-paragraph (a) has been brought
into line with the proposed alter-
ation of Article 66, paragraph 3.
Account was taken of the Note to
Article 66.

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Article 77, paragraph 1:

(1) The Examining Section shall examine the European patent application in the light of the provisions of Articles 68 and 69.

Rule 20.6

(a) The invitation to correct under Article 11(2) shall specify the requirement provided for under Article 11(1) which, in the opinion of the receiving Office, has not been fulfilled.

(b) The receiving Office shall promptly mail the invitation to the applicant and shall fix a time limit, reasonable under the circumstances of the case, for filing the correction. The time limit shall be not less than 10 days, and shall not exceed 1 month, from the date of the invitation. If such time limit expires after the expiration of 1 year from the filing date of any application whose priority is claimed, the receiving Office may call this circumstance to the attention of the applicant.

PART V
EXAMINATION, GRANT AND OPPOSITION

CHAPTER I

Procedure prior to the introduction of the request for examination

Article 76a new

Examination on filing of the European patent application

(1) The European Patent Office shall examine the European patent application in the light of the provisions of Articles 68 and 69.

(2) If the examination referred to in paragraph 1 reveals that the requirements laid down in Article 68 are not satisfied, the European Patent Office shall invite the applicant to remedy the disclosed deficiencies within a period of one month.

Notes:

1. In this working document it is proposed that in addition to the examination of the European patent application in the light of Articles 68 and 69, a copy of the application documents should be sent to the IIB; moreover, this examination on filing should also include examination as to whether the drawings referred to in the description or the claims have been submitted. In these circumstances it would seem advantageous to combine the provisions of the present Article 77, paragraph 1, and the present Article 78, paragraph 7(b), to form a new Article 76a, to be followed by the provision on the transmittal of the application documents to the IIB as the new Article 76b.

The proposed Article 76a has moreover been aligned on Rules 20.6 and 20.7 of the Regulation under the PCT, in order to give the EPO the opportunity to reject the documents filed if, in spite of the invitation, the requirements laid down in Article 68 have not been satisfied and the deficiency does not consist exclusively in a lack of drawings.

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Article 78, paragraph 7(b):

(b) If the examination provided for in Article 77, paragraph 2(h), reveals that the drawings were not filed, the Examining Section shall invite the applicant to do so within a period of one month. If the applicant files the drawings in due time, the application shall be re-dated to the date on which they were filed; otherwise the references to the drawings shall be considered as cancelled.

Rule 20.7

If the receiving Office does not, within the prescribed time limit, receive a reply to its invitation to correct, or if the correction offered by the applicant still does not fulfil the requirements provided for under Article 11(1), it shall:

(1) promptly notify the applicant that his application is not and will not be treated as an international application and shall indicate the reasons therefor.

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(3) If the applicant files the drawings in reply to the invitation referred to in paragraph 2, and if the other requirements set out in Article 68 are fulfilled before the drawings have been filed, the date of filing shall be established as the date on which the drawings are filed. If the applicant does not file the drawings in due time, the date on which the other requirements set out in Article 68 are fulfilled shall be deemed to be the date of filing, and the references to the drawings shall be deemed to be deleted.

(4) If on expiry of the period specified in paragraph 2 the requirements laid down in Article 68 have not been met and the failure to file the drawings is not the sole deficiency, the European Patent Office shall inform the applicant that his application will not be dealt with as a European patent application.

2. In the proposed Article 76a and subsequent proposals the term "Examining Section" has been replaced by "the European Patent Office", as, following the elimination of the examination for obvious deficiencies, it would appear questionable whether the examination on filing should still be done by the Examining Sections, which consist of technically qualified examiners. It may be useful to provide for a special department for this purpose, whose duties would precede those of the Examining Divisions in the procedure, and which would be responsible for all work from the registration of the application to its being laid open to public inspection.
3. It should be examined whether the content of the third sentence of Rule 20.6 (b) should be included in the Imp. Reg.

