

BR/GT I/150 e/72

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

Brussels, 25 February 1972
BR/GT I/150/72

- Secretariat -

N O T E

Subject: Proposals for Articles 9, 11, 15, 16 18 and 19, 20,
34 and 107a, 106a.

Drawn up by: United Kingdom delegation

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Note by the United Kingdom delegation on points
put to Working Party I
by the Inter-Governmental Conference

ARTICLE 9

In connection with Article 9, paragraph 2, the following suggestions have been made:

1. Delete item (b) and add the words "and discoveries as such" to item (a). We are of the opinion that discoveries are already excluded by the terms of paragraph 1 since they are generally recognised as being distinct from "inventions". We think, however, that the same may also reasonably be said of items (a) and (b). It appears desirable, therefore, to make it quite clear that a discovery is not patentable, even though it does not fall within the wording of items (a) and (b). This could be done by deleting items (a) and (b), but it seems preferable to be more explicit than this and we therefore think it would be advisable to adopt the proposal made.
2. Group the various items together in one sentence. Several of the categories itemised are quite distinct and we see no advantage in redrafting as suggested. On the contrary, such redrafting might affect the interpretation and might lead to difficulties in amending the text at some future date.
3. Delete "or animal" from item (e). We believe this suggestion should be accepted. It is very difficult to make a distinction between methods of treating animal diseases

For humane reasons and methods of treating animal diseases so as to improve the yield or quality of the ultimate product. By ridding an animal of disease it is obvious that the ultimate product will be improved.

4. Restrict item (e) to methods of physical treatment with a view to making patentable new pharmaceutical uses of known substances. Since methods of treatment can only be physical or chemical, it seems to follow by a contrario reasoning, that chemical methods, such as a method for curing an illness by means of a novel or well known drug, are not excluded, though the matter could remain in some doubt since such methods are not, prima facie, of industrial application. We realise that the aim of the proposal is not to stop the dispenser or medical practitioner from practising but to prevent the manufacturer selling the known material as a drug. Since a claim to the material would be invalid, a claim to a method of treating the body would be necessary together with a provision in each national law excluding acts done by the chemist or practitioner but creating a law of contributory infringement applying to this class of case. We recognise the logic of the drug industry's case for patents for such "inventions". However, the existing practice in many countries is to refuse them and we doubt whether public opinion is generally ready for such a change. Adoption of the suggestion might well hinder parliamentary approval of the Convention in several States. Apart from all this, we would remark that there may be much difficulty in deciding whether a treatment is or is not physical, e.g. when the treatment consists of applying an ointment to the skin.

5. Restrict the reference to "diagnostic methods" so that only such methods which are applied to the body are excluded.

We consider that methods which can be used in diagnosis, whether applied to the body or not, are not "susceptible of industrial application" and that many countries would not regard patent protection for them as appropriate. In any case, we think the distinction which this proposal seeks to make is unreal.

6. Group items (d) and (g) together in order to make it clear that only the purely intellectual aspects of computer programs are excluded.

We are opposed to the suggestion. Computer programs fall in a particular category and should, we consider, be presented in isolation. Adoption of the proposal would leave the way open to an interpretation of the text in such a way that it would be possible to get protection for computer programs in a roundabout manner, e.g. by claiming a computer when programmed, the only novelty residing in the program itself.

ARTICLE 11

The Working Party is to re-examine Article 11, paragraph 3, in view of the so-called problem of "self collision". We see no real difficulty in this, particularly since Article 13 gives the applicant the freedom to include non-inventive variants or developments of anything disclosed in a prior, unpublished, European application. Furthermore the priority provisions and

the facilities offered by Article 137a allow the applicant satisfactory devices. We note that without some of these provisions, the Swedish delegation has reported no difficulty in their practice. However, we understand that the French delegation intend to put in a paper explaining the difficulties and proposing a solution by way of amendment of Article 21.

The second question to be examined concerns the proposal to redraft Article 11 so that, although the contents of an earlier European application as defined in paragraph 3, could still be used to destroy the novelty of a later application, the earlier application would no longer be regarded as being in the "state of the art". If this was accepted, the second sentence of Article 13 could be cancelled but, in addition, it would be necessary to make many other changes in the draft Convention, the Implementing Regulations and the Rules relating to Fees wherever the expression "state of the art" is used. Since the effect of the proposal would merely be to remove the "fiction" that a European application is regarded as published as of its priority date, we do not think that this is sufficient to justify making all the changes that would be necessary.

ARTICLE 15

Working Party I has been asked to re-examine the last sentence of Article 15, paragraph 1. This sentence implies that if 2 persons apply on the same day for patents covering the same invention, a patent will only be granted to the one who files first on that day; this is contrary to the "whole day" philosophy enshrined in the draft. Moreover, the sentence

is also inaccurate because, contrary to what it implies, a person ought not to be prevented from obtaining a patent merely because of an earlier application if in fact the latter has been withdrawn, deemed to be withdrawn or refused prior to being published. No doubt the sentence could be amended to meet these defects. However, we would observe that the sentence has no connection with the rest of Article 15 and is also superfluous having regard to Article 11. We strongly prefer therefore to delete this sentence.

ARTICLE 16

In connection with this Article, amendment of the Regulation Re. Article 16, No. 1 has been suggested with a view to eliminating the possibility of suspending proceedings on the original application. It is true that suspension of these proceedings could result in an unwelcome delay in cases where the claimant is acting in a vexatious manner. But we doubt whether there will be many such cases. It seems more likely that claims will be made when there is a reasonable chance of success and, in these cases, we think it would be wasteful of time and effort for the proceedings before the European Patent Office to continue, unless the claimant agrees. We would also point out that continuance of the proceedings on the original application would be inconsistent with Article 16, paragraph 1, in that it would reduce the alternative remedies which this Article makes available to the applicant, e.g. if in continuing the proceedings the European Patent Office had refused the application.

