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Reports

on the

**Second preliminary Draft of a convention establishing a
European System for the Grant of Patents**

**First preliminary Draft of the Implementing Regulations to
the convention establishing a European System for the
Grant of Patents**

First preliminary Draft of the Rules relating to Fees

BERICHTE

zum

ZWEITEN VORENTWURF EINES ÜBEREINKOMMENS ÜBER EIN
EUROPÄISCHES PATENTERTEILUNGSVERFAHREN

ERSTEN VORENTWURF EINER AUSFÜHRUNGSORDNUNG ZUM ÜBEREINKOMMEN
ÜBER EIN EUROPÄISCHES PATENTERTEILUNGSVERFAHREN

ERSTEN VORENTWURF EINER GEBÜHRENORDNUNG

REPORTS

on the

SECOND PRELIMINARY DRAFT OF A CONVENTION
ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS TO THE
CONVENTION ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT
OF PATENTS

FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

RAPPORTS

relatifs au

SECOND AVANT-PROJET DE CONVENTION INSTITUANT UN
SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS

au

PREMIER AVANT-PROJET DE RÈGLEMENT D'EXÉCUTION DE LA CONVENTION
INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS

et au

PREMIER AVANT-PROJET DE RÈGLEMENT RELATIF AUX TAXES

EINLEITUNG

1. Die Regierungskonferenz über die Einführung eines europäischen Patenterteilungsverfahrens hat auf ihrer 4. Tagung vom 20. bis 28. April 1971 in Luxemburg beschlossen, folgende von ihr vorläufig angenommene Texte zu veröffentlichen:

- den Zweiten Vorentwurf eines Übereinkommens über ein europäisches Patenterteilungsverfahren,
- den Ersten Vorentwurf einer Ausführungsordnung zum Übereinkommen,
- den Ersten Vorentwurf einer Gebührenordnung.

Um die Anhörung der interessierten Kreise zu erleichtern, hat die Konferenz beschlossen, zu diesen Veröffentlichungen Berichte herauszugeben, die Erläuterungen zu den genannten Vorentwürfen enthalten.

Diese Berichte sind in dem vorliegenden Band in deutscher, englischer und französischer Sprache, den Arbeitssprachen der Konferenz, zusammengefaßt⁽¹⁾.

2. Der vorliegende Band beginnt mit einem Bericht über die Tätigkeit der Arbeitsgruppe I, den der Präsident des niederländischen Patentamts (Octrooiraad), Herr J.B. VAN BENTHEM, in seiner Eigenschaft als Generalberichterstatter dieser Gruppe verfaßt hat. Dieser Bericht, mit dem die Beratungen der Konferenz über die Vorentwürfe eingeleitet wurden, ist vor Beginn der 4. Tagung erstellt worden.

Der Bericht gibt einen kurzen Überblick über die Arbeiten, die zur Vorbereitung der 4. Tagung durchgeführt worden sind, wobei die Tätigkeit der Arbeitsgruppe I mit besonderer Aufmerksamkeit behandelt wird.

3. Der zweite Bericht im vorliegenden Band betrifft die Ergebnisse der 4. Tagung der Konferenz. Er ist ebenfalls von Herrn J.B. VAN BENTHEM, und zwar als Generalberichterstatter der Konferenz, verfaßt worden.

Dieser zusammenfassende Bericht behandelt nicht nur die patentrechtlichen Vorschriften, sondern auch andere Kapitel des Zweiten Vorentwurfs des Übereinkommens, über die im vorliegenden Band nicht gesondert berichtet wird (Bestimmungen betreffend den Verwaltungsrat, Finanzvorschriften, Schlußbestimmungen).

4. Es schließt sich eine Reihe von Berichten an, die von der britischen, der deutschen, der französischen, der niederländischen, der schwedischen und der schweizerischen Delegation, aus denen sich die Arbeitsgruppe I

⁽¹⁾ Der Einfachheit halber sind die Texte im vorliegenden Band nacheinander in deutscher, englischer und französischer Sprache wiedergegeben.

INTRODUCTION

1. At its 4th Meeting, held in Luxembourg from 20 to 28 April 1971, the Inter-Governmental Conference for the setting up of a European System for the Grant of Patents provisionally adopted and decided to publish the following texts:

- (i) the Second Preliminary Draft of a Convention establishing a European System for the Grant of Patents,
- (ii) the First Preliminary Draft of the Implementing Regulations to the Convention, and
- (iii) the First Preliminary Draft of the Rules relating to Fees.

The Conference decided that all the reports forming a commentary to the aforesaid texts should be published along with the texts themselves, in order to simplify consultations with the interested circles.

These reports are published together in this volume in English, French and German, which are the working languages of the Conference⁽¹⁾.

2. The volume begins with a report on the activities of Working Party I, drawn up by Mr J.B. VAN BENTHEM, President of the Netherlands Patent Office (*Octrooiraad*) in his capacity as the Working Party's General Rapporteur. This report was used as an introduction to the Conference's discussions on the Preliminary Drafts, and was drawn up before the beginning of the 4th Meeting.

The report outlines the work done in preparation for this meeting, with the accent placed particularly on the activities of Working Party I.

3. The second report deals with the results of the 4th Meeting of the Conference, and was also drawn up by Mr J.B. VAN BENTHEM in his capacity as General Rapporteur for the Conference.

This general report deals not only with the provisions relating to patent law and the procedural provisions, but also with other chapters of the Second Preliminary Draft Convention on which this volume does not contain specific reports (provisions on the Administrative Council, financial provisions and final provisions).

4. There follows a series of reports, drawn up by the German, United Kingdom, French, Netherlands, Swedish and Swiss delegations which form Working

⁽¹⁾ For reasons of convenience, the texts contained in this volume are given in German, English and French, in that order.

INTRODUCTION

1. La Conférence Intergouvernementale pour l'institution d'un système européen de délivrance de brevets a décidé, lors de sa 4ème session tenue à Luxembourg du 20 au 28 avril 1971, de publier les textes suivants, qu'elle a provisoirement adoptés :

- Second Avant-projet de Convention instituant un système européen de délivrance de brevets
- Premier Avant-projet de règlement d'exécution de la Convention
- Premier Avant-projet de règlement relatif aux taxes

La Conférence a décidé de faire accompagner cette publication de celle d'un ensemble de rapports constituant un commentaire aux Avant-projets précités, en vue de faciliter la consultation des milieux intéressés.

Ces rapports se trouvent réunis dans le présent volume en langues allemande, anglaise et française qui sont les langues de travail de la Conférence ⁽¹⁾.

2. Le volume s'ouvre avec un rapport sur les activités du Groupe de travail I, établi par Monsieur J.B. VAN BENTHEM, Président de l'Office néerlandais des brevets (Octrooiraad), en sa qualité de Rapporteur général de ce Groupe. Il s'agit d'un rapport qui a servi d'introduction aux délibérations de la Conférence sur les Avant-projets et qui a été établi avant le début de la 4ème session.

Ce rapport donne un bref aperçu des travaux effectués pour la préparation de cette session, l'accent étant particulièrement mis sur les activités du Groupe de travail I.

3. Le deuxième rapport concerne les résultats de la 4ème session de la Conférence. Il a été également établi par Monsieur J.B. VAN BENTHEM, en sa qualité de Rapporteur général de la Conférence.

Ce rapport de synthèse porte non seulement sur les dispositions relatives au droit des brevets et sur les dispositions de procédure, mais concerne également d'autres chapitres du second Avant-projet de Convention qui ne font pas l'objet de rapports spécifiques dans le présent volume (dispositions concernant le Conseil d'administration, dispositions financières, dispositions finales).

4. Suit un ensemble de rapports, établis par les délégations allemande, britannique, française, néerlandaise, suédoise et suisse qui composent le Groupe de travail I. Ces rapports exposent les modifications et les complé-

(1) Pour des raisons de commodité, les textes que comporte le présent volume sont présentés successivement en Allemand, Anglais et Français.

zusammensetzt, erstellt worden sind. Diese Berichte zeigen die Änderungen und Ergänzungen patentrechtlicher Vorschriften auf, die die Konferenz an dem 1970 veröffentlichten Ersten Vorentwurf des Übereinkommens vorgenommen hat und die im Zweiten Vorentwurf ihren Niederschlag gefunden haben.

5. Der Band enthält ferner einen einführenden Bericht von Herrn P. FRESSONNET, Directeur-adjoint am Institut National de la Propriété Industrielle (Frankreich) und Vorsitzender der Untergruppe Ausführungsordnung, zum Ersten Vorentwurf einer Ausführungsordnung zum Übereinkommen sowie weiter einen Generalbericht von Herrn Dr. R. SINGER, Abteilungspräsident beim Deutschen Patentamt, in dem dieser Vorentwurf erläutert wird.

6. Schließlich ist ein Bericht über die Gebührenordnung wiedergegeben, den Herr P. BRÄNDLI, Vizedirektor des Schweizerischen Patentamts, in seiner Eigenschaft als Vorsitzender der Untergruppe Gebührenordnung erstellt hat.

Party I. These reports set out the amendments and additions that the Conference has made to the provisions relating to patent law and the procedural provisions which were contained in the First Preliminary Draft Convention published in 1970 and which are to be found in the Second Preliminary Draft.

5. The fourth section consists of an introductory report drawn up by Mr P. FRESSONNET, Directeur adjoint at the Institut national de la propriété industrielle (France) and Chairman of the "Implementing Regulations" Sub-Committee, on the First Preliminary Draft of the Implementing Regulations to the Convention, and a general report drawn up by Dr R. SINGER, Abteilungspräsident at the German Patent Office; this forms a commentary to the text in question.

6. Finally there follows a report on the Rules relating to Fees, drawn up by Mr P. BRÄNDLI, Deputy Director at the Swiss Patent Office, in his capacity as Chairman of the Sub-Committee on Rules relating to Fees.

ments que la Conférence a apportés au premier Avant-projet de Convention publié en 1970, pour autant qu'il s'agisse de dispositions touchant au droit des brevets et aux dispositions de procédure et qui figurent dans le second Avant-projet.

5. On trouvera en quatrième lieu, d'une part un rapport introductif concernant le premier Avant-projet de règlement d'exécution de la Convention, établi par Monsieur P. FRESSONNET, Directeur-adjoint à l'Institut national de la propriété industrielle (France), Président du Sous-groupe de travail «règlement d'exécution», et, d'autre part un rapport général établi par Monsieur Dr. R. SINGER, Abteilungspräsident à l'Office allemand des brevets et qui constitue un commentaire audit Avant-projet.

6. Le volume comporte enfin un rapport concernant le règlement relatif aux taxes, établi par Monsieur P. BRÄNDLI, Vice-Directeur du Bureau Suisse des brevets, en sa qualité de Président du Sous-groupe de travail «règlement relatif aux taxes».

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GENERAL REPORT

ON THE ACTIVITIES OF WORKING PARTY I OF THE INTER-GOVERNMENTAL CONFERENCE

RAPPORTEUR: MR J.B. VAN BENTHEM,

*President of the Netherlands Patent Office (Octrooiraad),
as General Rapporteur of Working Party I
of the Inter-Governmental Conference*

I. Introduction

1. At its second Meeting, held at Luxembourg from 13 to 16 January 1970, the Conference approved, and decided to publish a First Preliminary Draft Convention setting up a European System for the Grant of Patents.⁽¹⁾ Since the First Preliminary Draft was only fragmentary, the Conference instructed four Working Parties to continue to study and supplement the draft. Working Party I, which prepared the published First Preliminary Draft, was instructed to continue studying the latter, supplementing it in particular by rules of procedure, by the Implementing Regulations and by the Rules relating to Fees; this Working Party was also given the task of co-ordinating the work of the different Working Parties. Working Party II was instructed to draw up provisions relating to the Administrative Council, final provisions and the Protocol on privileges and immunities. Working Party III was given the task of preparing the Staff Regulations of the officials of the European Patent Office, laying down the general principles relating to their salaries and drawing up the Statute of the Appeals Committee for disputes between the European Patent Office and its staff. Working Party IV was instructed to prepare the Articles relating to financial provisions and the financial planning of the Office.

2. As General Rapporteur of Working Party I, it would not be appropriate for me to report on the outcome of the work of Working Parties II, III and IV: the Conference will be able to evaluate this with the aid of the reports by these Working Parties themselves. In this respect, the duties of Working Party I as Co-ordinating Committee were limited simply to the co-ordination of the work of the three other Working Parties; it made no attempt to evaluate their work and confined itself to co-ordinating the insertion of the Articles

proposed by the latter in the re-cast and completed Draft Convention which it has the honour to submit to you. These other Working Parties were responsible for Articles 35a to 35p (Administrative Council), 39 (Appeals Committee for disputes between the Office and its staff), 41 to 52d (Financial Provisions), 158 (Transitional Provisions: First accounting period) and 161 to 173 (Final Provisions).

3. As regards the work which the Conference entrusted to Working Party I apart from co-ordination, I can also be brief. In view of the volume of work to be carried out within a relatively short period of time, the Working Party formed two Sub-Committees: one for the Implementing Regulations and one for the Rules relating to Fees. Since these Sub-Committees were made up of the same delegations and, partially, of the same experts as the Working Party itself, the latter did not make any attempt to re-examine the work of the Sub-Committees and confined itself to amending a few Articles of the Convention, on the basis of a list of questions raised by the "Implementing Regulations" Sub-Committee. The work of these two Sub-Committees will be explained to the Conference, as will that of Working Parties II, III and IV, in individual reports.⁽¹⁾

4. Returning now to Working Party I, this has held four meetings since the second Meeting of the Conference. The first, from 1 to 3 April 1970, was devoted to a study of the basic features of a financial plan for the European Patent Office. Working Party I worked on the assumption that it would be appropriate to draw up a number of recommendations for Working Party IV, based on considerations in the patents field, and which the latter could act on in carrying out its mandate. The Working Party accordingly made evaluations, in particular of the number of applications for European patents and the number of examiners necessary to examine

⁽¹⁾ First Preliminary Draft of a Convention establishing a European System for the Grant of Patents, published by the Office for Official Publications of the European Communities, Luxembourg, 1970.

⁽¹⁾ The reports of the two Sub-Committees are published in this volume.

these applications. These recommendations have been transmitted to Working Party IV, which used them as a basis for its work. The other three meetings of Working Party I were devoted to the Draft Convention. Apart from a few improvements to the wording of several Articles of the First Preliminary Draft, the activities of the Working Party have had three objectives: to amend the Draft Convention in the light of those observations by non-governmental organisations which were deemed to be well-founded, to supplement the Draft with sections not yet drawn up at that time, and finally to deal with various questions still remaining open. These objectives have, in principle, been achieved and the Working Party has succeeded in preparing a Preliminary Draft Convention, re-cast and completed, which it has the honour to submit to you. In the chapters which follow, I shall give a general idea of the type of amendments and additions inserted in the First Preliminary Draft.

5. The distribution of the provisions between the instruments submitted to you, that is, the Draft Convention and the Draft Implementing Regulations, is only provisional: for the time being, these instruments are intended merely to give a general idea of the matters to be settled. Let me therefore repeat the suggestion made at the second Meeting of the Conference, that is, not to discuss the said distribution and to postpone this discussion until the final revision of the two drafts.

6. This introduction to the General Report cannot be concluded without recording that the discussions took place in an atmosphere of co-operation and understanding between the members of the Working Party and between the members of the Drafting Committee. Nevertheless, the Working Party would not have achieved the results it has without the work of our Chairman, Dr K. HAERTEL and that of the Secretariat. Dr HAERTEL will no doubt be embarrassed to see his name mentioned yet again. It is impossible to imagine, however, that we could have succeeded within such a short space of time without his preparatory documents and his unfailingly efficient and painstaking Chairmanship. As regards the Secretariat, the Working Party holds in high esteem the excellent and indispensable contribution of Mr SAUR and his colleagues to the work.

II. Amendments to the Draft Convention in the light of those observations by non-governmental organisations which were deemed to be well-founded

7. The interested circles submitted their observations on the published First Preliminary Draft Convention in two ways. Their representatives were first consulted on certain fundamental matters relating to the Preliminary Draft at the third Meeting of the Conference, held in Luxembourg from 21 to 23 April 1970. After hearing the points of view expressed by the representatives of the interested circles, the Conference re-examined the questions submitted to them. On certain of these the Conference took decisions that Working Party I was instructed to implement, and the Working Party has been instructed to re-examine other questions. It has carried out this work.

The non-governmental international organisations that had been invited to submit their written observations on the First Preliminary Draft Convention at a later date took up this invitation and had submitted eleven reports by the end of January 1971. The Working Party has examined the reports but has not yet had time to reach a conclusion on all the suggestions that have been made, as some of them require more detailed study. It therefore proposes that you should give it the opportunity to devote further work to the subject, for example as regards the question of the period in which an application for a patent of addition is to be filed, or the more or less related questions of the filing of the European patent application with the national industrial property offices or with the International Patent Institute at The Hague (IIB), the elimination of the special search fee, and the abolition of examination of the application for obvious material deficiencies during the procedure prior to the request for examination. On the other hand, it has been possible to examine many other suggestions; some of them coincide with those made in the course of the consultations that I mentioned before and have been dealt with in this context, but others were new and in the opinion of the Working Party should either give rise to amendments to the text of the Convention or be rejected.

Among the documents submitted to the Conference you will find a summary of Working Party I's proposals in connection with the comments from the international organisations. As General Rapporteur, I shall confine myself to a few important points in respect of which Working Party I has amended the First Preliminary Draft Convention on the basis of the comments from the interested circles.

8. As you will recall, according to the First Preliminary Draft the procedure for the grant of patents carried out by the European Patent Office culminates with a single act in a set of national patents having the same status as patents granted at national level, even as regards their validity. The great majority of the international organisations had come out against this so-called "minimum approach", in particular for reasons of legal security, and had expressed the wish that the validity of the European patent should be subject to uniform criteria, to be laid down in the Convention, in all the Contracting States. The Conference has decided to meet this wish, and consequently Working Party I has drawn up Article 133 which lists the grounds for revocation of the granted European patent by including the main criteria which also govern the grant of the European patent. This so-called "maximum solution" excludes revocation of the European patent for reasons other than those listed in the Convention and could therefore give rise to difficulties in connection with the accession of countries which do not regard food and pharmaceutical products as such as patentable. In order to guard against difficulties of this nature, the Working Party has inserted Article 159 into the Convention, which allows the Contracting States the possibility of a reservation on this point for a limited transitional period; and the Conference should now re-examine the usefulness of this right to make reservations.

9. At the request of the interested circles, the so-called "maximum solution" was also adopted as regards the term of the European patent, and Article 20a now lays down a uniform term of twenty years. This Article, like Article 133 which lists the grounds for revocation, is subject to a safeguard clause, which is to be found in Article 159. It should be noted that Articles 20a and 133 exhaust the maximum solution; Article 2 makes it perfectly clear that otherwise, and in particular as regards the scope of exclusive rights, infringement, licences and the levying of renewal fees, the European patent remains subject to national law.

10. Bearing in mind the fact that as regards regional patents Article 45 of the Patent Co-operation Treaty (PCT) makes the PCT route available only to patents based on a regional patent treaty which guarantees free access to filing, the Working Party has amended Article 5 so that anyone may apply for a European patent.

11. As the opinions of the interested circles were divided about the scope of earlier European patent applications which, under Article 11, paragraph 3, are to be considered as comprised in the state of the art, the Working Party retained this provision, which is based on Article 4 of the Strasbourg Convention of 27 November 1963 on the Unification of Certain Points of Substantive Law on Patents for Invention. Nevertheless, it has mitigated the consequences of the provision in question by adopting in the case of Article 13, the first variant appearing in the Preliminary Draft published in 1970, which excludes these earlier applications when deciding whether there has been an inventive step involved in an invention.

12. In the interests of legal security, particularly with regard to competitors, an overwhelming majority of the organisations had come out in favour of fixing as short a period as possible for the filing of the request for examination. Acting in accordance with the Conference's wishes, the Working Party therefore laid down in Article 88 that the request for examination must be submitted within a period of six months from the date of publication of the International Patent Institute report on the state of the art, otherwise the patent application in question will lapse. This practically eliminates the possibility of deferring examination; the system is now one of compulsory examination, except that it takes place in two stages to allow the greatest economy. As agreed, the Conference is to decide on it in the light of the financial estimates of Working Party IV.

13. Bearing in mind the general lines of thought that had emerged when the international organisations were heard, the Working Party, in accordance with the Conference's decision, has retained the provisions providing for opposition proceedings after the grant of the patent, but it has shortened the opposition period from 12 to 9 months (Article 101) and defined the grounds for opposition to align them with those for revocation of the European patent (Article 101a).

III. Drawing up of new provisions to complete the First Preliminary Draft Convention

14. Apart from Part VII which contains only two Articles (133 and 134) and which is concerned with the revocation of the European patent as I have mentioned above, the Working Party has completed the Draft Convention by adding two new parts, Part VIII (Articles 135 to 156) which contains the Common Procedural Provisions before the European Patent Office, and Part IX (Articles 157 to 160) which contains the Transitional Provisions. The tenth and last part of the Draft contains the Final Provisions drawn up by Working Party II.

15. Part VIII of the Draft consists of the provisions which do not relate specifically to proceedings before a single department of the European Patent Office but are to be applied generally in proceedings before the European Patent Office. Most of these provisions have been taken, with some amendments, from the latest 1965 version of the EEC Preliminary Draft Convention and from the Preliminary Draft by the Member States of the European Free Trade Association. The Working Party has added some other provisions such as Articles 137, 139 and 140 which include the fundamentals of rules provided in the First Preliminary Draft Convention as regulations governing individual procedures but which, being equally valid for all the procedures, would be better placed with the general procedural provisions contained in Chapter I of Part VIII of the Draft. Chapter II concerns the admission of the public, notifications and communications from the European Patent Office. I would point out that Working Party I has added a new (sixth) paragraph to Article 149, providing for an exception to the rule of secrecy of the file before publication of the European patent application: certain information such as the number of the application, the name of the applicant and the title of the invention may be communicated or published as soon as the patent application is filed. Chapter III deals with costs and their enforcement, and Chapter IV with representation before the European Patent Office and authorisation. When drawing up Articles 153 and 154 on representation, the Working Party left untouched the principles contained in the previous drafts mentioned above. The text is only to be regarded as a basis for detailed discussion with the interested circles at a later date. Chapter V contains only one Article (Article 156), which entrusts to the European Patent Office the task of supplying technical opinions on European patents at the request of the national courts trying infringement actions. In addition, on examining Part VIII, Working Party I decided that several of the provisions in this part which touch on civil law will have to be discussed with the government legal experts.

16. Apart from Article 159 which enables acceding Contracting States to make certain reservations, and Article 158 on the first accounting period of the European Patent Office, Part IX of the Draft contains only Articles 157 and 160. The latter give two different courses of action for the initial period of operation of the European Patent Office: it seems out of the question that the European Patent Office will be able to deal with the

examination of all European patent applications from the beginning.

17. In addition to Parts VIII and IX, Working Party I has drawn up Chapter VI of Part V of the Draft on the conversion of a European patent application into an application for a national patent. For reasons of legal security, the possibility of conversion has been restricted exclusively to the cases listed in Articles 65, paragraph 5 (placing of a European application under secrecy) and 157 (refusal of examination during the initial period), but on the other hand there was no wish to prevent the national laws of the Contracting States from providing for other possibilities for conversion.

IV. Discussion of various questions still remaining open

18. In order to clarify the situation regarding the naming of the inventor, the Working Party made it

compulsory in Article 69a to identify the inventor in the European patent application under the same conditions as those required by the Patent Co-operation Treaty.

19. After a detailed study, the Working Party deleted Articles 24 to 27 which cover in particular the mortgaging and distraint of the European patent application, and Article 29 which deals with the supplementary application of national law. A new Article 22a makes it clear that, unless otherwise specified in the Convention, the European patent application as an object of property is subject in each Contracting State to the national law applicable to national patent applications.

20. An examination of the Patent Co-operation Treaty, as signed at the Washington Diplomatic Conference, led to the adaptation of a number of Articles of the Draft Convention.

GENERAL REPORT

ON THE RESULTS OF THE FOURTH MEETING OF THE INTER-GOVERNMENTAL CONFERENCE FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS (LUXEMBOURG, 20 TO 28 APRIL 1971)

RAPPORTEUR: Mr J.B. VAN BENTHEM.

*President of the Netherlands Patent Office (Octrooiraad),
as General Rapporteur
of the Inter-Governmental Conference*

I. SUMMARY OF THE DECISIONS OF THE CONFERENCE

1. After having admitted to the discussions the Principality of Monaco and Yugoslavia, thus bringing the number of European countries participating in the Inter-Governmental Conference to 19, the Conference examined the outcome of the work of the four Working Parties which it had set up. The meeting lasted nine days, during which time the Conference was able to cover all the points on its agenda, thanks to the willingness to co-operate shown by all the delegations, to the excellent guidance of discussions by the President of the Conference, Dr HAERTEL, and to the invaluable work of the Secretariat. The discussions finally gave rise to the following decisions of principle:

(a) The Preliminary Draft Convention establishing a European System for the Grant of Patents, submitted to the Conference for the second time in a redrafted and supplemented text, was adopted subject to a few adaptations for the purposes of a second publication to obtain the views of interested circles. In this connection, the Conference decided to hold a meeting at the beginning of 1972 at which the representatives of the non-governmental international organisations would be able to present their observations on this draft. Working Party I was instructed to continue its study of certain provisions of the Draft Convention.

(b) The Preliminary Draft of the Implementing Regulations, which was submitted to the Conference for the first time, was adopted almost without amendment, for publication at the same time and to the same end as the Preliminary Draft Convention.

(c) The Preliminary Draft of the Rules relating to Fees, also submitted to the Conference for the first time, will be published at the same time; this publication will give the interested circles an idea of the various fees to be paid in proceedings for the grant of European patents as well as of the amounts of such fees.

(d) It was also decided that as a supplement to this information, explanatory reports on the above-mentioned drafts will be published.

(e) The Draft Protocol on the Privileges and Immunities of the European Patent Office was referred to Working Party II for further study in the light of comments put forward.

(f) The principles relating to the Service Regulations of the European Patent Office and in particular the salary scales were approved by the Conference; Working Party III was, furthermore, entrusted with the study of a pensions scheme.

(g) The Conference took note of the report on the financing of the European Patent Office as well as of the implications for the States party to the Convention.

2. These decisions and in particular the adaptations made by the Conference to the Preliminary Draft Convention were the outcome of discussions during which the Conference settled a considerable number of questions. In the following chapters, we shall deal only with the main items debated: as far as possible, this report follows the order of the Articles.

II. PRELIMINARY DRAFT CONVENTION SETTING UP A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

3. The Conference accepted the principle contained in Article 5 guaranteeing free access to proceedings for the grant of a European patent to any natural or legal person of whatever nationality. In adopting this position, account was taken, both of the interests of the Contracting States and of the fact that under Article 45 of the PCT, the filing of international applications as provided for in that Treaty gives access to regional patents only if the patents are applied for pursuant to a regional patent treaty guaranteeing free access for patent applications.

4. Discussion arose concerning Articles 9 and 10. It was recognised that paragraph 2 of Article 9, which specifies what may not be considered as an invention for the purposes of the Convention, would have to be studied in greater depth. The same applied to the link between that paragraph and Article 10(b).

5. The Conference accepted the rule contained in Article 11, paragraph 3, to the effect that, for the purposes of a European patent application, the entire contents of applications for European patents, filed earlier but published on or after the filing or priority date of the said application, were to be considered as comprised in the state of the art. The acceptance of this rule, which may appear strict, was greatly facilitated by fact of its attenuation by two other rules, those contained in Article 13 and Article 11, paragraph 4. Article 13 provides that the earlier applications in question are not to be considered in deciding whether there has been an inventive step and merely serve for the assessment of novelty as such. The rule contained in Article 11, paragraph 4, provides that the principal rule is to apply only when a Contracting State designated in respect of the later patent application was also designated in respect of the earlier patent application. If only some of the States designated in the later patent application were designated in the earlier application, the applicant may, pursuant to Article 138, split this application by submitting different claims according to the States designated. With regard to the problem of earlier applications, it appeared difficult to find a satisfactory alternative solution.

6. Article 20a, providing for a uniform twenty-year term for the European patent as from the date of filing of the application, touches on the question of the "maximum solution" which, in accordance with the wishes expressed by the interested circles, was adopted by the Conference. Under this solution, the European patent, while merely constituting a bundle of national patents, is nevertheless subject as far as its validity and term are concerned, not to the provisions of national legislation, but to those of the Convention. It follows that in this respect the Convention constitutes a common legislation governing European patents after they have been granted at national level. It should also be noted that work of a common body of legislation affecting only the procedure for grant. In addition to Article 20a on the term of the patent, we refer to Article 133 which lays down the grounds for revocation of a European patent once granted; apart from the juridical security which these Articles provide for the European patent, it is to be hoped that they will have a harmonising effect on the national laws governing national patents granted at national level. It should also be noted that Article 2, also adopted by the Conference, makes it clear that otherwise, particularly as regards the content of exclusive rights, their infringement, licences and the collection of renewal fees, national patents granted according to the European procedure will remain subject to national law in the same way as other national patents.

7. The Conference was conscious that the so-called "maximum" solution, which excludes in particular the revocation of European patents on grounds other

than those listed in the Convention, might seriously interfere with the national legislation of European States and consequently make accession to the Convention more difficult for certain of these States. The Conference however attached more importance to the juridical security which the maximum solution affords. However, in order to facilitate acceptance of the European system, it approved Article 159 which gives each Contracting State the possibility of making reservations with regard to the maximum solution, such reservations being valid for a maximum period of ten years, from the entry into force of the Convention. These reservations concern particularly the exclusion from protection of food and pharmaceutical products as such, since European patents granted for such products may be declared revocable or ineffective in the State concerned.

8. In view of the fact that for the purposes of an application for a European patent, the content of earlier patent applications published after the filing of the said application may not be considered in deciding whether there has been an inventive step (Article 13), the system of patents of addition laid down in Article 21 can only be justified through its implications as regards fees. This is the only aspect which could *a fortiori* justify the grant of a patent of addition—in the case of the term provided for in Article 21 being extended—following an application filed after publication of the parent patent. The Conference was not, for the time being, of the opinion that these considerations as regards fees were a factor justifying the extension of the term for the filing of applications for patents of addition. This extension was advocated by some of the interested circles.

9. Under Article 22, the European patent application retains its unitary character for the purposes of European grant proceedings but, as an object of property (assignment and establishment of rights) constitutes a separate object in each designated State. In Article 22a, the Conference drew the consequence that the application will, as an object of property, be subject to national law in each designated State.

