Rule 44 E

Travaux Préparatoires (EPC 1973)

Comment:

The collection represents purely an internal research tool for the purpose of Directorate Patent Law of the European Patent Office. No guarantee can be given for its completeness or correctness. The documents produced before 1969 cannot be provided in English as this was not an official language in the period before that date. These documents therefore are provided in French and German.
Regel 44
MPÜ
Inhalt des europäischen Recherchenberichts

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ANNEX I

REPORT

by Mr. Paul Braendli, Lic. iur.
Vice-Director of the Federal Intellectual Property Office (Switzerland)

on the results of Main Committee I's proceedings

ANNEX II

REPORT

by Mr. R. Bowen
Assistant Comptroller, British Patent Office

on the results of Main Committee II's proceedings

ANNEX III

REPORT

by Mr. Fressonnet
Deputy Director of the Institut National de la Propriété Industrielle (France)

on the results of Main Committee III's proceedings

ANNEX IV

REPORT

by Mr. A. Fernandez Mazarambroz
Head of the Spanish Patent Office

on the results of the Credentials Committee's proceedings

with regard to full powers for signing the Convention
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MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Munich, 10 September to 5 October, 1973)

published by the
Government of the Federal Republic of Germany
Chapter II

European search report

Rule 44

Content of the European search report

(1) The European search report shall mention those documents available to the European Patent Office at the time of drawing up the report, which may be taken into consideration in deciding whether the invention to which the European patent application relates is new and involves an inventive step.

(2) Each citation shall be referred to the claims to which it relates. If necessary, the relevant parts of the documents cited shall be identified (for example, by indicating the page, column and lines or the diagrams).

(3) The European search report shall distinguish between cited documents published before the date of priority claimed, between such date of priority and the date of filing, and on or after the date of filing.

(4) Any document, which refers to an oral disclosure, a use or any other means of disclosure which took place prior to the date of filing of the European patent application, shall be mentioned in the European search report, together with an indication of the date of publication, if any, of the document and the date of the non-written disclosure.

(5) The European search report shall be drawn up in the language of the proceedings.

(6) The European search report shall contain the classification of the subject-matter of the European patent application in accordance with the international classification.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/ 146/R 9
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Implementing Regulations: Rules 27 to 53
Chapter II
European search report

Rule 44
Content of the European search report

(1) The European search report shall mention those documents available to the European Patent Office at the time of drawing up the report, which may be taken into consideration in deciding whether the invention to which the European patent application relates is new and involves an inventive step.

(2)

(3)

(4) Unchanged from 1972 published text.

(5)

(6)
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 27 September 1973

M/140/I/R11

Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 26 SEPTEMBER 1973

Rules of the Implementing Regulations:

Rules 2
13
17
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95
(2) However, subject to the decisions of the Administrative Council referred to in paragraph 3:

(a) a supplementary European search report shall be drawn up in respect of all international applications;

(b) unchanged.

(3) and (4) Unchanged.

IMPLEMENTING REGULATIONS

RULE 9. - Allocation of duties to the departments of the first instance

(1) The President of the European Patent Office shall determine the number of Search Divisions, Examining Divisions and Opposition Divisions. (Rest of paragraph unchanged).

(2) In addition to the responsibilities vested in them under the Convention, the President of the European Patent Office may allocate administrative duties to the Receiving Section, Search Divisions, Examining Divisions and Opposition Divisions.

(3) and (4) Unchanged.

RULE 12. - Administrative structure of the European Patent Office

(1) The Search Divisions, the Examining Divisions and the Opposition Divisions shall be grouped together administratively so as to form Directorates, the number of which shall be laid down by the President of the European Patent Office.

(2) and (3) Unchanged.

VARIANT

(1) Unchanged

(2) The Directorates, the Receiving Section, the Boards of Appeal and the Enlarged Board of Appeal, and the administrative services of the European Patent Office shall be grouped together administratively so as to form Directorates-General. The Search Divisions shall be grouped together administratively so as to form a Directorate-General.

(3) Unchanged.

RULE 44. - Content of the European search report

(1) The European search report shall mention those documents available to the Search Division at the time of making the report, which may be taken into consideration in deciding whether the invention to which the European patent application relates is new and involves an inventive step.

