

BR/GT I/145 e/72

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

Brussels, 14 February 1972
BR/GT I/145/72

- Secretariat -

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

for the 11th meeting of Working Party I,
to be held from 28 February to 3 March 1972

Subject: Suggestions for dealing with some of the questions
that the Conference referred to Working Party I for
discussion at its 11th meeting

Submitted by: The Chairman of Working Party I

BR/GT I/145 e/72 ley/KL/prk

Foreword

At its 5th Meeting, held from 24 January to 4 February 1972, the Inter-Governmental Conference instructed Working Party I to re-examine a number of the provisions of the Second Preliminary Draft of a Convention establishing a European System for the Grant of Patents and the Implementing Regulations thereto.

This Working Document submitted by the Chairman contains suggestions for dealing with some of these questions, and is intended as an aid to Working Party I in carrying out the work on the agenda for its 11th meeting, to be held from 28 February to 3 March. These suggestions should in no way be regarded as encroachments on the reserves of the reporting delegations.

1. Article 9

The Chairman considers that as paragraph 2 of this Article contains a ruling on exclusions it should be interpreted strictly, as in any case of exclusion. On the other hand, it must not be possible to interpret the list contained in Article 9, paragraph 2, as an exhaustive catalogue. The corollary to such an interpretation, i.e. that everything not listed in paragraph 2 or in Article 10 is to constitute a patentable invention, must be excluded. For these reasons the Chairman recommends the retention of the words "in particular" in the introductory clause of this paragraph.

In order to take partial account of the views expressed by the international organisations and of the wishes of the Yugoslav delegation, the Chairman suggests that sub-paragraphs (a), (d), (f) and (g) be combined, a limitation be placed on computer-programmes, sub-paragraph (b) be worded more generally to cover scientific discoveries, sub-paragraph (e) be clarified, and the order of the individual sub-paragraphs be changed. He considers that Article 9, paragraph 2, should read as follows:

"(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:

- (a) mere discoveries;
- (b) purely aesthetic creations;
- (c) scientific theories, mathematical methods, schemes, rules or methods of doing business, performing purely mental acts or playing games, computer-programmes as such and mere presentations of information;
- (d) cures for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods which may be carried out on the human or animal body.

2. Articles 11, 13 and 21

In the light of the experience gained in Sweden, the Chairman considers it unnecessary to amend Articles 11 and 13 to the effect that the applicant may not have one of his own earlier patent applications cited against him as prejudicial to novelty (problem of self-collision), nor, in view of the abuses and legal difficulties that this might give rise to, does he consider it desirable.

The Chairman suggests however that the applicant should, as a compensation, be allowed patents of addition to the extent previously provided for in Article 21 of the Second Preliminary Draft (published text). The Chairman is also aware that the only benefits that the applicant would derive from the re-introduction of the right to apply for patents of addition up to the time of publication of the parent patent would be of a financial rather than a legal nature.

BR/GT I/145 e/72 ley/KM/prk

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3. Article 15, paragraph 1, third sentence

- (a) The Chairman suggests deleting this sentence completely in the anticipation that jurisprudence will solve the problem of simultaneous invention by different people.
- (b) In the event of the provision of the third sentence of Article 15, paragraph 3, being retained, the following drafting is suggested:

"If several persons have made an invention independently of each other, the right to the European patent shall belong to the person who filed his patent application with the European Patent Office on the earliest date, unless the patent application has not been published pursuant to Article 85, paragraph 4."

4. Implementing Regulations; Re. Article 16, No. 1

The Chairman recommends the insertion of a new paragraph 3a, reading as follows:-

"(3a) When giving a decision on the suspension of proceedings for grant pursuant to paragraph 1, the European Patent Office may set a date on which it intends to continue proceedings for grant regardless of the stage reached in the proceedings for claiming entitlement to the European patent. That date is to be communicated to the claimant and to the applicant. If no final decision has been taken by that date, the European Patent Office may continue proceedings for grant with the applicant."

Reference should also be made to the new paragraph 3a quoted above in Re. Article 16, No. 3, paragraph 4.

5. Article 18 in conjunction with Article 97

The Chairman suggests solving the problem raised by CEIF by expanding Article 19, paragraph 1, as follows:

"(1) A European patent application shall, from the date of its publication under Article 85 up to the date of publication of the notification of grant of the European patent, provisionally confer upon the applicant such protection as is conferred by Article 18."

