Article 158 E

Travaux Préparatoires
(EPC 1973)

Comment:

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**Art. 158**

**MPÜ**

Veröffentlichung der internationalen Anmeldung und ihre Übermittlung an das Europäische Patentamt

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

(d) Deletion from the list of professional representatives

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

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

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

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

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

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

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

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

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

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

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

ANNEX II
REPORT
by Mr. R. Bowen
Assistant Comptroller, British Patent Office
on the results of Main Committee II's proceedings

ANNEX III
REPORT
by Mr. Fressonnet
Deputy Director of the Institut National de la Propriété Industrielle (France)
on the results of Main Committee III's proceedings

ANNEX IV
REPORT
by Mr. A. Fernandez Mazarambroz
Head of the Spanish Patent Office
on the results of the Credentials Committee's proceedings
with regard to full powers for signing the Convention
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MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Munich, 10 September to 5 October, 1973)

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Government of the Federal Republic of Germany
however had been very limited and did not directly concern the question under discussion. In the second place it did not seem logical to restrict discussion to Article 29 alone and forget the basic philosophy of the PCT. The PCT was intended to help applicants at national offices who also wished to file their applications at other national offices. From this point of view the PCT's scope should not extend to applicants who did not maintain their applications. Furthermore an over-strict interpretation of Article 24 which excluded the admissibility of the Norwegian delegation's proposal did not appear to take due account of the principle embodied in Article 27, paragraph 5, of the PCT, which provided that "Nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires".

942. In connection with this last point the WIPO delegation said that it emerged very clearly from the conclusions of the Washington Conference that Article 27, paragraph 5, itself constituted no restriction on the principle expressed in Article 11, paragraph 3. It had in fact been considered necessary to lay down an express provision in Article 64, paragraph 4.

943. The United Kingdom delegation thought that account should be taken of the basic philosophy of the PCT rather than of the details of certain of its provisions; the intention of the PCT was to make international publication equivalent in all respects to national publication, except that rights under it became effective only when the application existed in a language understood in the States concerned.

Furthermore, the philosophy of the "whole contents approach" was that of enabling the applicant to have his disclosures included in the state of the art of retroactive effect to the date of filing for designated States, with the option before publication, of withdrawing the designation in which he did not wish his disclosure to be included in the state of the art.

The result of combining these two philosophies was not compatible with the Norwegian proposal. Clearly, PCT applications which designated European States and which were filed in one of the official languages of the European Patent Office sought protection before publication and were in a language understood in the States concerned. Moreover, the European Patent Office would be able to examine such applications on the basis of the "whole contents approach". The existing text should therefore be retained, bearing in mind the fact that the obscurity of the PCT allowed of a certain flexibility.

944. The Chairman considered that the matter had been sufficiently debated and that a vote could be taken. However, in order to clarify the situation, he pointed out that the Norwegian proposal did not refer only to international applications in Russian or Japanese but to all international applications submitted via the PCT route. It would mean that an international application published by WIPO in any of the five official languages of the PCT would only have effect on the state of the art as from the date of filing or of priority if a translation were supplied to the European Patent Office in due time and the European fee were paid.

The Chairman noted that the Committee was in favour of the Norwegian delegation's proposal by eleven votes for, two against and one abstention, and the proposal was therefore referred to the Drafting Committee.

945. The Committee examined the Netherlands delegation's proposal as given in M/52, page 15.

The Netherlands delegation explained that its proposal was that an addition be made to the end of the first paragraph which would provide that the European Patent Bureau should mention publication under Article 21 of an international application for which the European Patent Office was a designated Office. The Netherlands delegation stated that its proposal was supported by the interested circles on the grounds of the importance to the public of such a mention.

946. The delegation of the Federal Republic of Germany could accept the principle underlying the Netherlands delegation's proposal, but wondered whether the result it was intended to achieve had not already been achieved by Article 129 (a) in conjunction with the first paragraph of Rule 93.

The Chairman pointed out that the proposal by the Netherlands delegation went further than the current situation, since it made mention of publication obligatory. The current text, however, merely gave the President the possibility of publishing such a mention.

The Committee agreed to the proposal by the Netherlands delegation.

947. The Committee then examined the proposal for an amendment to Article 157, paragraph 2, submitted by the Member States of the European Communities (see M/14, point 13).

The United Kingdom delegation presented this proposal to the Committee; it was to the effect that if the international application were published in a language other than one of the official languages of the European Patent Office, that Office should publish the international application supplied as specified in Article 153, paragraph 2. This wording would make it possible to simplify the situation as regards the problem of provisional protection, since the latter could be effective from the date of publication by the European Patent Office, thereby relieving each Contracting State of the need to apply corresponding provisions to this end.

948. The Committee agreed to this proposal.

Article 161 (162) — Progressive expansion of the field of activity of the European Patent Office

949. The Committee examined the proposals for amendments submitted by the French delegation (see M/26, points 19 and 20).

950. The French delegation pointed out that it felt that its proposals really concerned drafting changes. The current text of paragraph 1 specified that European patent applications could be filed with the European Patent Office in all areas of technology from a date fixed by the Administrative Council. However, the second sentence of this paragraph stipulated that the examination of applications might be restricted to certain areas of technology. Paragraph 2 enabled the Administrative Council to "further restrict" the processing of a patent application affected by the restrictions provided for in paragraph 1. The further restrictions on processing could therefore apply subsequently to the decisions taken by the Administrative Council pursuant to paragraph 1. For example, in certain areas of technology the Administrative Council could suspend the procedure for the drawing up of the European search report. The authors of the text had never intended to provide such a possibility. The French delegation's proposed amendments were aimed at ensuring, more explicitly than in the present text, that there was no question of reversing the decision of the Administrative Council.

The Netherlands delegation supported the French delegation's proposal.

951. The United Kingdom delegation had doubts about making an amendment along the lines suggested by the French delegation. It might so happen that in a certain situation the Administrative Council would be obliged to reverse a previous decision. The delegation was therefore in favour of retaining
WIPO delegation said that it could not tell without consulting the relevant documents whether such a statement appeared in the minutes of the Washington Conference or not.

931. The Swedish delegation, supported by the Netherlands delegation, said that a reference to this question would not appear in the minutes of the Washington Conference itself but in those of the preparatory proceedings.

932. The Chairman asked the WIPO delegation whether it could possibly search the minutes of the preparatory proceedings for the passage to which the Swedish and Netherlands delegations had referred.

933. The WIPO delegation declared its willingness to carry out this search. It stressed however that it did not think that the conclusions to be drawn from it would be likely to affect the present discussion of the matter. It was in fact true, as the Netherlands delegation had pointed out, that a State which did not recognise the effect on the state of the art of a withdrawn application could apply this principle to international applications made under the PCT. This point had been raised during the PCT negotiations and had been confirmed. The situation here however was different. If the Norwegian delegation's proposal were to be adopted, different treatment would be given to applications made under the European procedure from that given to applications made under the PCT procedure. If this were to be so, the situation would not be in accordance with Article 11, paragraph 3, and Article 24 of the PCT.

934. The Netherlands delegation said that during the Washington Conference it had attached importance to the question of whether, since Netherlands law attributed effect on the state of the art to earlier applications, the Netherlands would be obliged to attribute the same effect to international applications which were not maintained for the Netherlands on the grounds of failure to supply translations or to pay fees. Furthermore, the Netherlands delegation asked what the situation would be if no translation were supplied in view of the proposal made by the Member States of the European Communities concerning paragraph 2 of Article 157, to the effect that international applications in languages which were not official languages of the European Patent Office would have to be published in one of the EPO official languages. Would an application, which had not been published in one of the official languages of the European Patent Office, nevertheless have effect on the state of the art?

935. The Chairman said that at first sight the answer to this question would appear to be in the affirmative. He asked the WIPO delegation whether it was now able to adopt a position on the preparatory proceedings.

936. The WIPO delegation said that having examined certain preparatory documents it was now able to state its views more clearly. It recalled that in December 1968, during the Geneva discussions of the draft PCT, a statement had been made concerning Article 29. In that statement the Danish and Australian delegations had said that if the whole issue were not to be left within the competence of national legislation, they wished to be assured that this Article did not involve effects on the state of the art which national legislations attributed to published national applications. These two delegations concluded their statement by saying that in their opinion such effects should not apply as long as the international application had not been received by the national offices concerned. In this sense, the view expressed by the Swedish and Netherlands delegations was in accordance with the true state of affairs. This statement was not, however, followed up by practical conclusions. Subsequently a document examining the fundamental differences between the 1968 and 1969 drafts, contained in the minutes of the Washington Conference (page 180, point 47), stated: "Consequently, no State will be obliged to consider internationally published applications as part of the prior art already from the priority or the filing date (rather than only from the publication date), even if such a State were a designated State when the publication was effected and even if, for national applications, its law so provided". During the preparatory proceedings for the Washington Conference in 1970 amendments were made to Article 24, in particular the insertion in the first paragraph of the stipulation "in any designated State" on the basis of a proposal by the Japanese delegation. In the minutes of the Washington Conference there was no mention of any discussion of Article 24, which had therefore been adopted in the amended version proposed by the Japanese delegation. In these circumstances no precise information could be gleaned from the minutes of the Washington Conference concerning the problem under discussion. It was therefore for the Contracting States to interpret the PCT bearing in mind the aforementioned historical background.

937. The Chairman thanked the WIPO delegation for its very full account of the origins of Article 24 of the PCT and shared its opinion that the admissibility or otherwise of the Norwegian delegation's request depended on the interpretation which the various Contracting States gave to Article 24 of the PCT.

938. The Netherlands delegation wished to put a further question to the WIPO delegation. It asked what significance should be attributed to the fact that Article 24, paragraph 2, of the PCT began with the words: "Notwithstanding the provisions of paragraph (1), any designated Office may maintain the effect provided for in Article 11 (3)." The effect provided for in Article 11 (3) was in fact the effect on the state of the art. The question therefore arose of whether, on the basis of the second paragraph, the first paragraph could not be interpreted as referring to the effect provided for in Article 11, paragraph 3.

939. The WIPO delegation pointed out that in the first place the case covered by the second paragraph was the exact opposite of that which was being discussed. In fact that paragraph allowed of the possibility of going beyond the obligations of the PCT by maintaining the effect on the state of the art as regards national applications even where under the first paragraph of Article 24 of the PCT the effect provided for in Article 11, paragraph 3, in the event of international filing had ceased. Both provisions dealt with the same broad concept of the effect of an international application. The WIPO delegation did not therefore consider that the interpretation of the second paragraph could have any effect on the interpretation of the first paragraph.

940. The Netherlands delegation repeated that it was in favour of acceptance of the Norwegian delegation's proposal. It did not think it justifiable for the European procedure to take account, for the purposes of the state of the art, of international applications which had not been confirmed. This approach was not used even for national applications in the Contracting States. Considerable difficulties could be encountered, for example where applications were in Russian or Japanese and no translations were supplied.

941. The Norwegian delegation agreed that a literal interpretation of Article 24 of the PCT could lead to the view that its proposal was inadmissible. This Article should however be interpreted in the light of the historical considerations adduced by the WIPO delegation. It was clear that during the preparatory proceedings some delegations had adopted well-defined positions on the question under discussion and that no objections had been expressed. It was true that the text had in fact been changed as a result of the Japanese delegation's proposal for an amendment. The aim of this amendment
had agreed on the French delegation's proposal in M/59 for the inclusion in the Convention of a provision covering the Directorate-General for Searching, Main Committee I was now faced with the problem of what this implied for certain other Articles in the Convention. He held that as the basic issue had already been decided, the Committee could confine itself to referring to the Drafting Committee the problem of how to word the relevant provisions.

The Chairman noted that the Committee agreed to refer this problem to the Drafting Committee.

**Article 156 (157) — International search report**

913. The Committee agreed to instruct the Drafting Committee to make the appropriate amendments to this Article, following the decision to delete Article 124 (see point 664) and the decision by Main Committee II on the incorporation of the IIB in the European Patent Organisation, in the form of the Directorate-General for Searching.

914. While the results of the Drafting Committee's work (see M/136/I/R, p. 22) were being examined, the FICPI delegation wished to know from which date the time allowed for filing a request for examination would run in the case of international applications for which an international search report had been drawn up.

915. After the matter had been discussed, the Chairman noted that the Committee was unanimously of the opinion that in the case of the international applications referred to in this Article the time allowed for submitting a request for examination started to run from the day on which the international application was published by WIPO.

**Article 157 (158) — Publication of the international application**

916. The Committee examined the proposed amendments to this Article: a proposal by the Norwegian delegation (see M/71, page 4), a proposal by the Netherlands delegation (see M/52, page 15) and a proposal by the Member States of the European Communities (see M/14, point 13).

