Article 81 E

Travaux Préparatoires (EPC 1973)

Comment:

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MPO
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official languages instead of only the language of the proceedings.

2. Patentability (Articles 50-55)

The provisions of substantive law on patentability were not amended as to substance. The exceptions listed in Article 50, paragraph 2, were confirmed by the Main Committee as basic principles of the Convention. Certain drafting improvements however now make it completely clear that the various types of subject-matter, acts and activities listed are only excluded as such from patentability and that therapeutic and diagnostic methods are not patentable on the grounds that they lack industrial application.

The exception to patentability laid down in Article 51 in respect of inventions the publication of which would be contrary to "ordre public" or morality was reinforced by a duty to examine on the part of the European Patent Office (see Rule 34).

An improved wording of Article 52, paragraph 5, now ensures the patentability of known chemicals for such uses in therapeutic and diagnostic methods as do not form part of the state of the art. In this connection the Main Committee was also of the opinion that only a first use, irrespective of whether it is with regard to humans or animals, fulfils the requirements of this provision.

With respect to non-prejudicial disclosure the Main Committee amended Article 53 to provide that an abusive disclosure in relation to the person entitled shall not be prejudicial if it occurred no earlier than six months before the filing of the application. This amendment means that, taking into account the concept of novelty contained in Article 52, paragraphs 3 and 4, cases of abusive disclosure after the date of filing of the application by the person entitled are dealt with in the same way as a disclosure within six months preceding the date of filing of the European patent application. The Main Committee decided not to extend the definition of the international exhibitions referred to in Article 53 not only because such an amendment would diverge from the Strasbourg Convention but also because exhibition priorities as such are a dangerous instrument for the applicant.

In discussing Article 54 a proposal for supplementing this provision to the effect that any technological advance proven by the applicant should be taken into account in deciding whether there has been an inventive step was rejected, mainly because it was feared that too much weight might be given to this factor.

3. Position of the inventor (Articles 58, 59, 60, 79, 90 and Rules 17, 19, 26, 42)

The Main Committee gave detailed consideration to a proposal to give the inventor a better and stronger legal position in the system set up by the Convention than that afforded by the drafts. The main proposal sought to compel the applicant to designate the inventor at the time of filing the application and at the same time to prove his entitlement to the invention by producing a certificate of transfer drawn up by the inventor or some other conclusive document.

It was not contested that the rights of the inventor should be adequately protected in the Convention. The Main Committee therefore decided unanimously that in respect of all European patent applications, irrespective of which States were designated in them, the filing of a statement identifying the inventor should be a compulsory requirement, with the result that if it were not complied with, the application would be deemed to be withdrawn. However, the Main Committee rejected the proposal to require the production of proof that the applicant was the inventor's successor in title for three main reasons: there would be difficulties in obtaining such a document in individual cases; it could not be produced where the transfer took place in the due course of law; and finally it would put the European Patent Office in the extremely difficult situation of having to apply the national law of the Contracting States in examining such documents. Similarly, an alternative proposal, to require proof of being the inventor's successor in title only where the national law of at least one of the designated Contracting States required such proof in respect of national patent applications, could not be adopted as this would have caused the same difficulties. In order that the rights of the inventor should nevertheless be protected, the Main Committee finally adopted a compromise solution whereby, if the applicant were not the inventor or not the sole inventor, he would be obliged to file a statement, which would be an integral part of the designation of the inventor indicating the legal basis of his acquisition of the invention. In addition, this designation of the inventor by the applicant would be notified to the inventor, thus allowing him where necessary to invoke his rights in due time. Corresponding amendments were made to Articles 79 and 90 and to Rules 17, 19, 26 and 42.

4. Effects of the European patent and the European patent application (Articles 61-68)

The main subject of discussion in this respect was Article 67 which defines the protection conferred by the European patent and the European patent application.

The Main Committee adopted by a majority a provision which also occurs in the Draft of the Second Convention for the Community patent, whereby the protection conferred on a process is extended to the products directly obtained by that process. This provision, which was inserted in Article 62 and which is already known in the laws of several Contracting States, takes account of the fact that in certain branches of industry, such as the plastics industry, it is not always possible to define a material without reference to its means of production. At the same time, a similar majority of the Main Committee rejected a proposal that this extended protection be reinforced in the case of an invention relating to the manufacture of a new product by assuming, to the benefit of the proprietor of the patent, that any product of the same nature would be considered to be obtained by the protected process. This proposal to reverse the burden of proof was countered by the argument that it would constitute too great an inroad into the national law of the Contracting States.

Main Committee I also considered, in respect of Article 67, paragraph 2, that the concept of extending the protection conferred by the European patent application included the case of a shift in the protection as a result of an amendment to the claims. With regard to the interpretative statement proposed by the Inter-Governmental Conference in respect of Article 67, it considered that this should be officially adopted unamended by the Diplomatic Conference and should be annexed to the Convention in the form of a declaration.

As regards the right to continue to use the invention, which a third party who has been operating in good faith may invoke under Article 68, paragraph 4(b), where the proprietor of the patent has corrected the translation of the specification, the Main Committee decided by a majority to depart from the draft by providing that this right could be exercised without payment, by analogy with the comparable situation dealt with in Article 121, paragraph 6.
Minutes of the proceedings of the Committee of the Whole

1. The Committee of the Whole, which was established by the Plenary of the Conference and comprised all the Government delegations (see Rule 14 of the Rules of Procedure)*, was, pursuant to paragraph 4 of Rule 14, chaired by Dr. Kurt Haerel (Federal Republic of Germany), President of the German Patent Office and Chairman of Main Committee I, Mr. François Savignon (France), Director of the French Industrial Property Office and Chairman of Main Committee II, was First Vice-Chairman; Mr. Edward Armitage (United Kingdom), Comptroller-General of the United Kingdom Patent Office and Chairman of Main Committee III was Second Vice-Chairman.

2. In accordance with Rule 14 of the Rules of Procedure, the terms of reference of the Committee of the Whole were to take decisions on proposals from the Gernal Drafting Committee on drafts established by Main Committees I, II and III and on proposals submitted to it directly and to forward the drafts approved by it to the Plenary of the Conference for adoption.

3. The Committee of the Whole met under the direction of the Chairman from 1 to 4 October 1973.

4. At the meeting on 1 October 1973, the Committee of the Whole received the reports of Main Committees I and II. Main Committee I's report was approved without debate (see Section I below).

5. At its meeting on 2 October 1973, the Committee of the Whole discussed Main Committee II's report. The discussion and subsequent approval of the report are dealt with below in Section II.

6. At the same meeting, it heard and approved Main Committee III's report (see Section III below); it also discussed the results of the proceedings of the General Drafting Committee (M/146 R/1 to R/15 and M/151 R/16). These discussions are covered in Section IV below.

