Article 155 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.
Art. 155
MPÜ

Das Europäische Patentamt als mit der internationalen vorläufigen Prüfung beauftragte Behörde

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provision was also adopted to authorise the national authorities of the host country to withdraw the right to a place of business for reasons of "ordre public".

(d) Deletion from the list of professional representatives

The Main Committee examined the grounds for deletion of professional representatives from the list and re-arranged them in Rules 103 (permanent solution) and 107 (transitional period). No difficulties were presented by the three grounds for deletion which apply both in the transitional period and in the permanent solution, namely, death or legal incapacity of the representative, his ceasing to be a national of one of the Contracting States, where the President does not grant or is not required to grant exemption from this requirement, or his ceasing to have a place of business or employment in any of the Contracting States. There was unanimous agreement that, in respect of representatives during a transitional period, the national central industrial property office in question must, in these three cases, withdraw the certificate which it has issued and the representative must be deleted from the list. There was, however, disagreement as to whether the mere surrender of the place of business in the State in which the certificate was granted should result in the withdrawal of the certificate, if the representative establishes another place of business in another Contracting State. The Committee's answer was in the negative. The majority adopted the viewpoint that it would be unfair and unjustifiable to make representation before the European Patent Office during a transitional period dependent on a merely national requirement of any State that the place of business should be within its territory. This restriction on the national central industrial property offices was incorporated in Rule 107 relating to the transitional period, while at the same time it was laid down that the national offices could withdraw the certificate, apart from on one of the three above-mentioned grounds, pursuant to other conditions of national law and, in particular, on disciplinary grounds.

Subject to these limitations, representatives entered on the list during the transitional period will, throughout this period, be required to have a certificate issued by the national central industrial property office of a Contracting State. This requirement will, however, cease to apply on the expiry of the transitional period after which the certificate will be devoid of all effect. Thus, representatives during the transitional period and representatives newly authorised after having taken the European qualifying examination will have equal status under the permanent solution. Both kinds of representative will therefore be subject to the disciplinary power decided upon by the Administrative Council pursuant to Article 134, paragraph 7(c); in order to avoid a situation where there would be no disciplinary supervision, the disciplinary power should begin to apply not later than on the expiry of the transitional period.

The Main Committee also remedied other defects in Rules 103 and 107 by including in them provisions laying down that, when the ground for deletion no longer obtains, a representative deleted from the list may be re-entered on it.

13. Conversion procedure (Articles 135-137/Rules 104)

Article 135, paragraph 1, sets out the grounds for the conversion of a forfeited European patent application into a national application. It was proposed to delete the possibilities for conversion under the national laws of the Contracting States in paragraph 1(b). It was maintained that, firstly, Articles 120 and 121 protected the applicant sufficiently against the consequences of omissions and, secondly, that there were no grounds to justify pursuit at national level of European patent applications refused or European patents revoked on material grounds. The principal objection raised against this proposal for deletion was that it was a matter for the national laws whether conversion should be permissible in cases other than those compulsorily prescribed, i.e. in cases where national law provided for forms of protection such as utility models, the grant of which was conditional on less exacting requirements than those applicable to the grant of patents for invention. The great majority of the Committee subsequently rejected the proposal, so that the existing solution was retained.

14. Revocation and prior rights (Articles 138-139)

With regard to the grounds on which, pursuant to Article 138, a European patent may be revoked, the Main Committee made it clear that extension of the protection conferred can be a ground for revocation, irrespective of whether the extension occurs during opposition proceedings or national proceedings. This clarification takes account of the fact that a change in the claims of a European patent during national revocation proceedings or during national proceedings for partial surrender may result in an inadmissible extension of protection. Moreover, the Committee refused to impose, in paragraph 2 of the same Article, any restrictions on national laws in respect of the form in which limitations of European patent claims can be made in cases of partial revocation.

A further proposal, in connection with the rules laid down in Article 139 governing the relationship between European and national patents, to provide that, in cases of collision, the European patent should always take precedence was also unsuccessful. The Committee, by a great majority, rejected this solution which would have been a further step towards adopting a maximum solution, principally in the belief that, in the interests of flexibility, the national laws of the Contracting States should be left to adopt such collision rules as they considered justified.