917. The Chairman pointed out that the proposal of the Norwegian delegation concerning paragraph 1 was in two parts. He considered the first of these, whereby the words "or elected" would be inserted between the words "designated" and "Office", superfluous since under the last sentence in Article 31, paragraph 4(a), of the Patent Co-operation Treaty: "Election may relate only to Contracting States already designated under Article 4".

918. The Norwegian delegation agreed with the Chairman and accordingly withdrew the first part of its proposal.

919. The Norwegian delegation stated that it attached much greater importance to its second proposal whereby paragraph 1 would be supplemented by a provision excluding the content of international applications which were not maintained as European patent applications from the state of the art referred to in Article 52, paragraph 3.

920. The Chairman did not consider that this proposal coincided with the intentions of the authors of the preparatory work. According to Article 157, paragraph 1, as it stood, an international application, published by WIPO under Article 21 of the PCT, which was deemed to be an application for a European patent, became part of the state of the art from the date of filing or the date of priority, regardless of whether it had been forwarded to the European Patent Office or the national fee had been paid.

921. The Netherlands delegation pointed out that this question depended on the interpretation given to Article 24 of the PCT on the possible loss of effect in designated States. This Article stipulated that the effect of the international application ceased in any designated State with the same consequences as the withdrawal of a national application. This would appear to mean that the application would be deemed to have been withdrawn and that the effects provided for in Article 52, paragraph 3, would apply.

922. The Chairman said that the situation seemed to him to be exactly the same as that of a European patent application withdrawn after publication. In such a case the effects described in Article 52, paragraph 3, would apply in spite of the withdrawal of the application.

923. The United Kingdom delegation agreed with the Chairman's interpretation but pointed to the disadvantages of such a situation.

924. The WIPO delegation did not think that this question could be settled on the basis of Article 24 of the PCT, since that Article referred to the loss of effect, referred to in Article 11, paragraph 3, of the PCT, of the international application. This effect was "the effect of a regular national application". The situation was different for regional patent applications. The system adopted in the present Convention was that even if a European patent application was withdrawn, the effects on the state of the art would continue to apply. Applying this system to Article 24 of the PCT, the loss of effect provided for in Article 11, paragraph 3, of the PCT would certainly not mean that the content of the application would cease to be part of the state of the art since the withdrawal of the application would not have any effect as regards regional patent applications either.

925. The Netherlands delegation felt that the Norwegian delegation's proposal would counter the disadvantages of an excessively rigorous interpretation to the effect that an international application for which no translation in an official language of the European Patent Office was produced or for which no fee had been paid would be considered to form part of the state of the art. This delegation then asked whether the provisions of the PCT would allow the insertion in this Convention of a provision taking account of its wishes and those of the Norwegian delegation. Article 24 of the PCT did not in fact say that the application was deemed not to have been filed but that it ceased to have effect.

926. The WIPO delegation confirmed that Article 24 did not support the Norwegian delegation's proposal but rather the contrary.

927. The United Kingdom delegation asked the WIPO delegation whether, for the purposes of the application of Article 52, paragraph 3, it would be possible to have access to the priority documents of an international application.

928. The Swedish delegation pointed out that the problem being discussed had been debated at length during the preparatory proceedings for the Washington Conference because of the importance attributed to it by the Scandinavian countries. The Swedish delegation thought that the minutes of the preparatory proceedings would show that it had been agreed that the arrangement now being requested by the Norwegian delegation was not incompatible with the PCT.

929. In reply to the question raised by the United Kingdom delegation, the WIPO delegation pointed out that Rule 17, paragraph 2, of the PCT stipulated that "the International Bureau shall, at the specific request of the designated Office... furnish a copy of the priority document to that Office". Offices also had the right to require production of priority documents from the applicant after expiry of the twenty-month period. Before the expiry of that period, access was therefore possible to priority documents only in the original language.

930. As regards the Swedish delegation's statement, the
to delete (see point 629) since the resulting loss of fees should in its opinion be made up for by a flat-rate increase in the search fee so that in effect the applicant would indirectly pay for such loss.

However, the procedure for PCT applications was different: in this case, if, in accordance with Article 156, the Administrative Council has in certain cases waived the requirement for a supplementary search report, an additional search fee can no longer be charged. Nevertheless, special cases could arise where, although a general decision had been taken not to require a supplementary search, such a search might become necessary; it would then be only fair and reasonable to let the PCT applicant bear the resultant cost. The same would also have to apply should the PCT applicant make changes in the patent claims in the course of completing the procedure. In this case also it would be unreasonable if all European applicants had to bear the cost of such supplementary searches.

Finally, the Swiss delegation stressed that it regarded this problem as being purely financial and not a matter of discriminating against PCT applications; it feared that without Article 124, paragraph 2, an excessive strain might be placed on the budget of the European Patent Office.

653. The United Kingdom delegation considered that the vast majority of cases of inadequate international search reports were sufficiently covered by Article 156; this was so where the search report was drawn up by an International Searching Authority whose reports had not yet reached European standard; where the International Searching Authority declared, in accordance with Article 17 of the Patent Cooperation Treaty, that it was unable to make an adequate search; or where the applicant had changed the claims in the international application in accordance with Article 19 of the Patent Cooperation Treaty. The only case in which Article 124 could conceivably be applied would be where the International Searching Authority had drawn up a bad report which just did not make sense. This would give rise to disputes between the applicant and the European Patent Office as to whether a further search fee was called for. Such cases were so rare that it was not worth while bothering about them.

The United Kingdom delegation was therefore in favour of deleting, not only paragraph 2, but all of Article 124 since, were paragraph 1 retained on its own, it would only make the obvious statement that the European Patent Office could at any time call for additions to the search report.

654. It was equally the opinion of the German delegation that there was no justification for retaining Article 124, paragraph 2, at the same time as Article 156; Article 156 was severe on PCT applicants in that in addition to each PCT search report, a supplementary search report — subject to a fee — was required. Of course the Administrative Council could decide to waive the requirements for a supplementary report or to reduce the search fee. However, it would only do so when the reports of a given PCT Searching Authority reached the same standard as the European search reports and when furthermore the relevant PCT Searching Authorities fully recognised the European reports. When this stage was reached, it would hardly be justified to charge a supplementary search fee for the few cases in which a supplementary search was necessary. It might also be expected that other PCT States would waive payment of supplementary fees when calling for a supplementary search to a European search report. It was above all a matter of observing the spirit of the Patent Cooperation Treaty which promoted international co-operation on patents; this would be infringed by any petty-minded charging of supplementary search fees.

Article 124, paragraph 2, should accordingly be deleted; paragraph 1 would then cease to have any meaning since the European Patent Office, which would itself be responsible for carrying out the search, could of course supplement the search at any time.

655. The Netherlands delegation asked the Swiss delegation whether its doubts would be removed if the search fee — although reduced by the Administrative Council — were still fixed at such a level as to cover by means of a flat-rate fee the cost of all supplementary searches necessary for PCT applications. In its opinion Article 156 (17), paragraph 3, would permit such a flat-rate fee to be fixed.

656. The Swiss delegation replied that it did not interpret Article 156 (157), paragraph 3, in this way. It considered that paragraph 3 was a derogation from paragraph 2 and that it did not give a blanket authorisation to fix a flat-rate search fee. But the Swiss delegation was in no way opposed to Article 156, paragraph 3, being amended to give such authorisation.

657. The United Kingdom delegation maintained that, according to Article 156, paragraph 3, a supplementary search fee could be fixed at a flat-rate for PCT applications. After all, the European Patent Office would have to carry out some sort of search in respect of each PCT application on account of Article 52 (54), paragraph 3. In this event, a complete remission of fees would be out of the question unless the European Patent Office itself was acting as a PCT Searching Authority.

658. The Chairman stated that it was quite clear to him that, in accordance with Article 156, paragraph 3, the Administrative Council could make a general reduction in the search fees for PCT applications. Should it so decide, all PCT applicants would have to pay this fee irrespective of any subsequent searches in individual cases. Were Article 124 to be retained, however, a supplementary search fee could only be charged in individual cases where a subsequent search was actually carried out.

659. Moreover, the question should be asked, if Article 124 were completely deleted, as to whether Rule 67, paragraph 2, should also be dropped. This states that the Board of Appeal could ask an Examining Division and a Searching Division for further information concerning the state of the art (see point 2316a).

660. The Swiss delegation stated that it would re-examine its attitude to the question of the deletion of Article 124 in case the Committee in general considered that the Administrative Council — irrespective of whether it waived the requirement for supplementary European search reports in accordance with Article 156, paragraph 3(a) — could fix a flat-rate search fee for PCT applications.

661. After inquiring all round, the Chairman ascertained that it was the unanimous opinion of the Main Committee that the Administrative Council could, in accordance with Article 156, paragraph 3, decide to charge a small search fee for PCT applications which would cover the cost of the supplementary search reports.

662. The German delegation pointed out that the cost of the supplementary search reports could be covered in other ways, e.g. by an overall increase in the application fee. Whichever option the Administrative Council were to choose in future would probably depend on what other PCT Searching Authorities did later; in any case it should keep its options open.

663. The French delegation stated that even if the Main Committee had interpreted Article 156, paragraph 3, in this way, there was no assurance that the Administrative Council would subsequently endorse this interpretation. This was why the French delegation advocated retention of Article 124.

664. Finally, the Main Committee voted on the most far-reaching proposal, namely, that Article 124 be completely deleted.

This proposal was adopted by 8 votes to 2 with 3 abstentions.
Searching Authority under the PCT had to be supplemented, and there seemed to be no reason why the cost of this should be shifted over to all applicants collectively. On these grounds, Article 124, paragraph 2(b), should be retained.

636. The Swiss delegation was also in favour of sub-paragraph (b) being retained, on the grounds that even if, pursuant to Article 156, the Administrative Council waived supplementary searching for certain categories of international search reports, it must still be possible to draw up a supplementary search report in individual cases.

637. The Netherlands delegation also thought it reasonable for the Administrative Council to forgo the supplementing of certain categories of international search reports pursuant to Article 156, but only if they could be regarded as completely equivalent to a European search report. But once an international search report was deemed as equivalent to a European search report, it would no longer be justified to treat them differently.

638. The French delegation likewise held the view that it would be justifiable not to carry out any further supplementary searching if the Administrative Council recognised the equivalence of certain categories of international search reports, pursuant to Article 156. All the same, it could still see differences between the cases in sub-paragraphs (a) and (b). Those in sub-paragraph (a) were likely to be of little significance numerically, but this was by no means certain in the cases in sub-paragraph (b).

639. The WIPO delegation considered that Article 156 made sufficient provision for all cases in which it proved necessary to supplement international search reports. Furthermore, it should not be forgotten that, even if all international search reports should subsequently be acknowledged to be equivalent to European reports — one of the main purposes of the PCT was, in fact, to achieve this — Article 124 would still be available and could result in fees having to be paid for international search reports, but not for equivalent European reports.

640. The delegation of the International Chamber of Commerce considered that the proceedings would be unduly complicated if the European Patent Office were to carry out subsequent searching for a search report it had itself drawn up and then collected a supplementary fee from the applicant. On the other hand, in the perhaps not infrequent cases where an international searching authority drew up the report, the possibility of drawing up a supplementary search report, requiring a fee, did seem justified.

641. The Chairman thought that conceivable cases should be differentiated according to whether the original search report was incomplete or complete. If the International Searching Authority's original report was incomplete and therefore needed supplementing, he considered it justified to make the applicant bear the costs thus incurred, for there was no perceivable reason why the European Patent Office should have to make amends for an error committed by the International Searching Authority. On the other hand, if the original search report was complete but the applicant had subsequently occasioned the need for a supplement, it should be immaterial whether the original report had been drawn up by the European Patent Office or the International Searching Authority.

642. The Netherlands delegation emphasised its view that the European Patent Office should undertake supplementary searching — whether for a European or an international search report — only in exceptional circumstances and, in principle, after the patent claims had been amended, because otherwise the procedure would never be concluded.

643. In the ensuing vote on the Swedish delegation's oral proposal also to delete sub-paragraph (b) from Article 124, paragraph 2, 2 delegations voted in favour, 8 against and there were 4 abstentions.

644. At the final meeting of the Main Committee, the delegations of the Federal Republic of Germany, the Netherlands, Sweden and the United Kingdom proposed resuming the discussion of paragraph 2(b) with a view to deleting it, and also deleting the amended version of paragraph 3 (see point 623 and M/128/1 Rev.).

645. In support of this proposal, the Netherlands delegation pointed out that pursuant to the version of paragraph 2 recently decided by the Main Committee, the applicant had to bear the cost of a search report which supplemented an international search report. This provision did not seem very felicitous in view of the fact that Article 156 (157) also laid down that a supplementary European search report could be obtained for an international application in return for the payment of a fee. But since, pursuant to Article 156, the Administrative Council had recognised certain categories of international search reports as being equivalent to search reports of the European Patent Office, there remained only isolated instances in which it would be justifiable to obtain a supplementary search report; after all, the Examining Divisions could examine all categories of search reports which had already been recognised to ascertain whether they were adequate for the European proceedings. However, for those few isolated instances, it was completely tenable that the supplementary search reports should be drawn up free of charge and the costs thereof borne by all applicants collectively.