10. In accordance with the wishes expressed by the Conference, Articles 35a, 35b and 35c provide an exhaustive inventory of all the responsibilities of the Administrative Council. This list involves repeating a certain number of responsibilities already provided for in other Articles, which has however been allowed in order provisionally to achieve a comprehensive view, in the Articles in question, of the powers of the Administrative Council. It seems possible that these Articles might be simplified in the final text of the Convention.

11. Article 35h provides that the Administrative Council may, when there are at least eight Contracting States, set up a Board composed of five of its members. This Board may prepare Council decisions but, in accordance with the ruling of the Conference, powers may not be delegated to it by the Council.

12. Article 35n deals with the rules governing votes taken within the Administrative Council. As in the case of revisions of the Convention which, according to Article 162, must be adopted by a majority of three-quarters of the Contracting States represented at a Diplomatic Conference, the Conference wished to avoid

giving the right of veto to each Contracting State. It therefore excluded any possibility of recourse to a unanimity rule for the purposes of voting Administrative Council decisions. Certain highly important decisions, including the amendment of the Implementing Regulations, the adoption or amendment of the Rules relating to Fees and the adoption of the budget of the European Patent Office, will require a majority of three-quarters of the Contracting States. All other decisions will be taken by a straight majority. For the purpose of determining such majority, only those Contracting States represented and voting will be taken into account. There is no cause to doubt that this arrangement will guarantee the Administrative Council's capacity to take decisions.

13. The interest of the Contracting States in the European patent system varies from country to country, depending mainly upon the number of European patents applied for and granted in respect of the country in question. This variation is expressed in terms of the difference between the contributions payable—whether these be payments representing the renewal fees for European patents (Article 43) or the special contributions provided for in Article 44. The Conference discussed whether this variation in interest should give rise to a certain weighting of votes in the decisions of the Administrative Council. Finally, a system of weighting on these lines was accepted and set out in Article 35o. It was, however, limited to a few major decisions liable to affect the contributions of the Contracting States, pending further examination of the weighting scale.

14. As regards the final decision on any dispute between the European Patent Office and its employees, the Conference had a choice between an appeals committee, governed by a special statute, and the Administrative Tribunal of the International Labour Organisation which was already in existence. In the interests of unity of treatment and of jurisprudence, the Conference opted for the second solution in Article 39.

15. The Conference endorsed the important principle, set forth in Article 44, that the sum of fees and of payments in respect of renewal fees should ensure the balance of the budget of the European Patent Office. It is however possible, and during the launching period of the European Patent Office may even be inevitable, that this balance may not be achieved. In that event, the same Article makes provision for the payment of special financial contributions by the Contracting States. On the other hand, these special payments would merely constitute an advance; for Article 44 lays down that, as soon as the balance of the budget of the European Patent Office permits, these contributions are to be repaid from credits provided for that purpose in the said budget. The Conference considered various ways of fixing the special contributions and concluded that two methods appeared to be acceptable. In view of differences of opinion as to the acceptability of one or the other of these systems, the Conference decided to postpone taking a decision and provisionally to retain both systems as variants on Article 44.

16. Article 64 concerning the filing of the European patent application was amended, in paragraph 2, so as

to safeguard the public interests of the Contracting States, especially as regards their national defence.

17. A majority of the representatives of the interested circles advocated a rationalisation of the procedure from the filing of a European patent application to the transmission of the report on the state of the art. They threw doubt on the usefulness, at the time of filing, of an examination regarding obvious deficiencies under substantive law, as provided for in Article 77, and requested that the examination of filing formalities (Articles 66, 67, 68, 69a and 72) be combined with the search into the state of the art. The special search fee payable would then be abolished, while the filing fee might possibly have to be increased. The Conference, being informed by Working Party I that it was not yet in a position to undertake a detailed study of what was described as the "package" of questions, decided to abstain from taking up any position on the matter and instructed Working Party I to submit proposals to it in due course.

18. The Conference adopted Article 69a which, like the corresponding PCT provision, lays down that the European patent application must include mention of the inventor in the event of the legislation of at least one of the designated Contracting States requiring that such particulars be provided in respect of national applications.

19. Article 75 stipulates that the declaration of priority must be made at the time of filing of the patent application. The Conference saw no sufficient reason why an extra term should be allowed for the production of this declaration but, with a view to warding off a difficulty referred to by the interested circles, it decided to instruct Working Party I to draw up a provision permitting the correction of inaccurate information.

20. In accordance with the provisions governing the international application provided for in the PCT, the Conference added to the conditions with which European patent applications must comply, the compulsory submission of an abstract thereof, to be used exclusively for technical information purposes; the definitive content of this abstract is to be determined by the International Patent Institute (Articles 66 and 79, paragraph 3).

21. At its preceding meeting, the Conference had decided to review the question of the time limit for the submission of the request for examination, provided for in Article 88, in the light of the financial estimates to be presented by Working Party IV. These estimates however showed that, reckoning with data derived from existing deferred examination systems, a short period such as six months (tantamount to an immediate examination system) would involve far greater expense than a long period such as seven years (so-called deferred examination).

This was attributable to the different number of patent applications reaching the examination stage under each respective system, a factor directly determining the number of examiners required.

The Conference nevertheless decided, in line with the opinion of the interested circles, to fix as short a period

as possible for the submission of the request for examination. This it did on grounds of juridical security, especially *vis-à-vis* the applicant's competitors. A six-month period was adopted, dating from the entry in the European Patent Bulletin concerning the publication of the report on the state of the art. Prolongation of this period to twelve months would however be considered. After all, the period would in certain cases be prolonged under the PCT to the advantage of those holding an international application (Article 117). There was, moreover, good reason to wonder whether a six-month period would in general give applicants sufficient time to weigh up their position after studying the report on the state of the art. However, whether the period were to be six or twelve months, the Conference by its decision excluded deferred examination, that is to say the possibility for applicants to postpone patent grant proceedings for long enough to be able to reconsider their economic interest in the patent being granted. At the moment, the Draft Convention provides only for the system of immediate examination, both in the case of the search and in the case of the subsequent examination, the only difference being that the latter is not automatic: the applicant must make a request for the purpose.

22. By lengthening in principle the period within which a request for examination may be made, Article 160 provides for the introduction of a system of deferred examination during a transitional period after the entry into force of the Convention, in order to facilitate the launching of the European Patent Office. However, it must be acknowledged that the Conference was not very sympathetic towards such a solution, since there was a danger that it might be extended beyond what could properly be called a transitional period. On the whole, there was a preference for the alternative solution for overcoming the difficulties of the launching period, contained in Article 157, namely, the progressive expansion of the field of activity of the European Patent Office to the various areas of technology. There were also some doubts about this solution, which might raise other problems, in particular that of the choice of the areas of technology. It was suggested that it might be possible to dispense with all transitional measures for the launching of the European Patent Office and to rely on the circumspection with which the applicants would begin to make use of the European procedure which, until a framework of precedents had been established, would contain many elements of uncertainty. As a counter-argument, it was observed that the attitude of the applicants was too precarious a factor to make the successful launching of the Office dependent upon it. Provisionally the Conference decided to retain Articles 157 and 160 and continue examining them.

23. Taking into account the views of the interested circles, the Conference retained the opposition procedure after the grant of the European patent, adding *inter alia* Article 101a, which defines the grounds for opposition. These grounds are in fact similar to those for the revocation of the European patent. Having regard to the guidelines which emerged from the observations of the interested circles, it was decided to shorten the period for opposition from twelve to nine months (Article 101).

24. In Article 124, the possibility of converting European patent applications into national patent applications, which could give rise to legal uncertainty, has been restricted, as far as conventional law is concerned, to the exceptional cases referred to in Article 65, paragraph 5, and in Article 157. However, the Conference did not wish to prevent national legislations from going further and allowing conversion in all cases where the European patent application has been refused or withdrawn, or where the European patent has been revoked.

25. The Conference adopted Part VIII of the draft Convention which contains common procedural provisions of the European Patent Office. Attention is drawn to Article 149, which ensures that documents from files relating directly to the procedure for grant of the European patent and to opposition proceedings, are to be available for inspection by the public. An exception is made during the time preceding the publication of the European patent application, but even in this case, certain particulars concerning the application (number, date of filing, name of applicant, title of invention, names of designated States) may be inspected. In addition, any person who can prove that the applicant has availed himself of his application in respect of him, may obtain inspection of the complete file.

26. Part VIII also contains Articles 153 to 155 on representation and in particular, Article 153 on persons who are authorised to undertake representation before the European Patent Office. The Conference did not discuss the principles contained in this Article which are taken from previous drafts and were adopted primarily as a basis for discussion with the interested circles on a problem which is of particular concern to them.

27. The Conference also adopted the tenth and final part of the draft containing the final provisions. In this context, the Conference approved the important principle that the revision of the Convention does not require unanimity on the part of the Contracting States: such a revision could be validly adopted by a majority of three-quarters of the Contracting States represented and voting at a diplomatic Conference where at least three-quarters of the States which are party to the Convention are represented (Article 162).

One consequence of a revision, particularly in such circumstances, could have been the entry into force of the revised text for some of the Contracting States only, the others remaining bound by the old text of the Convention, so that both texts would be valid. At the same time, such a consequence, which might be acceptable in the case of other Conventions, such as the Paris Convention for the Protection of Industrial Property, would not be acceptable in the case of this Convention which entrusts the grant of common patents to a central Office in accordance with common rules: this Office could not apply two sets of rules to patent applications designating States which were party to the revised text and States which were party to the old text of the Convention. For this reason, the Conference approved two rules, one of which is severe, but inevitable: such States as have not ratified or acceded to the revised text of the Convention at the time of its entry into force shall cease to be parties to the Convention (Article 162,

paragraph 4). The Revision Conference will have to take into account the implications of this rule when determining the date of the entry into force of the revised text. The second rule, contained in Article 171, preserves acquired rights, in the case of Article 162, paragraph 4, being applied, but also lays down that patent applications or oppositions which are pending on the date on which a designated State ceases to be party to the Convention, shall continue to be processed in accordance with the revised text of the Convention.

28. The Conference provided, in Article 167, that disputes between the Contracting States concerning the interpretation or application of the Convention, on which it has not been possible to reach agreement within the Administrative Council, may be brought before the International Court of Justice. This, of course, applies only in the case of disputes between States: internal procedural disputes will be settled by the European Patent Office.

III. PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS TO THE CONVENTION

29. Since the intention is to publish the Implementing Regulations as a First Preliminary Draft in order to ascertain the initial reactions of the interested circles, the Conference did not discuss the provisions of the draft in depth, but confined itself to answering a few questions raised by the Sub-Committee responsible for preparing the draft.

30. One of these questions concerned Re. Article 16, No. 3, which, if adopted, would involve amending Article 16 of the Convention, which deals with the judicial recognition of the entitlement of a third party to a patent application filed by a person not entitled to apply; in this case, the third party may file a new patent application for the same invention. This application then benefits from the dates of filing and priority of the previous application which it invalidates. Re. Article 16, No. 3, of the Implementing Regulations extends to opposition proceedings the rule contained in Re. Article 16, No. 1, providing for the suspension of proceedings for grant in the event of a claim of entitlement to the European patent; this presupposes amending Article 16 of the Convention to cover opposition proceedings. The Conference provisionally retained Re. Article 16, No. 3, but without amending Article 16 of the Convention: it expressed doubt as to the advisability of extending the rule in Article 16 to a situation where there is already in existence a large number of independent national patents governed entirely by national laws, except as regards the objective conditions of their validity which are governed by the Convention. The question will therefore have to be re-examined; the Conference in fact asked for a re-examination of the whole of Article 16, which, it was observed, did not offer a solution to the case of a recognition of entitlement to a European patent which was only valid for part of the application or in respect of some of the designated States. When Article 16 is examined, it will in any case be necessary to take into

account the opinion of the Conference, which felt that the European Patent Office ought not itself to judge the entitlement to a patent, pursuant to Article 15.

IV. PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

31. Article 35a of the Convention provides that the Rules relating to Fees will be adopted by the Administrative Council. Nevertheless, and without prejudice to the decision to be made at a later stage by the Council, the Conference had a Preliminary Draft of the Rules relating to Fees drawn up and approved it for publication purposes, in order to give the interested circles an idea of the nature and level of the fees to be paid in the course of the procedure for the grant of European patents. The sums indicated are based on the calculations contained in the Report on the Financing of the European Patent Office, which were themselves based on provisional information, such as the levels of the salary scales of officials of the European Communities in force at the time when the calculations were made. The level of the fees quoted in the Preliminary Draft should therefore be viewed in the light of the current price situation.

32. The Conference decided that the levels of the fees should provisionally be expressed in European Units of Account, which are of equal value to the dollar; when the Rules relating to Fees are adopted, the level of the fees will probably be expressed in the currency of the State in which the European Patent Office is located. The Conference noted that the plan for the fees contains two variants, one of which provides for a fee for the report on the state of the art at a level equivalent to that of the fee charged by the IIB, whereas the other provides for a reduction in this fee and an increase in certain other fees. The fact that these two variants are given does not in any way prejudice the study of the "package" of questions relating in particular to Articles 74 and 79 of the Convention. Should this study lead to the complete elimination of the fee for obtaining the report on the state of the art, the result would be a modified plan in which, among other things, the filing fee would be raised.

33. In view of the purpose of publishing the Preliminary Draft of the Rules relating to Fees, the Conference did not discuss these Articles in depth.

V. DRAFT PROTOCOL ON THE PRIVILEGES AND IMMUNITIES OF THE EUROPEAN PATENT OFFICE

34. The Conference recognised that the European Patent Office, being an inter-governmental organisation, and its staff should enjoy privileges and immunities similar to those enjoyed by other existing inter-governmental organisations and their staffs. However, as these privileges and immunities vary somewhat from one organisation to another, the Conference considered that the Protocol for the European Patent Office should not

include the maximum number of privileges and immunities but should be restricted to those generally recognised. A draft containing the provisions of the Protocol of the European Launcher Development Organisation (ELDO) was remitted without detailed discussion to Working Party II for examination in the light of the opinion expressed by the Conference and the written observations submitted by certain delegations.

35. The question of the system of taxation applicable to the staff of the European Patent Office was deferred for discussion at a later stage.

VI. REPORT ON THE SERVICE REGULATIONS AND SALARY SCALE SYSTEM FOR THE STAFF OF THE EUROPEAN PATENT OFFICE

36. Article 35a of the Draft Convention provides that the Administrative Council shall be competent to adopt the Service Regulations for officials and their salary scales. Nevertheless, as soon as the Convention enters into force and the Administrative Council has assumed its functions, it will have to recruit staff to prepare for the launching of the European Patent Office. For this reason the Conference had instructed Working Party III to begin a preparatory study of the questions of the Service Regulations and salary scales for the staff of the European Patent Office.

37. The Report by Working Party III contains this study, which is based on two principles, which the Working Party proposed that the Conference should adopt. The first is that the Service Regulations of the European Patent Office should be based on the Model Staff Regulations for the European Civil Service drawn up in the Final Act of the Governmental Conference on the European Civil Service, of Strasbourg, 6 July 1967; the second is that the salary scale should be based on that of the European Communities. The Conference approved these two principles, without prejudice to the final decision of the Administrative Council of the European Patent Office.

38. The Conference also instructed Working Party III to study a pensions scheme for the staff of the European Patent Office in preparation of the decisions by the Administrative Council.

VII. REPORT ON THE FINANCING OF THE EUROPEAN PATENT OFFICE

39. The Conference noted the report by Working Party IV, which contains recommendations on possible methods of financing the European Patent Office, both in its steady state when it has reached its full development and is receiving a full range of revenue and also during the period when it is developing and when its full revenue is still not being received. The report points out that although the European Patent Office can be envisaged as growing to its full size in a few years, it will be at least 20 years from opening before the full range of renewal fee income will be obtained. The calculations are based on advance estimates as regards both the number of patent applications which will be filed with the European Patent Office and the number of examiners, bearing in mind the time that they will have to devote to the various operations. The considerations set out in the report form the basis for both the financial provisions of the Convention, and in particular Articles 42 to 44, and the system of fees provided in the Preliminary Draft of the Rules relating to Fees.

40. The Conference approved without a great deal of discussion the principles of the report, which gives a detailed picture of the expenditure that the European Patent Office will incur and the burden which will consequently rest on the Contracting States. It instructed Working Party IV to examine the following questions:

- (i) the financial consequences of a State acceding to the Convention after its entry into force (Article 164), of a State denouncing the Convention (Article 170) and of the automatic loss of the status of Contracting State (Article 162, paragraph 4);
- (ii) the percentages of the European Patent Office's expenditure to be met by Yugoslavia and Monaco, which have recently been admitted to the Conference, according to the two variants set out in Article 44;
- (iii) the calculation of these percentages according to the alternative placed in square brackets in the second variant of Article 44.

VIII. FINAL NOTE

41. Working Party I, which will continue to study various questions, was instructed to examine certain Articles of the Preliminary Draft Convention and the Preliminary Draft of the Implementing Regulations affecting general principles of civil law with the government legal experts.

REPORTS

ON AMENDMENTS AND ADDITIONS TO THE FIRST PRELIMINARY DRAFT OF A CONVENTION ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS⁽¹⁾, APPEARING IN THE SECOND PRELIMINARY DRAFT

REPORT BY THE UNITED KINGDOM DELEGATION ON THE CHANGES MADE IN ARTICLES 1 TO 29

PART I

GENERAL PROVISIONS

1. The Inter-Governmental Conference has approved the texts giving effect to the "maximum approach" which have been prepared by Working Party I following the directions given to it by the Conference at its meeting in April 1970.
2. This approach requires that the criteria for judging the validity of a European patent in the national phase shall be substantially the same in all Contracting States. The new Articles 133 and 134 (see paragraphs 98 to 102) which provide for this are reported on separately.
3. The approach also requires that the legal term of a European patent shall be the same in all the Contracting States covered by it. For this purpose, a new Article 20a has been adopted which provides a uniform term for a European patent of 20 years from the filing date of the application. In the case of a European patent of addition, the term is to run from the filing date of the parent application so that the patent of addition will expire no later than the parent patent. Some States contain provisions in their laws for extending the term of national patents on account of loss incurred by the proprietors of the patents by reason of war or similar emergency conditions affecting those States. In order to avoid too great an interference with national laws, an exception has therefore been provided in Article 20a to allow such States to extend the term of European patents covering them if such circumstances should arise. A new Article 159, which is the subject of a separate report, (see paragraphs 127 to 130) also allows a State the right for a limited period to provide that European patents designating that State shall have a shorter term than 20 years.

4. Adoption of the "maximum approach" has made necessary a change in Article 2, paragraph 2, to make clear that a European patent is to have the effect of and be subject to the same conditions as a national patent in the State for which it is granted, except when the Convention provides otherwise.

5. A minor change has been made in Article 4 for the purpose of making it clear that the European Patent Office is a creation of the Convention itself.

6. Pursuant to Article 121 of the First Preliminary Draft the European Patent Office shall act as a designated or elected Office under the PCT for those Contracting States to the Convention which are designated in the PCT application where the applicant wishes to obtain a European patent for those States. The effect of Article 45, paragraph 1 of the PCT is, however, that European patents may be obtained via the PCT route only if they are accessible to anyone entitled to file a PCT application. Article 5 of the First Preliminary Draft did not allow applications for patents to be made by residents or nationals of non-Contracting States which "subject the grant of a patent to conditions which can only be met in the territory of the State in question". On the other hand, Article 9, paragraph 1, of the PCT provides that any resident or national of a State, party to the Treaty, may file an application under the Treaty; and this is extended by Article 9, paragraph 2, according to which the Assembly of PCT States may decide to allow PCT applications to be filed by residents or nationals of any Paris Convention country not party to the PCT. It follows from this that in order to permit European patents to be obtained via the PCT route, the restriction on accessibility which was contained in Article 5 of the First Preliminary Draft had to be removed. Having considered various possibilities, the Inter-Governmental Conference decided that it would be in the best interests not only of applicants but also of the Contracting States to the Convention to make European patents freely accessible to anyone. Article 5 has been amended accordingly.

7. Article 6 has also been widened with a view to making it also a matter for national law whether, and on what terms, the protection afforded to an invention by

⁽¹⁾ First Preliminary Draft of a Convention establishing a European System for the Grant of Patents, published by the Office for Official Publications of the European Communities, Luxembourg, 1970.

a European application under Article 19 and by a national application may be enjoyed at the same time.

8. A new Article 8a has been inserted to make it quite clear that certain provisions of the Convention which refer to national applications cover also applications for utility models and utility certificates where the relevant national law provides for such forms of protection.

At the present stage, the States participating in the Conference whose laws make provision for utility models or utility certificates are the following: Federal Republic of Germany (*Gebrauchsmuster*), France (*certificat d'utilité*), Italy (*modello d'utilità*), Portugal (*modelo de utilidade*) and Spain (*modelo de utilidad*).

PART II

SUBSTANTIVE PATENT LAW

CHAPTER I

PATENTABILITY

9. Article 9, paragraph 2, of the First Preliminary Draft has been provisionally amended to bring it into closer agreement with Rule 39.1 of the Regulations under the PCT. It is realised that the PCT, unlike this Convention, does not bind countries to adopt a particular substantive law and the exclusions from patentability set out in Article 9, paragraph 2, will be re-examined later.

10. There has been a thorough discussion of the problem, inherent in Article 11, paragraph 4, of a European application or patent which covers some Contracting States not designated in an earlier European application having substantially the same content. The new Article 138 provides a solution according to which the applicant or patentee may file a different set of claims which are to have effect in the States not covered by the citation. This allows the conflict to be resolved in an equitable manner without recourse to conversion to national applications.

11. Article 13 of the First Preliminary Draft presented two alternatives which differed in the extent to which prior European applications, under Article 11, paragraph 3, are to be taken into account in assessing inventive step. In accordance with the provisional decision of the Inter-Governmental Conference at its meeting in April 1970, the second variant has now been cancelled.

CHAPTER II

RIGHT TO THE PATENT

12. During discussion of Article 16 and the Regulations relating thereto, it became apparent that these provisions probably give rise to legal and procedural difficulties and may not cover all cases of obtaining which may arise in practice. The note therefore indicates that further study will be given to this Article.

CHAPTER IV

PATENTS OF ADDITION

13. In view of the deletion of the second variant of Article 13, paragraph 5 of Article 21 has been deleted. In accordance with Article 21, paragraph 1, the application for a patent of addition must be filed before the date of publication of the parent application. Therefore, the parent application will not be in the state of the art as defined in Article 11, paragraph 2; the question as to whether the application for a patent of addition has an inventive step over the parent does not arise because of Article 13.

14. In this connection it is considered that the question whether to provide for European patents of addition should be re-examined. Having regard to the short time available for filing applications for patents of addition, the scope for them will be quite small. And, if the second sentence of Article 13 is retained, only a fiscal advantage will be afforded to applicants for patents of addition.

15. Article 21, paragraph 3 provides that a patent of addition shall be granted only to the proprietor of the parent patent. Before grant of the patent of addition, the parent application may have resulted in a patent and this may have been assigned to different owners in the different Contracting States covered by the patent. This matter should be dealt with in the Implementing Regulations.

16. It does not seem necessary to amend Article 21, paragraph 7. If Article 13, as now proposed, is finally adopted there will be no need to consider whether the converted application has an inventive step over the parent. If, on the other hand, the final text makes it necessary to examine this question, the applicant can hardly complain of a delay in obtaining a grant if he applies for a conversion at the latest time allowed for this purpose.

CHAPTER V

THE PATENT APPLICATION AS AN OBJECT OF PROPERTY

17. The Conference has concluded that it is not necessary to include in the Convention provisions, corresponding to those found in the 1965 version of the EEC Preliminary Draft Convention, to deal with the procedure to be followed in the case of mortgaging or distraint of, or the creation of some other right *in rem* in, a European patent application.

18. The above-mentioned 1965 Preliminary Draft contained such provisions because the European application was intended to be unitary. However, the present draft makes a clear distinction. Although for the purposes of proceedings before the European Patent Office a European application is to be treated as a single unit, such application when considered as an object of property is in effect a bundle of national applications. It follows from this that the procedure governing a mortgage etc. should be that of the applicable national law, and a new Article 22a, which makes this explicit, has been introduced. This provision is, however, subject

to two exceptions. First, it is considered desirable to retain Article 23, paragraph 1, which partially unifies the law governing assignments. Secondly, a new Article 28b permits the EEC States to prescribe a unitary law governing the European application as an object of property in those States; Article 22, paragraph 2, which dealt only with assignments, has consequently been deleted.

19. Articles 24 to 27 of the 1965 Preliminary Draft have therefore been omitted. However, a new Article 28a has been included to provide for the entry into the Register of European Patents of information relating not only to an assignment as in the 1970 First Preliminary Draft, but also to a licence, mortgage or other right under a European application. The reason for this is that it appears advisable to allow third parties the possibility of acquiring information as to the exact legal position under a European application. Since the European Patent Office is not itself affected by the creation of rights, other than by way of an assignment, Article 28a does not refer to Article 23, paragraph 4.

20. It follows from the new Article 22a that a European application and a European patent resulting therefrom are, as objects of property in a designated State, subject to the same law, namely the national law of that State. Accordingly Article 29 has been deleted. Paragraph 1 of this Article was considered to be nothing more than a codification of the normal rules of private international law and thus to be unnecessary. As regards paragraph 2, it was felt that this was also unnecessary and would in certain circumstances create insuperable difficulties.

PART III

THE EUROPEAN PATENT OFFICE

REPORT BY THE FRENCH DELEGATION ON THE AMENDMENTS TO CHAPTER I d

CHAPTER I d

ADMINISTRATION; LIABILITY
(Articles 36 to 40)

21. Article 36 on the administration of the European Patent Office has been amended on two points.

Sub-paragraph 2(i), which dealt with the participation of the President in the deliberations of the Administrative Council, has been deleted, and this question is now covered by Article 35f.

The second sentence of paragraph 3 has been amended to make it clear that the Administrative Council is to designate the Vice-President who is to represent the President when the latter is absent.

22. In the First Preliminary Draft Convention, Article 39 made provision for entrusting the adjudication of disputes between the European Patent Office and its employees to an "Appeals Committee", whose composi-

tion and procedure were to be laid down in a special statute.

This solution has been abandoned in favour of one which gives the Administrative Tribunal of the International Labour Organisation competence to adjudicate in such disputes, within the limits and subject to the conditions laid down in the Service Regulations for officials and the conditions of employment of other employees of the European Patent Office.

23. Article 40, paragraph 1, on the contractual liability of the European Patent Office and paragraph 3 on the personal liability of its employees towards the European Patent Office have not been amended.

24. However, Article 40, paragraph 2, which, in the text of the 1970 First Preliminary Draft provided that in the matter of non-contractual liability, the European Patent Office would be bound to make good any damage caused by its employees in the performance of their duties, "in conformity with the general principles common to the laws of the Contracting States", has been replaced by a provision whereby damages are to be made good in accordance with the provisions of the law of the State in which the European Patent Office is located, or, where appropriate, in accordance with the law of the State in which the branch for information and liaison, which is created within the territory of such State pursuant to Article 33, paragraph 2, is located.

25. Article 40, paragraph 4 was similarly amended and now provides that the disputes under paragraphs 1 and 2 fall within the jurisdiction of the courts in the place at which the European Patent Office or the branch, as the case may be, is located.

REPORT BY THE SWISS DELEGATION ON THE AMENDMENTS TO CHAPTER III

CHAPTER III

ORGANISATION OF THE DEPARTMENTS
(Articles 53 to 58)

26. These provisions, which were contained in the 1970 First Preliminary Draft, have undergone amendments which, with the exception of a few minor improvements, provide for Opposition Divisions in addition to the European Patent Office departments already envisaged. The innovation responds to a general wish expressed at the third Meeting of the Inter-Governmental Conference in Luxembourg by the non-governmental international organisations. The establishment of separate Opposition Divisions means that the Examining Divisions do not have to take decisions on oppositions directed against their own decisions, as was previously provided for. However, the amended provisions allow a partial re-organisation of the Examining Divisions. The Opposition Division may still be regarded as impartial if only one of its members worked in the Examining Division whose decision is being contested. This has the advantage that the Opposition Division will have at its disposal the specialist knowledge of the member of the Examining Division who is familiar with the case. The details of the provisions of the 1970 First Preliminary Draft which have been amended are given below.

27. In Article 53, sub-paragraph (a), the Opposition Divisions are named expressly as departments. The Examining Divisions' responsibility for hearing oppositions has been deleted from Article 55, paragraph 1. In paragraph 2 it is made clear that in the event of oral proceedings (Article 140) the applicant is to be heard not by the member of the Examining Division processing the application but always by the Examining Division itself. The new Article 55a governs the responsibilities and the composition of the Opposition Divisions. The composition and organisation of these divisions entirely correspond to those of the Examining Divisions. The Opposition and Examining Divisions can only overlap as regards staff to the extent that a technically qualified examiner may be a member of both departments at the same time. For practical purposes this will be the examiner who has already dealt with the patent application as the single examiner in the Examining Section and as a member of the Examining Division. The reference to the Opposition Divisions has been added to Articles 56, paragraph 1 and 58, paragraph 2.

REPORT BY THE NETHERLANDS DELEGATION ON THE AMENDMENTS MADE TO PART IV

PART IV

APPLICATION FOR EUROPEAN PATENTS

CHAPTER I

FILING AND REQUIREMENTS OF THE APPLICATION *(Articles 64 to 72)*

28. The following amendments have been made to the 1970 First Preliminary Draft:

29. The second paragraph of Article 64 has been replaced by a more flexible formula which, to a greater extent than the previous text, takes account of the legal situation in certain countries in respect of inventions which, because of their nature—in particular those of interest to national security—may not be published in another country without the prior agreement of the authorities of the country concerned. The third paragraph of Article 64 has been deleted. It did not seem either practicable or desirable to impose on the European Patent Office the rôle of checking national provisions in respect of inventions which may not be published in another country without prior authorisation. The penal provisions of each country ought to be sufficient to prevent infractions of the provisions referred to in paragraph 2.

30. The square brackets appearing in Article 65 have been deleted. It should be noted that the period of fourteen months referred to in paragraph 3(b) exceeds that laid down by Rule 22.1 of the Regulations under the PCT by one month. However, where the European Patent Office is acting as a receiving Office under the PCT the national offices are bound by Article 120, paragraph 2, and must transmit the applications to the European Patent Office "in time for the latter to be

able to comply in due time with the conditions for transmittal under the Co-operation Treaty".