15. Relationship between the Convention and the PCT (Articles 150-157/Rules 105-106)

The Main Committee re-examined the provisions of Articles 150-157, linking the Convention and the Patent Cooperation Treaty/PCT, i.e., the provisions governing the procedure for international applications which are the subject of proceedings before the European Patent Office. In the course of this examination, it remedied the remaining defects and, where necessary, removed discrepancies between the provisions of the Convention and those of the PCT.

With regard to material content, the amendment made by the Main Committee to Article 157 concerning the effects of the publication of the international application on proceedings before the European Patent Office should be noted. A consequence of the previous text of paragraph 1, according to which publication of the international application by the International Bureau of WIPO takes the place of the publication of a European patent application, would have been that, in each case, the published international application would have formed part of the state of the art, pursuant to Article 52, paragraph 3. This legal consequence was regarded as unjustified where an application, which has not been published in an official language of the European Patent Office, is withdrawn before its communication to the European Patent Office. Therefore, the Committee, after a thorough examination of the relevant provisions of the PCT, decided by a large majority to take account of this case by providing that an international application published pursuant to Article 21 of the
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
Article 154.5

The European Patent Office as an International Preliminary Examining Authority

(1) The European Patent Office shall act as an International Preliminary Examining Authority within the meaning of Chapter II of the Cooperation Treaty for applicants who are residents or nationals of a Contracting State bound by that Chapter subject to the conclusion of an agreement between the Organisation and the International Bureau of the World Intellectual Property Organization.

(2) Subject to the prior approval of the Administrative Council, the European Patent Office shall also act as an International Preliminary Examining Authority for any other applicant, in accordance with an agreement concluded between the Organisation and the International Bureau of the World Intellectual Property Organization.

(3) The Boards of Appeal shall be responsible for deciding on a protest made by an applicant against an additional fee charged by the European Patent Office under the provisions of Article 34, paragraph 3(a), of the Cooperation Treaty.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/ 146/R 6
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Convention: Articles 140 to 166
Article 154

The European Patent Office as an International Preliminary Examining Authority

(1) The European Patent Office shall act as an International Preliminary Examining Authority within the meaning of Chapter II of the Cooperation Treaty for applicants who are residents or nationals of a Contracting State bound by that Chapter subject to the conclusion of an agreement between the Organisation and the International Bureau of the World Intellectual Property Organization.

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MUNICH DIPLOMATIC CONFERENCE

FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 27 September 1973

M/ 136/I/R 10

Original: English/French/German

TEXTS DRAWN UP BY

THE DRAFTING COMMITTEE OF MAIN COMMITTEE I

AT THE MEETING ON 26 SEPTEMBER 1973

Articles of the Convention:

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(3) Für Entscheidungen, die das Europäische Patentamt als Bestimmungsamt nach Artikel 25 Absatz 2 Buchstabe a des Zusammenarbeitsvertrags zu treffen hat, ist die Prüfungsabteilung zuständig.

Artikel 154
Das Europäische Patentamt als mit der internationalen vorläufigen Prüfung beauftragte Behörde


(3) Für Entscheidungen über einen Widerspruch des Anmelders gegen eine vom Europäischen Patentamt nach Artikel 34 Absatz 3 Buchstabe a des Zusammenarbeitsvertrags für die internationale vorläufige Prüfung festgesetzte zusätzliche Gebühr sind die Beschwerdekammern zuständig.

Artikel 155
Das Europäische Patentamt als ausgewähltes Amt

Das Europäische Patentamt wird als ausgewähltes Amt im Sinn des Artikels 2 Ziffer xiv des Zusammenarbeitsvertrags tätig, wenn der Anmelder einen der benannten Staaten, auf die sich Artikel 153 Absatz 1 oder Artikel 149 Absatz 2 bezieht, ausgewählt hat und für diesen Artikel 154
The European Patent Office as an International Preliminary Examining Authority

(1) The European Patent Office shall act as an International Preliminary Examining Authority within the meaning of Chapter II of the Co-operation Treaty for applicants who are residents or nationals of a Contracting State bound by that Chapter subject to the conclusion of an agreement between the Organisation and the International Bureau of the World Intellectual Property Organization.

