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

Brussels, 10 May 1972
BR/GT I/165/72

- Secretariat -

N O T E

Subject: Proposals concerning Articles 19, 67 and 105 of the Draft Convention (BR/184/72) and the Draft Implementing Regulations (BR/185/72), in particular Article 88

Drawn up by: the United Kingdom delegation

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Proposals drawn up by the United Kingdom delegation
concerning Articles 19, 67 and 105 of the
Draft Convention (BR/184/72)
and the Draft Implementing Regulations (BR/185/72),
in particular Article 88

1. Article 19

The operations of the Receiving Section are now largely of a clerical nature. It has to decide simple questions of fact, e.g. whether the filing and search fees have been paid in time or whether the request for the grant of a European patent contains the information required.

In our view, it is therefore unnecessary - and too expensive - for appeals from the Receiving Section to be heard by a Board of Appeal having the composition set out in Article 19, paragraph 2. It seems to us that it would be preferable to provide for the possibility of a mixed Board of Appeal to deal with such appeals, the actual composition of the Board in a particular case depending upon the facts of that case.

We therefore propose that Article 19 should be amended as follows:

"(1) Unchanged

(2) For appeals from a decision of the Receiving Section, a Board of Appeal shall consist of:

(a) three members, at least one of whom shall be legally qualified;

(b) delete

(3) For appeals from a decision of an Examining Division, a Board of Appeal shall consist of:

(a)

(b)

{ Unchanged

(c) three members, at least one of whom shall be legally qualified.

(4) Unchanged."

2. Article 67

We consider that the first sentence of paragraph 2 should be completed by the words "the latest filed claims contained in the publication under Article 92."

The effect of this is that the provisional protection will be determined by what the early published claims and the claims at grant have in common, thus inhibiting lateral shifts during the examination stage. We do not believe that claims filed after the Article 92 publication, other than the claims in their form at grant, should be taken into account in determining the extent of the provisional protection. This would give rise to complications in calculating the extent of the protection at any given time, particularly when the claims are amended several times; and it would require all the amended claims to be published by the European

Patent Office, as is envisaged by Article 98, paragraph 2, of the Regulations. If our proposal for Article 67 is accepted, we think that Article 98, paragraph 2 of the Regulations should be cancelled.

3. Article 105, paragraph 2

Cases will occur in which an applicant claims priority under Article 86 and the Receiving Section decides under Article 90, paragraph 3, that "the right of priority shall be lost for the application". Such a decision does not terminate the proceedings for the applicant and is therefore not immediately appealable. Having regard to the terms of Article 105, paragraph 2, the applicant is compelled to await a decision to grant or refuse his application before he can question before a Board of Appeal the decision to cancel the priority date claimed. The same applies if the Examining Division decides to cancel the priority date claimed under Article 96, paragraph 1.

If priority is lost, publication under Article 92 will be held up until the expiry of 18 months from the filing date. Also, because there may have been a disclosure between the priority and filing dates, the application may be refused or may proceed to grant but with claims of much narrower scope.

It is clearly undesirable for these effects to occur because of a wrong decision of e.g. the Receiving Section. If the applicant appeals the final decision under Article 105, paragraph 2, and at that time succeeds in his efforts to re-instate his claim to priority, then much time and effort will have been wasted because it will be necessary to re-examine the application.

In order to remedy this situation, we take the view that if there is a decision that priority is lost the possibility of an immediate appeal should be open to the applicant. This requires amendment of Article 105, paragraph 2, but loss of priority is not the only case. Thus, we also consider that the same possibility of immediate appeal should apply in the following cases:

- (i) where the Receiving Section deems the designation of a State to be withdrawn under Article 90, paragraph 4 or 5;
- (ii) where the Receiving Section re-dates the application or deems a reference to drawings to be deleted under Article 90, paragraph 6; and
- (iii) where an original application is refused or withdrawn for some only of the designated States or for part of the subject-matter under Article 59.

The same kind of situation may also arise during opposition proceedings (e.g. where the result is dependent upon which of two patents has the earlier date of priority). It will be appreciated that in oppositions circumstances vary widely from case to case.

It seems to us that there may well be cases, other than those we have specifically mentioned, in which it would also be expedient to provide for the possibility of immediate appeal. In order to avoid difficulties arising from the use of specific wording relating only to particular cases, we therefore propose that Article 105, paragraph 2, should be amended to read:

"A decision which does not terminate proceedings as regards one of the parties can only be the subject of an appeal together with the final decision, unless the authority which gave the decision states in its decision that the time limit of Article 107 runs from the date of notification of that decision."

We would expect that the President would lay down guidelines for use in the European Patent Office which would govern the exercise of this discretion by at least the Receiving Section and the Examining Divisions. In our view, if it appears that time, effort and expense would be saved by allowing an immediate appeal then this should be done.

4. We take the view that the Implementing Regulations should refer throughout to "Rules" rather than "Articles". This would lead to greater clarity and simplify the drafting (e.g. it would no longer be necessary to refer back to the Convention each time the Regulations refer to an Article).

5. Article 88 of the Regulations

We think the square brackets in paragraph 2 of this Article should be deleted. In our view, it would be highly convenient for the examiners to have before them the complete amendments which the applicant, after reflecting upon the search report, wishes to make to his application. Further, we would point out that the European Patent Office could not prevent the applicant proposing amendments to his description and drawings; and there would, in any event, be no point in the European Patent Office returning the proposals to the applicant, since paragraph 4 permits the applicant at a slightly later stage to make these changes.
