Article 56 E

Travaux Préparatoires
(EPC 1973)

Comment:

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Bonn, 14 March 1961

First Preliminary Draft
Convention relating to a European Patent Law
Articles 11 to 29
If the Patents Working Party is unable to reach agreement on a proposed definition of inventive level, it will be necessary to re-examine whether it is not possible to dispense with a definition of "inventive level" in European patent law and to leave application and interpretation of the concept to the case law of European judicial bodies.
involve any inventive step having regard to what was known or used, before the priority date of the claim, in the United Kingdom.

A similar approach was to be found in the American case-law requirement of a "flash of genius" which has since been dropped.

The possible objections against the Anglo-Saxon concept of inventive level are primarily that the assessment of inventive level is on the basis of a purely subjective factor namely that of creative effort.

(c) The proposals of the French experts in the Council of Europe document (EXP/Brev. (57), 3, p. 14 et seq.).

Those proposals suggest a list of objective criteria for the concept of inventive level including: new application of known means and not mere new use; combination of means not mere juxtaposition.

Regarding the objections to the French proposal, reference is made to point III.4 of the Kühnemann study.
(bb) The requirement that the invention be substantially different from what is already known could lead to strict standards being set for inventive level. That would probably be contrary to current practice in most Common Market countries. It would further mean that European patents could not be granted for a considerable number of inventions. In all probability that would lead to demands for a European utility model law to be created to protect "small inventions". Quite apart from the fact that the creation of a European utility model law would run into problems because only two of the six Common Market countries have their own national utility model laws, the question arises whether demands for protection covering "small inventions" as well could not better be met by an appropriate formulation of European patent law, namely by not setting too high a standard for inventive level.

(b) A provision such as that contained in the United Kingdom Patent Act of 16 December 1949 in Section 32 (1)(f).

Under that provision a patent may be revoked on the ground:

"that the invention, so far as claimed in any claim of a complete specification, is obvious and does not
Paragraph 2 in the Reimer Proposal has not been adopted. The rules seem too specific for a convention. It is probably better to leave it to the case law to decide the basis for determining the state of the art to assess inventive level, rather than lay down fixed rules as in the Reimer Proposal.

In his study on the harmonisation of patent laws in the Council of Europe States, von Zweigbergk endorsed the Reimer Proposal. It must, however, be remembered that the fiction of the "average skilled person" contained in the Reimer proposal is probably unknown in the legal practice of the other Common Market States.

If the Patents Working Party were to reject the proposal in the Preliminary Draft as unsuitable but wish to refer expressly to "inventive level", the following further possibilities could be considered:

(a) The proposed Nordic patent law.
    In that proposed law "inventive level" is worked into the concept of novelty so that an invention is only considered as new if it "is substantially different from what was known when the application was filed".

    The Nordic patent law solution is temptingly simple but is open to the following objections:

    (aa) The linking of inventive level to novelty which does not logically fit in the system.
Re Article 16

Inventive level

1. Documents:
   (a) Haertel Study, p. 24 et seq;
   (b) Von Zweigberk Study, p. 11 and 12 (French text; top of p. 16 of
       the unofficial German translation)
   (c) Kühnemann report on "Technical Progress and Inventive Level"
       for the Council of Europe Committee of Patent Experts (Council
       of Europe document EXP/Brev. (60) 5)
   (d) Reimer Proposal, Section 4
   (e) Draft Nordic patent law, Section 2, paragraph 1

2. Comments:

   The Co-ordinating Committee asked for the Patents Working Party's views
   as to whether the main features of the concept of "inventive level"
   should be defined in the Preliminary Draft Convention relating to a
   European patent law insofar as it is expressly mentioned in the Convention
   at all (cf. report of the Co-ordinating Committee of 10 November 1960,
   II.6, paragraph 2).

   The following comments are only relevant if, in its discussions on
   Article 11, the Working Party comes down in favour of expressly
   mentioning inventive level in a European patent law.

   Article 16 of the Preliminary Draft largely uses the wording of
   Section 4, paragraph 1, of the Reimer Proposal.
Comments

on the first Preliminary Draft Convention
relating to a European patent law
of 14 March 1961

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(Articles 11 to 29)
In order to leave no lacunae in the text submitted, the Working Party decided to specify that patent applications published on the same day as the prior application was filed also formed part of the state of the art.

To eliminate the risk of duplicated patents for a single invention if two applications were filed by two different applicants on the same day, the Working Party endorsed a proposal by Mr. Pfanner that paragraph 3 be supplemented by a provision that in such cases the time of filing would be decisive.

The new text of Article 14 was adopted taking account of the amendments made during the discussions.

**Article 15**

Drafting of the whole of this Article was deferred.

**Article 16**

Article 16 was adopted by the Working Party. It wanted Article 11, which listed the essential conditions for patentability, to mention inventive step. The words "and involving inventive step" would be inserted at the end of Article 11.

To make Article 16 readily understood, the text as submitted, including the reference to Article 14, was adopted.

Article 16 was adopted by the Working Party.

As proposed by Mr. Fressonnet, the Working Party decided to re-examine the order of the Articles when it had finished drawing up the whole of the Draft Convention. It was already clear that the numbering of Articles 11 and 12 would not change, that Article 14 would become Article 13, that Article 15 (discussion of which had been deferred) would become Article 14 and the former Article 13 would become Article 16.
The Chairman considered Mr. Fressonnet's proposal a good compromise solution and instructed the Drafting Committee to submit to the Working Party a text worded accordingly.

Agreeing with Mr. Lannoy, the Chairman said that there would be no point in trying to define the concept of inventive step. Mention of the criteria would be enough.

In reply to a question from Mr. Fressonnet, the Chairman agreed that the term "inventive step" could be omitted from the title of Article 16. He suggested that the text of that Article become paragraph 4 of Article 14 of the Preliminary Draft and begin with the words "a new invention shall not be patentable ....".
In contrast to the Preliminary Draft, that wording did not contain a precise definition of inventive level but rather circumscribed it. It sought to provide a compromise between the differing standpoints of the delegations and to make concessions to those who feared that the concept of inventive level was too subjective.

Mr. Roscioni emphasised that the new proposal had the advantage over the Nordic proposal of not confusing novelty and inventive level. As a gloss on the words "if the invention is not substantially different from the state of the art", he proposed adding at the end of the Article the words: "that is to say that the invention is not obvious from the state of the art".

Mr. van Benthem, on the other hand, was worried that the Chairman's new proposal might make the concept of inventive level stricter and he suggested going back to Article 16 as worded in the Preliminary Draft.

Mr. Fressonnet said that in the French translation of the Chairman's new proposal, rather than the words "si l'invention ne diffère pas essentiellement de l'état de la technique", the following wording should be used: "si l'invention ne diffère pas notablement (ou de façon appreciable) de l'état de la technique". That wording was more flexible and closer to the German text.

He further proposed another compromise solution for Article 16. That Article opened with a general phrase alluding to inventive level. It continued something like this: "A European patent shall not be granted even where the invention is considered to be new under Article 14, paragraph 1, if the invention does not involve an inventive step, that is to say, if it does not differ considerably from the state of the art and if it is obvious for a man skilled in the art". The requirements following the words "that is to say" must not be cumulative.
PATENTS WORKING PARTY

Meeting from 17 to 28 April 1961

Minutes of the meeting on 20 April 1961

The Chairman opened the meeting at 10.15 hrs.

The Working Party approved the minutes of the meeting on 18 April 1961.

The Chairman said that he could not yet give his opinion on Mr. van Benthem's question about the words "in any other way" in Article 13.

Article 13 was passed to the Drafting Committee which was to leave the expression in brackets pending a final decision.

Continuation of the discussion on Article 16 of the Preliminary Draft

The Working Party discussed the different principles applying to Article 16 and adopted a number which would appear in the new wording of that Article.

The Chairman submitted to the Working Party a proposed new version of Article 16 worded as follows:

"A European patent shall not be granted, even where the invention is considered to be new within the meaning of Article 14, paragraph 1, if the invention is not substantially different from the state of the art when the European application is filed."
the department of second instance, which would constitute a judicial body as proposed by Mr. Roscioni.

2. In addition to the patent grant procedure, the Convention would provide for revocation proceedings. A European court would have exclusive jurisdiction over such matters, at least at second instance. After some years the case law of that court would have established valid criteria for evaluating the concept of inventive level just as national courts have done for the concept of morality. Such case law would provide all the necessary guarantees for uniform judicial interpretation of that concept.

The Working Party decided to submit to the Co-ordinating Committee not only a draft provision on this subject but also notes explaining the various viewpoints within the Working Party.
applied, the interested circles would prefer the technically-qualified staff of the European Patent Office to assess it rather than the courts.

On this subject, Mr. van Bentheim, supported by Mr. Pfanner, recounted the numerous difficulties encountered in his country where the evaluation was left to the courts (expert evidence, counter-evidence and two instances).

Replying to Mr. Fressonnet, the Chairman confirmed that Mr. Roscioni's proposal would certainly be upheld. The Chairman's proposal for a definition of inventive level would satisfy the mandate given by the Co-ordinating Committee. It would also allow the matter to be discussed with national interested circles on the basis of a more detailed document.

Mr. Roscioni summarised his views as follows: he preferred to maintain his proposal since, in such matters, he had greater confidence in lawyers than in technically-qualified persons. The problems with expert evidence and counter-evidence could be avoided by giving the European Office responsibility for submitting an opinion to the European court. The opinion would be drawn up by the technical staff of the European Office. Finally, he was prepared to support the concept of inventive level examined by the European Office provided that a satisfactory definition was found incorporating objective criteria.

The Chairman, from the more general angle of future European procedure, made two comments:

1. The European Office could comprise two instances, the second being made up of independent technical and legal staff on the lines of a recent Swiss solution. In effect then the department of second instance would be an administrative court within the European Office. Such a solution would allow a compromise to be found. In the procedure at first instance, the examiner at the Office would decide on the inventive level, but the inventor could appeal to
2. The concept of inventive level was better defined in countries with preliminary examination. The reason was that in those countries, patent offices took many more decisions on this point than were taken by courts in revocation proceedings in other countries.

3. The concept of inventive level was an objective concept like that of morality. In both cases, there could ultimately only be one solution.

4. Even if the Convention did not incorporate the concept of inventive level, examiners from countries with preliminary examination would certainly apply it. They would find it difficult to grant a patent for an invention failing to satisfy this criterion.

5. It would certainly be simpler not to incorporate the concept of inventive level in the Convention. But then Germany and the Netherlands would find it difficult to ratify the Convention. It would also give rise to the risk of real legal uncertainty pending the development of case law.

6. Interested circles in the six States wanted the European patent to give them a maximum of certainty. Therefore the criterion of inventive level had to be used.

7. The fact that the concept of inventive level was not common to all the national laws would not cause any major problems since an inventor who failed to obtain a European patent could apply for a national patent.

8. An objection to the evaluation of inventive level by the courts was that the inventor's competitors would be obliged to challenge the existence of inventive level by means of very costly revocation proceedings and this could damage the reputation of the European patent. Furthermore in Germany, where the concept was
Mr. Fressonnet felt that it was desirable to discuss first of all whether or not the concept of inventive level should be included in the European Convention. He added that the trend in France was moving towards that concept (Roubier). Some people, though, thought that it was too subjective a criterion.

Mr. van Benthem declared that the Netherlands would find it difficult to accept the grant of a European patent having no regard to inventive level. An exclusive right could not be granted for inventions which were already common property because they were part of the state of the art.

Mr. De Muyser emphasised the general trend of the Convention to lay down strict criteria for the grant of European patents and said that the introduction of the concept of inventive level was in line with that trend.

Mr. De Reuse pointed out that under Belgium law, this notion was, in part, contained in the concept of invention itself. He also felt that the criterion involved some risk of subjectivity.

Mr. Roscioni was in favour of the criterion of inventive level but feared difficulties in defining the concept. He suggested that it be left to the courts.

Mr. Pfanner endorsed Mr. van Benthem's comments and emphasised that, under German law, the concept of "Erfindungshöhe" did not necessarily involve creative effort (flash of genius) on the part of the inventor. It was enough if he broke new ground and applied some intellectual activity.