7. On 3 October 1973, the Committee of the Whole received and approved the report of the Credentials Committee (see Section V below). The problems of a European School and the European Patent Office building in Munich were then dealt with (see Sections VI and VII).

8. At its last meeting on the morning of 4 October 1973, the Committee of the Whole discussed the organisation and work programme of the Interim Committee. These discussions are presented in Section VIII below. It finally considered a proposal from the Yugoslav delegation for a Resolution on technical assistance (Section IX) and a Recommendation regarding the status and remuneration of certain employees (Section X).

I. Report of the discussions and decisions of Main Committee I

8. The rapporteur of this Main Committee, Mr. Paul Braendli, Vice-Director of the Federal Intellectual Property Office (Switzerland), presented the report on the work of Main Committee I to the Committee of the Whole. The text of this report is given in Annex I.

The report was unanimously adopted by the Committee of the Whole.

II. Report on the work of Main Committee II

9. Subject to a few minor amendments, the Committee of the Whole unanimously approved the report presented by the rapporteur of Main Committee II, Mr. R. Bowen (United Kingdom), Assistant Comptroller of the United Kingdom Patent Office. The text of the report as adopted by the Committee of the Whole is given in Annex II. The discussions concerning the proposals for amendments to the report are summarised in the following paragraphs.

10. As regards the section of the report concerning the Protocol on Centralisation, the Netherlands delegation, commenting on the first sentence in point 16, stated that the obligations of the European Patent Office towards the Member States of the International Patent Institute had simply been clarified rather than extended. However, the French and United Kingdom delegations maintained that the obligations had in fact been extended since the original text had only referred to tasks at present incumbent upon the Institute whereas now tasks entrusted to the EPO after the signing of the Protocol were expressly covered. While disagreeing with this view, the Netherlands delegation did not insist on an amendment.

11. The Netherlands delegation proposed, also with regard to point 16, that the last sentence should state that the EPO would also undertake searches for Member States of the EPO which had not submitted any applications for search before the entry into force of the Convention. This would make provision for those States which, up to the time in question, had submitted no applications for search to the EPO although they were entitled to do so.

The Committee of the Whole agreed to amend the part of the report concerned as follows: "...the Office will also assume this responsibility in respect of a Member State of the Institute which prior to the entry into force of the Convention, has agreed to submit national applications to the Institute for search."

12. The Committee of the Whole adopted a proposal from the Swedish delegation that the idea proposed by the Scandinavian countries at the beginning of point 22 be worded as follows: "Consideration was given to the idea, proposed by the Scandinavian countries, that such work might be entrusted to national offices, possessing the minimum documentation, whether or not they possessed the other qualifications, required of an International Searching Authority under the Patent Cooperation Treaty." It also approved an addition at the end of the third sentence in this point to the effect that national offices would have to "fully" qualify as Searching Authorities.

13. The Austrian delegation suggested that in the English version of point 22, in the middle of page 14, the words "some search work" be used so as not to prejudice the question of the amount of such search work, which had deliberately been left open. The text would therefore read: "difficulties resulting from a renunciation under Section I.2, to entrust some search work to national offices whose language is...".

The Committee of the Whole accepted this suggestion. The German and French texts remained unaltered.

14. With regard to the part of the report dealing with Article 166 (Article 167 of the signed version) of the Convention, the Greek delegation proposed that point 11 be amended at the top of page 7 so as to state, not that Main Committee II had accepted the view as to the effects of a reservation, but that it had considered such a possibility. The rapporteur and the Netherlands delegation stated that this view had been generally accepted in Main Committee II.

The Committee of the Whole accordingly decided not to amend the draft which had been submitted.

III. Report on the results of Main Committee III's proceedings

15. Main Committee III's rapporteur, Mr. Fressonnet, Deputy Director of the National Industrial Property Office
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)
should suffice as evidence of assignment, and further documents should not be required; the declaration should be required in all cases and not only where a designated State had corresponding regulations; the inventor should merely be notified of the application and should not receive a copy of the patent application; finally, the legal relationship between the applicant and the inventor or third persons should in no way be impaired by such a declaration.

276. The Chairman pointed out that he had understood the compromise proposal by the delegation of the Federal Republic of Germany as meeting the requirements laid down by the United Kingdom delegation.

He noted that (subject to its wording) no delegation had opposed the proposal, and asked the delegation of the Federal Republic of Germany to submit its proposal in writing so that a formal vote could be taken on it (see points 282 et seq., 321 et seq., 2038 et seq., 2047 et seq., 2090 et seq. and 2245).

277. The Swiss delegation said it was withdrawing its proposal on Article 58, paragraph 3 (M/54/I/II/III, page 11), which was merely intended as an alternative to the Scandinavian proposal.

278. The delegation of the International Chamber of Commerce raised the question of how to deal with a case where an initially correct designation of the inventor were to prove incorrect in the course of the procedure, for example if someone were designated in the application as one of a number of inventors but a claim for that part of the invention with which he had been associated were rejected. This delegation felt that it would be undesirable for this person also to appear in the patent specification as an inventor.

279. The Chairman recalled that in such a case, the designation of the inventor could be rectified in accordance with Rule 19, which would require the consent of the person concerned, however.

280. The delegation of the International Chamber of Commerce considered that this could not solve all conceivable problems, but saw no real possibility of improving Rule 19.

281. Regarding the suggestion made by the Yugoslav delegation that the inventor should not be designated if he wished to remain anonymous (see point 236 above), the Main Committee left it up to this delegation to submit an appropriate proposal in writing.

282. At a subsequent meeting, the Main Committee examined the compromise proposal which had been formulated in the meantime by the delegation of the Federal Republic of Germany in M/118/I (see point 276).

283. In this connection, the delegation of the Federal Republic of Germany pointed out that it proposed resolving the fundamental issue of the designation of the inventor in a separate Article. The first sentence of its proposal, whereby the inventor would have to be designated in the European application, had been decided by the Main Committee. The compromise suggested by it was contained in the second sentence, to the effect that if the applicant were not the inventor or not the sole inventor, the designation of the inventor would have to contain a declaration as to how the applicant acquired the right to the European patent.

284. The Chairman pointed to the fact that the wording of the German proposal meant that “identification of the inventor” would comprise identification of the inventor and the statement on the transfer of the right in cases where the applicant was not the inventor.

285. The Swedish delegation, which also spoke on behalf of the other Scandinavian delegations, could accept the compromise proposal subject to certain improvements in the drafting. Its thanks were due to the German delegation for the proposal, the unanimous adoption of which by the Main Committee and by the Conference would be greatly appreciated.

