Rule 50 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.

Rule50eTPEPC1973
Regel 50

MPÜ

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\[167,185\]
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
chemical, food and pharmaceutical products. He pointed out, however, that if its proposal were rejected, the Greek delegation would remain free to submit another proposal, narrower in scope and entailing deletion of use in relation to food and pharmaceutical products only.

The Greek proposal was rejected by 9 votes against, 8 in favour and 1 abstention.

65. The Greek delegation announced a new proposal along the lines mentioned by the Chairman, although it went further than suggested by some delegations, because it did not mention food and pharmaceutical products in the second half of the sentence.

66. The French delegation stated that it would have to reject this proposal because processes of manufacture of food and pharmaceutical products must at all events be protected.

67. At a subsequent meeting the Greek delegation submitted the following compromise proposal for the second half of paragraph 2 (a) of Article 167 (M/154 G):

"... this reservation shall not affect protection conferred by the patent in so far as it involves a process of manufacture or use of chemical products or a process of manufacture of pharmaceutical or food products."

68. This proposal was adopted by the Committee of the Whole, which instructed the General Drafting Committee to include it in the existing text of the Article.

B. Implementing Regulations

Rule 28 (R/9) — Requirements of European patent applications relating to micro-organisms

69. The Committee of the Whole adopted the revised version of this Rule drawn up by the General Drafting Committee on the basis of the conclusions reached by Main Committee I.

Rule 50 (R/9) — Information about publication

70. The Committee of the Whole adopted the version of this Rule as submitted by the Drafting Committee, paragraph 2 of which was based on the proposal put forward by the Austrian delegation in Main Committee I (M/PR/I, point 2272).

Rule 65 (R/10 and M/151 R/16) — Rejection of the appeal as inadmissible

71. The Chairman of the General Drafting Committee stated that, further to a proposal by the Norwegian delegation that the procedure for remediating deficiencies in the case of appeals should be the same as that applicable in the case of opposition, Main Committee I had instructed the Drafting Committee to examine the possibility of more closely aligning Rules 65 and 56 (M/PR/I, point 2299). Bearing in mind the fact that in Article 108 Main Committee I had divided the time limit for appeal into the period within which notice of appeal must be filed (two months) and that within which a written statement setting out the grounds of appeal must be filed (four months) (M/PR/I, point 462), the General Drafting Committee proposed the following wording, which it did not however consider to be absolutely essential:

"... rejected as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 108 has expired."

72. The Norwegian delegation still found this solution somewhat harsh compared with the possibilities laid down in Rule 56. It suggested that a paragraph corresponding to paragraph 2 of Rule 56 be included in Rule 65.

73. The Austrian delegation shared this view.

74. The Netherlands delegation feared that because of the shorter time limits applicable to appeals, there would not be sufficient time for arrangements along the lines of the proposed paragraph 2.

75. The Norwegian delegation considered that even in the case of appeals there would be sufficient time for remedying those minor deficiencies with which paragraph 2 was concerned.

At a subsequent meeting the Committee of the Whole first of all approved the abovementioned proposal by the General Drafting Committee for supplementing paragraph 1 of Rule 65, subject to the proviso that this provision only related to deficiencies resulting from failure to comply with the requirements of Rule 64 (b). Notwithstanding the objections of the German delegation, which considered that there should be stricter rules for appeals proceedings, it also adopted a proposal which had been submitted in the meantime by the Norwegian delegation (M/155/G) for the inclusion of a new paragraph 2 corresponding to paragraph 2 of Rule 56.

Rule 84 (R/11) — Duration of time limits

76. The Committee of the Whole approved the deletion of paragraph 2 made by the General Drafting Committee on the basis of the conclusions of Main Committee I (M/PR/I, point 2994).

Rule 93 (R/11) — Parts of the file not for inspection

77. In accordance with the discussions in Main Committee I (M/PR/I, point 2409) the General Drafting Committee specifically provided in sub-paragraph (c) that the designation of the inventor should not be disclosed where he had renounced his title as inventor.

The Committee of the Whole adopted this solution.

Rule 99 (R/11) — Procedure for letters rogatory

78. Further to a proposal by the Italian delegation (M/PR/I, point 2427) referred to it by Main Committee I, the General Drafting Committee submitted an amended version of paragraph 4 of this Rule.

This version was adopted by the Committee of the Whole.

Rule 106 (R/11) — Amendment of the list of professional representatives during a transitional period

79. The Chairman of the General Drafting Committee referred to the lengthy discussions which had been held on this Rule in Main Committee I. Although, after clarifying the interpretation to be given to this Rule, Main Committee I had concluded that the text need not be amended (M/PR/I, point 2519), the Drafting Committee had decided to refer to "other" requirements in paragraph 1 (b) instead of "further" requirements, in order to make the interpretation agreed by Main Committee I quite clear.

80. The Chairman of the Committee of the Whole confirmed that the other requirements referred to in paragraph 1 (b) were requirements other than those mentioned in paragraph 1 (a).

81. The Committee of the Whole approved the amendment submitted by the General Drafting Committee.

C. Protocol on Recognition (M/146 R/12)

82. Further to a proposal made by the IAPIP delegation in Main Committee I and the Committee's decision in this
2252. The FICPI delegation emphasised that if the reference to a drawing was deemed to be deleted, this ought to apply only to the reference signs, but not to a more extensive description of the drawing which, even if the drawing as such were missing, could still be understandable to some extent at least. This Rule should in no event be so interpreted as to mean that something which was actually disclosed in the application should be deemed to be deleted.