31. A provision laying down that an abstract must be filed, has been included in Article 66.

The provision previously contained in the second paragraph has been deleted from Article 66 and inserted into Article 68(c); thus one of the conditions to be fulfilled before a filing date is granted is that the application is drawn up in one of the languages referred to in Article 34, paragraphs 1 and 2.

A note was also added to Article 66, pointing out that the Article is to be re-examined in connection with Articles 77, 78, 79, 80, 122 and 137, particularly for the purpose of rationalising the procedure from the filing of the application to the issue of the report on the state of the art.

32. By aligning the German text of Article 68 on the English and French wording, it has been made clear that only the date is to be recorded when a European patent application is filed.

33. Working Party I inserted a new Article 69a, stipulating that the inventor be identified where the national law of at least one of the designated Contracting States requires it. This Article corresponds to Article 4, paragraph 1(v) of the PCT.

CHAPTER II

PRIORITY *(Articles 73 to 76)*

34. In Article 73, paragraph 1, it has been made clear that the national application on which the priority right is to be based must have been filed in or for a State party to the Paris Convention for the Protection of Industrial Property. So that recognition of the priority right of the European application cannot be made conditional on it being recognised by another State party to the Paris Convention, the reciprocity clause has been restricted in paragraph 5 to the States which are not party to the Paris Convention.

35. The note to Article 74 has been deleted in the hope that after the discussions held during the drafting of the PCT, no State will interpret the effect of the priority right in such a way that the priority date is not effective for prior art purposes, although as a rule that State includes the content of patent applications in the state of the art as from their date of filing.

36. The note to Article 75 envisages the drawing up of a general Article making it possible to remedy any unintentional failure to observe the relevant provisions.

37. A new paragraph 1a has been added to Article 76 which further develops the principle of the first paragraph. In accordance with paragraph 1a, the European application having a priority date earlier than a national application in a designated State is to constitute in that State a right prior to that of this national application, provided that the European application is published on or after the priority date of the national application.

PART V

EXAMINATION, GRANT AND OPPOSITION

REPORT BY THE SWEDISH DELEGATION ON THE CHANGES MADE IN CHAPTER I

CHAPTER I

PROCEDURE PRIOR TO THE INTRODUCTION OF THE REQUEST FOR EXAMINATION

(Articles 77 to 87)

38. Articles 77 and 78 have been clarified to distinguish the effects of the application not fulfilling the requirements necessary to receive a filing date (Article 68) from the case where the application is deemed to be withdrawn. The decision "that the application is not validly made" has been deleted. Failure to meet the requirements of Article 68 will thus simply result in no filing date being accorded.

39. If a filing date has been accorded, and the application is not deemed to be withdrawn, it is checked for obvious deficiencies which the applicant is invited to remedy. As further points to be checked are added the naming of the inventor in accordance with Article 69a, the presence of drawings and the presence of an abstract.

40. Generally, deficiencies found shall be remedied within a period prescribed by the Examining Section.

41. However, with regard to the naming of the inventor it is only required that he be identified before the end of the sixteenth month after the priority date.

42. With regard to drawings referred to in the description or the claims, their later submittal will have the same consequences as in the PCT, i.e. re-dating of the application; if drawings are not submitted within a period of one month after invitation to do so, the reference to the drawings shall be considered to be cancelled. Drawings submitted subsequently will thus be considered to be "added matter".

43. Interested circles have remarked that it would serve little purpose to examine for substantive requirements prior to the receipt of the search report. It is therefore left open for further discussion whether the requirements for such check by the Examining Section should be retained. Interested circles have suggested that in closer agreement with the PCT procedure this function in part or in full should be left to the Searching Office (IIB).

44. The question whether the search fee shall be a special fee or whether it should be included in the application fee, has been re-opened on account of the consideration, *inter alia*, that a European search—where the fee covers the cost of the search—may not be competitive with a national PCT search. This question, together with the question of the fee for a supplementary report — now regulated in Article 137 — is to be reconsidered.

45. The question of the publication of patent claims has been settled in the way that both original and amended claims shall be published. Only the amended

claims shall be published in the three official languages, cf. Article 34, paragraph 5. This is in accordance with the views expressed by the interested circles.

46. It is now explicitly prescribed that the report on the state of the art, if not available at the time of publication of the application, shall be published separately.

47. It is now proposed that the IIB shall determine the definitive contents of the abstracts which shall be published together with the application.

48. The proper division of functions between the Examining Section and the IIB are to be considered at a later date. Included in a "package" covering this and related problems are—as far as Chapter I is concerned—the questions of examination for obvious deficiencies and of fees under 43 and 44 above, and further whether the search report should be communicated to the applicant directly by the IIB.

REPORT BY THE GERMAN DELEGATION ON THE AMENDMENTS TO CHAPTER II

CHAPTER II

PROCEDURE FOR GRANT

(Articles 88 to 100)

49. At its third Meeting, the Inter-Governmental Conference had decided, as regards the procedure for grant covered by Articles 88 to 100, to have new texts drawn up with reference to the following points:

(1) Filing of the request for examination and simultaneous payment of the examination fee within two years of the date of filing of the patent application or, where applicable, within two years of the date of priority of the application; this period could perhaps be fixed at six months after the receipt or publication of the IIB report on the state of the art;

(2) Retention of the provision that a request for examination may be made at the same time as the application is filed;

(3) Deletion of the note to Article 88, paragraph 2;

(4) Transitional period, during which the period within which the request for examination may be made may be longer than the period ultimately fixed in Article 88. In this case the Administrative Council would be able to shorten this period during the transitional period; it would not, however, be able to lengthen it;

(5) Deletion of paragraphs 2 to 4 of Article 89.

50. In accordance with these decisions, the period within which the request for examination may be made was changed in Article 88, paragraph 2. Under Article 88 (see also note to Article 88) this period is now six months after the date on which the European Patent Bulletin notifies the publication of the report on the state of the art pursuant to Article 85, paragraph 5.

The choice of this particular date achieves two things: one is that the commencement of the period and its

duration are also recognisable to the competitors of the applicant for the patent. In addition it achieves the result—without there being any need to state it specifically—that the period for request should not expire less than two years after the date of filing of the patent application or, where applicable, less than two years after the priority date of the application. The publication of the European patent application takes place not less than eighteen months after the date of filing of the patent application or, where applicable, as from the date of priority. When the six months period for request is added to this, the minimum period after the date of filing of the application or after the date of priority is two years. This minimum period may be exceeded if there is a delay in drawing up the report on the state of the art and the notification referred to in Article 85, paragraph 5, is therefore made later; the period for request will then also begin to run correspondingly later.

51. As stated in note 1 to Article 88, it is to be re-examined whether the period referred to in Article 88, paragraph 2, should be increased from six to twelve months. Articles 22 and 39 of the PCT in particular suggest that this period should be extended. Under these provisions the European Patent Office would in certain cases be prevented from beginning the examination procedure before the expiry of the periods for which they provide, in other words from requesting the filing of the request for examination. In order to make it clear that the periods provided for in Articles 22 and 39 of the PCT will not be shortened as a result of the period of six months at present provided for in Article 88, paragraph 2, an extra sentence was added to Article 117, paragraph 2, containing a corresponding reservation in favour of international patent applications.

A prolongation of the six-month period provided for in Article 88, paragraph 2, to one year would provide sufficient leeway to avoid there being different rules for those European patent applications received by the European Patent Office which do not invoke the PCT and those which do. Moreover, a certain prolongation of the period allowed for filing the request for examination would give the applicant more time for consideration. A period of six months after receipt of the report on the state of the art might in many cases be considered too short for the applicant to reach a decision as to whether he should uphold his patent application.

52. Pursuant to Article 88, paragraph 2, the request for examination may be made at the same time as the patent application is filed, since Article 88, paragraph 2, contains no time limit in this respect. Pursuant to Article 90, however, the examination proceedings are only transferred to the Examining Division when the report on the state of the art has been received.

53. Article 160 has replaced Article 89 in providing for a transitional period. During a transitional period, it lengthens the period for request of six months, as laid down in Article 88, paragraph 2, to "... years". The Conference has not yet determined the space of time thus indicated, as Article 160 is to be re-examined. This transitional provision would appear to have disad-

vantages, because even a gradual transition from a longer to a shorter period for filing the request for examination could give rise to a back-log of work at the European Patent Office. However, the Conference could see no other solution which would adequately reduce and control the influx of work during the running-in period at the European Patent Office. Thus the question of whether Article 160 can be dispensed with can only be decided in connection with a further study of the problems entailed in the progressive expansion of the field of activity of the European Patent Office, as provided for in Article 157.

54. The Administrative Council will determine the end of the transitional period referred to in Article 160 by a majority of three-quarters of the votes (see Article 35a, paragraph 3 and Article 35n, paragraph 1(a)). By the same majority it may also shorten the longer period laid down in Article 160 for making the request for examination. Article 160, in paragraphs 2 and 3, provides certain guarantees for the applicant for a patent, namely, the publication of the said decisions of the Administrative Council in the Official Journal of the European Patent Office and the ruling that these decisions apply only in respect of European patent applications filed after the publication of such decisions. Since the minimum period, pursuant to Article 88, paragraph 2, is two years after the date of filing or the date of priority, there is sufficient time for persons filing new patent applications to make a request for examination during the shortened period.

55. Article 93, paragraph 2, has been deleted as such from the new text and included under the general provision "Supplementary report on the state of the art" — Article 137.

56. A paragraph 1a was included in Article 95 to make it clear that several notifications of the type referred to in paragraph 1 may be issued by the Examining Division. A new paragraph 1b also provides that the European patent application is deemed to be withdrawn if the applicant fails to reply, within the period fixed, to an invitation by the Examining Division to present observations or rectify irregularities. In this case the Examining Division had previously been obliged to issue a reasoned notification of refusal, although in many cases the applicant had lost interest in the application and had indicated this by his behaviour. Additional work for the Examining Division has therefore been avoided by this deemed withdrawal. The applicant nevertheless receives an appropriate notification in conformity with Implementing Regulation Re. Article 145, No. 11. He may then provoke a decision from the Examining Division against which an appeal is possible, in conformity with Article 108. In the event of the time limit not being observed through *force majeure*, the applicant may request that his rights be re-established in accordance with Article 142.

57. Article 96, paragraph 2, has been deleted as such from the new text and included under the general provision "Notification of the grounds" — Article 139.

58. The former Article 100, which is now divided between Articles 97a and 100, was revised with a view to shortening the period of three months allowed for translating the patent specification into the official language of a Contracting State. According to the earlier drafting of Article 100, this period of three months began as from the date of the publication of the grant of the patent in the European Patent Bulletin, which takes place, in accordance with Article 98, simultaneously with the publication of the specification of the European patent. Although as before, a time limit of three months for the translation is envisaged in the new Article 97a, the desired result has been achieved by substantially bringing forward the starting-point of the period. It now begins with the notification of the grant of the European patent, as laid down in Article 97, paragraph 1. In this way the interval needed for administrative work and for the printing of the European specification can also be used for producing the translation. Since, in addition, Article 97, paragraph 4, provides that the grant of a European patent will be entered in the Register of European Patents and published in the European Patent Bulletin not earlier than three months after the said notification, the interval for printing is co-ordinated in such a way with the period of time allowed for translating, that the publication of the grant of the European patent and of the specification cannot take place before the period of time allowed for translating has expired. In all the Contracting States which have prescribed a translation in accordance with Article 97a, the translation will be submitted at the same time as the grant of the European patent and the specification of the European patent are published.

REPORT BY THE UNITED KINGDOM DELEGATION ON THE CHANGES MADE IN CHAPTER III

CHAPTER III OPPOSITION PROCEDURE (Articles 101 to 107)

59. The Inter-Governmental Conference in April 1970 had instructed Working Party I to study the possibility of reducing the length of the opposition period and to prepare the texts for other provisions relating to opposition procedure which need to be included in the Convention.

60. As a result of the changes made in Article 97 and the introduction of the new Article 97a, it was concluded that the opposition period could be reduced to nine months from the date of publication pursuant to Article 97, paragraph 4. This period has now been written into Article 101, paragraph 1. It is felt that nine months allows sufficient time for consideration of a case following the making available of translations of the specification in those Contracting States which require them. However, practical experience may show that a period of nine months is not long enough. Any amendment of this period may be decided by the Administrative Council, as provided for under Article 35a, paragraph 1(b).

61. A new paragraph 1a has been added to Article 101 to make clear that an opposition to a European patent covers all the Contracting States designated in the patent. Since the proprietors in the different designated States may differ, it is necessary for the European Patent Office to know whom it must deal with. For this purpose, the new paragraph 1a follows the same line as Article 22, last sentence, by providing that the different proprietors shall, for the purposes of the opposition proceedings, be regarded as joint proprietors.

62. Article 101a lays down the grounds on which an opposition may be based. The European patent will have been granted following a serious examination of the application for compliance with all the requirements of the Convention and the Implementing Regulations. Because of this, the grounds on which an opponent could attack a European patent have been strictly limited.

63. Ground (a) concerns the basic question of patentability. This enables an opponent to contend that the subject-matter of the patent is not an "invention" within the meaning of the Convention. It also enables him—and this is probably the more likely case—to seek revocation of the patent on the ground that the invention is not new or is obvious, having regard to certain public disclosures (for example, a prior use) of which the European Patent Office was not aware during the application proceedings.

64. Ground (b) covers two other fundamental questions which are interrelated. The specification which is published pursuant to Article 98 must be clear as to what the invention is and it must give enough information to enable a person skilled in the particular art to perform the invention without having to exercise further inventive ingenuity. An opponent may seek to revoke a patent if he considers that the published specification fails to satisfy these conditions. He may also argue that, although the description is clear and gives enough detail to enable the embodiment described to be carried out, the claims are so widely drawn that they must be regarded as "speculative". The need for ground (b) is to be found in the fact that an industrial competitor of the patentee is likely to be able to form a clearer view as to the sufficiency of the published specification than an Examiner acting alone. The competitor may be expected to have a more complete practical knowledge of the technical fields in which he is interested and he also has the possibility of conducting experiments on the basis of the information given in the published specification.

65. Ground (c) also related to a fundamental objection which should be open to an opponent. During the application procedure, the applicant may have amended his claims, description and drawings. In so doing he may—deliberately or inadvertently—have introduced into the specification, either explicitly or implicitly, matter which, when comparison is made with the specification as originally filed, can be seen not to have been disclosed to the European Patent Office on the filing date of the application. The addition of such matter would clearly give an applicant an unwarranted advantage and be damaging to third party interests. An Examiner will, during the application procedure, consider the point

and insist upon limitation where appropriate (see Article 83a). But it is not always an easy matter to detect that an amendment makes the claims, description or drawings go beyond the original disclosure. For this reason a competitor should also be able to oppose on this ground.

66. The Conference was unanimous in its view that the grant of a European patent of addition should not be opposed on the ground provided for in the 1965 version of the EEC Preliminary Draft Convention that its subject-matter does not constitute an improvement, development or supplementing within the meaning of Article 21, paragraph 1, and that it does not satisfy the provisions of Article 13. It should be sufficient for the examiner to decide the question of compliance with Article 21, paragraph 1, this being a question of a technical nature.

67. Some delegations believed that obscurity of the claims should be made a ground of opposition. This belief was based on the view that it was most important for third parties to be able to identify clearly the precise area in which the patentee has a monopoly and in which they must not trespass. If therefore the claims in the specification, pursuant to Article 98, were lacking in clarity and distinctness, a third party should be permitted to oppose the grant. However, other delegations took the different view that this ground of opposition was unnecessary since the Examiner, during the application procedure, would have considered the clarity of the claims. They also felt that such a ground of opposition would lead to undue delay in prosecution and possibly involve further searching and re-examination of the description. For the time being therefore this ground has not been included in Article 101a but this matter may be re-examined later.

68. Article 101b lays down the basis for *ex officio* examination by the Opposition Division; it provides that the Division shall adopt the same approach as a Board of Appeal under the provisions of Article 113, paragraph 1. Assume that an opponent alleges that claim 1 of a patent is not new or is obvious having regard to certain published documents which he cites in his notice of opposition. The Opposition Division is not restricted to a consideration of claim 1 only; neither is it limited in its examination to the documents cited by the opponent. It may draw the patentee's attention to the fact that claim 2 or some other claim is affected by the documents cited by the opponent and insist upon amendment. It may be aware of other relevant documents and if so it is empowered to bring them into the opposition proceedings. It may require, in appropriate cases, further evidence to be supplied by either the opponent or the patentee. It may also take up with the patentee some objection not made by the opponent himself, provided that this objection falls within one of the grounds of opposition defined in Article 101a. The justification for such *ex officio* examination is twofold. It is not in the general public interest that a European patent should be maintained when it is apparent that it does not satisfy those conditions which are fundamental

to a grant. Secondly, maintenance of a grant in such cases would not be in the best interests of the patentee for he would then be faced with the clear possibility of having to defend several actions for revocation in national courts.

69. Article 105 has been amended to reflect more clearly the principle underlying the new Article 101b. The examination made by the Opposition Division must be confined to the grounds of opposition which are laid down in Article 101a. Thus, the Division cannot at this stage require formal deficiencies to be remedied; nor can it raise objection on the ground that there is a lack of unity of invention; it also follows that division of a European patent is not permissible during opposition proceedings. This limitation on the powers of the Opposition Division has been imposed for the reason that otherwise many published specifications (and translations made pursuant to Article 97a) would probably need to be revised, even though no limitation on the extent of the protection conferred by the patent was required.

70. Paragraphs 4 and 5 of the 1970 First Preliminary Draft of Article 105 have been cancelled. Paragraph 4 expresses a general principle, applicable also to other proceedings as is clear from Article 78, paragraph 5, Article 96, paragraph 2 and Article 115, paragraph 5 of the 1970 First Preliminary Draft. This principle is now embodied in a new Article 139. Paragraph 5 was regarded as superfluous in view of the provisions of Articles 59 and 60.

71. A new Article 105a defines the effect of a final decision wholly or partly revoking a European patent. The patent to the extent to which it is revoked, is to be regarded, in each State covered by it, as never having had "the same rights as would be conferred by a national patent" granted in that State. It was not thought wise to define the retrospective effect of this provision any more closely, since this would tend to interfere too much with the civil procedures of Contracting States.

72. Article 106 has been cancelled, following the transfer of its contents to a new Article 140, dealing with the general question of oral proceedings.

73. In connection with Articles 101 to 107, it did not seem necessary to make any provision concerning the surrender or lapse of a European patent during opposition proceedings. Moreover, it was felt that it would not be advisable to impose any limitation on the possibility of engaging in national revocation actions on a European patent or of deciding such actions, until the time limit for opposition has expired or a final decision on an opposition has been given. It was considered that a national court would be likely to stay any national revocation action started and that it was accordingly unnecessary to impose any fetter by a provision in the Convention. Such a provision would in any case be likely to be impractical without interfering with the procedural rules under which national courts operate.

REPORT BY THE FRENCH DELEGATION ON THE AMENDMENTS TO CHAPTER IV

CHAPTER IV

APPEALS

(Articles 108 to 116)

74. The second part of the first sentence and the second sentence of the previous text of Article 113, paragraph 3, have been deleted. These provisions, which referred to the additional reports on the state of the art requested of the IIB by the Board of Appeal, are contained in Article 137 which combines all the provisions relating to additional reports on the state of the art requested by the European Patent Office. Basically no change.

75. The provisions of Article 114 have been transferred to Article 140 which refers to oral proceedings before all the departments of the European Patent Office. Basically no change.

76. Certain additions to paragraph 3, second sentence, of Article 115 are intended to extend to cover opposition proceedings the previous provisions, which enabled the Board of Appeal either to take a final decision itself or to remit the matter to the authority originally responsible for the decision, and which were restricted to the procedure for the grant of a European patent.

REPORT BY THE GERMAN DELEGATION ON AMENDMENTS TO CHAPTER V

CHAPTER V

INTERNATIONAL APPLICATION PURSUANT TO THE PATENT CO-OPERATION TREATY

OF 19 JUNE 1970

(Articles 117 to 123)

77. Articles 117 to 123 and some other provisions of the 1970 First Preliminary Draft have been adapted to correspond to the final version of the PCT, which was adopted by the Washington Diplomatic Conference (25 May to 19 June 1970). In addition, Article 118 was considered superfluous and deleted. The following should be noted in connection with the individual Articles.

78. The purpose of Article 118 of the First Preliminary Draft was to make it clear that the European Patent Office may assume functions in the context of the PCT even if the Treaty or an individual Chapter of the Treaty has not yet entered into force in respect of all the Contracting States to the Convention establishing a European System for the Grant of Patents. Such an intention on the part of the Contracting States is implicit in the wording of Articles 119 and 121 and the recently inserted Articles 121a and 121b, and therefore does not need to be stated explicitly. Article 118 was therefore deleted.

79. Article 119, paragraph 3, provides that, subject to the prior approval of the Administrative Council and on the basis of a decision by the PCT Assembly, the European Patent Office may also act as receiving Office if the applicant is a resident or national of a State not party to the PCT; this paragraph was restricted in the light of the wording of Article 9, paragraph 2, of the PCT adopted in Washington. It was stated explicitly that in such cases the European Patent Office may only act as receiving Office for international applications filed by persons who are nationals or residents of States party to the Paris Convention for the Protection of Industrial Property.

80. Article 120, paragraph 3, was drawn up as the contractual basis for the levying of the transmittal fee which the receiving Office may require under Rule 14.1 of the Regulations under the PCT. The date of filing the international application was laid down as the due date, as the European Patent Office will have no later opportunity to ensure that the fee is paid.

81. Article 121, paragraph 1, was first amended to the effect that an applicant filing an international application for a European patent and not merely for national patents in individual European States must state this intention in the international application. According to the earlier versions of the First Preliminary Draft the applicant could make such a declaration at a later date, i.e. within 12 months after the priority date of the application. In the light of the second provision of Article 4, paragraph 1(ii) of the PCT as adopted in Washington, this solution could not be retained.

82. A second sentence was also added to Article 121, paragraph 1 to take into account the last provision of Article 4, paragraph 1(ii) of the PCT. This part of the sentence provides that the national law of a State party to the PCT may lay down that the designation of that State in an international application has the effect of an application for a regional patent. If a Contracting State to the Convention establishing a European System for the Grant of Patents takes advantage of this possibility, the designation of that State in an international application has the effect of an application for a European patent in accordance with the newly inserted second sentence of Article 121, paragraph 1; in this event the designated Office will therefore be the European Patent Office.

83. The latter case also had to be borne in mind in Article 121, paragraph 2: in so far as any group of Contracting States has made use of the authorisation under Article 8 of the Convention, specifying that European patents may only be granted for all the States in the group and not in respect of some only of the States, and if one of the States belonging to the group has specified that its designation always has the effect of an application for a regional patent, the group must be able to prescribe that the designation of that State in an international application is to be taken as the designation of all the Contracting States in the group. Such provision is made in the newly inserted second sentence of Article 121, paragraph 2.

84. Article 121, paragraph 3, refers to Article 25, paragraph 2, of the PCT which provides that each designated Office specified in an international application shall, at the request of the applicant, decide whether measures taken in the procedure laid down in the PCT and resulting in the termination of the procedure were justified; the relevant designated Office will resume the procedure if it finds that the international procedure was terminated without justification. Article 121, paragraph 3, names the Examining Division as the competent department in the event of the European Patent Office being called upon as a designated Office in accordance with Article 25, paragraph 2(a) of the PCT.

85. Article 121a is new and lays down in connection with Article 121 the cases in which the European Patent Office may act as an International Preliminary Examining Authority; the only reference made to this case in the earlier versions of the First Preliminary Draft was in paragraph 2 of Article 118, which has now been deleted. Article 121a, paragraph 1, is concerned with the conventional case, whereby the European Patent Office is to act as an International Preliminary Examining Authority for applicants who are residents or nationals of a Contracting State bound by Chapter II of the PCT. Paragraph 2 provides that on the basis of a decision of the PCT Assembly, the European Patent Office may, on certain conditions, also assume the functions of an International Preliminary Examining Authority for other applicants; this paragraph takes into account Article 31, paragraph 2(b) of the PCT.

86. According to Article 34, paragraph 3(a) of the PCT, if the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention, it may invite the applicant to restrict the claims or to pay an additional fee. In provision for the case that the applicant objects to such an additional fee being charged by the European Patent Office in its capacity as International Preliminary Examining Authority in accordance with the PCT, Article 121a, paragraph 3, lays down that the Boards of Appeal shall be responsible for deciding on the protest. The allocation of responsibility for these decisions to the Boards of Appeal seemed advisable, as the case would involve reviewing a decision made by another department of the European Patent Office.

87. Article 121b is also new. It lays down all the provisions governing the case of the European Patent Office being designated as an elected Office within the meaning of Chapter II of the PCT. The first sentence corresponds to Article 118, paragraph 3 in the earlier versions of the First Preliminary Draft. The second sentence takes into account the provision of the PCT adopted at the Washington Conference and already referred to in connection with Article 121a, paragraph 2; according to this provision, the PCT Assembly may decide to allow nationals or residents of certain States which are not party to the PCT to apply for preliminary examination of their international applications (Article 31, paragraph 2(b) of the PCT). Applicants from those States may however elect only such Contracting States to the PCT as have declared that they are prepared to be elected by such applicants (Article 31, paragraph 4(b), second sentence, of the PCT). The second sentence is

to provide the contractual basis for the possibility of making a declaration under Article 31, paragraph 4(b), second sentence, of the PCT in respect of the European Patent Office subject to the prior approval of the Administrative Council.

88. Earlier versions of the First Preliminary Draft contained a fourth paragraph of Article 121, which provided that the designation fee provided for in Article 67, paragraph 2, should not be payable for international applications. The Inter-Governmental Conference based its adoption of this provision on the fact that according to Rule 15.1 of the Regulations under the PCT, a designation fee has already been paid in respect of each designated State for an international application, and that this serves the same purpose as the designation fee under Article 67, paragraph 2. There should be no possibility of the applicant being made to pay duplicate fees. At the Washington Conference it was decided, however, that where an international application is made for a regional patent, only one designation fee is to be levied covering all the designated States. There is therefore no cause for dispensing with the designation fee under Article 67, paragraph 2 in the case of an international application for a European patent. Article 121, paragraph 4, was therefore deleted.

89. However, the deletion of Article 121, paragraph 4, now has the consequence that for the first designated State in respect of which application is made for a European patent the international applicant pays a double fee, namely, the designation fee under the PCT and the designation fee under Article 67, paragraph 2. As these fees are relatively low, a perfect solution providing for the calculation of the designation fee under the PCT on the basis of the designation fee under Article 67, paragraph 2, could be dispensed with. It did not seem necessary to provide for a reduction in the European filing fee for international applications on the grounds that, pursuant to the PCT, a formal examination of the application has already been undertaken in the international proceedings and this therefore reduces the work at the European Patent Office.

90. Article 122, paragraph 1, corresponds to the earlier versions of the First Preliminary Draft. The question of a reduction in the search fee where an international search report is filed with the application, is still to be examined in another context, as are other questions raised by the non-governmental international organisations.

91. Article 122, paragraph 2, of the published First Preliminary Draft, which laid down that the European Patent Office might at any time and for all international applications obtain a supplementary report on the state of the art from the IIB, has been deleted from this position. The rule is now contained in Article 137, which also goes beyond the original wording of Article 122, paragraph 2, in providing that the cost of a report obtained by the European Patent Office to supplement an international search report, is to be borne by the applicant.

92. Pursuant to Article 17, paragraph 3(a) of the PCT, it will be possible for the international search authority

to draw up a search report on one part only of an international application if it does not consider the application to be unitary and if the applicant is not prepared to pay an additional fee. Paragraph 3(b) of this Article lays down that a designated Office may regard as withdrawn those parts of the international application in respect of which a search has not been carried out, unless the applicant pays a special fee to this designated Office. It was not considered necessary to adopt a specific provision covering this case in the context of the European system for the grant of patents; Article 79, paragraphs 5 and 6 would be adequate.

93. In other chapters of the Convention the following alignments with the PCT were made. While these are intended to be of purely editorial significance, they nevertheless go further than mere correction of references:

The wording of Article 9, paragraph 2, was partly aligned with Rule 39.1 of the Regulations under the PCT.

Article 13 was aligned with Article 33, paragraph 3, of the PCT by adding the words "to a person skilled in the art".

An alignment of Article 11, paragraph 2, with Rule 64.1(a) of the Regulations under the PCT and of Article 14 with Article 33, paragraph 4, of the PCT was considered unnecessary.

REPORT BY THE SWISS DELEGATION ON CHAPTER VI

CHAPTER VI

CONVERSION OF A EUROPEAN PATENT APPLICATION INTO A NATIONAL APPLICATION (Articles 124 to 127)

94. The drafting of Articles 124 to 128 on the conversion of a European patent application into a national application was adjourned in the 1970 First Preliminary Draft. These provisions have now been drawn up (Articles 124 to 127). They are explained as follows:

95. It does not seem advisable to give an applicant whose European patent application has been rejected or withdrawn or is deemed to be withdrawn an unrestricted right to convert the application into a national application. A general authorisation of this nature would encroach too heavily on national law, jeopardise legal security and excessively reduce the authorisation given to the Contracting States to the PCT in Article 45 of this Treaty.

For these reasons therefore, the Contracting States are only obliged in Articles 124 *et seq.* to allow a conversion if it is essential for safeguarding the legitimate interests of the applicant under the system set up by the Convention. This would be true in the cases mentioned in Article 124, paragraph 1(a), *i.e.* the situation in which a European patent application filed with a national industrial property office is not forwarded to the European Patent Office within the period laid down in Article 65, paragraph 5, and the case in which the European patent application is affected by procedural limitations pursuant to Article 157, paragraph 3, during a transitional period. If either of these two circumstances, which are beyond the control of the applicant, arises, he is to have the opportunity to prosecute his rights under national procedure. Otherwise Article 124, paragraph 1(b) leaves it to the discretion of the Contracting States to decide whether or not to allow a conversion into a national application in other cases, for example if a European patent application is rejected on the grounds of lack of inventive step. However, under Article 124, paragraph 2, conversion always requires that the European patent application be terminated by means of a rejection or a withdrawal. In that case the notification from the European Patent Office that the application cannot be processed further has the same effect as the withdrawal of the application would have had (Article 157, paragraph 3). If the request for conversion is not filed within the three month period prescribed in Article 124, paragraph 2, the European patent application loses its effect as a regular national filing (Article 76, paragraph 1). This means that provided that the request for conversion is filed regularly and within this period, the European patent application retains this effect. The proprietor of a national patent granted as a result of this request thus retains in particular the priority and filing dates of the European patent application.