286. The Yugoslav delegation drew attention to the fact that under Yugoslav law it was possible for a number of persons working in a firm or institute to be responsible for an invention without there being any need to designate the inventor. The questions arose as to whether such cases would be covered by the compromise proposal.

287. The delegation of the Federal Republic of Germany considered that such cases would be covered neither by Article 79 as it stood, nor by the version which it had submitted.

288. The Chairman pointed out that in the case referred to by the Yugoslav delegation, the principle of designation of the inventor as adopted by the Main Committee meant that corporate bodies responsible for inventions would have to be designated by name.

He went on to note that all the delegations were basically in agreement with the compromise proposal.

289. The Swedish delegation pointed out that the German version of the proposal contained in M/118/I differed from the English and French versions. As the proposal stood in German, the identification of the inventor would, under certain circumstances, have to contain a statement on the transfer of the right, whereas according to the other two versions the statement was simply to be attached. This difference could affect the sanction applied in cases where such statements were not provided. It considered that the sanction referred to in Article 90 (91), paragraph 5, i.e. whereby the application would be deemed to be withdrawn, should be applied in such cases. The Swedish delegation therefore suggested that the English and French be brought into line with the German version.

290. The Main Committee referred the matter to the Drafting Committee.

291. The French delegation wondered whether it could not be inferred from the proposal contained in M/118/I that omission of a statement on the transfer of the right implied that the applicant was the sole inventor. This seemed unjustified and a better method would be to require applicants who were sole inventors to give notice to that effect.

292. The Netherlands delegation contended that applicants who were sole inventors should not be required to furnish a separate document to that effect.

293. The Chairman’s opinion was that the Convention gave no grounds for inferring that applicants were in fact the inventors unless they gave some indication to the contrary. Even in cases where the applicant was the inventor, that fact would have to be indicated; such applicants would, however, simply omit the statement on the transfer of the right. Designation of the inventor would then be governed by Article 58 (60).

294. After due reflection the French delegation found the proposed text to be adequate on the premise that if the applicant were the sole inventor, he was bound to give indication to that effect in the application. If he were not the inventor, or not the sole inventor, he would have to include in the application a statement indicating the origin of the right to the European patent.

295. The Main Committee called upon the Drafting Committee to examine whether some clarification of Article 79 was necessary in the light of discussions on the matter (points 291 to 294).

Article 81 (83) — Disclosure of the invention

296. The Main Committee referred to the Drafting Committee a drafting proposal submitted by the French delegation (M/58/I/II).

* For Rule 19, see points 2047 et seq.

* No amendments were made to Article 79 by the Drafting Committee.
ted in such a way that in the case of all applications in which the Community States were designated, evidence of assignment by the inventor to the applicant would have to be provided, for the reason that the national law of one Community State, i.e. Denmark, required this evidence.

260. The Italian delegation suggested that evidence of assignment should not be required where this was laid down in the national law of a designated State, but rather where the application originated in a State whose law required this evidence.

261. The delegation of the International Chamber of Commerce referred to the great difficulties which would arise for the European Patent Office if, on the basis of a deed of assignment or of any other document describing the circumstances, it had to examine whether the assignment actually took place. It thus warned against adopting the Scandinavian proposal.

262. At this stage in the discussion, the Chairman pointed to the fact that the Scandinavian proposal was not so much aimed at protecting the rights of the inventor; these rights could, indeed, be protected before the national courts with the aid of Articles 58 and 59 (60 and 61) or, at all events, by means of revocation proceedings under Article 138. However, the Scandinavian proposal had a farther-reaching aim, namely, to introduce evidence of the applicant's right at the stage of the granting procedure.

263. The French delegation pointed out that the Scandinavian alternative proposal led to the same difficulties as the main proposal. There were, indeed, cases in which evidence of assignment was not required, or was even impossible, at least under French law, since there were no authorities which could certify such an assignment. At all events, this might suggest a unilateral declaration by the applicant to the effect that he was entitled to the application under national law.

264. The Austrian delegation raised three points which it saw as problematic in the Scandinavian proposal, although it fundamentally supported the proposal.

Firstly, it considered the 16 month period for submitting a deed of assignment too severe in some cases. Nor was the possibility of the re-establishment of rights under Article 121 (122) satisfactory in every case. It thus reiterated its question as to whether this period should not be extended until the grant of the patent in certain cases.

Secondly, as regards evidence of legal assignment, it should suffice if, in accordance with the Swedish proposal, this evidence could be provided otherwise than by means of a document.

Thirdly, the Austrian delegation expressed doubts about whether the European Patent Office was actually obliged, in accordance with the Scandinavian proposal, to examine, on the basis of the document submitted to it, whether rights had in fact been assigned to the applicant. The basis for this should be that entitlement to file an application was determined by national law, pursuant to Article 58. Under this national law, it should therefore also be examined whether the document established assignment. The Austrian delegation could imagine that it should suffice for such a document to be submitted to the European Patent Office. However, it would like some clarification on this point.

265. The delegation of the Federal Republic of Germany pointed out that it was unable to accept the alternative proposal by the Scandinavian countries for the same reasons for which it was unable to accept the main proposal. However, since it was aware of the significance of the problem for the Scandinavian States, and since, on the other hand, the latter had declared that they did not wish to impose their own system on the other Contracting States, a compromise solution might perhaps be considered. This could consist in the applicant, who was not the inventor, submitting a declaration to the European Patent Office when filing the application or at the latest within 16 months of its filing on the way in which the right to the European patent was transferred to him. If this declaration were not supplied in due time, the application would be deemed to be withdrawn. The content of the declaration should not be examined by the European Patent Office. There could also be provision for the Office to forward a copy of the declaration to the inventor to notify him that he was mentioned as such and how his right had been transferred to the applicant.

266. Also on behalf of the other Scandinavian delegations, the Swedish delegation said it could accept as a compromise the German proposal, even though it did not take all its desiderata into account. However, it appeared to this delegation to be important that the European Patent Office notify the inventor that he had been mentioned as such.

267. The French and Swiss delegations supported this compromise proposal. The Swiss delegation explicitly agreed that a copy of the declaration to be submitted should be forwarded to the inventor, and added the hope that this would largely prevent the drawing up of incorrect declarations of assignment.

268. The United Kingdom delegation reserved its position on the compromise proposal until the interested circles had expressed their views on it.

269. In the EIRMA delegation's opinion, the compromise proposal which it supported was very suitable for avoiding excessive bureaucracy in the European Patent Office and in the industrial patent departments, and also for safeguarding the inventor's rights. If the inventor considered that the applicant were not entitled to the application, he could bring charges before a national court under Article 59 (61). Furthermore, the Scandinavian proposal, in its most recent form, would be unable to solve the problem which might arise if several applicants were not to mention as an inventor a person who had been associated with them in the invention. This person would no longer be able to safeguard his right in due time.