To retain this latest version of paragraph 2 would be to risk an adverse influence on other countries and future conventions. Furthermore, one might well wonder whether paragraph 1 should not also be deleted, if paragraphs 2 and 3 were.

646. The French delegation was opposed to any resumption of discussions on paragraph 2; it considered that the Netherlands delegation's comments went beyond a mere justification of the proposal on procedure.

647. The Belgian and Swiss delegations also opposed the proposal for resuming discussions.

648. The Main Committee finally decided by 11 votes to 3 to resume discussion of Article 124, paragraph 2.

649. The United Kingdom delegation, supported by other delegations, proposed that the whole of Article 124 should be deleted.

650. The Italian delegation said it could agree to the deletion of paragraphs 2 and 3, but not to the deletion of the whole Article, on the grounds that it should be possible to obtain a supplementary search report during a transitional period at least.

651. The French delegation considered that, even if Article 124 were deleted, the European Patent Office could have a supplementary search report drawn up. In this event, it felt that it would not be right to exempt the applicant from payment of fees by making all the applicants and in particular the European applicants bear the resulting increase in costs. In any case, the search fee, which is meant to cover search costs in full, will be quite considerable, probably greater than all the other fees. Consequently, at least in this case, a person submitting an international application in respect of which an inadequate search report has been drawn up, should have to bear the cost of the supplementary search report. The French delegation therefore favoured retention of the most recently adopted version of Article 124, paragraph 2.

652. The Swiss delegation supported the French delegation. It felt that the case in question differed from the case in paragraph 2(a) in which the Main Committee had already decided
considered that it would not be feasible for the additional search fee to be paid after the time limit set for its payment had expired. In any case, the applicant could always pay the fee first and then, if the Board of Appeal recognised that its collection had been unwarranted, subsequently request that it be refunded on the grounds of unwarranted gain.

612. The Austrian delegation thought that the nearest solution legally would be for the applicant to pay the fee provisionally, so that the proceedings were not held up, and he could also appeal against a decision that he should be required to pay it. The Austrian delegation was prepared to draw up a proposal to this effect, if so desired by the majority of delegations.

613. The Chairman’s opinion was that the present version did not permit of the subsequent payment of the search fee.

614. The FEMPI delegation endorsed the Austrian delegation’s suggestion.

615. The French delegation referred to Rule 46, paragraph 2, under which the applicant could request that a search fee be refunded if the IIB had unjustly denied the unity of the application and had therefore demanded further search fees. It thought that a similar solution could perhaps be found for the present case, and that the other similar cases would possibly have to be settled in the same way, and this might be going too far.

616. The Netherlands delegation pointed out that Article 124 would have to be thoroughly overhauled if Main Committee II should decide to incorporate the IIB as one of the European Patent Office’s administrative units. It said that for the time being it could agree to the present version of Article 124, but reserved the right to return subsequently to this provision in general, but with particular reference to the question of liability to pay fees.

617. The Chairman considered that, irrespective of whatever amendments Main Committee II might make to Article 124, Main Committee I should continue to work on the premise that the applicant would have to pay an additional search fee, under certain conditions.

618. The FICPI delegation said it would welcome the idea of the Implementing Regulations making express provision for the filing of qualified applications.

619. The Chairman replied that the point at issue here was a far more limited one, namely whether the applicant had to pay the additional search fee within the specified time limit or could pay it subsequently.

620. Finally, after general consultation, the Chairman noted the Main Committee’s view that the applicant had to pay the additional search fee under Article 124, paragraph 3, even if he believed that he had not necessitated the obtaining of supplementary search reports. In this case he could file an appeal and, if successful, could demand a refund of the fee he had paid.

621. The delegation of the Federal Republic of Germany, supported by several other delegations, proposed extension of the time limit for the payment of the additional search fee from one to two months (M/47//II/III, point 18).

622. The Swiss delegation did not consider that this time limit should be extended, since the proceedings could be unduly impeded as a result. Furthermore, the time limit for the payment of the main search fee was also one month.

623. 8 delegations voted in favour of the time limit for payment being extended to two months, 2 delegations voted against and there were 3 abstentions.

624. At a subsequent meeting of the Main Committee, the delegations of the Netherlands, Switzerland and the United Kingdom proposed the deletion of paragraph 2, sub-paragraph (a) (M/104/I).

625. In support of this proposal, the Netherlands delegation said that it was not warranted to make the applicant bear the cost of a supplementary search report which he had made it necessary to obtain, unless the report was drawn up by a body other than the European Patent Office. This would no longer be the case since it had more or less been established that, from the very beginning, the IIB would be incorporated in the European Patent Office. In these circumstances, it would only complicate the proceedings for grant unduly to make the applicant pay for searching, the need for which became apparent only during the proceedings themselves. The drop in income which the European Patent Office would sustain as a result of the additional search fee not being paid could be compensated by a slight increase in other fees, particularly the main search fee. Furthermore, the national patent offices also carried out similar supplementary searching without being paid for it.

626. The French delegation emphatically supported this proposal, which it considered would serve to simplify the proceedings before the European Patent Office.

627. The WIPO delegation pointed out that Article 124, paragraph 2, apart from sub-paragraph (a), had to relate solely to international applications for which an international search report had already been drawn up and the corresponding fee paid. General provision for the proceedings for processing international applications was, however, already made in Article 156. It was a question of simplifying the proceedings by releasing the applicant from the obligation to an additional search fee, the same considerations should also prevail in the case of supplementing the international search report.

628. The Chairman pointed out that a difference could be perceived between the two cases, inasmuch as in the former the original searching was done by the European Patent Office, whereas in the latter, searching originally conducted elsewhere was supplemented.

629. Since no delegation opposed the proposal put forward by the Netherlands, Swiss and United Kingdom delegations for the deletion of sub-paragraph (a), it was adopted.

630. Following this decision of the Main Committee, the Netherlands delegation queried whether there was any point in retaining sub-paragraph (b), considering that in the eventuality of the Administrative Council recognising a specific category of international search reports as the equivalent of European search reports under Article 156, the situation would be the same as in the case of sub-paragraph (a) which had already been deleted, and it would therefore be unfair to collect a supplementary search fee from the applicant.

The Netherlands delegation said it did not intend its statement to be taken as a formal proposal at this stage.

631. The Swedish delegation adopted as its own proposal the Netherlands’ suggestion, whose main advantage it saw as simplifying proceedings.

632. The Netherlands delegation supported the Swedish proposal.

633. The United Kingdom delegation expressed its readiness to support this proposal as well, but thought that a provision was needed whereby a supplementary search report for which a fee had to be paid could be drawn up if the international search report under Article 17 of the PCT could not be obtained or could be obtained only partially.

634. The Chairman considered that the problem raised by the United Kingdom delegation was settled by Rule 45.

635. The French delegation considered there was a great difference between the case referred to in sub-paragraph (a) and that of sub-paragraph (b), which was now under discussion. The first case referred to searching carried out by the European Patent Office itself which had to be supplemented, whereas the second was a case where searching by an International
should embody the principle that, in proceedings before the European Patent Office, it was the original text of a patent application and not its translation into the language of the proceedings which prevailed. It considered that paragraph 1 should therefore state that throughout the proceedings the translation could be brought into conformity with the original text (M/105/1).

587. The Netherlands delegation could support the Belgian proposal, but pointed out that, under Article 68 (70), paragraph 2, the original text of the European patent application determined whether or not the subject-matter of the application or patent extended beyond the content of the application as filed. This held good in all cases, irrespective of whether the patent application was filed in the language of the proceedings or only translated subsequently.

588. The Italian delegation also supported the Belgian proposal. It pointed out that the applicant could incur a certain amount of expenditure if he decided to bring the translation in the language of the proceedings into conformity with the original text.

589. The delegation of the International Chamber of Commerce wondered whether the eventuality referred to in the Belgian proposal might not be covered by Rule 89 (88), under which linguistic mistakes in documents which had been filed at the European Office could be corrected.

590. The Swiss delegation said that it took Article 68, paragraph 2, to mean that the original text, not the translation, prevailed, where opposition or a revocation action followed from the subject-matter of the patent extending beyond the content of the application as filed.

591. The Chairman and the Netherlands delegation said that they, too, interpreted Article 68, paragraph 2, in this way.

592. Since the translations of patent applications referred to in Article 14, paragraph 2, could be corrected, the United Kingdom delegation wondered whether it should not perhaps also be possible for the documents referred to in Article 14, paragraph 4, to be corrected.

593. The Chairman noted that, in the view of the Main Committee, no particular provision was needed here since, in proceedings before the European Patent Office, the correction of translations of documents other than patent applications (for which alone there must be a special provision, on account of the filing date), had to be allowed at all times.

594. The Main Committee adopted the Belgian proposal.*

Article 123 (124) — Information concerning national patent applications

595. The Main Committee referred to the Drafting Committee a drafting proposal from the United Kingdom delegation concerning the English version of paragraph 1.

596. The Main Committee referred to the Drafting Committee a drafting proposal from the Netherlands delegation concerning paragraph 2 (M/32, point 20).

Article 124** — Supplementary European search report

597. The Norwegian delegation proposed that paragraph 2 (a) should be so amended that the applicant bore the cost of the supplementary search report only where he had amended the patent claims to such an extent as to render supplementary searching necessary (M/31/1, page 1). It wished in this way to avoid a situation in which each and every amendment to claims necessarily resulted in a supplementary search report.

598. The Netherlands delegation had no objections to this amendment, since it could scarcely conceive of any other cases in which a supplementary search report would be necessary.

599. The United Kingdom delegation thought there might conceivably be other cases in which a supplementary search report proved necessary, e.g. if the Examining Division wished to use a different priority date for the examination than that decided on by the Search Division, and therefore it would be preferable to retain the present version of sub-paragraph (a).

600. The Norwegian delegation doubted whether the applicant would have to bear the cost of the supplementary search report in the instance referred to by the United Kingdom delegation.

601. The Italian delegation thought that the Norwegian proposal might prove pointless if paragraph 1 were taken to mean that the European Patent Office had to obtain only such supplementary search reports as it deemed necessary.

602. The Netherlands delegation considered that, in the few cases where an amendment to the claims did not necessitate a supplementary search report, the European Patent Office could bear the cost without further ado.

603. The delegation of the Federal Republic of Germany preferred the present version of paragraph 2, sub-paragraph (a), on the grounds that there might conceivably be other cases in which the applicant had occasioned the need for a search report, without actually amending the patent claims. For example, he might delete part of the description. If a supplementary search report was thus rendered necessary, it was reasonable that the applicant should bear the cost thereof.

604. In the ensuing vote on the Norwegian proposal, 5 delegations voted in favour and 5 against, with 4 abstentions.

605. With regard to paragraph 2, sub-paragraph (b), the CNIPA delegation queried whether a report could be obtained only to supplement an international search report under Article 156 (157) or also in other cases. If this were so, it would be unfair to exact an additional fee from the applicant.

606. The Chairman considered that Articles 124 and 136 were designed to deal with two distinct cases. Article 156 laid down that, under certain conditions, a supplementary search report should be obtained in respect of every international application, whereas under Article 124, the European Patent Office could, in specific instances, obtain a supplementary search report if it deemed the international search report to be inadequate.

607. This view was endorsed by the United Kingdom delegation.*

608. The Austrian delegation wondered whether the applicant could appeal against a request made to him by the European Patent Office under paragraph 3 to pay the additional search fee if he considered that he had not necessitated the obtaining of a search report.

609. The delegations of the Federal Republic of Germany and of Switzerland imagined that the procedure in such a case would be as follows. An applicant failed to pay the fee required of him in due time, so that his application was deemed to be withdrawn, pursuant to the second sentence of paragraph 3. He was informed of this fact by the European Patent Office, in accordance with Rule 70 (69), paragraph 1. Under Rule 70 (69), paragraph 2, the applicant could apply for a decision on this notification. An appeal against this decision was possible.

610. The FICPI delegation thought that if this really was the procedure, the application would run the danger of being deemed to be withdrawn, if the Board of Appeal took the view that the additional search fee should have been paid. This danger had to be avoided at all costs otherwise there would be virtually no possibility of filing an appeal. Therefore the applicant had to be enured to pay the additional search fee subsequently and should be able to request this by way of an amendment in the notice of appeal.

611. The delegation of the Federal Republic of Germany...
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MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Munich, 10 September to 5 October, 1973)

published by the
Government of the Federal Republic of Germany
Article 158

Publication of the international application and its supply to the European Patent Office

(1) Publication under Article 21 of the Cooperation Treaty of an international application for which the European Patent Office is a designated Office shall, subject to paragraph 2, take the place of the publication of a European patent application and shall be mentioned in the European Patent Bulletin. Such an application shall not however be considered as comprised in the state of the art in accordance with Article 54, paragraph 3, if the conditions laid down in paragraph 1a are not fulfilled.

