

# BR/GT I/121 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

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Brussels, 30 September 1971  
BR/GT I/121/71

- Secretariat -

N O T E

The members of Working Party I will find attached a note sent on 27 September 1971 to the Secretariat by the United Kingdom delegation concerning the problem of the "package" (cf. item 2 on the provisional agenda for the 9th meeting, BR/GT I/120/71).

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NOTE BY THE UNITED KINGDOM DELEGATION

The Early Stages of the Procedure

1. The preliminary examination of Article 77, paragraph 2, involves both clerical and technical operations. The aim of the clerical operation is to get a European application into proper form of publication under Article 85. The aim of the technical operation is to eliminate those applications which by definition are obviously not patentable and to clean up an application so that a meaningful search may be made.
2. Maintenance of the clerical operation is essential. However, it does not appear that the technical examination is useful to anyone. This is because it deals only with obvious deficiencies, the removal of which does not guarantee that the application can be effectively searched. Apart from this, the technical examination has serious disadvantages. A disadvantage for the Office is that it does not result in a smooth procedure leading in all cases to the possibility of publishing the applications, together with the search report, at 18 months from the priority date. It has disadvantages for applicants in that they are given no choice and must take up definite positions (eg as to unity of invention) at an early stage in the life of the application. It has disadvantages for third parties in that the delays involved may result in applications not being published together with the search report as soon as they should be. In this connection, it is to be remembered that an application is not sent to the IIB for search until the examination has been completed and the search fee has been paid. In some cases this could mean that the IIB would be unable to begin a search until well into the 17th month from the priority date.

3. It seems obvious that if an application is to be published at 18 months together with the search report then the search copy should be transmitted to the IIB as soon as possible. We think that this search copy should go to the IIB as soon as the examination prescribed by Article 77, paragraph 1, has been completed. This is after a date of filing has been accorded the European application and it has been decided not to deem the application withdrawn (ie the filing fee has been paid and any Article 34 (2) translation filed). At the latest this will be 13 months after the priority date. It follows from this that another change should be made, namely that the search fee should be made payable at the same time as the filing fee, either as a separate fee or combined with the filing fee.
  
4. In view of the disadvantages of the examination for obvious deficiencies it should be eliminated; indeed it would be futile to look for obvious defects when the IIB is struggling with a search made difficult by non-obvious defects. The result of this will be that the IIB will receive some applications which will be difficult to search. Normally the IIB will have to search them as best it can. If, however, the application is one which it is impossible to search or one on which no really effective search can be done, then the IIB should report out to this effect to the Examining Section. And then the application should be published at 18 months together with a partial search report or a note indicating that no search or no meaningful search has been possible. We see no serious disadvantage in this because ex hypothesi the state of the application is such that third parties will not be harmed; any provisional rights that may exist in respect of such applications would be difficult or impossible to enforce.

5. So far as concerns unity of invention, we think the same system should apply. If the IIB finds there is more than one invention it should search the invention first-mentioned in the claims and report through the Examining Section to this effect and the applicant, instead of being required to restrict his applications as under Article 78, paragraph 2, of the draft, should be invited to pay additional fees. If he does so, then the search is completed and the publication at 18 months will include a complete search report. If, however, the applicant does not pay the additional fees, then the IIB will have searched only the main invention and the publication at 18 months will then include a partial search report. Reserving unity of invention to the IIB allows them the possibility of taking appropriate action when they find objection before or during a search, a flexibility which is also lacking in the present draft.
6. Article 79 (6) at present envisages that the parts of the application which are not searched shall be deemed to be withdrawn. We think that this provision could also usefully be deleted. It is open to the Examining Division under Article 94 to require restriction of the application to one invention only at a later stage. If an application were deemed to be withdrawn in such cases, the Office would probably have to edit it in order to exclude the parts relating to the unsearched inventions, this being a task which can be difficult and sometimes impossible without a complete redraft of the application. And, in any case, deeming to be withdrawn involves the applicant in taking up an immediate position and the possibility of a dialogue between him and the Office and

eventually an appeal to the Board of Appeal. It is true that deletion of Article 79 (6) would mean that an application could be published with unsearched inventions present in it, but these are likely to form only a small proportion of the cases and third parties at least have notice that monopolies are being sought for these inventions.