270. The UNION delegation was prepared to support the compromise solution even though it was not possible to dispel entirely the fear that the requirement for a declaration concerning assignment might delay the procedure.

271. The IFIJA delegation also supported the compromise proposal.

272. The delegation of the International Chamber of Commerce also regarded the compromise proposal as an acceptable solution, which it furthermore took to mean that the requisite declaration on assignment would always have to be submitted, and not merely where the national law of a designated State laid down a similar regulation.

273. The FICPI delegation supported the compromise proposal, since it had made an identical proposal itself in M/48/1.

274. After hearing the statements by the interested circles, the Netherlands delegation pointed out that it could agree to the compromise proposal. It hoped that its practical application would not encounter any great difficulties, despite the fact that the European Patent Office would have to forward an estimated 10,000 declarations on assignment each year to inventors.

275. The United Kingdom delegation fundamentally regretted the fact that such a complicated solution had to be sought for the problem of mentioning the inventor. However, after hearing the interested circles, it was prepared to accept the compromise proposal provided that the following would be assured: the period for submitting the declaration on assignment should amount to 16 months; a simple declaration
247. Summing up the discussion up to that stage, the Chairman noted that all the delegations recognised the rights of the inventor and wished to protect them to the largest possible extent. He also referred to Article 58 (60), paragraph 1, which established the principle of the right of the inventor to a European patent. As for the difficult problem of inventions by employees, the Luxembourg Inter-Governmental Conference had deliberately made an exception by stipulating that rights arising out of an invention by an employee should be determined according to national law. This exception had been deliberately made in order to avoid a procedural Convention regulating matters of substantive law concerning the right to inventions in the employer/employee relationship, these being less a matter of patent law than a matter of labour and social law.

As regards the first part of the main Scandinavian proposal, the Chairman asked whether there were any objections and then noted that no delegations opposed compulsory mention of the inventor; this item was thus adopted.

The Chairman summed up the discussion on the second part of the main Scandinavian proposal by noting that all the other government delegations as well as some of the observer delegations had rejected any requirement that an applicant who was not the same person as the inventor should prove that rights had been assigned to him. Two major arguments had been put forward in this respect: firstly, it might be difficult in practice, or legally impossible, to obtain a document establishing assignment to the applicant. Secondly, the European Patent Office would have to apply the various laws of the individual States in order to determine whether the document submitted was legally valid and established the assignment. The Chairman asked whether any other government delegation supported the Scandinavian proposal, noted that this was not the case and that this part of the proposal was thus rejected.

248. The Committee then went on to discuss the Scandinavian alternative proposal to the effect that if the applicant was not one and the same person as the inventor, evidence would have to be provided that the applicant was entitled to the invention where this was provided for under the law of one of the designated States, and that the application for the designated Contracting States whose laws required such evidence would accordingly be deemed to be withdrawn if the evidence were not provided.

249. The Swiss delegation raised the question of how the Scandinavian alternative proposal, which was based on the law of the designated Contracting States, could be reconciled with Article 58 (60), paragraph 1, second sentence, under which, in the case of the inventions of employees, the right to the patent is determined in accordance with the law of the State in which the employee is mainly employed.

250. The Swedish delegation replied that the alternative proposal was in no way irreconcilable with Article 58 (60), paragraph 1, second sentence. It was based on whether or not assignment to the applicant should require documentary evidence under the law of a designated State. The question as to whether and under what law the applicant obtained the right to the patent had nothing to do with this. According to the alternative proposal, evidence of assignment should not be provided in all cases, but only in a limited number of cases. If the Scandinavian States were partisans of this solution it was because it had proved its worth in their countries, and to relinquish it would mean a step backwards for these countries.

251. The Netherlands delegation felt that it would be illogical to require a deed of assignment where the invention simply was not transferred to the applicant but the employer was legally entitled to the invention, as under Netherlands law. As an example, it quoted the case of a Netherlands employer filing a patent application in which both the Netherlands and Sweden were designated.

A further argument against the Scandinavian alternative proposal was that in almost all European patent applications, the nine States of the European Communities, which could only be designated jointly, would also be designated. Since Danish law required evidence of assignment to the applicant, such evidence would therefore always have to be produced if the application for all the States of the Community were not to be deemed as being withdrawn.

252. The Chairman shared the Netherlands delegation's view that if the Scandinavian proposal were adopted, the Second Convention would inevitably have to be supplemented in such a way that wherever an EC State were designated in the European application, evidence would have to be given of assignment to the applicant where the applicant and the inventor were not one and the same person.

253. The Swedish delegation raised the point that the Scandinavian countries' proposal was in no way intended to impose their legal solution on the other States of the Convention.

In the case referred to by the Netherlands delegation where it would be impossible to obtain a deed of assignment since assigner did not exist under Netherlands law, any other document from which this fact of law would be apparent would suffice. Thus, the Scandinavian proposal did not exclusively mention "deeds of assignment", but also "other documents establishing the applicant's right to the invention".

254. The Austrian delegation was prepared to support the Scandinavian proposal in principle, but found withdrawal of the application if the deed of the assignment were not submitted to be too severe a penalty in many cases. It suggested that if the deed of assignment were not submitted within 16 months, it should be possible, in exceptional cases, to submit the deed subsequently up to the end of the granting procedure. It was thinking here of cases in which it would not be possible for the applicant, for excusable reasons, to obtain the deed in due time, e.g. in the case of the death of the inventor.

255. In the United Kingdom delegation's view, the Scandinavian alternative proposal amounted virtually to the same thing as the main proposal which had already been rejected, since in view of the legal arrangements in Denmark, a deed of assignment would have to be submitted for all European applications in which a Community State was designated. The alternative proposal should therefore be rejected also.

256. The Finnish delegation suggested that the difficulties which might arise in the event of legal assignment could be resolved by requiring not "another document establishing the applicant's right to the invention", but any evidence establishing the applicant's right to the application. In the case referred to by the Netherlands delegation, reference to the fact that the employer would be entitled to the invention under Netherlands law would be sufficient evidence.

257. The Chairman considered that in this case also, the European Patent Office would still have to examine whether the national law cited did in fact result in assignment.

258. The Swedish delegation also felt that in the case of assignment, no deed of assignment should be required, but that the description of the content should suffice, and this should perhaps be confirmed by the inventor. However, it was unable to take the reference to the planned Convention between the EC States as an argument against the Scandinavian proposal.

