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Comment:

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INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Luxembourg, 12 October 1971
BR/GT I/124/71

- Secretariat -

N O T E

The delegations to Working Party I will find attached
a note submitted by the Netherlands delegation on
12 October 1971, on the publication of pending European
patent applications and its impact on third party interests.

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N O T E

PRESENTED BY THE NETHERLANDS DELEGATION
ON THE PUBLICATION OF PENDING EUROPEAN PATENT
APPLICATIONS AND ITS IMPACT ON THIRD PARTY INTERESTS

I. The first European Patent Convention provides for early publication of patent applications together with a literature search report, followed by a patentability examination and for a preliminary protection to be based on non-examined published applications. By doing so, it recognises in principle the interests of both applicants and third parties by offering the former a provisional protection and the latter the possibility, after a certain period, to judge the rights which may possibly arise from a European patent application and their validity, at the same time trying to reduce the period of uncertainty.

II. However, experience by interested circles in the Netherlands has taught that in many cases this judgement is practically impossible, even in those cases where a novelty report has been issued.

This is due mainly to the fact that the claims are very often drafted in a broad, vague and meaningless way in which cases the novelty report (which is based on the claims) is necessarily of no use in determining the ultimate valid scope of the application.

This situation is rendered even worse by applicant's virtually unlimited freedom to shift the ground during the patentability examination as a result of which he can base his ultimate claims on almost everything disclosed in the specification and or drawings, notwithstanding the fact that such features have never been stressed as essential.

The foregoing results in a situation of uncertainty for third parties during a period of which the length is outside their control.

This period of uncertainty may last for many years. In particular in the case of vague or complex applications (there are applications numbering 100-200 pages) the applicant can delay the prosecution and has for many years the opportunity to file divisional applications directed to subject matter neither touched upon in any of the published claims, nor indicated as essential in any statement of the invention.

III. The system of the European Patent Convention would not seem to guarantee that the disastrous uncertainties described above will not arise here.

This opinion is based on the fact that also here there will be a period of at least several years between the publication of the application and the grant of the patent(s).

A period during which the scope of the ultimate protection can hardly or not at all be assessed by third parties since here too the applicant has the possibility of shifting the ground, a situation still further aggravated by the fact that filing of divisional applications cannot only complicate the matter considerably but also prolong the prosecution for a large number of years.

Moreover those concerned about the serious situation described above, claim that they can hardly escape from the impression that there are cases in which said confusion and uncertainty have been created on purpose and that the number of such cases is increasing as time goes on.

Up till now, this situation has practically only been possible in a limited number of countries for which it may not have been worthwhile to exploit these possibilities to the full extent. However, it is feared that if these possibilities could be exploited by one application covering up to 19 countries, more applicants may be tempted to do so and to act accordingly.

IV. Although the thesis is often heard that applicant should know right from the moment of filing his patent application what he has invented and what he wants to be protected, it is fully realised that there are many situations where this is rather theory than reality.

Therefore it seems to be justified and in the applicant's interests to enable him to redefine his invention and, if necessary, to shift the ground after the results of the novelty search have been communicated to him.

On the other hand it is felt that in the legitimate interests of third parties, there should also be a moment at which applicant's freedom as to shifting the ground comes to an end.

It is considered that the interests of both applicants and third parties are adequately acknowledged by adding to Article 83 of the Second Preliminary Draft a third paragraph as given in Appendix A. Corollary to this third paragraph is a fourth one, given in the same Appendix.

There is, of course, a further number of Articles which need adaptation or amendment as a consequence of this change. First of all this applies to Article 94 where paragraph 1 needs an addition. A revised paragraph 1 is given in Appendix B (the suggested addition being underlined). Other articles to be studied closer are e.g. 95 and 95a.

Article 83, paragraph 3

After the request for examination pursuant to Article 80, the claims shall have a binding character, in so far as the contents of the claims ultimately granted shall not differ in essence from the contents of claims at the moment of making the request for examination, read in context with the description and drawings.

Article 83, paragraph 4

The claims in force pursuant to paragraph 3 will be published by the European Patent Office without delay.

Article 94, paragraph 2

Article 81, paragraphs 3 to 5, and Article 83,
paragraph 3, shall apply.

Article 95, paragraph 1(c)

Article 83, paragraph 3, shall apply.