2253. In conclusion, the Chairman pointed out that in publishing the application, the European Patent Office should delete nothing from the application, but merely indicate that the references to the drawings which were not available were deemed to be deleted. If the application were to contain references which were understandable on their own without the drawing, he felt that these should also continue to be the subject of the application.

Rule 46 — European search report where the invention lacks unity

2254. The Netherlands delegation proposed making it clear in the first half of paragraph 1, first sentence, that if the invention were to belong to a group of inventions within the meaning of Article 80 (82), the search report would be drawn up on those parts of the application which relate to the group of inventions first mentioned in the claims (M/52/I/II/III, point 21).

2255. The Main Committee adopted this proposal.

2256. The Netherlands delegation proposed fixing the period for payment of the search fee at no less than two months and no more than three months in the second half of paragraph 1, first sentence (M/52/I/II/III, point 21).

2257. None of the national delegations supported this proposal.

Rule 48 — Time limit for forwarding the European search report to the European Patent Office

2258. The Main Committee adopted a proposal by the Netherlands delegation, which was supported by several other delegations (M/52/I/II/III, point 22).

Rule 50 (49) — Form of the publication of European patent applications and European search reports

2259. The delegation of the Federal Republic of Germany proposed taking into account in paragraph 1 the fact that the abstract must be published (M/47/I/II/III, point 28), as was decided with regard to Article 92 (93) (see point 332).

2260. The Main Committee adopted this proposal.

Rule 51 (50) — Information about publication

2261. The Netherlands delegation proposed wording paragraph 1 to the effect that the European Patent Office would not communicate to the applicant the date on which the period for filing the request for examination expires, but would draw his attention to the fact that this period expires six months after the date on which the publication of the search report is mentioned in the European Patent Bulletin and that after expiry of this period, the application is deemed to be withdrawn (M/52/I/II/III, point 23).

2262. The French, Austrian and Swiss delegations supported this proposal.

2263. The United Kingdom delegation expressed a reservation on this solution if the date on which the period began, i.e. the date on which publication of the search report was mentioned, were not to be communicated to the applicant.

2264. The Chairman considered that according to the present wording of paragraph 1, in the German version at least, the European Patent Office had to notify the applicant of the date on which the publication of the search report was mentioned in the European Patent Bulletin. The purpose of the Netherlands proposal was merely to make this clear. The advantage of this solution would be that the European Patent Office itself would not need to calculate the end of the period.

2265. The Main Committee adopted the Netherlands proposal with the proviso that the date of the beginning of the period would have to be communicated to the applicant.

2266. At a later sitting, the Main Committee examined paragraph 2 after the Drafting Committee had amended paragraph 1 in accordance with the Netherlands proposal (point 2261), but had left paragraph 2 unchanged.

2267. The Austrian delegation emphasised that with the solution adopted by the Main Committee for paragraph 1, whereby the applicant would not be notified of the end of the period for filing the request for examination, it would be even more unsatisfactory than before to allow the applicant to run the risk of an incorrect communication. It thus proposed that paragraph 2 be so worded that an error on the part of the European Patent Office would not set the applicant at a disadvantage, unless the error were immediately obvious to him (M/145/1).

2268. The United Kingdom delegation supported the Austrian proposal with a proviso as to its wording.

2269. The Netherlands delegation asked when, in the Austrian delegation's view, an error on the part of the European Patent Office would be immediately obvious to the applicant. It felt that this should always be the case, since the applicant could consult the European Patent Bulletin to see when the publication of the search report was mentioned.

2270. In the Austrian delegation's view, an immediately obvious error would arise only if it were to be apparent as such from the communication by the European Patent Office. The applicant should not be expected to consult the European Patent Bulletin.

2271. The Chairman drew attention to the fact that the Austrian proposal could, in certain cases, lead to an extension of the period for filing requests for examination.

2272. The Main Committee adopted the proposal, which was also supported by the Swiss delegation, with a proviso as to the revision of its wording.

Rule 58 (57) — Preparation of the examination of the opposition

2273. The Committee examined the Netherlands delegation's proposal (M/52, page 24) that the last sentence of paragraph 1 be deleted.

2274. The Netherlands delegation considered that this sentence introduced an unjustified restriction on the rights of the proprietor of a patent. In view of paragraph 4 of Rule 58, which provided that in the case of a notice of intervention in opposition proceedings the Opposition Division need not communicate the intervention to the proprietor of the patent, it did not seem appropriate to limit the amendments which the proprietor could make to what was necessary to meet the opposition.

2275. The Austrian delegation supported the Netherlands delegation's proposal.

2276. The delegation of the Federal Republic of Germany said that it could support this proposal provided that the delegations of the interested parties professed interest along these lines.
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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
(1) The European Patent Office shall communicate to the applicant the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention in this communication to the provisions of Article 94, paragraphs 2 and 3, the text of which shall be attached.

(2) The applicant may not invoke the omission of the communication provided for in paragraph 1. If a later date than the date of the mention of the publication is specified in the communication, the later date shall be the decisive date as regards the time limit for filing the request for examination unless the error is apparent.
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
Rule 51

Information about publication

(1) The European Patent Office shall communicate to the applicant the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention in this communication to the provisions of Article 93, paragraphs 2 and 3, the text of which shall be attached.

(2) Unchanged from 1972 published text.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 27 September 1973
M/ 142/I/R 13
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 27 SEPTEMBER 1973

Articles of the Convention:

Articles 59
162

Rules of the Implementing Regulations:

Rules 51
69
70
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85
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100
103
107

Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent
(Protocol on Recognition):

Articles 3
6

Recommendation on preparations for the opening of the European Patent Office

Decision on Training Staff for the European Patent Office
Rule 51

Information about publication

(1) The European Patent Office shall communicate to the applicant the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention in this communication to the provisions of Article 93, paragraphs 2 and 3.