259. In order to clarify the above point, the Chairman pointed out that if the Scandinavian alternative proposal were to be adopted, the Second Convention would have to be supplemen-
every effort should be made to strengthen the position of the inventor. However, considerable practical reservations could be made about the Scandinavian proposal that the transfer of rights to the applicant should be established within a certain period. Problems could arise, for instance, where the inventor was an employee and left his firm after a disagreement or where he emigrated or died. In all these cases, the required deed of assignment might not be submitted in due time, which would result in the application being deemed to be withdrawn.

239. The delegation of the International Chamber of Commerce supported the first part of the Scandinavian proposal but rejected the second part.

240. The UNION delegation also supported the first part of the Scandinavian proposal, but not the second part. As regards the latter, it proposed an arrangement according to which, if the applicant and the inventor were not one and the same person, the European Patent Office would notify the person mentioned in the application, as the inventor, of this fact.

241. The IFIA delegation referred to the declaration which it had made at the beginning of the Conference to the effect that the fundamental rights of the inventor should be recognised in the Convention. This had obviously been done in the case of Article 58, paragraph 1, which provided that the right to a European patent shall belong to the inventor or his successor in title. However, the discussions had hitherto shown that there was a lack of readiness to draw the consequences from these principles for other provisions. In order to make these consequences clear, IFIA submitted M/70/I/Corr, which not only contained the desires of the inventors' associations of IFIA, but also reflected the wish of industrial and employers' organisations to obtain clarification of the matter. IFIA, which had hitherto refrained from adopting positions on other matters, felt it had to express its opinion on this question which it considered to be an important one.

IFIA's proposal in M/70/I/Corr. were aimed at resolving the question of the assignment of the right of the inventor in a liberal, flexible and practicable way. Various solutions were possible, but hitherto exceptional cases only had been put forward against IFIA's efforts to secure a fundamental human right. IFIA would welcome any constructive proposal by means of which this fundamental right, which had been recognised by all the delegations present, would be put into effect in the Convention. But this self-evident demand had been opposed by arguing that national laws on this matter could not be harmonised. Inventors in all the national inventors' associations frequently complained of the fact that their rights were often lost without their knowledge. This could be remedied if, as had already been suggested by another observer delegation, a copy of the application were forwarded to the inventor. For this purpose, of course, the inventor would have to be known at a very early stage in the procedure. Such a solution would possibly satisfy the employees' organisations.

IFIA's proposals in M/70/I/Corr. were slightly more advantageous to the inventor than the Scandinavian proposal. IFIA had not, as a rule, put forward precisely formulated proposals because it was aware that their formulation would have to be harmonised with other provisions of the Convention, which would be possible only after their adoption in principle and should best be done by the competent committee of the Conference.

242. The COPRICE delegation felt that the problem of inventions by employees was one of the most important and, at the same time, most difficult problems, since it affected not only patent law, but also labour law. However, this problem should not further complicate discussions on the European patent. It should be realised that the European patent would lose its attraction for industry if the application formalities were made more complicated. This would be the case if, in accordance with the Scandinavian proposal, applicants had to submit documents which were difficult or impossible to obtain. In this connection, it should be noted that in some Contracting States, the employer was legally entitled to inventions by an employee without a deed of assignment being required. The legal situation could become very complicated in cases where the invention was the result of the work of several persons. On the basis of these considerations, the Scandinavian proposal should be rejected.

243. The EIRMA delegation pointed out that the industrial undertakings which were members of its organisation would not welcome a solution according to which documents which where difficult to obtain had to be submitted to the European Patent Office. On the other hand, as had already been suggested, the problem might perhaps be solved by the inventor being notified by the European Patent Office that an application in which he had been mentioned as the inventor had been filed.

244. The FICPI delegation considered IFIA's proposal to notify the inventor more flexible than the Scandinavian proposal and could thus support it. Furthermore, it referred to the fact that in M/48, Part B, FICPI itself had submitted proposals for the formulation of various Articles and Rules with the intention of solving the difficult problem of establishing assignment. Both solutions were equally acceptable to it.

245. The Swedish delegation gave the examples of the Swedish Ball-bearing Factory (SKF) and of Volvo to underline the great importance of inventors in every country for the technological development of the whole country. It was thus in the interests of all States to encourage their nationals to make good inventions. In this sense, the Scandinavian proposal attributed great significance to the rights of the inventor being given a fitting place in the Convention.

246. The Norwegian delegation stated that, according to the Scandinavian proposal, the question as to who was entitled to a patent should be decided under national law. This also applied to the relationship between employers and employees.

Various delegations had objected that it would be difficult or even impossible for the applicant to establish assignment to himself, particularly in the case of inventions by employees to which the employer was legally entitled. In such cases the Norwegian delegation contended that it might be sufficient for it to be proved to the European Patent Office that at the time of the invention, an employee/employer relationship existed between the inventor and the employer according to which the employer was entitled to the application. It should also be possible to find a solution for the other exceptional cases referred to, such as the disappearance or death of the inventor, and in this connection, the possibility of widening Rule 13 concerning the suspension of proceedings had been considered.

Various delegations had also criticised the fact that the European Patent Office would be burdened with too difficult a task if the entitlement of the applicant had to be examined in every case. This criticism could be answered by pointing out that, although under the Scandinavian proposal, a certain amount of work would be entrusted to the European Patent Office, this would, in most cases, be easy to carry out and would only be of any considerable amount in a very few cases. The European Patent Office would, of course, have to examine the applicant's entitlement to the application on the basis of the law of his country and, clearly, this could also involve the law of a third State. However, many years of experience in the Scandinavian countries had shown that this system was practicable. It was therefore felt that this would not be an unreasonable burden to put on the European Patent Office.
lengthy discussions, should be re-opened. They proposed first and foremost that the inventor should always be identified before the European Patent Office, irrespective of whether or not this was required by the law of a designated Contracting State and, furthermore, that the applicant's right to the invention should be attested to by means of documents, where the applicant and the inventor were not the same person. Adoption of this proposal would entail Articles 58, paragraph 2 (60, paragraph 3), 76 (78), paragraph 1 and 90 (91), paragraphs 1 and 5 being redrafted and Articles 79 (81) being deleted (M/69/I, pages 1 to 3).

The Scandinavian delegations proposed the following amendment:

If, where the applicant is not the inventor, it is not proven that the applicant has a right to the invention, the application shall be deemed to have been withdrawn in respect of the designated Contracting States, which prescribe such proof in their national law. This proposed amendment would entail amendment of Articles 58, paragraph 2 (Article 60, paragraph 3), 79 (81) and 90 (91), paragraphs 1 and 5 (M/69/I, pages 3 to 5).