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Article 76b new

Transmittal of the application documents to
the International Patent Institute

The European Patent Office shall transmit a set of the documents making up the European patent application to the International Patent Institute at the Hague for the purpose of drawing up the report on the state of the art, as soon as

- (a) the date of filing of the European patent application has been established,
- (b) the fees provided for in Article 66, paragraph 3, have been paid,
- (c) the abstract has been submitted, and
- (d) in the case referred to in Article 34, paragraph 2, the translation of the patent application has been filed.

Note:

Provision should be made in the Implementing Regulations that the European Patent Office is to inform the International Patent Institute immediately of any lapse of the application which occurs after transmittal of the application documents.

German statistics show that only 1.7% of the applications filed are rejected on the basis of the examination for obvious deficiencies. Working on the assumption that this percentage may also be expected in the European patent system, the notification referred to above would not be necessary too often.

Article 77

Examination of the European patent application
for formal and obvious deficiencies

(1) The Examining Section shall examine the European patent application in the light of the provisions of Articles 68 and 69.

(2) If a European application has been accorded a filing date, and is not deemed to be withdrawn by virtue of Article 69, the Examining Section shall examine:

- (a) whether, by its nature, the subject-matter of the application is obviously not an invention within the meaning of Article 9;
- (b) whether the application is obviously not patentable by virtue of Article 10;
- (c) whether the invention is obviously not susceptible of industrial application within the meaning of Article 14;
- (d) whether the application is obviously not contrary to Articles 70 and 71;
- (e) whether the application satisfies the requirements regarding form laid down in the Implementing Regulations to this Convention and whether the contents of the description, claims and drawings are obviously not contrary to the relevant provisions of the Implementing Regulations;
- (f) whether, in the case of an application for a patent of addition, the subject of that application is obviously not an improvement, development or supplementing within the meaning of Article 21, paragraph 1;
- (g) whether the inventor has been identified pursuant to Article 69a;
- (h) whether the application complies with the requirements of Article 66, paragraph 1 (d);
- (i) whether the application complies with the requirements of Article 66, paragraph 1 (e).

Note to Article 77:

See note to Article 66.

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Article 77

Examination of the European patent application for formal deficiencies

- deleted - (see Article 76a, paragraph 1)

+ ... the European Patent Office shall examine:

- deleted -

- deleted -

- deleted -

- deleted -

(a) whether the application satisfies the requirements regarding form
laid down in this Convention and the Implementing Regulations thereto, and

- deleted -

(b) +

- deleted - (see Article 68(c) and Article 76a, paragraph 1)

- deleted -

Note:

(a) to (d), the second half of (e) and (f) are deleted, as they refer to the examination for obvious deficiencies.

The present (i) may be included in the (a) now proposed.

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Article 78

Notification and refusal of the application

(1) - deleted - (Cf. Article 77, paragraph 2).

(2) If the examination provided for in Article 77, paragraph 2(a) to (f) and (i) reveals that the application for a European patent or the invention to which it relates does not meet the requirements to be taken into consideration in this examination, the Examining Section shall inform the applicant accordingly and invite him to make observations or to remedy the disclosed deficiencies within a period to be fixed by the Section. The description, claims and drawings may be amended only to an extent sufficient to remedy the disclosed deficiencies in accordance with the observations of the Examining Section.

(3) If the Examining Section finds that the invention is obviously not new, it may inform the applicant accordingly.

(4) If, on expiry of the period referred to in paragraph 2, it appears that the invention or the application for a European patent fails to meet the requirements referred to in that paragraph, the Examining Section shall refuse the application.

(5) - deleted - (Cf. Article 139).

(6) If the examination provided for in Article 77, paragraph 2(g), reveals that the inventor has not been identified, the Examining Section shall invite the applicant to do so. If the inventor has not been identified before the end of the 16th month after the priority date, the designation of any Contracting State requiring such identification in respect of national applications shall be deemed to be withdrawn.

(7) (a) If the examination provided for in Article 77, paragraph 2 (h), reveals that the drawings were filed later than the filing date of the application, the application shall be re-dated to the date on which the drawings were filed.