(2) Subject to the prior approval of the Administrative Council, the European Patent Office shall also act as an International Preliminary Examining Authority for an applicant who is a resident or national of a State not party to the Co-operation Treaty or not bound by Chapter II of that Treaty in respect of which the Assembly of the International Patent Co-operation Union has, in accordance with an agreement concluded between the Organisation and the International Bureau of the World Intellectual Property Organization, specified the European Patent Office as a competent International Preliminary Examining Authority.

(3) The Boards of Appeal shall be responsible for deciding on a protest made by an applicant against an additional fee charged by the European Patent Office under the provisions of Article 34, paragraph 3(a), of the Co-operation Treaty.

Article 155
The European Patent Office as an elected Office

The European Patent Office shall act as an elected Office within the meaning of Article 2(xiv) of the Co-operation Treaty if the applicant has elected any of the designated States referred to in Article 153, paragraph 1, or Article 149, paragraph 2, for which Chapter II of that Treaty has become binding. Subject to the prior
ENTWURF EINES ÜBEREINKOMMENS
ÜBER EIN EUROPÄISCHES PATENTERTeilungsverfahren

DRAFT CONVENTION
ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

PROJET DE 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
déborés 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
contented the Working Party considered that the Boards of Appeal should be responsible for deciding on the protest.

Article 121b (new) - The European Patent Office as an elected Office

39. The Working Party transferred the former paragraph 3 of Article 121 to the new Article 121b; it drew up this Article also to cover two different cases in which the European Patent Office is to act as an elected Office within the meaning of Article 2(xiv) of the PCT:

(a) where the applicant has elected a designated State bound by Chapter II of the PCT (first sentence; the content corresponds to the deleted Article 118, paragraph 3).

(b) where the applicant is a resident or national of a State which is not a party to the PCT or which is not bound by Chapter II of the PCT; in this event the European Patent Office may, subject to certain limiting conditions, act as an elected Office. This does however require the prior approval of the Administrative Council (second sentence; this sentence takes Article 31, paragraph 2(b) and paragraph 4(b), second sentence, of the PCT into account).

40. In connection with Article 17, paragraph 3(b) of the PCT, under which the national law of any designated State may provide that those parts of the international application in respect of which the International Searching Authority has not established a search report on the grounds of lack of unity of invention, are, subject to
(b) the European Patent Office may also act in the same capacity for an applicant who is a resident or national of a Contracting State not party to the PCT or not bound by Chapter II of the PCT in respect of which the Assembly of the International Patent Co-operation Union has specified the European Patent Office as an International Preliminary Examining Authority. In this event however, the European Patent Office may only act in such a capacity with the prior approval of the Administrative Council (paragraph 2; this provision takes Article 31, paragraph 2(b), of the PCT into account).

In connection with the new paragraph 2 it was pointed out that one particular case in which this provision would be of particular advantage was that of the applicant being a national of a developing country.

38. Article 34, paragraph 3(a) of the PCT was referred to in connection with the European Patent Office's function as an International Preliminary Examining Authority. This provision states that if an International Preliminary Examining Authority considers that an application does not comply with the requirement of unity of invention, it may invite the applicant to restrict the claims or to pay an additional fee.

In paragraph 3 the Working Party lays down the department of the European Patent Office which is to be responsible if the applicant protests against an additional fee being charged by the European Patent Office in its capacity of International Preliminary Examining Authority. As in this case a decision of the European Patent Office itself is being
36. The Working Party finally discussed the question of which department of the European Patent Office in its capacity of designated Office is to be responsible for the decision under Article 25, paragraph 2(a) of the PCT; this provision states that a designated Office is to decide whether a refusal, declaration or finding was justified under the provisions of the PCT.

In view of the fact that such a decision may give rise to difficult questions regarding the interpretation of the PCT, the Working Party considered it advisable to make it the responsibility of the Examining Divisions and not the Examining Sections of the European Patent Office; the Boards of Appeal could then be called upon as a second authority if their decisions were challenged. A new paragraph 3 was added to this effect.