228. The Swedish delegation put forward the following grounds for introducing these proposals.

The Scandinavian countries would not have tried to re-open discussion of the problem of the identification of inventors had it not been of paramount importance to all of them. The Swedish delegation had no wish to dwell on the reasons for the proposals, since they were all sufficiently well-known, but, it did wish to point out yet again that, in the view of the Scandinavian countries, the inventor deserved to play a central role in the procedure for the grant of patents and that this should be duly reflected in the Convention. To do so would in no way weaken but rather strengthen the procedure. Note should also be taken of the current trends in the law in other states, e.g. the USA and the Common Market States, particularly since the latter were considering making the identification of the inventor compulsory in the Second Convention. It would be a great mistake to adopt a solution which would soon be behind the times.

In conclusion, the Swedish delegation appealed both to those delegations which had previously been undecided, and to those which had initially opposed its proposals, to give some further thought to what it had said. The Scandinavian delegations, moreover, were fully prepared to agree to reasonable compromise solutions.

229. The Main Committee decided that it would initially confine its discussions to the principal proposal*. The Chairman recalled that, as things stood at present, the inventor would have to be identified before the European Patent Office only if the law of at least one of the designated States so required, and that the inventor had the right to be designated as such by the applicant.

230. The Austrian delegation said that, fundamentally, it was ready to agree to any solution which would improve the position of the inventor.

231. The United Kingdom delegation pointed out that it could support compulsory mention of the inventor. However, an incorrect designation of the inventor should not lead to any sanctions.

It had considerable reservations about the second request by the Scandinavian countries. Legal developments in the United Kingdom were following an opposite trend, and above all, the right to a patent did not always arise out of contracts of service, which, if the desired goal were to be attained, would have to be formulated in different legal terms. There were frequently no contracts of service whatsoever, but common law rights applied.

* See points 248 et seq. for discussion of the proposed amendment.

In its opinion, the justified interests of inventors were already met by the introduction of compulsory mention of the inventor. However, should the second part of the Scandinavian proposal also be adopted, the European Patent Office should be able to authorise exceptions to the procedure.

232. The French delegation also said it could support compulsory mention of the inventor, which was already provided for in the draft Second Convention. However, it could not agree to the second part of the Scandinavian proposal since this was closely related to the problem of inventions by employees. In this particular field, steps were currently being undertaken in France to codify hitherto existing jurisprudence in the matter and the outcome could not yet be predicted.

233. The Netherlands delegation also said it was prepared to agree to compulsory mention of the inventor. However, this already constituted a compromise for it, since there was no obligation in the Netherlands to mention the inventor. However, it could not support the second part of the Scandinavian proposal, which had only just been made after lengthy discussions on the problem. In the Netherlands, where the employer was legally entitled to an invention by an employee, this could lead to considerable difficulties.

234. The delegation of the Federal Republic of Germany pointed out that it could also accept compulsory mention of the inventor. However, it could not support the second part of the Scandinavian proposal. This would create considerable difficulties in the Federal Republic since, under German law, inventions by employees could be claimed by the employer and in such cases, the right to the invention would be transferred to the employer without any deed of assignment. Nor could there be any question of the European Patent Office having to examine the question of the validity of the assignment or the problem of the applicant's entitlement in general.

235. The Irish delegation could support the first part of the Scandinavian proposal, but not the second. It explained that under Irish law also, the transfer of an invention by an employee to the employer required no deed of assignment.

236. The Yugoslav delegation welcomed any effort to improve the situation of the inventor. For this reason, it sympathised with the Scandinavian proposal to render mention of the inventor compulsory. However, it should also be considered that there could be cases where the inventor might wish to remain anonymous, just as the right to remain anonymous existed in the case of copyright (see also point 281).

As for the second part of the Scandinavian proposal, it should be noted that a deed of assignment was relatively easy to obtain where a legal assignment of the right was involved. However, it would be practically impossible to obtain such a document in those cases where the right was transferred under law from the inventor to another person. Moreover, the European Patent Office could hardly be expected to examine whether the applicant was also entitled to the application, since this would necessarily involve interference in the civil law affairs of third parties. As regards the problem of employees' inventions in particular, the principle laid down in the Convention that the right to an invention by an employee was governed by national law was correct and should be approved.

237. The Swiss delegation also said it could agree to compulsory mention of the inventor, but not to the second part of the Scandinavian proposal. Under Swiss law also, the employer was legally entitled, in certain cases, to an invention by an employee without any deeds of assignment being required. In such cases no document whatsoever could therefore be submitted. Moreover, there could be no question of giving the European Patent Office the task of examining the substantive content of deeds of assignment.

238. The FICPI delegation stated its opinion that, in principle,
208. The Swiss delegation said it would be prepared to do so. It nonetheless requested that, in the French version, paragraph 2 ("objet d'une demande") should be brough into line with paragraph 1 ("éléments contenus dans une demande"), as was already the case in the English and German versions.

209. The delegation of the Federal Republic of Germany pointed out that, in its view, elements of the divisional application which extended beyond the earlier application could perhaps not be deleted, but should merely receive the date of filing of the divisional application.

210. Summing up, the Chairman noted that the Main Committee was agreed on the following interpretation of paragraph 2*: where a divisional application comprised new examples not to be found in the earlier application, these examples were allowable if they did not extend beyond the content of the earlier application. They were not, however, deemed to have been filed on the date of the earlier application but belonged to the state of the art only as from the date of filing of the divisional application. Where a divisional application comprised new examples extending beyond the content of the original version of the earlier application, these examples were not allowable. They should not, however, be deleted, but should be dealt with in exactly the same manner as the other category of new examples.

211. The Main Committee referred examination of the French version (see point 208 above) to the Drafting Committee.

Article 75 (77) — Forwarding of European patent applications

212. The delegation of the International Chamber of Commerce wondered why different time limits were laid down in paragraphs 3 and 5. Under paragraph 3, the national office had either 4 or, in the case of priority applications, 14 months in which to forward to the European Patent Office European applications. Under paragraph 5, however, the European patent application was deemed to be withdrawn if it did not reach the European Patent Office within 14 months of filing or the date of priority. It wondered whether it might not be advisable for a single time limit of 14 months to be set out in paragraph 3, or, for the time limit in paragraph 5 to be 4 months.

213. The Chairman replied by pointing out that paragraphs 3 and 5 were designed to deal with two distinct points. Paragraph 3 laid down how much time national patent offices were allowed for forwarding to the European Patent Office applications not liable to secrecy. The applicant's interests did not suffer if his application was forwarded to the European Patent Office more than 4 months after filing, provided no more than 14 months were allowed to elapse. On the other hand, paragraph 5 laid down the sanction to be imposed in the event of the application not being forwarded to the European Patent Office within 14 months. Here, in accordance with the PCT, it made no difference whether applications were filed with or without priority.