(2) to (6) Unchanged.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 11 September 1973

M/ 59/I/II
Original: French

CONFERENCE DOCUMENT

Drawn up by: French delegation

Subject: Incorporation of the IIB into the European Patent Office as the Directorate-General for Searching Proposals for amendments to the Convention and the Implementing Regulations
unter anderem auf die Regel 36 Absatz 1 zu verweisen. In dieser letztgenannten Regel wird wiederum auf die Regeln 27 und 29 sowie 32 bis 35 verwiesen. Einige dieser Regeln enthalten jedoch materiell-rechtlich nicht nur Formvorschriften.

Regel 44 Absatz 2 – Inhalt des europäischen Recherchenberichts

27 CIFE beantragt, die Worte „soweit erforderlich“ zu streichen. Seines Erachtens ist es nämlich für den Anmelder stets wichtig zu wissen, welche Seiten, Spalten und Zeilen der Schrifstücke Anlaß zu deren Zitierung gegeben haben.

Artikel 14 und Regel 2 Absatz 1 – Sprachen des Europäischen Patentamts

28 Hat ein an einem mündlichen Verfahren vor dem Europäischen Patentamt Beteiligter die Absicht, sich einer anderen Amtssprache des Patentamts als der Verfahrenssprache zu bedienen, so sollte nach Ansicht des CIFE der betreffende Beteiligte gehalten sein, dies dem EPA schon einen Monat und nicht erst zwei Wochen vor der Anhörung mitzuteilen. Noch zweckmäßiger dürfte es wohl sein, bei jedem Beteiligten so zu verfahren, der sich einer der Amtssprachen eines der Vertragsstaaten bedienen möchte.

29 Schließlich sollte jeder Beteiligte, der sich einer anderen Sprache als der Verfahrenssprache bedient, die Kosten für die Übersetzung übernehmen müssen, aber nicht für die Übersetzung selbst Sorge tragen; dies sollte dem EPA überlassen werden, zumindest in den Fällen, in denen die verwendete Sprache eine andere Amtssprache des Patentamts ist, damit die Qualität der Übersetzung einheitlich und von möglichst hohem Niveau ist.

Artikel 18 Absatz 2 – Einspruchsabteilungen

30 Der CIFE vertritt die Auffassung, daß das Mitglied der Einspruchsabteilung, das unter Umständen am Erteilungsverfahren beteiligt war, weder mit der Bearbeitung des Einspruchs noch mit dem Vorsitz der Abteilung betraut werden dürfte.

Artikel 96 und Regel 70 – Feststellung eines Rechtsverlusts

31 Falls jemand, der von einem Rechtsverlust betroffen ist, die Auffassung vertritt, daß die Feststellung des Europäischen Patentamts nicht zutrifft, und das Patentamt sich dieser Auffassung anschließt und demnach das Verfahren fortsetzt, dürfte es wünschenswert sein, daß der Betroffene hiervon unterrichtet wird.

reference to Rule 36, paragraph 1. The latter refers to Rules 27 and 29 and Rules 32 to 35. Some of these Rules concern requirements of substance rather than of mere form.

Rule 44, paragraph 2 – Content of the European search report

27 CEIF requests deletion of the words “If necessary,” as it is considered that it will always be important for the applicant to know what are the pages, columns and lines of the documents cited that have motivated citation of these documents.

Article 14 and Rule 2, paragraph 1 – Languages of the European Patent Office

28 When a party in an oral procedure before the European Patent Office wishes to use one of the other official languages of the Office rather than the language of the proceedings, it seems desirable to CEIF that said party be required to notify the EPO one month rather than two weeks before the oral proceedings. It also seems even more desirable that the same should apply to any party wishing to use one of the official languages of the Contracting States.

29 Also, it seems preferable that a party using a language other than the language of the proceedings should bear the cost of interpretation but not assume responsibility for interpretation, which would be left to the European Patent Office, at any rate when the language used is one of the other official languages of the Office, so as to ensure translation of a uniform and if possible high quality.

Article 18, paragraph 2 – Opposition Divisions

30 CEIF thinks that the member of the Opposition Division who may have participated in proceedings for the grant of the patent should not be given the task of examination of the opposition, nor should he chair the Division.