**Article 121a (new) - The European Patent Office as an International Preliminary Examining Authority**

37. The Working Party transferred the former Article 118, paragraph 2, to this new Article, and drafted it to cover two different cases:

(a) the European Patent Office is to act as an International Preliminary Examining Authority for applicants who are residents or nationals of a Contracting State bound by Chapter II of the PCT, subject to the conclusion of an agreement between the Administrative Council and the International Bureau of the WIPO/OMPI (Paragraph 1; the content corresponds to the deleted Article 118, paragraph 2);
MINUTES
of the 7th meeting of Working Party I
held at Luxembourg from 26 to 29 January 1971

Item 1 on the agenda (1) : Opening of the meeting and adoption of the provisional agenda.

1. The Working Party held its seventh meeting at Luxembourg from Tuesday 26 to Thursday 28 January 1971 with Dr. Haerétel, President of the German Patent Office, in the Chair.

   The meeting was attended by representatives of the Commission of the European Communities, WIPO/OMPI and the International Patent Institute (2). The representative of the General Secretariat of the Council of Europe sent his apologies for being unable to attend.

2. The Drafting Committee, under the Chairmanship of the President of the Netherlands "Octrooiraad", Mr J.V. Van Benthem, held its meetings directly after the deliberations of the Working Party, and also on the morning of 29 January 1971.

(1) For the provisional agenda (BR/GT I/101/71), see Annex I.
(2) For the list of those attending the meeting of the Working Party, see Annex II.
Article 121a

The European Patent Office as an International Preliminary Examining Authority

(1) The European Patent Office shall act as an International Preliminary Examining Authority within the meaning of Chapter II of the Co-operation Treaty for applicants who are residents or nationals of a Contracting State bound by that Chapter subject to the conclusion of an agreement between the Administrative Council and the International Bureau of the World Intellectual Property Organization.

(2) Subject to the prior approval of the Administrative Council, the European Patent Office shall also act as an International Preliminary Examining Authority for an applicant who is a resident or national of a State not party to the Co-operation Treaty or not bound by Chapter II of that Treaty in respect of which the Assembly of the International Patent Co-operation Union has, in accordance with an agreement concluded between the Administrative Council and the International Bureau of the World Intellectual Property Organization, specified the European Patent Office as a competent International Preliminary Examining Authority.

(3) When the European Patent Office acts as an International Preliminary Examining Authority, the Boards of Appeal shall be responsible for deciding on a protest made by an applicant against an additional fee charged by the European Patent Office under the provisions of Article 34, paragraph 3(a) of the Co-operation Treaty.
FIRST PRELIMINARY DRAFT OF A CONVENTION

ESTABLISHING

A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- Stage reached on 29 January 1971 -
had to be obvious to a person skilled in the art, did not, however, need to be defined any more precisely, since it was self-evident from the references to Article 11, paragraph 2 in Articles 13 and 74 that it was the filing date on the date of priority as the case may be.

**Article 14 - Industrial application**

26. After the German delegation had withdrawn its proposed amendment (BR/GT I/74/70, page 6), the Working Party decided against undertaking an alignment in Article 33, paragraph 4 of the PCT.

**Article 118 - Functions of the European Patent Office in the context of the Patent Co-operation Treaty**

27. The Working Party agreed to delete this Article, since its provisions were repeated individually in the following Articles: paragraph 1 was unnecessary because of the already existing Articles 119 and 121; in place of paragraph 2, a new Article 121a would be adopted, and in place of paragraph 3, a new Article 121b.

**Article 119 - The European Patent Office as a receiving Office**

28. Apart from a textual correction in paragraph 1, the Working Party, on the basis of Article 9, paragraph 2, of the PCT, limited the possibility of the European Patent Office acting as a receiving Office pursuant to paragraph 3 to instances in which the applicant is a resident or national of a State party to the Paris Convention.
MINUTES

of the 7th meeting of Working Party I
held at Luxembourg from 26 to 29 January 1971

Item 1 on the agenda (1) : Opening of the meeting and adoption of the provisional agenda

1. The Working Party held its seventh meeting at Luxembourg from Tuesday 26 to Thursday 28 January 1971 with Dr. HAERTEL, President of the German Patent Office, in the Chair.