(1a) The international application shall be supplied to the European Patent Office in one of its official languages. The applicant shall pay to the European Patent Office a national fee provided for in Article 22, paragraph 1, C. Article 39, paragraph 1, of the Cooperation Treaty.

(2) If the international application is published in a language other than one of the official languages of the European Patent Office, that Office shall publish the international application, supplied as specified in paragraph 2. Subject to the provisions of Article 67, paragraph 3, the provisional protection in accordance with Article 67, paragraphs 1 and 2, shall be effective from the date of that publication.
MUNICH DIPLOMATIC CONFERENCE

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

- 1973 -

Munich, 30 September 1973
M/146/R 6

Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Convention: Articles 140 to 166
Article 157

Publication of the international application
and its supply to the European Patent Office

(1) Publication under Article 21 of the Cooperation Treaty
of an international application for which the European Patent
Office is a designated Office shall, subject to paragraph 2,
take the place of the publication of a European patent appli-
cation and shall be mentioned in the European Patent Bulletin.
Such an application shall not however be considered as
comprised in the state of the art in accordance with Article
52, paragraph 3 if the conditions laid down in paragraph 1a
are not fulfilled.

(1a) The international application shall be supplied to the
European Patent Office in one of its official languages. The
applicant shall pay to the European Patent Office a national
fee provided for in Article 22, paragraph 1, and Article 39,
paragraph 1, of the Cooperation Treaty.

(2) If the international application is published in a language
other than one of the official languages of the European Patent
Office, that Office shall publish the international application,
supplied as specified in paragraph 1a. Subject to the provisions
of Article 65, paragraph 3, the provisional protection in
accordance with Article 65, paragraphs 1 and 2, shall be effective
from the date of that publication.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 27 September 1973

M/136/I/R 10

Original: English/French/German

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

Articles of the Convention:

| Articles | 14 | 52 | 79 | 89 | 90 | 91 | 95 | 101 | 105 | 121 | 124 | 133 | 134 | 148 | 150 | 151 | 152 | 153 | 153a | 154 | 155 | 156 | 157 | 161 |
|----------|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|----|
Article 157

Publication of the international application and its supply to the European Patent Office

(1) Publication under Article 21 of the Cooperation Treaty of an international application for which the European Patent Office is a designated Office shall, subject to paragraph 2, take the place of the publication of a European patent application and shall be mentioned in the European Patent Bulletin. Such an application shall not however be considered as comprised in the state of the art in accordance with Article 52, paragraph 3 if the conditions laid down in paragraph 1a are not fulfilled.

(1a) The international application shall be supplied to the European Patent Office in one of its official languages. The applicant shall pay to the European Patent Office a national fee provided for in Article 22, paragraph 1, and Article 39, paragraph 1, of the Cooperation Treaty.

(2) If the international application is published in a language other than one of the official languages of the European Patent Office, that Office shall publish the international application, supplied as specified in paragraph 1a. Subject to the provisions of Article 65, paragraph 3, the provisional protection in accordance with Article 65, paragraphs 1 and 2, shall be effective from the date of that publication.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 22 September 1973
M/124/I/R 8
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 21 SEPTEMBER 1973

Articles of the Convention:

Article 96
Article 101
Article 157
Article 161

Rules of the Implementing Regulations:

Rule 20
Rule 32
Rule 35
Rule 38
Rule 40
Rule 41
Rule 43
Rule 46
Rule 50
Rule 52
Rule 59
Article 157

Publication of the international application and its supply to the European Patent Office

(1) Publication under Article 21 of the Cooperation Treaty of an international application for which the European Patent Office is a designated Office, subject to paragraph 2, shall take the place of the publication of a European patent application and shall be mentioned in the European Patent Bulletin. Such an application shall not however be considered as comprised in the state of the art in accordance with Article 59, paragraph 3, if the conditions laid down in paragraph 1a are not fulfilled.

(1a) The international application shall be supplied to the European Patent Office in one of its official languages. The applicant shall pay to the European Patent Office a national fee provided for in Article 22, paragraph 1, and Article 39, paragraph 1, of the Cooperation Treaty.

(2) If the international application is published in a language other than one of the official languages of the European Patent Office, that Office shall publish the international application, supplied as specified in paragraph 1a. Subject to the provisions of Article 65, paragraph 3, the provisional protection in accordance with Article 65, paragraphs 1 and 2, shall be effective from the date of that publication.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 20 September 1973
M/113/I/R 6
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 19 SEPTEMBER 1973

Articles of the Convention:

Articles 52
153
157
Article 157

Publication of the international application

(1) Publication under Article 21 of the Cooperation Treaty of an international application for which the European Patent Office is a designated Office shall take the place of the publication of a European patent application and shall be mentioned in the European Patent Bulletin.

(2) Nevertheless, if the international application is published in a language other than one of the official languages of the European Patent Office, that Office shall publish the international application, supplied as specified in Article 153, paragraph 2. Subject to the provisions of Article 65, paragraph 3, the provisional protection in accordance with Article 65, paragraphs 1 and 2, shall be effective from the date of that publication.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 18 September 1973
M/98/I/R 4
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 17 SEPTEMBER 1973

Articles of the Convention:

Articles 50
130
137
138
139
141
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157
Proposal on Article 157

Paragraph 1 of Article 157 should read:

(1) Publication under Article 21 of the Co-Operation Treaty of an international application for which the European Patent Office is a designated or elected Office shall take the place of the publication of a European patent application. However, such application shall not be considered as comprised in the state of the art under Article 52, paragraph 3, unless the applicant fulfills the requirements provided in Article 153, paragraph 2, or Article 155, paragraph 2.

Comments:

It is proposed that the prior art effect under Article 52(3) of international applications which are not maintained as European patent applications, should be excluded. Such applications should only become prior art as of their publication date.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 12 September 1973

W/71/I
Original: English

CONFERENCE DOCUMENT

Drawn up by: Norwegian delegation

Subject: Proposals for amendments to Articles 124, 139, 153, 155 and 157 of the Convention and Rules 66, 67, 69, and 97 of the Implementing Regulations
Rule 51 Paragraph 2

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

Rule 69 Paragraph 2

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

NOTES

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

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

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

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

- 1973 -

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

CONFERENCE DOCUMENT

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

Subject: Additional comments

In the Implementing Regulations should be inserted at an appropriate place, for instance after Rule 105, a new Rule to read as follows: "The mention of the publication of an international application pursuant to Article 157, paragraph 1, shall be effected by publishing the name and the address of the applicant, the number under which the publication took place and the Contracting State or States designated in the international application."

To be seen in connection with the Netherlands proposal to Article 157, paragraph 1.
15. **Proposal of the Netherlands Delegation to Article 157, paragraph 1.**

Article 157, paragraph 1 should be amended to read:

"(1) Publication under Article 21 of the Co-operation Treaty of an international application for which the European Patent Office is a designated Office shall take the place of the publication of a European patent application and shall be mentioned in the European Patent Bulletin."

See also the Netherlands proposal for a new Rule to be inserted in the Implementing Regulations.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 10 September 1973

M/52/I/II/III

Original: English

CONFERENCE DOCUMENT

Drawn up by: Netherlands delegation

Subject: Proposals for amendments to the draft texts
applicant of the international application has indicated that he wishes to obtain a European patent for one or more of the designated States of the group or has designated a Contracting State in the group, whose national law provides that the designation of that State shall have the effect of the application being for a European patent.

23. Article 157, par. 1:

In order to facilitate the identification of international (PCT) applications, in which States party to this Convention are designated, we propose to add to the last line of this paragraph the following words:

"and shall be mentioned in the European Patent Bulletin". Furthermore we propose to insert in the Implementing Regulations, at an appropriate place, the following new Rule:

"The mention of the publication of an international application pursuant to Article 157, paragraph 1, shall be effected by publishing the name and address of the applicant, the number under which the publication took place and the Contracting State or States designated in the international application."

24. Rule 13, par. 2:

We wonder whether this paragraph is not superfluous, because it seems just a repetition of what has already been expressed in the preceding paragraph 1.

25. Rule 13, par. 4:

Pursuant to the second sentence of this paragraph it may happen that the reinstated time limit will end embarrassingly soon after the communication of the resumption of the proceedings. It seems only fair to the party concerned to introduce here a minimum of, say, one month. Therefore we propose to add to the last line of this paragraph the following sentence:

"However, if the time limit ends prior to the expiration of one month from said communication, it is extended till the end of that month".

./.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Brussels, 1 June 1973
M/32
Original: English

PREPARATORY DOCUMENT

Drawn up by: Netherlands Government

Subject: Observations and proposed amendments concerning the Draft Convention and the Draft Implementing Regulations
Gebühr durch das Europäische Patentamt weiterbearbeitet wird oder nicht, gemäß Artikel 52 Absatz 3 zum Stand der Technik gehört. Nach Ansicht Norwegens ist diese Konsequenz nicht wünschenswert und sollte durch eine Änderung des Artikels 157 Absatz 1 ausgeschlossen werden.

16 Hinsichtlich des Entwurfes einer Ausführungsordnung beschränkt sich die norwegische Regierung auf folgende Bemerkungen:


Aus den vorhergehenden Absätzen der Regel 2 ergibt sich, daß Erklärungen in einer anderen Sprache als der Amtsprache in mehreren Fällen in eine andere Amtsprache als die Verfahrenssprache übersetzt werden können. Nach norwegischer Auffassung sollte die Erklärung in diesen Fällen in der Sprache der Übersetzung aufgenommen werden. Anderenfalls muß die Erklärung zweimal übersetzt werden, bevor sie in die Niederschrift aufgenommen werden kann, und noch zweimal, wenn der die Erklärung abgebende die Niederschrift genehmigt (Regel 77 Absatz 2). Das könnte leicht zu Mißverständnissen führen.

18 In Verbindung mit der Regel 23 über die Ausstellungsbescheinigung wird vorgeschlagen, daß der Anmelder auch den Nachweis erbringen muß, daß die betreffende Ausstellung tatsächlich unter das Übereinkommen über internationale Ausstellungen fällt.

19 Nach der Regel 67 Absatz 3 Buchstabe g und der Regel 69 Absatz 2 sind die Entscheidungen des Europäischen Patentamts zu begründen. Entscheidungen können jedoch mehrheitlich getroffen werden, und in solchen Fällen müßte dies besonders erwähnt werden. Mitglieder, die eine andere Auffassung vertreten, sollten darüber hinaus Gelegenheit erhalten, ihre Gründe darzulegen.

fee. In the Norwegian opinion, this consequence is unfortunate and should be precluded by an amendment to Art. 157(1).

16 As regards the Draft Implementing Regulations the Norwegian Government will limit itself to the following remarks:

17 According to Rule 2(6) statements made in one of the official languages of the European Patent Office during oral proceedings shall be entered in the minutes in the language employed. However, statements made in any other language shall always be entered in the language of the proceedings.

It follows from the preceding paragraphs of Rule 2 that statements made in other languages than the official ones may in several instances be translated into another official language than the language of the proceedings. In the Norwegian view, the statement should in these cases be entered in the language of the translation. Otherwise the statement has to be translated twice before it can be entered in the minutes, and twice again when the person who submitted the statement is going to approve the minutes (Rule 77(2)). This might easily give cause to misunderstandings.

18 In connection with Rule 23 on certificate of exhibition it is proposed that the applicant also should be obliged to furnish a proof, stating that the exhibition concerned actually falls within the terms of the Convention on International Exhibitions.

19 According to Rules 67(3)(g) and 69(2) decisions of the European Patent Office shall contain reasons. Decisions may, however, be taken by a majority and in such cases this fact ought to be mentioned separately. The dissenting members should moreover have the opportunity of stating their reasons.
Europäische Patentamt eine Anmeldung als zurückgenommen ansehen können, wenn der Anmelder einer Aufforderung nicht nachkommt.


14 Es sei auf den Fall aufmerksam gemacht, in dem der Anmelder einen oder mehrere europäische Staaten auswählt, die von dem Vorbehalt nach Artikel 64 Absatz 2 Buchstabe a des Zusammenarbeitsvertrags Gebrauch gemacht haben. In diesem Fall muß die von einem solchen Staat abgegebene Erklärung zusätzlich zu den Bestimmungen des Zusammenarbeitsvertrages berücksichtigt werden. Dem Artikel 155 sollte ein Absatz 3 hinzugefügt werden, der diese Variante erfaßt.

15 Nach Artikel 157 Absatz 1 tritt die Veröffentlichung einer internationalen Anmeldung nach dem Zusammenarbeitsvertrag, in der das Europäische Patentamt benannt ist, an die Stelle der europäischen Veröffentlichung. Diese Bestimmung dürfte in Verbindung mit Artikel 150 Absatz 3 zur Folge haben, daß eine solche internationale Anmeldung unabhängig davon, ob sie nach Einreichung einer Übersetzung und Entrichtung einer nationalen able to deem an application to be withdrawn if the applicant fails to reply.