96. Articles 125 to 127 contain the rules of procedure for the request for conversion. It is essential that the request should be filed at the European Patent Office, except in the case of Article 65, paragraph 5 as dealt with in Article 124, paragraph 1(a). Thus the applicant needs to file only one request, and the European Patent Office will be able to send a copy of the documents relating to the European patent application simultaneously to each of the States in which the applicant wishes national procedure to be applied, with a saving on costs. Article 126 guarantees that national procedure shall not require the applicant to comply with more stringent requirements than those provided for in the Convention and the Implementing Regulations. The Contracting States are however free to require filing fees and the filing of a translation of the application into the national official language. As a derogation from Article 125, Article 127 provides for the filing of the request for conversion at the national industrial property offices in the event of the request being filed because the national industrial property office has failed to forward the European patent application to the European Patent Office within the period laid down.

**REPORT BY THE SWISS DELEGATION ON
THE AMENDMENTS TO PART VI**

PART VI

**RENEWAL OF
EUROPEAN PATENT APPLICATIONS AND
EUROPEAN PATENTS**
(Articles 129 to 132)

97. Articles 129 to 132 on the renewal of European patent applications and European patents, are unchanged, with the exception of Article 130, paragraph 1, where a textual amendment makes it clear that the renewal fees for the European patent application are to be paid in advance.

**REPORT BY THE UNITED KINGDOM DELEGATION
ON PART VII**

PART VII

REVOCATION OF THE EUROPEAN PATENT
(Articles 133 and 134)

98. These Articles result from the direction of the Inter-Governmental Conference in April 1970 to adopt the "maximum approach", according to which the validity of a European patent shall not be subjected in the Contracting States to tests additional to those applied by the European Patent Office.

99. Article 133 provides that a European patent may only be revoked on certain defined grounds. It was felt that it would be going too far at this point in time to impose an obligation on Contracting States to revoke on all these grounds. The solution proposed has the result therefore that a European patent may in theory be declared valid in one State and invalid in another. This will in practice be unlikely in view of the limited number of grounds available; Article 133 is likely to encourage all States to amend their national laws to conform with all the grounds of revocation available to them. In any case the wording of the Article prevents any State from revoking a European patent on any ground not specified in the Article. This appears to be a sufficient guarantee to users of the European system that a patent granted by the European Patent Office will not be revocable nationally on grounds drawn from national law alone.

100. As regards the grounds, it was decided that they should be strictly limited. Grounds (a) to (c) are in fact the same grounds on which a European patent may be opposed pursuant to Article 101a. Ground (d) has been added in order to deal with cases in which inadvertently the claims of a European patent were widened in scope during an opposition before the European Patent Office (this is contrary to the provisions of Article 104).

101. The special case was discussed of a European patent effective in a Contracting State in which there is a prior national patent for the whole or part of the invention protected by the European patent. No doubt States will wish to have the possibility of revoking the European patent in such a case. However, Article 9 of the second Convention, which is open only to the EEC States, provides a different solution according to which the European patent is to have no effect in the State where there is a prior national right to the extent that, had it been a national patent, it would have been revoked. In order to cater for both solutions—and possibly others—Article 133 does not provide for the revocation of a European patent on this ground, but it is made subject to Article 134 which leaves this question to be treated in accordance with the provisions of national laws. It follows that a Contracting State may have the sanction of revocation on this additional ground or may treat the matter in some other way.

102. Article 133, paragraph 2 provides a more flexible solution than the 1965 version of the EEC Preliminary Draft Convention. In the event of a decision partially revoking the European patent, the necessary limitation of the patent may, if the national law allows, be effected by amendment of the description, claims and drawings.

**REPORT BY THE SWEDISH DELEGATION
ON PART VIII**

PART VIII

**COMMON PROCEDURAL PROVISIONS OF
THE EUROPEAN PATENT OFFICE**
(Articles 135 to 156)

103. Part VIII of the Second Preliminary Draft Convention deals with general provisions governing procedure (Chapter I), admission of public, notifications and inspection of files (Chapter II), costs and their enforcement (Chapter III), representation (Chapter IV) and finally opinions given to the national courts by the European Patent Office (Chapter V). Several of the provisions contained in Part VIII of the Draft are to be re-examined with government legal experts.

CHAPTER I

**GENERAL PROVISIONS GOVERNING
PROCEDURE**

104. Article 135 provides that members of the Board of Appeal may be objected to by any party *e.g.* for reasons of challenge or suspicion of partiality. The Board of Appeal shall decide as to the action to be taken when an objection is raised. The question whether the members concerned should not take part in the decision is to be examined with the legal experts. If such an exclusion is accepted, a study will still have to be made as to which rules are to apply in the case of a Board becoming

incompetent to take decisions because of objections raised against several or all of its members.

105. With regard to Article 136, paragraph 4, the question whether the European Patent Office should be given the power to impose a fine on a witness who fails to appear is to be discussed with the legal experts. However, this power could be deemed unnecessary since the European Patent Office could arrange for witnesses to be heard by courts of the individual Contracting States as already provided for in paragraph 6.

Paragraph 5 provides that each Contracting State shall –on notification by the President of the European Patent Office–treat any perjury as if the offence had been committed before one of its national courts. Paragraph 5 is also to be examined with the legal experts.

106. Article 137 lays down that the European Patent Office may at any time obtain a supplementary report on the state of the art from the IIB. The costs for the report shall—at least when caused by amended claims or by the necessity to supplement a PCT report—be borne by the applicant. However, this Article is to be re-examined in the light of the views already expressed by the international organisations, who have proposed to combine the filing fee and the search fee and to make this fee an average fee which would not require additional fees for supplementary searches mentioned under paragraph 2(a) and (b).

107. Article 138 gives the applicant the right to submit different sets of claims for different States in the case where an earlier patent application forms part of the state of the art under Article 11, paragraphs 3 and 4, and the designations are overlapping. The question is still open whether the same possibility should be extended to the description.

108. Article 139 lays down the principle that decisions before the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

109. Article 140 deals with oral proceedings which shall take place at the instance of the European Patent Office or at the request of any party to the proceedings. This general principle is subject to an exception laid down in paragraph 2 (transferred from Article 84 in the First Preliminary Draft) which gives to the applicant an absolute right to be orally heard only when the Examining Section proposes to refuse the application wholly or in part.

110. The provision in Article 142 gives the applicant, who is prevented by *force majeure* from observing a time limit, the possibility to re-establish his right under certain conditions. Time limits which are excluded from the right of re-establishment are the time limit for payment of the filing fee, the twelve months priority period, the sixteen months period for filing complete information about the application on which priority is claimed, the period for filing the request for examination and the time limit for filing a divisional application after limitation of the original application.

Paragraph 6 states that in the case of the exploitation of the invention by any person in good faith during

the period between refusal of the application and notification of the re-establishment of the applicant's rights the exploitation may freely continue.

Article 142 only deals with the possibility for the applicant to re-establish his rights. However it is to be later examined whether Article 142 should be extended to cover patentees and opponents.

111. Article 143 deals with the consequences of the death of the applicant in respect of the European patent application if his heirs cannot be located. The provision will be further studied with the legal experts.

112. The provision under Article 144 makes it clear that both in the examination and appeal proceedings and in the opposition proceedings the European Patent Office is bound by the form of the application or the patent approved by the applicant or patentee.

113. In the absence of procedural provisions in the Convention the European Patent Office shall take into account the principles of procedural law commonly recognised in the Contracting States. In the absence of such common principles the European Patent Office shall draw upon the legislation of one or more Contracting States (Article 145). This question will be examined with the legal experts.

CHAPTER II

ADMISSION OF PUBLIC, NOTIFICATIONS AND INSPECTION OF FILES

114. Oral proceedings shall with certain exceptions be public if they are held before the Boards of Appeal or the Opposition Divisions and if they deal with a published European patent application (Article 147).

115. Apart from certain bibliographic data—including among other data the title of the invention—the files relating to European patent applications shall not be made available for inspection before the 18-month publication without the consent of the applicant (Article 149).

However, this main principle is subjected to exceptions. One of them (paragraph 2) admits a competitor, who had begun manufacturing operations, to inspection of the files when the circumstances are such that he should be able to decide, in full knowledge of the facts, whether or not to continue to exploit or invest in the invention. The second exception concerns a published divisional application. If the original application has not been published (for example was withdrawn) a competitor should be able to check whether *e.g.* the priority claimed for the divisional applications was indeed correct (paragraph 3).

After the 18-month publication both the documents relating directly to the proceedings for the grant of a European patent and those relating to opposition proceedings may be inspected by third parties.

The President of the European Patent Office shall decide whether the bibliographic data referred to in paragraph 6 will be automatically published or only be communicated to third parties on request.

A proposal to include the classification symbols in the bibliographic data was considered. However, this goes further than the corresponding PCT provision (Article 30, paragraph 2(b)).

116. According to Article 150 the applicant must on request furnish information (reference numbers and countries) about national applications for the whole or part of an invention which is the subject of a European application. Failing this the application is refused. This provision completes the system for exchange of search and examination result provided for in Article 62.

CHAPTER III

COSTS AND THEIR ENFORCEMENT

117. The costs of proceedings for grant—in particular the costs of obtaining evidence—shall in principle be borne by the applicant himself. In the case of opposition proceedings each party shall meet the costs he has incurred unless a decision of the Opposition Division or the Board of Appeal orders an equitable apportionment of the costs incurred in hearing the parties or during a preliminary investigation (Article 151, paragraph 1). The apportionment of costs shall be dealt with in the decision in the opposition and shall only take into account expenses necessary to assure proper protection of the rights involved.

118. Decisions of the European Patent Office taxing costs of the proceedings or imposing fines shall themselves be enforceable (Article 152, paragraph 1). The enforcement shall be regulated by the rules of civil procedure in the Contracting State in whose territory the enforcement takes place. Each Contracting State shall appoint a national authority which issues the enforcement order received from the European Patent Office (Article 152, paragraph 2). Thereafter the interested party may enforce execution by direct application to the competent authority in accordance with national law (Article 152, paragraph 3).

Another solution proposed is to state only that a decision of the European Patent Office taxing costs or determining a fine should be enforceable in accordance with the legislation of the Contracting State in which the enforcement takes place, in the same way as a judgment of a Court of that State.

The questions of enforcement will be re-examined with the legal experts.

CHAPTER IV

REPRESENTATION

119. According to Article 153 representation before the European Patent Office may only be undertaken by natural persons appearing on a list at the European Patent Office. This is subject to an exception when the representative is a legal practitioner able to act as a representative in patent matters in a Contracting State (paragraph 5).

The qualification required of a representative and enabling him to be entered on the list are laid down in paragraphs 2 and 3.

The question whether legal persons should be able to represent has been considered. A practical solution to this problem might be that those members of the leading bodies of legal persons who intend to appear before the European Patent Office should have themselves entered on the list at the European Patent Office.

The question of professional representation will be re-examined in light of the discussions with the interested circles.

120. Natural and legal persons not having either a residence or a registered place of business in one of the Contracting States must be represented in all proceedings before the European Patent Office. Persons within the Contracting States are not compelled to be represented (Article 154).

121. When discussing the question of compulsory representation it was considered whether compulsory representation could be limited to certain procedural steps only or even that there should be a requirement only to name an address for service with which the European Patent Office could correspond.

However, it was concluded that all procedural steps must in principle be undertaken through a representative. One exception should be—in the interest of the applicant—filing of the application, subject to a representative being appointed within a specific period (cf. paragraph 3). It was agreed that further exceptions could be laid down in the Implementing Regulations. In the present draft of the Regulations an additional exception is made in the case where a request for examination is made by a third party.

Finally it was concluded that procedural steps for which no exception is permitted should not be effective unless undertaken by the representative.

122. Article 155 deals with the authorisations. It has been discussed whether an individual authorisation should be required or whether a general authorisation might be sufficient. It was pointed out that in certain countries with general authorisations there has been some unsatisfactory experience with this system. The question was left to be solved in the Implementing Regulations. The solution proposed is that in all cases where a general authorisation has been granted the President of the European Patent Office is able to impose the use of a standard form.

Special rules with regard to the continuation, on the death of the issuing person have been provided for in paragraph 3.

In any case a representative shall continue to be regarded as the representative until the termination of his authorisation has been communicated to the European Patent Office.

Article 155 will also be discussed with the legal experts.

CHAPTER V

OPINION BY THE EUROPEAN PATENT OFFICE

123. Article 156 gives the possibility—but no obligation—to national courts in case of trying an infringement or revocation action concerning a European patent to ask the European Patent Office for a technical opinion. This provision does not entail delivering legal opinions or more particularly, pronouncing as to the validity of a European patent.

The cost of the opinions shall be borne by the Courts asking for the opinions.

PART IX

TRANSITIONAL PROVISIONS

REPORT BY THE NETHERLANDS DELEGATION ON ARTICLE 157

124. Article 157 concerns the initial period of the European Patent Office and the treatment of applications for European patents during that period. The European Patent Office will not have sufficient staff at first to examine all the applications for patents pursuant to Article 88. The Administrative Council may therefore restrict this examination to certain areas of technology.

As regards these areas of technology, it is probable that the European Patent Office will be able to process the applications up to the stage of the publication of the application. In this way, a uniform stage will be reached in the proceedings as in proceedings under the PCT.

125. The second paragraph is intended only as a safety valve; if, for example, the European Patent Office were not able to carry the processing of the application to this stage or if the IIB were not yet able to draw up reports on the state of the art in certain areas, the Administrative Council would be able to restrict the proceedings at its own discretion. However, examination must be made as to whether the European patent application meets the conditions set out in Article 68, so that the applicants may in any event have the benefit of a priority date.

126. If a patent application cannot be further processed as a result of these restrictions, this application may be converted into a national application, pursuant to Articles 124 *et seq.* (See also paragraphs 94 to 96 above).

REPORT BY THE UNITED KINGDOM DELEGATION ON ARTICLE 159

127. Article 159 concerns reservations which may be made by a State when it signs, ratifies or accedes to the Convention. The intention is to allow a State to become a member of the Convention, even though its national circumstances are such that for a time the State in question is unable to fulfil all the obligations imposed by the Convention.

128. Notwithstanding the provisions of Article 133, a State may reserve the right to revoke or make ineffective a European patent relating to food or drugs or to agricultural or horticultural processes (excluding those involving microbiological processes) if it does not grant national patents for such products or processes. Moreover, if the term of its national patents is less than the 20 years provided for in Article 20a, the State may reserve the right to grant such lesser term to a European patent covering the State.

129. Such a reservation is effective only during a period of 10 years from the date on which the Convention enters into force. It is to be noted that this period does not run from the date of ratification by the State concerned.

130. Paragraph 2 provides that any reservation made should be withdrawn as soon as circumstances permit.

REPORT BY THE GERMAN DELEGATION ON ARTICLE 160

131. Observations on Article 160 (Period within which a request for examination may be made during a transitional period) are included under paragraphs 53 and 54 above.

INTRODUCTORY REPORT

ON THE FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS TO THE CONVENTION ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

RAPPORTEUR: Mr P. FRESSONNET

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as Chairman

*of the "Implementing Regulations" Sub-Committee
of Working Party I of the Inter-Governmental Conference*

1. At its meeting from 1 to 3 April 1970, Working Party I decided that while it was drawing up the First Preliminary Draft of a Convention establishing a European System for the Grant of Patents, work should begin at the same time on the First Preliminary Draft Implementing Regulations to the Convention, since these two texts are ultimately to be adopted by the Diplomatic Conference of representatives of the States concerned. To this end, it set up a Sub-Committee which met five times, the first meeting being held at the end of June 1970, immediately after the Washington Diplomatic Conference on the Patent Co-operation Treaty, and the last in mid-January 1971.

2. The result of the work of the Sub-Committee was submitted to Working Party I at its meeting of 26 to 29 January 1971, and subsequently at the Inter-Governmental Conference at its 4th meeting held from 20 to 28 April 1971. The latter adopted with some modifications the submitted text as the First Preliminary Draft of the Implementing Regulations, on the understanding that it would subsequently be submitted to government legal experts of the countries of the delegations participating in Working Party I for examination and to the non-governmental international organisations for their observations.

3. The First Preliminary Draft of the Implementing Regulations consists of 125 Articles in provisional order some of which include a large number of necessarily detailed provisions: this is the case, for example, with those dealing with the form and content of the various documents making up the European patent application.

Subject to later examinations, the text covers all the procedures for implementing the Articles of the Convention, with the exception of the texts drawn up by Working Party II (Articles 35a to 35p and 162 to 173), Working Party III (Article 39) and Working Party IV (Articles 41 to 52d and 158), in so far as these Articles require implementing provisions, and with the exception of the Rules relating to Fees.

4. The First Preliminary Draft of the Implementing Regulations is extremely comprehensive and detailed and may sometimes appear unnecessarily complicated. The Sub-Committee was not unaware of this and attempted to exclude from the Implementing Regulations all the provisions which, in its opinion, could come into the field of jurisdiction of the President of the European Patent Office.

However, the Sub-Committee considered that the text could not be simplified except at the expense of clarity and of the guarantees which any person involved in the various procedures before the European Patent Office ought to enjoy, and that the absence of a provision on a particular point—which it may be easy to remedy by referring to common law or to general legal principles in the case of a national text—might lead, at international level, to questionable or questioned solutions.

5. The General Report published hereunder, drawn up by Dr R. SINGER, Abteilungspräsident at the German Patent Office, contains a commentary on most of the Articles of the First Preliminary Draft of the Implementing Regulations. There is no doubt that this remarkable commentary will facilitate comprehension of the proposed text and of the intentions of the Sub-Committee.

6. I should like, nevertheless, to draw the reader's attention to the three essential parts of the text, which concern: the use of languages, the formalities involved in filing a European patent application and the general procedural provisions.

Obviously, the question of the use of languages before the European Patent Office is extremely important. Seventeen different languages are in official use on the territory potentially covered by the European patent. It would not be reasonable to impose on the European Patent Office the current use of these languages in written or oral proceedings. Normally, the language of the proceedings is that of the European patent application, as determined in the conditions laid down in Article 34,

paragraph 3, of the Convention, that is, German, English or French, "subject to the exceptions provided for in the Implementing Regulations".

I think it is fair to say that the Sub-Committee has tried to reach the absolute limit of the possibilities of the European Patent Office as regards the use of languages in proceedings. A single example will suffice: that of the derogation provided for in the Implementing Regulations, Re. Article 34, No. 5, paragraph 4, under the terms of which, if the parties and the European Patent Office agree, any language may be used in oral proceedings.

The Sub-Committee made every effort to diminish by all possible means, including the reduction of the filing, examination, opposition and appeal fees (Re. Article 34, No. 2), the difficulties that might be experienced by parties to proceedings before the departments of the European Patent Office when such parties do not have sufficient command of English, French or German.

7. Numerous provisions relate to the formalities for filing a European patent application. They are necessarily detailed.

In this connection the Sub-Committee was able to draw to a large extent on previous work, in particular that done in Strasbourg by the Council of Europe Committee of Patents Experts and, more recently, in Geneva and Washington under the auspices of WIPO during the preparation and conclusion of the Patent Co-operation Treaty and the Regulations under that Treaty.

The memorandum of 10 March 1969, on which the States taking part in the Inter-Governmental Conference based their work when setting up the European System for the Grant of Patents, includes the recommendation that "it would be necessary to arrange that the provisions of the two instruments (PCT and European System for the Grant of Patents) relating to the filing of applications would be harmonised".

This harmonisation has been achieved in the First Preliminary Draft of the Implementing Regulations. It is of course true that the PCT and the Regulations under it

have allowed the Sub-Committee the possibility of adapting certain provisions as it thought fit.

However, the Sub-Committee was constantly concerned with avoiding any administrative complication for the European Patent Office which might result from European patent applications which it receives directly being presented differently from those sent to it in accordance with the rules of the PCT.

8. Finally, the Implementing Regulations contain important details on the proceedings taking place before the departments of the European Patent Office. Some are concerned specifically with patent law and are based on the regulations currently in force in the various national industrial property offices of the European countries. Others are more generally concerned with civil procedure and have been taken as far as possible from the Rules of Procedure of the Court of Justice of the European Communities. They will have to be carefully examined by the government legal experts.

9. The First Preliminary Draft of the Implementing Regulations is the joint work of the six delegations to the Sub-Committee, and this work also involved the close co-operation of the observers from WIPO and the International Patent Institute and of the Conference Secretariat. Proposals and counterproposals have been submitted by all the delegations, and even by the observers when invited to do so, in a friendly spirit of mutual understanding and great competence.

10. I wish to take this opportunity to thank everyone for the efforts that they have made over the last seven months. If the results of the work that I am proud to submit are considered satisfactory, all the credit is due to the whole team. With your permission, however, I should like to extend particular thanks to the members of the Drafting Committee and to its Chairman, Mr NEERVOORT, Secretary of the Netherlands Patent Office (Octrooiraad), and express my heartfelt gratitude to the General Rapporteur of the Sub-Committee, Dr R. SINGER, Abteilungspräsident at the German Patent Office, whose profound knowledge of patent law has given me so much assistance.

GENERAL REPORT

ON THE FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS TO THE CONVENTION ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

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"Implementing Regulations" Sub-Committee of Working Party I
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11. At its fourth meeting from 1 to 3 April 1970, Working Party I of the Inter-Governmental Conference for the Setting up of a European System for the Grant of Patents decided to set up a Sub-Committee to draw up the Implementing Regulations to the Convention establishing a European System for the Grant of Patents. All the delegations of Working Party I sent representatives to this Sub-Committee.

12. The Sub-Committee has held five meetings: from 24 to 26 June, from 15 to 18 September, from 20 to 23 October, from 23 to 27 November 1970 and from 12 to 14 January 1971. It has drawn up a First Preliminary Draft of the Implementing Regulations to the Convention establishing a European System for the Grant of Patents.

The Sub-Committee is very conscious of the fact that this enormous task was only able to be completed as a result of the intensive preparatory work carried out by its Chairman, Mr J.P. FRESSONET, Deputy Director, National Institute of Industrial Property, Paris, and of the authoritative and judicious way in which he conducted the meeting. At the same time I would like also to extend especial thanks to the excellent Chairman of the tireless Drafting Committee, Mr NEERVOORT, Secretary of the Netherlands Patent Office (Octrooiraad), who was chiefly responsible for the decisions of the Working Party emerging in the form of a comprehensible legal text.

At its 7th meeting, which was held from 26 to 29 January 1971, Working Party I took note of the First Preliminary Draft of the Implementing Regulations and adopted it with certain amendments.

The Sub-Committee has not examined whether the provisions drawn up by Working Parties II to IV require implementing regulations.

13. In drawing up these Articles, the Sub-Committee based its work mainly on the hitherto unpublished draft Implementing Regulations to the Convention on a European Patent Law which was drawn up in 1964 by

the EEC "Patents" Working Party. The Sub-Committee also endeavoured to bring the results of their work, and particularly the provisions on the application, into line with the provisions of the Regulations under the PCT. The general procedural provisions drawn up by the Sub-Committee are in part closely based upon the Rules of Procedure of the Court of Justice of the European Communities.

14. As in the above-mentioned 1964 Draft, the individual proposals of the Sub-Committee are numbered according to the Articles of the Convention for which Implementing Regulations have been drawn up. As a result, the order of the submitted Articles follows the order of the Articles of the Convention. The Sub-Committee assumes, however, that the Implementing Regulations will be numbered consecutively at a later date.

On the question of whether and which Articles of the First Preliminary Draft of the Implementing Regulations could be incorporated into the Convention, the Sub-Committee did not in principle adopt a position. In their view, this division ought to be undertaken only when all the legal texts are finally revised.

In view of the scope of the results of the work, this report deals only with those Articles which are of especial importance to the system for the grant of patents or which gave rise to particular differences of opinion among the delegations of the Sub-Committee at the drafting stage. A commentary on the few Implementing Regulations to Part I (Articles 1 to 8a—General Provisions), Part VI (Articles 129 to 132—Renewal of European Patent Applications and European Patents) and Part IX (Articles 157 to 160—Transitional Provisions) of the Convention, seems unnecessary if this principle is applied. The Sub-Committee did not draw up any Implementing Regulations to Parts VII and X of the Convention (Revocation of the European Patent and Final Provisions). The following report is accordingly confined to the Implementing Regulations to Parts II to V and VIII of the Convention.

REGULATIONS CONCERNING PART II OF THE CONVENTION

SUBSTANTIVE PATENT LAW (Articles 9 to 28b)

15. Article 12(b) of the Convention provides that a disclosure of the invention by the applicant is non-prejudicial to novelty if it occurs at a specified international exhibition within six months preceding the filing date. The Implementing Provision thereto (Re. Article 12, No. 1) provides that this situation must be invoked on filing the European patent application and must be authenticated within four months of filing the application by a certificate from the organisers of the exhibition. This provision is modelled on the French law and is paralleled in the provisions of the Convention on claiming the priority of a previous application (Article 75, paragraphs 1 and 2, of the Convention).

16. Article 16 of the Convention protects the rights of the person entitled to apply if a European patent application has been filed by a person not entitled to apply. In the Implementing Regulations the aim has been to strengthen the position of the person entitled to apply: at his request, the proceedings for grant are to be suspended after the publication of the European patent application (Re. Article 16, No. 1, paragraph 1). As a result, the applicant cannot withdraw the application for a European patent during the suspension of the proceedings for grant without the agreement of the opposing party (Re. Article 16, No. 2).

If it has been established by a national court—or by a national authority as, for example, in the United Kingdom—that a person other than the applicant is entitled to the patent, that person may, under Article 16 of the Convention, lodge a new application at the European Patent Office claiming the priority of the previous application within three months of the entry into force of the decision. If the rightful claimant fails to lodge this new application within the specified period, the previous application to the European Patent Office remains in being. In such a case—admittedly not a frequent occurrence—the Implementing Regulations provide that the proceedings for grant of the previous application can be continued with the first applicant (Re. Article 16, No. 1, paragraph 2, second sentence). This consequence of Article 16 of the Convention was considered by one delegation to be unsatisfactory.

To cover the possibility of Article 16 of the Convention being extended to opposition proceedings, provisions have been drawn up on the suspension of opposition proceedings and on the limitation of the option to surrender the European patent during the suspension (Re. Article 16, Nos. 3 and 4).

The various problems arising out of Article 16 and the solution to be adopted in consequence in the Implementing Regulations in each instance will be re-examined.

17. With regard to the designation of the inventor (Article 17 of the Convention) there is a provision

that this may be effected by the applicant or the proprietor of the patent at any time before the end of the opposition period or of the opposition proceedings (Re. Article 17, No. 1) in so far as the national law of at least one of the Contracting States designated does not prescribe the designation of the inventor for a national application (Article 69a of the Convention). The designation of the inventor should be mentioned in all relevant publications, principally in the publications of the European Patent Office (Re. Article 17, No. 2).

18. Article 21 of the Convention deals with European patents of addition.

The relevant provisions of the Implementing Regulations should of course be deleted in the case that the envisaged re-examination of Article 21 should lead to the system of patents of addition being abandoned.

Article 21, paragraph 7, of the Convention provides that the applicant may convert an application for a European patent of addition into an independent European patent application, until such time as the European Patent Office informs him of the form in which it intends to grant the European patent. In the Implementing Regulations the reverse case, namely the conversion of an independent European patent application into an application for a European patent of addition, is expressly prohibited (Re. Article 21, No. 1).

It is also expressly stated that an application for a European patent of addition may only be dependent upon one single European parent patent and that it may not be dependent upon a patent of addition (Re. Article 21, No. 2).

In accordance with Article 21, paragraph 3, of the Convention, the European patent of addition will only be granted to the proprietor of the European parent patent. The Sub-Committee has therefore drafted an implementing provision which deals with the question of whom the European Patent Office is to regard as the proprietor of the European parent patent (Re. Article 21, No. 3).

19. Articles 23, paragraphs 2 and 3, and 28a of the Convention contain provisions on the entry of licences, *inter alia*, in the Register of European Patents.

An implementing provision thereto lays down that a licence in respect of a European patent application shall be recorded in the Register of European Patents as an exclusive licence if the applicant and the licensee so require (Re. Article 28a, No. 2, paragraph 1). This limitation to a purely formal recording requirement takes account of the fact that a definition of the exclusive licence among the States taking part in the Inter-Governmental Conference seems impossible.

A further Regulation will clarify the concept of the sub-licence for the purposes of the Register of European Patents: a sub-licence is to be recorded as such in the Register where it is granted by a licensee whose licence is recorded in the said Register (Re. Article 28a, No. 2, paragraph 2).

REGULATIONS CONCERNING PART III OF THE CONVENTION

THE EUROPEAN PATENT OFFICE (Articles 30 to 63)

20. The basic principles regarding the languages to be used in the European system for the grant of patents are laid down in Article 34 of the Convention. The Implementing Regulations contain further very detailed provisions on this problem which should give a fairly clear idea of the practice to be followed. These provisions form one of the main elements of the Implementing Regulations. They are characterised by an endeavour to achieve a balance between the necessity of using a single language in the proceedings for the grant of a European patent, and the interests of the parties concerned in using the language in which they are most fluent before the European Patent Office. The appropriate provisions were taken largely unchanged from the 1964 Draft.

21. It is laid down that the translation into the German, French or English languages of the European patent application submitted by the applicant in accordance with Article 34, paragraph 2 of the Convention shall in principle replace the application in the original language in proceedings before the European Patent Office. For the purposes of determining the extent of the protection applied for, it is however laid down that the European Patent Office may refer back to the original text. The time limit for the filing of the translation of the application has been fixed at three months after the filing of the application and in the case of a European patent application claiming priority, at thirteen months after the priority date (Re. Article 34, No. 1).

22. In order to provide compensation for translation costs for those persons who have to have their application and other documents translated, a reduction on a percentage basis of the filing, examination, opposition and appeal fees has been provided for (Re. Article 34, No. 2).

23. For the written proceedings, the principle laid down in Article 34, paragraph 3 of the Convention of the use of language of the proceedings has been broken in two respects. First, the opponent may submit his unsworn written statements in one of the two other languages of the European Patent Office instead of in the language of the proceedings. Secondly, documents used as evidence by the applicant or by the opponent, particularly technical publications, may be submitted in any language. The European Patent Office may, however, request an authenticated translation. The time limit for the submission of the translation of those unsworn written statements of the applicant or of the

opponent which are bound by a time limit and are not drafted in German, English or French, has been fixed at one month after the submission of the statement, in the interests of the rapid completion of the proceedings. If a translation has not been submitted within the time limit laid down, any unsworn written statement or the document to be used as evidence which should have been translated, will not be taken into consideration (Re. Article 34, No. 4).