The meeting was attended by representatives of the Commission of the European Communities, WIPO/OMPI and the International Patent Institute (2). The representative of the General Secretariat of the Council of Europe sent his apologies for being unable to attend.

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(1) For the provisional agenda (BR/GT I/101/71), see Annex I.
(2) For the list of those attending the meeting of the Working Party, see Annex II.

BR/94 e/71 son/KM/prk
Article 118 (former Article 113b)
Functions of the European Patent Office in the context of the Patent Co-operation Treaty

(1) Subject to the provisions set out below, the European Patent Office shall act as a receiving Office and as a designated Office within the meaning of Chapter I of the Co-operation Treaty, once that Chapter has entered into force for at least one Contracting State to this Convention.

(2) Subject to the provisions set out below, the European Patent Office shall act as an International Preliminary Examining Authority within the meaning of Chapter II of the Co-operation Treaty, once that Chapter has entered into force for at least one Contracting State to this Convention, and all other conditions laid down by the Co-operation Treaty and by this Convention for the performance of the functions of an International Preliminary Examining Authority have been met.

(3) Subject to the provisions set out below, the European Patent Office shall act as an elected Office within the meaning of Chapter II of the Co-operation Treaty, once that Chapter has entered into force for at least one Contracting State to this Convention.

BR/70 e/70 gc
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

- Secretariat -

Brussels, 21 December 1970
BR/70/70

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

(Articles drafted by Working Parties I, II, III and IV)

BR/70 e/70 gc
which accepted Chapter II would also accept that their patent offices should act as an International Preliminary Examining Authority.

38. The Conference had a broad discussion on whether Article 113f proposed by Working Party I was necessary and, if so, on the wording to be adopted.

(a) As regards the first question, the Conference recognized the need for the Article since it provides an essential link between the Convention and the PCT. Some delegations pointed out that it might be useful, before adopting any final wording in the Preliminary Draft Convention, to discover the views third countries might take as regards the international search. Other delegations, however, felt that the European States might be in a better position if Article 113f clearly stated their intention to place all international searches on an equal footing, in order to avoid giving third countries the impression that the search carried out by the IIB would have a privileged status among the Contracting States to the Convention.
Articles 113a to 113g

International application pursuant to the Patent Co-operation Treaty (PCT)
(Report by the German delegation: BR/24/69)

37. On the subject of Article 113b, the French delegation observed that, pursuant to paragraph 2, the European Patent Office would act as an International Preliminary Examining Authority. In view of the intentions expressed by a number of patent offices from States which were to take part in the European system for the grant of patents, these offices would also be International Preliminary Examining Authorities under the PCT. Such a situation was no doubt perfectly compatible with the PCT draft, but it would nonetheless mean that several routes would be open for applicants to obtain an international preliminary examination. This might present certain disavantages. The French delegation thought it would be desirable to achieve a certain concentration of the search capacity of the various States taking part in the European Patent Office.

The Conference observed that no answer could be given to this question at the present stage, since it was not yet known which States would accept Chapter I and which would accept both Chapter I and Chapter II of the PCT draft and, furthermore, it was not known whether those States...
MINUTES

of the
2nd MEETING
held at Luxembourg on 13 to 16 January 1970

Item 1 on the agenda (BR/14/69) (1)

OPENING OF THE MEETING

1. The Conference began its work at 10.00 a.m. on Tuesday 13 January at the Kirchberg European Centre, Luxembourg, with Dr. HAERTEL, President of the German Patent Office, in the Chair (2).

Item 2 on the agenda

ADOPTION OF THE PROVISIONAL AGENDA

2. The Conference adopted the provisional agenda submitted by the President.

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(1) The agenda is given in Annex I
(2) The list of those attending the 2nd meeting is given in Annex II.

BR/26 e/70 kel/PA/mk

.../...
is available to act as an elected Office. The requirements to be met for the European Patent Office to act as an elected Office in an individual case are set out in Article 113e, paragraph 3.