11 In connection with Art. 125 the sixth meeting of the Inter-Governmental Conference “established that the European Patent Office may not grant more than one European patent to the same person for the same invention being the subject of applications filed on the same date” (Minutes par. 49). However, in the Norwegian opinion, it follows from Art. 52(3) that applications filed on the same day do not at all constitute novelty hindrance against each other and that an applicant may thus without detriment to himself file several applications on the same day. Under the circumstances, a possible restriction as established at the sixth meeting should be expressly stated in the Convention.

12 According to Art. 139(3) the contracting states may prescribe whether an invention disclosed in both a national patent and a European patent having the same date of filing, may be protected simultaneously by both patents. The Norwegian Government questions whether it is right to allow the states to revoke the European patent in these cases. This seems particularly doubtful where the European patent and the national patent belong to different inventors.

13 As Art. 153 only deals with the European Patent Office as a designated office under the Patent Cooperation Treaty, the reference in paragraph 2 to Art. 39(1) of the Cooperation Treaty should be omitted. To Art. 155 should, on the other hand, be added a second paragraph corresponding to Art. 153(2), yet with reference to the national fee provided for in Art. 39(1) of the Cooperation Treaty.

14 Attention is drawn to the case where the applicant elects one or more European states which have made use of the reservation under Article 64(2)(a) of the Patent Cooperation Treaty. In this case the declaration made by such state must be applied in addition to the provisions of the Cooperation Treaty itself. A third paragraph ought to be added to Art. 155 to cover this alternative.

15 According to Art. 157(1) publication under the Cooperation Treaty of an international application in which the European Patent Office is designated, shall take the place of the European publication. This provision, together with Art. 150(3), seems to entail that such international application will become prior art pursuant to Art. 52(3) irrespective of whether it is carried on with the European Patent Office by furnishing of a translation and a national
STELLUNGNAHME
DER NORWEGISCHEN REGIERUNG

COMMENTS
BY THE NORWEGIAN GOVERNMENT

PRISE DE POSITION
DU GOUVERNEMENT NORVÉGIEN
34 Artikel 157

Es ist wünschenswert, daß die Veröffentlichung einer internationalen Anmeldung gemäß dem PCT auch in den Veröffentlichungen des Europäischen Patentamts erwähnt wird.

35 Artikel 161

Es ist wünschenswert, daß unabhängig von den — stufenweise abzubauenden — Beschränkungen bei der Prüfung europäischer Patentanmeldungen in allen Fällen der Recherchenbericht erstellt wird.

34 Article 157

Publications, under the PCT, of international applications should be mentioned in the publications of the European Patent Office.

35 Article 161

Whatever the restrictions — to be gradually eliminated — on the examination of European patent applications, a search report should in all cases be drawn up.
STELLUNGNAHME DES

FEMIPI

Europäischer Verband der Industrie-Patentingenieure

COMMENTS BY

FEMIPI

European Federation of Agents of Industry in Industrial Property

PRISE DE POSITION DE LA

FEMIPI

Fédération européenne des mandataires de l’industrie en propriété industrielle
mit PCT-Ursprung handelt, sofern dies der Fall ist.

Artikel 157 — Veröffentlichung der internationalen Anmeldung

38 CIFE möchte, daß im Europäischen Patentblatt auf die Veröffentlichung der europäischen Anmeldung auch dann hingewiesen wird, wenn die entsprechende internationale Anmeldung bereits veröffentlicht worden ist.

Part Three
EDITORIAL COMMENTS

Article 16 — Competence of the Receiving Section

39 At least in the French text it would be desirable to improve the wording to render more explicit the cumulative character of the two conditions, the Receiving Section remaining responsible up to the date of the later of the two conditions to be fulfilled.

Part Four
REPRESENTATION

Articles 133, 134 and 162

42 The present text of Articles 133 and 134 is considered satisfactory by CEIF as to their substance.
STELLUNGNAHME DES
CIFE
Rat der Europäischen Industrieverbände

COMMENTS BY
CEIF
Council of European Industrial Federations

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

(1) English translation submitted by CEIF
Artikel 157

23 Es ist wünschenswert, in einer Notiz im Europäischen Patentblatt auf die Veröffentlichung internationaler Anmeldungen nach Artikel 21 des Zusammenarbeitsvertrages hinzuzweisen, damit die interessierten Kreise einen Gesamtüberblick über die eingereichten Anmeldungen haben können, wenn sie nur die Veröffentlichungen dieses Patentblattes verfolgen.

Artikel 161

24 Eine Klärung erscheint wünschenswert, ob für alle Anmeldungen ein Recherchenbericht erstellt wird, auch wenn sie anschließend nicht weiterverfolgt werden können.

Artikel 162

25 Um zu vermeiden, daß der englische Text, der den Begriff „professional representatives“ verwendet, zu einer Auslegung führt, die mit dem deutschen und französischen Text nicht vereinbar ist (im Deutschen: „zugelassener Vertreter“, im Französischen: „mandataires agréés“), sollte in einer Randnote präzisiert werden, daß dieser Begriff Angestellte und Freiberufler umfaßt.

26 Der verbesserte Text des Artikels 162 enthält noch einige Spuren der alten Fassung, die den vorgenommenen Veränderungen angepaßt werden sollten. Hierzu schlägt die U.N.I.C.E. einen Text vor, der als Anlage 1 beigefügt ist.

27 Während der Anhörung der interessierten Kreise in Luxemburg im Januar 1972 hat der Präsident der Konferenz die Absicht der Konferenz der Sachverständigen unterstrichen, während der Übergangsperiode die vorhandene Lage und die erworbenen Rechte zu respektieren, ohne sie auszuweiten oder einzuschränken.

Diesbezüglich ist darauf hinzuzweisen, daß die gegenwärtigen Rechte zur Vertretung anderer Gesellschaften, über die Gesellschaften in manchen Mitgliedstaaten verfügen, vergessen worden sind. Folglich wird vorgeschlagen, einen Artikel 161 bis aufzunehmen, dessen Fassung als Anlage 2 beigefügt ist.

Artikel 166, paragraph 2(a)

28 UNICE wishes the period within which reservations
STELLUNGNAHME DER
UNICE
Union der Industrien der Europäischen Gemeinschaft

COMMENTS BY
UNICE
Union des Industries de la Communauté européenne

PRISE DE POSITION DE
L'UNICE
Union des Industries de la Communauté européenne

(1) Deutsche Übersetzung der Stellungnahme und der Anlage 2 vorgelegt von UNICE
(2) Annex 3 to these Comments submitted by UNICE in English
Diese Bestimmung sollte wie folgt geändert werden:

„Ist die internationale Anmeldung jedoch in einer Sprache veröffentlicht, die nicht eine der Amtssprachen des Europäischen Patentamts ist, so veröffentlicht das Europäische Patentamt die ihm nach Artikel 153 Absatz 2 zugeleitete internationale Anmeldung. Vorbehaltlich Artikel 65 Absatz 3 tritt der einstweilige Schutz nach Artikel 65 Absätze 1 und 2 erst von dem Tag dieser Veröffentlichung an ein."

Begründung:

Nach Artikel 157 Absatz 1 des Übereinkommens tritt die Veröffentlichung einer internationalen Anmeldung für die das Europäische Patentamt Bestimmungamt ist, durch das Internationale Büro an die Stelle der Veröffentlichung der europäischen Patentanmeldung. Da internationale Anmeldungen nicht nur in Deutsch, Englisch oder Französisch veröffentlicht werden können, sondern auch in Japanisch oder Russisch, hat Artikel 157 Absatz 1 notwendigerweise zur Folge, daß die Veröffentlichung einer internationalen Patentanmeldung auch in japanischer oder russischer Sprache an die Stelle der Veröffentlichung der europäischen Patentanmeldung tritt. Die Schwierigkeiten, die daraus für den vorläufigen Schutz entstehen können, haben dazu geführt, in Artikel 157 Absatz 2 für jeden Vertragsstaat die Möglichkeit vorzusehen, den vorläufigen Schutz davon abhängig zu machen, daß eine Übersetzung der internationalen Anmeldung ins Deutsche, Englische oder Französische entweder der Öffentlichkeit zugänglich gemacht worden oder dem vermeintlichen Patentverletzer übermittelt worden ist.

Die Mitgliedsstaaten der Europäischen Gemeinschaften haben nun festgestellt, daß bereits aufgrund des Artikels 153 Absatz 2 eine solche Übersetzung dem Europäischen Patentamt zuzuweisen ist und folglich verfügbar sein wird.

Sie sind deshalb der Auffassung, daß eine rationale Lösung und die zur Zeit in Artikel 157 Absatz 2 vorgesehene Lösung angestrebt werden sollte; diese Lösung sollte darin bestehen, daß das Europäische Patentamt die internationale Anmeldung in dieser Übersetzung veröffentlichen muß. Der einstweilige Schutz könnte dann vom Zeitpunkt dieser Veröffentlichung an gewährt werden, und die einzelnen Vertragsstaaten bräuchten nicht jeder für sich entsprechende Bestimmungen zu erlassen. Das in Artikel 65 Absatz 3 des Übereinkommens eingeräumte Recht, daß jeder Vertragsstaat, dessen Amtssprache nicht die Verfahrenssprache der Anmeldung ist, die Gewährung des einstweiligen Schutzes von der Vorlage einer Übersetzung der Patentansprüche in eine seiner Amtssprachen abhängig machen kann, würde durch diese Bestimmung nicht berührt.

13 Article 157, paragraph 2

It is proposed that this provision be amended as follows:

"Nevertheless, if the international application is published in a language other than one of the official languages of the European Patent Office, that Office shall publish the international application, supplied as specified in Article 153, paragraph 2. Subject to the provisions of Article 65, paragraph 3, the provisional protection in accordance with Article 65, paragraphs 1 and 2, shall be effective from the date of that publication."

Reason:

Article 157, paragraph 1, of the Convention provides that the publication by the International Office of an international application for which the European Patent Office is a designated Office shall take the place of the publication of a European patent application. Since international applications may be published in Russian or Japanese as well as in English, French or German, Article 157, paragraph 1, therefore has the effect of allowing even international applications in Russian or Japanese to take the place of the publication of a European patent application. Because of the difficulties to which this could give rise as concerns provisional protection, provision has been made in Article 157, paragraph 2, for an option on the part of any Contracting State to make provisional protection subject to a translation of the international application in English, French or German being made available to the public or being communicated to the presumed infringer in the State in question.

However the Member States of the European Communities noted that under Article 153, paragraph 2, such a translation must in any event be supplied to the European Patent Office and would therefore be available.

They therefore considered that a more rational solution than that laid down in Article 157, paragraph 2, would be to make it compulsory for the European Patent Office to publish the international publication in this translation. Provisional protection could thus be granted from the date of the publication of the translation, thereby relieving each Contracting State of the need to apply corresponding provisions to this end. The new provision would not affect the option provided under Article 65, paragraph 3, of the Convention whereby any Contracting State which does not have as an official language the language of the application proceedings, may make provisional protection subject to the submission of the translation of the claims in one of its official languages.
STELLUNGNAHME

DER MITGLIEDSTAATEN DER EUROPÄISCHEN GEMEINSCHAFTEN

COMMENTS

BY THE MEMBER STATES OF THE EUROPEAN COMMUNITIES

PRISE DE POSITION

DES ÉTATS MEMBRES DES COMMUNAUTÉS EUROPÉENNES
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)

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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

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1973
(2) Nevertheless if the international application is published in a language other than one of the official languages of the European Patent Office, any Contracting State may, additionally to the provisions of Article 65, paragraph 3, stipulate that provisional protection in accordance with Article 65, paragraphs 1 and 2, shall not be effective until such time as a translation of the international application in one of these languages either has been made available to the public in the manner prescribed by national law or has been communicated to any person using the subject-matter of the application in the said State.

Artikel 156
Internationaler Recherchenbericht


(2) Vorbehaltlich der Beschlüsse des Verwaltungsrats nach Absatz 3
a) holt das Europäische Patentamt beim Internationalen Patentinstitut einen ergänzenden europäischen Recherchenbericht zu jeder internationalen Anmeldung ein;

b) hat der Anmelder die Rechencegebühr zu zahlen, die gleichzeitig mit der nationalen Gebühr nach Artikel 22 Absatz 1 und Artikel 39 Absatz 1 des Zusammenarbeitvertrags zu entrichten ist. Ist die Rechencegebühr nicht rechtzeitig entrichtet worden, so gilt die Anmeldung als zurückgenommen.

(3) Der Verwaltungsrat kann beschließen, unter welchen Voraussetzungen und in welchem Umfang
a) auf einen ergänzenden europäischen Recherchenbericht verzichtet wird;

b) die Rechencegebühr herabgesetzt wird.