24. There are numerous derogations from the provisions concerning the language of proceedings in oral proceedings. Any party may, in lieu of the language of the proceedings, use one of the other two languages of the European Patent Office on condition either that such party gives notice to the European Patent Office at least two weeks before the date laid down or makes provision for interpreting into the language of the proceedings. Any party may likewise use one of the other official languages of the Contracting States, on condition that he makes provision for interpretation into the language of the proceedings. Apart from English, French and German, there are fourteen other official languages in the States at present participating in the Inter-Governmental Conference, namely Croat, Danish, Dutch, Gaelic, Greek, Italian, Macedonian, Norwegian, Portuguese, Serbian, Slovenian, Spanish, Swedish and Turkish. In order to meet such requirements, regarding understanding of the parties to any given proceedings, as are not met by these liberal rules, provision is also made for the European Patent Office to permit derogations from the rules in question (Re. Article 34, No. 5, paragraph 1).

The officials of the European Patent Office should be able to use, in addition to the languages of the proceedings, one of the other two languages of the European Patent Office (Re. Article 34, No. 5, paragraph 2).

As is the general principle before courts, witnesses and experts should be able to use their own language before the European Patent Office. If they are not called by the European Patent Office but are heard at the request of one of the parties, such party must however make provision for statements not made in English, French or German to be translated into the language of the proceedings or into one of the other two languages of the European Patent Office, if this is allowed by the European Patent Office (Re. Article 34, No. 5, paragraph 3).

If all the parties and the competent officials of the European Patent Office agree, any language may be used in oral proceedings (Re. Article 34, No. 5, paragraph 4).

The European Patent Office is to make provision at its own expense for interpretation into the language of the proceedings or into one of the other two languages of the European Patent Office. Of course this does not apply where the Implementing Regulations expressly lay down that a party must make provision for interpretation. However, derogations can also be made in such cases, as for example if a European Patent Office interpreter can interpret from a language which he knows into the language of the proceedings (Re. Article 34, No. 5, paragraph 5).

are far more detailed than those of the 1964 Draft; in arrangement and wording they are very closely modelled on the Regulations under the PCT. However, the Sub-Committee decided not to exclude completely improvements to the wording when adopting PCT texts.

33. Multiple dependent claims are also to be allowed for applications for European patents (Re. Article 66, No. 3, paragraph 4). The Sub-Committee agreed to adopt the content of the solution contained in the Regulations under the PCT (Rule 6.4), but to word it more clearly.

34. Article 70 of the Convention sets out the principle of unity of invention. Re. Article 70, No. 1, of the Implementing Regulations gives an authentic interpretation of this. With some linguistic improvements this provision corresponds entirely to Rule 13.2 of the Regulations under the PCT.

Re. Article 70, No. 2, makes it clear that a single application for a European patent may contain several independent claims in the same category. However, as opposed to Re. Article 70, No. 1, no "fiction" was drawn up; the admissibility of several categories in one application always depends principally on whether the various claims are uniform under Article 70 of the Convention, so the European Patent Office retains a margin of discretion.

This provision follows very closely the corresponding Rule of the Regulations under the PCT (Rule 13.3). However, the conditions for the application of this provision have been rendered more flexible.

35. In order to keep the number of claims in an application for a European patent within reasonable limits and to take into account the extra work involved in examining an application with a large number of claims, the Sub-Committee provided that a special fee must be paid for eleven or more claims (Re. Article 71, No. 1).

REGULATIONS CONCERNING PART V OF THE CONVENTION

EXAMINATION, GRANT AND OPPOSITION (Articles 77 to 127)

36. On the basis of proposals by the International Patent Institute at The Hague, the Sub-Committee drew up a provision on the content of the report on the state of the art (Re. Article 79, No. 1). The time limit for drawing up the report on the state of the art was set at three months (Re. Article 79, No. 2).

37. Article 85 of the Convention governs the publication of the European patent application. The Sub-Committee considered that the European Patent Office should be able at all times to take into account advances in copying techniques *e.g.* in the form of microfilms) and new discoveries in the field of documentation for the purposes of the publication of European patent applications and specifications. The Sub-Committee therefore decided not to give detailed rules in the Implementing Regulations, but empowered the President

of the European Patent Office to prescribe the details (Re. Article 85, No. 1).

38. Articles 88, 101 and 111 of the Convention introduce examination procedure, opposition procedure, and appeals procedure. On the basis of the provision of the Implementing Regulations governing the form and content of the request for grant of a patent (Re. Article 66, No. 1), the Sub-Committee drew up corresponding provisions for the request for examination (Re. Article 88, No. 1), the notice of opposition (Re. Article 101, No. 1), and the appeal (Re. Article 111, No. 1).

The rejection and refusal of these requests and legal recourses needed to be governed in the Implementing Regulations only where they are not dealt with in the Convention (see Articles 78, 105 and 115 of the Convention). For this reason the Sub-Committee was able to limit itself to a provision on the refusal of a request for examination (Re. Article 88, No. 2) and a provision on the rejection of the notice of opposition (Re. Article 101, No. 3).

With regard to opposition proceedings, a provision has been drawn up according to which these proceedings can be continued *ex officio* where the opponent withdraws the opposition, becomes legally incapable or dies (Re. Article 101, No. 4).

In connection with opposition proceedings one more provision should be mentioned; this provides that the European Patent Office need not take into account any evidence based on documents which are not at the disposal of the European Patent Office and which are not made available to it after the parties concerned have been requested to produce these documents (Re. Article 101, No. 2).

39. When the appeals procedure was dealt with, differences between national legal systems, particularly the difference between procedure under Roman law and that under Anglo-Saxon law, came to light. After a far-reaching discussion, the Sub-Committee agreed to retain provisionally, and for the most part unchanged, the provisions of the 1964 Draft, particularly those based on the Rules of Procedure of the Court of Justice of the European Communities, on appeal proceedings (Re. Article 115, No. 1, paragraph 2), and, as far as the conduct of oral proceedings is concerned, on examination and opposition proceedings (Re. Article 140, No. 2).

40. In order to avoid detailed rules, it was laid down that the provisions relating to proceedings before the department which made the decision from which the appeal is brought are to be applicable to appeal proceedings *mutatis mutandis* (Re. Article 113, No. 3). Separate provisions were made for the option of waiving the right to participate in proceedings (Re. Article 113, No. 2), for dealing with observations by the parties (Re. Article 113, No. 1), and for the obligatory reimbursement of appeal fees in two cases: where there is an interlocutory revision or where the Board of Appeal deems the appeal to be admissible provided that such reimbursement is equitable, on account of a substantial procedural violation (Re. Article 112, No. 1).

25. Apart from the derogations from the language of the proceedings already discussed, the Implementing Regulations also allow that the language of the proceedings may be changed at the request of the applicant for or proprietor of the patent after the other parties have been consulted (Re. Article 34, No. 6, paragraph 1). This may be of importance in the event of assignment of an application or a patent to a person in another country. In order to maintain uniformity of language for the application, it is laid down for this case that amendments to the description and claims must be filed in the initial language of the proceedings (Re. Article 34, No. 6, paragraph 2).

26. Further Implementing Regulations relate to the language of applications for patents of addition (Re. Article 34, No. 7) and divisional applications (Re. Article 34, No. 8). These are to be filed in the initial language of the proceedings concerning the application for the parent patent or the original application.

27. Articles 53 *et seq.* of the Convention govern the structure of the various departments and their duties. The Implementing Regulations lay down provisions relating primarily to the allocation of duties and organisation.

28. The President of the European Patent Office is to allocate duties to the Examining Sections, Examining Divisions and Opposition Divisions, and is also to determine the number of these departments (Re. Article 53, No. 1).

Regulations for the allocation of duties to the Boards of Appeal have been laid down to take into account one of the suggestions made by the Conference to the effect that the Boards of Appeal should bear greater resemblance to courts. The allocation of duties is to be the responsibility of a special authority; it may take decisions if at least five members are present, including the President of the European Patent Office or a Vice-President and the Chairmen of two Boards of Appeal. The other members of this authority are to be the Chairmen of all the other Boards of Appeal and three other members of the Boards of Appeal elected by their colleagues. Before the beginning of each working year this authority is to allocate duties to the Boards and designate the members of the individual Boards. The Chairman of the Board is to be responsible for the internal allocation of duties to the members of the Board. If circumstances require, the authority may change its arrangements during the course of the working year (Re. Article 53, No. 2).

29. The Sub-Committee recommended that, in accordance with the 1964 Draft, a regulation governing the administrative structure of the European Patent Office should be laid down. The Sub-Committee was aware however that the adopted regulation is only intended as a basic concept, which should immediately give way to any better concepts. As the Implementing Regulations will be subject to revision by the Administrative Council, the structure can later be adapted without particular difficulty to meet any practical requirements which prove necessary.

The Implementing Regulations lay down that the Examining Sections, Examining Divisions and Opposi-

tion Divisions are to be grouped together to form Directorates, the number of which will be determined by the President of the European Patent Office. The Directorates, the Boards of Appeal including the Enlarged Board of Appeal, and the administrative services of the European Patent Office are to be grouped together to form Directorates General. Each Directorate General is to be directed by a Vice-President. This latter provision does not exclude the possibility that one or more Vice-Presidents may only represent the President of the European Patent Office, instead of directing a Directorate General (Re. Article 53, No. 4).

30. In order that the cost of staffing the European Patent Office should not be unnecessarily high, it has been provided, following the example of the national legislation of various delegations, that the President of the European Patent Office may entrust to officials without special qualifications the execution of individual duties falling to the Examining Sections, Examining Divisions or Opposition Divisions and posing no technical or legal problems (Re. Article 54, No. 2).

REGULATIONS CONCERNING PART IV OF THE CONVENTION

APPLICATION FOR EUROPEAN PATENTS (Articles 64 to 76)

31. Article 64 of the Convention governs the filing of applications for European patents. For the implementation of this provision, the Sub-Committee laid down the method by which the national authorities of the Contracting States with whom applications for European patents are filed should deal with them. They are to mark the date of receipt on the documents, immediately issue to the applicant a receipt containing at least the file number and the filing date, and send a duplicate of the receipt to the European Patent Office. Thus the national authorities will only function as a type of letter-box (Re. Article 64, No. 2).

32. The provisions governing the application itself form the second main element of the Implementing Regulations. They are listed provisionally under Article 66 of the Convention, although the objective reader might perhaps expect to find them attached to Article 72 of the Convention.

The Sub-Committee discussed the idea of removing these provisions from the Implementing Regulations altogether. Bearing in mind that it should be possible for the President of the European Patent Office to amend them, it was proposed that the provisions governing the application should form a "third" category of regulations in addition to the Convention and the Implementing Regulations. This would conform to the national legal systems of several delegations. The Sub-Committee agreed however that it would be advisable in the first instance to elaborate these provisions, which are important for the form of the procedure, for the interested circles and for harmonisation with the PCT, as a preliminary draft within the framework of the Implementing Regulations. The provisions governing the application

REGULATIONS CONCERNING PART VIII
OF THE CONVENTION

COMMON PROCEDURAL PROVISIONS OF
THE EUROPEAN PATENT OFFICE
(Articles 135 to 156)

41. I consider the Implementing Regulations to Part VIII of the Convention to be the third main element—together with the provisions on languages and those governing the application—of the Implementing Regulations. These Articles form approximately one third of the total number of Articles in the Implementing Regulations. Together with the corresponding Articles of the Convention they represent an endeavour to produce provisions for a European administrative system tailored to meet the practical requirements of the system for the grant of patents. The Rules of Procedure of the Court of Justice of the European Communities were used in part as a model for this. An apparently satisfactory solution was reached by making national law applicable in certain contexts (Re. Article 136, No. 5; Re. Article 145, No. 7; Re. Article 148, No. 1, paragraph 3; and Re. Article 148, No. 2).

42. The principles of investigation are set out in Article 136 of the Convention. The seven Implementing Regulations which have been drawn up concerning investigation should not, in the view of the Sub-Committee, prejudice the question as to whether the European Patent Office may take evidence *ex officio*.

In the provision governing the hearing of witnesses and experts (Re. Article 136, No. 5), unlike the provision in the 1964 Draft, no uniform formula was adopted for the oath. The wording of this provision also deliberately leaves open the question as to whether the oath is to be taken before or after giving evidence. This question appears to be resolved in different ways under the national laws of the various Contracting States, and this may be of importance in the event of sanctions for perjury (see Article 136, paragraph 5 of the Convention).

The provision governing the payment of expenses of witnesses and experts (Re. Article 136, No. 6) should be applicable only to persons appearing before the European Patent Office and not to those who are heard by the courts of their State of residence (see Article 136, paragraph 6 of the Convention).

The provision concerning conservation of evidence (Re. Article 136, No. 7) was the subject of detailed discussions within the Sub-Committee. It is of the opinion that this provision could also be seen as an important addition to Article 87 of the Convention. It gives third parties the possibility during the proceedings for grant, which may be long, of obtaining the evidence of witnesses for opposition proceedings after grant, where, for example, such witnesses intend to leave the business of the third party or emigrate, or where their state of health gives cause for concern.

43. Article 140 of the Convention lays down that oral proceedings shall take place before the Sections and Boards of the European Patent Office at the mere request of a party. In order to avoid abuse of this liberal rule

for the purpose of delaying proceedings, it is laid down in the Implementing Regulations that proceedings may be continued if a party who has been duly summoned to oral proceedings does not appear as summoned before the European Patent Office (Re. Article 140, No. 1). For the conduct of oral proceedings, see para. 39 above.

44. The provisions governing the calculation and the extension of time limits (Re. Article 141, Nos. 1 and 2) are based closely on Rule 80 of the Regulations under the PCT. However, the Implementing Regulations differ from this Rule in that terms of weeks are also provided for.

45. Article 142 of the Convention governs re-establishment of rights. It appeared necessary to lay down in the Implementing Regulations that an entry recording the re-establishment of rights should be made in the Register of European Patents and in the European Patent Bulletin (Re. Article 142, No. 1, paragraph 2). For Article 142, paragraph 6, of the Convention states that any person who has in good faith exploited or made effective and serious preparations for exploiting an invention in the course of the period between the refusal of the European patent application or the time when the European patent application has been deemed to have been withdrawn and notification of re-establishment of the applicant's rights, may freely continue such exploitation in the course of his business or for the needs thereof.

46. A number of miscellaneous provisions for which the Sub-Committee could provisionally find no better place were grouped together under Article 145 of the Convention.

Rules were laid down here concerning the term of the summons and the minutes of hearings in respect of oral proceedings and preliminary investigations (Re. Article 145, Nos. 1 and 2). With regard to decisions of the European Patent Office, provisions were made here governing their form, rectification and the notification of the possibility of appeal (Re. Article 145, Nos. 3 to 5).

The question of notification of the possibility of appeal was discussed in detail by the Sub-Committee. Contrary to the 1964 Draft, which contained only a recommendation, the Sub-Committee decided in favour of making the notification of the possibility of appeal an obligation upon the European Patent Office (Re. Article 145, No. 5, paragraph 1). It considered that it was not easy to be acquainted with all the details of the European system for the grant of patents, especially for nationals of Contracting States who did not need to be represented. With regard to the legal consequences of failure to make the notification or any errors contained in it (Re. Article 145, No. 5, paragraph 2), however, the Sub-Committee was in favour of retaining the text of the 1964 Draft according to which the parties may in no way invoke such failure or errors against the European Patent Office.

With regard to interruption of proceedings, the Sub-Committee drew up a provision which seems complicated at first sight (Re. Article 145, No. 7). It was not possible to avoid touching upon questions concerning international private law, bankruptcy law, the rules governing representation before the European Patent Office and the calculation of time limits.

In the interests of the proceedings for grant not being subjected to unnecessary delays, the European Patent Office was finally given the option of not taking into consideration observations or evidence not submitted in due time (Re. Article 145, No. 8).

47. So that the European Patent Office may take advantage of the progress to which it is to contribute, it is laid down in the Implementing Regulations that routine notices and other communications may be issued by a data-processing installation, therefore not requiring the signature and statement of name of an official (Re. Article 145, No. 9).

A further provision aimed at avoiding unnecessary expenditure has been laid down as regards the lapse of the rights of the European Patent Office to the payment of fees (Re. Article 145, No. 10, paragraph 1). This provision will not however be of great significance in practice, since the European Patent Office can undertake official services without advance payment of the relevant fee only in cases where the fee is laid down by the President of the European Patent Office instead of in the Convention or Implementing Regulations (Article 4 of the First Preliminary Draft of the Rules relating to Fees), for example fees for supplying attestations, copies, photocopies, films and information (Article 3, paragraph 1, of the First Preliminary Draft of the Rules relating to Fees).

48. In this context, a provision should be mentioned which is intended to save work which the European Patent Office considers unnecessary. The Convention and the Implementing Regulations contain a number of cases in which certain rights are lost where a party fails to take a certain step. The most important example of an automatic loss of rights of this nature is the deemed withdrawal of the European patent application, for example when the applicant does not pay the filing fee within the period specified (Article 69a of the Convention).

The Sub-Committee discussed in detail the form in which the party concerned is to be notified of such a loss of rights. The Sub-Committee considers that it has found a provision (Re. Article 145, No. 11) which saves work for the European Patent Office as intended, while taking into account the interest of the party concerned in obtaining a decision that is subject to appeal. Under this provision, the European Patent Office is to send a notification to the party concerned to the effect that the European Patent Office considers that the rights have been lost, that is, in the example given, that it deems the application for a European patent to be withdrawn. This notification need not be dealt with by the Examiner himself. If the party concerned is of the opinion that the rights have not been lost – which will only very seldom be the case – the Examiner, if he does not share the applicant's view, will take a decision against which an appeal may be lodged.

49. Article 148 of the Convention deals with only the principle of notification. The individual detailed provisions (Re. Article 148, Nos. 1 to 12) were taken over from the 1964 Draft without substantial changes and with very few exceptions (No. 2 and No. 10). Under

these provisions notification by the European Patent Office is made by post (Nos. 2 to 5 and 7), delivery by hand in the European Patent Office (No. 6), or public notification (No. 8). The first two of these means of notification are also provided for in the Rules of Procedure of the Court of Justice of the European Communities. In the case of the European Patent Office being unable to prove that a document has been duly notified or of provisions relating to the notification not being observed in respect of a document which reaches the addressee, the document is to be deemed to have been notified on the date established by the European Patent Office as the date of receipt (No. 12).

Between two provisions concerning notifications to a representative and to a common representative, the Sub-Committee has inserted a new and noteworthy provision concerning the appointment of the common representative (No. 10), which does not govern any aspect of the notification itself. The basic idea behind this provision is taken from the Regulations under the PCT (Rule 4.8(b)); if an application is made by more than one person and if the request for the grant of a European patent does not name a common representative, the applicant first named in the request is to be considered to be the common representative. If the problem of a common representative having to be found for several persons does not arise until the proceedings are under way, the principle of the person first named should apply as a rule here too. As it is possible, however, that the European Patent Office may have to make a notification to the common representative before it has in its possession any document in which the persons entitled are named (for example the transfer document or the certificate naming the heir), the following rule has been decided upon: the European Patent Office can require the persons concerned to appoint a common representative within a period of two months. If this requirement is not complied with, the European Patent Office is to appoint the common representative.

50. Article 149 of the Convention concerns inspection of files. The Implementing Regulations to this Article (Re. Article 149, Nos. 1 to 4) are also taken over to a greater or lesser extent from the 1964 Draft.

The files may also be inspected at the central industrial property offices of the Contracting States; however, in principle, no originals but only photocopies or films of the originals are to be sent to these offices (Re. Article 149, No. 2, paragraph 2). A derogation from this provision is only possible in the case of proceedings at the Courts or Public Prosecutors' Offices (Re. Article 62, No. 2, paragraph 1).

The question as to whether and in what form the data referred to in Article 149, paragraph 6, of the Convention concerning European patent applications are to be published was assigned to the responsibilities of the President of the European Patent Office by the Sub-Committee (Re. Article 149, No. 4).

51. The President of the European Patent Office was given a further power in the Implementing Regulations with regard to the enforcement of costs and financial sanctions: he may decide not to recover sums of money

due where such sums are minimal or recovery is too problematic (Re. Article 152, No. 1).

52. Finally, in connection with representation before the European Patent Office, two further Implementing Regulations should be mentioned, concerning the authorisation of the representative (Re. Article 155, Nos. 1 and 2).

The option of lodging general authorisations was expressly provided for.

For the purpose of facilitating the work of the European Patent Office, the President was empowered to notify,

in the Official Journal of the European Patent Office, the form and content of those authorisations which are granted by persons without a place of business or residence within the territory of the Contracting States and of general authorisations (Re. Article 155, No. 1).

In addition to the period of two months after the date of filing of the application provided for in the Convention (Article 154, paragraph 3, second sentence), within which the persons named must notify the European Patent Office of the appointment of a representative, there is now to be a further period of two months for lodging the authorisation (Re. Article 155, No. 2).

REPORT

ON THE FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

RAPPORTEUR: Mr P. BRÄNDLI,

*Deputy Director of the Swiss Patent Office,
as Chairman of the Sub-Committee on "Rules relating to Fees"
of Working Party I of the Inter-Governmental Conference*

I. INTRODUCTION

At its meeting in September 1970, Working Party I instructed a Sub-Committee to draw up Rules relating to Fees pursuant to the Convention establishing a European System for the Grant of Patents.

The Sub-Committee subsequently met from 8 to 10 December 1970 at Luxembourg. Delegates from all the States represented in Working Party I were present, together with observers from the IIB and WIPO. The rapporteur took the chair at the meeting. The discussions were based on Draft Rules relating to Fees submitted by the Chairman. The Drafting Committee was composed of delegates from the Federal Republic of Germany, France, the United Kingdom and Switzerland and was very competently chaired by Dr Otto BOSSUNG, Regierungsdirektor at the German Patent Office.

The outcome of this meeting was the First Preliminary Draft of the Rules relating to Fees.

II. THE MAIN POINTS OF THE DRAFT

1. General

Working Party II has drawn up a provision (Article 35a, paragraph 2(c), of the Convention) empowering the Administrative Council to adopt the Rules relating to Fees. In accordance with this empowering clause, the Rules relating to Fees are therefore presented as an example of an order from the Administrative Council (cf. Preamble to the Rules relating to Fees).

Article 1 of the Rules relating to Fees makes it clear that the provisions thereof are binding only as regards the levying of fees which must be paid to the European Patent Office. Accordingly, where the Convention or the Implementing Regulations empower the Contracting States to collect fees, these States are not bound by the Rules relating to Fees.

2. Catalogue of Fees

The Rules relating to Fees make a distinction between fees for which provision is made in the Convention or

in the Implementing Regulations and those which are fixed by the President of the European Patent Office.

The fees in the first category are laid down definitively in Article 2. The recommendations of Working Party IV as regards the amount of the fees have been adopted with the two alternatives suggested therein. Variant A is based on the levy of the full search fee. In Variant B this fee is reduced by 100 U.A. (Units of Account) and the deficit covered by increasing other procedural fees. The latter alternative is intended to allow for the fact that applicants on whose behalf a PCT search has been carried out will, under the provisions of Article 122 of the Convention, normally have no search fee to pay. The First Draft of the Rules relating to Fees does not take into account the third possibility proposed by Working Party IV whereby the search fee and the filing fee would be combined to form an overall fee since various provisions of the Convention would first have to be amended.

The Sub-Committee did not deem it appropriate to lay down specific amounts for certain of the fees at the present stage. The fees in question were all of no importance as regards either the applicant or the financing of the European Patent Office.

Fees in the second category are those which may be fixed by the President of the European Patent Office, by virtue of the powers contained in Article 3 of the Rules relating to Fees. Although the prices of the European Patent Office publications referred to in Article 3, paragraph 2, of the Rules relating to Fees are not strictly speaking "fees", the Sub-Committee was of the opinion that in the context of the Rules relating to Fees, the President of the European Patent Office should be given the authority to fix them.

3. Methods of paying Fees

The Rules relating to Fees contain various provisions governing how fees are to be paid to the European Patent Office. Article 5, paragraph 1, gives a definite list of the methods by which payments may be made. They are those in general use for international payments. In addition, however, the President of the European

Patent Office must be enabled to authorise other methods for the payment of fees if it is to the advantage of the parties. He is given this authorisation in Article 5, paragraph 2, of the Rules relating to Fees.

4. Payment Offices and Currencies

The Rules relating to Fees in principle assume the use of a central payment system, whereby fees would in the first place be paid at the headquarters of the European Patent Office in the currency of the State in which these headquarters are situated. The European Patent Office is to maintain at least a bank account and a GIRO account in the State in which its headquarters are situated. On the other hand, it is at liberty to maintain such accounts in the other Contracting States or even in non-Contracting States. One delegation has even suggested obliging the European Patent Office to open such accounts in any Contracting State which requests it to do so, provided that the currency of that State can be freely converted into the currency of the State in which the European Patent Office has its headquarters.

In Article 6 of the Rules relating to Fees it is assumed that if fees are paid into an account or payment office outside the State in which the headquarters are situated, they are to be paid in the currency of the relevant State. In this the Rules relating to Fees take into account the fact that, where appropriate, the branches for information and liaison referred to under Article 33, paragraph 2, of the Convention could also be authorised to accept payments.

Under Article 6, paragraph 4, of the Rules relating to Fees, it is for the President of the European Patent Office to see to the conversion of the fees from the currency of the State in which the European Patent Office has its headquarters—the currency in which the fees are to be laid down in Article 2—into any other currency concerned. The European Monetary Agreement, which is based on the dollar parity (1 dollar = 0.88867088 grams of fine gold), or accessorially the Statutes of the International Monetary Fund, is to be taken as the basis for the conversion.

5. Date of payment of Fees

Article 4 of the Rules relating to Fees governs, as far as necessary, the due date for fees. Article 8, which defines the day on which the fee is to be considered to have been paid, is of particular importance. In accordance with the principle that requests shall only be deemed to have been filed at the European Patent Office when the corresponding documents have been received there (cf. *e.g.* Re. Article 64, No. 2, of the Implementing Regulations), Article 8 of the Rules relating to Fees defines the date to be considered as the date of payment as the date of “receipt” of payment at the European Patent Office or the date on which the payment is credited to the account of the European Patent Office. It is considered that such a solution is also desirable

because in certain cases the date of the payment or transfer order cannot be seen from the documents arriving at the European Patent Office or can only be established after lengthy enquiries. The Sub-Committee is, however, of the opinion that the principle set out in paragraph 1 of Article 8 of the Rules relating to Fees should be relaxed in favour of the payer. Thus the evidence provided for under paragraph 3 that steps have been taken for making the payment at least ten days before the term expires avoids the risk that the payers are placed at a legal disadvantage as a result of exceptional delays, for which they are not responsible, in the transfer of the payment.

6. Miscellaneous Provisions

The Rules relating to Fees also contain provisions governing specific details. Article 7 sets out the particulars that must be given when making a payment and governs sanctions in the event of this provision not being observed.

Article 9, paragraph 1, sets out the principle that only payment of the full amount of the fee is of legal effect with respect to the observance of time limits. For reasons of economy, however, the European Patent Office may, in the payer's favour, disregard minor amounts owing. Paragraph 2 of the same provision, in concordance with Rule 15.5 under the PCT, governs the case of payment of inadequate designation fees where more than one Contracting State has been designated.

Article 10 of the Rules relating to Fees provides for a partial refund of the search fee in cases where the IIB has already drawn up, in accordance with certain criteria, a report on the state of the art for a similar application. It will be a matter for the co-operation agreement between the European Patent Office and the IIB to determine the other details necessary to enable the European Patent Office to make the refund. The percentage to be refunded will also have to be laid down in this co-operation agreement, so that Article 10 of the Rules relating to Fees can be completed accordingly. The Sub-Committee is of the opinion that the amount to be refunded should not be left to the discretion of either the IIB or the European Patent Office, in order to avoid decisions against which appeals can be lodged having to be taken. Article 10 of the Rules relating to Fees therefore provides for a fixed percentage for such refunds. Two delegations have suggested extending the application of Article 10 of the Rules relating to Fees to cover novelty reports not drawn up by the IIB but drawn up by the search authority of a Contracting State in accordance with the conditions of the Convention establishing a European System for the Grant of Patents. This question will be examined at a later date.

Article 11 of the Rules relating to Fees provides for a percentage reduction of fees in some cases. This is simply a provision for the application of Re. Article 34, No. 2, of the Implementing Regulations.

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

REPORTS

on the

FIRST PRELIMINARY DRAFT
CONVENTION FOR A EUROPEAN
SYSTEM FOR THE GRANT
OF PATENTS

FOREWORD

At its second meeting, held at Luxembourg from 13 to 16 January 1970, the Inter-governmental Conference for the setting up of a European system for the grant of patents adopted a First Preliminary Draft Convention for a European System for the Grant of Patents, which it decided to publish.*

The Draft had been submitted to the Conference by a Working Party consisting of the British, French, German, Netherlands, Swedish and Swiss delegations. These delegations also submitted reports to the Conference on the various Parts and Chapters of the Draft Convention. In addition, a General Report on the main outlines of the Draft was submitted by Mr. VAN BENTHEM, President of the "Octrooiraad" (Netherlands Patent Office).

The Conference decided to publish all these reports, in order to facilitate consultations on the First Preliminary Draft with the interested circles.

* This text has been published separately.

PART I

GENERAL PROVISIONS

(Articles 1 - 8)

4. These provisions, and particularly Article 2, reflect the basic idea adopted by the Conference i.e. that an international system for the grant of patents should be set up, leading by a single act to be performed by an international body (the European Patent Office) to the grant of a European patent, which would be the equivalent of a bundle of national patents governed by the respective national law of each of the Contracting States to the Convention. The international aspect, then, only relates to the procedure for the grant of a European patent, giving a bundle of national patents which have the same status as patents delivered at national level, in particular as regards their term and revocation, the substance of exclusive rights and infringement thereof, licences, and the levying of annual fees. Hence the sections of the 1965 Draft Convention (drawn up by the EEC "Patents" Working Party) dealing with revocation procedure, procedure in infringement and compulsory licences (Parts VII, VIII and X) have not been adopted, and the national law of the Contracting States will not be affected in this respect. These sections will probably be found in a second Convention to be concluded by the Member States of the EEC setting up a system under which the

procedure for the grant of a European patent will, for these countries, lead to the grant of a Community patent governed by Community law, but the status of this Community patent vis-à-vis the Convention for the grant of European patents will not be different from that of the national patents of the other Contracting States resulting from the grant of the European patent.