The Chairman summarised the discussion as follows:

1. Opinions in the Member States differed somewhat on this point but the Gajac study showed that there was general opposition to granting a patent for something that went beyond the state of the art but that any person skilled in the art could have found. There was therefore a certain consensus on this point.
The Working Party adjourned this question until its next meeting to allow time for contacts with interested circles and also to take account of the outcome of the next meeting of the Committee of Experts of the Council of Europe.

Discussion of Article 16 of the Preliminary Draft

The Chairman reminded the Working Party of its mandate from the Co-ordinating Committee in this respect. The Working Party was to examine whether the concept of "inventive step" should be incorporated in the European Convention, and if so, whether it should be defined.

The Chairman pointed out that there had already been two attempts to define it, one in Article 16, the other in Article 14 (second variant, paragraph 1) of the Preliminary Draft.

The difference between the two definitions lay in the words "substantially" ("essentiellement", "merklich") on the one hand and "was obvious" ("allait de soi", "nahe lag") on the other. That difference was not between a subjective concept and an objective concept but between a quantitative criterion and a qualitative criterion.

The aim of the proposed criterion in Article 16 was to protect an invention by a patent on condition that it involved inventive step (qualitative characteristic). The aim of the wording of Article 14, second variant, paragraph 1, (Nordic draft) on the other hand was to grant a patent for an invention on condition that it was at a certain remove from the state of the art (quantitative characteristic). It was quite conceivable, for example, that a new invention, involving only a slight change in the state of the art, could nevertheless constitute a genuine inventive step although not being at a sufficient remove from the state of the art to satisfy the Nordic criterion. The patentability position would therefore differ under the two systems.
Proceedings of the 1st meeting of the
Patents Working Party held at
Brussels from 17 to 28 April 1961
Article 16
Inventive Step

A European patent shall not be granted even where the invention is considered to be new within the meaning of Article 14, if the invention does not involve an inventive step, particularly by virtue of the fact that, for a man skilled in the art, its realisation flowed obviously from the state of the art.

Notes:

1. The Working Party agreed unanimously that the requirement of inventive step should be used as a condition for the validity of a European patent.

2. The Working Party also agreed unanimously that such a requirement should be expressed in the text of the European Convention.

3. The Working Party agreed unanimously that the requirement of inventive step in the text of the Convention should be expressed in the form set out in Article 16 above.

4. (a) The majority of the Working Party thought that evaluation of the requirement of inventive step should be a matter for the European Office during the procedure for the grant of the European patent.

    (b) Some members of the Working Party were in favour of a system leaving evaluation of the requirement to a judicial body after grant of the patent.

    Very strong reservations were expressed concerning that proposal by many delegations which argued that an inter partes procedure is long and onerous and would leave the European patent in a position of permanent uncertainty.

5. The majority of the Working Party expressed the opinion that even if the requirement of inventive step were not expressed in the text of the Convention, the European Patent Office could not dispense with an evaluation of that requirement during the examination procedure.
Proceedings of the 1st meeting
of the Patents Working Party
held at Brussels from 17 to
28 April 1961
The Working Party approved the proposal but Mr. van Benthem and Mr. Pfanner regretted the disappearance of the term "person skilled in the art".

The Chairman replied that that concept would certainly be taken into account in the Office's case-law.

The comments on Article 16 were deleted. They will appear in the statement of grounds.
PATENTS WORKING PARTY

Meeting from 2 to 19 April 1962

Provisional Minutes of the meeting on 18 April 1962

The Chairman reopened the meeting at 09.45 hrs. He stated that the minutes as from 13 April 1962 would be deemed to have been approved if no requests for corrections were received by the Secretariat before 28 April 1962. The time limit for the last minutes, which were to be sent to delegates after the meeting, would be extended accordingly.

Article 15 (continued)

The Chairman pointed out that sub-paragraph (b) was in conformity with the corresponding provisions of the Strasbourg draft.

Mr. van Benthem wondered whether they should not extend protection for exhibition at an international exhibition so as to grant a priority right.

After some discussion, the Working Party decided that the Drafting Committee should re-examine the text of Article 15 in the light of the corresponding article of the Strasbourg draft.

It would also draw up a footnote that some of the delegations would approve the text of Article 15 only if a similar rule was accepted within the Council of Europe.

The text could be revised after the September meeting of the Council of Europe in Strasbourg.

Article 15 was referred to the Drafting Committee.

Article 16

Mr. Fressonnet proposed that they adopt the wording of the Strasbourg draft (Article 4).

The Chairman noted that that text did not modify the principles of Article 16 but merely gave the Officer wider powers of interpretation.
Proceedings of the 5th meeting
of the Patents Working Party
held at Brussels
from 2 to 18 April 1962
Article 13 (16)
Inventive step

A European patent shall not be granted even where the invention is considered to be new within the meaning of Article 11, if the invention does not involve an inventive step, particularly because it is obvious from the state of the art.
VE MAY 1962
PRELIMINARY DRAFT CONVENTION
RELATING TO A
EUROPEAN PATENT LAW
The article was adopted and referred to the Drafting Committee which was to ensure that the wording of the article was similar to that of Article 4 of the Strasbourg Draft.
the Working Party decided to allow the conversion of the European application or provisional European patent until the latter was confirmed. The effect of the proposal was to provide that prior national rights formed part of the state of the art and thus destroyed novelty. Consequently the provisional European patent would have to be revoked by the Examining Division of the European Patent Office if a prior national right existed in any one Contracting State. In that case the proprietor of the provisional European patent would be able to convert the provisional European patent into national applications in those Contracting States where no prior right existed. Moreover, under the German proposal, Article 19(20a), paragraph 1, was confined to the definitive European patent and revocation proceedings under Article 126(122) were excluded when they were based on the existence of prior national rights if the previous patent application or specification had been published by the competent authority of one of the Contracting States.

Mr. Fressonnet and Mr. van Benthem said that, having regard to those explanations, they preferred the previous solution under which prior national rights did not form part of the state of the art and the European patent had no effect in Contracting States where a prior national right existed.

A long debate followed after which the Chairman stated that the two solutions were feasible. The new German proposal laid down emphasis on the territorial unity of the European patent. The solution advocated by the French and Netherlands delegations, on the other hand, stressed the advantages of a European patent over different national patents. An automatic result of the new German proposal would be the conversion of a number of European patents into national patents.

In conclusion, the Working Party retained the wording of the Preliminary Draft (Doc. 4488).

The article was adopted as it stood and the note was deleted.

Article 13(16)

The Working Party compared the text of Article 13 with that of Article 4 of the Strasbourg Draft. It then decided to delete the word "particularly" from the wording of the Preliminary Draft.
next meeting of the Council of Europe Committee of Experts, Mr. van Benthem wanted to know the views of the other delegations on a possible proposal for incorporating a stricter rule in the Council of Europe Draft. He pointed out that the Strasbourg Draft left the States free to give their nationals wider protection. In other words, should the minimum protection rule be transformed into that of maximum protection?

Mr. De Muyser and Mr. Degavre were prepared to accept such a proposal in order to guarantee inventors greater legal certainty.

Mr. Pfanner thought that, having regard to its discussions with interested circles, the German delegation would not be able to accept such a proposal in Strasbourg.

The Chairman said that, as set out in the Council of Europe Draft, the proposal gave rise to some legal uncertainty. But that uncertainty existed only for inventors from countries that gave wider protection than the minimum protection under the Draft.

Article 12 was adopted.

Article 13(16).

Discussion was postponed until the French delegation arrived in order to decide whether the word "particularly" should be retained even though the Strasbourg Draft was worded differently.

Article 14(13)

Mr. van Benthem explained that Article 14 followed the principle of the Strasbourg Draft but was more explicit. That was in fact why the Netherlands delegation was proposing that the Strasbourg Draft adopt the wording of the European Convention.
Proceedings of the 6th meeting
of the Patents Working Party
held at Munich
from 13 to 23 June 1962
Article 13. Inventive step
An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art.

Article 14. Industrial application
An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

CHAPTER II—RIGHT TO THE PATENT

Article 15. Right to obtain a European patent
(1) The right to a European patent shall belong to the inventor or his assignee.

(2) For the purposes of procedure before the European Patent Office, the person making the patent application shall be deemed to be entitled to exercise the right referred to in paragraph 1.

Article 16. Obtaining
(1) If the essential elements of a patent application or of a European patent have been unlawfully obtained from the invention of another, the person injured by such obtaining may request that the application or the patent be assigned to him.

(2) After a period of five years from the date of the grant of the provisional European patent, the right referred to in paragraph 1 may no longer be exercised, except in a case where the proprietor of the patent acquired the patent in bad faith.

(3) As from the date of the notification to the European Patent Office that an action under paragraph 1 has been brought, the proprietor of the provisional European patent may not surrender the patent save with the consent of the person who has brought the action.

(4) If an action has been brought under paragraph 1 the European Patent Office shall stay the proceedings for confirmation of the provisional European patent, unless the person having brought the action consents to their continuation; such consent shall be irrevocable.

(5) If a final decision is given in favour of a person who has brought an action under paragraph 1, that person may, within a period of three months following the final decision, file a new application in respect of the same invention, the application being deemed to have been filed on the date of the earlier application. The earlier application for a European patent shall be deemed to have been withdrawn and any provisional European patent shall be deemed to have lapsed once the injured party has filed a new application.

(6) Following the final decision, any proceedings for confirmation of the provisional European patent stayed under the terms of paragraph 4, shall be resumed. However, if the decision is in favour of the person who has brought
Translation of a Draft Convention relating to a European Patent Law

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The Working Party discussed the concept of obviousness. It preferred the German word "naheliegender". The Dutch, French and Italian versions of the Convention were to translate the term as closely as possible. Article 13 was transmitted to the Drafting Committee which was to take the wording of the Strasbourg Draft into account.

Article 14

After reading the opinions of the international associations, the Working Party discussed UNICE's comments on the drafting regarding the term "in any kind of industry, including agriculture".

Mr. Fressonnet underlined the very broad meaning of the word "industry".

Mr. Pfanner added that the word even covered the army and the professions. The Chairman concluded by saying that the text would have to remain unchanged so as not to deviate from the Strasbourg Draft. Article 14 was transmitted to the Drafting Committee.
Mr. Fressonnet proposed that the purely practical reasons in support of the draft text should be put forward at the meeting to be held with UNICE and possibly other international organisations.

In conclusion, the Chairman noted that the Working Party did not want to take a final decision. He recorded the views of the Working Party that the UNICE proposal was impractical and that of Mr. van Benthem unsuitable. There remained the compromise proposal and the current text.

Mr. Pfanner was asked to draw up a draft text incorporating his proposal. The Working Party would look at the question of the meeting with UNICE on Friday.

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Article 12

Mr. Froschmaier read the opinions of the international associations. UNICE and UNION opposed Article 12. The Scandinavian draft on the other hand was substantially the same. After some discussion, the Working Party concluded that the text should be retained in the Preliminary Draft since a corresponding obligation was contained in the Strasbourg Draft.

At the instigation of Mr. Pfanner, the text was transmitted to the Drafting Committee which was to take account of the corresponding provision in the Strasbourg Draft.

Article 13

Mr. Froschmaier read the opinions of the international associations.
Proceedings of the 10th meeting of the Patents Working Party held at Brussels from 16 to 27 September 1963

MINUTES
The Chairman recognised that the German proposal would in fact complicate the practical problem of the examination for inventive step but he stressed that the compromise proposal would probably help to overcome the interested circles' opposition to paragraph 3 of Article 11. The proposal thus had real tactical advantages and he thought it should be accepted.

The Working Party then discussed the German delegation's proposal. The Netherlands delegation gave it its full support while the French delegation reserved its position until it had consulted the interested circles. If the latter said that they were not satisfied with the new proposal, the French delegation would then support the text in the Preliminary Draft. The Belgian, German and Italian delegations adopted similar positions.

The Working Party finally decided that the Drafting Committee should insert the wording of the German proposal in Article 13. It would appear in brackets and a footnote would state that the Working Party reserved its final position on the matter.

The German delegation, with the assistance of the Netherlands delegation, would draft a summary of arguments supporting the compromise proposal to help the other delegations in their technical appreciation of this very difficult question.
content of specifications of European patents filed prior to and published on or after the date of filing of a subsequent European patent application was considered to be comprised in the state of the art.

