

# BR/GT I/151 e/72

## Travaux Préparatoires EPC 1973

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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/151/72

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- Secretariat -

N O T E

Subject: Proposals concerning Articles 137a and 137b,  
Re. Article 141, No. 2 and Article 9 of the  
Rules relating to Fees

Drawn up by: United Kingdom delegation

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NOTE BY THE UNITED KINGDOM DELEGATION

While reserving the right to comment generally on the draft Convention, the United Kingdom delegation would like at this stage to make the following observations on certain Articles.

Articles 137a and 137b

Considering first Article 137b, we would remark that the inclusion of all these provisions in one Article results in confusion, particularly since there are many other provisions in the draft (e.g. Articles 92, 95, 101) which concern amendment of an application or patent. We suggest below a way of overcoming the difficulty.

Article 137b, paragraphs 3 and 4, are intended to allow the possibility for voluntary amendments by the applicant at different stages in the life of the application. We see no need to restrict the applicant to amending his claims in the period covered by paragraph 3. Since, after he has received the first notification from the Office, the applicant is permitted to amend his description and drawings, it also seems pointless to prevent him from doing so under paragraph 3. If the applicant were given the opportunity of amending his description, claims and drawings under paragraph 3, the possibility is opened up of the examiner being in the position of starting his examination on the basis of an application in the form desired by the applicant, after he has considered the contents of the report on the state of the art. This, we believe, is a desirable aim and accordingly we suggest removal from paragraph 3 of the present restriction to amendment of the claims.

The second sentence of paragraph 3 only has relevance to the scope of provisional protection. We think therefore it should be made clear that it applies only to the situation where the applicant amends before the termination of the technical preparations for publication.

We are still not happy with paragraph 4, but judging from the reactions of the other delegates at the January Conference, its removal seems to be a forlorn hope. Nevertheless, we think some amendment of the paragraph is desirable. As the draft stands, an applicant is free to amend voluntarily even after expiry of the time allowed to meet the requirements of the "first notification". This is inconsistent with the scheme laid down in Article 97 when the "first notification" is that provided for in Article 97, paragraph 1. And, if the "first notification" is made under Article 95, amendments made by the applicant after he has responded to the examiner's objections would impede the efficient handling of the application. We suggest therefore that paragraph 4 should be revised so that the opportunity it gives to make amendments is limited to the time allowed for reply to meet the requirements of the "first notification". Secondly, we think the right to make amendments under paragraph 4 should be made subject to the payment of a fee. This should be pitched sufficiently high so as to compensate to some extent for the extra examination work involved and to operate as a means of encouraging applicants to amend under paragraph 3 instead.

Turning now to Article 137a, we suggest that paragraph 1(a) should be redrafted so as to link it more closely with Article 137b, paragraph 4. In view of the above, we suggest the following redrafts for Articles 137a and 137b:

Article 137b

Amendment of the European application  
at the request of the applicant

(1) Delete (Cf. Article 137c)

(2) Delete (Cf. ~~reinstated~~ Article 82)

(3) After receipt of the report on the state of the art  
..... the applicant may of his own volition amend  
the description, claims and drawings. If the applicant amends  
the claims before the technical preparations for publication  
under Article 85 have been completed, the amended claims shall  
determine the protection sought in so far as their subject  
matter does not extend beyond the content of the application  
as filed .....

(4) After receipt of the first notification from the  
Examining Division, the applicant may of his own volition  
amend once the description, claims and drawings, provided  
that the amendment is submitted at the same time as the reply  
to the notification. No further amendment may be made without  
the consent of the Examining Division. Any amendment in  
accordance with this paragraph shall not be deemed to be sub-  
mitted until the fee prescribed by the Rules relating to Fees  
adopted pursuant to this Convention has been paid.

Article 137c (new)

Limitations on amendment

(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, a new application filed in accordance with Article 16, or a patent granted on the basis of either, shall not contain subject-matter which extends beyond the content of the earlier application as filed.

(2) 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

Amendment of European application before  
receipt of the report on the state of the art

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.

Article 137a

European divisional applications

(1) A European divisional application must be filed .....  
in an earlier European application:



(a) at any time after the earlier application has been received by the European Patent Office; nevertheless after receipt of the first notification from the Examining Division, only if the divisional application is filed at the same time as the reply to the notification or the Examining Division considers the filing of a divisional application to be justified.

(b) unchanged.

(2) Unchanged.

(3) Unchanged.

(4) Unchanged.

Re. Article 141, No. 2

It seems evident that in operating the European patent system applicants will make much use of the postal services of the Contracting States. Paragraph 1 of the Regulation, however, only deals with the situation where mail is not delivered in the locality of the European Patent Office and paragraph 2, as we understand it, only deals with late filing with a national Office on account of an interruption in the mail services "in the locality" in which the national Office is situated.

Since, for all practical purposes, the European Patent Office will operate in effect as the national office for a very wide territory, we do not think this Regulation is satisfactory. It should, in our view, recognise the fact that interruptions in the postal services in a Contracting State or between a Contracting State and the European Patent Office are not unlikely, and that such occurrences would cause the same difficulties for applicants as a postal strike in the locality of the European Patent Office itself. We realise that the applicant in such cases may seek re-instatement of his rights under Article 142. But this is subject to important exceptions and, because many applicants could be affected by a postal strike in one of the Contracting States lasting for some weeks, the European Patent Office could find itself inundated with pleas for re-instatement.

We therefore suggest the insertion of a new paragraph 1(a) as follows:

"1(a) If a time limit expires during a period when normal postal services in a Contracting State or between a Contracting State and the European Patent Office are generally interrupted, the time limit shall, in respect of applicants who are residents of that State or have appointed a representative with a place of business in that State, be extended until the first day following expiry of the period of interruption. The European Patent Office shall certify the period during which the postal services were interrupted after taking the advice of the competent authorities of the State concerned."

As a consequence, we suggest the following amendment of Article 141 of the Convention:

"The Implementing Regulations .....

(a) ..... or because mail is not delivered in the localities in which the European Patent Office or such authorities are situated or because there is an interruption in the postal services of a Contracting State or between that State and the locality of the European Patent Office.

(b) Unchanged."

The United Kingdom delegation notes that Article 8, paragraph 3 of the Rules relating to Fees is in some circumstances inconsistent with Article 142 and therefore ultra vires the Convention.

Article 9 of the Rules relating to Fees

We consider this Article to be too harsh in that it requires the full amount of a fee to be paid within the time limit laid down for payment of this fee. While we accept that an applicant should be expected to make every effort to pay the full fee in due time, we think the present rule is unrealistic in that it takes no account of the fact that errors (e.g. in a bank) do occur quite often. It seems to us more equitable for the European Patent Office to point out that the payment made within the period allowed is insufficient in amount and to allow one month for making good the deficiency.

We suggest therefore that Article 9 of the Rules relating to Fees should be amended as follows:

"(1) A time limit for payment shall ..... has been paid in due time. If the fee is not paid in full, the European Patent Office may, where this is considered justified -

- (a) overlook any small amount lacking without prejudice to the rights of the person making the payment, or
- (b) allow the person making the payment a period of 1 month in order to make good the deficit.

(2) Where the application for a European patent designates ..... and should the amount paid, within the period, if any, allowed under paragraph 1(b), be insufficient ....."

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