(2) Unchanged from 1972 published text.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 24 September 1973
M/ 126/I/R 9
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 22 SEPTEMBER 1973

Articles of the Convention:

Article 14
Article 133
Article 134

Rules of the Implementing Regulations:

Rule 26
Rule 51
Rule 56
Rule 69
Rule 76
Rule 79
Rule 93
Rule 95

Draft Protocol on the Recognition of Decisions in respect of the Right to the Grant of a European Patent:

Article 2
Rule 51 Paragraph 2

The proposal made under No. 34 of the Comment M/21 UNEPA is withdrawn in view of Article 120.

Rule 69 Paragraph 2

The proposal made under No. 35 of the Comment M/21 UNEPA is withdrawn in view of Article 120.

NOTES

1. The greater part of the above proposals is essentially in line with proposals made in Comments delivered by others. However, the above proposals do contain further desirable amendments.

   The UNEPA agrees, without further proposal for amendment, with a great number of proposals contained in Comments delivered by others. These are particularly the following proposals:

   Article 67
   Article 86 Paragraph 1
   Article 105 Paragraph 1
   Article 141
   Article 157 Paragraph 2
   Article 162
   Rule 107
   Rule 108

   M/18 No. 7, 8
   M/32 No. 16
   M/14 No. 6
   M/14 No. 10
   M/14 No. 13
   M/19 No. 23
   M/32 No. 23
   M/11 No. 7
   M/15 No. 15
   M/15 No. 21.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 11 September 1973
M/62/I/II
Original: German/English/French

CONFERENCE DOCUMENT

Drawn up by: Union of European Patent Agents (UNEPA)
Subject: Additional comments

Rule 51 should be amended to read:

"(1) The European Patent Office shall inform the applicant of the publication of the European patent application or, if the European search report is published at a later date, of the publication of the latter, and shall at the same time draw his attention to the prescriptions laid down in Article 93, paragraphs 2 and 3.
(2) The applicant may not invoke the omission of the communication provided for in paragraph 1."

See also the Netherlands proposal to Rule 69, paragraph 2.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 10 September 1973

M/52/I/II/III
Original: English

CONFERENCE DOCUMENT

Drawn up by: Netherlands delegation

Subject: Proposals for amendments to the draft texts
B. Implementing Regulations

46. Rule 51

"The European Patent Office shall inform the applicant of the date of the publication of the European patent application or, if the European search report is published at a later date, of the date of the publication ......."

47. Rule 91

"(1) ... (c) in the event of the death of the professional representative of the applicant for or proprietor of the patent or of his inability to conduct his business."

48. Rule 96

On the basis of the proposal by CEEP in M/30, No. 32:

"... Subject to the restrictions provided for in Article 19, paragraphs 1 to 4 and in Rule 94, ..."

C. Protocol on the Centralisation of the European Patent System and on its Introduction

49. Section I

"3. A sub-office ... shall be set up in (West) Berlin at the time ..."
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 10 September 1973
M/47/I/II/III
Original: German

CONFERENCE DOCUMENT

Drawn up by: The delegation of the Federal Republic of Germany

Subject: Proposals for amendments to the draft texts
the same time (in paragraph 2) any responsibility for errors made in that information. The applicant could easily be led astray by an error in the indication of that date. We suggest to amend the last two lines of this paragraph 1 in such a way that the European Patent Office shall draw applicant's attention to the contents of Article 93, par. 2 and 3. When this is done in a general way errors can not be made.

36. Rule 58, par. 1:

In our opinion the last sentence of this paragraph is an unnecessary restriction on the proprietor of the patent. Moreover this stipulation would oblige the Opposition Division to check whether an amendment proposed by the proprietor goes farther than is necessary to meet the opposition. With other words, if the proprietor proposes a restriction the Opposition Division would have to judge whether a less far going restriction would not already meet the opposition.

We propose to cancel the last sentence of this paragraph 1.

Unnecessary to say that Article 122, par. 5, remains applicable.

37. Rule 69, par. 2:

Referring to our observations concerning rule 51, par. 1, we propose to delete the second sentence of this paragraph.

38. Rule 70, par. 2:

According to the last sentence of this paragraph a decision shall only be given if it is a negative one. It may be that in case the European Patent Office agrees with the petitioner it is not necessary to take a formal decision, however for the petitioner it would be very useful to be informed as soon as possible about the positive result of his request.
31. **Rule 38, par. 4:**

In conformity with our observation nr. 15 on Article 86, par. 1, we propose to replace the expression "the language of the proceedings" in the second line of this paragraph 4 by the following: "one of the official languages of the European Patent Office".

32. **Rule 46, par. 1:**

If there is no unity of invention the European search report shall, as stated in the lines 4-6 of this paragraph, be restricted to those parts which relate to the invention first mentioned in the claims. It may be however, that this invention belongs to a group of inventions so linked as to form a single general inventive concept (see Article 80). In such a case the search report should not be restricted to the first mentioned invention but to the first mentioned group of inventions.

33. **Rule 46, par. 1:**

The minimum (i.e. two weeks) of the period for payment of the additional search fee seems very short and in conflict with the gist of Rule 85.

34. **Rule 48:**

If the European patent application is filed without invoking a priority right, the time limit of three months, mentioned in this Rule, may be too short for the International Patent Institute to draw up the search report because I.I.B.'s search files may not yet be up to date. We propose to follow here Rule 42 of PCT and to add to the last line of Rule 48 the following words: "or, when no priority has been claimed, nine months from the date of filing, which ever time limit expires later".