Mr. Pfanner said that the Working Party had to choose between two possible solutions to the problem of prior rights: duplicated patenting or recourse to this legal fiction. He summarised the cogent reasons for the Working Party's choice of the legal fiction. His delegation was sure that that decision was right and in looking for a compromise solution had retained the principle of a legal fiction but had tried to adapt it to meet the arguments of the interested circles. The proposal was to provide that inventive step would be considered first with regard to the state of the art on the date of filing the European application and then with regard to each prior European right individually.

That solution was more favourable to the later application. Under that system it would be easier to hold that the later application involved an inventive step.

Mr. Pfanner gave an example to illustrate his proposal. The later invention concerned a process for producing tetracyclin by pressure means (50 atmospheres). An unpublished prior application had been filed for a process for producing tetracyclin by means other than pressure. The known state of the art contained various inventions for producing products similar to tetracyclin by pressure means.

According to the text of Article 11, paragraph 3, in the Preliminary Draft (fiction that the state of the art = state of the art including prior European rights), the later invention would not involve an inventive step.

Under the German delegation's proposal, it was possible to recognise that the later invention involved an inventive step. The known state of the art was confined to the pressure means. But the prior right related only to the production of tetracyclin by another process. It was therefore possible for the examiner to consider that the application of that process to the production of tetracyclin involved an inventive step.
Prior European rights - Articles 11 to 13

The Working Party then went on to discuss the third item on the agenda concerning a German proposal for Article 11, paragraph 3, and Article 13 with regard to prior European rights.

The German delegation's proposal was contained in document 9662.

Mr. Pfanner introduced his delegation's proposal. He emphasised that the proposal was submitted by way of a compromise in order to answer the almost unanimous opposition from the interested circles to the wording of Article 11, paragraph 3. That Article instituted a legal fiction that the
Proceedings of the 15th meeting of the Patents Working Party held at Brussels from 19 to 26 October 1964

MINUTES
Article 13
Inventive step

An invention shall be considered as involving an inventive step if it is not obvious from the state of the art. If the state of the art includes documents referred to in Article 11, paragraph 3, the assessment of inventive step shall take account of each of those documents with the state of the art relating thereto, but excluding the rest of the state of the art.

Note
The Working Party has not yet decided whether to add the words in brackets to Article 13. That question will have to be re-examined. See also the note under Article 11.
Amendments to the Preliminary Draft Convention relating to a European Patent Law

(Articles 1 to 175)

This document replaces document 11.155/IV/64-E of 2 October 1964 (Articles 1 to 103)
Certain delegations observed, however, that the system proposed by the Netherlands delegation would give rise to difficulties connected with the fact that several prior rights having different contents could be made the subject of opposition proceedings in different countries.

The Netherlands delegation was invited to consider the procedural provisions which could be adopted later in the event of a solution less restrictive than that laid down in paragraph 4 being decided upon.

**Article 12 - Non-prejudicial disclosures**

27. Article 12 corresponds to Article 4, paragraph 4 of the 1963 Strasbourg Convention.

**Article 13 - Inventive step**

28. The matter referred to in Article 13 is the subject of Article 5 of the Strasbourg Convention, which leaves to the Signatory States the option of totally or partially excluding the earlier application in deciding whether there has been an inventive step.

The Working Party was unable to reach a joint position on the second sentence of Article 13, for which it has provisionally accepted two variants.

**Article 14 - Industrial application**

29. Article 14 corresponds to Article 3 of the 1963 Strasbourg Convention.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 25 July 1969
BR/6/69

- Secretariat -

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

Articles 1 to 41

prepared by Working Party I
(8 to 11 July 1969)

compared synoptically with

- the 1965 version of the Draft Convention as established by the EEC "Patents" Working Party and

- the Draft of an open European Patent Convention drawn up by the Member States of the European Free Trade Association

BR/6 e/69 mk
INTER-GOVERNMENTAL CONFERENCE  Brussels, 29 July 1969
FOR THE SETTING UP OF A EUROPEAN SYSTEM BR/7/69
FOR THE GRANT OF PATENTS

- Secretariat -

MINUTES

of the meeting of Working Party I
(Luxembourg, 8 - 11 July 1969)

I

1. The first working meeting of Working Party I, set up by the Conference, was held at Luxembourg from Tuesday 8 to Friday 11 July 1969.

In accordance with the decision taken by the Working Party at its inaugural meeting held at Brussels on 21 May 1969, the Chair was taken by Dr. HAERTEL, President of the German Patent Office.

In addition to the Commission of the European Communities, the following inter-governmental organisations, which had been invited to take part in the work of the Working Party, were represented: BIRPI, the General Secretariat of the Council of Europe and the International Patent Institute (1).

(1) See annexed list of participants in the meeting of the Working Party.
### Article 13
#### Inventive step

<table>
<thead>
<tr>
<th>1965 Draft</th>
<th>Working Party text</th>
<th>EFTA Draft</th>
</tr>
</thead>
</table>
| An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. \(\text{If the state of the art also includes documents within the meaning of Article 11, paragraph 3, each of these documents is to be considered, together with the state of the art relating to it, but excluding other parts of the state of the art, in deciding whether there has been an inventive step.}\) | 1st variant
An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step. | + |
| 2nd variant
An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, each of these documents is to be considered separately in deciding whether there has been an inventive step. | |

**Note**
The working party has not yet decided whether to include the sentence in brackets in Article 13. The need for it is to be examined further.

**Note:**
The first sentence of Article 13 corresponds to the first sentence of Article 5 of the Strasbourg Convention.
16. The Conference provisionally retained the two variants under Article 13 for the purpose of consultations with the interested circles.

17. The Swedish delegation wished to see a requirement laid down in Article 17 for applicants to mention the inventor as such upon filing the application, and for failure to do so to incur a penalty, which could be fixed in the Implementing Regulations.

The Netherlands delegation, on the other hand, was opposed to laying down such a penalty.

The French delegation pointed out that the obligation to mention the inventor as such went beyond the provisions of the Paris Convention.

III

Articles 31 to 41

The European Patent Office – Status and general organisation

(Report by the French delegation: BR/17/69)

18. The Conference noted that the proposals by the British delegation on Branch Examining Offices were to be examined by Working Party I at a later date. The Working Party in particular have to study their financial and administrative implications, and the proposals would be discussed at a future meeting of the Conference.

BR/26 e/70 ke1/PA/mk

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

- Secretariat -

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.

(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

.../...
(4) Le paragraphe 3 n’est applicable que lorsqu’un État contractant désigné dans la demande de brevet ultérieure l’était également dans la demande antérieure, telle que publiée en vertu de l’article 85.

Bemerkung zu Artikel 11, Absatz 4:
Es wurde beschlossen, später zu prüfen, welche Folgenungen aus diesem Absatz hinsichtlich der in beiden Anmeldungen benannten Staaten zu ziehen sind; in Betracht kommt eine Teilung der europäischen Patentanmeldung und/oder einer Umwandlung in nationale Anmeldungen.

Note to Article 11 (4)
It is agreed to examine later the consequences to be drawn from this paragraph as to the possible division of the European patent application and/or its conversion to national applications in respect of States designated in both applications.

Remarque concernant l’article 11, paragraphe 4 :
Il a été convenu d’examiner ultérieurement les conséquences à tirer de ce paragraphe en ce qui concerne les États désignés dans les deux demandes; pourront être prises en considération la division éventuelle de la demande de brevet européen et/ou sa transformation en demandes nationales.

Article 12
Divulgations inopposables
Une divulgation de l’invention au sens de l’article 11 n’est pas prise en considération si elle est intervenue dans les six mois précédant le dépôt de la demande de brevet européen et si elle résulte directement ou indirectement :

a) d’un abus évident à l’égard du demandeur ou de son prédécesseur en droit;

b) du fait que le demandeur ou son prédécesseur en droit a exposé l’invention dans des expositions officielles ou officiellement reconnues, au sens de la Convention concernant les expositions internationales, signée à Paris le 22 novembre 1928 et modifiée le 10 mai 1948.

Bemerkung zu Artikel 12:
Artikel 12 entspricht Artikel 4 Abs. 4 des Straßburger Übereinkommens.

Note to Article 12
Article 12 corresponds to Article 4, paragraph 4, of the Strasbourg Convention.

Remarque concernant l’article 12 :
L’article 12 correspond à l’article 4, paragraphe 4, de la Convention de Strasbourg.

Article 13
Activité inventive

1ère variante
Une invention est considérée comme impliquant une activité inventive si elle ne découle pas d’une manière évidente de l’état de la technique. Si l’état de la technique comprend des documents visés à l’article 11, paragraphe 3, ils ne sont pas pris en considération pour l’appréciation de l’activité inventive.

2ème variante
Une invention est considérée comme impliquant une activité inventive si elle ne découle pas d’une manière évidente de l’état de la technique. Si l’état de la technique comprend des documents visés à l’article 11, paragraphe 3, chacun de ces documents doit être pris en considération séparément pour l’appréciation de l’activité inventive.

Bemerkung zu Artikel 13:
Artikel 13 Satz 1 in beiden Fassungen entspricht Artikel 5 Satz 1 des Straßburger Übereinkommens.

Note to Article 13
The first sentence in each variant corresponds to the first sentence of Article 5 of the Strasbourg Convention.

Remarque concernant l’article 13 :
L’article 13 première phrase, dans ses deux variantes, correspond à la première phrase de l’article 5 de la Convention de Strasbourg.
Artikel 12
Unschädliche Offenbarungen

Eine Offenbarung der Erfindung im Sinne des Artikels 11 bleibt außer Betracht, wenn die Offenbarung innerhalb von sechs Monaten vor Einreichung der europäischen Patentanmeldung erfolgt ist und unmittelbar oder mittelbar zurückgeht:

a) auf einen offensichtlichen Mißbrauch zum Nachteil des Anmelders oder seines Rechtsvorgängers oder


Artikel 13
Erfinderische Tätigkeit

1. Fassung
Eine Erfindung gilt als auf einer erforderlichen Tätigkeit beruhend, wenn sie sich nicht in naheliegender Weise aus dem Stand der Technik ergibt. Gehören zu dem Stand der Technik auch Unterlagen im Sinne des Artikels 11 Absatz 3, so werden diese bei der Beurteilung der erforderlichen Tätigkeit nicht in Betracht gezogen.

2. Fassung
Eine Erfindung gilt als auf einer erforderlichen Tätigkeit beruhend, wenn sie sich nicht in naheliegender Weise aus dem Stand der Technik ergibt. Gehören zu dem Stand der Technik auch Unterlagen im Sinne des Artikels 11 Absatz 3, so ist bei der Beurteilung der erforderlichen Tätigkeit jede dieser Unterlagen gesondert in Betracht zu ziehen.

(4) Paragraph 3 shall be applied only when a Contracting State designated in respect of the later patent application was also designated in respect of the earlier patent application as published under Article 85.

Artikel 12
Non-prejudicial disclosures

A disclosure of the invention within the meaning of Article 11 shall not be taken into consideration if it occurred within six months preceding the filing of the application for a European patent and if it was due to, or in consequence of:

(a) an evident abuse in relation to the applicant or his predecessor in title, or

(b) the fact that the applicant or his predecessor in title has displayed the invention at official, or officially recognised, exhibitions falling within the terms of the Convention relating to international exhibitions signed at Paris on 22 November 1928 and revised on 10 May 1948.

Artikel 13
Inventive step

1st variant
An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

2nd variant
An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, each of these documents is to be considered separately in deciding whether there has been an inventive step.
ERSTER VORENTWURF EINES ÜBEREINKOMMENS ÜBER EIN EUROPÄISCHES PATENTERTeilungsVERFAHREN

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

PREMIER AVANT-PROJET DE CONVENTION INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS
104. The Working Party reached the provisional conclusion that it was not necessary to lay down, in the Convention, any provision to give effect to Article 45, paragraph 2, of the PCT, as the latter Article seemed to be sufficient on its own. Should the need arise, this matter can be re-examined later.

Article 13: Inventive step (BR/40/70, page 4, No. 11)

105. In accordance with the provisional decision of the Conference, the Working Party deleted the second variant of Article 13 of the First Preliminary Draft. It was agreed that the deletion of this variant means that paragraph 5 of Article 21 must be re-examined.

106. The Working Party reserved the right to re-examine the need to harmonise the PCT and the Convention texts where this Article is concerned.