(4) Der Verwaltungsrat kann die nach Absatz 3 getroffenen Beschlüsse jederzeit ändern.

Vgl. Regel 70 (Feststellung eines Rechtsverlusts)

Artikel 157
Veröffentlichung der internationalen Anmeldung

(1) Die Veröffentlichung einer internationalen Anmeldung nach Artikel 21 des Zusammenarbeitvertrags, für die das Europäische Patentamt Bestimmungsamt ist, tritt an die Stelle der Veröffentlichung der europäischen Patentanmeldung.

Article 156
International search report

(1) Subject to the provisions of Article 124, the international search report under Article 18 of the Co-operation Treaty or any declaration under Article 17, paragraph 2(a), of that Treaty and their publication under Article 21 of that Treaty shall take the place of the European search report and the mention of its publication in the European Patent Bulletin.

(2) However, subject to the decisions of the Administrative Council referred to in paragraph 3,
(a) the European Patent Office shall request the International Patent Institute to supply a supplementary European search report in respect of all international applications;

(b) the applicant shall pay the search fee, which shall be paid at the same time as the national fee provided for in Article 22, paragraph 1, and Article 39, paragraph 1, of the Co-operation Treaty. If the search fee is not paid in due time the application shall be deemed to be withdrawn.

(3) The Administrative Council may decide under what conditions and to what extent:
(a) the supplementary European search report is to be dispensed with, and

(b) the search fee is to be reduced.

(4) The Administrative Council may at any time rescind the decisions taken pursuant to paragraph 3.

Cf. Rule 70 (Noting of loss of rights)

Artikel 157
Publication of the international application

(1) Publication under Article 21 of the Co-operation Treaty of an international application for which the European Patent Office is a designated Office shall take the place of the publication of a European patent application.
ENTWURF EINES ÜBEREINKOMMENS
ÜBER EIN EUROPÄISCHES PATENTERTEILUNGSVERFAHREN

DRAFT CONVENTION
ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

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

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

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

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

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

DOCUMENTS PRÉPARATOIRES
élabord 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
during the life of a patent. Furthermore, as from the publication of the correction to the text, the competitor would be obliged, without prejudice to other provisions of national law, to cease the activity which constituted infringement.

77. The Working Party was also of the opinion that, in order to leave wide open the solution to be adopted within the framework of the Second Convention on the Community patent, and in order not to rule out the possibility that other Contracting States might also decide not to make the protection conferred by a patent dependent upon the presentation of a translation in one of their official languages, the proposals of the Swedish and United Kingdom delegations should be amended in such a manner as to make such a requirement purely optional.

78. As a consequence of these decisions, the Working Party amended Articles 123, 19, 34, 77, 78 and 85 and introduced a new Article 34a.

With regard to the amendments made to Re. Article 34, Nos. 2, 4 and 4a, see points 52, 50 and 49.

Article 137a (European divisional applications)

79. The Working Party adopted the proposal by the United Kingdom delegation to amend paragraph 1(a) in such a way as to allow the applicant to file a divisional application until such time as he replied to the first notification from the Examining Division. This provision had thus been aligned with the conditions laid down in Article 137b, paragraph 4, on amending the application.
Owing to the difficulty of establishing the concept of good faith in order to determine whether in a specific instance the assumed infringer was aware or not of the scope of the protection conferred by the patent in the language of the proceedings, the Working Party finally preferred not to draw up such a provision. It was considered however that the right should be granted to the proprietor of the patent to correct the text of the translation which was authentic in a given country. As soon as the text had been corrected, in such a way as to be brought into line with the text in the language of the proceedings, and had been either published or brought to the attention of the competitors, it would be impossible to invoke the earlier text in order to justify an activity which would constitute infringement within the meaning of the text in the language of the proceedings.

76. With regard to the period during which such a correction to the text of the patent might be carried out, the Swedish delegation stated that, in the interests of legal certainty, it would be advisable to limit it to a relatively short period, of, say, one year from the granting of the patent or from the time that the patent became final. Other delegations, on the contrary, thought that this possibility should remain open throughout the duration of the patent, since such errors of translation were likely to be discovered, in the majority of cases, only during infringement proceedings which might be initiated at any time.

In conclusion, the Working Party decided in favour of this second formula, i.e. the possibility for correction without restrictions as to timing. It was understood that this possibility for correction could be used several times.
application or of a European patent was that drawn up in the language of the proceedings before the European Patent Office, it being understood however that, to the extent that a State might have recourse to the option created under Article 19, paragraph 4, with respect to the application, and that created under Article 107a, paragraph 1, with respect to the granted patent, the text of the application or of the patent in one of the official languages of that State should be considered authentic, in so far as the protection (whether provisional or definitive) conferred by it did not extend beyond that conferred by the application or patent in the language of the proceedings.

75. In opposition to these proposals, it was pointed out that they ran the risk of diminishing the attraction offered by the European procedure, inasmuch as the protection conferred by the European patent could differ from country to country according to the text of the translation accepted in that country.

The interested circles had not, moreover, raised objections at the second hearing to the principle that the text in the language of the proceedings should be the authentic text in all States designated in the patent.

It was also pointed out that the consequence of the proposals from the United Kingdom delegation and from the Swedish delegation would be that a competitor of the proprietor of a patent might undertake an activity, in respect of which he would be likely to be charged with infringement of the terms of the patent in the language of the proceedings, if the text of the translation in the language of a Contracting State conferred a less extensive protection upon the holder. If such a consequence might be permitted if the competitor had no knowledge of the original text, it appeared less justified if the competitor was a large industry, perfectly capable of acquainting itself with the patent in the language of the proceedings.
The German delegation stated that if one worked on the assumption that in almost all cases, European applications would designate the States which constituted the European Communities and that, in accordance with the Second Convention, the provisional protection granted for the Common Market as a whole would depend upon the existence of a text of the application in one of the working languages of the European Patent Office and a translation of the claims in the other two languages, the objective of keeping the public informed could be fulfilled for almost all applications reaching the Office.

73. Following a broad exchange of views on the two proposals put forward, the Working Party adopted the proposal by the United Kingdom delegation, by a majority vote.

The German delegation made a reservation with regard to this solution.

74. The Working Party then turned its attention to the problem of the authentic text of a European application or a European patent.

The Working Party had the following proposals for consideration:

(a) proposal by the Swedish delegation (BR/GT I/153/72)
(b) proposal by the United Kingdom delegation
   (BR/GT I/150/72, pages 6 to 8)
(c) suggestion by the Chairman (BR/GT I/145/72, point 22).

The Working Party noted that the proposals from the United Kingdom and Swedish delegations, although varying in presentation, had essentially the same goal, i.e. that of stipulating that the authentic text of a European
71. The Working Party then considered the solution proposed by the United Kingdom delegation consisting of providing for a single system for all applications, whether European or international. With regard to international applications, it would be laid down that publication within the meaning of Article 21 of the PCT should replace publication of the European patent application under Article 85, without imposing any other condition. The provisional protection referred to in Article 19, paragraph 4, could be subject in all instances to the conditions laid down in this same provision (translation of claims in one of the official languages of a Contracting State should be made available to the public or communicated to the person using the subject-matter of the application). The Contracting States in which German, English or French was the official language should have the same possibility. This solution would however be adopted without in any way prejudicing the provisions to be taken under the Second Convention. Moreover, in instances of an international application being published by the International Bureau in a language other than one of the European Patent Office's working languages (Russian or Japanese), the provisional protection would be made subject by each Contracting State to the submission of a translation of the international application in one of the three official languages of that Office.

72. With due regard to the objections put forward against its request on the one hand, and to the remarks presented by the WIPO representative on the other, the German delegation was prompted to amend its original proposal and it submitted a new draft of Article 123 (BR/GT I/159/72). Under the terms of this draft, the system of translations provided for in Article 34, paragraph 5, would remain unchanged. With regard to international applications, on the other hand, provisional protection would only be granted to them if a translation of the claims in one of the other official languages of the European Patent Office were supplied within a period to be specified.
This proposal met with objections from several delegations. One delegation pointed out that it was opposed to the idea of entrusting the translation of claims to the Office for reasons of a financial nature, and also on account of the procedural complications which would be entailed by the need to obtain the agreement of the applicant to the text of the translations. It was also pointed out that, if the principle of the unity of the language of the proceedings were accepted, it could be questioned whether it was really necessary for information purposes to require the claims to be translated into the two other languages of the Office, all the more so since these translations would normally be supplied by the applicant and would not have been checked by the Office. The problem arose in different terms as regards the temporary protection which an application confers and, for this purpose, it could certainly be envisaged that the option currently granted by Article 19, paragraph 4, to all the Contracting States which have official languages other than German, English and French, be extended to all the Contracting States.

In this connection, it was pointed out that such a solution could not be envisaged without taking account of the repercussions it would have on the arrangements for languages under the Second Convention.

The solution adopted at present by the texts of the Second Preliminary Draft of the Second Convention published in 1971 excludes the possibility for the Contracting States of this Convention to have recourse to the option provided in Article 19, paragraph 4, or in Article 107a, paragraph 1, of the First Convention, without calling in question the unitary and autonomous nature of the Community patent.
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The solution adopted at present by the texts of the Second Preliminary Draft of the Second Convention published in 1971 excludes the possibility for the Contracting States of this Convention to have recourse to the option provided in Article 19, paragraph 4, or in Article 107a, paragraph 1, of the First Convention, without calling in question the unitary and autonomous nature of the Community patent.
(b) or a translation of the claims in the other two languages when the international application had been published by the International Bureau in one of the three working languages of the European Patent Office,

was not compatible with Article 22 of the PCT nor with Rule 49.2 of the Regulations under the PCT.

Quite a different problem was that of the conditions which may govern temporary protection conferred by the international application. For this purpose, Article 29, paragraph 2, of the PCT expressly provides for the possibility of requiring translations which, the European Patent Office being considered as a national office, may be extended to one or more of the official languages of the Contracting States.

70. The German delegation indicated that its proposal was principally intended to settle the problem of international applications without calling in question the arrangements set out in Article 34, paragraph 5, for European applications.

In addition, it was striving to create the conditions which would enable the European Patent Office to have available translations of the claims, even for international applications, in its three working languages in order to be able to keep the public informed, which was the main objective of the system of publishing the application relatively soon after filing. For this purpose, it could be laid down that translations would be prepared by the European Patent Office and submitted to the applicant for his approval; however, if the applicant consented to supply translations voluntarily, he could benefit from a reduction in fees.

BR/177 e/72 nan/KM/gc
(b) determination which would be the authentic text, both for the European application and for the granted European patent (the text of the language of the proceedings or the text of the translation which may be required by a Contracting State, in accordance with Article 19, paragraph 4 or Article 107a, paragraph 1).

67. Before examining these problems, the Working Party confirmed its agreement to the provision of Re. Article 34, No. 1, paragraph 1, according to which, if an application was filed in an official language of the Contracting States other than the three working languages of the European Patent Office, this text would be taken into consideration, in the proceedings brought before the Office, in order to determine whether the subject-matter of the application (or of the patent during opposition) had not been extended beyond the contents of the application as filed.

68. The Working Party then dealt with the question of the consequences of the incompatibility of the system under Article 123, paragraph 5, with the provisions of the PCT. The Working Party had two proposals to discuss, one from the United Kingdom delegation (BR/GT I/156/72) and the other from the German delegation (BR/GT I/157/72).

69. The WIPO representative, confirming the statement which had been made at the 5th Meeting of the Conference, stated that to require the applicant to produce:

(a) either a translation of his international application in one of the working languages of the European Patent Office, accompanied by the translation of the claims in the other two languages, when the application had not been published by the International Bureau in one of these three languages,
64. The Working Party did not however adopt the proposals submitted to it whereby the Enlarged Board of Appeal would only have resorted to oral proceedings if it considered it necessary. Although the Enlarged Board of Appeal would take decisions on questions of law and not of fact, the Working Party saw no reason to limit the possibility for parties to make oral statements before it, to those cases alone where the Enlarged Board of Appeal considered it to be useful.

Furthermore, the Working Party did not adopt a proposal according to which the Enlarged Board of Appeal would have to take a decision within a limited period taking effect from the time when the question had been referred to it.

65. With regard to paragraph 1(b) which refers to a case where there are no parties to a proceeding, it was noted that the Rules of Procedure of the Enlarged Board of Appeal, provided for in Re. Article 57, No. 1; could lay down that this authority may appeal to experts.