6. Article 20

The Conference and the interested circles agree that the interpretation of the European patent should strike a happy medium between the present wide interpretation given to German patents by the German courts and the British courts' interpretation of British patents, strictly limited as it is to the wording of the claims.

The Chairman is of the opinion that the first sentence of Article 20, paragraph 1, will exclude the wide German interpretation (general inventive idea). In order to attenuate the narrower British interpretation, the Chairman suggests, in accordance with proposals made by several of the international organisations in BR/165/72, that Article 20, paragraph 1, could be extended and would then read as follows:

"(1) The extent of the protection conferred by a European patent shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims, so that the extent of the protection shall not be restricted to the framing of the claims."

The Chairman also suggests including a provision corresponding to Article 20, paragraph 1, in the Second Convention, so that by applying Art. 77 of the Second Convention, a decision by the Court of Justice of the European Communities on the interpretation of this provision can in any event be obtained in respect of the Common Market. It might be anticipated that such a decision will also influence the interpretation of this provision in those Contracting States which are parties to the First Convention but not Member States of the European Communities.

7. Article 34, paragraph 3

The Chairman suggests deleting the second half of the first sentence of Article 34, paragraph 3, as the rule envisaged for internal proceedings before the European Patent Office may be dispensed with. Re. Article 34, No. 1, of the Implementing Regulations deals with the question of the position of a European application in a language not envisaged as one of the working languages of the European Patent Office vis-à-vis the translation of that application into one of the working languages.

The Chairman considers however that it would be advisable to make it quite clear which version is to be authentic in connection with infringement proceedings on the basis of the provisional protection under Article 19. He therefore suggests that the following new paragraph 4a be added to Article 19:

"(4a) For the purpose of asserting the right conferred by a European patent application, the text of the application in the language of the proceedings shall in cases of doubt prevail."

8. Article 56, second part of paragraph 2, sub-paragraph (c)

In the opinion of the Chairman, sub-paragraph (c) should be retained. It deals solely with the case referred to in Article 97, paragraph 2, in which the Examining Division grants the European patent in spite of the fact that the applicant has given notice, within the time limit set in Article 97, paragraph 1, that he does not agree to the European patent being granted in the text in which it is intended to grant it. In such a case the applicant must have the opportunity to appeal against the grant of the European patent, and the decision should be taken by a Board of Appeal composed of two technically qualified members and one legally qualified member.

Sub-paragraph (c) is not applicable to appeals against decisions taken in opposition proceedings, as may be seen from the wording of the second part of the paragraph.

9. Article 59, paragraph 1, second sentence

The Chairman recommends retaining this provision without amendment. It is in conformity with both Article 23, paragraph 4, and Article 149, paragraph 6.

According to Article 23, paragraph 4, a transfer has effect vis-à-vis the European Patent Office once the latter has received the documents verifying the transfer. To this extent entry of the transfer in the Register of European Patents is therefore not required. It may be assumed that at this stage of the proceedings, before publication of the patent application, there is no need to make it easier to prove to third parties by means of an entry in the Register that the transfer has been made.

Article 149, paragraph 6, deals with a case which is entirely unrelated to the entry of the application in the Register of European Patents. The communication or publication of the particulars listed in Article 149, paragraph 6, has nothing to do with the entry in the Register, as it merely constitutes a communication of information from the application files.

10. Implementing Regulations; Re. Article 66, Nos 1 to 8

The interested circles proposed taking the provisions of Re. Article 66, Nos 1 to 8 out of the Implementing Regulations, and empowering the President of the European Patent Office to adopt corresponding provisions as rules governing European filings.

The Chairman advises against removing these provisions from the Implementing Regulations, as this would leave open many questions regarding the form and content of European applications, which would be of great practical importance, until the entry into force of the Convention, and this could give rise to uncertainty among the interested circles.

Instead, the Chairman suggests including a provision in the Convention, under which the Administrative Council could authorise the President of the European Patent Office to adopt and amend the rules laid down in Re. Article 66, Nos 1 to 8, of the Implementing Regulations as rules governing European filings.

11. Implementing Regulations; Re. Article 66, No 3

Contrary to the proposal put forward by CNIPA, the Chairman recommends the retention of paragraph 1.

On the other hand the Chairman suggests compliance with the wish expressed by the overwhelming majority of the international organisations that paragraph 3 (b) should be deleted.

