

BR/GT I/155 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

Luxembourg, 28 February 1972

BR/GT I/155/72

- Secretariat -

NOTE

Subject: Observations on the possibility of using European
patents of addition to solve difficulties arising
from "self-collision"

Drawn up by: French delegation

BR/GT I/155 c/72 lor/IV/prk

Observations on the possibility of using
European patents of addition to solve difficulties
arising from "self-collision"

I. Summary of the problem

To prevent two European patents being granted for the same invention, Article 11, paragraph 3, of the Draft Convention lays down that:

"Additionally, the contents of earlier applications for European patents published on or after the date referred to in paragraph 2 shall be considered as comprised in the state of the art."

This approach, known as the whole contents approach, prevents a claim of the later patent application relying on a description of which the contents were disclosed in the earlier application; although this is severe for the second applicant, it provides a clear solution which is relatively easy to apply; it is also equitable where the inventions which are the subject-matter of the first and second applications are made independently of each other.

Where both applications are filed by the same person and where the second invention has to refer to the description of the first to make its description intelligible, the second invention is dependent on the first and, more often than not, is also an improvement on it; if the applicant is unable to base a claim of the second application both on part of the first application and on the second application, he is at a positive disadvantage. Take the example of a first application A consisting of two parts, I and II, and two corresponding claims, I and II; a second application, B, repeats part

m and adds another part, n; B contains two claims, M' which relates to m but is different from M, and (M+N) which relates to both m and n; under the system as it stands at present in the Draft, claim M' cannot be maintained in application B since part m already appears in the earlier application A; however, it can no doubt be inserted in application A under the conditions laid down in Article 137b; claim (M+N) cannot be maintained either; it will have to be replaced by a claim N, if at all possible, based solely on part n.

II. Conditions which a solution must satisfy

1. Allow the applicant to base the claims of the second application on a text repeating in part the description of the earlier application.
2. Prevent two applications, containing parts of the description which are identical, from being maintained by different applicants.
3. Prevent the total duration of the protection being extended.

III. Possible solutions

1. Prior claim approach

Under this approach, which cannot be fully justified, only the contents of the claims of the earlier patent are excluded. Thus, in the above example, claim M' and claim (M+N) will be valid in application B.

Condition 1 is thus satisfied, but not conditions 2 and 3.

2. Special patent of addition approach

Under this approach, by derogation from the provisions of Article 11, paragraph 3, the contents of earlier European patent applications do not form part of the state of the art with regard to applications for European patents of addition based on such earlier applications.

Claim M' and claim (M+N) will validly be contained in the patent of addition.

Condition 3 is satisfied, since the addition is valid only during a period calculated from the date of filing of the parent application.

Condition 2 is not satisfied, but can be easily if:

- (a) the parent patent and the patent(s) of addition may not be assigned independently of each other;
- (b) conversion of the patent of addition into an independent patent results ipso facto in the loss of the derogation mentioned above.

It should be noted that attaching the patent of addition to the parent patent is facilitated by the very fact that the patent of addition is a special case.

IV. Proposals

1. Article 11, paragraph 3, add at the end:

... subject to the provisions of Article 21, paragraph 2bis.

2. Article 21, paragraph 2 bis (new)

With regard to European patents of addition, the contents of the corresponding parent patent applications published on or after the date referred to in Article 11, paragraph 2, shall not be considered as comprised in the state of the art.

3. Article 23, paragraph 1 bis (new)

An application for a European patent of addition may only be assigned together with the corresponding parent patent application or the parent patent to which it relates.

The question of whether Article 18 of the Second Convention, "Transfer of a Community patent", should be amended in the same respect should be examined by the Working Party preparing that Convention.