ARTICLES 18 & 19

It has been suggested that, under the terms of the draft Convention, no protection is available under either Article 18 or Article 19 in the period between the grant of a patent and the date of publication of the grant. We believe that this suggestion should be dealt with under Article 97 and that no amendment of Article 18 or 19 is called for to meet this point.

ARTICLES 19, 34 & 107a

It has been suggested that the draft Convention should be clarified as to which language version of a European application or patent is to be regarded as the authentic text in the various situations where translations are required. Treatment of this suggestion involves us in going outside the Articles for which we have some responsibility and dealing also with Article 34.

Article 34, paragraph 3, provides that "..... the text of the application in the language of the proceedings shall be the authentic text". It is clear that this provision applies during the proceedings before the European Patent Office, but we doubt whether its effect goes further than this. We are inclined to the view that it has no legal effect in the Contracting States, but, even if this is incorrect, we would observe that the provision leaves a wide gap in that it applies only to the relation between the application as filed in (say) Italian and the translation thereof provided under Article 34, paragraph 2.

There appears to be nothing in the existing draft defining the authentic text in the case of the publication at 18 months and at grant, though in each case translations of the claims are included (Article 34, paragraphs 5 and 6). Neither is

there any provision dealing with the status of the translations submitted under Article 19, paragraph 4, and Article 107a. We consider, therefore, that there should be a general provision dealing with these cases and that it would be preferable for this provision to deal also with the same problem in connection with the proceedings before the European Patent Office. It seems to us that the principle underlying the provision in Article 34, paragraph 3, is correct and, in general, we think the same principle should be made operable in the designated States. This would then ensure that a uniform text would be effective throughout the territories of the States. Nevertheless, we think that some derogation from this general principle is necessary as the following example shows. Assume that an application is filed in the German language. This will be published in German under Article 98, together with English and French claims as provided for in Article 34, paragraph 6. Sweden may, in accordance with Article 107a, require a translation of the specification into the Swedish language. In the United Kingdom (or Sweden) a firm puts goods on the market believing, as is correct, it is free to do this from a reading of the English (or Swedish) claims. However, because of an incorrect translation, these claims happen to be narrower than the German claims and the nature of the goods is such that they fall within the terms of the German claims. In cases like this, it would seem quite wrong to allow the proprietor to rely in the United Kingdom and Sweden upon the wider German claims as being the authentic text and thus succeed in an infringement action.

We suggest, therefore, the deletion from Article 34, paragraph 3, of the words "and the text of the application in the language of the proceedings shall be the authentic text". In addition, we suggest the insertion of a new Article as follows:

Article 34a

Authentic text of a European application or patent

(1) The text of a European application or European patent in the language of the proceedings, as defined in Article 34, shall be the authentic text in any proceedings before the competent authorities of a designated State and, subject to the exception provided for in the Implementing Regulations, in any proceedings before the European Patent Office.

(2) Nevertheless, the translation, as provided for in this Convention, in the official language of a designated State, shall in that State be regarded as authentic in so far as

- (i) the protection conferred does not extend beyond the protection conferred by, or
- (ii) its subject matter does not extend beyond the content of the application or patent in the language of the proceedings.

ARTICLE 20

Working Party I was entrusted by the Conference with the task of drawing up a declaration for insertion in the minutes of the Diplomatic Conference as to the way it is intended that Article 20 is to be interpreted. Alternatively the Working Party was asked to re-examine the possibility of adding to Article 20 a sentence along the lines of the proposal made in BR/165/72.

We do not approve of the proposal made in BR/165/72 and have found it impossible to redraft it so as to express the required meaning without undue vagueness. We suggest, therefore, that the idea of adding more wording to the present text of Article 20 be dropped and that Working Party I content itself with formulating a declaration of intent. This itself has proved to be no easy task but we are able to suggest the following redraft:

"It is not intended that Article 20 should be interpreted in the sense that the protection conferred is to be that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither is it intended that Article 20 is to be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may go beyond what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, Article 20 is to be interpreted as defining a position between these extremes which combines a fair protection for the applicant with a reasonable degree of certainty for third parties."

ARTICLE 106a

It has been suggested that this Article should be revised so that intervention is to be permitted only if

- (a) it is lodged within 3 months of the commencement of the infringement proceedings and
- (b) the original opposition is still pending before the Opposition Division.

In the interests of avoiding undesirable prolongation of an opposition, we think it is imperative that a third party who intends to intervene should be required to lodge his application for intervention without undue delay. We consider therefore, that condition (a) should be accepted. Moreover, we are of the opinion that condition (b) should be accepted, since this has the merit of preventing intervention at a stage when the original opposition is before the Board of Appeal.

Accordingly, we suggest the following redraft of Article 106a:

(1) Any person who, after opposition proceedings have been instituted against a European patent by another person, provides the European Patent Office with proof that proceedings alleging infringement have been instituted against him, may intervene in the opposition proceedings, provided:

- (i) the opposition proceedings are pending before the Opposition Division, and

(ii) the application for intervention is made within a period of 3 months from the date on which the infringement proceedings were instituted; however, if the infringement proceedings were instituted more than 3 months before expiry of the period prescribed by Article 101, paragraph 1, the application for intervention may be made at any time before such expiry.

It shall be made by means of a reasoned statement and shall not be deemed to have been made until the fee provided for in Article 101, paragraph 1, has been paid.

(2) The provisions of Article 101, paragraphs 2 and 3, Article 101a, Article 101b, Article 102, Articles 103 and 105 shall be extended to cover intervention proceedings.