7. In all these cases where the IIB has been unable to draw up a search report or has found it possible only to make a partial search report, then if a request for examination pursuant to Article 88 is made, no doubt the Examining Division will raise those objections which have given rise to the inability of the IIB to produce only an incomplete report or no report at all. When these objections have been met, it is very likely that the Examining Division will require the IIB to carry out a search or to complete its search. In these cases, the applicant may be required under Article 137 to pay a further fee. Normally the applicant would be in no position to complain. But if it so happens in a particular case that the original action of the IIB is not considered to be justified, the Examining Division may waive the Article 137 fee. The provision in Article 79, paragraph 7, should be retained to deal with the cases where an IIB objection as to lack of unity of invention is not considered to be justified.
8. It may be said that this system could result in the publication of obscene, libellous or disparaging matter. There are not likely to be many cases of this kind and we think



they can easily be dealt with. The Article 77 examination as to form may be stretched to cover this point, or, as we propose, the Office might be empowered to cut out such matter from its publications by adding a paragraph to Re Article 66 No. 6.

9. The attached proposals give effect to the new scheme explained above.

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PROPOSED REDRAFT OF MAIN ARTICLES INVOLVED IN THE "PACKAGE"

Article 66

Unchanged

Note:

The "filing fee" referred to in paragraph (3) is to be regarded as a combined application and search fee.

Article 77

(1) Unchanged.

(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) - (d) deleted

(e) whether the application satisfies the physical requirements laid down in the Implementing Regulations

(f) deleted

(g) - (i) unchanged.

Note:

The effect of these amendments is to reduce the examination to a clerical operation, mainly concerned with getting the application in proper form for publication. The Section will not however look for defects in the "contents" of the description, claims and drawings and will not concern itself with unity of invention.

Article 78

(1) deleted.

(2) If the examination provided for in Article 77, paragraph 2(e) and (i) reveals that the application does not meet the requirements to be taken into consideration in this examination, the Examining Section shall invite the applicant to make observations or to remedy the disclosed deficiencies within a period to be fixed by the Section.

(3) deleted.

(4) If, on expiry of the period referred to in paragraph 2 it appears that the application fails to meet the requirements referred to, the Examining Section shall refuse the application

(5) deleted.

(6) Unchanged.

(7) Unchanged.

Note:

These amendments follow from the changes made in Article 7. So far as concerns the abstract, the Section will object only if it is missing or includes some formal defect; it will not check the contents of the abstract.

Article 79

(1) If a European application has been accorded a filing date, and is not deemed to be withdrawn by virtue of Article 6

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 a copy of the documents of the European application. The International Patent Institute shall also determine the definitive contents of the abstract.

(2) 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 drawings, if any.

Note:

The main effect of paragraph (1) is that the IIB will receive the search copy at a much earlier date.

Article 79a

(1) If the International Patent Institute considers that the application does not comply with the requirement of Article 70, the Examining Section shall invite the applicant to pay within a period of 1 month the additional fees prescribed by the Rules relating to fees adopted pursuant to this Convention.

(2) The International Patent Institute shall draw up the report on the state of the art on those parts of the application which relate to the invention first mentioned in the claims and, if additional fees are paid within the period referred to in paragraph 1, on those parts of the application which relate to inventions in respect of which the fees were paid.

(3) Any fee which has been paid under paragraph 1 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 paragraph 1 was not justified.

Note:

The effect of this amendment - based on PCT Article 17 - is to avoid the need for the EPO and the applicant to take up a definite position at this stage as to unity of invention. This means that the applicant is not invited to restrict his application; it follows that Article 81(1)(a) can be deleted. The procedure may result in the application containing unsearched parts, but these are not to be deemed withdrawn. It is likely that the applicant in such cases may now wish to divide out the unsearched parts as is allowed under the provision of Article 81(1)(b). But whether or not he does so, the entire application will be published and it will be open to the Examining Division to object later when examination pursuant to Article 88 is requested.

Article 79b

(1) If the International Patent Institute considers that the application does not comply with the provisions of the Convention and the Implementing Regulations to such an extent that it is not possible to carry out a meaningful search on the basis of some or all of the claims, it shall either declare that search is not possible or shall, so far as possible, draw up a partial report.

(2) The partial report and the declaration referred to in paragraph 1 shall be considered as included in the term "report on the state of the art".

Note:

Since the search copy has not been checked as regards contents, there may be cases in which the IIB finds that it cannot search at all (eg all the claims are directed to a plant variety). There may also be cases in which some of the claims are not searchable whereas others are (eg claims 1-4 are for a camera and claims 5-10 are for a photograph). Both kinds of case may also arise because of obscure claims. This Article is intended to set out a procedure for the IIB to follow; it is based on PCT Article 17. Paragraph (2) is a drafting amendment which takes account of the fact that many Articles in the Convention refer only to "the report on the state of the art".

Article 80

(1) The report on the state of the art, copies of any cited documents and the definitive contents of the abstract shall be transmitted to the European Patent Office within the time limit and in the form prescribed in the Implementing Regulations to this Convention.