35. **Rule 51, par. 1:**

In our opinion it is not advisable to oblige the European Patent Office to inform the applicant of the exact date of expiry of the period for making a request for examination and to deny at - the same time -
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Brussels, 1 June 1973

M/32

Original: English

PREPARATORY DOCUMENT

Drawn up by: Netherlands Government

Subject: Observations and proposed amendments concerning the Draft Convention and the Draft Implementing Regulations
Regel 48

33 Vorschlag:
Die Regel sollte gestrichen werden, wenn dem Abschnitt 1 des Protokolls über die Zentralisierung des europäischen Patentsystems und seine Einführung zugestimmt wird.

Begründung:
Die Regel ist dann überflüssig.

Regel 51, Absatz (2)

34 Vorschlag:
Die Worte „und aus in ihr enthaltenen Fehlern“ sollten gestrichen werden.

Regel 69, Absatz (2)

35 Vorschlag:
Die Worte „oder aus in ihr enthaltenen Fehlern“ sollten gestrichen werden.

Begründung zu Regel 51(2) und 69(2):
Es kann dem Empfänger einer solchen Mitteilung des Europäischen Patentamtes nicht zugemutet werden, daß er den vom Europäischen Patentamt begangenen Irrtum erkennt, beispielsweise erkennt, daß eine in der Mitteilung angegebene Frist oder Höhe einer Gebühr im Widerspruch zu einer vorrangigen Bestimmung steht.

Die Folge der vorgeschlagenen Änderung beschränkt sich darauf, daß das Europäische Patentamt, insbesondere innerhalb der irrlich angegebenen Frist, begangene Handlungen als fristgerecht anerkennt bzw. zur Zahlung eines ergänzenden Teiles der Gebühr eine Frist stellt.

Regel 70, Absatz (2), Satz 2

36 Vorschlag:
Der Text sollte lauten „Eine solche Entscheidung ist innerhalb von 2 Monaten nach Eingang des Antrages beim Europäischen Patentamt zu treffen“.

Begründung:
Bei der Bedeutung der Entscheidung hat der Betroffene Anspruch auf eine Mitteilung des Europäischen Patentamtes.

Rule 48

33 Proposal:
The Rule should be deleted if Section 1 of the Protocol on the Centralisation of the European Patent System and on its Introduction is accepted.

Grounds:
The Rule is then superfluous.

Rule 51, paragraph 2

34 Proposal:
In line 1, after the word “may” insert “not” and delete the word “neither”; in lines 2 and 3 delete the words: “nor any errors contained therein”.

Rule 69, paragraph 2

35 Proposal:
In line 8, after the word “may” insert “not” and delete the word “neither”; in line 9 delete the words: “nor any error contained therein”.

Grounds Re. Rules 51(2) and 69(2):
It cannot be expected that the recipient of such a notice from the European Patent Office will recognise the error committed by the European Patent Office; for example, recognise that a term or tariff quoted in the report is contrary to a prior decision. The result of the proposed amendment is restricted to the European Patent Office accepting transactions begun within the term given in error as being within the prescribed term and setting a term for payment of a supplementary part of the fee.

Rule 70, paragraph 2, 2nd sentence

36 Proposal:
The text should read “Such decision shall be given within two months from the date of application for the decision at the European Patent Office.”

Grounds:
Due to the importance of a decision, the person concerned has a claim to a report from the European Patent Office.
STELLUNGNAHME DER
UNEPA
Union Europäischer Patentanwälte

COMMENTS BY
UNEPA
Union of European Patent Agents

PRISE DE POSITION DE
L'UNEPA
Union des Conseils en brevets européens

(1) English translation submitted by UNEPA
(2) La traduction française a été fournie par l'UNEPA
Artikel 86 Absatz 3

18 Die Verwendung des Ausdrucks „Merkmale“ im deutschen Text ist unverständlich. Wenn die beanspruchte europäische Erfindung eine Kombination von A und B ist, dürfte es unangebracht sein, eine Priorität einzuräumen, wenn durch die frühere Anmeldung lediglich A oder B und nicht die Kombination offenbart wurde.

Artikel 87

19 Es wäre zu erwägen, ob es zweckmäßig ist, diesen Artikel auf Artikel 53 Absatz 1, Artikel 74 Absatz 2 und die Regel 28 anzuwenden.

Artikel 92 – Regel 51 Absatz 2

20 Anmelder haben viele Bedingungen zu erfüllen, und es ist daher offensichtlich unbillig, daß sie auf der anderen Seite durch Fehler des Europäischen Patentamts in Mitleidenschaft gezogen werden sollten. Es wird daher darum gebeten, diesen Absatz in der Regel 51 zu streichen.

Artikel 107

21 Da es schwierig ist, alle Gründe für eine Beschwerde zum gleichen Zeitpunkt anzugeben, an dem der Beschluß, sie zu erheben, geäst wird, wird darum gebeten, daß zu dem Grundsatz des früheren Artikels 111 (2. Vorentwurf) zurückgekehrt wird, d.h., daß gesonderte Fristen für die Beschwerdeerhebung und für die Einreichung eines Schriftsatzes mit der Begründung vorgesehen werden. Es wird empfohlen, beide Fristen zum gleichen Zeitpunkt beginnen zu lassen. Die Frist für die Beschwerdeerhebung könnte dann verkürzt und die Frist für die Einreichung des Schriftsatzes mit der Begründung verlängert werden.

Artikel 115 – Regel 69 Absatz 2

22 Es dürfte gegenüber dem Anmelder ungerecht sein, daß er aus einem Irrtum des Europäischen Patentamts, durch den er unter Umständen in eine Lage gebracht worden ist, in der keine Abhilfe mehr möglich ist, keine Ansprüche auf Bereinigung der Situation herleiten kann. Es wird daher darum gebeten, den letzten Satz zu streichen.