12. Article 67, paragraph 2, second sentence

The Chairman first suggests retaining the provision of the second sentence of Article 67, paragraph 2, in order to ensure compatibility with the PCT. He admits however that it is illogical to set the applicant a time limit for the payment of the filing and search fees, which may well not expire until 13 months after the priority date, whereas the same applicant has in any case to pay the designation fee within 12 months of the priority date. Should the Working Party consider an amendment expedient in the light of this, the second sentence of Article 67, paragraph 2, could be re-worded to read as follows:

"If payment is not made within a period of twelve months as from the date of filing or, if a priority has been claimed, as from the date or earliest date of priority, or within the period specified in Article 66, paragraph 3, if the latter period expires after the former, the designation shall be deemed to be withdrawn."

The Chairman points out however, that a PCT applicant could be misled by such a provision (cf. PCT Rule 15.4 (b)).

13. Article 71

The Chairman approves of the proposal by CNIPA that the depositing of microbiological cultures should be prescribed where a European patent is applied for in respect of the invention of a microbiological process. The specimens should be deposited with an official body in a Contracting State. The Banks Report should be referred to for the arguments on this subject.

If the Working Party adopts such a provision, its place should be in the Implementing Regulations.

14. Implementing Regulations; Re. Article 71, No 1, paragraph 5

One international organisation pointed out that the sanction laid down in this provision is too strict. The Chairman shares this point of view and suggests that paragraph 5 be re-drafted as follows:

"(5) Any further claim shall be deemed not to have been filed if the fee for such claim is not paid in due time."

15. Implementing Regulations; Re. Article 145, No 4 (a)

The Chairman recommends that the second sentence be deleted on the grounds that this provision can be interpreted too restrictively, especially in the case of the applicant having made a mistake in the declaration of priority with regard to the date or State of the first filing.

16. Article 75, paragraph 2 (a)

The Chairman suggests that the period for producing a translation of the first application into the language of the proceedings should be 20 months (instead of 16 as at present). He also considers that initially the only obligation on the applicant should be that of filing a translation prepared by him. Nevertheless, the European Patent Office should have the power to require that this translation be certified at a later date.

The Chairman therefore suggests that paragraph 2 (a) be re-drafted as follows:

"(2(a)) In the case where the language of the first application is not one of the languages referred to in Article 34, paragraph 1, the person making a declaration of priority shall also produce, within twenty months after the priority date, a translation of the first application in the language of the proceedings. The European Patent Office may require that a document certifying that the translation corresponds to the original text be produced at a later date within a period to be determined by the Office. Failure to produce the translation or the later certificate in due time shall lead to the loss of the right to claim priority of filing."

The Chairman considers that the cost of the translation should not be borne by the European Patent Office.

17. Article 78, paragraph 7(a)

The Chairman suggests that the Working Party comply with the request of some of the international organisations that an applicant filing drawings after the filing date but before the examination for formal deficiencies may have the option of dispensing with these drawings in order to retain the initial filing date. The Chairman therefore proposes the following wording:

"(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 Receiving Section shall notify the applicant that the application is to be redated to the date on which the drawings were filed, unless the applicant requests, within a period to be determined by the Receiving Section, that the drawings be deemed not to have been filed and any references to the drawings in the patent application be deemed to be deleted. If such a request is not made in due time, the application shall be redated to the date on which the drawings were f filed."

18. Article 79, paragraph 4a, second sentence

The Chairman suggests that the problem raised in connection with Article 79, paragraph 4a, second sentence, be solved by adding a new paragraph 2 as follows to Article 66:

"(2) For the purposes of Article 11, paragraph 3, the abstract shall not form part of the European patent application. It shall merely serve for use as technical information; it may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought."

The second sentence of the above proposal corresponds to Article 79, paragraph 4a, second sentence. The latter would have to be deleted if the proposal were adopted.

Article 78, paragraph 2, and Article 95 are not affected by the amendment proposed by the Chairman.

19. Article 79, paragraph 5

For the purpose of alignment on Rule 40.3 of the Regulations under the PCT the following wording is suggested for the last part of the first sentence of this paragraph:

"it shall notify the applicant that if reports on the state of the art are to be drawn up in respect of the other inventions the necessary fees for obtaining such reports must be paid within the period provided for in the Implementing Regulations."

The following new provision should be added to the implementing regulations to Article 79:

"Re. Article 79, No. 5
Period for the payment of the fee under Article 79,
paragraph 5

The period provided for in Article 79, paragraph 5, shall be determined by the International Patent Institute; it shall not be shorter than two weeks and shall not exceed six weeks."