Article 96 and Rule 70 – Noting of loss of rights

31 In a case where a person concerned considers that the finding of loss of right of the European Patent Office is inaccurate and the Office accepts his views and consequently continues the proceedings, it seems desirable that the person concerned be informed accordingly.
STELLUNGNAHME DES
CIFE
Rat der Europäischen Industrieverbände

COMMENTS BY
CEIF
Council of European Industrial Federations

PRISE DE POSITION DU
CIFE
Conseil des fédérations industrielles d'Europe

(1) English translation submitted by CEIF
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN
PATENTERTEILUNGSVERFAHRENS 1973
(München, 10. September bis 6. Oktober 1973)

MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS, 1973
(Munich, 10 September to 6 October 1973)

CONFÉRENCE DIPLOMATIQUE DE MUNICH
POUR L'INSTITUTION D'UN SYSTÈME EUROPÉEN
DE DÉLIVRANCE DE BREVETS
(1973)
(Munich, 10 septembre - 6 octobre 1973)

__________

STELLUNGNAHMEN
zu den vorbereitenden Dokumenten
herausgegeben von der
Regierung der Bundesrepublik Deutschland

__________

COMMENTS
on the preparatory documents
published by the
Government of the Federal Republic of Germany

__________

PRISES DE POSITION
sur les documents préparatoires
publiées par le
Gouvernement de la République fédérale d'Allemagne

__________

1973
Kapitel II
Europäischer Recherchenbericht

Regel 44
Inhalt des europäischen Recherchenberichts

(1) Im europäischen Recherchenbericht werden die dem Internationalen Patentinstitut zum Zeitpunkt des Berichts zur Verfügung stehenden Schriftstücke genannt, die zur Beurteilung der Neuheit der der europäischen Patentanmeldung zugrunde liegenden Erfindung und der erfinderischen Tätigkeit, auf der die Erfindung beruht, in Betracht gezogen werden können.

(2) Die Schriftstücke werden im Zusammenhang mit den Patentansprüchen aufgeführt, auf die sie sich beziehen. Soweit erforderlich werden die maßgeblichen Teile jedes Schriftstücks näher gekennzeichnet (beispielsweise durch Angabe der Seite, der Spalte und der Zeilen oder der Abbildungen).

(3) Im europäischen Recherchenbericht ist zu unter- scheiden zwischen Schriftstücken, die vor dem bean- spruchten Prioritätstag, zwischen dem Prioritätstag und dem Anmeldetag und an oder nach dem Anmeldetag veröffentlicht worden sind.

(4) Schriftstücke, die sich auf eine vor dem Anmeldetag der europäischen Patentanmeldung der Öffentlichkeit zugänglich gemachte mündliche Beschreibung, Benutzung oder sonstige Offenbarung beziehen, werden in dem europäischen Recherchenbericht unter Angabe des Tags einer etwaigen Veröffentlichung des Schrift- stücks und einer nichtschriftlichen Offenbarung genannt.

(5) Der europäische Recherchenbericht wird in der Verfahrenssprache abgefaßt.

(6) Auf dem europäischen Recherchenbericht ist die Klassifikation des Gegenstandes der europäischen Patentanmeldung nach der Internationalen Klassifikation anzuzeigen.

Vgl. Artikel 91 (Europäischer Recherchenbericht)

Chapter II
European search report

Rule 44
Content of the European search report

(1) The European search report shall mention those documents available to the International Patent Institute at the time of making the report, which may be taken into consideration in deciding whether the invention to which the European patent application relates is new and involves an inventive step.

(2) Each citation shall be referred to the claims to which it relates. If necessary, the relevant parts of the documents cited shall be identified (for example, by indicating the page, column and lines or the diagrams).

(3) The European search report shall distinguish between cited documents published before the date of priority claimed, between such date of priority and the date of filing, and on or after the date of filing.

(4) Any document, which refers to an oral disclosure, a use or any other means of disclosure which took place prior to the date of filing of the European patent application, shall be mentioned in the European search report, together with an indication of the date of publication, if any, of the document and the date of the non-written disclosure.

(5) The European search report shall be drawn up in the language of the proceedings.

