

# BR/GT I/123 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, 6 October 1971

BR/GT I/123/71

- Secretariat -

NOTE

The delegations to Working Party I will find attached a note submitted by the Swedish delegation on 4 October 1971, on Article 11, paragraph 3, of the Second Preliminary Draft of a Convention establishing a European System for the Grant of Patents.

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REPORT BY THE SWEDISH DELEGATION  
concerning Article 11, paragraph 3

At the meeting of Working Party I in January 1971 the Swedish delegation agreed to give a report on Scandinavian experiences with regard to the rule on novelty and inventive step that includes prior applications (the "whole contents" principle) when applied to inventor's own earlier applications.

1. In the new Nordic patent laws the regulation contained in Article 4, paragraph 3 of the Strasbourg Convention applies generally, i.e. also in relation to applicant's own prior applications. However, at the same time Article 5 of the Strasbourg Convention is applied in such a way that an inventor may obtain a patent of addition on a development of an invention patented through a prior application. A patent of addition can be obtained if the later application concerns a development of the earlier invention, and on



condition that the later application is filed before the earlier application was made public. However, the applicant does not need to specify already at the time of application that it concerns a patent of addition, an application may at any time up to grant be changed to a patent of addition.

2. Already from the start the fact that an applicant's own earlier application is included in the state of the art - in relation to which inventive step is required - met with objections especially on the part of patent agents. The objections may be summarized as follows:
3. An applicant who files his first application nationally will be at a disadvantage as compared to a foreign applicant who claims multiple priorities. The foreign applicant will be able to draft his claims taking account of those subsequent improvements that are contained in the later priorities, and may thus obtain a main claim with a wider scope of protection. Traditionally this is not possible in a patent of addition.
4. The possibility of obtaining a patent of addition is dependent on an administrative decision in each case as to what constitute a "development". This does not give sufficient legal security for the protection of inventions that - from the point of view of inventors - in fact constitute further developments.

5. In drafting a patent application an agent will have difficulty in deciding the detailing of the description. When an invention is part of a "complex of inventions", material leading to another invention may have to be included in order to give a full description. This material may become a novelty hindrance to the patenting of the other invention in its completed form.
6. In order to meet these objections certain legal and administrative rules have been provided.
7. Already in the law itself it is stated that applications filed on the same day do not constitute novelty hindrance against each other. An applicant may thus without detriment to himself file several applications on the same day, or divide an application. If an application contains material which does not pertain to the invention for which a patent is applied, that material may be kept secret regardless of the 18 months publication rule, if there are special reasons for this. This material will then not count as novelty hindrance in relation to a subsequent application.
8. By way of administrative regulations a liberal practice has been introduced with regard to patents of addition. If the relation to the main invention is acceptable from the point of view of unity of invention, the additional

invention is considered as a "development". Thus, a patent of addition may have a more general scope than that of the patent to which it relates. Practice is even more liberal than in case of the inventions being presented in the same application. A patent of addition may, e.g. contain further independent claims, whereas in one and the same application only one independent claim of a certain category is allowed.

9. As far as patent office practice is concerned we have not been able to find any negative effects of the "whole-content" principle applied also to prior applications from the same applicant. In practice, cases of "self collision" have occurred very rarely except in connection with certain transitory provisions which are here disregarded. Since patents of addition have assumed a specific substantive law importance one would expect the number of applications for such patents to have materially increased. However, this has not been the case. The number of applications for patents of addition have remained at the very low proportion of the total number of applications that existed under the old law, i.e. approximately 2.5 %. In our opinion this is due to the overriding effects of the 18-months publication, by which an application anyway becomes an absolute novelty hindrance at an early stage.

10. Anyway, certain patent agents - especially in Denmark - still claim difficulties in patent application drafting. They feel insecure in deciding how much to reveal since the description may have to contain material that may prove a hindrance to the applicant's own future applications. The agents' associations have also taken official action to initiate a change of law whereby applicant's own prior application should be excepted from the "whole contents" principle.
11. This initiative has so far been met by the following arguments. The difficulty claimed can only appear with regard to inventions that even with a liberal practice with regard of addition could not be considered to be developments of the first invention. From the point of view of the general public and the competing industry it remains an unjustified restriction to have to face patent monopolies which are not sufficiently separated with regard to inventive step. For this situation it is irrelevant whether the patents are granted to different persons or to the same person.
12. If applicant's own applications are not included there would be no equal treatment of applicants. By including extraneous material in patent applications, applicants could try to reserve certain fields of invention to themselves, although they have not yet achieved actual patentable results. This could appear unjust to other inventors

that have not applied until the invention is completed. When applying the "whole contents" principle this could lead to unwieldy applications which would be difficult for competing industry and third parties to analyze and penetrate.

13. It has been observed that technical difficulties arise if the "whole contents" principle is differentially applied. Which point of time should be decisive in determining identity of applicants? Should an applicant - perhaps even after the date of application - be allowed to avoid a novelty hindrance by the purchase of somebody else's prior application?
  14. In recent discussions among interested circles both sides of the argument have found support. During a recent meeting with the Nordic AIPPI groups there was a Danish proposal for a resolution against the present rule. This proposal was, however, withdrawn as a result of the discussion.
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