Article 66 (former Article 68): Filing of the application (BR/40/70, page 5, No. 15 paragraph 1)

107. For the new paragraph 4, the Working Party adopted the text of Article 3, paragraph 3, of the PCT.

Article 79 (former Article 78): Obtaining of report on the state of the art (BR/40/70, page 7, No. 20, paragraph 2, (ii)).

108. The Working Party inserted the sentence between brackets in Article 79, paragraph 3 as a result of the amendment made to Article 66.

In this connection, the IIB representative pointed out that, as it is simply a question of verifying the abstract supplied by the applicant, the cost of this operation would be $10.
MINUTES

of the meeting of Working Party I

Luxembourg, 7 - 11 September 1970

Agenda item 1 (1): Opening of the meeting and adoption of the provisional agenda

1. The fifth working meeting of Working Party I was held at Luxembourg from Monday 7 to Friday 11 September 1970, with Dr. HAERTEL, President of the German Patent Office, in the Chair.

Representatives of the Commission of the European Communities, WIPO-BIRPI and the International Patent Institute took part in the meeting (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.B. van BENTHEM, held its meetings directly after the meetings of the Working Party.

(1) See Annex I for provisional agenda (BR/GT 1/51/70).
(2) See Annex II for list of those attending the meeting of the Working Party.

BR/49 e/70 ela/PA/bcc

.../...
PART II
SUBSTANTIVE PATENT LAW
CHAPTER I
PATENTABILITY
Article 13
Inventive step

Text drawn up by the Working Party

2nd variant
- deleted -

Note:
The deletion of the 2nd variant means that paragraph 5 of Article 21 must be re-examined.

BR/48 e/70 cm
PART II

SUBSTANTIVE PATENT LAW

CHAPTER I

PATENTABILITY

Article 13

Inventive step

1970 Draft

1st variant

An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

2nd variant

An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, each of these documents is to be considered separately in deciding whether there has been an inventive step.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

- Secretariat -

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

Articles prepared by Working Party I

(7 to 11 September 1970)
44. Article 5: Persons entitled to apply for a European patent

The note was deleted in view of the new draft of Article 5.

45. Article 6: Simultaneous protection

The scope of this Article was extended to the provisional protection given by patent applications.

46. Article 13: Inventive step

In note 2 the Working Party reiterates the provisional nature of the decision taken by the Conference on the second sentence of Article 13.

47. Article 17: Right of the inventor to be mentioned as such

a) While studying this provision, the Working Party re-examined, on the basis of a note submitted by the Swedish delegation (BR/GT I/76/70), the general question of whether the Convention should make it obligatory for the applicant to name the inventor and of the effects this would then have on various articles of the Draft. In view of the relevant national legislation, the Working Party thought it not possible to incorporate such a rule in the Convention. It therefore confined itself to drawing up an obligation of this kind, to apply in cases where the legislation of a Contracting State designated in the application contains such a provision, by adopting a similar clause from the PCT without prejudice to the rules to be laid down in this respect in the second Convention. For this purpose, the Working Party added an Article 69a and a paragraph (g) to Article 77, paragraph 2.

BR/87 e/71 nan/BS/prk
CORRIGENDUM
to BR/87/71

Page 22, point 55, please read:

"55. Article 34, (5) : Languages

The Working Party found that the problem in question was settled by the wording of Article 19(4) of the First Preliminary Draft of a Convention".
Article 13
Inventive step

An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

Notes to Article 13:

1. The first sentence corresponds to the first sentence of Article 5 of the Strasbourg Convention.

2. The Inter-Governmental Conference has only provisionally adopted the rule laid down in Article 15, 2nd sentence.
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
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.

BR/94 e/71 aut/KM/prk
Article 9 - Patentable inventions

22. The Working Party agreed that Article 9, paragraph 2, of the First Preliminary Draft, which set out exceptions to patentability, should first and foremost be adapted to the corresponding provision of the Regulations under the PCT (Rule 39.1), although the regulations in question were not, in fact, identical. To this end it amended sub-paragraphs (a), (d) and (e) of paragraph 2 and placed the words "or animal" in sub-paragraph (e) as well as the whole of sub-paragraph (f) (mere presentations of information) and sub-paragraph (g) (computer programmes) between square brackets. The brackets serve to indicate that the Working Party still intends to continue its examination of these provisions.

23. Furthermore, the Working Party agreed that the re-drafted paragraph 2 would have to be discussed later with the interested circles.

Article 11 - Novelty

24. The Working Party thought there was no need to adapt Article 11, paragraph 2, to a corresponding PCT Regulation (Rule 64.1), which only referred to written disclosures.

Article 13 - Inventive step

25. The Working Party agreed to enlarge the first sentence of Article 13 by aligning it on Article 33, paragraph 3, of the PCT by addition of the words "to a person skilled in the art". The exact time at which the inventive step

BR/94 e/71 aut/KCI/prk .../...
MINUTES

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

1. The Working Party held its seventh meeting at Luxembourg from Tuesday 26 to Thursday 28 January 1971 with Dr. HAERTHEL, 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.

BR/94 e/71 son/KM/prk
Article 11
Nouveauté

(1) Une invention est considérée comme nouvelle si elle n'est pas comprise dans l'état de la technique.

(2) L'état de la technique est constitué par tout ce qui a été rendu accessible au public avant le jour du dépôt de la demande de brevet européen par une description écrite ou orale, un usage ou tout autre moyen.

(3) Est également considéré comme compris dans l'état de la technique le contenu de demandes de brevets européens antérieures, ayant fait l'objet d'une publication au jour mentionné au paragraphe 2 ou après ce jour.

(4) Le paragraphe 3 n'est applicable que lorsqu'un État contractant désigné dans la demande de brevet ultérieure l'était également dans la demande antérieure, telle que publiée en vertu de l'article 85.

Bemerkung zu Artikel 11 Absätze 1, 2 und 3:
Absätze 1, 2 und 3 entsprechen Artikel 4 Absätze 1, 2 und 3 des Straßburger Übereinkommens.

Note to Article 11, paragraphs 1, 2 and 3:
Paragraphs 1, 2 and 3 correspond to Article 4, paragraphs 1, 2 and 3 of the Strasbourg Convention.

Remarque concernant l'article 11, paragraphes 1, 2 et 3:
Les paragraphes 1, 2 et 3 correspondent aux paragraphes 1, 2 et 3 de l'article 4 de la Convention de Strasbourg.

Article 12
Divulgations inopposables

Une divulgation de l'invention au sens de l'article 11 n'est pas prise en considération si elle est intervenue dans les six mois précédant le dépôt de la demande de brevet européen et si elle résulte directement ou indirectement :

a) d'un abus évident à l'égard du demandeur ou de son prédécesseur en droit;

b) du fait que le demandeur ou son prédécesseur en droit a exposé l'invention dans des expositions officielles ou officiellement reconnues, au sens de la Convention concernant les expositions internationales, signée à Paris le 22 novembre 1928 et modifiée le 10 mai 1948.

Bemerkung zu Artikel 12:
Artikel 12 entspricht Artikel 4 Absatz 4 des Straßburger Übereinkommens.

Note to Article 12:
Article 12 corresponds to Article 4, paragraph 4, of the Strasbourg Convention.

Remarque concernant l'article 12:
L'article 12 correspond à l'article 4, paragraphe 4, de la Convention de Strasbourg.

Article 13
Activité inventive

Une invention est considérée comme impliquant une activité inventive si, pour un homme de métier, elle ne découle pas d'une manière évidente de l'état de la technique. Si l'état de la technique comprend des documents visés à l'article 11, paragraphe 3, ils ne sont pas pris en considération pour l'appréciation de l'activité inventive.

Bemerkung zu Artikel 13:
Artikel 13 Satz 1 entspricht inhaltlich Artikel 5 Satz 1 des Straßburger Übereinkommens.

Note to Article 13:
The first sentence corresponds in substance to the first sentence of Article 5 of the Strasbourg Convention.

Remarque concernant l'article 13:
L'article 13, première phrase, correspond en substance à la première phrase de l'article 5 de la Convention de Strasbourg.

Article 14
Application industrielle

Une invention est considérée comme susceptible d'application industrielle si son objet peut être fabriqué ou utilisé dans tout genre d'industrie, y compris l'agriculture.

Bemerkung zu Artikel 14:
Artikel 14 entspricht Artikel 3 des Straßburger Übereinkommens.

Note to Article 14:
Article 14 corresponds to Article 3 of the Strasbourg Convention.

Remarque concernant l'article 14:
L'article 14 correspond à l'article 3 de la Convention de Strasbourg.
**Artikel 11**
Neuheit

(1) Eine Erfindung gilt als neu, wenn sie nicht zum Stand der Technik gehört.

(2) Den Stand der Technik bildet alles, was vor dem Tag der Anmeldung der Erfindung zum europäischen Patent der Öffentlichkeit durch schriftliche oder mündliche Beschreibung, durch Benutzung oder in sonstiger Weise zugänglich gemacht worden ist.

(3) Als Stand der Technik gilt auch der Inhalt früherer europäischer Patentanmeldungen, die erst an oder nach dem in Absatz 2 genannten Tag veröffentlicht worden sind.

(4) Absatz 3 ist nur dann anzuwenden, wenn ein für die spätere Patentanmeldung benannter Vertragsstaat auch für die frühere gemäß Artikel 85 veröffentlichte Patentanmeldung benannt worden ist.

**Artikel 12**
Unschädliche Offenbarungen

Eine Offenbarung der Erfindung im Sinne des Artikels 11 bleibt außer Betracht, wenn die Offenbarung innerhalb von sechs Monaten vor Einreichung der europäischen Patentanmeldung erfolgt ist und unmittelbar oder mittelbar zurückgeht:

a) auf einen offensichtlichen Mißbrauch zum Nachteil des Anmelders oder seines Rechtsvorgängers oder


**Artikel 13**
Erfinderische Tätigkeit

Eine Erfindung gilt als auf einer erfinderischen Tätigkeit beruhend, wenn sie sich für den Fachmann nicht in naheliegender Weise aus dem Stand der Technik ergibt. Gebühren zu dem Stand der Technik auch Unterlagen im Sinne des Artikels 11 Absatz 3, so werden diese bei der Beurteilung der erfinderischen Tätigkeit nicht in Betracht gezogen.

**Artikel 14**
Gewerbliche Anwendbarkeit

Eine Erfindung gilt als gewerblich anwendbar, wenn ihr Gegenstand auf irgendeinem gewerblichen Gebiet ein- schließlich der Landwirtschaft hergestellt oder benutzt werden kann.

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**Article 11**
Novelty

(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing the application for a European patent.

(3) Additionally, the contents of earlier applications for European patents published on or after the date referred to in paragraph 2 shall be considered as comprised in the state of the art.

(4) Paragraph 3 shall be applied only when a Contracting State designated in respect of the later patent application was also designated in respect of the earlier patent application as published under Article 85.

**Article 12**
Non-prejudicial disclosures

A disclosure of the invention within the meaning of Article 11 shall not be taken into consideration if it occurred within six months preceding the filing of the application for a European patent and if it was due to, or in consequence of:

(a) an evident abuse in relation to the applicant or his predecessor in title, or

(b) the fact that the applicant or his predecessor in title has displayed the invention at official, or officially recognised, exhibitions falling within the terms of the Convention relating to international exhibitions signed at Paris on 22 November 1928 and revised on 10 May 1948.

**Article 13**
Inventive step

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

**Article 14**
Industrial application

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.
ZWEITER VORENTWURF EINES ÜBEREINKOMMENS ÜBER EIN EUROPÄISCHES PATENTERTEILUNGSVERFAHREN
sowie
ERSTER VORENTWURF EINER AUSFÜHRUNGSORDNUNG ZUM ÜBEREINKOMMEN ÜBER EIN EUROPÄISCHES PATENTERTEILUNGSVERFAHREN
und
ERSTER VORENTWURF EINER GEBÜHRENORDNUNG

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

SECOND AVANT-PROJET DE CONVENTION INSTITUANT UN
SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS
ainsi que
PREMIER AVANT-PROJET DE RÈGLEMENT D’EXÉCUTION DE LA CONVENTION
INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS
et
PREMIER AVANT-PROJET DE RÈGLEMENT RELATIF AUX TAXES

— 1971 —
that have not applied until the invention is completed. When applying the "whole contents" principle this could lead to unwieldy applications which would be difficult for competing industry and third parties to analyze and penetrate.