20. Article 88, paragraph 2

In the view of the Chairman, the proposal to provide that the applicant is to be informed of the expiry of the period for making a request for examination, can be met by adding a new paragraph 6 as follows to Article 85:

"(6) The European Patent Office shall inform the applicant of the publication of the European patent application or, if the report on the state of the art is published at a later date, of the publication of the latter, and shall at the same time inform him of the date of expiry of the period for making a request for examination pursuant to Article 88, paragraph 2."

21. Article 97, Article 105, paragraph 3, and Article 107a, paragraph 1

The international organisations rightly pointed out that the 3 month period provided for in Article 107a, paragraph 1, following the notification referred to in Article 97, paragraph 1, where the applicant does not approve of the text in which it is intended to grant the patent. In such a case the examination procedure would have to be continued. Before the patent is granted, the notification under Article 97, paragraph 1, and the request to pay the fees for grant and printing will have to be repeated. It was also pointed out that Article 105, paragraph 3, is incomplete, as it does not make provision for the eventuality of the proprietor not approving of the text in which the Opposition Division intends to grant the patent.

The Chairman proposes the following amendments to remove these difficulties.

- (a) Article 97, paragraph 2, should end at the word "withdrawn", thus reading as follows:

"(2) If the fees for grant and printing are not paid in due time, the European patent application shall be deemed to be withdrawn."

- (b) A new paragraph 2a worded as follows should be added to Article 97:

"(2a) If the applicant communicates to the European Patent Office his disapproval of the European patent being granted on the basis of the text mentioned in paragraph 1 within the period referred to in that paragraph, the examination shall be continued; in such cases the period referred to in paragraph 1 shall be deemed not to have been laid down."

- (c) The following new sentence should be inserted between the first and the second sentences of Article 105, paragraph 3:

"Article 97, paragraph 2a, shall apply mutatis mutandis."

- (d) Article 107a, paragraph 1, should read as follows:

"(1) Any Contracting State may prescribe that if the text, in which the Examining Division intends to

grant a European patent for that State or in which the Opposition Division intends to maintain a patent as amended, is not drawn up in one of its official languages, the applicant for or the proprietor of the patent shall, within a period of three months following the expiry of the period referred to in Article 97, paragraph 1, or in Article 105, paragraph 3, in so far as such period is not deemed not to have been laid down by virtue of Article 97, paragraph 2a, or by virtue of Article 105, paragraph 3, in conjunction with Article 97, paragraph 2a, supply to its central industrial property office a translation of this text into one of its official languages."

22. Article 107a

The Chairman suggests, in conformity with his proposal under point 7 above, that it should be made clear in respect of the granted patent which language should be binding in cases of doubt.

He therefore recommends that the following paragraph 6 be added to Article 107a :

"(6) For the purpose of asserting the rights conferred by a European patent, the text of the patent in the language of the proceedings shall prevail in cases of doubt."

23. Articles 116 and 140

The request of the international organisations that provision should be made for oral proceedings before the Enlarged Board of Appeal would appear to be met by Articles 139 and 140. This leaves the question of whether the application of Article 140 should be restricted. Should it be restricted, the following paragraph 3 would have to be added to Article 140 :

"(3) Oral proceedings shall take place before the Enlarged Board of Appeal at the request of a party to the proceedings only where the Enlarged Board of Appeal considers this to be expedient."

The Chairman has no objection to providing explicitly that any party to proceedings before a Board of Appeal may request that a point of law be referred to the Enlarged Board of Appeal. To avoid delays in the proceedings, the Board of Appeal should be able to refuse such requests in its final decision. The Chairman therefore suggests that the following paragraph 3 be added to Article 116 :

"(3) Any party to proceedings before a Board of Appeal may request that the Board of Appeal refer a point of law to the Enlarged Board of Appeal in accordance with paragraph 1(a). The Board of Appeal shall give reasons in its final decision where it refuses any such request."

24. Implementing Regulations; Re. Article 148, No. 1

The Chairman suggests that the provisions contained in this rule relating to notifications should not be changed. The differences between the provisions on notifications in the PCT and their counterparts under the European system are acceptable, as those under the PCT will apply only to the probably very small number of European filings by which PCT applications are filed directly with the European Patent Office as a PCT receiving Office. In the other cases, in which PCT applications are filed with the European Patent Office as a designated Office, the European provisions on notifications will apply. It should be borne in mind that a majority of the international organisations spoke in favour of the European provisions on notifications.

25. Implementing Regulations; Re. Article 141, No. 3

The Chairman suggests, in line with the suggestions made by the international organisations, that in the second sentence the words "In certain special cases" be deleted and that the words "upon request" be replaced by "upon reasoned request".