Article 123 (Publication of the international application)
Article 34 (Languages)

66. With regard to languages, the Working Party, in accordance with the mandate given to it by the Conference at its fifth Meeting, examined the following two problems:

(a) the search for a solution to the problem of the incompatibility of Article 123, paragraph 5, with the PCT and the repercussions which the solution adopted for international applications would have on the system applicable to the translation of the claims of European applications (Article 35, paragraph 5);
REPORT

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

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

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

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

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

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

BR/177 e/72 cyd/AH/prk
125. The ICC representative wondered whether the fact of asking the IIB for a "supplementary" report on the state of the art might not result in the latter drawing up a new report in addition to the international search report, whereas strictly speaking, its aim should be to check and, if necessary, supplement, that report. IFIA observed in this context that in its view, the IIB's task at that stage was primarily to bring the international search report up to date.

ICC and UNICE asked that the international search report should be transmitted to the IIB immediately the European Patent Office had received it.

Article 123 (Publication of the international application)

126. CNIPA expressed doubts as to the conformity with rule 49.2 of the PCT of Article 123, paragraph 5, which requires the applicant to provide a translation of the claims into the other two official languages of the European Patent Office. In the event of the provision being amended as a result of this, CNIPA and ICC suggested that the possibility provided for in Article 19, paragraph 4, should also be offered to those Contracting States with an official language used by the European Patent Office, in the event of the international application not being drafted in or translated into that language. A similar possibility should also be provided for in Article 107a, in respect of a patent which had been granted.

BR/169 e/72 ght/PB/prk

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

Brussels, 15 March 1972
BR/169/72

- Secretariat -

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)

BR/169 e/72 ley/KM/prk
(b) Two suggestions were made concerning Article 160a. One suggestion was that the text should stipulate that the international search report would be forwarded to the IIB as soon as it was received by the European Patent Office and as soon as the fee had been paid. The other suggestion was that the phrase "and shall be paid at the same time" should be inserted in paragraph 1(b), after the words "shall be the same as", and that the last sentence should be deleted. It was pointed out in support of this suggestion that the existing text gave the applicant an additional period of one month, which did not appear to be justified.

Article 123 (Publication of the international application)

140. In view of the problems raised with regard to paragraph 5 in relation to the PCT, this Article was referred back to Working Party I, which will also be able to examine proposals for simplifying the wording of the Article.

Article 124 (Request for the application of national procedure)

141. The suggestion by certain non-governmental organisations for the deletion of paragraph 1(b), having already been rejected at its April 1971 Meeting, the Conference saw no reason to depart from its earlier decision.

However, the Netherlands delegation expressed a reservation with regard to this provision.
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)
Article 123

Publication of the international application

(1) +

(2) +

(3) +

(4) +

(5) The translations referred to in paragraphs 2 and 3 shall be provided by the applicant not later than twenty months after the priority date of the international application, otherwise the European application shall be deemed to be withdrawn.

(6) For the purposes of Articles 59 and 149, the date of publication of the international application by the International Bureau shall be deemed to be the date of publication of the European patent application under Article 85.
SECOND PRELIMINARY DRAFT OF THE CONVENTION

ESTABLISHING

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

Brussels, 6 December 1971

BR/139/71

- Secretariat -

DOCUMENT CORRECTING

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

FIRST PRELIMINARY DRAFT
OF THE IMPLEMENTING REGULATIONS

and

FIRST PRELIMINARY DRAFT
OF THE RULES RELATING TO FEES

- Stage reached on 26 November 1971 -

BR/139 e/71
The Working Party considered it sensible, for the purposes of inspection of the files and entry in the Register, to take the point in time of the publication of the application by the International Patent Office, since once this had taken place, anyone could acquaint himself with the content of the application. To this end, the Working Party adopted a new paragraph 6 to Article 123.

116. The Working Party found that the provision Re. Article 34, No. 1 would have to be altered, not as the result of the amendments decided upon for Article 34, but for another reason. In the text as it stood, this provision covered in particular revocation proceedings and infringement proceedings. This was not intended, because a third party involved in such proceedings ought to be able to rely on the wording of the patent in the language in which it had been granted.

The Working Party therefore decided to restrict to proceedings before the European Patent Office the rule that in the event of the application being translated into an official language, the original text should be decisive for the purposes of determining the extent of the protection (paragraph 1). The remaining amendments to paragraph 1 and paragraph 2 are textual.

Article 137a - European divisional application

117. On the basis of Article 137a, paragraph 2, which provided that in the special case of a divisional application, the claims of the divisional application should not contain any subject-matter for which protection was
The Working Party further made it clear in the new paragraph 5 of Article 123, that the applicant for an international patent was not only responsible for the translation of the claims from the language of the proceedings into the other two official languages (see above points 107 to 109) but also for the translation of the application itself into an official language, in the event of the application not having been published in such a language by the International Patent Office (Article 123, paragraph 3). This provision satisfies rule 49.2 of the Regulations under the PCT.

The time-limit and the penalty for its not being observed were the same as for the translation of the claims: 20 months after the date of priority (as provided for in Article 22 of the PCT) on penalty of the application being deemed to have been withdrawn.

The Working Party also raised the question of from what point in time the files relating to international applications could be made available for inspection without the consent of the applicant (Article 149) and from what point in time entries regarding these applications could be made in the European Patent Register (Article 52). As Article 123 stood, inspection of the files and entries in the European Patent Register would only be possible after the claims had been translated from one official language into the two other official languages and subsequently published (Article 123, paragraphs 2 and 4) or after the application had been translated into one official language and the claims into the two other official languages and subsequently published (Article 123, paragraphs 3 and 4); for these translations the applicant was however allowed a time-limit of 20 months from the date of priority (Article 123, new paragraph 5).
112. As regards both European and international patent applications, the time-limit within which the applicant must transmit the translation of the claims intended for publication to the European Patent Office had to be specified.

In respect of European patent applications the Working Party considered that a time-limit of 16 months from the date of application or date of priority was appropriate (Article 34, paragraph 5, new third sentence),

Its reasoning was that the applicant could modify the claims at a relatively late stage (Article 137b, paragraph 3) and should therefore not be obliged to submit the translations until the latest possible moment.

In respect of international patents it set the time-limit at 20 months from the date of priority, taking into account Article 22 of the PCT (Article 123, new paragraph 5).

113. In the same way, the sanctions to be applied in the event that the above-mentioned translations are not supplied on time had to be decided in respect of both kinds of application. The Working Party's view is that in both cases the application should be deemed to have been withdrawn. In respect of European applications, the legal basis for this is to be found in Article 78, paragraph 8 (new), together with Article 77, paragraph 2(j) (new). For international applications, the matter is settled in Article 123, paragraph 5 (new).
109. The Working Party saw no need for different arrangements for international applications. Since up to now Article 123 imposed no express obligation on the applicant to provide a translation of the claims, a new paragraph 5 was added to this effect.

110. The Working Party then proceeded to a detailed examination of the question of the text which would be authentic if there were discrepancies between the versions of the claims published in the patent application in the three official languages.

From the outset it ruled out the possibility of considering all three texts equally binding.

It then considered whether claims should be binding only to the extent that their contents were covered in all three languages. This solution was not however supported by most of the delegations.

The Working Party finally decided that, in the event of discrepancies between the different versions, the claims expressed in the language of the proceedings should be binding. To this end it added half a sentence to the first sentence of Article 34, paragraph 3.

In adopting this solution the Working Party bore in mind the fact that the applicant could attempt to manipulate the translation of the claims into the other two official languages. This could in certain circumstances result in a difference in the scope of protection provisionally from one country to another (Article 19). It was established, however, that this would only be possible if
(b) Binding force of the translation (point 110)

(c) Obligation to have the claims of the patent translated (point 111)

(d) Period for submitting the translation (point 112)

(e) Sanction in the event of failure to observe the time limit (point 113)

(f) Translation of international applications into one of the official languages (point 114)

(g) Date as from which, in the case of international applications, entries may be made in the Register of European Patents and the files may be inspected (point 115)

(h) Amendment to Re. Article 34, No. 1 (point 116).

107. The Working Party worked on the initial assumption that according to the present wording of the Convention (Article 34, paragraphs 1, 2 and 5) it would be the responsibility of the European Patent Office and not of the applicant to have the application translated out of the language of the proceedings into the other two official languages, both for European and failing provisions to the contrary in Article 123 - for international applications. It then held a detailed discussion on whether this regulation should be retained as it stood or amended.

108. In connection with European applications, part of the Working Party was of the opinion that the European Patent Office should have the claims translated out of the language of the proceedings into the two other official languages. Only in this way would an accurate translation
The Working Party was however of the opinion that there was no need to amend Article 105a in order to make this legal consequence explicit, because it referred to Article 18 and because a further reference is made to Article 18 in the provision on the rights conferred by a European patent application after publication (Article 19). On the other hand, the Working Party considered that it should be made clear in Article 19, paragraph 5, that in the event of the patent being revoked it would be deemed not to have had as from the outset the provisional protection conferred by the application after publication; a new sub-paragraph (b) was added to this effect.

105. The drafting of Article 19, paragraph 5 was amended so as to make cases of deemed withdrawal of applications equivalent to cases of actual withdrawal.

Article 34 - Languages

Article 123 - Publication of the international application

Re. Article 34, No. 1, IR - Legal authenticity and time limit for the filing of a translation of the application

106. The Working Party's discussions on the problems remaining open in connection with these provisions will be dealt with in the following order:

(a) Whose responsibility is it to have the claims translated into the other official languages of the European Patent Office in the case of European and international applications? (see points 107 to 109 below).
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING-UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 16 December 1971
BR/144/71

SECRETARIAT

MINUTES

of the 10th meeting of Working Party I,
held in Luxembourg from 22 to 26 November 1971

1. Working Party I held its 10th meeting in Luxembourg from 22 to 26 November 1971, with Dr. HAERTEL, President of the Deutsches Patentamt, in the Chair.

Representatives from the Commission of the European Communities, the IIB and WIPO attended the meeting as observers. The Council of Europe representatives sent their apologies for being unable to attend. For the list of those present at the 10th meeting see Annex I to these minutes.

2. Working Party I adopted the provisional agenda as contained in BR/GT I/133/71 on the understanding that item 3 would also cover the examination of a number of problems including those referred to in BR/GT I/138/71. The provisional agenda is given in Annex II to these minutes.

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

BR/144 e/71 ley/prk
Unrevised translation
148. The Working Party also considered that it was clear from the wording of Article 123, paragraph 1, and particularly from the reference to Article 19, that the provisional protection conferred by an international application would not have effect in respect of a State taking the option provided in Article 19, paragraph 4, until the date on which the claims had been translated into the official language of the country in question.

149. The United Kingdom delegation pointed out that it could be logically concluded from Article 123, paragraph 4, which provided that the publication of the international application would take the place of the publication of the European patent application pursuant to Article 85, that no entry could be made in the Register of European Patents pursuant to Article 59, and no file be laid open to inspection without the consent of the applicant being obtained pursuant to Article 149, until the claims had been translated into the official languages of the European Patent Office and published in these languages.

The Working Party admitted that this interpretation, which could logically be deduced from the system adopted in Article 123, ran the risk of delaying considerably the point at which third parties could inspect the file. Moreover, this system did not correspond to the system provided under the PCT, which did not make the time at which consent could be given to inspect the files dependent on the existence of a translation into certain languages. The Working Party reserved the right to resume its examination of this question at a later stage.

BR/135 e/71 ley/prk
Article 117 (Application of the Patent Co-operation Treaty)

146. The Working Party considered that it would be advisable to specify expressis verbis and in the Convention itself that "international applications made under the PCT may be the subject of proceedings before the European Patent Office". It also agreed with the WIPO representatives that Article 117, paragraph 2, did not convey with sufficient clarity the principle that in the event of conflict between the PCT provisions and those of the Convention regarding international applications, the former provisions were to prevail, and it amended the paragraph accordingly.

Article 123 (Publication of the international application)

147. The Working Party discussed the question raised by the United Kingdom delegation of who would be responsible for the translation of the claims of an international application into the official languages of the European Patent Office in the cases referred to in Article 123, paragraphs 2 and 3.

The Working Party considered that the present system under the Convention seemed to oblige the European Patent Office to provide such translations, along with the publication of the claims, the date of the publication determining the date on which the provisional protection referred to in Article 19 was to come into effect. The Working Party however reserved the right to return to its examination of this problem.
MINUTES

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

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

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

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

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

BR/135 e/71 prk
(Unrevised translation)
(2) Si la demande internationale est publiée par le Bureau International dans une des langues visées à l'article 34, paragraphe 1, la protection provisoire prévue au paragraphe 1 ci-dessus ne joue qu'à compter de la date de la publication d'une traduction des revendications dans les deux autres langues visées à l'article 34, paragraphe 1.

(3) Si la demande internationale n'est pas publiée par le Bureau International dans une des langues visées à l'article 34, paragraphe 1, la protection provisoire prévue au paragraphe 1 ne joue qu'à compter de la date de la publication d'une traduction de la demande dans une des langues visées à l'article 34, paragraphe 1, et d'une traduction des revendications dans les deux autres langues.