As regards the purely national legal status of patents resulting from the grant of a European patent, a marginal comment is however called for. It is to be expected that all the interested circles will argue, for reasons of legal certainty, in favour of the adoption of the Convention's substantive law, which governs the grant of European patents, as the law also governing their validity after grant. It is very probable that this is to be the case for the Community patent of the Member States of the EEC but the question (which, I would emphasize, does not affect the jurisdiction of national judges) merits study by the other countries. The same applies to the term of national patents resulting from the grant of a European patent, which has provisionally been left to national law to determine, unless the Conference should take this question into consideration (see note 2 to Article 2).

PART II

SUBSTANTIVE PATENT LAW

(Articles 9 - 29)

This part deals firstly with the patentability of inventions and the rights conferred by the patent and by the publication of the application prior to grant. In addition, it contains certain miscellaneous rules concerning, in particular, the right to the grant of a European patent, the right of the inventor to be mentioned as such, patents of addition, and the assignment of European patent applications.

In the spirit of the principles contained in Part I, the rights conferred by a European patent are the same as those conferred by an ordinary national patent in the State concerned (Article 18). The publication of the European application 18 months after its priority date provisionally gives rise to the same rights, unless the national law prefers to reduce these rights to that of claiming appropriate compensation from any person using the subject matter of the application in circumstances determined by the national law (Article 19). It is thus national law which determines the rights conferred by the European patent as well as those resulting from the publication of the European application.

The rules of patentability (Articles 9 to 14 — in particular those concerning the exceptions to patentability, novelty, inventive step and industrial application) have in principle been taken over from the Strasbourg Convention of 27 November 1963 on the unification of certain points of substantive law on Patents for Invention. In the matter of patent applications filed prior to the application to be examined, but published later, the above-mentioned Convention offers a choice between two methods, of which the Working Party has chosen, as did the 1965 Draft, that which consists in considering the contents of such applications as being comprised in the state of the art, and therefore as a possible obstacle to novelty (Article 11). The strictness of this solution has been reduced, on the one hand by the provision laying down that prior applications are only taken into consideration when intended for the same country as the application to be examined (Article 11 (4)) and, on the other hand, by totally or partially excluding such applications from being considered in deciding whether there is an inventive step involved in the invention which forms the subject matter of the application to be examined (Article 13). The foregoing naturally only applies in the case of several applications for European patents which correspond more or less. The effects of

GENERAL REPORT

by Mr. J.B. van Benthem, President of the Netherlands Patent Office ("Octrooiraad")

1. At its meeting in Brussels on 21 May 1969, the Conference decided to draw up a draft for a Convention setting up a European system for the grant of patents, on the basis of the principles contained in a Memorandum, dated 13 May 1969, submitted by the six Member States of the Common Market. The Conference set up a Working Party, composed of the delegations of the Federal Republic of Germany, France, the Netherlands, the United Kingdom, Sweden and Switzerland, to examine the section of the Convention dealing with the patentability of inventions and the procedure for the grant of patents. This Working Party has instructed me to submit to you, at the present meeting, from 13 to 16 January, a general report on the work accomplished so far. I shall restrict myself to giving a concise survey of the results of this work, since the Working Party has appointed a number of special rapporteurs to give more detailed information to the Conference.

2. The Working Party has held three meetings, on 8 - 11 July, 14 - 17 October and 24 - 28 November 1969. During these three meetings, it has been able to draw up a preliminary draft of Convention provisions to govern the patentability of inventions and the procedure for the grant of European patents with the exception of a few general procedural provisions which it proposes to submit to you later. The results of its work are embodied in a series of Articles, which have been submitted to you successively in the framework of a synoptic comparison with the last draft, the 1965 Draft, prepared by the EEC "Patents" Working Party, and with the Draft drawn up by the Member States of the European Free Trade Association.

It is only because of a number of factors which have helped its work, that the Working Party has been able to achieve this result in six months. In the first place, it was able to take advantage of the above-mentioned drafts, which represent a considerable amount of work which, to a large extent, the Working Party did not have to do again. Secondly, we must express our appreciation to the Working Party's Chairman, Dr. Haertel, not only for the highly productive preparatory work which he did in submitting texts to the Working Party as a basis for discussion, but also for the excellent

way in which he guided the discussions, which were not always easy, until a joint position was reached. Finally, I must not fail to mention the spirit of co-operation and mutual understanding shown by the Members of the Working Party, the members of its Drafting Committee and the members of the Secretariat, who never avoided the sometimes severe requirements of their work.

3. The provisions drawn up by the Working Party have been grouped in six Parts of a Preliminary Draft Convention which cover respectively: general provisions, substantive patent law, the European Patent Office, applications for European patents, the grant of a European patent, and renewal of the application during procedure for grant. The Working Party did not have time to prepare a seventh Part on certain general procedural provisions, but should the Conference so wish it is prepared to submit proposals on this subject at a later stage. Furthermore, the Working Party refrained from studying the financing of the European Patent Office and the transitional and final provisions; this was not included in the terms of reference which the Conference gave to the Working Party and, furthermore, appeared premature before the approval of the rules on patentability and the procedure for grant.

The fact that the Working Party's proposals have been submitted to you in the form of the successive provisions of a Convention in no way prejudices how the necessary provisions are to be distributed between the Convention which is to be concluded and its Implementing Regulations, which should be concluded at the same time, but which it should be possible to amend by a less complex procedure than that of a Diplomatic Conference. The Working Party proposes that discussion of this distribution of the provisions be postponed until the final stage of work on the draft Convention and the draft Implementing Regulations. Its proposals should be seen as an expression of its desire to submit, provisionally, an overall survey of the subjects to be settled.

The contents of the various Parts into which the Working Party has grouped its proposals will now be briefly explained, while leaving more detailed explanation to the special rapporteurs.

a similarity between a European patent application and a prior or later national right are to be settled by the national law concerned (revocation of the European patent or of the national patent).

The right to the European patent is determined by the Convention (belonging to the inventor or his assignee) except where a contract of employment is in force, when the Convention refers to national law. However,

the European Patent Office will not decide on the right of the applicant to the grant of a patent, since the applicant is deemed to be entitled to that right (Article 15). To meet the possible needs of the interested circles, the European patent application may be assigned for one or more of the designated States, but in the case of a partial assignment, the application shall remain undivided in proceedings before the European Patent Office (Article 22).

PART III

THE EUROPEAN PATENT OFFICE

(Articles 30 to 63)

6. This part governs the status and organization of the body common to the Contracting States which is responsible for the grant of European patents (the European Patent Office).

As regards the status of the European Patent Office, Articles 32 and 34 endow it with legal personality and with the privileges and immunities to be set out in a Protocol.

To ensure the smooth working of the European Patent Office, its working languages have been restricted to three, English, French and German, and applications and specifications are published in only one of these languages (that of the application itself) with a translation of the claims into the other two working languages (Article 34). The rights of Contracting States are given maximum protection, however, by a number of special provisions. In the first place, anyone residing in a State in which a language other than the three above-mentioned languages is used may file a European application in that language, provided that they furnish a translation into one of the working languages within a period to be determined (Article 34). Such a State may also require the applicant to furnish a translation of the claims into its official language on the publication of a European application valid for its territory (Article 19). Last but not least, any Contracting State may require the applicant to furnish a complete translation of the specification of a European patent granted for its territory,

and even to pay for its publication where the specification has not been drawn up in an official language of that State (Article 100).

As regards the organization of the Office, the latter is to be directed by a President responsible to an Administrative Council, composed of representatives of the Contracting States (Articles 30-36). For carrying out procedure, the Office has two administrative bodies (Articles 53-58) responsible for examining European patent applications (the Examining Sections and Examining Divisions) and two judicial bodies (the Boards of Appeal, responsible for appeals from the decisions of the Examining Sections and Examining Divisions, and an Enlarged Board of Appeal responsible for decisions on points of law submitted to it by the Boards of Appeal or by the President). The Enlarged Board of Appeal has been added to ensure the uniform application of the law, since it appeared to be impossible to provide for appeal either to the Court of Justice of the European Communities (as envisaged in the 1965 Draft) or to a special Court.

Articles 59 to 63 deal with the Register of European Patents, with the publications of the European Patent Office and with its relations with national authorities. During the discussion of Article 60, it was suggested that the confidential nature of patent applications prior to their publication should not prevent the publication of certain data, such as the name of the applicant and the date, number, classification and title of the application, but the Working Party has not yet taken up any position on this proposal, which is to be reconsidered later.

PART IV

APPLICATIONS FOR EUROPEAN PATENTS

(Articles 64 to 76)

7. This part deals with the filing and requirements of applications for European patents and with priority right.

A European patent application may enjoy a right of priority based on a regular national first filing made in

a Contracting State or in another State, on condition, however, that that other State grants corresponding rights to a national filing based on a European first filing. Articles 73 to 75 govern priority right in accordance with the provisions of the Paris Convention.

The formal requirements and conditions for accepting European patent applications are set out in Articles 66 to 73, in accordance with the Strasbourg Convention

relating to the formalities required for patent applications and with the PCT; Article 72 refers to the Implementing Regulations for the details of these requirements. The new system of the Convention means that the applicant must designate in his application for the grant of a European patent the Contracting State or States in which he desires protection for his invention (Article 67). It is thus enough to designate a single State.

European patent applications must be filed either with the European Office or, if the law of a Contracting State so permits, with the competent national authority or authorities of that State. Contracting States may even prescribe such filing with the national authority for persons resident in their territory: this option must be open in order to safeguard any secrecy requirements in the interests of the State concerned (Article 64).

PART V

EXAMINATION, GRANT AND OPPOSITION

(Articles 77 - 123)

8. There are three stages in the proposed procedure for the grant of a European patent.

9. The first stage (Articles 77 - 87) is compulsory: it involves an examination of the European patent application for formal or obvious deficiencies, carried out by an Examining Section, and a search into the state of the art concerned, carried out by the International Patent Institute (IIB). The examination effected by the Examining Section leads to the acceptance or refusal of the application, whereas the search carried out by the IIB results simply in a report which is attached to the application. This report is replaced by the international search report in the case of an international application under the PCT, but the European Patent Office may, where appropriate, obtain a supplementary report from the IIB. If the European patent application is accepted, it is published, together with the report on the state of the art, 18 months after its priority date.

10. The second stage (Articles 88 - 100) involves the full examination of the European patent application by an Examining Division, which examines whether the application meets all the formal and substantive requirements laid down in the Convention. This examination leads either to the grant of the patent (where appropriate, after amendment of the application) or to refusal of the application. With the introduction of the system of deferred examination, the second stage examination has become optional. It will only be made on request by the applicant or by any other person; such a request may be made up to the end of a period which remains to be fixed. To offset any disadvantages which certain delegations see as attached to the system of deferred examination (notwithstanding the compulsory search into the state of the art and the possibility of requesting examination on the filing of the application), a special provision gives the Administrative Council of the European Patent Office authority to reduce this time limit, either as a general rule or in respect of certain areas of technology, should the public interest so require. Despite this provision the only agreement which the Working Party has been able to reach on the time limit for deferred examination is that this should not exceed seven years after the filing of the European

patent application. The question should be reconsidered later in the light of discussions with the interested circles.

11. If the second stage of the European procedure should lead to the grant of the patent, the latter is published together with a specification containing the description, claims and any drawings, in the form in which they have been approved. This publication marks the beginning of a period of twelve months during which anyone may give notice to the European Patent Office of opposition to the grant of the European patent. Such opposition opens the third stage of the procedure (Articles 101 - 107), which is therefore also not obligatory, in which an Examining Division examines any opposition, and may either revoke the European patent wholly or in part, or reject the opposition. In the case of partial revocation, a new specification is then published.

The Conference will note, on making a comparison with the 1965 EEC Draft, that the Working Party has placed opposition procedure after the grant of the European patent, the second stage no longer ending with the second publication of the application, but with the grant of the patent itself. This change offers two advantages: not only does it avoid a second publication of the application but, above all, and without harming the interests of the proprietor of the patent, it allows the opposition period to be extended by four months to one year, such extension allowing the Contracting States to require and to publish, for the benefit of any of their own nationals who may be interested in opposition, a translation of the patent specification well before the end of the opposition period. Of course, the transfer of opposition to after the grant of the European patent means that its proprietor obtains full rights prior to any opposition, but the Working Party was of the opinion that, for a number of reasons, and particularly to avoid any dilatory opposition, even the publication of the application after the second stage of the procedure should in principle enjoy the same rights as the patent itself.

12. The Draft submitted to the Conference for approval sets out in Part V the whole of the procedure which takes place at European level, between the European Patent Office and the applicant alone as regards the first and second stages, and, as regards the third stage, with third parties taking part in the proceedings with

the applicant. The rules of procedure allow the parties to state their opinion on any communication made and, in particular, allow the applicant to meet the objections raised, if possible, by amending the description, claims and drawings of his application or, in the case of opposition, of his patent. In each of the three stages, the decision of the first authority (Examining Section or Division) is subject to appeal before a Board of Appeal (Articles 108 - 115), which may in turn submit any point of law to the Enlarged Board of Appeal (Article 116).

13. Finally, Articles 117 - 123 bring the Draft Convention into line with the provisions of the PCT, in particular as regards the activities of the European Patent Office as a receiving Office, designated Office or elected Office within the meaning of that Treaty.

14. Examination of Articles 124 - 128 on the conversion of a European patent application into a national application has been postponed until the preceding provisions relating to the procedure for grant have been approved.

PART VI

RENEWAL OF EUROPEAN PATENT APPLICATIONS AND EUROPEAN PATENTS

(Articles 129-132)

15. European patent applications are subject to the payment to the European Patent Office of annual renewal fees due in respect of the third year and each

subsequent year, calculated from the date of filing the application. Articles 129 - 131 lay down the conditions for payment of these fees, which are only payable up to the grant of the European patent. It is for the national law of each Contracting State to prescribe any annual fees payable after the grant of the European patent, resulting in a bundle of national patents.

REPORT BY THE BRITISH DELEGATION ON ARTICLES 1 TO 29

PART I

GENERAL PROVISIONS

16. Article 1 raised the fundamental question whether the work should aim at providing only a common system of rules and procedure for granting patents effective in the Member States (the "minimum" approach) or whether it should go further and provide in addition a common law for judging the validity of the patents when granted (the "maximum" approach). While the Working Party was generally in sympathy with the objective of harmonising the laws on validity, it felt that it was more prudent to adopt the "minimum" approach to the drafting as it was considered to require too much from acceding States to oblige them either to amend their national tests of validity or to apply to patents granted through the European route tests different from those applied to national patents. It was thought that the "cold harmonisation" effect would probably induce States for whom patents had been granted on one set of rules to avoid judging their validity on a different set of rules; thus they would be encouraged to amend their national laws to conform with the tests applied in granting European patents. It was also suggested that if there was strong pressure for the maximum solution to be adopted, the draft could perhaps be altered.

It is to be noted, however, that the provisions for "belated opposition" (Articles 101 to 107) constitute an exception to the "minimum" approach since they provide for centralised revocation of the European patent application within one year of grant.

17. Article 2 points out the main distinctions between the present draft and the earlier (1965) draft. Under the earlier draft a provisional patent was granted on the application when published and was "confirmed" after examination. The same concept was retained in the EFTA Draft except that the confirmed or "final" patents were in effect independent national patents. The present draft drops the concept of a provisional patent. On publication after 18 months from the priority date there is simply a published European patent application. European patents are granted only after examination and then have the effect of and are subject to the same conditions as national patents in the countries affected.

Thus, the grant of a European patent is equivalent to the grant of a bundle of national patents. The bundle

is subject as a whole to the belated opposition procedure referred to above. Otherwise, each national patent is subject only to the jurisdiction of the competent authorities of the respective State and to the law of that State. This contrasts with the old draft which resulted in the grant of an international and autonomous patent. Under the present draft the international character is restricted to the application before grant and to the belated opposition procedure. The unitary character of a European application vis-à-vis the European Patent Office is dealt with separately in Article 22.

18. Under the new system it will be neither necessary nor desirable to require an applicant to cover all Member States in one application. Article 3 provides for designating one or more of the Member States.

19. Contrary to the earlier draft there is no Article 4 setting up a Patent Court. It is proposed to deal with appeals on patent applications by an appeal body other than a court and to use other means for dealing with disputes etc. which, under the earlier draft, were dealt with by the Patent Court.

20. Article 5, defining "accessibility" or entitlement to apply, has been drafted in accordance with the Brussels memorandum and follows as closely as possible the wording of Articles 2 and 3 of the Paris Convention and it particularly excludes from accessibility nationals and residents of non-Contracting States which "subject the grant of a patent to conditions which can only be met in the territory of the State in question" (subject to certain exclusions). The Working Party had in mind countries which allow priority to an applicant who can show that the invention was made in its territory at a date earlier than the date of filing of the patent application while denying this possibility in respect of inventions made outside its territory. The former case would mainly occur in respect of inventions made by its own nationals, while it would be rare for the latter case to apply to inventions made by its nationals. In such countries it was felt by some members of the Working Party that foreign nationals are treated — in practice if not in theory — differently from

their own nationals. The exact wording of the text is subject to further study and possible revision.

21. Article 6 of the 1965 Draft prohibited simultaneous protection of a given invention by a national patent and a European patent. There was some support for retaining this as a harmonising act, but the majority favoured the present draft which leaves the matter to national law.

22. Article 7 was retained on the understanding that it applies only to past commitments at the time of joining the Convention.

23. Article 8 permits the EEC countries to ensure that the European patent is unitary as far as the Common Market is concerned and must cover all or none of the EEC countries.

PART II

SUBSTANTIVE PATENT LAW

CHAPTER I

PATENTABILITY

24. Article 9 (1) defines the basic requirements for patentability as in Article 1 of the 1963 Strasbourg Convention on Substantive Patent Law. For the avoidance of doubt it is considered desirable to set out in Article 9 (2) a non-exhaustive list of exclusions which follow as far as possible the corresponding provisions in Rule 39 of the PCT Regulations. Computer programmes are not, for the present, specifically excluded, since their patentability is still a subject of controversy. This does not, however, mean that they are necessarily considered to be inventions within the meaning of Article 9 (1).

25. Article 10 (exceptions to patentability) simply follows Article 2 of the Strasbourg Convention.

26. Articles 11 and 12 follow closely the novelty rules of Article 4 of the Strasbourg Convention. Article 11 (3), by a substantial majority view of the Working Party, adopts the option provided by the Strasbourg Article 4 (3) according to which conflicts between copending applications are resolved by treating the whole contents of the earlier application as part of the prior art as of its priority date. This means that the later invention must be novel in relation to anything disclosed in the earlier application. The question whether it needs to show an inventive step over the earlier disclosure is dealt with in Article 13. The formula adopted in Article 11 (3) is of course more severe than that adopted in, for example, the UK, German and French laws which adopt the test of prior claiming. It is to be observed that it may be possible for an applicant to withdraw his European application and retain only a particular national application if he is in a position where he could get a national patent but not a European one. This could apply not only where the national law is less strict but also in a case where the earlier European application covers some only of the countries covered by the later application (see Article 11 (4)). Conflict between a European application and a national application will be left to be resolved nationally, after grant of the European patent. While this Article refers to "dates of filing", Article 74 in effect substitutes for these dates, the "priority dates".

27. Article 13 presents two alternatives which differ only to the extent to which prior European applications, under Article 11 (3) are to be taken into account in assessing inventive step. According to the first variant, the Article 11 (3), documents are to be ignored altogether however trivial the difference. According to the second variant, any Article 11 (3) document can only be considered on its own, separately from the rest of the prior art, in the light of the knowledge available to the "man skilled in the art" who is deemed to be judging the question. The second variant should thus exclude trivial differences and common substitutions. Neither variant, however, permits Article 11 (3) documents to be associated with other individual elements of the prior art, whether other Article 11 (3) documents or published material.

28. Article 14 (industrial application) follows Article 3 of the Strasbourg Convention.

CHAPTER II

RIGHT TO THE PATENT

29. Article 15 of the 1965 Draft had the effect of partially unifying national law on the right to a patent by laying down that the right to a European patent shall belong to the inventor or his assignee, subject to national law on employed inventors. The Working Party considered whether a complete unification on this point was practicable at this point in time since the law on employed inventors varies greatly from country to country. It came to the conclusion that the principle set out in the 1965 Draft would be satisfactory but has clarified the position of employed inventors; whether the right to the patent belongs to the employer or to the employee is determined by the national law governing their contractual or other relationship. Where the same invention has been evolved independently by more than one person, then the right to the patent belongs to the first to file; under Article 74, the priority dates are taken into account.

30. By paragraph 2 of Article 15 the European Patent Office will make no investigation into the applicant's entitlement to apply. Nor will it receive a complaint of unlawful obtaining of the invention as in Article 16 (1) and (2) of the 1965 Draft. It will, however, under Article 16 as now drafted, act on a final decision by a competent

PART III

THE EUROPEAN PATENT OFFICE

CHAPTER I

STATUS AND GENERAL ORGANIZATION

42. After defining the basic principles (Part I) and then establishing substantive patent law (Part II), the Preliminary Draft Convention deals, in Part III, with the administrative and financial organization of the "European Patent Office", which is a body "common to the Contracting States" (Article 4) responsible for the application of this law as regards the grant of patents.

Chapter I of Part III contains Articles 30 to 40, which were of identical tenor in the EEC and EFTA drafts. These Articles lay down the broad outlines of the administrative arrangements applicable to the international body, which will have to be supplemented or further defined either in the Convention itself or in the Implementing Regulations. Substantial amendments have been made to these Articles only where it was necessary to take account of the fact that, at the present stage, the setting up of a European Patent Court is no longer envisaged.

43. In its present form, the Preliminary Draft Convention proposes that the European Patent Office be "endowed with administrative and financial autonomy" (Article 30 (1)) and "legal personality" (Article 32 (1)). These provisions are, then, aimed at setting up an inter-governmental organization having its own administrative and financial arrangements, independent of any other existing institution, and enjoying, in each of the Contracting States, the most extensive legal capacity, allowing it in particular to acquire or transfer movable and immovable property, and to sue and be sued in its own name (Article 32 (2)).

44. The European Patent Office is to be directed by a "President", assisted by "Vice-Presidents" (Article 36 (1) and (3)) and his activities will be supervised by an "Administrative Council" (Article 30 (2)).

45. The President will be responsible to the Administrative Council for the activities of the European Patent Office (Article 36 (1)).

The powers of the President (Article 36) fall under four categories:

(a) He has to ensure the correct application of the provisions of the Convention and its Implementing Regulations. To this end, he will take all necessary steps to inform the public or to instruct the personnel placed under his authority, and to improve the organization and functioning of his administration.

(b) He exercises supervisory authority over the whole of the personnel and may appoint and promote them and exercise disciplinary authority over them, save over the

Vice-Presidents and the members of the Boards of Appeal.

(c) He must prepare the budget and implement it after its approval by the Administrative Council, to whom he must submit the annual accounts, the balance sheet and a management report.

(d) He may place before the Administrative Council any proposal on which he is not competent to decide, such as any proposal for amending the Convention or its Implementing Regulations.

46. The composition, duties and operation of the Administrative Council have not yet been studied by the Working Party, but will be the subject of provisions to be introduced into the Convention.

However, it will be recalled that the Memorandum adopted by the Inter-governmental Conference at its first meeting provides that the Administrative Council should have an inter-governmental character, and that the member states should be represented on an equal basis, which implies that the decisions of the Council would be directly binding on the Governments without having to pass through a higher instance. In accordance with the Memorandum the principal tasks of the Administrative Council would be: laying down the Service Regulations, the appointment of the senior officials, the adoption of the budget, and the administrative and financial control of the European Patent Office.

On the subject of the appointment of the senior officials, Article 37 lays down that the President, the Vice-Presidents and the members of the Boards of Appeal are to be appointed by decision of the Administrative Council.

In addition, Articles 30 and 36, which have already been referred to, in effect endow the Administrative Council with budgetary powers and powers as regards administrative and financial control.

Article 36 (2)(b), which gives the President the right to act on his own initiative as regards regulations, implies that the regulatory powers granted to the Administrative Council will not be restricted to the Service Regulations, which the Memorandum indicates as an area within the competence of the Council.

47. The powers of the President and of the Administrative Council (acting in a select committee) may extend beyond the normal field of application of the Convention for a European System for the Grant of Patents (Article 31), since Article 8 of the Preliminary Draft provides that "any group of Contracting States may provide by a special agreement that a European patent granted for all those States has a unitary character throughout their territories and is subject to the provisions of that special agreement." The Member States of the EEC are at present drawing up an agreement of this nature, intended

court or authority that some person other than the applicant is entitled, under Article 15, to the patent. In that case the application in suit is considered withdrawn and its priority will be transferred to a new application for the same invention filed by the other person. The draft permits the new application to include matter not present in the disclosure of the original application, but such added matter would not benefit from the priority of the original application.

It seems necessary to make provision for a similar substitution in accordance with a decision of a competent court or authority given while belated opposition proceedings are possible or pending.

31. Article 17 follows the 1965 Draft. Under Article 4ter of the Paris Convention, the inventor has a right to be mentioned as such in the patent. The European Patent Office will not adjudicate on a claim by a person to be the inventor. The inventor will, however, have the right to seek a court order as to his inventorship and the applicant will then be obliged to mention him in his application. This Article can, therefore, be considered as creating a new civil right in each member country.

CHAPTER III

EFFECTS OF THE PATENT

32. Article 18 of the Draft is omitted since European patents are, under Article 2 (2), effectively national patents (or group patents under Article 8).

In conformity with the "minimum" approach referred to in connection with Article 1, the resolution of conflicts between European patents and national patents, neither of which is published prior art relative to the other, is left to national action, e.g. in revocation proceedings. Article 19 of the 1965 Draft is therefore omitted.

33. Article 18 may be considered repetitive having regard to Article 2 (2). The general view of the Working Party was, however, that its retention is justified, Article 2 setting out the general principle and Article 18 dealing with a specific aspect which goes naturally with Article 19.

34. Article 19 defines the rights conferred on publication of the application before grant. The Memorandum of 13 May 1969 requires that some protection is granted at that stage. The draft, while establishing, as a principle, in paragraph 1, that full patent protection should be given, allows (paragraph 2) any State to reserve the right to give more restricted protection and to make it depend (paragraph 4) on the availability of the patent claims in a particular language. Protection is, in any case, governed (paragraph 3) by the scope of the granted patent. The relevant national law governs whether the protection of this Article can be invoked before grant.

35. Article 20 follows Article 8 of the Strasbourg Convention. Some members of the Working Party were anxious to ensure that there would be uniform interpretation of the claims in all member States, but no agree-

ment could be reached on any more precise formulation than that of the Strasbourg text.

36. Articles 22 and 23 of the 1965 Draft were omitted as being matters for national law under the "minimum" approach to the Convention. However, it was noted that if all member States were prepared to accept a term of 20 years, this could be incorporated in the draft.

CHAPTER IV

PATENTS OF ADDITION

37. Article 21 follows the principles of the 1965 Draft but has been redrafted having in mind the text developed in the draft Council of Europe proposals for further unification. It is to be noted that the scope for patents of addition will be quite small having regard to the time limit for application mentioned in paragraph 1. The application may be converted into a substantive application at the option of the applicant; the latest date at which this can be done will have to be determined later for there must be sufficient time after conversion to allow for examination for non-obviousness vis-à-vis the parent patent.

CHAPTER V

THE PATENT APPLICATION AS AN OBJECT OF PROPERTY

38. As regards Article 22, the Working Party considered whether assignment of the application in the various States to different persons should be prohibited. It decided, however, that it was preferable to allow such assignment or the granting of rights to different people in different States. However, the application is to be prosecuted before the European Patent Office as an entity, i.e. it will not be possible to amend it for some States and not for others. The various assignees will be regarded as joint applicants and the Regulations will provide for who is to represent them before the European Patent Office.

39. The provisions of Article 23 reproduce, for the registration of European patent applications, the provisions of paragraphs 2 to 5 of Article 25 of the 1965 Draft for registering the assignment of patents. It is to be noted that it will also be necessary to arrange for the registration of assignments of patents made during belated oppositions or during the period in which such oppositions may be filed.

40. The Working Party doubted whether Articles 26 to 28a and 30 of the 1965 Draft, which regulate property in respect of mortgaging, distraint, etc., were necessary or desirable in relation to applications, but this matter will be considered later.

41. Article 28 allows licensing of patent applications either for all States or in some only and provides for the registration of the licences. Whether it is necessary will be considered later.

to make the "unitary patent" granted for the whole of the territories of their States subject to a unitary law – in particular as regards revocation – which requires the setting up of special bodies, such as Revocation Boards.

The aim of Article 31 is to allow for the setting up of such special organs within the European Patent Office, reserved for the use the States signatory to such a special agreement. These organs set up within the European Patent Office will be placed under the authority of the President but, of course, their operating expenses will be borne only by the States signatory to the special agreement, and the administrative and financial control of this additional part of the administrative machinery of the European Patent Office will only be exercised by these States, meeting within a select committee of the Administrative Council.

Naturally, the select committee will have certain links, whose form is to be fixed, with the Administrative Council as a whole, in particular on the occasion of the discussion and adoption of the budget of the European Patent Office.

48. Under the present provisions of Article 33, the administration of the European Patent Office will be concentrated in a single headquarters.

However, should it deem it necessary, the Administrative Council may decide to create branches for information and liaison in the Contracting States or with the International Patent Institute at The Hague or with other organisations in the field of industrial property. The name given to these branches indicates the limit of their functions, and their creation clearly could not lead to any real decentralization of the European Patent Office.

This is not at all the case as regards a proposal for the setting up, in view of the languages used for the filing of patent applications, of "Branch Examining Offices" in certain Contracting States. The present report will limit itself to mentioning this proposal, since the matter has not yet been discussed by the Working Party.

49. The languages in use at the European Patent Office will be English, French and German (Article 34).

However, an exception must be made in respect of nationals of or persons domiciled in Contracting States where none of the three languages of the European Patent Office is an official language. In such a case, the patent application and the documents to be produced by the applicant during the proceedings may be drawn up in an official language of the Contracting State concerned (e.g. Italian for an Italian or Swiss national), provided that a translation into one of the languages of the European Patent Office is supplied within a time limit specified in the Implementing Regulations.

Official publications of the European Patent Office will appear in the three languages. This applies to entries in the Register of European Patents, to the European Patent Bulletin and to the Official Journal of the European Patent Office and to published claims, whether of patent applications or of patents themselves. On the other hand, for reasons of economy, the description of the invention will only be published in the language used for filing the application, or in that of the translation if, for example, Italian was used for filing the application.

50. Article 35 of the Preliminary Draft establishes the principle that the European Patent Office is to enjoy certain privileges and immunities in the territory of the Contracting States, under conditions to be defined in a separate Protocol.