13. It has been observed that technical difficulties arise if the "whole contents" principle is differentially applied. Which point of time should be decisive in determining identity of applicants? Should an applicant — perhaps even after the date of application — be allowed to avoid a novelty hindrance by the purchase of somebody else's prior application?

14. In recent discussions among interested circles both sides of the argument have found support. During a recent meeting with the Nordic AIPPI groups there was a Danish proposal for a resolution against the present rule. This proposal was, however, withdrawn as a result of the discussion.
Anyway, certain patent agents - especially in Denmark - still claim difficulties in patent application drafting. They feel insecure in deciding how much to reveal since the description may have to contain material that may prove a hindrance to the applicant's own future applications. The agents' associations have also taken official action to initiate a change of law whereby applicant's own prior application should be excepted from the "whole contents" principle.

This initiative has so far been met by the following arguments. The difficulty claimed can only appear with regard to inventions that even with a liberal practice with regard of addition could not be considered to be developments of the first invention. From the point of view of the general public and the competing industry it remains an unjustified restriction to have to face patent monopolies which are not sufficiently separated with regard to inventive step. For this situation it is irrelevant whether the patents are granted to different persons or to the same person.

If applicant's own applications are not included there would be no equal treatment of applicants. By including extraneous material in patent applications, applicants could try to reserve certain fields of invention to themselves, although they have not yet achieved actual patentable results. This could appear unjust to other inventors.
invention is considered as a "development". Thus, a patent of addition may have a more general scope than that of the patent to which it relates. Practice is even more liberal than in case of the inventions being presented in the same application. A patent of addition may, e.g. contain further independent claims, whereas in one and the same application only one independent claim of a certain category is allowed.

9. As far as patent office practice is concerned we have not been able to find any negative effects of the "whole-content" principle applied also to prior applications from the same applicant. In practice, cases of "self collision" have occurred very rarely except in connection with certain transitory provisions which are here disregarded. Since patents of addition have assumed a specific substantive law importance one would expect the number of applications for such patents to have materially increased. However, this has not been the case. The number of applications for patents of addition have remained at the very low proportion of the total number of applications that existed under the old law, i.e. approximately 2.5%. In our opinion this is due to the overriding effects of the 18-months publication, by which an application anyway becomes an absolute novelty hindrance at an early stage.
5. In drafting a patent application an agent will have difficulty in deciding the detailing of the description. When an invention is part of a "complex of inventions", material leading to another invention may have to be included in order to give a full description. This material may become a novelty hindrance to the patenting of the other invention in its completed form.

6. In order to meet these objections certain legal and administrative rules have been provided.

7. Already in the law itself it is stated that applications filed on the same day do not constitute novelty hindrance against each other. An applicant may thus without detriment to himself file several applications on the same day, or divide an application. If an application contains material which does not pertain to the invention for which a patent is applied, that material may be kept secret regardless of the 18 months publication rule, if there are special reasons for this. This material will then not count as novelty hindrance in relation to a subsequent application.

8. By way of administrative regulations a liberal practice has been introduced with regard to patents of addition. If the relation to the main invention is acceptable from the point of view of unity of invention, the additional
condition that the later application is filed before the earlier application was made public. However, the applicant does not need to specify already at the time of application that it concerns a patent of addition, an application may at any time up to grant be changed to a patent of addition.

2. Already from the start the fact that an applicant's own earlier application is included in the state of the art - in relation to which inventive step is required - met with objections especially on the part of patent agents. The objections may be summarized as follows:

3. An applicant who files his first application nationally will be at a disadvantage as compared to a foreign applicant who claims multiple priorities. The foreign applicant will be able to draft his claims taking account of those subsequent improvements that are contained in the later priorities, and may thus obtain a main claim with a wider scope of protection. Traditionally this is not possible in a patent of addition.

4. The possibility of obtaining a patent of addition is dependent on an administrative decision in each case as to what constitute a "development". This does not give sufficient legal security for the protection of inventions that - from the point of view of inventors - in fact constitute further developments.
REPORT BY THE SWEDISH DELEGATION

concerning Article 11, paragraph 3

At the meeting of Working Party I in January 1971 the
Swedish delegation agreed to give a report on Scandinavian
experiences with regard to the rule on novelty and inventive
step that includes prior applications (the "whole contents"
principle) when applied to inventor's own earlier applications.

1. In the new Nordic patent laws the regulation contained
in Article 4, paragraph 3 of the Strasbourg Convention
applies generally, i.e. also in relation to applicant's
own prior applications. However, at the same time Article 5
of the Strasbourg Convention is applied in such a way that
an inventor may obtain a patent of addition on a development
of an invention patented through a prior application. A
patent of addition can be obtained if the later application
concerns a development of the earlier invention, and on
NOTE

The delegations to Working Party I will find attached a note submitted by the Swedish delegation on 4 October 1971, on Article 11, paragraph 3, of the Second Preliminary Draft of a Convention establishing a European System for the Grant of Patents.
documents as they stood on the priority date (description, claims, drawings), excluding any subsequent amendments or additions, would be considered. The Working Party also considered that this interpretation was sufficiently clearly implied in the text and that there was therefore no need to amend it before the interested circles had stated their position on the matter.

Article 20, paragraph 1 (Extent of the protection conferred by a European patent)

102. The German delegation pointed out that in the English text particularly and in the two other versions to a lesser extent, the wording of this provision was too narrow. The present text could indeed be interpreted so as to limit the protection to the literal content of the claims, excluding their substance. Moreover, the word "nevertheless" would seem to indicate that the description and drawings would only be used by way of exception. It proposed that the wording of paragraph 1 would be made more flexible if it were to read: "... shall be determined by the claims. The description and ...".

In opposition to this proposal, it was said that the text in question was aligned on a provision of the Strasbourg Convention and was the result of a compromise between, amongst others, the German and United Kingdom delegations, being part of a version that had been even more precisely worded than the version eventually adopted. It was also pointed out that the proposal would result in a provision of such a general nature as to render it more or less superfluous.

BR/135 e/71 ley/prk
Article 11, paragraph 3 (Novelty)

Article 13 (Inventive step)

101. In accordance with the undertaking that it had given at Working Party I's January 1971 meeting, the Swedish delegation submitted a report on the experience gained in the Scandinavian countries with regard to the rule on novelty and inventive step that includes prior applications in the state of the art (the "whole contents" principle) when applied to the inventor's own earlier applications. This report (BR/GT I/123/71) is contained in Annex III to these minutes.

The Working Party thank the Swedish delegation for its report, which it duly noted, and found that the conclusions to be drawn from it were in no way contrary to the solutions laid down in the Convention on this matter. It was stressed in particular that any special rules on "self collision" would imply a degree of discrimination against cases of collision between third parties, and that it would, moreover, be difficult to lay down objective criteria which would allow a clear distinction to be made between the two categories in such a way as to avoid any risk of distorting the system.

The Working Party were in agreement that the term "the contents of earlier applications for European patents" would have to be interpreted in the sense that the priority date would be decisive as regards anteriority and that only the
MINUTES

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

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

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

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

3. The Drafting Committee of Working Party I met first under the chairmanship of Mr. van BENTHEM, President of the Octrooiraad; and after his departure, that of Mr. LABRY, Embassy Counsellor at the Ministry of Foreign Affairs (France).
Article 13 (Inventive step)

42. The Conference decided to reject the proposal made by certain organisations (cf. BR/169/72, point 24) to include an interpretation of what should be considered as obvious to a person skilled in the art, taken from Rule 65.1 of the Regulations under the PCT. Such interpretation is unnecessary in a system under which jurisprudence will be developed by a single authority, the European Patent Office.

Article 15 (Right to the grant of a European patent)

43. One delegation proposed that the last sentence of paragraph 1 should be deleted. This provision does not, in fact, seem to be properly placed in Article 15, which governs a dispute among several persons claiming the right to the grant of a European patent. The earlier date of filing of the application is, on the contrary, a criterion of the validity of the latter, and it is self-evident in the present system that a subsequent application cannot result in the grant of a patent if its content has already been the subject of another application, even if the latter has not yet been published (Article 11).

Before taking a decision on this proposal, the Conference thought it preferable to instruct Working Party I to re-examine the problem.

44. The Swedish delegation expressed a reservation with regard to paragraph 2, pointing out that, in its opinion, the person making the patent application can be deemed to be entitled to exercise the right to the grant of a European patent only if he is expressly authorised by the inventor.
MINUTES

of the

5th Meeting of the Inter-Governmental Conference for the Setting up of a European System for the Grant of Patents

Parts 1 and 3

(Luxembourg, 24-25 January and 2-4 February 1972)
to apply only to the parts of the disclosure made in the previous application which tally with the disclosure made in the application on which priority was based.

Article 13 (Inventive step)

24. Three organisations (CNIPA, PICPI and UNEPA) proposed that Article 13 should be supplemented by a provision corresponding to the second sentence of Rule 65.1 of the PCT Regulations.

The ICC requested the deletion of the last sentence of Article 13, as a corollary to its drafting proposal for Article 11 (cf. BR/162/72, page 4). The same request was made by COFRICE.

Article 15 (Right to the grant of a European patent)

25. EIRMA had doubts about the scope of the last sentence in paragraph 1. In its view, if this provision were retained, it would be necessary to lay down that the application filed first should have been published. It would indeed be possible for such an application to be withdrawn before publication and still opposed to a new application at a later date. However, having regard to Article 11, paragraph 3, EIRMA wondered about the usefulness of this sentence.

Article 16 (Patent applications by persons not entitled to apply)

26. Certain organisations (ICC, EIRMA and UNICE) expressed their agreement to the text of Article 16 as contained in the 1971 Preliminary Draft. As regards the text proposed by Working Party I, contained in BR/139/71, these

BR/169 e/72 ett/AV/prk

.../...
MINUTES

of the

5th Meeting of the Inter-Governmental Conference
for the Setting up of a European System
for the Grant of Patents

Part II

Hearing of the non-governmental international organisations
on the Second Preliminary Draft of a Convention
establishing a European System for the
Grant of Patents

(Luxembourg, 26 January to 1 February 1972)
Article 13
Inventive step

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

Notes to Article 13:
1. The first sentence corresponds in substance to the first sentence of Article 5 of the Strasbourg Convention.
2. The Inter-Governmental Conference has only provisionally adopted the rule laid down in Article 13, 2nd sentence.
FIRST PRELIMINARY DRAFT OF A CONVENTION

ESTABLISHING

A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- Stage reached on 29 January 1971 -
It was also observed that if the expression "entire content" were used in Article 11, paragraph 3, applicants would be faced with difficulties as a result of earlier applications which they themselves might have filed. The Conference agreed with Working Party I that the text of Article 13 would alleviate such difficulties but that the question should be re-examined (see point 25, Article 21).

The Norwegian delegation stressed the importance of this problem. It said that in Article 13 it would like to provide the additional condition that "the applications should belong to the same applicant".
Article 11 (Novelty)

Article 12 (Inventive step)

17. The Conference approved the suggestions put forward by Working Party I to retain paragraphs 3 and 4 of Article 11. These provisions would have to be seen in the light of Article 137a, which allows for the filing of different claims for the designated States in which the contents of an earlier application are considered to be included in the state of the art.

The Conference took this decision bearing in mind that to a certain extent Article 137a meets the wishes expressed by the interested circles.

It should be noted that the expression "the contents of earlier applications for European patents" as used in Article 11, paragraph 3, is to be re-examined by Working Party I with a view to finding a clearer definition, if possible, of the term in question.


BR/125 e/71 ley/KM/prk
MINUTES

of the

4th Meeting of the Inter-Governmental Conference

for the setting up of a European System

for the Grant of Patents

(Luxembourg, 20 to 28 April 1971)
Gehören zu dem Stand der Technik auch Unterlagen im Sinn des Artikels 52 Absatz 3, so werden diese bei der Beurteilung der erfinderischen Tätigkeit nicht in Betracht gezogen.

Artikel 55
Gewerbliche Anwendbarkeit

Eine Erfindung gilt als gewerblich anwendbar, wenn ihr Gegenstand auf irgendeinem gewerblichen Gebiet einschließlich der Landwirtschaft hergestellt oder benutzt werden kann.