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Article 78

Notification and refusal of the application

- deleted -

(1) If the examination provided for in Article 77, sub-paragraph (a), reveals that the application for a European patent does not meet the requirements regarding form laid down in this Convention and the Implementing Regulations thereto, the European Patent Office shall inform the applicant accordingly and invite him to remedy the disclosed deficiencies within a period to be fixed by the European Patent Office. The description, claims and drawings may be amended only to an extent sufficient to remedy the disclosed deficiencies in accordance with the observations of the European Patent Office. If the deficiencies are not remedied in due time, the European Patent Office shall refuse the application.

- deleted -

- deleted - (see third sentence of paragraph 1)

- deleted - (Cf. Article 139)

(2) If the examination provided for in Article 77, sub-paragraph (b), reveals that the inventor has not been identified, the European Patent Office shall invite the applicant to do so. If the inventor has not been identified before the end of the 16th month after the filing date or, if a priority has been claimed, after the priority date, the designation of any Contracting State requiring such identification in respect of national applications shall be deemed to be withdrawn.

- deleted - (see Article 68(c))

Notes:

1. The present paragraph 3 is deleted following the elimination of the examination for obvious deficiencies.
2. In the present paragraph 6 the priority date is quoted as the beginning of the 16-month period. In the new paragraph 2, in accordance with practice elsewhere in the Convention (cf. Article 65 paragraph 5), the filing date is quoted in addition to the priority date. It should be examined whether the case of more than one priority being claimed should also be taken into consideration here, i.e. whether the date of the earliest priority should also be quoted (cf. the first sentence of Article 85, paragraph 1).

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(7) (b) If the examination provided for in Article 77, paragraph 2(h), reveals that the drawings were not filed, the Examining Section shall invite the applicant to do so within a period of one month. If the applicant files the drawings in due time, the application shall be re-dated to the date on which they were filed; otherwise the references to the drawings shall be considered as cancelled.

Note to Article 78:

See note to Article 66.

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- deleted - (see Article 76a, paragraph 2).

Article 79

Obtaining of the report on the state
of the art

(1) If the examination reveals that the application for a European patent and the invention to which it relates meet the requirements to be taken into consideration in the examination, the Examining Section shall request the applicant to pay, within a period of one month, the fee for obtaining a report on the state of the art as prescribed by the Rules relating to Fees adopted pursuant to this Convention.

(2) If the fee is not paid in due time, the application for a European patent shall be deemed to be withdrawn.

(3) On the date of payment of the fee or, if the latter has already been paid, on concluding 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. The International Patent Institute at the Hague shall also determine the definitive contents of the abstract.

(4) The report on the state of the art shall be drawn up on the basis of the claims, with due regard to the description and the drawings, if any.

(4a) The report on the state of the art and the definitive contents of the abstract shall be transmitted

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Article 79

Drawing up of the report on the
state of the art

- deleted - (see Article 66, paragraph 3)

- deleted - (see Article 69, sub-paragraph a)

- deleted - (see Article 76b and paragraph 2, first sentence, of the Article below)

(1) The International Patent Institute at the Hague shall draw up the report on the state of the art on the basis of the claims, with due regard to the description and the drawings, if any, in the form prescribed in the Implementing Regulations to this Convention.

(2) At the same time as drawing up the report on the state of the art the International Patent Institute shall undertake a provisional classification of the European patent application

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to the European patent Office within the time
limit and in the form prescribed in the
Implementing Regulations to this Convention.

Article 17

Procedure before the International
Searching Authority

(2)(a) If the International Searching Authority
considers

(ii) that the description, the claims, or the
drawings, fail to comply with the prescribed
requirements to such an extent that a
meaningful search could not be carried out
the said Authority shall so declare and shall
notify the applicant and the International
Bureau that no international search report
will be established.

(b) If any of the situations referred to in
sub-paragraph (a) is found to exist in connection
with certain claims only, the international
search report shall so indicate in respect of
such claims, whereas, for the other claims, the
said report shall be established as provided in
Article 18.

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in accordance with the patent classification used by the European Patent Office and shall determine the definitive contents of the abstract. The provisional classification and the abstract shall merely serve for organisational purposes and for use as technical information; they may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought.

