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Comment:

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

Luxembourg, 29 February 1972

BR/GT I/156/72

- Secretariat -

N O T E

Subject: Proposals for Articles 19, 34, 77, 78, 85, 123
and 137b.

Drawn up by: the United Kingdom delegation

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NOTE

from the United Kingdom delegation
concerning proposals for Articles 19, 34,
77, 78, 85, 123 and 137b

At the January Conference, we indicated that we would put to Working Party I some proposals concerning the language of published European applications and the requirements for provisional protection. The broad aim of these proposals is to create a more uniform system for the treatment of European patent applications, PCT applications for European patents and PCT applications for national patents.

According to Article 21 and Rule 48.3 of the PCT, international publication will be effected in English, French, German, Japanese or Russian. There will be no published translations of the claims in any other language. It appears that the States participating in the work of the Conference have thus accepted that a PCT application for national patents in those States shall, when published in one of those languages, be effective in those States as a publication as from the date on which the application is published by the International Bureau. In view of this, we find it difficult to see the need for the provision in Article 34, paragraph 5, that, in the case of an application for a European patent designating the same States, translation of the claims into the other two official languages shall be published. Article 34, paragraph 5,

imposes upon the European applicant the responsibility for supplying these translations. As agreed in January, Article 123, paragraph 5, which puts a similar burden on a PCT application for a European patent, is incompatible with the PCT and will have to be cancelled. It seems to us however, that simply to delete Article 123, paragraph 5, would lead to an undesirable difference in treatment without any compensating advantage. It appears that there is no real need to force a direct European applicant to incur higher costs by the provision of such translations. Moreover, we consider it undesirable that the published form of a European application should differ according to whether the publication is effected under Article 85 of the Convention or under Article 21 of the PCT. Accordingly, we suggest that direct European applications should be published in the language of the application or of the translation provided under Article 34, paragraph 2, translation of the claims into the other two languages referred to in Article 34, paragraph 1, being dispensed with.

As regards the question of provisional protection, it seems evident that publication of a European application in English, French, or German will not be acceptable as sufficient to confer provisional protection in a State having a different official language. In the case of a PCT application for a national patent, PCT Article 29 overcomes this by providing that each designated State may require a translation into its official language of a PCT application designating it. It is open to the State to be more liberal and to require only a translation of the claims. This, we believe, may well be sufficient if the PCT application is published in English, French or German and the designated State is a European State. Consistently with this, we suggest that Article 19, paragraph 4, of the Convention should be widened so as to allow any State the facility of requiring, if

it so wishes, a translation of the claims of a direct European application into its official language.

Finally, we think that PCT applications for a European patent should be dealt with in Article 123 in accordance with the same principles. It has been agreed by the Conference, as mentioned earlier, that Article 123, paragraph 5, must be cancelled, and we see no reason why translations of the claims or of the complete application should be necessary before a PCT publication can, as specified in Article 123, paragraphs 2 and 3, confer any provisional protection. It seems to us that publication under the PCT, whether this publication is in English, French, German, Japanese or Russian, should be equated with the publication of a direct European application by the European Patent Office under Article 85. In order that provisional protection may be conferred by such a PCT publication of a European application in a designated State, it seems to us that the latter should be able to require a translation of the whole application into one of the languages referred to in Article 34, paragraph 1, together with a translation of the claims in its official language.

We suggest, therefore, the following amendments:

Article 34, paragraph 5 - Delete all after "that of the translation".

Article 19, paragraph 4 - amend to read:

"... an official language the language of the application or, in the case referred to in Article 34, paragraph 2, the language of the translation, may stipulate ..."

Article 77, paragraph 2(1) - delete

Article 78, paragraph 3 - delete

Article 85, paragraph 3 - delete "and the translation referred to therein supplied".

Article 137b, paragraph 3 - delete last sentence.

ARTICLE 123

(1) Publication under Article 21 of the Co-operation Treaty of an international application for which the European Patent Office is a designated office under Article 121, paragraph 1, shall take the place of a publication under Article 85.

(2) Nevertheless if the international application is published in a language other than those specified in Article 34, paragraph 1, any Contracting State may, additionally to the provisions of Article 19, paragraph 4, stipulate that provisional protection in accordance with Article 19, paragraphs 1 and 2, shall not be effective until such time as a translation of the international application into one of these languages either has been made available to the public in the manner prescribed by national law or has been communicated to any person using the subject matter of the application in the said State.