Kapitel II
Zur Einreichung und Erlangung des europäischen Patents berechtigte Personen – Erfindernennung

Artikel 56
Recht zur Anmeldung europäischer Patente

Jede natürliche oder juristische Person und jede einer juristischen Person nach dem für sie maßgebenden Recht gleichgestellte Gesellschaft kann die Erteilung eines europäischen Patents beantragen.

Artikel 57
Mehrere Anmelder

Die europäische Patentanmeldung kann auch von gemeinsamen Anmeldern oder von mehreren Anmeldern, die verschiedene Vertragsstaaten benennen, eingereicht werden.

Vgl. Regeln 26 (Erteilungsantrag) und 101 (Bestellung eines gemeinsamen Vertreters)

Artikel 58
Recht auf das europäische Patent


Anricht Art also includes documents within the meaning of Article 52, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

Article 55
Industrial application

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

Chapter II
Persons entitled to apply for and obtain European patents – Mention of the inventor

Article 56
Entitlement to file a European patent application

A European patent application may be filed by any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it.

Article 57
Multiple applicants

A European patent application may also be filed either by joint applicants or by two or more applicants designating different Contracting States.

Cf. Rules 26 (Request for grant) and 101 (Appointment of a common representative)

Article 58
Right to a European patent

(1) The right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee the right to the European patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has his place of business to which the employee is attached. If two or more persons have made an invention independently of each other, the right to the European patent shall belong to the person whose European patent application has the earliest date of filing; however, this provision shall apply only if this first application was published under Article 92 and shall only have effect in respect of the Contracting States designated in that application as published.
(2) Den Stand der Technik bildet alles, was vor dem Anmeldetag der europäischen Patentanmeldung der Öffentlichkeit durch schriftliche oder mündliche Beschreibung, durch Benutzung oder in sonstiger Weise zugänglich gemacht worden ist.

(3) Als Stand der Technik gilt auch der ursprüngliche Inhalt europäischer Patentanmeldungen, deren Anmeldetag vor dem in Absatz 2 genannten Tag liegt und die erst an oder nach diesem Tag nach Artikel 92 veröffentlicht worden sind.

(4) Absatz 3 ist nur anzuwenden, wenn ein für die spätere europäische Patentanmeldung benannter Vertragsstaat auch für die veröffentlichte frühere Anmeldung benannt worden ist.

(5) Die Absätze 1 bis 4 stehen der Patentierbarkeit der in Artikel 50 Absatz 3 genannten Stoffe oder Stoffgemische nicht entgegen, wenn selbst wenn die betreffenden Stoffe oder Stoffgemische zum Stand der Technik gehören, sofern der Stand der Technik eine Offenbarung dieser Stoffe oder Stoffgemische für irgendein in Artikel 50 Absatz 2 Buchstabe d genanntes Verfahren nicht einschließt.

Artikel 53
Unschädliche Offenbarungen

(1) Für die Anwendung des Artikels 52 bleibt eine Offenbarung der Erfindung außer Betracht, wenn sie innerhalb von sechs Monaten vor dem Anmeldetag der europäischen Patentanmeldung erfolgt ist und unmittelbar oder mittelbar zurückgeht:

a) auf einen offensichtlichen Mißbrauch zum Nachteil des Anmelders oder seines Rechtsvorgängers oder


(2) Absatz 1 ist im Fall des Buchstaben b nur anzuwenden, wenn der Anmelder bei Einreichung der europäischen Patentanmeldung angibt, daß die Erfindung zur Schau gestellt worden ist, und eine entsprechende Bescheinigung einreicht, für die die Form und die Frist zur Einreichung in der Ausführungsordnung vorgeschrieben sind.

Vgl. Regel 23 (Ausstellungsbescheinigung)

Artikel 54
Erfinderische Tätigkeit

Eine Erfindung gilt als auf einer erfinderischen Tätigkeit beruhend, wenn sie sich für den Fachmann nicht in naheliegender Weise aus dem Stand der Technik ergibt.

Article 53
Non-prejudicial disclosures

(1) For the application of Article 52 a disclosure of the invention shall not be taken into consideration if it occurred within six months preceding the date of filing of the European patent application and if it was due to, or in consequence of:

(a) an evident abuse in relation to the applicant or his legal predecessor, or

(b) the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognised, international exhibition falling within the terms of the Convention on international exhibitions signed at Paris on 22 November 1928 and amended on 10 May 1948 and 16 November 1966.

(2) In the case of paragraph 1(b), paragraph 1 shall apply only if the applicant states, when filing the European patent application, that the invention has been so displayed and files a supporting certificate within the period and under the conditions laid down in the Implementing Regulations.

Cf. Rule 23 (Certificate of exhibition)

Artikel 54
Erfinderische Tätigkeit

Eine Erfindung gilt als auf einer erfinderischen Tätigkeit beruhend, wenn sie sich für den Fachmann nicht in naheliegender Weise aus dem Stand der Technik ergibt.

Article 54
Inventive step

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the
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)

CONFÉRENCE 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
6 Artikel 50 Abs. 2, 50 Abs. 3 und 52 Abs. 5

Die in Artikel 50 Abs. 2 enthaltene Aufzählung ist recht zufriedenstellend und berücksichtigt die Vorschläge der interessierten Kreise. Artikel 50 Abs. 3 stellt eine nützliche Ergänzung des vorangehenden Absatzes dar.

7 Artikel 52 Abs. 5 könnte noch klarer gefaßt werden, damit deutlich wird, daß selbst eine spätere neue Anwendung eines Stoffes oder Stoffgemisches patentierbar ist.

8 Artikel 52 Abs. 3 und 54


Die Minderheit hebt hervor, daß die Anwendung des „prior claim approach“-Prinzips folgende Konsequenzen hat: Gehört zum Stand der Technik, der einer zweiten europäischen Patentanmeldung entgegengehalten wird, eine im Zeitpunkt der zweiten Anmeldung noch nicht veröffentlichte erste europäische Patentanmeldung, so kann dieser Stand der Technik mit Gewißheit erst bei der Erteilung des ersten europäischen Patents bestimmt werden, weil der Inhalt der Patentansprüche erst zu diesem Zeitpunkt definiert werden kann. Dies hat für den Anmelder des zweiten Patents und für Dritte eine Ungewißheit zur Folge, die mehrere Jahre lang andauern kann.

Durch die Anwendung der „whole content approach“-Regel entfällt dieser Nachteil, weil der Inhalt der ersten europäischen Patentanmeldung von der Einreichung dieser Anmeldung an feststeht.

6 Article 50, paragraphs 2 and 3 and Article 52, paragraph 5

The list given in Article 50, paragraph 2, is quite adequate and takes account of the suggestions made by the interested circles. Article 50, paragraph 3, constitutes a useful addition to the previous paragraph.

7 Article 52, paragraph 5, could be clarified even further so as to emphasise that even a further new use of a substance or composition may be patented.

8 Article 52, paragraph 3 and Article 54

These clauses apply the “whole content approach” to the European patent. This approach requires there to be novelty but not an inventive step even with respect to European patent applications filed on a prior date, and even if they are secret. Apart from the practical difficulty of completely separating the principle of novelty from that of the inventive step, the majority of COPRICE considers that the “prior claim approach” is clearer and more equitable. This approach has been adopted in several laws which have recently entered into force, particularly in France. It represents a development which has taken place since the signing of the Strasbourg Convention. It is true that that Convention adopted the “whole content approach” but it is felt that subsequent developments which have led, instead, to the “prior claim approach” being adopted in several national laws could be applied in the European Convention.

A minority of COPRICE point out that the application of the “prior claim approach” would have the effect that if a second European patent application is opposed on the grounds of the state of the art and the latter comprises a first European patent application which had not been published upon the date of the second application, the state of the art can only be defined with certainty when the first European patent is granted since it is only then that the terms of the claims can be defined. This will give rise to uncertainty, which could last over several years, on the part of the applicant for the second patent and on the part of third parties.

This difficulty is removed by the application of the “whole content approach” since the content of the first European patent application is determined when the application is filed.

9 Artikel 67 Abs. 1

Der Inhalt dieses Artikels könnte klarer gefaßt werden.

9 Article 67, paragraph 1

This Article could be clarified by deleting the words
STELLUNGNAHME DES 
COPRICE

Comité pour la Protection de la propriété industrielle dans la 
Communauté économique européenne

COMMENTS BY 
COPRICE

Comité pour la Protection de la propriété industrielle dans la 
Communauté économique européenne

PRISE DE POSITION DU 
COPRICE

Comité pour la Protection de la propriété industrielle dans la 
Communauté économique européenne
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
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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

Artikel 67
13 Die Erklärung, die nationalen Gerichten als Leitlinie dienen soll und deren Annahme der Konferenz empfohlen wird, wird begrüßt.

Artikel 68 Absatz 3
14 Der englische und der französische Text weichen von der deutschen Fassung hinsichtlich der genauen Bedeutung des Wortes „enger“ ab.

Artikel 76 – Regel 29

16 In der deutschen Fassung werden die Worte „festzulegen“ und „Festlegung“ benutzt; sie sollten mit dem in Artikel 82 verwendeten Wort „angeben“ in Einklang gebracht werden.

Artikel 86 Absatz 1 – Regel 38 Absatz 2
17 Obgleich anerkannt ist, daß eine Priorität zum Zeitpunkt der Anmeldung beansprucht werden muß, besteht stets die Möglichkeit von Schreibfehlern bei der Angabe des Datums und des Landes. Diese werden möglicherweise erst bei der Einreichung der Prioritätsunterlage oder anläßlich der Formalprüfung beim Patentamt entdeckt. Angesichts der Regel 41 wird um Bestätigung darum gebeten, daß die Regel 89 auch für die Berichtigung solcher Fehler gilt.

Preliminary Examining Authority under Chapter II of PCT; it is desirable that, in the practice of examination at the European Patent Office, the criteria for inventive level be identical. It is recommended therefore that a new Rule be adopted (between Rules 23 and 24) equivalent to Rule 65 of PCT.

Article 67
13 The declaration, to be used by National Courts as a guideline and recommended for adoption by the Conference, is welcomed.

Article 68 (3)
14 The English and French texts differ from the German text in respect of the exact meaning of the word “enger”.

Article 76 – Rule 29
15 It is regretted that the use of the word “Wherever” in the English text implies strict rules for drafting claims. Although this word appears in Rule 6.3 of PCT, that Treaty allows redrafting of claim in the national phase to suit the national legislation of the country in which infringement will be determined. The applicant must have freedom to draft his claims with an eye to future infringement suits, if he is to be encouraged to use the European Patent System. The claim should define the extent of protection (Article 67). It is not the right place to define prior art, as is required by the Rule.

16 In the German text, the words “festzulegen” and “Festlegung” are used, but these should be reconciled with the word “angeben” appearing in Article 82.

Article 86 (1) – Rule 38 (2)
17 Although it is accepted that a claim to priority should be made at the date of filing, there always exists the possibility of clerical errors in date and country. This may only be discovered when the priority document is to be filed or upon formal examination at the Patent Office. In the light of Rule 41, confirmation is sought that Rule 89 is applicable to the correction of such errors.
Artikel 19 Absätze 3 und 4

8 Das unter den Buchstaben a dieser Absätze vorgesehene Erfordernis, wonach jede Beschwerdekammer von einem Berichterstatter unterstützt werden soll, dürfte in vielen Fällen nur zusätzliche Kosten verursachen und eine administrative Belastung darstellen. Es wird vorgeschlagen, das Erfordernis in eine fakultative Bestimmung umzuwandeln.

Sollte unser vorstehender Vorschlag angenommen werden, so müßten die Buchstaben a und b in einigen Punkten neu gefaßt werden, was zu einer Vereinfachung des Verfahrens führen würde.

Artikel 23

9 Dieses Übereinkommen betrifft die Erteilung von Patenten und nicht ihre Auslegung durch nationale Gerichte. Es wird deshalb beantragt, diese Bestimmung zu streichen, vor allem weil nicht klar ist, was mit dem Wort „technisch“ gemeint ist. Solche „technischen“ Gutachten könnten als Rechtsgutachten beispielsweise über Verletzungen angesehen werden.