(3) If the International Patent Institute considers that the description, the claims and the drawings, if any, fail to comply with the requirements of this Convention and the Implementing Regulations thereto to such an extent that meaningful enquiries into the state of the art could not be carried out, the International Patent Institute shall so declare. If it is established in respect of certain claims only that meaningful enquiries into the state of the art cannot be carried out, the report on the state of the art shall so indicate in respect of such claims only, whereas, for the other claims a report on the state of the art shall be drawn up as provided in paragraph 1.

Notes:

1. Cf. present Article 66, paragraph 4

2. Paragraph 3 is based on PCT Article 17, paragraph 2(a)(ii) and (b).

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(5) If an additional report on the state of the art becomes necessary, by reason of lack of unity of the invention, the Examining Section shall invite the applicant, at his option, within a period of one month, either to restrict the application to one invention or to pay the additional fee prescribed by the Rules relating to Fees adopted pursuant to this Convention.

(6) If the applicant does not restrict the application to one invention only or the fee provided for in paragraph 5 is not paid in due time, the part of the application which is not covered by the search report shall be deemed to be withdrawn.

(7) Any fee which has been paid under paragraph 5 shall be refunded if, during the examination under Article 93, the applicant requests a refund and the Examining Division finds that the invitation referred to in the said paragraph was not justified.

Note to Article 79, paragraph 1:

When the examination referred to in the note to Article 66 is undertaken, the question of dispensing with the fee referred to in this paragraph and replacing it by an increase in the filing fee.

(3)(a) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the applicant to pay additional fees. The International Searching Authority shall establish the international search report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") and, provided the required additional fees have been paid within the prescribed time limit, on those parts of the international application which relate to inventions in respect of which the said fees were paid.

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(4) If the International Patent Institute considers that the European patent application fails to comply with the requirement of unity of invention as prescribed in this Convention and the Implementing Regulations thereto, the International Patent Institute shall draw up the report on the state of the art on those parts of the European patent application which relate to the invention first mentioned in the claims; it shall notify the applicant that for the other inventions included in the application one or possibly more reports on the state of the art will only be drawn up, if the corresponding fee for the report on the state of the art is paid within a period of one month. The International Patent Institute shall transmit to the European Patent Office a copy of the notification to the applicant. When it is established that the payment has been made, the International Patent Institute shall draw up a report on the state of the art for those parts of the European patent application which relate to inventions in respect of which the fees referred to were paid.

- deleted -

(5) Any fee which has been paid under paragraph 4 shall be refunded if, during the examination under Article 93, the applicant requests a refund and the Examining Division finds that the notification referred to in the said paragraph was not justified.

Remarks:

- (1) Paragraph 4 is based on PCT Article 17, paragraph 3(a).
- (2) It should be examined whether there should not be provision in the Implementing Regulations for the European Patent Office to inform the International Patent Institute of the payment of additional search fees.
- (3) The question should also be examined, whether the fee for the report on the state of the art should be refunded, if the application is refused, either
 - (a) before the report on the state of the art is drawn up, or
 - (b) after the report on the state of the art has been drawn up, but prior to publication.

For the refund of the search fee under the PCT procedure cf. Rule 15.2.

Second Preliminary Draft

Article 79, paragraph 4a

(4a) The report on the state of the art and the definitive contents of the abstract shall be transmitted to the European Patent Office within the time limit ... prescribed in the Implementing Regulations to this Convention.

Article 80

Transmission of the report on the state of the art

On receipt of the report on the state of the art, the European Patent Office shall transmit it to the applicant.

Chairman's Proposal

Article 80

Transmission of the report on the state of the art and the abstract

The International Patent Institute at the Hague shall transmit within the time limit prescribed in the Implementing Regulations to this Convention:

- (a) to the European Patent Office, the report on the state of the art and the definitive contents of the abstract or the declaration that a report cannot be drawn up,
- (b) to the applicant, a further copy of the report on the state of the art and of the definitive contents of the abstract or a copy of the declaration that a report cannot be drawn up.

Note:

Re. Article 79, No. 2 of the Implementing Regulations needs to be extended to include the declaration that a report cannot be drawn up and also to include the transmission of the report or the declaration to the applicant.