214. The CNIPA delegation said it was very surprised that, under paragraph 5 applications which were not forwarded punctually to the European Patent Office were deemed to be withdrawn, despite the fact that the applicant had no influence over the forwarding procedure.

215. The United Kingdom delegation pointed out that, in practice, applicants could make enquiries at the national offices as to the processing of their applications.

216. The EIFRMA delegation pointed out that, under Article 135, paragraph 1(a), a European patent application could be converted into a national application if it were not forwarded punctually to the European Patent Office and that, in such cases, the applicant suffered no loss of rights. Nonetheless, it considered it advisable to review the time limits and sanctions laid down in paragraphs 3 and 5.

217. The Main Committee referred paragraph 5 to the Drafting Committee, with the request that it review its wording in the light of the above remarks.

Article 76 (78) — Requirements of the European patent application

218. With reference to the proposal it made in M/52/1/11/I11, point 10, the Netherlands delegation raised the question of whether it was really necessary to include an abstract in the requirements laid down in paragraph 1. It was true that at the Luxembourg Conference it had already been decided to do so — partly with reference to the PCT, which also prescribed an abstract; nonetheless, there were still some doubts in the Netherlands as to whether an abstract was really essential.

219. The United Kingdom delegation considered that experience in great Britain had demonstrated that an abstract was of value. It did not want it to be omitted from the procedure from the outset but if, subsequently, it should prove to be an unnecessary complication, it could agree to the Administrative Council being given power to dispense with the abstract in the list of requirements for the application.

220. The Swedish delegation was also in favour of the retention of the abstract, but would likewise be prepared to give the Administrative Council the power to have the abstract deleted.

221. The French delegation was in favour of the retention of the abstract. It would not be prepared to give the Administrative Council the power to decide on the deletion of the abstract.

222. The delegation of the Federal Republic of Germany was in complete agreement with the French delegation. It also drew attention to the difference between the content of patent claims and the content of the abstract. While patent claims delimit the protection of the patent, the purpose of the abstract was to provide a summary of everything set out in the claims, description and diagrams. In many cases, the abstract would thus contain more than the patent claims and it would therefore be regrettable if this source of information were to be relinquished.

223. Following these comments, the Netherlands delegation withdrew its proposal. Paragraph 1, as worded in M/1, was thereby adopted.

224. The Netherlands delegation said it interpreted paragraph 2 as meaning that the filing fee did not necessarily have to be the same for all applications, but that it could vary depending on the length of the description and the number of claims, for example.

225. The Chairman said that he shared this view. Filing fees were, moreover, to be laid down by the Rules relating to Fees, and were, therefore, a matter for the Administrative Council.

Article 77 (79) — Designation of Contracting States

226. The Chairman noted that no proposals had been put forward regarding Article 77.

Article 79 (81) — Identification of the inventor

227. The Danish, Finnish, Norwegian and Swedish delegations proposed that the question of the identification of the inventor and related questions, which had already been settled by the Luxembourg Inter-Governmental Conference after
Minutes of the Proceedings of Main Committee I

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

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

On this basis the Main Committee was responsible for Articles 14, 50 — 142, 144, 148 — 157, 161, 162 and 174 of the Draft Convention (M/1), Rules 1 — 7 and 13 — 107 of the Draft Implementing Regulations (M/2), the Draft Protocol on Recognition (M/3), the Recommendation on preparations for the opening of the European Patent Office (M/8) and the Recommendation on training staff for the European Patent Office (M/37).

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

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

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

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

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

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

A. General

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

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

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

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

The Main Committee agreed with this interpretation.

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

Article 14 — Languages of the European Patent Office

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

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

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

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

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

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

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

* The Rules of Procedure (M/34) had been previously adopted unanimously by the Plenary (see M/PR/K/1, point 10).
MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Munich, 10 September to 5 October, 1973)

published by the
Government of the Federal Republic of Germany
Article 79 § 1

Designation of the inventor

The European patent application shall designate the inventor. If the applicant is not the inventor or is not the sole inventor, the designation shall contain a statement indicating the origin of the right to the European patent.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

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

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee
Subject: Convention: Articles 55 to 83
Article 79

Designation of the inventor

The European patent application shall designate the inventor. If the applicant is not the inventor or is not the sole inventor, the designation shall contain a statement indicating the origin of the right to the European patent.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 27 September 1973

M/ 136/I/R 10

Original: English/French/German

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

Articles of the Convention:

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Article 79

Identification of the inventor

The European patent application shall identify the inventor. If the applicant is not the inventor or is not the sole inventor, the identification shall be associated with a statement indicating the origin of the right to the European patent.

Article 90

Examination as to formal requirements

(1)

(a)

(b)

(c)

(d)

(1)

(f) the identification of the inventor has been made in accordance with Article 79;

(g)

(2)

(3)

(4)

(5) Where, in the case referred to in paragraph 1(f), the omission of the identification of the inventor is not, in accordance with the Implementing Regulations and subject to the exceptions laid down therein, corrected within 16 months after the date of filing of the European patent application or, if priority is claimed, after the date of priority, the European patent application shall be deemed to be withdrawn.

(6) Unchanged from 1972 published text

M/118/I
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 21 September 1973
M/118/I
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: German delegation (1)

Subject: Identification of the Inventor -
Articles 79 and 90 and Rules 17, 19, 26 and 42

(1) The German delegation's proposals have been examined by the Drafting Committee of Main Committee I.
has been assigned to the applicant, i.e. in the case of non-compliance the application shall be deemed to have been withdrawn in regard to any designated State requiring such proof in respect of national applications.

The following amendments should then be made:

**Article 58**

The following should be added to paragraph 2:

"subject to the provisions of Article 79".

**Article 79**

Article 79 should be worded as follows:

"The European patent application shall identify the inventor and, if the applicant is not the inventor, contain a deed of assignment executed by the inventor or another document establishing the applicant's right to the invention where the national law of at least one of the designated Contracting States requires such identification and documentation to be supplied for national patent applications".

**Article 90**

Paragraph 1(f) should be amended in the following way:

"(f) the inventor has been identified and the application contains a deed of assignment or another document establishing the applicant's right to the invention pursuant to Article 79."

M/69/I/mb
Article 79

The Article should be deleted.

Article 90

Paragraph 1(f) should be worded as follows:

"the requirements of Article 76, paragraph 1(f) and (g), have been satisfied;"

Paragraph 5 should be amended as follows:

"Where, in the case referred to in paragraph 1(f), the omission of the identification of the inventor or, in the case when the applicant is not the inventor, of the deed of assignment executed by the inventor or of another document establishing the applicant's right to the invention is not, in accordance with the Implementing Regulations and subject to the exceptions laid down therein, corrected within 16 months after the date of filing of the European patent application or, if priority is claimed, after the date of priority, the application shall be deemed to be withdrawn."

