

BR/GT I/135 e/71

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

- Secretariat -

Brussels, 9 November 1971

BR/GT I/135/71

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

for the 10th meeting of Working Party I
to be held from 22 to 26 November 1971

Article: 137a

Problem: Amendment of the European patent application and of the European patent

Drawn up by: The German delegation

The delegations to Working Party I will find attached a proposal by the German delegation for the drafting changes to the Articles on the amendment of the European patent application and of the European patent.

BR/GT I/135 e/71 lor/bm

Introductory Notes

At the ninth meeting of Working Party I the German delegation was asked to draw up a proposal for redrafting the provisions on the amendment of the European patent application and of the European patent, i.e. Articles 82, 83 and 95a. This document contains that proposal, synoptically compared with the texts of those Articles as they stand in the published Second Preliminary Draft or in BR/134/71 of 29 October 1971 where appropriate.

In drawing up this proposal, the German delegation also had to take into consideration the relevant provisions of Articles 83a and 104, which concern prohibited extensions of the European patent application and of the European patent.

On the other hand, the proposal by the Netherlands delegation for Article 83 (Working Document BR/GT I/124/71 of 12 October 1971) was not taken into consideration, as the Working Document has not yet been discussed by the Working Party. Any amendments necessitated by the Netherlands proposal may however be subsequently worked into the drafting proposal.

The German delegation would suggest that the new Article on "Amendment of the European patent application and of the European patent", together with the new Article 137b which has already been adopted by the Working Party ("European divisional applications"), be inserted provisionally immediately after Article 137 in the "General provisions governing procedure". The final placing of these Articles can be left to the "toilette finale" next year.

There follows, therefore, a proposal for a new Article 137a "Amendment of the European patent application and of the European patent", which would replace not only Articles 82, 83 and 95a, but also Articles 83a and 104. The arrangement of this Article is that the first paragraph contains the principle, which is equally valid for the European patent application and the European patent, that extension of the subject-matter is prohibited (until now Article 83a and Article 104, paragraph 2), and that each subsequent paragraph states the amendments which are permissible at each stage of the proceedings.

Second Preliminary Draft

Article 83a

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 104, paragraph 2

A European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

Article 82, paragraph 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 for in the Implementing Regulations to this Convention.

Proposal

The adjoining provisions of the Second Preliminary Draft should be deleted and the following new Article inserted in their place:

Article 137a

Amendment of the European patent application and
of the European patent

(1) A European patent application and a European patent may not be amended in such a way that they contain subject-matter which extends beyond the content of the application as filed. A divisional application or a patent granted on the basis of a divisional application shall not contain subject-matter which extends beyond the content of the earlier application as filed.

Note:

Does not concern the
English text.

(2) 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 for in the Implementing Regulations to this Convention.

Second Preliminary Draft

Article 83

(1) After receipt of the report on the state of the art, but before making a request for examination pursuant to Article 88, the applicant may abandon one or more of the original claims of the application or submit new or amended claims.

(2) If the applicant avails himself of the right referred to in paragraph 1, the new or amended claims instead of the original claims shall determine the protection sought in so far as their subject-matter does not extend beyond what was described in the application.

Article 95a, paragraphs 1 and 2

(1) After the request for examination has been made, but not before the applicant has received the report on the state of the art, he may, provided that he has not received the notification referred to in Article 97, paragraph 1, amend the description, the claims and the drawings.

(2) Where the Examining Division considers it necessary for the normal conduct of the proceedings for grant, it may lay down a period for the applicant after the expiry of which amendments to the description, the claims and the drawings may not be made without its consent.

Proposal

(3) After receipt of the report on the state of the art, but before making a request for examination, the applicant may abandon one or more of the original claims of the application or submit new or amended claims. If the applicant avails himself of this right, the new or amended claims instead of the original claims shall determine the protection sought in so far as their subject-matter does not extend beyond what was described in the application.

(4) After receipt of the report on the state of the art, but only if a request for examination has been made, the applicant may, provided that he has not received the notification referred to in Article 97, paragraph 1, amend the description, the claims and the drawings. Where the Examining Division considers it necessary for the normal conduct of the proceedings for grant, it may lay down a period for the applicant, after the expiry of which amendments to the description, the claims and the drawings may not be made without its consent.

Second Preliminary Draft

Article 104, paragraph 1

The claims of the European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred.

Article 82, paragraph 2

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

Article 95a, paragraph 3

The above provisions shall not prejudice the application of Article 88, paragraph 3, Article 92, paragraph 1, and Article 95, paragraphs 1 and 1a.

Proposal

(5) +

Notes:

1. The reference in Article 133, paragraph 1(d), to Article 104 is to be amended to read "Article 137a, paragraph 5".

(6) The above provisions shall not prejudice the application of Article 78, paragraph 2, second sentence, Article 88, paragraph 3, Article 92, paragraph 1, Article 95, paragraphs 1 and 1a, Article 101, paragraph 3, first and second sentences, Article 102, first sentence, and Article 137b, paragraphs 1 and 2.

2. Paragraph 6 refers to a number of provisions in which amendment of the European patent application or of the European patent is referred to as a procedural step which may be taken at the time in question, or in which special rules are laid down for special cases. None of these provisions conflict with the new Article 137a, but it seemed expedient to make it clear that these provisions are to be applied in addition to that Article.