51. All officials and employees of the European Patent Office are to be bound by the rules of professional secrecy (Article 38), and may not file applications for patents, either directly or through an intermediary. The rules governing the recruitment, promotion, remuneration and discipline of officials and employees will, as has already been stated, be laid down in Service Regulations to be adopted by the Administrative Council.

52. In the earlier EEC and EFTA Drafts, disputes between the European Patent Office and its staff relating to the implementation of the Service Regulations (Article 39) fell within the competence of an International Court. This is not a viable solution if it leads to excessive financial burdens, as would be the case if the number of cases brought before this Court were small. The drafters of the EEC Draft did not envisage the creation of a "European Patent Court", to which Article 4 of that text (now deleted) referred, but intended to entrust the Court of Justice of the European Communities with the settlement of the disputes in question and the control of the legality of the decisions of the Administrative Council and of the President of the European Patent Office (Article 41 of the 1965 Draft, now deleted – see point 54 below) and with wider competences in respect of activities relating to European patents. However, it is not possible to entrust this ultimate jurisdiction to the Court of Justice of the European Communities in a European system for patents which involves other States besides the Member States of the EEC.

As, furthermore, in the present opinion of the Working Party it is not considered indispensable to set up an International Court of Justice, Article 39 of the Preliminary Draft awards competence to settle any dispute between the European Patent Office and its servants to an "Appeals Committee", whose Statute will have to be set out in a special regulation. This appears to be a viable solution, since many inter-governmental organisations deal with the settlement of disputes of this nature by referring to Appeals Committees, variously composed, but always including members not belonging to the organisation concerned. Such is the case, for example, with the International Patents Institute, BIRPI, and the Council of Europe.

53. In the matter of the liability of the European Patent Office, the provisions of Article 40 have been taken from the Treaty of Rome establishing the EEC, and, in particular, from Article 215 thereof.

54. Finally, as has been stated above, the fact that the setting up of an International Court of Justice is no longer envisaged leads to the abandonment of the control of the legality of the decisions of the Administrative Council and of the President of the European Patent Office, as had been provided for in Article 41 of the

EEC and EFTA Drafts. This omission seems to bear little practical significance, if one refers to the existing inter-governmental institutions, such as the Inter-

national Patent Institute or BIRPI, which do not have any such control and where the absence of this control has not led to any difficulties.

REPORT BY THE SWISS DELEGATION ON ARTICLES 53 TO 63

CHAPTER III

THE DEPARTMENTS

55. Chapter III (Articles 53-58) refers to the separate departments of the European Patent Office, which are occupied with the procedure of examination and grant, and with appeals. Their composition and functions are described and their respective competences are set out. The departments in question are, on the one hand, the Examining Sections and Examining Divisions whose main responsibility is the examination procedure, in addition to which the latter are also competent to decide on the refusal or grant of a patent and on any opposition raised after the grant of the patent. It is the task of the Boards of Appeal and of the Enlarged Board of Appeal to give decisions on appeal against decisions of the Examining Sections and Examining Divisions.

56. Article 53 lists the separate departments engaged in proceedings before the European Patent Office.

In order to make it clear that the Examining Divisions do not constitute a higher procedural instance, but that each consists of a group of examiners which takes over from the individual examiners, they have been listed together with the Examining Sections under (a).

The reference to Patent Administration Divisions in the 1965 Draft has been deleted because, in accordance with the objective of the Draft Convention, a European patent once granted is no longer administered by the European Patent Office, but by the authorities of the Contracting States. In the same way the Revocation Boards have been deleted, because revocation — apart from special agreements under Article 8 — falls under the exclusive competence of the authorities of the Contracting States in which the patent produces its effect. (cf. Article 2(2)).

57. Article 54 (1) describes the functions of the Examining Section and delimits its competence as against that of the Examining Division. The Working Party chose the making of a request for examination and the receipt of the report on the state of the art as the criterion for delimiting this competence (see Article 79). It is therefore the task of the Examining Section to examine the European patent application for formal and obvious deficiencies (Article 77) and to obtain the report on the state of the art from the International Patent Institute (Article 79). The procedure then goes to the Examining Division (Article 55).

Paragraph 2 makes it clear that each Examining Section is to consist only of a single Examiner. The Working Party was of the opinion that it is for the European Patent Office itself to determine how many Examining Sections are necessary and to allocate their responsibilities.

58. Article 55 (1) sets out the responsibilities of the Examining Divisions. The group of examiners constituting an Examining Division continues the examination of the European application from the time when the Examining Section ceases to be responsible. In normal cases the Examining Division will therefore continue the procedure with the examination for novelty according to Articles 88 et seq. It is competent for the decision on the grant of the European patent (Article 97) and for any opposition proceedings introduced after the grant of the patent (Articles 101 et seq.). The Working Party discussed this division of responsibilities between the Examining Sections and the Examining Divisions very thoroughly. It was suggested that the Examining Section should be responsible up to the publication of the patent claims, i.e., within the meaning of the latest procedure decided upon by the Working Party, up to the grant of the patent (Article 97). Under this system the Examining Divisions would only enter as a body taking opposition proceedings. The Working Party was not unaware of the advantage of this solution as regards the organisation of procedure. However the majority was of the opinion that the division of responsibilities laid down in Article 54 (1) and Article 55 (1) was, at least during the initial period of the European Patent Office's activities, more likely than the counter proposal to guarantee the correct and uniform application of the Convention. It was also aware that only experience would show whether the procedure chosen would prove satisfactory. It therefore proposes that provision should be made for a simplified procedure for revising Articles 54 and 55 in order to be able to adapt these provisions more easily to the knowledge gained through practice. The Working Party proposed to examine later whether the examiners constituting the Examining Division which has decided on the grant of the patent should be changed in the event of opposition proceedings.

Paragraph 2 governs the composition of the Examining Divisions. The Working Party assumed that the single examiner constituting the Examining Section would in general belong to the Examining Division competent for the examination of the application. It therefore seems expedient in the interests of the procedure to entrust him with the processing of the application until the documents for the Examining Division are ready for the final decision. In the opinion of the Working Party the allocation of duties within an Examining Division will be a question to be settled under the internal organisation of the European Patent Office, in particular in view of possible language problems.

59. For the reasons for the abandonment of the patent Administration Divisions provided for in Article 57 of the 1965 Draft, see the comments under Article 53 (cf. point 56 above).

Should administrative questions arise at some stage during the procedure for the grant of a patent, for example in connection with the payment of fees, the Examining Section or the Examining Division responsible at that stage in the proceedings shall be competent to deal with them. Should a decision on this matter require specialized knowledge, in particular of a legal nature, they may if necessary ask the advice of another member of the Patent Office.

60. Article 56 (1) describes the competence of the Boards of Appeal.

The majority of the Working Party was in favour of a solution, in paragraph 2, in respect of the composition of the Boards of Appeal, which is close to the second variant of the 1965 Draft. This solution provides, according to the nature of the decision to be taken, for a Board composed of three or five technically qualified or legally qualified members. The fact that the Boards are always composed of an unequal number of members allows the undesirable necessity for a casting vote to be avoided.

61. Article 57 provides for the setting up of an Enlarged Board of Appeal. The Working Party is of the opinion that such a body is needed to ensure the uniform application of the law by the Boards of Appeal. To this end, it will therefore give binding decisions only on fundamental points of law submitted to it by the Boards of Appeal. In addition it was proposed that the Enlarged Board of Appeal should be constituted as a body of third instance in order to give the parties the possibility of a further appeal. The majority of the Working Party rejected this proposal, since it was afraid that such a system would make the procedure for the grant of patents excessively long and heavy.

The majority of the Working Party was of the opinion that the President of the European Patent Office should be able, in the interests of the uniformity and legal consistency of examination practice, to seek the opinion of the Enlarged Board of Appeal. It is therefore laid down that the Enlarged Board of Appeal shall be competent to give such opinions.

The Working Party assumed that the Enlarged Board of Appeal would not be organized as a standing body, but would be constituted ad hoc for each case with the composition referred to in paragraph 2, the member normally being drawn from the Boards of Appeal.

The responsibilities of the Enlarged Board of Appeal are set out separately in Article 116.

62. Article 58 governs the independence of the members of the Boards of Appeal and of the Enlarged Board of Appeal. In order to emphasize the juridical nature possessed by these bodies, the Working Party has proposed, in paragraph 1, a term during which the members of the Boards may not be removed from office.

63. The reasons for the abolition of the Revocation Boards (former Article 59) are given under Article 53 (cf. point 56 above).

CHAPTER IV

REGISTER AND PUBLICATIONS

64. Chapter IV (Articles 59 and 60) deals with the keeping of the Register of European Patents and with the publication obligations of the European Patent Office.

65. Article 59, which deals with the keeping of the Register and the opening of the Register to inspection has been brought into line with Article 30 (2) of the PCT. In order to guarantee the applicant's justified interest in secrecy, it was considered necessary, in the second sentence of paragraph 1, to prohibit entries in the Patent Register, which is open to public inspection, before the publication of the application (Article 85). Otherwise, this provision corresponds to that of the 1965 Draft.

When discussing a provision for the inspection of files, the Working Party will examine at a later date whether the European Patent Office may give certain details of the application to third parties before the publication of the application.

66. According to Article 60, which should still be supplemented by a reference to Article 98, the publications of the European Patent Office are as follows:

- (i) Publication of the application pursuant to Article 85;
- (ii) Publication of the specification pursuant to Article 98 at the same time as the publication of the grant of the patent;
- (iii) Publication of a new specification pursuant to Article 107, where the European patent has been amended during opposition proceedings;
- (iv) Publication of a European Patent Bulletin;
- (v) Publication of an Official Journal containing the matter described in sub-paragraph (b), including in particular, fundamental decisions of the Boards of Appeal and the Enlarged Board of Appeal.

As with Article 59, this provision is also to be reconsidered during discussions on the provision concerning inspection of files.

67. The Working Party examined whether a provision on the patent classification to be used by the European Patent Office should be retained in the Convention. It came to the conclusion that it would be more useful to include a corresponding provision in the Implementing Regulations, in order to be able to take into account developments in patent classification and thus to be able to adapt more easily to changed conditions.

CHAPTER V

RELATIONS WITH NATIONAL AUTHORITIES

68. Chapter V (Articles 61 - 63) regulates the relationships between the European Patent Office and the legal and administrative authorities of the Contracting States as regards the exchange of publications, mutual information and the response to letters rogatory.

69. In paragraph 1 of Article 61, a reference must be made to Article 98 in addition to Articles 60, 85 and 107.

70. In paragraph 2 of Article 62 it is laid down that files will only be communicated on request. This provision is thus brought into line with paragraphs 1 and 3, which also prescribe the making of a request. The Working Party was also of the opinion that files could

be communicated without this having to be explicitly stated in the text as in the EFTA draft.

71. Article 63 stipulates that letters rogatory originate from the European Patent Office as such.

REPORT BY THE NETHERLANDS DELEGATION ON ARTICLES 64 TO 76

PART IV

APPLICATIONS FOR EUROPEAN PATENTS

CHAPTER I

FILING AND REQUIREMENTS OF THE APPLICATION

72. Chapter I contains Articles 64 to 72, which deal with the filing of applications for European patents and lay down the requirements for such filing. European applications may be filed either directly at the European Patent Office or through the intermediary of a national patent office, if the national law so permits (Article 64). Any Contracting State may require, in view of the filing of applications whose subject matter may concern national defence interests, that the European application may only be filed through the intermediary of the national patent office. Applications whose subject matter concerns national defence interests will not be forwarded to the European Patent Office (Article 65).

73. Article 66 sets out the formal requirements for the filing of European applications. In drafting these Articles, account was taken of the Strasbourg drafts and the provisions of the PCT draft. The sanction for failure to pay the filing fee is dealt with in a new Article 69, which provides that in such case the application shall be deemed to be withdrawn.

The question of the inclusion of an abstract in the application at the time of filing will be put to the interested circles. In the PCT, the language problem and the use of the abstract in the examination for novelty are deemed to be grounds justifying the requirement of an abstract, whereas here, in the grant of European patents, these two grounds are not relevant.

74. The Contracting States in whose territory the applicant desires protection for his invention must be designated on filing the application. The requirements correspond to those of the PCT draft. It is possible to designate a single State, since the applicant may have a valid interest where the State in question does not provide for prior examination in its national procedure (Article 67).

75. Article 68 lays down the minimum requirements for obtaining a filing date for the European application.

76. Article 70 on unity of invention corresponds exactly to Rule 13 of the PCT draft.

77. Article 71 is based on Article 8 of the 1963 Strasbourg Convention on the unification of certain points of substantive law on Patents for Invention, pursuant to which the description must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

78. Article 72 contains a reference to the Implementing Regulations in respect of the other conditions which the European application must satisfy.

CHAPTER II

PRIORITY

79. Chapter II contains Articles 73 to 76, which regulate the claiming of a priority right based on a first filing in a country which is a Member of the Paris Union. The Chapter deals successively with the substance of priority right (Article 73), the juridical effects (Article 74), formal requirements (Article 75) and the juridical effect where the European application is converted into a national application (Article 76).

80. The provisions concerning the substance of priority right correspond to the provisions of the Paris Convention. Paragraph 5 of Article 73 lays down that the priority right of a first filing made in a non-Contracting State will only be recognized in so far as that State in return recognizes the right of priority based on a first filing made at the European Patent Office. It will be for the Administrative Council to decide where there is reciprocity. A distinction has been drawn between the Members of the Paris Union and other countries. Article 76 provides that an application for a European patent shall be equivalent to a national filing. This provision will be applicable in the event of a European application being converted into a national application.

81. Article 74 defines the juridical effect of the right of priority. For the purposes of applying paragraphs 2 and 3 of Article 11, the date of first filing counts as the date of filing the European application, i.e. from that date the contents of the application are considered to be comprised in the state of the art (provided that the first application is later published). This raises a problem: in certain countries, patent applications enjoying a foreign priority right are not considered to be comprised in the state of the art as from the priority date, al-

the applicant on his own initiative could divide the application prior to search. At that stage, therefore, only forced division, i.e. at the invitation of the Examining Section, will be permitted (Article 81 (1)).

91. A divisional application shall be deemed to have been filed on the date of the original application only in so far as it does not contain "added matter" in relation to the original application (Article 81 (4)).

92. Article 82 permits applicants to amend the claims upon the receipt of the report on the state of the art (the search report). Such amendments (including also new claims) may call for an additional search report with accompanying fee. Except for such amendments and those called for by the Examining Section, no material amendments may be made in the application (Article 83). Two observations should be made in this context. Since the protection sought in the claims can not go beyond what was disclosed in the original application and amendments in the description and drawings can only be made to the extent called for by the examiner, the inclusion in the application of "added matter" is effectively prevented. The restrictions on amendments are in full conformity with the PCT plan (cf. Rule 26 of the PCT plan). The further possibilities for amendments foreseen in the PCT plan, Article 28, refer to the stage where the application has passed to the designated Offices.

93. In the 1965 Draft the applicant's right to a hearing before the Examining Section was left to the discretion

of the Examining Section itself. The present Draft gives to the applicant an absolute right to be orally heard when the Examining Section proposes to refuse the application wholly or in part (Article 84).

94. According to the present Draft the application shall be actually published after the expiry of a period of 18 months from the filing or the priority date respectively. Thus the application will not merely become available by allowing the public to inspect the files. It should be observed that the technical preparations for publication may extend the time somewhat above the 18 months limit (Article 85). Division of the application may delay the publication of matter disclosed in the original application. It is therefore intended that the publication of the original application shall include also the original patent claims, and not only the claims remaining after division. The same applies when claims have been amended upon the receipt of a search report. The question is still open if both the original and amended claims shall be published in all three Convention languages (Article 85 and note thereto).

95. Upon the publication of the European patent application any person may submit written observations as to the patentability of the invention concerned. This is to be considered purely as a service for the applicant and third parties, and does not give to the person making the observations the status of a party to the following procedure. Especially, submission of such observations are not in any way connected with opposition proceedings. Observations may be submitted up to the grant of the patent.

REPORT BY THE GERMAN DELEGATION ON ARTICLES 88 TO 100

CHAPTER II

PROCEDURE FOR GRANT

96. The old Articles 88 to 104 of the 1962 Draft dealt with examination procedure under the heading of "Confirmation of the provisional European patent as a final European patent". After the introduction in the 1965 Draft of the "classical opposition procedure" and now the placing of opposition procedure after the grant of the patent (see Article 101), Articles 88 to 104 of the 1965 Draft have been split into two Chapters, i.e. Chapter II (Articles 88 to 100 — procedure for grant) and Chapter III (Articles 101 to 107 — opposition procedure).

97. Articles 88 to 100 cover that stage in the procedure generally referred to as examination for novelty in the narrow sense, which extends from the filing of the request for examination to the grant of the patent. In every case, however, this procedure is preceded by the "procedure prior to the introduction of the request for examination" (Articles 77 to 87). This also applies in the case of a request for examination being filed at the same time as the application, which, unlike in the 1962 and 1965 Drafts, is now possible. The examination for novelty within the meaning of Article 88 therefore always

takes place after examination of the European patent for formal or obvious deficiencies (Article 77 et seq.) and after a report on the state of the art has been obtained (Article 79).

98. Article 88 (1) lays down the object and the scope of the examination. The examination provided for here is a comprehensive one. Special stress is laid on examination of the patentability of the invention, but the examination also covers all the other formal and substantive requirements of the Convention and its Implementing Regulations.

99. Article 88 (2) enshrines the principle of "deferred examination" on which the Working Party was to base its work, in accordance with the Memorandum of 13 May 1969. The length of the time limit within which the request must be made has not yet been fixed. The time limits of two, five and seven years put forward for discussion represent varying conceptions of the system of "deferred examination". The object of deferred examination is to avoid the expense of examining inventions which present no economic interest. The question of what minimum period is required for a considerable number of applicants to become sufficiently certain of whether their invention is worth exploiting, to be able

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to decide whether to pursue the application or to abandon it, is still to be investigated. If the fundamental decision in favour of "deferred examination", taken in the Memorandum of 13 May 1969, is to be maintained, the time limit chosen must not be shorter than this minimum period.

100. In the note to paragraph 2, it is put forward for discussion whether, if the time limit for making the request were relatively long, third parties should be enabled to introduce a request for examination on payment of a part only of the examination fee. In such a case the applicant would have to pay the remainder of the fee. This amendment to the system of deferred examination was proposed in order to make a longer time limit more readily acceptable to the public.

101. Article 88 (2) to (7) lays down further particulars relating to the introduction of a request for examination. The fact that, contrary to the 1962/1965 Drafts, a request for examination may already be introduced on filing the application, is of particular importance. To the extent that use is made of this possibility, "deferred examination" becomes "immediate examination". This time limit for the introduction of a request for examination is now to be calculated as from the filing of the application.

102. Article 89 contains further amendments to the system of deferred examination, by which this may be changed to immediate examination for all or for certain areas of technology. The longer the time limit laid down in Article 88 (2), the more important this provision becomes.

103. Article 89 (1) in its present form provides for any desired reduction or prolongation of the time limit for making a request.

104. The authority given to the Administrative Council under Article 89 (2) will allow immediate examination to be made in those areas of technology where it is in the public interest, i.e. particularly where it is in the interests of economic or research policy.

105. Article 89 (3) is based on the consideration that it was, in particular, the excessive work load of the patent offices which led a number of countries to introduce the system of deferred examination. The Administrative Council is therefore to be given the possibility of replacing deferred examination by immediate examination whenever the work load of the European Patent Office permits of this in any area of technology. In so far as the conditions are met, immediate examination can be introduced in all areas of technology.

106. Article 89 (4) lays down the procedure for the case where immediate examination has been introduced for certain areas of technology. Further details are to be laid down in the Implementing Regulations.

107. Article 90, which deals with the transfer of proceedings from the Examining Sections to the Examining Divisions, is connected with Articles 54 (1) and 55 (1), where the responsibilities of these bodies are defined. The object of Article 90 is to ensure that examination of a European patent application for formal or obvious

deficiencies pursuant to Article 77 et seq. is still undertaken by the Examining Sections where a request for examination has for example been made on the filing of the application.

108. The object of Article 92 is to ensure that, even where the request for examination has been made before the report on the state of the art has been obtained, the applicant may have a suitable period within which to reconsider his application in the light of that report and to draw the appropriate conclusions, i.e. to decide whether to limit or to withdraw the application. In addition, Article 92 is intended to ensure that, after examining the report on the state of the art, the applicant indicates to the European Patent Office, whether he wishes to maintain his application. As a rule, this will occur through the applicant continuing to pay the annual renewal fees for the application after having obtained the report on the state of the art or introducing a request for examination. In the event, however, of his only having received the report on the state of the art after the introduction of the request for examination, and of his having been invited to present his observations pursuant to Article 92 (1), he should, particularly if he considers such observations to be unnecessary, at least indicate to the European Patent Office his interest in maintaining the application. Article 92 (2) consequently lays down that if the applicant does not indicate within the period fixed in paragraph 1 that he wishes to maintain his application, the latter shall be deemed to be withdrawn.

109. Article 93 concerns the commencement of examination and the particulars of the examination procedure. The last sentence of paragraph 1 clearly lays down that persons other than the applicant, such as anyone who has sent in his observations pursuant to Article 87, or the person who has introduced the request for examination, shall not take part in the proceedings. As regards the obtaining of an additional report on the state of the art, it is clear from paragraph 2 that the Examining Division may obtain such a report whenever it considers this necessary. The additional fee is only payable by the applicant if it was necessary to obtain an additional report because of amendments to the claims.

110. Article 94 deals with the division of the application after the request for examination has been made. The period preceding the introduction of the request for examination is covered by Article 81. This partitioning follows from the 1962/65 drafts, where Article 80 concerned the division of the application and Article 98 the division of the provisional European patent. The possibility of combining the two sets of provisions relating to division can be examined later. Both Articles, in accordance with Article 4 G (2) of the Paris Union Convention, assume that the applicant may also divide the application on his own initiative, and determine at which stages in the procedure this is possible. Under Article 94 (1), sub-paragraph (a), division may be made at the request of the applicant after the introduction of the request for examination and before the beginning of examination. In order to prevent abuse, division of the

application after the beginning of examination has been made subject to the Examining Division considering such division justified. Division because of lack of unity is possible under paragraph 1 (a) at any stage in the procedure, on the invitation of the Examining Division. Details concerning division are to be dealt with in the Implementing Regulations.

111. Article 95 lays down provisions concerning the notification of the results of an examination which gives rise to objections against the application. On the one hand, it concerns objections on the grounds of substantial deficiencies, such as lack of novelty or inventive step, which cannot be corrected. The object of the notification of the result in such a case is to give the applicant the opportunity to present his observations. In particular, Article 95 also concerns notifications intended to allow the applicant to present his application in a form such that a patent can be granted. This means that the applicant is required to remove any formal deficiencies or to limit the subject of his invention in such a manner as to remove any obstacles to the grant of the patent.

112. Under Article 97, the European patent is granted on the basis of examination proceedings in which only the applicant takes part (cf. second sentence of Article 93 (1)). Intervention by third parties in the form of opposition can only take place after the patent has been granted (see Articles 101 et seq.).

113. For the rest, Article 97 lays down the details for the grant of the patent, as contained in Article 101 of the 1962/65 Drafts under the heading "Confirmation of a provisional European patent". The purpose of informing the applicant pursuant to paragraph 1 is, in addition to requesting payment of the fees, to let him know the form in which it is intended to grant the patent, before it is granted. This information will only be given after any differences of opinion between the applicant and the Examining Division in respect of the form of the patent have been largely settled. By paying the fees due, without any further comment, the applicant signifies his agreement to the form of the patent communicated to him. He may, however, provided that he pays the fees in due time, formulate any further requests for amendment. Should the Examining Division not agree to his, these requests may lead, subject to postponement of the grant of the patent, to a further exchange of letters, since the general principle applies, that a patent may only be granted in a form agreed upon with the applicant. Delay

of the grant of the patent as a result of the exchange of further differences of opinion as to the form of the patent should, however, seldom occur. For this reason it appeared to be justified to request payment of the fees at the same time as the communication under Article 97 (1) is sent. In the event of failure to pay the fees due, as elsewhere in the Convention, the fictitious arrangement whereby the application is deemed to be withdrawn will apply, in the interests of a rapid and labour-saving procedure.

114. Article 97 pays particular attention to third parties who have made a request for examination. These third parties do not take part in the proceedings which they have initiated (see second sentence of Article 93 (1)). However, Article 97 provides that they shall be notified of both the communication pursuant to paragraph 1 and the decision to grant the patent pursuant to paragraph 3, in order to give them early and direct information as to the results of the proceedings.

115. Article 98 deals with the basic factors governing the form of the specification. The specification must allow the public to see for which Contracting States the patent has been granted, and it must also be possible to ascertain until what time it is possible to enter an opposition against the grant of the patent.

116. Article 100 follows from the basic principle of the projected Convention, i.e. that the European patent represents a bundle of national patents which – apart from the Community patent of the Member States of the EEC – separates out into the national patents when granted. For this reason it was necessary to include a provision allowing the Contracting States, on the basis of national law, to require a translation of the specification into their official language or languages. The Community patent of the EEC States is to be covered by special provision in the second Convention.

117. Article 100 regulates the competence of the Contracting States definitively, but does afford them various possibilities as regards the method of preparation and the publication of the translations. It might also follow from this Article that a Contracting State may restrict itself to requiring the translation of only part of the specification, such as the claims. The provision laid down in Article 19 (4) is independent of Article 100: in the former, the translation of the claims can be made a condition for the grant of protection for the European patent application.

REPORT BY THE BRITISH DELEGATION ON ARTICLES 101 TO 107

CHAPTER III

OPPOSITION PROCEDURE

118. The relevant Articles of the 1965 Draft (Articles 96a to 104) made provision for an opposition procedure

following upon the publication of the examined claims but before the actual grant, a three months period being then allowed for opposition. The Working Party was agreed that the whole specification should be published at this stage. However, a designated State could not

REPORT BY THE FRENCH DELEGATION ON ARTICLES 108 TO 116

CHAPTER IV

APPEALS

30. Chapter IV of Part V of the Preliminary Draft Convention (Articles 108 to 116) deals with appeals from the decisions taken by the Examining Sections and Examining Divisions in the procedure for granting European patents.

In accordance with the Memorandum of 13 May 1969, the Working Party made provision in this connection for the creation of Boards of Appeal (Article 53, point (b), Article 56 and Article 58) and of an additional jurisdictional body called the Enlarged Board of Appeal (Article 53, point (c), Article 57 and Article 58), the latter having as its function the co-ordination of the juridical action of the Boards of Appeal, but forming part of the European Patent Office.

31. Articles 108 to 115 refer to the conditions, effects and procedure for appeals to the Boards of Appeal. These provisions, based very largely on those which are stipulated by the patent laws of the examining European countries, specify only the main outline of the European procedure. They will be set out in more detail in the Implementing Regulations and supplemented by common procedural provisions (challenges to members of Boards of Appeal, the obtaining of evidence, observation of time limit prevented by force majeure, time limits, etc.).

32. Article 108 deals with decisions subject to appeal. It is applicable, not to expressly specified decisions, but to all decisions of the Examining Sections and Divisions (paragraph 1). This general rule is the only one which it seemed feasible to adopt, owing to the diversity of proceedings before the European Office. It is limited in paragraph 2, which provides that only final decisions are subject to appeal, to the exclusion of preliminary or contributing decisions, though the latter may be the subject of an appeal together with the final decision. The purpose of these provisions is obviously to prevent appeals which would be merely stalling for time. Paragraph 2 makes it clear, however, that by final decisions is meant those which terminate proceedings "as regards one of the parties". It was indeed justifiable to permit an immediate appeal in regard to decisions terminating individual proceedings without having to wait in every case for the conclusion of the examination procedure.

By the terms of paragraphs 3 and 4, the allocation of costs of proceedings stipulated in an initial decision cannot be the object of an appeal unless the appeal includes the decision itself and in no case unless the amount of the costs is in excess of a figure to be determined.

33. In conformity with the general rule followed under national laws, it is provided in Article 109 that appeals shall have suspensive effect. A decision appealed from

may not become mandatory until it has been upheld by the Board of Appeal.

134. By the terms of Article 110, appeal proceedings are open to all those who participated in the original proceedings with the exception of any party whose claims were favoured by the decision from which the appeal is being made. As is the rule in all legal systems, the plaintiff must be entitled to act and must prove that he has a justified interest. It is understood that the words "proceedings" and "participants" must be interpreted in a very broad sense, as they concern not only the proceedings for examination and for grant of a European patent, but also the proceedings relating to the designation of the inventor, consultation of files, etc.

135. Article 111 deals with the time limit and form of appeals. The time limit proposed for lodging an appeal is two months from the date of issue of the decision, which is the time provided by the Austrian legislation, amongst others. This time limit would appear to be sufficient, especially since Article 111 provides that the applicant may have another month in which to clarify in greater detail in an additional written statement the grounds set forth in his initial appeal.

An appeal is considered as not having been lodged unless the required fee has been paid. It is understood, however, that a decision classifying an appeal as null and void for that reason may itself be the object of an appeal.

136. Article 112 provides that the authority whose decision is the object of an appeal may change that decision. This provision is directed towards dispensing with the appeals procedure in the relatively large number of cases not subject to further question, particularly those where the original decision is attributable to an error by the European Patent Office or to the failure to observe a time limit, the consequences of which could then be removed by a *restitutio in integrum*.

Retraction of the original decision is automatic when the appeal is receivable and is well founded.

Paragraph 3 provides that no retraction shall be possible if the appellant is not the only party to the proceedings which led to the contested decision. This provision applies particularly — but not exclusively — to opposition proceedings.

Article 113, which deals with the examination of appeals, sets forth in paragraph 1 the principle of automatic examination, by analogy with the rule followed in the original proceedings. Even if the appellant contests only a part of the decision appealed from, the Board of Appeal may amend the entire decision. An appeal brought against a decision only partially refusing the application may therefore lead to a total rejection, possibly on the basis of evidence which did not enter into the original decision.

require a translation of the specification into its own language until at least three months after the actual grant. Thus a prospective opponent would not necessarily have before him a copy of the specification in his own language and this might be a serious hardship. If provision were made to allow a State to require a translation of the specification after publication but before opposition, the opposition period would have to be extended in all cases to allow time for preparation and publication of the translation and for consideration of whether to oppose; this extended period could perhaps be as long as nine months or a year and this delay might be thought unacceptable.

