

# **BR/GT I/131 e/71**

## **Travaux Préparatoires EPC 1973**

### **Comment:**

The collection represents purely an internal research tool for the purpose of Directorate Patent Law of the European Patent Office. No guarantee can be given for its completeness or correctness.

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.

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

Luxembourg, 22 October 1971

BR/GT I/131/71

- Secretariat -

WORKING PARTY I

WORKING DOCUMENT

- SECOND PRELIMINARY DRAFT OF A  
CONVENTION ESTABLISHING A EUROPEAN  
SYSTEM FOR THE GRANT OF PATENTS

Articles	77
	78
	81
	82
	83a
	85
	88
	88a (new)
	91
	92
	93
	94
	96
	97
	101
	101a
	133
	137b (new)
	142

- FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Articles	34, No. 8
	66, No. 1
	88, No. 1
	88, No. 2
	88, No. 3
	145, No. 4a (new)
	145, No. 11
	154, No. 1

- FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

Article 10

(Texts drawn up by the Drafting Committee)

PART V

EXAMINATION, GRANT AND OPPOSITION

CHAPTER I

Procedure prior to the introduction of the request for examination  
Article 77

Examination of the European patent application  
for certain deficiencies

(1) - deleted - (Cf. Article 76a, paragraph 1)

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filing date, and is not deemed to be withdrawn by virtue of  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

- (a) {
- (b) { - deleted -
- (c) {
- (d) {

[(d)bis whether the requirements of Article 154, paragraphs 2  
and 3, have been satisfied;]

(e) whether the application meets the physical requirements  
laid down in the Implementing Regulations to this Con-  
vention for the implementation of this provision;

(e)bis whether the request for the grant of a European patent  
satisfies the mandatory provisions of the Implementing  
Regulations to this Convention concerning its contents;

(f) - deleted -

- (g) {
- (h) { Unchanged from Second Preliminary
- (i) { Draft Convention published 1971

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 [(d)bis], (e), (e)bis and (i), reveals that the European patent application does not meet the requirements to be taken into consideration in this examination, the Receiving Section shall inform the applicant accordingly and invite him to remedy the disclosed deficiencies within such period as it shall specify. 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 Receiving Section. If the deficiencies are not remedied in due time, the Receiving Section shall refuse the application.

(2a)(new) The provisions of paragraph 2 shall not apply where the applicant, while claiming priority, has omitted to indicate in the request for the grant of the European patent the date and country of first filing. In such a case the priority shall be deemed not to have been claimed.

(2b)(new) If priority is claimed and the examination provided for in Article 77, paragraph 2(e)bis reveals that the date of the first filing given in the request for the grant of the European patent precedes the date of filing of the European application by more than

Article 78 continued

the year, the Examining Section shall invite the applicant to renounce the priority claim or, if he has incorrectly indicated the date of the first filing, to specify the correct date. If the applicant fails to comply with this invitation within a period of one month, the priority shall be deemed not to have been claimed.

(3) - deleted -

(4) - deleted - (cf. paragraph 2, third sentence)

(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 Receiving Section 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 date or earliest date of priority, 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.

b) If the examination provided for in Article 77, paragraph 2(h), reveals that the drawings were not filed, the Receiving Section shall invite the applicant to do so within a period of one month.

Article 78 continued

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 reference to the drawings shall be considered as cancelled.

Article 81

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

- deleted -

Article 82

Amendment of documents

(1) Before receiving the report on the state of the art, the applicant may not amend the description, claims or drawings of a European patent application, except where otherwise provided in the Implementing Regulations to this Convention.

(2) The provisions of paragraph 1 shall not prejudice the application of Article 78, paragraph 2.



Article 83a

Prohibition of new content

A European patent application shall not contain subject-matter which extends beyond the content of the application as filed, or if the application is a divisional application, beyond the content of the earlier application as filed.

Article 35

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 as filed and, 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. 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.

(2) { Unchanged from Second Preliminary  
Draft Convention published 1971

(3) If, before the termination of the technical preparation for publication, the claims of the European patent application have been amended pursuant to Article 83 or Article 137b, paragraph 2, the new or amended claims shall be included in the publication in addition to the original claims.

(4) { Unchanged from Second Preliminary  
(5) { Draft Convention published 1971

## CHAPTER II

### Procedure for grant

#### Article 88

##### Request for examination

- (1) ( Unchanged from Second Preliminary  
( Draft Convention published 1971

(2) Such a request may be made by the applicant up to the end of six months after the date on which the European Patent Bulletin notifies the publication of the report on the state of the art pursuant to Article 85, paragraph 5. The request shall not be considered to be made until after the examination fee prescribed by the Rules relating to Fees, adopted pursuant to the Convention has been paid.