(6) The European search report shall contain the classification of the subject-matter of the European patent application in accordance with the international classification.

Cf. Article 91 (European search report)

Regel 45
Unvollständige Recherche

Ist das Internationale Patentinstitut der Auffassung, daß die europäische Patentanmeldung den Vorschriften dieses Übereinkommens so wenig entspricht, daß es nicht möglich ist, auf der Grundlage aller oder einiger Patentansprüche sinnvolle Ermittlungen über den Stand

Rule 45
Incomplete search

If the International Patent Institute considers that the European patent application does not comply with the provisions of the Convention to such an extent that it is not possible to carry out a meaningful search into the state of the art on the basis of all or some of the claims,
ENTWURF EINER AUSFÜHRUNGSORDNUNG
ZUM ÜBEREINKOMMEN
ÜBER EIN EUROPÄISCHES PATENTERTeilungsverfahren

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

PROJET DE RÈGLEMENT D'EXÉCUTION
DE LA CONVENTION
INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN
PATENTerteilungsverfahrens 1973
(München, 10. September bis 6. Oktober 1973)

MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS, 1973
(Munich, 10 September to 6 October 1973)

CONFERENCE DIPLOMATIQUE DE MUNICH
POUR L'INSTITUTION D'UN SYSTÈME EUROPÉEN
DE DÉLIVRANCE DE BREVETS
(1973)
(Munich, 10 septembre - 6 octobre 1973)

VORBEREITENDE DOKUMENTE
ausgearbeitet von der
Regierungskonferenz über die Einführung eines europäischen Patenterteilungsverfahrens
herausgegeben von der
Regierung der Bundesrepublik Deutschland

PREPARATORY DOCUMENTS
drawn up by the
Inter-Governmental Conference for the setting up of a European System for the Grant of Patents
and published by the
Government of the Federal Republic of Germany

DOCUMENTS PRÉPARATOIRES
élaborés par la
Conférence intergouvernementale pour l'instutition d'un système européen de délivrance de brevets
et publiés par le
Gouvernement de la République fédérale d'Allemagne

1972
Re. Article 79, No. 4, IR - Reference to the classification of the application in the report on the state of the art

54. In connection with Article 79, paragraph 4, it was discussed whether the task of classifying the application should be assigned to the IIB. The IIB representative stated that his organisation was prepared to assume this task. The Working Party agreed to deal with the matter not in the Convention itself, but in the Implementing Regulations. To this end it laid down in the new Re. Article 79, No. 4, IR, that the IIB report on the state of the art is to contain the classification of the subject-matter of the application in accordance with the international classification; this provision does not prejudice the competency of the President of the European Patent Office as laid down in Re. Article 55, No. 3.

Article 80 - Transmission of the report on the state of the art and the abstract

55. The previous provision, whereby the IIB is to transmit the report on the state of the art to the European Patent Office within three months (Re. Article 79, No. 2, IR) was retained. As a result of the acceleration of the procedure, it was also laid down that the IIB would also send the report on the state of the art directly to the applicant (Article 80, (b)).
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

Brussels, 17 November 1971
BR/135/71

MINUTES

of the 9th meeting of Working Party I
held from 12 to 22 October 1971, in Luxembourg

1. Working Party I held its 9th meeting in Luxembourg
from 12 to 22 October 1971, with Dr. Haertel, President of
the German Patent Office, in the Chair.

Representatives from the IIB and WIPO took part in
the meeting as observers. The representatives of the
Commission of the European Communities and the Council of
Europe sent their apologies for being unable to attend.
See Annex I to these minutes for the list of those present
at the 9th meeting.

2. Working Party I adopted the provisional agenda as
contained in BR/GT I/120/71 and attached to this document
as Annex II.

3. The Drafting Committee of Working Party I met first
under the chairmanship of Mr. van BENTHEM, President of the
Octrooiraad, and after his departure, that of Mr. LABRY,
Embassy Counsellor at the Ministry of Foreign Affairs
(France).