Artikel 118 – Regel 70 Absatz 2

23 Mit dieser Regel, die den Rechtsverlust nach Maßgabe vieler weiterer Artikel betrifft, wird vorgesehen, daß Entscheidungen gegenüber dem Anmelder...
STELLUNGNAHME DES

CNIPA

Committee of National Institutes of Patent Agents

COMMENTS BY

CNIPA

Committee of National Institutes of Patent Agents

PRISE DE POSITION DU

CNIPA

Committee of National Institutes of Patent Agents
Es wird daher vorgeschlagen, den ersten Satz des Art. 93(2) wie folgt abzufassen:


Regel 51 würde dann überflüssig werden und wäre zu streichen.

Da das IIB in das Europäische Patentamt eingegliedert wird, wird angenommen, daß einer Überseung nach Art. 91(3) die Maßnahme einer Zustellung gemäß Art. 118 zukommen würde.

Beitritt des vermeintlichen Patentverletzers

Es wird vorgeschlagen, im französischen Text Art. 104(1), Zeile 3 von oben, die Worte „contre le“ durch „sur la base du“ zu ersetzen, um diese Stelle klarer zu formulieren.

Frist und Form der Beschwerde, Art. 107

Die Gesamtfrist von drei (3) Monaten für die Einreichung einer Beschwerde samt einer Beschwerdebegründung wird oft als zu kurz angesehen werden, insbesondere dann, wenn umfangreiche Dokumente zu übersenden und an überseeische Anmelder zusammen mit Erklärungen und Vorschlägen weiterzuleiten sind. Andererseits haben die übrigen Beteiligten, wie auch die Öffentlichkeit, ein natürliches Interesse daran, so rasch wie möglich zu erfahren, ob die Entscheidung des Patentamts bekämpft wird oder nicht.

Es wird daher vorgeschlagen, die Gesamtfrist in eine erste Frist zum Einreichen einer Formalbeschwerde und eine zweite Frist zur Vorlage der Beschwerdebegründung aufzuspalten. Die erste Frist soll nicht weniger als zwei (2) Monate betragen, und es wird vorgeschlagen, daß dann die zweite Frist auf zwei (2) Monate festgesetzt werden könnte, ohne eine übermäßige Störung oder Verzögerung zu verursachen.

Entscheidung über die Beschwerde

Es wird gerne zur Kenntnis genommen, daß Art. 110(1) nunmehr die Bestimmung enthält, daß „die Beschwerdekammer im Rahmen der Zuständigkeit der Stelle tätig wird, die die angefochtene Entscheidung erlassen hat“. Da im Erteilungs- und Einspruchsverfahren die Entscheidung, die mit der Beschwerde angefochten wird, entweder von der Prüfungsabteilung oder von der Einspruchs-(Anmelde-)Abteilung gefällt worden sein muß, und da beide

Es ist therefore suggested to amend the first sentence of Art. 93(2) so as to read:

“(2) A request for examination may be filed by the applicant up to the end of six (6) months after the date on which the search report has been communicated to him under Art. 91(3). However, the time limit for filing the request shall in no case expire earlier than 24 months after the filing date or earliest priority date.

Rule 51 would then become superfluous and should be cancelled.

It is presumed that since the IIB is to be incorporated in the European Patent Office, transmission under Art. 91(3) would acquire the status of a communication under Art. 118.

Intervention of the Assumed Infringer

For clarity it is proposed in the French text of Art. 104(1), line 3 to replace the words “contre le” by “sur la base du”.

Time Limit and Form of Appeal, Art. 107

The total time limit of three (3) months for filing an appeal setting out the grounds on which it is based will frequently be felt too short, particularly when extensive documents have to be translated and communicated to overseas applicants accompanied by comments and recommendations. On the other hand, any other parties to the case, as well as the general public have a natural interest in knowing as soon as possible whether the decision of the Patent Office is contested or not.

It is therefore suggested to split up the total time limit into a first time limit for filing a Notice of Appeal and a second time limit for setting out the grounds on which the appeal is based. The first time limit should not be less than two (2) months, and it is suggested that the second time limit could then, without causing undue disturbance or delay, be fixed at two (2) months.

Decision in respect of Appeals

It is noted with satisfaction that Art. 110(1) now contains the provision that “the Board of Appeal may exercise any power within the competence of the department which was responsible for the decision appealed”. Since in the granting and opposition procedures the decision appealed must have been taken either by the Examining Division, or by the Opposition Division, and since both have the power of accepting amendments, it seems to
Besser berechtigte Partei

Die Bemerkungen des FICPI-Reports 7203-08 scheinen hier noch passend zu sein und werden mit entsprechend geänderten Artikel- und Regelnummern wiederholt:

Gemäß Art. 59(1) kann eine besser berechtigte Partei nur bis zur Ertüchtigung des Europa-Patentes einschreiten. Nach Regel 13(1) und (2) ist aber ein derartiges Einschreiten auch während der Behandlung eines Einspruchs oder während der Beschwerdefrist möglich, d.h. nachdem das Europa-Patent erteilt wurde. Offensichtlich steht Regel 13 mit Art. 59 im Widerspruch und ist daher gemäß Art. 163(2) null und nichtig.

Es erscheint daher notwendig, Art. 59 dahingehend zu ergänzen, daß die besser berechtigte Person während des schwebenden Einspruchverfahrens oder während der Beschwerdefrist einschreiten kann.