- (3) ( Unchanged from Second Preliminary  
( Draft Convention published 1971

- (4) - deleted -

- (5) ( Unchanged from Second Preliminary  
( Draft Convention published 1971

- (6) - deleted -

- (7) ( Unchanged from Second Preliminary  
( Draft Convention published 1971

Article 88a (new)

Amendment of the period within which a request  
for examination may be made

(1) The Administrative Council may extend the period laid down in Article 88, paragraph 2, within which a request for examination may be made:

- a) if it is established that European patent applications cannot be examined in due time, or
- b) if an extension is in the general interest.

(1a) If the Administrative Council takes the decision referred to in paragraph 1, it may decide that third parties will be entitled to make a request for examination. In such cases, it shall determine the appropriate rules in the Implementing Regulations.

(2) The decisions referred to in the preceding paragraphs shall be published in the Official Journal of the European Patent Office.

Any decision of the Administrative Council pursuant to paragraph 1 shall apply only in respect of European patent applications filed after the publication of such decision.

(4) If the Council takes a decision referred to in paragraph 1 (a) it must lay down measures with a view to restoring the period referred to in Article 88, paragraph 2, as soon as possible.

Article 91

Publication of a request for examination

Notification of the request for the examination of a European patent application shall be entered in the Register of European Patents and published in the European Patent Bulletin.

Article 92

Reply of the applicant for a European patent

(1) If the applicant has made the request for examination before the report on the state of the art has been communicated to him, the European Patent Office shall invite the applicant to state, within a period to be determined, whether he desires to proceed further with his application, and to comment, within the same period, on the report on the state of the art and any observations communicated to him, and where necessary to amend the description, claims and drawings.

(2) If the applicant does not indicate within the period fixed in paragraph 1 that he wishes to proceed further with his application, the application shall be deemed to be withdrawn.

Article 93

Examination of a European patent application

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

- (a) on receipt of a request for examination made after the report on the state of the art has been communicated to the applicant; or
- (b) 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 94

Division of a European patent application  
after request for examination

- deleted -



Article 96

Refusal of a European patent application

- (1) ( Unchanged from Second Preliminary  
( Draft Convention published 1971
- (2) - deleted - (Cf. Article 139)  
- *deleted* -
- (3) ~~The decision shall be communicated to the applicant.~~
- (4) - deleted - (Cf. Article 86).

Article 97

Grant of the European patent

(1) If the Examining Division is of the opinion that the application and the invention to which it relates meet the requirements of this Convention, it shall inform the applicant of the text in which it intends to grant the European patent. The applicant shall at the same time be requested to pay, within a period of one month, the fees prescribed for grant and printing by the Rules relating to Fees adopted pursuant to this Convention.

(2) ( Unchanged from Second Preliminary  
( Draft Convention published 1971

(3) When the fees for grant and printing and the fees already due under Article 129 and Article 130 have been paid, the Examining Division shall grant the European patent for the Contracting States designated in accordance with Article 67. The decision shall be communicated to the applicant.

(4) ( Unchanged from Second Preliminary  
( Draft Convention published 1971

### CHAPTER III

#### Opposition procedure

##### Article 101

##### Opposition

(1) Within a period of nine months from the date of the publication pursuant to Article 97, paragraph 4, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be given in a reasoned statement. It shall not be deemed to have been given until the fee prescribed by the Rules relating to Fees adopted pursuant to this Convention has been paid.

(1a) ( Unchanged from Second Preliminary  
( Draft Convention published 1971

(1b) Article 23, paragraphs 2, 3 and 4 shall apply mutatis mutandis to any transfer of the European patent made during the period mentioned in paragraph 1 or during opposition proceedings.

(2) ( Unchanged from Second Preliminary  
( Draft Convention published 1971  
(3)

Article 101a.

## Grounds for opposition

Opposition may only be lodged on the grounds that:

- (a) ( Unchanged from Second Preliminary  
( Draft Convention published 1971  
(
- (b)
- (c) the subject-matter of the European patent extends beyond the content of the application as filed, or if the patent was granted on a divisional application, beyond the content of the earlier application as filed.