BR/135 e/71 prk
(Unrevised translation)
Reference to the classification of the application in the report on the state of the art

The report on the state of the art shall contain the classification of the subject-matter of the European patent application in accordance with the international classification.
FIRST PRELIMINARY DRAFT

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

FIRST PRELIMINARY DRAFT
OF THE IMPLEMENTING REGULATIONS

FIRST PRELIMINARY DRAFT
OF THE RULES RELATING TO FEES

- Stage reached on 22 October 1971 -
attempt to avoid the payment of fees. Other delegations
did not share this opinion and considered that a precise
text would have the advantage of creating a clear situation
for the applicant and avoiding long discussions between the
latter and the European Patent Office as regards the unity
of invention.

Re. Article 70, No. 2 (Claims in the same category)

174. The Conference decided to amend this provision by
bringing it more into line with Rule 13.3 of the Regu-
lations under the PCT in order to place a certain limitation
on the use of independent claims in the same category. Such
a use would only be allowed when it was impossible to cover
the subject of the application by a single claim.

Re. Article 79, No. 1 (Report on the state of the art)

175. The Austrian delegation asked for clarifications on
the present documentation facilities of the IIB and on
the intentions of that institution as regards the extension
of its facilities in the future.

As information on this subject appears in the report
that the IIB has undertaken to communicate to the Conference
(see point 42), the examination of this question has been
postponed.

FR/125 e/71 ght/KM/prk .../...
MINUTES

of the
4th 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)
of the translation, of the Convention is applied, in the language

(5) The report on the state of the art shall be drawn up in the language of the European

ARTICLE 79, No. 1 continued
Report on the state of the art

No. 1

Re. Article 79
Implementing Regulation will be examined in due course.

1. The final allocation of certain propositions, either to the Convention Treaty or to the Procedures of the Court of Justice of the European Communities (BPJC), a note indicating the relevant article of the Convention Treaty of which they are to be adopted at a later date. For each proposition of the First Preliminary Draft based on provisions of the Rules of Procedure of the Court of Justice of the European Communities numbered by reference to the corresponding articles of the Convention Treaty, these propositions have been numbered consecutively with no date.*

2. To make reference of the Implementing Regulation to the First Preliminary Draft Implementing Regulation which are to be submitted to the 6th Meeting of the Inter-Governmental Conference (20 to 29 April 1974). This document contains all the provisions of the First Preliminary Draft Implementing Regulation.

Introductory Remarks
STAGE REACHED ON 29TH JANUARY 1971

TO THE CONVENTION ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

FIRST PRELIMINARY DRAFT IMPLEMENTING REGULATIONS

SECRETARIAT

BRUSSELS, 16TH FEBRUARY 1971

BR/90/77

INTER-GOVERNMENTAL CONFERENCE
AMENDMENTS TO THE MINUTES

of the meeting held from 23 to 27 November 1970

ANNEX III
to BR/84/71

Point 10: delete the last seven lines from "The fiction of the European patent" ...

Point 19: delete the text

Point 20: second-last line, for "see point 50" read "see point 51"

Point 36, 2nd sentence: delete the words "and were known to the International Patent Institute at the date of drawing up the report on the state of the art"

Point 37, 3rd sentence: delete the words "in making Article 122, paragraph 2, of the First Preliminary Draft Convention null and void", and substitute "in making Article 122 of the Convention practically meaningless"

Point 39, last line: for "see also point 43" read "see also point 53"

Point 50: Insert the text under point 52 after deleting the words "No comments"

Point 55, second-last line: for "original application" read "original claims".

BR/84 e/71 (Annex III) nan/EM/prk
The Sub-Committee agreed to examine this question at a later meeting.

Re. Article 79, No. 3 - Restriction of the search report to a part of the application for a European patent

22. At the request of the Sub-Committee, the International Patent Institute submitted a proposed text on the determination of the part of the application on which a search report must be made, where an additional report is necessary but the applicant does not respond to the invitation addressed to him pursuant to Article 79, paragraph 5 of the Convention, either to pay an additional fee or to limit the application.

After examining it, the Sub-Committee adopted the text proposed which, in such a case, allows the International Patent Institute to draw up the report on the part of the application relating to the invention or plurality of inventions forming a single general inventive concept and occurring first in the claims.