Da in Kraft stehende Fristen am Tag der Aussetzung des Verfahrens an diesem Tag praktisch verbraucht sind, wird vorgeschlagen:

in den letzten zwei Zeilen der Regel 13(4) die Worte „an dem Tag, an dem die Mitteilung nach Absatz 3 zugestellt wird“ zu ersetzen durch „an einem Tag zu laufen, der durch das Patentamt festgesetzt wird“.

Frist für Stellung eines Prüfungsantrages

Es wird gerne zur Kenntnis genommen, daß Regel 51 in Übereinstimmung mit den durch die Berufsorganisationen, siehe z.B. FICPI 7112-02, Absatz 59, vorgebrachten Wünschen entsprechend angepaßt wurde. Immerhin dürfte aber mit Bezug auf Absatz (2) der Regel 51 die Bedeutung der Mitteilung über den Ablauf der Frist für die Stellung des Prüfungsantrages ein wenig bedenklich erscheinen, da die Anmelder und ihre Vertreter von den Komplikationen und der Gefahr eines Irrtums bei Festsetzung der Frist auf Grund einer Veröffentlichung nicht entlastet sind. Unter diesen Umständen könnte überlegt werden, ob die in Absatz 59 des FICPI-Reports 7112-02 vorgeschlagene zweite Alternative nicht vorzuziehen wäre, nämlich die Frist zur Einreichung des Antrages beginnend mit der Mitteilung des Recherchenberichtes an den Anmelder laufen zu lassen. Die Frist für die Einreichung des Antrages würde dann so festgelegt sein, wie dies bei anderen Verfahrensfristen, z.B. für die Einreichung einer Beschwerde, der Fall ist, und die Gefahr eines Irrtums auf Seiten des Anmelders oder Vertreters würde viel kleiner sein.

Es wird darauf hingewiesen, daß in der Sache der Festsetzung der Frist die Sicherheit für den Anmelder wichtiger ist als dies üblicherweise für die Allgemeinheit zutrifft, da die letztere keine Rechte verliert, wenn sie hinsichtlich des genauen Datums einen Fehler begeht.

Party claiming a Better Title

The comments of the FICPI in report 7203-08 would appear still to apply and are repeated here with change of the Article and Rule numbers:

According to Art. 59(1) a party claiming a better title can intervene only up to the time when the European patent has been granted. However, according to Rule 13(1) and (2) such intervention is also possible during the examination of an opposition or during the opposition period, i.e. after the European patent has been granted. Thus, as far as can be seen Rule 13 is in conflict with Art. 59 and is therefore null and void under Art. 163(2).

Amplification of Art. 59 to cover intervention by the party claiming a better title during the pendency of opposition proceedings or during the opposition period would appear to be necessary.

Seeing that time limits in force at the date of suspension of the proceedings may have been practically consumed at that date, it is proposed:

in the last two lines of Rule 13(4) to replace “the day on which communication under paragraph 3 has been notified” to “a date fixed by the Patent Office”.

Time Limit for Filing Request for Examination

It is appreciated that Rule 51 has been adopted in accordance with the wishes expressed by the profession, e.g. in FICPI paper 7112-02, paragraph 59. It is felt, however, that in view of paragraph (2) of Rule 51 the value of the communication about the date of expiry of the period for making a request for examination is somewhat doubtful, since the applicants and their representatives are not relieved of the complications and risk of error involved by determining the time limit from the Bulletin. In these circumstances it may be considered whether the second alternative proposed in paragraph 59 of the FICPI report 7112-02 will not be preferable, viz. to calculate the time limit from the date on which the search report is communicated to the applicant. The time limit for filing the request would then be determined as any other time limit in the proceedings, such as that for lodging appeal, and the risk of error on the part of the applicant or his representative would be much less.

It is pointed out that in the matter of determining the time limit, security of the applicant is much more important than convenience to the general public, seeing that the latter will lose no rights if they make a mistake about the exact date.
STELLUNGNAHME DER

FICPI

Fédération Internationale des Conseils en Propriété Industrielle

COMMENTS BY

FICPI

Fédération Internationale des Conseils en Propriété Industrielle

PRISE DE POSITION DE LA

FICPI

Fédération Internationale des Conseils en Propriété Industrielle

(1) Deutsche Übersetzung vorgelegt von FICPI
(2) La traduction française a été fournie par la FICPI
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
Regel 51
Mitteilung über die Veröffentlichung

(1) Das Europäische Patentamt hat den Anmelder von der Veröffentlichung der europäischen Patentanmeldung oder, wenn der europäische Recherchenbericht später veröffentlicht wird, von dieser Veröffentlichung zu unterrichten und ihn gleichzeitig auf den Ablauf der Frist für die Stellung des Prüfungsantrags hinzuweisen.

(2) Der Anmelder kann aus der Unterlassung der Mitteilung nach Absatz 1 und aus in ihr enthaltenen Fehlern keine Ansprüche herleiten.

Vgl. Artikel 92 (Veröffentlichung der europäischen Patentanmeldung)

Kapitel IV
Prüfung durch die Prüfungsabteilung

Regel 52
Prüfungsverfahren

(1) In dem Bescheid nach Artikel 95 Absatz 1 stellt das Europäische Patentamt dem Anmelder anheim, zu dem europäischen Recherchenbericht Stellung zu nehmen und gegebenenfalls die Beschreibung, die Patentansprüche und die Zeichnungen zu ändern.

(2) In den Bescheiden nach Artikel 95 Absatz 2 fordert die Prüfungsabteilung den Anmelder gegebenenfalls auf, die festgestellten Mängel zu beseitigen und soweit erforderlich die Beschreibung, die Patentansprüche und die Zeichnungen in geänderter Form einzureichen.