The Working Party were also conscious that pre-grant opposition procedure may involve prolonged delay for the applicant unless he is entitled to sue for infringement and obtain an injunction during the opposition period.

119. Accordingly the Working Party considered a proposal for "belated opposition" in accordance with which the patent would be granted after *ex parte* examination and a printed specification would be published in one working language with the claims in the other two also. Any State would have the right to demand translations into its own language after three months. Within one year from the grant anyone could belatedly oppose the patent — in effect seek its revocation — before the European Patent Office. Any revocation or amendment of the European patent would be effective in all designated States. This system would to a large extent remove the language difficulty mentioned above and retain the advantages of a central opposition procedure without incurring an extended delay before the grant of the patent effective in the designated countries.

The Working Party recognised that the proposed system could pose problems of conflict of concurrent jurisdiction between the European Patent Office and national courts, particularly in relation to infringement proceedings commenced while a belated opposition is pending or while the opposition period has not expired.

Although some members of the Working Party reserved their position on the "belated opposition" proposal, nevertheless it was agreed to follow that proposal in drafting the Articles concerned.

120. Article 101 provides that, within one year of grant, any person may oppose the patent granted. The grounds upon which he may oppose have not yet been discussed but it is thought that they will be mainly failure of the specification to comply with Articles 9 to 14, lack of clarity in the claims and the introduction of new matter into the specification when it was before the European Patent Office; either this Article or the Regulations will set out the grounds. The opposition will be dealt with by the Examining Division and Article 55 has been amended to make this clear. The division will be differently constituted from that which granted the patent but one member will, if possible, be included in both.

121. Articles 101 (3), 102 and 103 deal with the procedure during the opposition and may need further

consideration in connection with consideration of the Regulations.

122. Article 104 prevents broadening of a claim after grant. The subject is to ensure that no one, operating in the art in such a way as to avoid infringement of the granted patent, will become liable for infringement of the patent if amended during opposition.

123. Article 98 of the 1965 Draft provided for division of the application during opposition but this was not thought necessary or desirable after grant. Accordingly the Article has been deleted. A corollary would seem to be that lack of unity of invention would not be a ground of opposition.

124. Article 99 of the draft has been deleted but it will be considered later whether provision must be made for carrying on the opposition if the patent lapses during the proceedings. The reason is that if the patent lapses it will have been a patent up to the time of lapsing and the patentee could sue nationally for infringement committed up to that time; however the patent, if invalid, ought not to have given rise to any rights and accordingly it would seem necessary to allow the opposition to be prosecuted to the point of revocation which would be retrospective.

125. Article 100 of the 1965 Draft has been deleted as there is no question of refusing a patent already granted.

126. Article 105 allows the Examining Division to revoke the patent, to dismiss the opposition, or to maintain the grant with amendment of the specification. In the last case, it will be necessary to issue a printed publication of the amended specification and thus to charge a printing fee. If this is not paid the patent will be revoked.

127. Article 106 requires the Examining Division to hear any party to the opposition on request. Thus no decision can issue against a party without that party having had an opportunity of presenting his case orally.

128. Article 107 prescribes the procedure for publishing any specification which has been amended in opposition proceedings. Paragraph 4 allows any designated State to require a translation into its own language of the amended specification not less than three months after the publication if the patent is to be of effect in that State. Thus any State can ensure that its nationals can have in their own language the final form of the European patent.

129. Article 104 of the 1965 Draft has been brought forward and is now Article 99. The Working Party thought that a certificate would be of no use after the revocation had been concluded but might conceivably be of some use to the patentee immediately after grant.

The restrictions contained in this Article are necessary for two reasons:

The Co-operation Treaty is a closed treaty. The advantages attaching to it can only be claimed by certain persons who stand in a particular relationship to the Contracting States which bear the financial and other charges of the Treaty. Article 9 of the Co-operation Treaty therefore lays down that only nationals of a Contracting State, or persons having their residence or registered place of business in a Contracting State, may file an international application. This principle is extended by Article 9 (2) of the Co-operation Treaty, in that the Assembly of the Contracting States may decide that nationals or residents of other States may file international applications. This provision covers cases in which, for some reason, a certain State does not feel able to become a Contracting State to the Co-operation Treaty, but in which it appears useful, in the interest of the world-wide application of the Co-operation Treaty, the nationals or residents of that State should be enabled to enjoy the advantages of the international procedure. Article 9 (2) of the Co-operation Treaty is supplemented by Rule 19 of the Regulations under the Treaty, which sets out in detail which patent office is competent as the receiving Office for a given international application.

According to Rule 19.1 (a) of the Regulations, the applicant may file his international application either with the national Office of the Contracting State of which he is a resident, or with the national Office of the Contracting State of which he is a national. Paragraph (b) extends this provision in the sense that a Contracting State may, by means of an agreement, transfer the function of receiving Office to another national Office or to an inter-governmental organisation. Finally, paragraph (c) provides that the PCT Assembly is to appoint the competent receiving Office for applications made by residents or nationals of non-Contracting States.

The second reason for the restrictions in Article 119 is the fact that Contracting States to the Convention may possibly not be or may not yet be Contracting States to the fact that Contracting States to the Convention may be expected to accept a rule under which their nationals or residents had the right, on account of their nationality or residence qualification, to file international applications with the European Patent Office.

149. Article 119 of the Convention therefore first provides, in paragraph 1, that the only persons qualified to file an international application with the European Patent Office shall be those who either have the nationality of a Contracting State to the Convention, in respect of which the Co-operation Treaty has in fact entered into force, or who have their registered place of business or residence in such State.

150. Article 119 (3) offers the European Patent Office the possibility, subject to the approval of the Administrative Council, of acting as a receiving Office for applications from nationals of States for which the PCT Assembly has appointed the European Patent Office as a receiving Office in accordance with Rule 19.1 (c) of

the Regulations in implementation of a decision taken under Article 9 (2) of the Co-operation Treaty. The same rule is to apply for persons having their registered place of business or residence in such non-Contracting State. This provision could be significant for applications from developing countries which are connected with a Contracting State to the Convention.

151. According to Article 119 (2) of the Convention which corresponds to the special case of Rule 19.1 (b) of the Regulations under the Co-operation Treaty, the Administrative Council may conclude an agreement with a Contracting State to the Co-operation Treaty, which is not a Contracting State to the Convention, under which applications from that State are not to be filed with the national Office of such State, but with the European Patent Office. This case, too, may primarily be of interest to non-European developing countries which cannot accede to the Convention, but which might entrust the function of receiving Office to the European Patent Office. The difference between the cases provided for in paragraph 2 and in paragraph 3 lies in the fact that paragraph 2 deals with nationals and residents of States which are Contracting States to the Co-operation Treaty but not to the Convention, while in paragraph 3 the State in question is not a party either to the Co-operation Treaty or to the Convention. For this reason, in the case set out in paragraph 2, the initiative for transferring the function of receiving Office to the European Patent Office may come from the State which cannot become a Contracting State to the Convention, while in the case provided for in paragraph 3 the PCT Assembly must ask the European Patent Office and the Administrative Council to accept the function of receiving Office.

152. It must be pointed out for the sake of clarity that the object of paragraphs 2 and 3 is simply to make prior provision for special situations arising in the future. The inclusion of these Articles by the Working Party does not mean that its members consider that such situations are very likely to occur. In any case, the European Patent Office's function as a receiving Office under the Co-operation Treaty will, in the first years of its activity, be restricted to the cases provided for in paragraph 1.

153. Article 120 is made necessary by Article 64. Under that Article, a European patent application may either be filed directly with the European Patent Office or through the intermediary of the national Office of a Contracting State to the Convention. According to Article 64 (2), any Contracting State may prescribe that persons having their residence or their registered place of business in its territory may only file European patent applications with its own national Office.

154. The first sentence of Article 120 (1) limits the choice given to the applicant by Article 64 of the Convention.

This appeared to be necessary because in some cases the receiving Office only has a very short time available for the formal examination and the transmittal of an international application. International applications

have to be transmitted to the International Bureau within 13 months from the priority date. If an applicant takes the whole priority year under the Paris Convention to file an international application, the receiving Office has only about a month available for the formal examination and the transmittal. It does not seem desirable that this short space of time should be shortened still further by the application first being filed with the national patent Office of a Contracting State as an intermediary step. This would mean the loss of a few days at least. There would also be the danger of the application being lost on the way from the national patent Office to the European Patent Office.

155. The second sentence of Article 120 (1) does however leave the route via the national Office open for the case in which a Contracting State insists on the use of this route for reasons of national security.

156. For the case in which an international application is filed with the European Patent Office via a national patent Office, Article 120 (2) provides that such national Office shall take all the necessary measures to ensure that the application is transmitted to the European Patent Office in due time. The national Office must therefore carry out the security check which it considers to be necessary so quickly that transmittal of the application by the European Patent Office to the International Bureau is not endangered thereby. A national Office naturally has the right, in the interests of its national security, to refuse to transmit the application to the European Patent Office.

157. Article 121 (1) and (2) make provision for the case in which the European Patent Office is to act as a designated Office under the Co-operation Treaty. According to Article 4 (1), sub-paragraph (ii), of the Co-operation Treaty, an international application must contain the designation of the Contracting State or States in which protection for the invention is desired. If an applicant wishes his international application under the Co-operation Treaty to lead to the grant of a European patent, he must first designate those Contracting States to the European Convention for which the European patent is to be granted on the basis of the international application. Designation of these Contracting States in this way will not of itself lead to the desired result. The applicant will also have to make it clear that the European Patent Office is to act as designated Office, in place of the national patent Offices of these Contracting States, and thereby that he wants to have a European patent. Article 121 (1) gives him a time limit of 12 months after the priority date for making such a communication. The priority date within the meaning of this provision is to be understood as the date of the earliest application, the priority of which is claimed for the international application, or, if no priority is claimed, the date of filing the international application. The limitation to 12 months is necessary because it ensures, in the event of very early transmittal to the designated Offices, that the application is forwarded to the right designated Office. In addition, the designated Offices which ask for early transmittal of a copy of the

international application under Article 13 of the Co-operation Treaty will see from it whether it is desired to obtain, by means of the international application, a European patent or a national patent in individual Contracting States to the European Convention. The communication is to be made either to the receiving Office or, if the international application is no longer with the receiving Office, to the International Bureau (BIRPI or WIPO). Paragraph 1 is drafted in such a way that the time limit is met if the communication is received by either of these bodies, since it could be difficult for the applicant to determine whether his application has already been forwarded to the International Bureau or not.

158. According to Articles 8 and 67 (4) of the Convention any group of Contracting States may provide that they may only be designated jointly. This provision is intended in the first place to cover the Member States of the European Economic Community, which wish to prescribe in a separate convention that the European patent is to count as a unitary patent for their territory. Article 121 (2) gives such a group of States the possibility of also laying down a corresponding special rule for international applications which are intended to lead to the grant of a European patent. In order to save the applicant from legal disadvantages if he accidentally fails to designate certain Contracting States in this group, it will be possible to prescribe that all the Contracting States in the group are to be taken as being designated even if only one or some of the Contracting States of the group have been designated, provided that the applicant has indicated that he wishes to obtain a European patent for these States.

159. Neither in Article 121 (1) and (2) nor in other Articles is it expressly provided that the European Patent Office may only become the designated Office for those Contracting States to the Convention which are at the same time Contracting States to the Co-operation Treaty. A ruling of this type appears to be unnecessary, since the receiving Office will refuse the designation, in an international application, of a State which is not a Contracting State to the Co-operation Treaty. As far as the States belonging to the European Economic Community are concerned, it is assumed that they will all have ratified the Co-operation Treaty before the Convention enters into force or that they will ratify it later at the same time.

160. Since designation fees are already levied for international applications in respect of every designated State, Article 121 (4) lays down that no additional "European" designation fee is to be payable under Article 67 (2) of the Convention.

161. According to Article 121 (3) of the Convention, the European Patent Office may act as an elected Office if the following conditions are met:

- (i) the applicant must have named as a designated State, and must have elected, a Contracting State to the Convention for which Chapter II of the Co-operation Treaty has entered into force,

Paragraph 2 provides, however, that the Board of Appeal is not obliged to consider facts or evidence which were not submitted when they should have been. This provision serves to prevent the appeal proceedings from being excessively delayed by negligent or intentionally dilatory applicants.

Paragraph 3 authorizes the Board of Appeal to ask the Examining Section for further information concerning the state of the art or to obtain an additional report from the International Patent Institute at The Hague. This provision would be applied particularly in a case where the appeal proceedings might lead the applicant to withdraw some part of his claims. An additional search may be necessary in such a case, as regards the claims maintained, in respect of which the first report might not be sufficiently complete. Paragraph 3 provides that in such a case the applicant may be asked to pay an additional fee.

138. As is generally admitted in judicial bodies, Article 114 provides that a hearing before the Board of Appeal shall take place if requested by any of the parties concerned. In the absence of any such request, the Board of Appeal itself may decide to hold such a hearing.

139. Article 115 refers to the different decisions which may be taken in respect of an appeal.

Paragraphs 1 and 2 provide that a decision may be taken to reject the appeal as inadmissible if it does not comply with Articles 108, 110 and 111 (lack of status or interest of the applicant, failure to observe the time limit for filing the appeal or submitting the additional statement, etc.) or to dismiss the appeal if it is unfounded in substance.

It is recalled in this connection that if the required fee for the appeal has not been paid or was not paid within the time due, the appeal may be deemed not to have been lodged (Article 111).

The decision as to whether the appeal is receivable must naturally precede any decision as to whether or not it is well founded.

Paragraph 3 authorizes the Board of Appeal, if it annuls the decision attacked, in whole or in part, to remit the matter to the authority which took the initial decision, or to take a final decision on its own account.

If the matter is remitted to the authority which issued the initial decision, that authority may, by virtue of paragraph 4, give a new decision in conformity with the decision of the Board of Appeal. Paragraph 4 adds that

the Examining Division shall also be bound by the interpretation expressed by the Board of Appeal regarding a decision by an Examining Section. This special provision serves to avoid a new appeal proceeding in the same case in the event that the Examining Division diverges from the position taken by the Board of Appeal.

Paragraph 5 conforms to the general principle already expressed in Article 78 (5).

140. Article 116 lays down the conditions in which matters may be referred to the Enlarged Board of Appeal.

In order to co-ordinate the jurisprudence of the Boards of Appeal, the 1962 and 1965 Drafts provided that the decisions of these Boards could be the subject of a further appeal to the European Patent Court, especially in order to ensure uniform application of the law or to settle an important point of law.

The new Preliminary Draft ((c) under Article 53) entrusts this regulatory function and these powers to the Enlarged Board of Appeal.

This higher board, which can be compared with certain national courts, such as the "Verstärkter Senat" (Reinforced Senate) established under former Austrian law, the "sections de recours réunis" (combined appeal sections) under Swiss law or the "Grosser Senat" (Grand Senate) of the old German law, is not a third level of the European Patent Office.

Article 116 (1), sub-paragraph (a), provides that, during proceedings on a case, the Board of Appeal may refer any question to the Enlarged Board of Appeal for decision. The decision of the Enlarged Board of Appeal is binding upon the Board of Appeal in the case in question (paragraph 2).

The same Article also provides (paragraph 1, sub-paragraph (b) that matters may be referred to the Enlarged Board of Appeal by the President of the European Patent Office. It follows, "*a contrario*" from paragraph 2, that in such a case the opinion expressed by the Enlarged Board of Appeal is not legally binding on the Boards of Appeal, which will not of course prevent it from influencing the Boards of Appeal in practice.

Nevertheless, while the Working Party was unanimous in admitting the possibility of such action in the particular case where two Boards of Appeal have given contradictory decisions, different opinions were expressed on the advisability of extending the powers given in this connection to the President of the European Patent Office.

REPORT BY THE GERMAN DELEGATION ON ARTICLES 117 TO 123

CHAPTER V

INTERNATIONAL APPLICATION PURSUANT TO THE PATENT CO-OPERATION TREATY

141. Chapter V contains the provisions which are intended to make it possible, in accordance with the

Memorandum of 13 May 1969, for a European patent to be obtained via an application under the Patent Co-operation Treaty (PCT) — referred to in this Chapter as "the Co-operation Treaty". This Chapter also lays down the conditions making it possible for European applicants to file international applications with the European Patent Office as a receiving Office.

142. Article 117 (1) lays down that the Co-operation Treaty can also be applied within the framework of the Convention for a European System for the Grant of Patents — subsequently referred to as “the Convention” — in accordance with the provisions of the Chapter under consideration. It is necessary to have a basic provision of this type since, in the absence of a special treaty arrangement, the Co-operation Treaty would only apply, after its ratification by a Contracting State to the Convention, to such a State's national system for the grant of patents. This provision is also compatible with the Co-operation Treaty, which provides expressly in its Article 44 for its application to patent applications and patents with effect in more than “one State” and to the corresponding international treaties. According to Article 2 (1) of the Co-operation Treaty, an international authority entrusted by several States with the task of granting patents is also to be regarded as a national Office within the meaning of that Treaty.

143. According to Article 117 (2) proceedings before the European Patent Office in respect of international applications under the Co-operation Treaty are to be subject in the first place to the provisions of that Treaty. The provisions of the Convention are to be applied only on a supplementary basis. Consequently they only apply in so far as they do not conflict with the provisions of the Co-operation Treaty. To the extent that the European Patent Office acts simply as a receiving Office within the meaning of the Co-operation Treaty, this precedence given to the provisions of the Co-operation Treaty follows from the nature of the situation. In this case, it is not a question of a procedure for the grant of a European patent; rather, the European Patent Office is simply acting as a receiving Office under the Co-operation Treaty and it seems quite obvious that it should perform this function in accordance with the provisions of the Co-operation Treaty. Where the European Patent Office acts as designated Office, the precedence given to the provisions of the Co-operation Treaty is required by Article 27 (1) of that Treaty. It is there prescribed that no designated State — and therefore no group of designated States — shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in that Treaty and the Regulations under it. In addition, in so far as Chapter II of the Co-operation Treaty contains provisions concerning International Preliminary Examining Authorities and elected Offices, these provisions must have precedence over the provisions of the Convention where the European Patent Office acts as an International Preliminary Examining Authority or an elected Office. On the other hand, it is natural that, as is the case in every national patent legislation, the Convention must contain supplementary provisions concerning the processing of international applications by the European Patent Office.

144. In order to simplify the text of the Convention it is provided in Article 117 (3) that references to the Co-operation Treaty shall also include the Regulations under that Treaty.

145. Account must be taken of the fact that, when the European Patent Office starts its activity, the Co-operation Treaty will not already be in force for all the Contracting States to the Convention, and that it will subsequently come into force for the remaining States on differing dates. It is however desirable that, even before the Co-operation Treaty has come into force for all the Contracting States to the Convention, the European Patent Office can accept international applications as a receiving Office and can deal with them as a designated Office, to the extent laid down in detail in the subsequent Articles. The European Patent Office requires a treaty authorization to do this, since it is a joint creation of all the Contracting States to the Convention. Article 118 (1) therefore lays down that, subject to the provisions set out in the subsequent Articles, the European Patent Office may act as a receiving Office and as a designated Office under the Co-operation Treaty as soon as that Treaty has entered into force for at least one Contracting State to the Convention. The subsequent Articles ensure that the status and the rights of those States for which the Co-operation Treaty has not yet entered into force are not thereby affected.

146. According to Chapter II of the Co-operation Treaty, an international preliminary examination report is to be prepared, on the demand of an applicant, by one of the International Preliminary Examining Authorities appointed by the Assembly instituted by the Co-operation Treaty. It is possible that the European Patent Office may be appointed as an International Preliminary Examining Authority by this Assembly. The decision as to whether the European Patent Office is to request appointment as an International Preliminary Examining Authority will have to be taken by the Administrative Council, which would then have to conclude a corresponding agreement with the International Bureau under the Co-operation Treaty — the BIRPI or WIPO. It will be necessary to include a corresponding authorization in the Rules governing the powers of the Administrative Council.

For this case too, i.e. that the European Patent Office should become an International Preliminary Examining Authority under the Co-operation Treaty, a special provision is required which enables the European Patent Office to undertake this activity before all the Contracting States to the Convention have become Contracting States to the Co-operation Treaty and have accepted Chapter II thereof, the application of which Contracting States to the Treaty may exclude. Article 118 (2) contains a provision of this type.

147. Article 118 (3) contains a corresponding provision for the European Patent Office being appointed as an elected Office within the meaning of Chapter II of the Co-operation Treaty, i.e. for the case in which the European Patent Office receives an international preliminary examination report produced by another authority.

148. Article 119 sets out in detail the conditions which must be met to enable the European Patent Office to accept international applications as a receiving Office.

- (ii) he must have indicated that he desires a European patent for this State and therefore that the European Patent Office is to be the designated Office.

The election of such a State means that the European Patent Office is also the elected Office for all the other Contracting States to the Convention which have been designated. This applies even when the Co-operation Treaty as a whole, or Chapter II thereof, has not entered into force for the other designated Contracting States. These other Contracting States must consequently accept that the European patent application is not dealt with before the end of the time limit of 25 months which is laid down in Chapter II of the Co-operation Treaty.

162. Article 122 (1) lays down that the International Search Report under Article 18 of the Co-operation Treaty shall take the place of the report on the state of the art provided for in the Treaty. It may be assumed that an International Search Report under the Co-operation Treaty will as a rule be equivalent to the report on the state of the art provided for in the Convention. This means that a European application which is based on an international application will be accompanied by a report which is adequate for the purposes of the European procedure. For the special case of the International Search Report not meeting the European requirements, it is provided in paragraph 2 that the European Patent Office may obtain a supplementary report on the state of the art from the International Patent Institute at The Hague at any time. The cost of this supplementary report will presumably have to be charged to the applicant, but this question has not yet been sufficiently elucidated. The provisions of paragraph 2 will enable the European Patent Office to examine international applications upon receipt in order to see if, on the face of it, the International Search Report meets or does not meet the requirements of this Convention. It would conflict with the spirit of the Co-operation Treaty if a report from the International Patent Institute at The Hague were in every case or for particular groups of cases to be automatically required in addition to the International Search Report. Instead, the European Patent Office is to decide in each case whether it is necessary to obtain a supplementary report on the state of the art.

163. The object of Article 123 of the Convention is to produce conformity with Article 29 of the Co-operation Treaty. Under the latter Article the protective effects of the international publication of an international application are to be the same as those of compulsory national publication of an unexamined national application. The Article does however give the designated States the possibility of providing that the protection shall apply only from a later date, when the international application has not been published in the language in which national applications are published. In this way, the designated States will be able to protect third parties in their territories from claims based on provisional

protection being brought against them before the application has either been made available to the public, or has been communicated to such third parties, in the language of such designated State.

Article 123 complies with this principle.

164. Paragraph 1 first provides that, as from its international publication by the International Bureau, an international application for which the European Patent Office is a designated Office shall confer the provisional protection granted pursuant to Article 19 of the Convention, i.e. the same provisional protection as that associated with the publication of an unexamined European application. It follows from the reference to Article 19, paragraph 1 of which refers in its turn to Article 18 of the Convention, that this provisional protection is only granted for those Contracting States to the Convention which are designated in the international application.

165. The International Bureau will publish the international application either in the English, French, German, Japanese or Russian version in which it has been filed, or, if it has been filed in another language, in an English translation. It is only the abstract which will always be available in English (see Rule 48.3 of the Regulations under the Co-operation Treaty). Since, in a number of cases, only the abstract will be available in a language which is widely employed in western Europe, the principle laid down in paragraph 1 must be limited in the subsequent paragraphs. Interested parties cannot be expected to take notice of an application which is available only in Japanese, for example, with an English abstract. Provisional protection can, rather, only commence at the time at which, from the linguistic point of view, the international application has been published to an extent not less than that laid down for the publication of European patent applications in Article 34 (5) of the Convention. This is guaranteed by paragraphs 2 and 3 of Article 123: The application must be published in at least one of the languages specified in Article 34 (1) of the Convention; in addition, a translation of the claims into both of the other languages specified in Article 34 (1) must be published. This means that, in the case referred to in paragraph 2, in which the International Bureau has already published the international application in one of the specified languages, all that is required is a translation of the claims into the other languages. In other cases, for example in the case of an international application published in Japanese, a translation of the application into one of the languages specified in Article 34 (1) is also required. This rule does not affect the right of every Contracting State to make the commencement of provisional protection depend on the claims being translated into one of its official languages and being made available to the public or at least to those affected by the provisional protection. This right, which is laid down in Article 19 (4), is of course also applicable in the context of Article 123.

166. In addition, paragraph 4 of Article 123 lays down that publication of the international application by the

International Bureau, together with the publication of the translation of the claims pursuant to paragraph 2, or the publication of the translations of the application and the claims pursuant to paragraph 3, is to take the place of the publication of the European application pursuant to Article 85. The object of the provision is to lay down that after the publication of the translations still required under paragraphs 2 and 3 the international application is regarded as being at the same stage of the European Patent Office procedure as a European application which has not been filed via the PCT route, but has been published pursuant to Article 85 of the Convention. For example, as from the date of publication of the translations, it is possible for any third party to raise objections against the patentability of the invention which is the subject of the application, in accordance with Article 87.

167. On account of the Co-operation Treaty, Articles 117 to 123 must be supplemented by further provisions. Supplementary provisions are in particular required for the cases in which the Co-operation Treaty leaves it to the national legislature to lay down rules or at least permits this. A special ruling might for example be required by Article 17 (3), sub-paragraphs (b) and (c), an Article 34 (3), sub-paragraphs (b) and (c) of the Co-operation Treaty. At the present stage, it is not necessary to formulate such special rules, which are only of secondary importance for the European system for the grant of patents as a whole. The drafting of these provisions can be left until after the diplomatic conference on the Co-operation Treaty, in order to wait and see in what form the individual Articles of the Co-operation Treaty, which would form the basis for such rules, issue from this diplomatic conference.

REPORT BY THE SWISS DELEGATION ON ARTICLES 124 TO 132

CHAPTER VI

CONVERSION OF A EUROPEAN PATENT APPLICATION INTO A NATIONAL APPLICATION

168. The Working Party has reserved Articles 124 to 128 for possible provisions concerning the conversion of a European patent application into a national application. This question will not be examined until the basic characteristics of the procedure for grant have been established.

PART VI

RENEWAL OF EUROPEAN PATENT APPLICATIONS AND EUROPEAN PATENTS

CHAPTER I

RENEWAL OF EUROPEAN PATENT APPLICATIONS

169. Article 129 (1) sets out the principle that the annual fees for a European patent application must be paid to the European Patent Office. The amount of these fees will be fixed in the Rules relating to fees, which are still to be drawn up. When drawing up these Rules, the Working Party will deal with the questions still left open, i.e. will the amounts of these fees be fixed or progressive, and are the renewal fees to include a supplement (country fee) fixed according to the number of Contracting States which have been designated? In this connection, see the introductory note to Part VI of the First Preliminary Draft Convention.

The Working Party considers that the question of whether the renewal fees are to help finance the European Patent Office, and if so, to what extent, should be reserved for the financial provisions in Articles 41 to 52.

Paragraph 2 clearly lays down for which period the last renewal fee has to be paid to the European Patent Office.

Paragraph 3 settles the question of the payment of renewal fees for European patents of addition. The Working Party is unanimous in considering that renewal fees should be paid for applications for patents of addition which have become independent applications, in the same way as for originally independent applications, i.e. retrospectively to the date of filing of the application. Against this, it was proposed that applications for patents of addition should be treated in the same way as applications for independent patents, as far as fees were concerned, and that the same fees should be levied.

The Working Party considered that this solution, which would compromise the advantages of an application for a patent of addition, would be less favourable to applicants than the solutions adopted by most of the national legislations, and rejected it by a majority vote.

Neither did the Working Party approve another suggestion that renewal fees should in principle be imposed for applications for patents of addition, but that these fees would be repaid if the patent remained a patent of addition when granted. The Working Party considered that such a procedure would be too expensive to administer.

170. Article 130 deals with the payment of renewal fees. The Working Party proposes in paragraph 1 that the due date should not be the anniversary of the date of filing of the application, but of the last day of the month in which the application was filed. This means that it will only be necessary to check on 12 due dates each year, and that it will be much easier for the European Patent Office to supervise the payment of fees.

The time limit of 6 months, and the imposition of an additional fee, which are laid down in paragraph 2 result from the obligation contained in Article 5bis of the Paris Convention.

The fiction of withdrawal of the application which is introduced into paragraph 3 corresponds to the consequence of failure to pay which the Draft normally lays down for failure to observe time limits.

171. Article 131 specifies that the administrative and judicial authorities of the Contracting States are bound by the decisions of the European Patent Office as to whether renewal fees and additional fees have been paid in due time. Depending on the stage reached in the procedure, it will be either the Examining Sections or the Examining Divisions which will have to take these decisions. In addition, in order to make it clear that the fiction introduced in Article 130 does not imply any disadvantage for the applicant, this provision refers expressly to the possibility of an appeal.

172. The Working Party has deleted the provisions of Articles 122 and 123 of the 1965 Draft, concerning

extensions of time for payment and the effects of failure to pay within the extended period. The object of these provisions was to enable a needy applicant to delay payment of the renewal fees due during the procedure, until after the final grant of the patent. In view of the structure of the present draft, this object can no longer be obtained, since — apart from revocation as a result of opposition proceedings — the European patent is subject after its grant to the national legislation of the Contracting States. It is for this reason that the maintenance of the European patent should not depend on the subsequent payment of European fees. When it deals with the question of assistance, the Working Party will examine whether it should also be extended to renewal fees.

CHAPTER II

RENEWAL OF EUROPEAN PATENTS

173. Article 132 defines the right of the Contracting States to impose renewal fees for European patents producing effects in their territories. This authorization already follows from Article 2 (2). Applicants or patent holders must however be prevented from having to pay a renewal fee both to the European Patent Office and to the authorities of the Contracting States for one and the same period of time.

With this in view, the Article lays down that Contracting States may only impose a fee in respect of a patent for the years following the last year for which a renewal fee had to be paid to the European Patent Office in respect of the application.

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174. The Articles which governed the surrender, lapse and revocation of the European patent, and also compulsory licences, in the 1965 Draft, have not been included in the present Draft Convention. These are legal points affecting the existence of the European patent. According to Article 2 (2) of the Preliminary Draft Convention the legal system of the Contracting States as applicable to national patents of these States is applicable here.

REPORTS ON THE FIRST CONVENTION

This booklet contains the reports which constitute a commentary on the First Preliminary Draft Convention for a European system for the grant of patents, which has been published separately.

The two booklets containing, on the one hand, the First Preliminary Draft Convention in German, English and French and, on the other hand, the reports in one of these three languages, form a set.

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