23. During the discussion, it was made clear that the provision in question applies both when the lack of unity of the application is discovered before a search is made and when this lack of unity is discovered as a result of the search. It was, moreover, decided to add a note to this effect to the text of the provision and also to draw the attention of Working Party I to the possible difficulties of interpretation in Article 79, paragraphs 5 and 6, of the Convention. It was particularly stressed that the words "by reason of lack of unity of the invention" appearing in paragraph 5, ought to be deleted. In fact, at the stage of the proceedings concerned in the text under discussion,
he has already requested a report on the state of the art from the International Patent Institute, in order to obtain, in that event, a reduction in the fee.

The Sub-Committee considered that this question should be re-examined later when it had been able to acquaint itself with the text of the provision of the Rules relating to Fees which deals with this problem. The representative of the International Patent Institute added that there was already a system of computer control operating in his Institute which made it possible to determine whether a specified search had already been carried out or not.

Re. Article 66, No. 3 - Form and contents of claims

20. The Sub-Committee adopted for paragraph 4 a text proposed by the Swiss delegation which, while including the content of Rule 6.4 of the Regulations under the PCT, has the advantage of being more clearly worded. However, the United Kingdom delegation reserved the right to study this new wording to determine whether it did not seriously differ from the PCT text in question.

Re. Article 79, No. 1 - Report on the state of the art

21. The United Kingdom delegation said that in its opinion, paragraph 4 should be revised. The report on the state of the art ought to mention as such any document published after the date of priority claimed. There should not, however, be a requirement that any document referring to an earlier disclosure should also have been published prior to the date of filing of the European patent application, since pursuant to Article 11, paragraph 3, of the Convention, this document may have been published after the filing of the European patent application.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

Brussels, 1st April 1971
BE/84/71

MINUTES

of the 5th meeting of the "Implementing Regulations" Sub-Committee
of Working Party I

(Luxembourg, 12 - 14 January 1971)

I

1. The fifth meeting of the "Implementing Regulations"
   Sub-Committee was held in Luxembourg from 12 to 14 January
   1971, with Mr FRESSONNET, Deputy Director, French Industrial
   Property Institute, in the Chair.

   In addition to the national delegations represented
   in the Sub-Committee, the meeting was attended by repre-
   sentatives of WIPO/OMPI and the International Patent
   Institute.(1)

2. The Drafting Committee met each day, under the Chair-
   manship of Mr NEERVOORT, Secretary of the Octrooiraad,
   following the Sub-Committee's meetings.

(1) See the list of participants in Annex I.

BR/84 e/71 nan/KM/prk
A supplementary report from the International Patent Institute.

37. During the discussion, the question whether or not the report on the state of the art should contain a concise analysis of the documents cited was also raised. The German, United Kingdom and Swedish delegations expressed reservations on this point and were opposed to such an analysis which was not provided for by the PCT and which would result in discrimination between international search reports within the European system for the grant of patents depending on whether or not such reports were drawn up by the International Patent Institute. In this respect the German delegation stated that such a provision would result in making Article 122, paragraph 2, of the First Preliminary Draft Convention null and void. The other three delegations felt that the problem should be discussed with the interested circles, which might, within the European patent context, view the problem from a different angle. Finally, the Chairman decided to put the text in question between square brackets so that the interested circles could express their views on this problem.

Re. Article 79, No. 2 - Time limit for the report on the state of the art.

38. The Sub-Committee adopted a three-month time limit. It refrained from making provision for an option to extend this period, so as to remain in conformity with Rule 42.1 of the Regulations under the PCT. The passage relating to the abstract was kept between square brackets in order to show that questions relating to the abstract must
35. The Sub-Committee drew up the text of this Article following an examination of this question on the basis of the proposal submitted by the International Patent Institute (working document of 12 October 1970). It was pointed out, first of all, that the sole purpose of this provision is to lay down the general principles for drawing up the report on the state of the art. The details will be governed by a working agreement to be made between the International Patent Institute and the Administrative Council of the European Patent Office.