(3) Die Bescheide nach Artikel 95 Absatz 2 sind zu begründen; dabei sollen alle Gründe zusammengefaßt werden, die der Erteilung des europäischen Patents entgegenstehen.

(4) Bevor die Prüfungsabteilung die Erteilung des europäischen Patents beschließt, teilt sie dem Anmelder mit, in welcher Fassung sie das europäische Patent zu erteilen beabsichtigt, und fordert ihn auf, innerhalb eines Monats die Erteilungsgebühr und die Druckkostengebühr zu entrichten. Teilt der Anmelder innerhalb dieser Frist mit, daß er mit der Erteilung des europäischen Patents in der vorgesehenen Fassung nicht einverstanden ist, so gilt die Mitteilung der Prüfungsabteilung als nicht erfolgt; die Prüfung wird fortgesetzt.

(5) In der Mitteilung der Prüfungsabteilung nach Absatz 4 werden den benannten Vertragsstaaten angegeben, die eine Übersetzung nach Artikel 63 Absatz 1 verlangen.

(6) In der Entscheidung, durch die das europäische Patent erteilt wird, ist die der Patentreihung zugrundeliegende Fassung der europäischen Patentanmeldung anzugeben.

Vgl. Artikel 63 (Übersetzung der Patentschriften), 95 (Prüfung der europäischen Patentanmeldung) und 96 (Zurückweisung oder Erteilung)

Rule 51
Information about publication

(1) The European Patent Office shall inform the applicant of the publication of the European patent application or, if the European search report is published at a later date, of the publication of the latter, and shall at the same time inform him of the date of expiry of the period for making a request for examination.

(2) The applicant may invoke neither the omission of the communication provided for in paragraph 1 nor any errors contained therein.

Cf. Article 92 (Publication of a European patent application)

Chapter IV
Examination by the Examining Division

Rule 52
Examination procedure

(1) In the invitation pursuant to Article 95, paragraph 1, the European Patent Office shall invite the applicant, if he wishes, to comment on the European search report and to amend, where appropriate, the description, claims and drawings.

(2) In any invitation pursuant to Article 95, paragraph 2, the Examining Division shall, where appropriate, invite the applicant to correct the disclosed deficiencies and, where necessary, to file the description, claims and drawings in an amended form.

(3) Any communication pursuant to Article 95, paragraph 2, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.

(4) Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant the European patent, and shall request him to pay within one month the fees for grant and printing. If the applicant has communicated his disapproval of the European patent being granted on the basis of this text within that period, the communication of the Examining Division shall be deemed not to have been made, and the examination shall be resumed.

(5) The communication of the Examining Division under paragraph 4 shall indicate the designated Contracting States which require a translation pursuant to Article 63, paragraph 1.

(6) The decision to grant the European patent shall state which text of the European patent application forms the basis for the grant of the European patent.

Cf. Articles 63 (Translation of the European patent specification), 95 (Examination of the European patent application) and 96 (Refusal or grant)
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
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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'institution d'un système européen de délivrance de brevets
et publiés par le
Gouvernement de la République fédérale d'Allemagne

1972
A provision to this effect was inserted in the Implementing Regulations as Re. Article 85, No. 3.

Article 97 - Grant of the European patent

58. The Working Party made clear in paragraph 2 the legal consequences of the applicant not being in agreement with the grant of the patent in the form envisaged: it would result in the communication of the text in which it was intended to grant the patent being deemed to be withdrawn and in the continuation of the examination proceedings (cf. BR/168/72, point 123).

The Working Party agreed that the applicant should state his grounds for disapproving the intended form of the grant of the patent.

59. For the amendments to paragraphs 3 and 4, see point 21 above.

Article 105 - Decision in opposition proceedings

60. By analogy with the clarification made in Article 97, paragraph 2 (see point 58 above), it was necessary to state in this Article the legal consequences of the proprietor of the patent (or the opponent) not being in agreement with the amended form of the patent.

Some delegations considered that only the proprietor of the patent should have the right to object to the grant of the patent; that the opponent should have no such right;
The Working Party also established that a published abstract formed part of the state of the art under Article 11, paragraph 2.

56. The Working Party amended the first sentence of paragraph 5 to the effect that the period for paying the fee for the supplementary report on the state of the art would no longer be fixed immutably at one month, but could vary between 2 and 6 weeks, thus being aligned on Rule 40.3 of the Regulations under the PCT (cf. BR/168/72, point 107). The International Patent Institute would determine the exact length of the period in each individual case.

The limits of this period were laid down in the Implementing Regulations (Re. Article 79, No. 5).

Article 85 - Publication of a European patent application

Re. Article 85, No. 3 - Notification to the applicant of publication and of the expiry of the period for making the request for examination

57. The Working Party decided, as requested by a large number of international organisations, that the European Patent Office should inform the applicant of the publication of his application or of the report on the state of the art, as well as informing him of the date of expiry of the period for making a request for examination (cf. BR/168/72, point 112). It was agreed, however, that the applicant would have no right of appeal against not being so informed or against being informed erroneously.

BR/177 e/72 lor/MGT/gc .../...
REPORT

on the 11th meeting of Working Party I
held in Luxembourg from 28 February to 3 March 1972

1. Working Party I held its 11th meeting in Luxembourg from 28 February to 3 March 1972 with Dr Haertel, President of the Deutsches Patentamt in the Chair.

Representatives of the Commission of the European Communities, the IIB and WIPO attended the meeting as observers. The Representatives of the Council of Europe sent apologies for absence. Those present at the 11th meeting are listed in Annex I to this report.

2. Working Party I adopted the provisional agenda as contained in BR/GT I/143/72; it was agreed that Articles 153 and 154 would be dealt with by the Co-ordinating Committee at its next meeting scheduled for 15 to 19 May 1972. The provisional agenda is contained in Annex II to this report.