Artikel 50 Absatz 2

10 Es wird nochmals der Wunsch geäußert, daß die unter den Buchstaben c, d und e vorgesehenen Ausnahmen in die Ausführungsvorschriften übernommen werden, damit die Entwicklung der Rechtsperspektive im Patentwesen auf weltweiter Ebene nicht durch die Schwierigkeiten behindert wird, die sich durch eine Änderung dieser Ausnahmen ergeben.

Artikel 50 Absatz 3

11 Es wird um die Bestätigung gebeten, daß es sich hierbei nicht um eine restriktive Bestimmung handelt, d.h. daß neue Stoffe oder Stoffgemische per se patentierbar bleiben.

Artikel 54

12 Da in Artikel 154 vorgesehen ist, daß das Europäische Patentamt als eine mit der internationalen
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
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

Die AIPPI stellt mit Befriedigung fest, daß in den der Konferenz unterbreiteten Texten einer großen Zahl von ihr geäußerten Wünsche entsprochen worden ist.

Sie gestattet sich jedoch, an einige ihrer Wünsche zu erinnern, denen nicht in der von ihr erhofften Weise stattgegeben wurde, obwohl ihnen ihres Erachtens große Bedeutung beizumessen ist.

2 Ihrer Ansicht nach sollten nichtveröffentlichte Unterlagen nicht zum Stand der Technik gehören und nur dann neuheitsschädlich sein, wenn sie nicht von ein und demselben Anmelder stammen. Da diese Bedingung nicht angenommen worden ist, rechnet die AIPPI darauf, daß die Beurteilung der alleinigen Neuheit gegenüber früheren Anmeldungen nicht im Wege der Auslegung ausgedehnt und daß der Schluß von Artikel 54 sehr streng angewendet wird.

3 AIPPI hätte gewünscht, daß ein supranationales Rechtsprechungsorgan eingesetzt wird; jedenfalls müßten ihres Erachtens, falls die Beschwerdekammer die Große Beschwerdekammer befindet, die Parteien, die keine Beschwerde eingeleitet haben, am Verfahren vor der Großen Beschwerdekammer beteiligt werden (Artikel 111 Absatz 1 Buchstabe a).

4 Die AIPPI ist nach wie vor der Ansicht, daß die Aufnahme eines Prüfers, dem die Sache bereits bekannt ist (Artikel 18 Absatz 2), in die Prüfungsabteilung allgemein anerkannten Grundsätzen widerspricht.

5 Schließlich erkennt die AIPPI zwar an, daß die in Artikel 166 vorgesehenen Vorbehalte zweckmäßig sind, um den Beitritt einer möglichst großen Zahl von Staaten zu bewirken, vertritt jedoch die Auffassung, daß ein Interesse daran besteht, die Dauer der zur Zeit auf 10 Jahre festgesetzten Übergangszeit zu verkürzen.

6 Die AIPPI behält sich schließlich die Möglichkeit vor, durch ihre Delegierten auf der Diplomatischen Konferenz weitere Bemerkungen nicht so grundlegender Natur vorzutragen.

1 With the convening of the Munich Diplomatic Conference in Autumn 1973, IAPIP welcomes the conclusion of several years' work for the setting up of a European patent system. It would express its gratitude for the invitation extended to it to attend the Conference.

It notes with satisfaction that a large number of the suggestions which it has put forward have been taken up in the texts submitted to the Conference.

It would however recall certain suggestions which have not been followed up as it had hoped, in spite of the importance which it attaches to them.

2 In its opinion, unpublished documents should not be comprised in the state of the art and should not be invoked against the current application except where they originate from different applicants. Since this condition has not been adopted IAPIP considers that the assessment of novelty alone in relation to prior applications will not be extended by way of interpretation and the result will be a strict application of the last part of Article 54.

3 IAPIP expressed the wish for a supra-national court to be set up, and now considers that in the absence of a right to appeal by the parties concerned, the latter should be able to take part in proceedings before the Enlarged Board of Appeal where a question has been referred to it by a Board of Appeal (Article 111, paragraph 1, sub-paragraph a).

4 It continues to feel that the inclusion in the Opposition Divisions of an examiner who is already familiar with the case (Article 18, paragraph 2) is contrary to generally accepted principles.

5 Finally, whilst recognising the desirability of the reservations laid down in Article 166 in order to enable as many States as possible to accede to the Convention, it considers that the length of the transitional period, at present fixed at 10 years, should be reduced.

6 IAPIP reserves the right to submit other comments of a less fundamental nature at the Diplomatic Conference through its delegates.
STELLUNGNAHME DER

AIPPI

Association Internationale pour la Protection
de la Propriété Industrielle

COMMENTS BY

IAPIP

International Association for the Protection
of Industrial Property

PRISE DE POSITION DE

L'AIPPI

Association internationale pour la protection
de la propriété industrielle
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN PATENTERTEILUNGSVERFAHRENS 1973
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1973
(2) If the applicant proves technological progress, this shall be considered in deciding whether there has been an inventive step.

**Article 104**

3. Under Swiss law, any person notified by the patent proprietor that he is infringing his patent may institute court proceedings for a ruling that he is not infringing the patent. As in the case of the defendant in infringement proceedings, any person notified by the patent proprietor that he is infringing the patent and who has instituted proceedings against the latter for a ruling that he is not infringing the patent should also be able to intervene in the opposition proceedings even after the opposition period has expired.

4. It is therefore proposed that Article 104, paragraph 1, be amended as follows:

(1) In the event of an opposition to a European patent being filed, any third party who proves that proceedings for infringement of the same patent have been instituted against him or any third party who proves that he has been notified by the proprietor of that patent that he is infringing the patent and that he has instituted proceedings against the proprietor for a court ruling that he is not infringing that patent, may ...

**Article 128**

5. Under paragraph 5, the European Patent Office may even before publication communicate certain data on the application, in particular as concerns the date of filing (item (b)). Communication of data on the date of filing without at the same time giving the date of any priority claim may be misleading for third parties.
I. Convention

1. Article 54

As in the case of the European Convention on the unification of certain points of substantive law on patents for invention, the present Draft Convention does not mention technological progress as a criterion of the patentability of an invention, which means that technological progress is not examined in the European patent grant procedure nor laid down as a condition for the grant of a patent. There should be some guarantee however that the absence of any reference in the Convention to technological progress will not be interpreted as meaning that where the applicant himself claims technological progress, this can in no event be considered in assessing the patentability of the invention. On the contrary, in examining whether the invention claimed involves an inventive step, account should be taken of any proof of technological progress which the applicant chooses to supply.

2. It is therefore proposed that Article 54 be supplemented by a second paragraph worded as follows:
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Brussels, 28 May 1973
M/31
Original: German/French

PREPARATORY DOCUMENT

Drawn up by: Swiss Government

Subject: Comments on the Convention establishing a European System for the Grant of Patents
Article 54

Proposal: Article 54 should be supplemented by a new paragraph 2 as follows:

"(2) If the applicant proves technological progress, this shall be considered in deciding whether there has been an inventive step".

Reason: Cf. M/31, No. 1
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 10 September 1973
M/54/I/II/III
Original: German

CONFERENCE DOCUMENT

Drawn up by: The Swiss delegation

Subject: Proposals for amendments to the draft texts
Article 34(b)
Inventive step

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 54, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.
CONFERECE DOCUMENT

Munich, 30 September 1973
M/146/R 3
Original: English/French/German

Drawn up by: General Drafting Committee

Subject: Convention: Articles 55 to 83
by the rightful inventor. The first application which was published within 6 months preceding the date of filing of the second application, does not, under the existing text of Article 53, paragraph 1(a), in conjunction with Article 52, form part of the state of the art. In the second, slightly different, example: the first, fraudulent application is filed on 1 January 1981 and published on 1 July 1982. On 1 October 1981 an application relating to the same subject-matter is filed by the rightful inventor. Thus, the wrongly filed application would not, as in the first example, have been published within six months preceding the date of filing of the application by the person rightfully entitled to do so, but afterwards. It would consequently not come under Article 53, paragraph 1(a), and its content would therefore form part of the state of the art. The Chairman continued by saying that the United Kingdom delegation did not seem to consider this result fair. In the cases covered by the second example it did not want the fraudulently filed application to form part of the state of the art.

64. The United Kingdom delegation confirmed that this was the aim of its proposal.

65. The Main Committee adopted the proposal which was seconded by the Netherlands delegation.

66. In this connection, the FICPI delegation raised the question of whether there was a provision in the Convention governing the fate of the earlier, fraudulently filed patent application:

67. The Netherlands delegation referred to Article 59 (61), paragraph 1(c), under the terms of which a person who has been declared the rightful proprietor of a European patent application by judgment of a national court, can request that the European patent application be refused.

68. The FICPI delegation deduced from the above that the person entitled to a European patent must, in any case, institute legal proceedings against the applicant who is not entitled to apply. If he did not do this, no action could be taken against the proprietor of the first application.

69. The Chairman was of the same opinion and considered that if the person entitled to apply did not institute legal proceedings, two patents would have to be granted for the same application.

70. The Finnish and Norwegian delegations suggested adding a new sub-paragraph (c) in paragraph 1 to the effect that it would be sufficient for the invention to have been displayed at an international exhibition which although it did not come under the 1928 Paris Convention, had been declared by the Government of the country organising the exhibition to be an exhibition to which the provisions of Article 53 (55), paragraph 1(b), were applicable (M/65/1; see also M/12, point 4). Both delegations pointed out that on the basis of the experience of the Scandinavian countries exhibitions which came under the 1928 Paris Convention were rare, so that no account was taken of inventors’ interests in their inventions being disclosed in a way which was not prejudicial to novelty. It therefore seemed appropriate to cover a wider range of exhibitions.

71. The French delegation was against this proposal for two reasons. Firstly, Article 53 (55) was an exception to Article 52 (54) which defined the novelty of an invention, and, since it was an exception, should not be extended. Secondly, such an extension would not be in the interests of inventors. Inventors should rather be advised to patent their inventions wherever possible before disclosing them in any way. For example, the law had also been amended in France some years ago so that only the display of inventions at world exhibitions, which admittedly were not very numerous, was non-prejudicial to novelty. This provision was binding as a result of the 1883 Paris Convention.

72. The United Kingdom delegation too did not wish to accept the proposal. It considered that there should be no departure from the definition of novelty and its exceptions found in the 1963 Strasbourg Convention. It was even doubtful whether this exception, which was based on the 1883 Paris Convention, was still appropriate in modern times.

73. The delegation of the Federal Republic of Germany said that, although it sympathised with the Scandinavian proposal, it could not depart from the 1963 Strasbourg Convention which had already been signed, so long as it did not wish to accept different principles for national law and for European law.

74. The Netherlands delegation agreed with the German point of view. It went further and described the proposed extension as being dangerous to the extent that inventors might be encouraged to display their inventions at exhibitions which later would perhaps not be recognised by some countries.

75. The Belgian delegation stated that, too, would have to reject the proposal for the reasons already mentioned by previous speakers. In addition, the experience gained at the world exhibition of 1958 had shown that virtually none of the inventors had taken advantage of the legal possibilities offered to them.

76. In view of these comments the Finnish and Norwegian delegations withdrew their proposal.

Article 54 (56) — Inventive step

77. The Swiss delegation pointed out that in conformity with the 1963 Convention on the Unification of Certain Points of Substantive Law on Patents for Invention the element of technical progress was not being made a requirement for the grant of a patent. Nor did the delegation want to question this principle. However, if the applicant, of his own accord, furnished proof that technical progress had been made, the delegation wished to see it ensured that this factor was considered in deciding whether there had been an inventive step. To this end, it proposed including a new paragraph 2 (M/31, points 1 and 2).

78. In the opinion of the Netherlands delegation technical progress should be considered in deciding whether an inventive step had been made; however, this was only one of many factors. The delegation therefore said that it was not in favour of the proposed addition.

79. The delegation of the International Chamber of Commerce feared that technical progress might, if specific mention were made of it, assume too much importance in the provision concerning the inventive step: this it did not consider to be right.

80. The UNION delegation saw the danger in the Swiss proposal that technical progress would have to be disclosed in the application, if it was to be considered in deciding whether there had been an inventive step.

81. The United Kingdom delegation was not in favour of the Swiss proposal for reasons similar to those of the Netherlands delegation.

82. The IFIA delegation proposed making the concept of inventive step as objective as possible in the European procedure.