36. The discussion then centred on the question whether the report on the state of the art should mention the documents relating to earlier rights referred to in Article 11, paragraph 3, of the First Preliminary Draft Convention. The Sub-Committee agreed that only such documents as had already been published and were known to the International Patent Institute at the date of drawing up the report on the state of the art should be taken into account in this report. This decision was based on three considerations. First of all, it is not desirable to impose on the International Patent Institute obligations which it would be unable to fulfil. Secondly, the drawing up of the report on the state of the art should not be delayed as this should, if possible, be published at the same time as the application. Thirdly, all known earlier rights should be drawn to the attention of the applicant in order to enable him to decide in full knowledge of all the facts whether or not to maintain his application.

On the other hand, earlier rights not published at the time of drawing up the report are to be sought by the European Patent Office itself during examination proceedings unless it considers it necessary to request...
MINUTES

of the 4th meeting of Working Party I Sub-Committee
on "Implementing Regulations"
(Luxembourg, 23-27 November 1970)

I.

1. The fourth meeting of the Sub-Committee instructed by
Working Party I to draw up draft Implementing Regulations to
the Convention was held at Luxembourg, from Monday 23 to
Friday 27 November 1970, with Mr. FRESSONNET, Deputy Director,
French Industrial Property Institute, in the Chair.

In addition to the national delegations represented in
the Sub-Committee, the meeting was attended by WIPO and the
International Patent Institute (1).

(1) See the list of participants in Annex I.
The sub-committee feel that the attention of the interested parties should in any case be drawn to this provision.

Pre-emptory Draft Condition.

The report on the state of the art, which it is to replace under Article 122(2) of the First Patents Convention, would not contain addenda such as those envisaged here and would therefore differ from square brackets, particularly in view of the fact that a search report provided under the Convention has already been published. The sub-committee strongly doubted the advisability of introducing the provision between paragraphs 3.1 and 3.2.

Note to paragraph 3.1 of the translation:

Paragraph 3.1, where Article 274 of the Convention is applied, in the language of the patent application or, where Application 274, paragraph 2, of the Convention is applied, in the language of the report on the state of the art shall be drawn up in the language of the European Patent Convention.
Any document, which refers to an oral disclosure, a use of any other means of disclosure, a report on the state of the art, or a patent or an application, shall be disclosed as such in the report on the state of the art.

Any cited document, which was published before the filing date of the European patent application but after the date of priority claimed, shall be disclosed in the same manner as any other cited document.

Each citation shall be accompanied by a concise analysis of the relevant part of the cited document to which it relates.

Text drawn up by the sub-committee

Report on the state of the art

No. 1

Re: Article 79
of the first preliminary draft convention

Re: Articles 16, 17, 21, 24, 66, 69, 79, 159, 161, 162, 170, 171, 172, 173, 176, 180, 186

PRELIMINARY DRAFT IMPLEMENTING REGULATIONS

(23 to 27 November 1970)

of Working Party I

Outcome of the work of the 'Implementation Regulations' sub-committee

- Secretary -

BR/67/70

Progresses, 15 December 1970

SECRETARIAT

SYSTEM FOR THE GRANT OF PATENTS
FOR THE SETTING UP OF A EUROPEAN
INTER-GOVERNMENTAL CONFERENCE
5. Filing and requirements of the European patent application (Articles 73-84 and Rules 24-37)

During its discussion of Article 73, the Main Committee was faced with the question of which office of the European Patent Office the European patent application should be filed at. In the interests of the applicant, it gave him the choice of Munich or The Hague and amended Article 73, paragraph 1(a) and Article 74, paragraph 1, accordingly.

In connection with the requirements of the application under Article 76, the Main Committee examined the need to file the abstract. It considered that if this were not done, there would be a loss of information and therefore maintained this requirement. It also decided to prescribe the compulsory publication of the abstract with the search report under Article 92.

Closely connected with the substantive requirement of disclosing the invention under Article 81 was the problem of making special provisions for European patent applications covering micro-organisms. It was not contested that the relevant provision, Rule 28, should lay down that micro-organisms which are not available to the public should be deposited with a recognised culture collection no later than at the time of filing the application, that the micro-organism should be adequately described in the application, and that the culture collection should be identified either in the application itself or within a short time thereafter. It was also agreed that the disclosure of the micro-organism should be subject to certain measures to protect the applicant. Views differed, however, on the latest time at which the micro-organism should be made available to the public. Contrary to the draft of Rule 28, which provided for this to be not later than the date of publication of the application, it was proposed that the applicant should not be obliged to make the micro-organism available to the public until the time of the grant of the patent, at which point the provisional protection would be lost. The main arguments put forward in defence of this standpoint were that the approach contained in the draft laid an unfair burden on such applicants in comparison to inventors in other fields of technology by requiring the subject-matter of the invention to be deposited, and that the applicant was forced to reveal know-how, thus making it easier for his invention to be copied at a time when it was not yet definite whether or not the application would lead to the grant of a patent.