**Article 113c - The European Patent Office as a receiving Office**

60. No comment.

**Article 113d - Filing and transmittal of the international application**

61. The Working Party agreed unanimously that, for an international application, the applicant has the choice of using either the European Patent Office or a national office as the receiving Office within the meaning of the PCT. The Working Party has expressed this in the opening words of paragraph 1. In the Working Party's opinion this does not pre-judge the question for which countries protection can be requested via an international application having the European Patent Office as receiving Office.

62. The Working Party discussed whether the European Patent Office can also be a receiving Office when the applicant does not want a European Patent, but only desires protection in States which are not Contracting States to the European Convention, and gave an affirmative answer. The Working Party did not wish to exclude this possibility, but desired instead to leave the applicant the choice between the national patent office and the European Patent Office in this case.

BR/12 e/69 ern/PA/che
CHAPTER III\textsuperscript{bis}

INTERNATIONAL APPLICATION PURSUANT TO THE PATENT CO-OPERATION TREATY

57. The Working Party noted, as regards Chapter III\textsuperscript{bis} as a whole, that it could only lay down the principles for the relations between the Convention and the PCT. Further details could not be worked out until later, when the text of the PCT has been finally adopted. This would be particularly true if the PCT were to allow the Contracting States the possibility of adopting additional rules in certain cases. It would then have to be examined whether these additional rules should be included in the Convention itself, or in the Implementing Regulations.

Article 113a - Application of the Patent Co-operation Treaty

58. No comment.

Article 113b - Functions of the European Patent Office in the context of the Patent Co-operation Treaty

59. The Working Party agreed that paragraph 3 simply sets out the conditions under which the European Patent Office
MINUTES

of the meeting of Working Party I
(Luxembourg, 24 to 28 November 1969)

I.

1. The third working meeting of Working Party I was held at Luxembourg from Monday 24 to Friday 28 November 1969, with Dr. HAERTEL, President of the German Patent Office, in the Chair.

The Commission of the European Communities, BIRPI, the General Secretariat of the Council of Europe and the International Patent Institute took part in the meeting (1).

2. The Working Party agreed to appoint the following as rapporteurs:

- a member of the German delegation for Articles 88 to 96 (Examination procedure) (2),

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(1) See Annex for list of those attending the meeting of the Working Party.

(2) It was originally agreed at the October meeting that the German delegation should produce a report for Articles 88 to 104.
at least one contracting State to this Convention.

3) (Subject to the provisions set out below, the

European Patent Office shall act as an accredited Office

Preliminary examination authority with the meaning of

Convention or at least one Contracting State for at least one Contracting

Chapter II of the Co-operation Treaty, once that Chapter

and as a designated Office within the meaning of

Article 179b

European Patent Office shall act as a receiving Office

functions of the European Patent Office in the

Article 179b
Of the European Free Trade Association —
the draft of an open European Patent Convention drawn up by the Member States
and
preparatory working party and
preparatory working party I

Article 88 to 172

Draft Convention for the European System for the granting of Patents
PCT, for which the European Patent Office is a designated Office, shall be deemed to form part of the state of the art only if it is confirmed, i.e. if it is communicated to the European Patent Office in one of its official languages and the national fee prescribed is paid. In order to create better information facilities for third parties, the Committee provided for a mention to be made in the European Patent Bulletin of the publication by the International Bureau of WIPO of the international application, and, where the publication by the International Bureau is not in one of the official languages of the European Patent Office, for the compulsory publication of the international application communicated to the European Patent Office.

The Committee then inserted a new Article 153a, which empowers the European Patent Office to act as an International Searching Authority within the meaning of the PCT, pursuant to an agreement to be concluded with WIPO at the appropriate time.

16. Activities of the European Patent Office during a transitional period (Article 161/Rule 106)

The principle, laid down in Article 161, that the European Patent Office will, after opening, only be able to assume its activities progressively was not questioned. The Main Committee was also of the unanimous opinion that, during the transitional period, searches should be carried out in all areas of technology, a task which the European Patent Office should easily be in a position to perform after taking over the capacity of the IIB and the Berlin sub-office. This unequivocal declaration of intent was, like other general opinions expressed by the Main Committee, included in the Minutes. Nevertheless, in order to be able to meet difficulties, at present unforeseeable, which might subsequently arise, the Committee decided not to incorporate this principle in any binding form in Article 161. On the other hand, it was considered a firm principle that the Administrative Council should not be able to rescind decisions on the extension of the system once they had been adopted. Article 161 was re-worded accordingly.