Second Preliminary Draft

Article 81

Division of the European patent application before filing a request for examination

(1) Before filing a request for examination, an applicant may divide his application for a European patent by limiting it and by filing divisional applications in respect of the inventions thus excluded from the application, in the following circumstances:

- (a) in response to the invitation referred to in Article 78, paragraph 2, or Article 79, paragraph 5;
- (b) at any time after he has received the report on the state of the art.

(2) The limitation must be effected by an amendment to the claims pursuant to Article 83, paragraph 1, or by a notice of abandonment of a part of the description or the drawings. This notice may include a proposal to insert a cross-reference to a divisional application filed in respect of the subject-matter contained in the abandoned part.

(3) The amended application instead of the original application shall determine the protection sought, in so far as its subject-matter does not extend beyond what was disclosed in the original application.

(4) Divisional applications 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 their subject-matter does not extend beyond what was disclosed in the original application, provided that the divisional applications have been filed within a period of two months after the limitation referred to in paragraph 1.

(5) 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.

Chairman's Proposal

Article 81

Division of the European patent application before filing a request for examination

(1) Before filing a request for examination, an applicant may divide his application for a European patent by limiting it and by filing divisional applications in respect of the inventions thus excluded from the application, in the following circumstances:

- (a) in response to a notification referred to in Article 79, paragraph 4,
- (b) at any time after he has received the report on the state of the art.

(2) +

(3) +

(4) +

(5) The fees 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. However, the fee for the report on the state of the art shall no longer be paid, if it has already been paid for the subject-matter of the application pursuant to Article 79, paragraph 4.

Note:

The invitation referred to in Article 78, paragraph 2 (now paragraph 1) has been deleted from paragraph 1(a), since according to this working document such an invitation should only ensue as a result of formal deficiencies in the application.

Second Preliminary Draft

Article 85, paragraph 1

Publication of a European patent application

(1) European patent applications shall be published as soon as possible after the expiry of a period of 18 months from the date of filing of the patent application or, if a priority has been claimed, as from the date or earliest date of priority. Nevertheless, at the request of the applicant the application may be published before the expiry of the period referred to above. The publication shall contain the description, the claims and any drawings and, in the annex, the report on the state of the art, in so far as the latter is available before the termination of the technical preparations for publication. If the report on the state of the art has not been published at the same time as the application, it shall be published separately.

Chairman's Proposal

Article 85, paragraph 1

Publication of a European patent application

(1) European patent applications shall be published as soon as possible after the expiry of a period of 18 months from the date of filing of the patent application or, if a priority has been claimed, as from the date or earliest date of priority. Nevertheless, at the request of the applicant the application may be published before the expiry of the period referred to above. The publication shall contain the description, the claims and any drawings; it will include in an annex the report on the state of the art, in so far as the latter is available before the termination of the technical preparations for publication, or the declaration referred to in Article 79, paragraph 3. If the report on the state of the art has not been published at the same time as the application, it shall be published separately.

Chairman's Proposal

Article 160a new

Non-application of Article 122 during a transitional period

(1) Article 122 shall not be applicable during a transitional period, the end of which shall be determined by the Administrative Council.

(2) The Administrative Council may decide during the transitional period that the international search reports of certain International Searching Authorities shall take the place of the report on the state of the art for all or certain areas of technology.

Note:

Article 122 should be retained on the grounds of the Netherlands delegation's Note on combining the filing and search fees (BR/GT I/104/71 of 15 January 1971).

The reservations of the non-governmental international organisations over the procedure laid down in Article 122 (see recommendations of Working Party I on Article 122 - BR/100/71 of 24 March 1971) should be met only to the extent that the international search report should only take the place of the report on the state of the art, if there is a guarantee that the contents are equivalent.

It is impossible to state categorically at this stage how far this will actually be the case in respect of the international search reports which are not drawn up by the International Patent Institute.

Chairman's Proposal

Therefore, it is considered necessary to introduce a provision to the effect that Article 122 shall not apply in principle during a transitional period, but that within this period the Administrative Council may decide that the search reports of certain International Searching Authorities are to take the place of the report on the state of the art for all or certain areas of technology.

Moreover, the proposed solution would appear to follow the same pattern as that apparently proposed by the interested circles in the USA for implementation of the PCT by the American Patent Office.