(4) La publication de la demande internationale par le Bureau International, en liaison avec la publication de la traduction des revendications conformément au paragraphe 2, ou la publication des traductions conformément au paragraphe 3, remplace la publication de la demande de brevet européen conformément à l'article 85.

**CHAPITRE VI**

**Transformation de la demande de brevet européen en demande de brevet national**

**Article 124**

Demande d'engagement de la procédure nationale

(1) Sur requête du titulaire d'une demande ou d'un brevet européen, le service central de la propriété industrielle d'un État contractant désigné engage la procédure de délivrance d'un brevet national :

a) si la demande de brevet européen est réputée retirée en vertu de l'article 65, paragraphe 5 ou de l'article 157, paragraphe 3;

b) dans les autres cas prévus par la législation dudit État, où, en vertu de la présente Convention, la demande de brevet européen est, soit rejetée, soit retirée, soit réputée retirée, ou le brevet européen révoqué.

(2) La requête doit être formulée dans un délai de six mois à compter de la date à laquelle la demande de brevet européen est, soit rejetée, soit retirée, soit réputée retirée, ou à laquelle le brevet européen est révoqué. Les effets prévus à l'article 76, paragraphe 1, s'éteignent si la requête n'est pas présentée dans le délai prescrit.

**Article 125**

Présentation et transmission de la requête

(1) Sous réserve de l'article 127, la requête prévue à l'article 124 doit être présentée à l'Office européen des brevets et mentionner les États contractants dans lesquels le requérant entend que soit engagée la procédure de délivrance d'un brevet national. La requête n'est considérée comme présentée qu'après le versement de la taxe prescrite par le règlement relatif aux taxes pris en exécution de la présente Convention.
(2) Sous réserve de l'accord préalable du Conseil d'administration, l'Office européen des brevets agit également en tant qu'administration chargée de l'examen préliminaire international, pour un demandeur ressortissant d'un État qui n'est pas partie au Traité de Coopération ou pour lequel le chapitre II de ce Traité n'est pas entré en vigueur, et pour lequel l'Assemblée de l'Union de coopération internationale en matière de brevets a désigné l'Office européen des brevets comme administration compétente chargée de l'examen préliminaire international, conformément à un accord conclu entre le Conseil d'administration et le Bureau International de l'Organisation Mondiale de la Propriété Intellectuelle; la présente disposition s'applique également lorsque le demandeur a son domicile ou son siège dans cet État.

(3) Lorsque l'Office européen des brevets agit en tant qu'administration chargée de l'examen préliminaire international, les chambres de recours sont compétentes pour statuer sur une réserve formulée par le déposant à l'encontre de la fixation par l'Office européen des brevets d'une taxe additionnelle, en vertu de l'article 34, paragraphe 3, sous a), du Traité de Coopération.

**Article 121b**

L'Office européen des brevets, Office élu

L'Office européen des brevets agit en qualité d'Office élu au sens de l'article 2, (xvi) du Traité de Coopération, si le demandeur a élu un des États désignés visés à l'article 121, paragraphe 1 ou 2 et à l'égard duquel le chapitre II dudit Traité est entré en vigueur. Sous réserve de l'accord préalable du Conseil d'administration, la présente disposition s'applique également lorsque le demandeur a son domicile ou son siège ou est ressortissant d'un État non contractant ou pour lequel le chapitre II n'est pas entré en vigueur, dans la mesure où il fait partie des personnes auxquelles l'Assemblée de l'Union de coopération internationale en matière de brevets a permis, par une décision prise conformément à l'article 31, paragraphe 2 sous b) dudit Traité, de présenter une demande d'examen préliminaire international.

**Article 122**

Rapport de recherche internationale

Sous réserve des dispositions de l'article 137, le rapport de recherche internationale prévu à l'article 18 du Traité de Coopération remplace l'avis documentaire sur l'état de la technique prévu à l'article 79, paragraphe 1.

**Article 123**

Publication de la demande internationale

(1) A compter de sa publication par le Bureau International conformément à l'article 21 du Traité de Coopération et sous réserve des dispositions ci-après, la demande internationale pour laquelle l'Office européen des brevets est Office désigné conformément aux dispositions de l'article 121, paragraphe 1, assure au demandeur la protection provisoire prévue à l'article 19.

**Bemerkung zu Artikel 122:**

Zusammen mit der in der Bemerkung zu Artikel 79 Absatz 1 vorgesehenen Untersuchung ist die Frage einer etwaigen Ermäßigung der Gebühr zur Deckung der Kosten des Berichts über den Stand der Technik für den Fall zu prüfen, daß zusammen mit der Anmeldung ein internationaler Recherchenbericht eingereicht wird.

**Note to Article 122:**

The question of a possible reduction of the fee for the report on the state of the art in the case of an application being filed together with an international search report is to be examined together with the examination referred to in the note to Article 79, paragraph 1.

**Remarque concernant l'article 122 :**

En liaison avec l'étude visée dans la remarque relative à l'article 79, paragraphe 1, la question d'une éventuelle réduction de la taxe destinée à couvrir l'avis documentaire, dans le cas d'une demande assortie du rapport de recherche internationale, doit encore être examinée.
SECOND PRELIMINARY DRAFT OF A CONVENTION
ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

SECOND AVANT-PROJET DE CONVENTION INSTITUANT UN SYSTÈME
EUROPEÉEN DE DÉLIVRANCE DE BREVETS
SECOND PRELIMINARY DRAFT OF A CONVENTION
ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

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

and
FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

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 —
of view reserving the right to re-examine it later if other delegations put forward any proposals on this subject.

Re. Article 128, No. 1 - National publications in the event of conversion of a European patent application

32. The Sub-Committee adopted this provision which was contained in the proposals put forward by the Chairman of Working Party I, the Working Party having decided to transfer it to the Implementing Regulations. The provision of this text was considered indispensable since it imposes an obligation on the States and thus guarantees that any application for a European patent which is converted to an application for a national patent will be communicated to the public.

Re. Article 130, No. 2 - Renewal fees due in respect of applications for divisional European patents

33. The United Kingdom delegation drew the Sub-Committee's attention to the question of establishing which date is to be taken into consideration for the duration of the validity of a divisional patent (the date of filing of the original application or not). The Sub-Committee decided to discuss this question again at a subsequent meeting.

Re. Article 139, No. 1 - Failure of parties to appear at oral proceedings

34. The provision adopted lays down that the oral proceedings may continue even if a party fails to appear.

BR/84 e/71 nan/KM/prk: .../...
Article 123 of the First Preliminary Draft Convention

31. In the Minutes of the third meeting of Working Party I which was held from 24 to 28 November 1969 (BR/12/69), point 71 reads as follows:

"With reference to paragraph 4 it was pointed out in the Working Party that the time of publication of the international application, which is to take the place of the publication of the European patent application, is not the same as the time of publication of the latter. This could have certain effects for various rules in the Convention, e.g. for Article 24(1) (Patents of addition), for Article 60 (Register of European patents) and for Article 162 (Inspection of files). The Working Party agreed to examine the question of the effect of paragraph 4 on the other provisions of the Convention before its next meeting."

This question was remitted to the "Implementing Regulations" Sub-Committee at the sixth meeting of Working Party I and more specifically to the discussion of the list of questions left open (cf. BR/GT I/67/70, page 35).

In the opinion of the German delegation a study of the effects of Article 123, paragraph 4, on the other provisions of the Convention and of the Implementing Regulations, and, in particular, on Articles 21 (24), paragraph 1, 59 (60) and 162 of the Convention, mentioned in BR/12/69, did not provide any grounds for amending the present provisions or for introducing new provisions. The Sub-Committee adopted this point.

BR/84 e/71 nan/KM/prk .../...
INTER-GOVERNMENTAL CONFERENCE
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Brussels, 1st April 1971
BE/84/71

- Secretariat -

MINUTES

of the 5th meeting of the "Implementing Regulations" Sub-Committee of Working Party I
(Luxembourg, 12 - 14 January 1971)

I

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

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

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

\(^{(1)}\) See the list of participants in Annex I.
Article 123 (former Article 113g)
Publication of the international application

(1) As from its publication by the International Bureau pursuant to Article 21 of the Co-operation Treaty, an international application for which the European Patent Office is a designated Office under Article 121, paragraph 1, shall confer upon the applicant the provisional protection granted pursuant to Article 19, subject to the provisions set out below.

(2) If the international application is published by the International Bureau in one of the languages specified in Article 34, paragraph 1, the provisional protection referred to in paragraph 1 above shall commence on the day of publication of a translation of the claims into both of the other languages specified in Article 34, paragraph 1.

(3) If the international application is not published by the International Bureau in one of the languages specified in Article 34, paragraph 1, the provisional protection referred to in paragraph 1 above shall commence on the day of publication of a translation of the application into one of the languages specified in Article 34, paragraph 1, and of the translation of the claims into both of the other languages.

(4) Publication of the international application by the International Bureau, together with the publication of the translation of the claims pursuant to paragraph 2, or the publication of the translations pursuant to paragraph 3, shall take the place of the publication of the European patent application pursuant to Article 85.
FIRST PRELIMINARY DRAFT
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(Articles drafted by Working Parties I, II, III and IV)
various Contracting States, if these States do not also see their way to supporting it.

Consequently, the Working Party did not accept the amendment proposed by the Director General of the EPI. It was not excluded however that this problem could be reviewed later. It was pointed out in this connection that the solution of this problem might not fall under the objectives of the Convention now under discussion.

**Article 113g - Publication of the international application**

71. With reference to paragraph 4 it was pointed out in the Working Party that the time of publication of the international application, which is to take the place of the publication of the European patent application, is not the same as the time of publication of the latter. This could have certain effects for various rules in the Convention, e.g. for Article 24(1) (Patents of addition), for Article 60 (Register of European patents) and for Article 162 (Inspection of files). The Working Party agreed to examine the question of the effect of paragraph 4 on the other provisions of the Convention before its next meeting.

**CHAPTER IV**

**CONVERSION OF A EUROPEAN PATENT APPLICATION INTO A NATIONAL APPLICATION**

**Articles 114 to 118**

72. The Working Party decided to postpone the examination of these Articles until the procedure for granting the European patent has been settled.
MINUTES
of the meeting of Working Party I
(Luxembourg, 24 to 28 November 1969)

I.

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

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

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

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

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

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

BR/12 e/69 kel/PA/mk .../...
(1) As from its publication by the International Bureau pursuant to Article 21 of the Co-operation Treaty, an international application for which the European Patent Office is a designated Office under Article 113e, paragraph 1, shall confer upon the applicant the provisional protection granted pursuant to Article 20bis, subject to the provisions set out below.

(2) If the international application is published by the International Bureau in one of the languages specified in Article 34, paragraph 1, the provisional protection referred to in paragraph 1 above shall commence on the day of publication of a translation of the claims into both of the other languages specified in Article 34, paragraph 1.

(3) If the international application is not published by the International Bureau in one of the languages specified in Article 34, paragraph 1, the provisional protection referred to in paragraph 1 above shall commence on the day of publication of a translation of the application into one of the languages specified in Article 34, paragraph 1, and of the translation of the claims into both of the other languages.

(4) Publication of the international application by the International Bureau, together with the publication of the translation of the claims pursuant to paragraph 2, or the publication of the translations pursuant to paragraph 3, shall take the place of the publication of the European patent application pursuant to Article 86a.

BR/11 e/69 mk
INTER-GOVERNMENTAL CONFERENCE
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--- Secretariat ---

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

Articles 88 to 152
prepared by Working Party I
(24 to 28 November 1969)

compared synoptically with

- the 1962 and 1965 versions 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/11 e/69 mk
<table>
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<tr>
<th>Entwurf, der dem nebeneinheitenden Dokument zugrunde liegt</th>
<th>Art. Nr. im Entwurf/Dokument</th>
<th>Dokument, in dem der Art. behandelt wird</th>
<th>Fundstelle im Dokument</th>
</tr>
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<tbody>
<tr>
<td>E 1972</td>
<td>157</td>
<td>M/124/I/R 8</td>
<td>S. 3</td>
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<tr>
<td>&quot;</td>
<td>157</td>
<td>M/136/I/R 10</td>
<td>S. 24</td>
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<td>M/146/I/R 6</td>
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<td>M/PR/G</td>
<td>S. 265/187-9</td>
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</tbody>
</table>
PCT, for which the European Patent Office is a designated Office, shall be deemed to form part of the state of the art only if it is confirmed, i.e. if it is communicated to the European Patent Office in one of its official languages and the national fee prescribed is paid. In order to create better information facilities for third parties, the Committee provided for a mention to be made in the European Patent Bulletin of the publication by the International Bureau of WIPO of the international application, and, where the publication by the International Bureau is not in one of the official languages of the European Patent Office, for the compulsory publication of the international application communicated to the European Patent Office.

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

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

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

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

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

III Protocol on Recognition

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

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

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

V Resolution on training staff for the European Patent Office

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

D Final remarks

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

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