17. Adjustment of the Convention to take account of the decisions of Main Committees II and III

The textual amendments adopted by Main Committee III did not affect the provisions dealt with by Main Committee I. Adjustments were, however, necessary in respect of two decisions of Main Committee II, relating to the inclusion of Search Divisions as departments in the proceedings (Article 15), a measure by which the Convention was adjusted to take account of the integration of the IIB provided for in the Protocol on Centralisation, and to the setting up of a Legal Division as a further department in the proceedings (Article 15) competent for certain decisions. These adjustments entailed purely drafting amendments (Articles 91, 105, paragraph 1, 109, paragraph 3, Rules 44-47), deletion of provisions which had become superfluous (Article 124, Rules 48, 67, paragraph 2) and new provisions such as the Article 153a referred to under point 15 above.

III Protocol on Recognition

The Protocol on Recognition, which lays down rules governing jurisdiction and the recognition of decisions of courts and other authorities of the Contracting States in respect of the right to the grant of a European patent required an amendment as to substance only in one point. With respect to the provision on jurisdiction in the Draft Protocol (Article 5), it was pointed out that a plaintiff residing in a Contracting State claiming the right to the grant of a European patent vis-à-vis an applicant not residing within the territory of a Contracting State would always have to bring proceedings before the German courts and not, as would be desirable, before the courts of his place of residence. The Main Committee agreed that this was a valid point and supplemented Article 5 to the effect that the courts of the plaintiff's place of residence shall also have jurisdiction in such cases, with, however, the subsidiary jurisdiction of the courts of the Federal Republic of Germany being retained.

IV Recommendation on Preparations for the Opening of the European Patent Office

The Main Committee approved the Recommendation which provides for the setting up of an Interim Committee responsible for preparatory work for the opening of the European Patent Office. In addition, in the interests of a clear delimitation of responsibilities the preparation both of the five-year plan mentioned in the Protocol on Centralisation and of the study on the extension of searches to the documentation of the Contracting States, introduced into that Protocol by Main Committee II, was assigned to the Interim Committee. With regard to the point that the Working Parties of the Interim Committee should, as a general rule, each be composed of six signatory States, the Committee decided that the Federal Republic of Germany and the Netherlands, as the countries in which the European Patent Office was based, should always be admitted as observers at meetings of Working Parties of which they were not members, and that other States should be admitted as observers at meetings where problems of special interest to them were dealt with. Furthermore, it was made clear that not only inter-governmental but also private international organisations could be invited as observers.

V Resolution on training staff for the European Patent Office

Finally, as the last item of the negotiations the Main Committee approved without discussion the draft Resolution on training staff for the European Patent Office contained in M/37 which essentially provides for the formation of an Interim Committee responsible for the training and recruiting of examiners.

D Final remarks

Here a report closes which has, perhaps, been too detailed, but which has attempted to summarise in the space of scarcely one hour the results of three weeks of extensive negotiations. The report may also have succeeded in showing that, in spite of the multitude of individual problems, which were usually resolved, those parts of the Draft Convention and the Draft Implementing Regulations which were the subject of the Main Committee's deliberations have been retained without any substantial changes. This is a happy state of affairs and demonstrates how thoroughly the Drafts were prepared.

The rapporteur feels he should not finish without paying tribute to the Chairman of the Main Committee, Dr. Kurt Haertel, for the efficient but gentle manner in which he has guided the negotiations, thus enabling the Main Committee to deal with such a multitude of problems. Main Committee I is also indebted to Mr. van Benthem, the indefatigable Chairman of Drafting Committee I, and his colleagues on that Committee, to the Secretariat staff, the interpreters and all the silent helpers whose selfless work has enabled the newly completed Drafts to be submitted today to the Committee of the Whole.