

BR/GT I/138 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

Brussels, 19th November 1971
BR/GT I/138/71

- Secretariat -

N O T E

Subject: Problems raised at the 9th meeting of Working Party I
and to be examined further at the 10th meeting

Drawn up by the Secretariat

1. At its 9th meeting (12 to 22 October 1971), Working Party I raised a number of problems which it reserved the right to re-examine at a later stage.

Some of these problems, which are listed under item 2(a) on the provisional agenda for the Working Party's 10th meeting (BR/GT I/133/71) are also quoted in the list contained in Annex I to the agenda.

2. The delegations to Working Party I will find on the next page a supplementary list of the problems raised during the drafting of the minutes of the 9th meeting of Working Party I (BR/135/71, which will be available to the delegations on Monday 22 November 1971) after the provisional agenda had been distributed. These problems could be examined by the Working Party after its discussion of item 2(a) on the agenda:

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(Unrevised translation)

- (a) Sanction to be applied in the event of failure to make the compulsory designation of a representative in the application and suitable time limit for making the designation
(Articles 77, paragraph 2(d bis), 78, paragraph 2 and 155, paragraph 3) (point 37 of BR/135/71).
- (b) Refund of the fee for obtaining the report on the state of the art in the event of the application being withdrawn before the IIB has begun the search
(Article 79 of the Convention and Article 10 of the Rules relating to Fees) (point 51 of BR/135/71).
- (c) Liability of the IIB in the event of failure to observe the period of three months for communication of the search report
(Re. Article 79, No. 2, IR) (point 56 of BR/135/71).
- (d) Is the "ex tunc" effect of the revocation of a patent following opposition proceedings to extend to the provisional protection afforded by the patent application on which the patent was granted?
(Article 105a) (point 142 of BR/135/71).
- (e) Problem of the translation of the international application, and particularly of the claims, by the European Patent Office and establishment of the date on which inspection of the dossier on such an application may commence
(Article 123) (points 147 and 149 of BR/135/71).
- (f) Application of the solution adopted in Article 137a, paragraph 2, in the case of a European application for which the priority of another European application is claimed

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

Luxembourg, 24 November 1971

BR/GT I/139/71

- Secretariat -

WORKING PARTY I

WORKING DOCUMENT

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

Articles 19
77
78
80
82
83
83a
95a
104
124
127
133
137b (new)
138
142
150
154

- FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Articles 79, No. 2
80, No. 1 (new)
142, No. 1
145, No. 11
155, No. 2

- FIRST PRELIMINARY DRAFT OF THE RULES RELATIVE TO FEES

Article 2
10

(Texts drawn up by the Drafting Committee)

Article 19

Rights conferred by a European patent application
after publication

- (1) { Unchanged from Second Preliminary
{ Draft Convention published 1971
- (2) { Unchanged from BR/134/71
- (3) { Unchanged from Second Preliminary
- (4) { Draft Convention published 1971

(5) The European patent application shall be deemed never to have had the effects set out in paragraphs 1 and 2 above when:

- (a) the European patent application is withdrawn, is deemed to be withdrawn or has been finally refused, or
- (b) the European patent has been finally revoked in opposition proceedings.

The same shall apply in respect of the effects of the European patent application in a Contracting State the designation of which is withdrawn or deemed to be withdrawn.

Article 77

Examination of the European patent application
for certain deficiencies

- (1) { Deleted (Cf. Article 76a,
paragraph 1)
- (2) { Unchanged from BR/134/71
- (a) {
- (b) {
- (c) { Deleted
- (d) {
- (d bis) whether the requirements of Article 154, paragraph 2,
have been satisfied.
- (e) {
- (e bis) { Unchanged from BR/134/71
- (f) { Deleted
- (g) {
- (h) { Unchanged from BR/134/71
- (i) {

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) 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 right of priority of filing is lost.

(2b) 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 one year, the Receiving Section shall

Article 73 (continued)

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 right of priority of filing is lost.

- (3) (Deleted
- (4) (Deleted (Cf. paragraph 2,
third sentence)
- (5) (Deleted (Cf. Article 139)
- (6) {
(7) (a) { Unchanged from BR/134/71
(b) {

Article 30

Transmission of the report on the state of the art

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

(2) At the same time the International Patent Institute at The Hague shall transmit to the applicant a copy of the report on the state of the art, copies of any cited documents and the definitive contents of the abstract.

Article 82

Amendment of documents

- deleted - (Cf. Article 137b, paragraph 2)

Article 83

Amendment of claims

- deleted - (Cf. Article 137b, paragraph 3)

Article 83a

Prohibition of new content

- deleted - (Cf. Article 137b, paragraph 1)

Article 95a

Amendment of the application

- deleted - (Cf. Article 137b, paragraph 4)

Article 104

Limitation of amendment of the patent

- deleted - (Cf. Article 137b, paragraphs 1 and 5)

CHAPTER VI

CONVERSION OF A EUROPEAN PATENT APPLICATION
INTO A NATIONAL APPLICATION

Article 124

Request for the application of national procedure

(1) Unchanged from Second Preliminary Draft Convention

(2) The request shall be made within a period of three months after the European patent application has been withdrawn or after notification has been made that the application has been refused, or deemed to be withdrawn or that the European patent has been revoked. The effects referred to in Article 76, paragraph 1, shall lapse if the request is not submitted within the prescribed period.