## PART VII

### REVOCATION OF THE EUROPEAN PATENT

#### Grounds for Revocation

- (1)
  - (a) { Unchanged from Second Preliminary Draft Convention published 1971
  - (b) {
  - (c) if the subject-matter of the European patent extends beyond the content of the application as filed, or if the patent was granted on a divisional application, beyond the content of the earlier application as filed;
  - (d) {
- (2) { Unchanged from Second Preliminary Draft Convention published 1971

Article 137b (new)

European divisional applications

(1) A European divisional application may be filed in respect of subject-matter contained in an earlier European patent application;

- (a) at any time; nevertheless, after the start of the examination proceedings only if the Examining Division considers it to be justified;
- (b) within two months of the invitation of the Examining Division, if the European application does not meet the requirements of Article 70.

(2) The claims of the earlier application and any divisional application shall exclude the matter for which protection is sought by any of the other applications. Where possible, the description and drawings of each application shall relate only to the matter for which protection is sought by that application. However, when it is necessary for an application to describe the matter for which protection is sought 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 filing of the earlier 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 earlier application as filed.

(4) 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.

Article 142

Restitutio in integrum.

- (1) (
- (2) ( Unchanged from Second Preliminary  
Draft Convention published 1971
- (3) (
- (4) (

(5) The provisions of the present Article shall not be applicable to the time limits specified in Article 66, paragraph 3, Article 73, paragraph 1, Article 75, paragraph 1, Article 88, paragraph 2 and Article 137b, paragraph 4.

- (6) ( Unchanged from Second Preliminary  
( Draft Convention published 1971

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 34,  
No. 8

Language used in the event of the division of  
European patent applications

The European divisional applications referred to in Article 137b of the Convention, or, in the case referred to in Article 34, paragraph 2, of the Convention, the translation thereof, must be filed in the initial language of the proceedings for the earlier application for a European patent.



## EC. 1

(1)

(2)

(a)

(b)

(c)

(a)

(e) where appropriate, indication that the application constitutes a divisional application. In such cases the request shall indicate the number of the patent application to which the divisional application refers;

(f)

(5)

(h)

(i)

(3)

(a)

(b)

Unchanged from First Preliminary  
Draft Implementing Regulations  
published 1971

Unchanged from First Preliminary  
Draft Implementing Regulations  
published 1971

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 38

No. 1

Form of the request for examination

A request for the examination of a European patent application must be submitted in writing.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 83

No. 2

Refusal of a request for examination

- deleted -

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 88

No. 3

Continuation of grant proceedings where a request  
made by a third party is invalid

- deleted -

FIRST PRELIMINARY DRAFT IMPLEMENTING REGULATIONS

Re. Article 145

No. 4a (new)

Obvious errors

Obvious linguistic errors, errors of transcription and mistakes in any document submitted to the European Patent Office may be corrected on request. The correction shall be obvious in the sense that anyone would immediately realise that nothing else would have been intended than what is offered as the correction.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 145

No. 11

Noting of certain legal consequences

- (1) {
- (a) { Unchanged from First Preliminary
  - (b) { Draft of the Implementing
  - (c) { Regulations published 1971
  - (c) - deleted -
  - (d) a notice of opposition or appeal is deemed not to have been given;
  - (e) an appellant is deemed to have waived his right to participate in appeal proceedings; or
  - (f) a priority claim is deemed not to have been made under Article 78, paragraph 2a and 2b,

it shall so notify the person concerned in accordance with the provisions of Article 148 of the Convention.

- (2) {
- { Unchanged from First Preliminary +
  - { Draft of the Implementing
  - { Regulations published 1971

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 154

No. 1

Exception to the rules governing compulsory  
representation

- deleted -

FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

Article 10

Partial refund of the fee for obtaining  
the report on the state of the art

(1) A percentage of the fee provided for in Article 2, No. 4, shall be refunded if the report on the state of the art is based on an earlier report on the state of the art already prepared by the International Patent Institute at The Hague on an application whose priority is claimed for the European application or which is the earlier application within the meaning of Article 137b of the Convention.

(2) The fee provided for in Article 2, No. 4, may be refunded partially if the report on the state of the art is based on an international search report prepared under the provisions of the Co-operation Treaty by the International Patent Institute at The Hague or other international searching authority competent to carry out such a search.

(3) The amount of any refund allowed under paragraph 1 or 2 shall be 25, 50 or 75 per cent of the fee provided for in Article 2, No. 4, depending upon the extent to which the International Patent Institute at The Hague benefits from the earlier report or the international search report. The fee shall be entirely refunded if the report on the state of the art relates to a divisional application and is based entirely on an earlier report on the earlier application.

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