3. The Drafting Committee of Working Party I was chaired by Mr van Benthem, President of the Octrooiraad.

The results of the Drafting Committee's work were circulated under reference BR/176/72.

BR/177 e/72 cyd/AH/prk

.../...
Re. Article 85
No. 3

Notification to the applicant of publication and of the expiry of the period for making the request for examination

(1) The European Patent Office shall inform the applicant of the publication of the European patent application or, if the report on the state of the art is published at a later date, of the publication of the latter, and shall at the same time inform him of the date of expiry of the period for making a request for examination pursuant to Article 88, paragraph 2.

(2) The applicant may invoke neither the omission of the notification provided for in paragraph 1 nor any errors contained therein.
FIRST PRELIMINARY DRAFT
OF THE
IMPLEMENTING REGULATIONS
SECOND PRELIMINARY DRAFT CONVENTION
FOR A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

(Preliminary Draft Convention of the Implementing Regulations)

(Preliminary Draft Convention of the Rules relating to Fees)

Articles prepared by Working Party I
(8 to 24 March 1972)
63. The Working Party agreed that in any case the abstract would be published as a part of the application. The President of the European Patent Office may, moreover, lay down special provisions governing the publication of the abstract. Re. Article 85, No. 1 IR was amended accordingly.
INTER-GOVERNMENTAL CONFERENCE Brussels, 17 November 1971
FOR THE SETTING UP OF A EUROPEAN BR/135/71
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

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/CT 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
Octrooi raad; and after his departure, that of Mr. LABRY,
Embassy Counsellor at the Ministry of Foreign Affairs
(France).

BR/135 e/71 prk
(Unrevised translation)
Zu Artikel 79
Nummer 2
Frist für die Erstellung des Berichts über den
Stand der Technik
Der Bericht über den Stand der Technik und der end-
gültige Inhalt der Zusammenfassung werden dem Euro-
päischen Patentamt spätestens drei Monate nach dem
Tag übermittelt, an dem das Internationale Patentinstitut
in Den Haag vom Europäischen Patentamt die zur Er-
stellung des Berichts erforderlichen Unterlagen erhalten
hat.

Re. Article 79
No. 2
Time limit for the report on the state of the art
The report on the state of the art and the definitive
contents of the abstract shall be transmitted to the
European Patent Office not later than three months
after the International Patent Institute at The Hague
has received from the European Patent Office the
documents needed to draw up its report.

Zu Artikel 79
Nummer 3
Beschränkung des Berichts über den Stand der Technik
auf einen Teil der europäischen Patentanmeldung
Kommt der Anmelder der in Artikel 79 Absatz 5 des
Übereinkommens vorgesehenen Aufforderung nicht
nach, so erstellt das Internationale Patentinstitut in
Den Haag den Bericht über den Stand der Technik über
denjenigen Teil der europäischen Patentanmeldung, der
sich auf die in den Patentansprüchen zuerst erwähnte
Erfindung oder Gruppe von Erfindungen bezieht, die
eine einzige allgemeine erforderische Idee verwirklichen.

Re. Article 79
No. 3
Restriction of the report on the state of the art to
a part of the application for a European patent
If the applicant does not respond to the invitation
provided for in Article 79, paragraph 5, of the Conven-
tion, the International Patent Institute at The Hague
shall draw up the report on the state of the art on that
part of the application for a European patent relating
to the invention or plurality of inventions forming a
single general inventive concept and occurring first in
the claims.

Zu Artikel 85
Nummer 1
Veröffentlichung der europäischen Patentanmeldungen
und Patentschriften
Der Präsident des Europäischen Patentamts bestimmt,
in welcher Form die europäischen Patentanmeldungen
und die Patentschriften veröffentlicht werden und welche
Angaben sie enthalten. Das gleiche gilt für die Veröf-
ffentlichung der Übersetzungen gemäß Artikel 123 Ab-
sätze 2 und 3 des Übereinkommens.

Re. Article 85
No. 1
Publication of European patent applications and
European patent specifications
The President of the European Patent Office shall
prescribe the form of the publication of the European
patent application and of the specification of a European
patent and the data which are to be included. The same
shall apply for the publication of the translations pursuant
to Article 123, paragraphs 2 and 3, of the Convention.

Zu Artikel 85
Nummer 2
Abschluß der technischen Vorbereitungen für die
Veröffentlichung
Der Präsident des Europäischen Patentamts bestimmt
für die in Artikel 85 Absätze 1, 3 und 4 des Überein-
kommens vorgesehenen Fälle, innerhalb welcher Frist
vor dem Tag der Veröffentlichung die technischen Vor-
bereitungen für die Veröffentlichung als abgeschlossen
gelten.

Re. Article 85
No. 2
Termination of the technical preparations for publication
The President of the European Patent Office shall lay
down, in the cases provided for in Article 85, paragraphs
1, 3 and 4, of the Convention, the date on which the
technical preparations for publication are to be deemed
to have been completed.
ERSTER VORENTWURF EINER AUSFÜHRUNGSORDNUNG  
ZUM ÜBEREINKOMMEN ÜBER EIN EUROPÄISCHES  
PATENTERTeilungsverfahren

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

PREMIER AVANT-PROJET DE RÈGLEMENT D'EXÉCUTION  
DE LA CONVENTION INSTITUANT UN SYSTÈME EUROPÉEN  
DE DÉLIVRANCE DE BREVETS
SECOND PRELIMINARY DRAFT OF A CONVENTION
ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

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

and

FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

— 1971 —
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 a provision 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.


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