Article 127

Application of national procedure in special cases

If the applicant is notified that the European patent application has been deemed to be withdrawn pursuant to Article 65, paragraph 5, the request provided for in Article 124 shall be submitted within three months to the relevant national central industrial property office. That office shall, subject to the provisions of national security, transmit the request, together with a copy of the European patent application, directly to the national central industrial property offices of the Contracting States specified by the applicant in the request. The effects referred to in Article 76, paragraph 1, shall lapse if such transmission is not made within a period of twenty months as from the date of filing of the European patent application or if a priority has been claimed, as from the date or earliest date of priority.

PART VII

REVOCATION OF THE EUROPEAN PATENT

Article 133

Grounds for revocation

(1) { Unchanged from BR/134/71

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

(b)

(c) { Unchanged from BR/134/71

(d) if the protection conferred by the European patent has,
contrary to Article 137b, paragraph 5, been extended during
opposition proceedings;

(e) if the proprietor of the European patent is not entitled
under Article 15.

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

Article 137b (new)

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.

(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 this Convention or in the Implementing Regulations.

(3) After receipt of the report on the state of the art, but before receipt of the first notification of the Examining Division, 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.

Article 137b (continued)

(4) After receipt of the first notification from the Examining Division, the applicant may of his own volition, amend once the description, the claims and the drawings. No further amendment may be made without the consent of the Examining Division.

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

Article 138

Different claims and description for different States

If the European Patent Office notes that in respect of one or some of the Contracting States designated in respect of a European patent application or patent, the contents of an earlier European patent application form part of the state of the art under Article 11, paragraphs 3 and 4, the applicant or patentee may submit different claims effective for such State or States. In such a case, where the European Patent Office considers it necessary, a different description or drawings shall be submitted for such State or States at the request of that Office.

Restitutio in integrum

(1) The applicant for or proprietor of a European patent who is prevented by force majeure from observing a time limit shall, upon application, have his rights re-established if the non-observance in question has the direct consequence, by virtue of the provisions of this Convention, of causing the refusal of the European patent application, or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress.

(2)

(3)

(4)

(5)

{
{ Unchanged from Second Preliminary
{ Draft Convention published 1971
{
{
{
{ Unchanged from BR/134/71

(6) Any person who, in a Contracting State, has in good faith exploited or made effective and serious preparations for exploiting an invention which is the subject of a published European patent application or a European patent in the course of the period between the loss of rights referred to in paragraph 1 and publication of re-establishment of those rights, may freely continue such exploitation in the course of his business or for the needs thereof.

Article 150

Information concerning national applications.

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

(2) If the applicant fails to submit an answer in response to a request under paragraph 1, the European patent application shall be deemed to be withdrawn.

Article 154

Compulsory representation

- (1) {
- (2) {

Unchanged from Second Preliminary
Draft Convention published 1971

(3) Subject to any exceptions permitted in the Implementing Regulations, and with the exception of the filing of the European patent application, persons referred to in paragraph 2 above may only act vis-à-vis the European Patent Office through their representative.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS-

Re. Article 79

No. 2

Time limit for the report on the state of the art

- deleted - (Cf. Re. Article 80, No. 1)

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 80 (new)

No. 1

Period for the transmission
of the report on the state of the art
to the European Patent Office

The International Patent Institute at The Hague shall be obliged in respect of the European Patent Office to transmit to the latter the report on the state of the art, the copies of any cited documents and the definitive contents of the abstract no later than three months after the date on which it has received from the European Patent Office the documents needed to draw up its report.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 142

No. 1

Restitutio in integrum

(1) Applications for re-establishment of rights shall be presented in writing. Such applications shall not be considered to be made until after the fee prescribed by the Rules relating to Fees adopted pursuant to the Convention has been paid.

(2) If an application for re-establishment of rights is granted, an entry to this effect shall be made in the Register of European Patents and published in the European Patent Bulletin, provided that an entry has been published in accordance with Article 86 of the Convention.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 145

No. 11

Noting of certain legal consequences

(1) If the European Patent Office notes that:

(a) (Unchanged from First
(Preliminary Draft of the
(b) (Implementing Regulations
(published 1971

(c) - deleted -

(d) (Unchanged from First
(Preliminary Draft of the
(e) (Implementing Regulations
(published 1971

(f) the right to claim priority of filing is lost,

(g) a request under Article 88, paragraph 2, or an application under Article 142 is considered not to have been made or a request under Article ... (Re. Article 136, No. 7) of the Implementing Regulations is deemed not to have been submitted,

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 155

No. 2

Time limit for lodging authorisations

- (1) (Unchanged from First Preliminary
(Draft of the Implementing
(Regulations published 1971

(2) If such authorisation is not lodged in due time, any procedural steps other than the filing of the application taken by the representative shall be deemed not to have been taken.

FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

Article 2

Fees provided for in the Convention and in the
Implementing Regulations

21. Fee for an application for re-establishment of rights
(Article ... (Re. Article 142, No. 1) of the Implementing Regulations

FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

Article 10

Refund of the fee for
the report on the state of the art.

- (1) {
- (2) { Unchanged from BR/134/71
- (3) {

(4) The fee provided for in Article 2, No. 4, shall be fully refunded if the European patent application is withdrawn or refused or deemed to be withdrawn at a time when the International Patent Institute at The Hague has not yet begun to draw up the report on the state of the art.

Notes to Article 10:

1. - deleted -

2. Unchanged from First Preliminary Draft of the Rules relating to Fees published 1971.