In this connection the Chairman noted that it had not proved possible to find a better definition than that given in Article 54 of the theoretically objective concept of inventive step, in respect of which, however, subjective elements also played a part in practice.

83. Finally, the Chairman noted that the Swiss proposal was supported by none of the Government delegations and was therefore rejected.
Minutes of the Proceedings of Main Committee I

1. Main Committee I (see Rule 12 of the Rules of Procedure*) set up by the Plenary of the Conference to deal with matters concerning patent law was chaired by Dr. Kurt Haerel, President of the German Patent Office (Federal Republic of Germany). Mr. Göran Borgia, Director-General of the Royal Swedish Patent Office (Sweden), was the first Vice-Chairman; Mr. Erkki Tuutili, Director-General of the Patent and Record Office (Finland), and Dr. Thomas Lorenz, Chairman of the Patent Office (Austria), were the other Vice-Chairmen. The Rapporteur was Lic. jur. Paul Braendli, Vice-Director of the Federal Intellectual Property Office (Switzerland) (see M/PR/K/1, points 19, 20 and 25; M/46/K, page 1 and M/55/K, page 2).

2. The duties of Main Committee I were based on Rule 12 of the Rules of Procedure (M/34) and on a recommendation adopted by the Steering Committee of the Conference (M/56/I/1/III). On this basis the Main Committee was responsible for Articles 14, 50 – 142, 144, 148 – 157, 161, 162 and 174 of the Draft Convention (M/1), Rules 1 – 7 and 13 – 107 of the Draft Implementing Regulations (M/2), the Draft Protocol on Recognition (M/3), the Recommendation on preparations for the opening of the European Patent Office (M/8) and the Recommendation on training staff for the European Patent Office (M/33).

3. Main Committee I met from 11 to 14 September, 17 to 21 September, 24 to 26 September and on 28 and 29 September 1973.

4. At its first meeting the Main Committee, on a proposal from its Chairman, set up a Drafting Committee. Modelled on the Drafting Committee of the Luxembourg Inter-Governmental Conference, this consisted of the delegations of the Federal Republic of Germany, France and the United Kingdom. The Chairman was Mr. J. B. van Bentheim, President of the Octrooi raad and Head of the Netherlands delegation.

5. The Main Committee did not deal with the tasks assigned to it in exactly the same order as the Articles, Rules and other provisions but in the order which seemed most appropriate in the given circumstances. Thus it happened that one and the same provision was discussed on different occasions, for example if the problem in question was first passed to a Working Party and subsequently referred back to the Main Committee.

However, in this report each provision is dealt with only once. The reader should thus be able to obtain, in one place, all the information he wants on the discussion of a particular problem. Within the following Sections the provisions are dealt with in numerical order:

A. General
8 – 10

B. Convention
11 et seq.

C. Implementing Regulations
2001 et seq.

D. Protocol on Recognition
3001 et seq.

E. Recommendation on preparations for the opening of the European Patent Office
4001 et seq.

F. Recommendation on training staff for the European Patent Office
5001 et seq.

6. If a provision was dealt with again in the Main Committee after being discussed in a Working Party or in the Drafting Committee, special mention is made of this below. On the other hand, if no mention is made, it is to be assumed that the Main Committee adopted the proposal of the Working Party or of the Drafting Committee. Purely drafting amendments which are not based on written proposals are not mentioned as a general rule.

7. In this report the numbering of the Articles, Rules, paragraphs, etc. follows the text of the draft proposals (M/1 to M/8). Where it seems appropriate, the numbering in the signed text is given in brackets after the number of the provision concerned.

A. General

8. At the beginning of the first meeting the Chairman noted that the Steering Committee had approved two requests at its meeting on 10 September 1973, namely that Mr. Sheehan of the US Patent Office and Mr. van Empel, a former member of the Secretariat, might be admitted as listeners to the meetings of the Main Committees. However, under Rule 48 of the Rules of Procedure Main Committee I's consent was also necessary, before participation in its proceedings was allowed.

Main Committee I agreed that both the gentlemen mentioned could take part in its proceedings as listeners pursuant to Rule 48, paragraph 1.

9. The Chairman pointed out that under Rule 32 of the Rules of Procedure only requests made in writing by the Government delegations could be discussed and voted upon. In principle, written requests had to be submitted by 5 p.m. on the day prior to the discussion.

10. The Chairman also stated that, pursuant to the Rules of Procedure, only Government delegations could make proposals, whereas representatives of any observer delegations could make oral statements under Rule 50 of the Rules of Procedure. If observer delegations made proposals, the latter had to be taken over by a Government delegation and seconded by a second Government delegation. If this was not the case, the proposal was deemed to be rejected.

The Main Committee agreed with this interpretation.

B. Draft Convention establishing a European system for the Grant of Patents (M/1)

Article 14 – Languages of the European Patent Office

11. The Main Committee forwarded to the Drafting Committee a drafting proposal from the Netherlands delegation concerning paragraph 2 (M/32, point 2).

12. While discussing Article 122, paragraph 2 (see point 594), the Main Committee decided on a further amendment to paragraph 2.

13. The Main Committee forwarded to the Drafting Committee a drafting proposal from the Luxembourg delegation concerning paragraph 4 (M/9, point 8).

14. The Main Committee decided that a proposal from the Netherlands delegation concerning paragraph 17 (M/52/I/11/ III, point 2), to the effect that an applicant must submit a translation of the claims in the other two official languages of the European Patent Office, would be discussed in connection with Article 96 (see under point 350). The Committee also adopted paragraph 7.

15. The Turkish delegation proposed amending paragraph 7 so that claims would have to be translated into all the official languages of the designated Contracting States.

It was pointed out to the delegation that the question of the translation of the European patent specification is dealt with in Article 63 (65), so that, for example, Turkey could request that the specification be translated into Turkish, if the European patent was to be effective in Turkey.

The Turkish delegation said it was satisfied with this explanation and withdrew its proposal.

* The Rules of Procedure (M/34) had been previously adopted unanimously by the Plenary (see M/PR/K/1, point 10)
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)

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81. The United Kingdom delegation was not in favour of the Swiss proposal for reasons similar to those of the Netherlands delegation.

82. The IFIA delegation proposed making the concept of inventive step as objective as possible in the European procedure.

In this connection the Chairman noted that it had not proved possible to find a better definition than that given in Article 54 of the theoretically objective concept of inventive step, in respect of which, however, subjective elements also played a part in practice.

83. Finally, the Chairman noted that the Swiss proposal was supported by none of the Government delegations and was therefore rejected.
Minutes of the Proceedings of Main Committee I

1. Main Committee I (see Rule 12 of the Rules of Procedure*) set up by the Plenary of the Conference to deal with matters concerning patent law was chaired by Dr. Kurt Haerel, President of the German Patent Office (Federal Republic of Germany). Mr. Göran Borggård, Director-General of the Royal Swedish Patent Office (Sweden), was the first Vice-Chairman; Mr. Erkki Tuuri, Director-General of the Patent and Record Office (Finland), and Dr. Thomas Lorenz, Chairman of the Patent Office (Austria), were the other Vice-Chairmen. The Rapporteur was Lieu. jur. Paul Braendli, Vice-Director of the Federal Intellectual Property Office (Switzerland) (see M/PR/1K/1, points 19, 20 and 25; M/46/K, page 1 and M/55/K, page 2).

2. The duties of Main Committee I were based on Rule 12 of the Rules of Procedure (M/34) and on a recommendation adopted by the Steering Committee of the Conference (M/56/I/II/III).

On this basis Main Committee I was responsible for Articles 14, 50 — 142, 144, 148 — 157, 161, 162 and 174 of the Draft Convention (M/1), Rules 1 — 7 and 13 — 107 of the Draft Implementing Regulations (M/2), the Draft Protocol on Recognition (M/3), the Recommendation on preparations for the opening of the European Patent Office (M/8) and the Recommendation on training staff for the European Patent Office (M/33).

3. Main Committee I met from 11 to 14 September, 17 to 21 September, 24 to 26 September and on 28 and 29 September 1973.

4. At its first meeting the Main Committee, on a proposal from its Chairman, set up a Drafting Committee. Modelled on the Drafting Committee of the Luxembourg Inter-Governmental Conference, this consisted of the delegations of the Federal Republic of Germany, France and the United Kingdom. The Chairman was Mr. J. B. van Bentheim, President of the Octrooiraad and Head of the Netherlands delegation.

5. The Main Committee did not deal with the tasks assigned to it in exactly the same order as the Articles, Rules and other provisions but in the order which seemed most appropriate in the given circumstances. Thus it happened that one and the same provision was discussed on different occasions, for example if the problem in question was first passed to a Working Party and subsequently referred back to the Main Committee.

However, in this report each provision is dealt with only once. The reader should thus be able to obtain, in one place, all the information he wants on the discussion of a particular problem. Within the following Sections the provisions are dealt with in numerical order:

points

A. General 8—10
B. Convention 11 et seq.
C. Implementing Regulations 2001 et seq.
D. Protocol on Recognition 3001 et seq.
E. Recommendation on preparations for the opening of the European Patent Office 4001 et seq.
F. Recommendation on training staff for the European Patent Office 5001 et seq.

6. If a provision was dealt with again in the Main Committee after being discussed in a Working Party or in the Drafting Committee, special mention is made of this below. On the other hand, if no mention is made, it is to be assumed that the Main Committee adopted the proposal of the Working Party or of the Drafting Committee. Purely drafting amendments which are not based on written proposals are not mentioned as a general rule.

7. In this report the numbering of the Articles, Rules, paragraphs, etc. follows the text of the draft proposals (M/1 to M/8). Where it seems appropriate, the numbering in the signed text is given in brackets after the number of the provision concerned.

A. General

8. At the beginning of the first meeting the Chairman noted that the Steering Committee had approved two requests at its meeting on 10 September 1973, namely that Mr. Sheehan of the US Patent Office and Mr. van Empel, a former member of the Secretariat, might be admitted as listeners to the meetings of the Main Committees. However, under Rule 48 of the Rules of Procedure Main Committee I's consent was also necessary, before participation in its proceedings was allowed.

Main Committee I agreed that both the gentlemen mentioned could take part in its proceedings as listeners pursuant to Rule 48, paragraph 1.

9. The Chairman pointed out that under Rule 32 of the Rules of Procedure only requests made in writing by the Government delegations could be discussed and voted upon. In principle, written requests had to be submitted by 5 p.m. on the day prior to the discussion.

10. The Chairman also stated that, pursuant to the Rules of Procedure, only Government delegations could make proposals, whereas representatives of any observer delegations could make oral statements under Rule 50 of the Rules of Procedure. If observer delegations made proposals, the latter had to be taken over by a Government delegation and seconded by a second Government delegation. If this was not the case, the proposal was deemed to be rejected.

The Main Committee agreed with this interpretation.

B. Draft Convention establishing a European system for the Grant of Patents (M/1)

Article 14 — Languages of the European Patent Office

11. The Main Committee forwarded to the Drafting Committee a drafting proposal from the Netherlands delegation concerning paragraph 2 (M/32, point 2).

12. While discussing Article 122, paragraph 2 (see point 594), the Main Committee decided on a further amendment to paragraph 2.

13. The Main Committee forwarded to the Drafting Committee a drafting proposal from the Luxembourg delegation concerning paragraph 4 (M/9, point 8).

14. The Main Committee decided that a proposal from the Netherlands delegation concerning paragraph 17 (M/52/II/III, point 2), to the effect that an applicant must submit a translation of the claims in the other two official languages of the European Patent Office, would be discussed in connection with Article 96 (see under point 350). The Committee also adopted paragraph 7.

15. The Turkish delegation proposed amending paragraph 7 so that claims would have to be translated into all the official languages of the designated Contracting States.

It was pointed out to the delegation that the question of the translation of the European patent specification is dealt with in Article 63 (65), so that, for example, Turkey could request that the specification be translated into Turkish, if the European patent was to be effective in Turkey.

The Turkish delegation said it was satisfied with this explanation and withdrew its proposal.

* The Rules of Procedure (M/34) had been previously adopted unanimously by the Plenary (see M/PR/1K/1, point 10).
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 16
Inventive level

A European patent shall not be granted even where the invention is new if, having regard to the state of the art, its realisation was obvious to a person of average skill in the technical field to which the subject-matter of the invention relates (average person skilled in the art).