Those who advocated the approach set out in the draft argued that the public could be considered to be sufficiently informed about the subject-matter of the invention only if the micro-organism were made available to the public at the time of the publication of the application; furthermore, it was only by such a disclosure that the micro-organism could be comprised in the state of the art under Article 52, paragraph 3, with the result that this was the only means whereby duplication of patents could be avoided and legal uncertainty in relation to national patent applications could be removed.

After detailed consideration of the various arguments for and against the two approaches, the Main Committee decided by a majority to retain the solution proposed in the draft and to lay down that the micro-organism should be made available to the public at the latest at the date of publication of the European patent application. At the same time, it added provisions to Rule 28 which gave the applicant far-reaching guarantees against misuse of the disclosed micro-organism during the existence of the provisional protection conferred by the application and the definitive protection of the European patent. These guarantees consisted in requiring that any third party who had access to a sample of the culture would have to make certain undertakings vis-à-vis the culture collection or the applicant for or proprietor of the patent in respect of the ways in which he used the culture. On the other hand, the Main Committee decided, in the same way as in respect of Article 67, not to adopt a procedural rule which would have obliged a third party who used a micro-organism disclosed by the applicant to prove that the culture concerned was not that described in the application, even though the reversal of the burden of proof would have reinforced the legal position of the applicant even further. It was also made clear in Rule 28 that the built-in safety clauses in favour of the applicant did not prejudice any national provisions concerning compulsory licences or uses in the interest of the State. The details governing the deposit, storage and availability of cultures were left to agreements to be concluded between the President of the European Patent Office and the recognised culture collections.

6. Questions of priority (Articles 85-87/Rule 38)

Apart from the amendment to Article 85, paragraph 5, already dealt with above in the chapter on "language questions", the provisions of Articles 85-87 concerning priority led to few amendments. It may be mentioned that the extension of the priority right to States which are not members of the Paris Convention, in accordance with an amendment decided upon by the Committee in the interests of the Contracting States, will apply only if international reciprocity is granted not only in relation to European but also in relation to national applications by Contracting States.

7. Procedure up to grant (Articles 88-97/Rules 39-55)

In so far as individual provisions of Articles 88-97 and the corresponding Rules 39-55 concerning the procedure up to grant have already been discussed in connection with language questions, identification of the inventor and the abstract, reference should be made to the appropriate Chapters 1, 3 and 5.

During the discussion of Articles 93/94 the Committee confirmed the specified period within which requests for examination may be filed and also the possibilities for extending the time limits, both of which are the result of well thought out compromises. The Committee refused in particular to lay down in Article 94 an absolute right for third parties to request examination in the event of the Administrative Council extending a time limit. The need for such a right for third parties depends largely on the length of time by which the period is extended.

8. Opposition procedure (Articles 98-104/Rules 56-64)

The provisions concerning opposition procedure gave rise to very little discussion. A proposal to delete the opposition fee in Article 98, paragraph 1, on the ground that the opponent was to be considered as a person helping to establish the legal facts of the matter, was rejected by the majority. If the fee were to be dispensed with, dilatory opposition would be encouraged. Furthermore, the interests of the opponent are his main incentive and lastly, pursuant to Article 114, any person who wishes to help to establish the legal facts of the matter may present, free of charge, observations concerning the patentability of an invention in respect of which an application has been filed. By a vast majority the Committee also refused to shorten to six months the nine-month opposition period laid down in Article 98, paragraph 1, which had been adopted as a compromise solution at an earlier stage in the negotiations.

In Article 98 and in Rule 61 the Committee added new provisions which also make possible the filing of notice of opposition and consequently the continuation of opposition proceedings when the proprietor has completely surrendered the European patent or when it has lapsed for all the