(2) At the same time the International Patent Institute shall transmit a copy of the report on the state of the art to the applicant. It shall be accompanied by copies of any cited documents if this has been requested by the applicant.

(3) If the application is withdrawn or is refused under Article 78, paragraph 4, the provisions of paragraph 1 and 2 of this Article shall not apply.

Note:

Paragraph (1) corresponds to Article 79(4a) of the draft with changes to take account of the proposed Articles 79a and 79b. Paragraph (2) meets the wishes of the interested circles. Paragraph (3) allows the IIB to suspend work when it is clear that the application is not going to proceed.

Re Article 66 No. 6

Insert new paragraph as follows:-

"If a European patent application contains such prohibited matter, the European Patent Office may omit it from the publication in accordance with Article 85."

Note:

This provision - based on PCT Article 21(6) - appears necessary, since under the proposed re-draft of Article 77 the Section will not examine the contents of an application (other than the request) and the applicant will not be invited under Article 78 to strike out prohibited matter.

Re Article 79 No. 3

Delete.

Note:

This provision is no longer necessary in view of the proposed Article 79a.



CONSEQUENTIAL AMENDMENTS

As foreshadowed above in the note to Article 66 it is assumed that the "filing fee" referred to in Article 66(3), 69a and 81(5), and Article 2 (Rules relating to Fees) is to be regarded as a combined application and search fee with appropriate increase in the amount quoted in Fees Article 2 No. 1.

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| (1) <u>Article 54(2):</u>                | Cancel                                     |
| <u>Re Article 54 No. 1. paragraph 2:</u> | Cancel                                     |
| <u>Re Article 54 No. 2:</u>              | Excise reference to<br>"Examining Section" |

The task of the Examining Section has been reduced to a non-technical operation and does not require a technical examiner.

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| (2) <u>Article 81(1)(a):</u> | Cancel |
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Since the applicant will not be invited under Article 78(2) or 79a(1) to restrict his application, division of the application will not arise.

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| (3) <u>Article 82(2):</u> | Cancel<br>"and Article 79,<br>paragraph 5". |
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There is no longer a provision corresponding to Article 79(5).

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| (4) <u>Article 122:</u> | Replace reference to<br>"Article 79 para-<br>graph 1" by<br>"Article 79 para-<br>graph 2". |
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This is drafting.

(5) Article 137(4):

Replace reference to  
"Article 79, paragraph  
5 and 6" by  
"Article 79a paragraph

The package redraft does not invite restriction of the application to one invention and non-payment of fees does not result in parts of the application being deemed withdrawn. Reference to Article 79a(1) is necessary to distinguish the additional fees of that Article from those of Article 137; no sanction is imposed by Article 79a whereas non-payment of Article 137 fees results in the application being deemed withdrawn.

(6) Rules relating to Fees

(i) Article 2 No. 1: increase fee

No. 4: Cancel

No. 5: excise "supplementary" and  
replace reference to "Article 7  
paragraph 5" by "Article 79a  
paragraph 1".

Re-number the various fees.

The fee of No. 1 is increased in view of the merge of the filing fee of No. 1 with the search fee of No. 4. Additional fees may be paid under Articles 79a and 137, but it is inappropriate to refer to Article 79a search reports as "supplementary".

(ii) Article 10: amend to read as follows:-

"(1) ..... per cent of the fee provided for in Article 2 No. 1 shall be refunded if the report on the state of the art to be drawn up for a European patent application is based to a large extent on a report on the state of the art drawn up in accordance with the criteria laid down for the European system for the grant of patents

(a) already prepared by the International Patent Institute at The Hague on an application whose priority is claimed for the European patent application or

(b) already prepared by the International Patent Institute at The Hague or other International Searching Authority under the provisions of the Co-operation Treaty.

(2) If an application is withdrawn, deemed to be withdrawn or refused before the International Patent Institute at The Hague has started to draw up a report on the state of the art, ..... per cent of the filing fee provided for in Article 2 No. 1 shall be refunded. The same shall apply in the case of any additional fee provided for in Article 2 No. 5."

Paragraph 1 expands the existing draft to take account of PCT searches and paragraph 2 deals with the case where an application is eg abandoned before search. Both provisions are equitable consequences of combining the filing and search fees.

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(iii) Article 11: amend to read as follows:-

"The reduction laid down in Article .....  
(Re Article 34 No. 2) ..... shall be .....  
per cent in the case of the fee provided for in  
Article 2 no. 1 and ..... per cent in the case  
of the fees provided for in Article 2, Nos. 6, 12  
and 13."

It was not intended to give a reduction in the search fee.  
Following on the merger of the filing and search fees, the  
percentage reduction for the Article 2 No. 1 fee should therefore  
be less than for the other fees.

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