Alternative proposals

If the solution proposed above does not gain sufficient support, the Nordic delegations alternatively propose that a solution along the same lines as that governing the requirement to identify the inventor (Articles 79 and 90 (5)) should apply also to the question of submitting evidence that the invention
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 11 September 1973
M/69/1
Original: English

CONFERENCE DOCUMENT

Drawn up by: The delegations of Denmark, Finland, Norway and Sweden

Subject: Proposals for amending Articles 58, 76, 79 and 90
(3) The copy of declaration mentioned in Art. 79 shall be transmitted forthwith by the European Patent Office to the inventor at his latest known address or, if the inventor is dead, where possible to a representative of his legal successors, with indication of the filing date and serial number of the application. The European Patent Office cannot be held responsible for any errors or omissions in connection with that transmittal."

15. If these amendments are adopted, the inventor, if he is of the opinion that the applicant was not entitled to file, could immediately proceed under Art. 59.

16. In the above proposals the possibility of obtaining European patents for Contracting States where mentioning of the inventor is not required under the national laws, has been omitted. It is felt that if a "maximum solution" is to be adopted, it must also extend to the fundamental question of the right to the European patent. For such countries applicants who cannot or will not mention the inventor still have the possibility of applying for national patents. Besides, such countries have the faculty of adopting provisions for conversion under Art. 135 (1) (b).
and, if the applicant is not the inventor, indicating the manner in which the inventor's right has been transferred to the applicant, as well as a copy of the said declaration for transmittal by the European Patent Office to the inventor with indication of the filing date and serial number of the application.

11. Rewrite Art. 90 (1) (f) as follows:
   "(f) the declaration and copy mentioned in Art. 79 have been filed, ".

12. Rewrite Art. 90 (5) as follows:
   "(5) Where, in the case referred to in paragraph 1 (f), the failure to file the declaration and copy mentioned in Art. 79 is not corrected within four (4) months after the date of filing of the European patent application, the application shall be deemed to be withdrawn."

13. Rewrite Rule 17 as follows:
   "Rule 17. Declaration of Inventorship.
   The declaration and copy to be filed under Art. 79 must state the family name and given names of the inventor as well as his full address or latest address known to the applicant."

14. Rewrite Rule 42 as follows:
   "42. Examination of declaration of inventorship.
   (1) If the examination provided for in Art. 90, paragraph 1 (f) reveals that the declaration and copy mentioned in Art. 79 have not been filed, the Receiving Section shall inform the applicant that the application will be deemed to be withdrawn unless the said declaration and copy are filed within four (4) months after the date of filing of the European patent application.

   (2) In the case of a European divisional application or of a new European patent application filed pursuant to Art. 59, paragraph 1 (b), the time limit for filing the declaration and copy mentioned in Art. 79 may in no case expire before two months after the communication referred to in paragraph 1, which shall state the time limit."
caring to answer letters or to comply with tedious formalities. He may be living in a place where it takes a travel of days to appear before an officer who can certify his signature. The situation arising when the inventor dies before the application is filed is sometimes almost hopeless. He may have a lot of heirs spread all over the world.

5. For these reasons the compulsory filing of an express assignment executed by the inventor is at least a too strict requirement, and the fact is that in the Nordic countries also other evidence of assignment is accepted, such as a certified copy of a world-wide assignment e.g. filed in respect of a U.S. application, or a certified copy of an agreement of employment showing that the right to the employee's inventions belongs to the employer (with or without special renumeration, as the case may be), or, where this follows from national law, just showing that the inventor was an employee of the applicant at the time when the invention can be presumed to have been made.

6. It is also pointed out by the profession in the Nordic countries that too strict requirements in respect of the time limit for the filing of evidence of assignment should not be adopted. In the normal case presentation within a relatively short time limit does not give rise to difficulties, but in special cases of the type referred to above it may take very long time to procure evidence, and it seems to be unreasonable that an application should become abandoned solely for the reason that there are practical difficulties in procuring evidence. In the majority of cases, the inventor would regret this just as much as the applicant. In this connectic it should be mentioned that in the Nordic countries the patent authorities are generally very lenient in the matter of granting and extending time limits for the filing of evidence of assignment, much more so than one would believe from their comments on the European Patent Convention.

7. It is pointed out from other quarters within the FICPI that the requirement to file an assignment document is no real guarantee to the inventor because the applicant, if really intent on committing fraud, may indicate another person as the inventor and have him sign an assignment. From these quarters it is also questioned whether the position of the inventor is in fact stronger in the countries where documentation of the transfer of the inventor's right is compulsory, than in countries where this is not the case.

8. The following compromise is presented for consideration:

9. At the end of Art. 58 (1) add the following: "..... provided that he has complied with the requirement of Art. 79".

10. Rewrite Art. 79 as follows:

"The European patent application shall be accompanied by a declaration, signed by the applicant, stating who is the inventor
re: Munich Diplomatic Conference  
September 1o to October 6, 1973.

MEMORANDUM B

on evidence of transfer of the inventor's right.

Art. 58, 79, 9a, Rules 17, 42.

1. It is strongly urged by all the Nordic countries, viz. the Finnish government in M/12, point 5, pages 76-77, the Swedish government in M/13, points 3-5, pages 80-81, the Norwegian government in M/28, points 5-6, pages 344-5, and the Danish government in M/35, points 3-4, pages 2-3 (not included in the printed volume) that where the applicant is not the inventor, he shall be required to prove that the invention has been transferred to him. The Swedish, Finnish and Danish governments would even prescribe the filing of an assignment document as compulsory.

2. In M/17, point 1, pages 146-7, the IFIA expresses the same idea, if possible even more emphatically.

3. Since the filing of evidence of transfer of the inventor's right has been urged by the Nordic governments, the FICPI has first of all requested its Nordic members to report on their experience under the Nordic patent systems where evidence of transfer is compulsory. The experience of the profession in the Nordic countries seems on the whole to be that the system of compulsory evidence of transfer works out satisfactorily, does usually not give rise to serious complications, and is generally of advantage to both the inventor and the applicant because the system forces them to establish their mutual rights at an early date, thereby reducing the danger of conflicts at a later time where it may be much more difficult to settle any differences between the parties.

4. On the other hand, it cannot be denied that once in a while cases occur where the filing of evidence in support of the transfer of the inventor's right does give rise to trouble. E.g., in the case of an employed inventor, he may have left his employ before the application is filed and it may be difficult or impossible to trace him or he may refuse to sign an assignment, even if he has a contractual obligation to do so, either because he has complaints against his previous employer in some respects not necessarily connected with the invention, or because he has been assimilated in an entirely different environment, maybe in a far-off country and has lost all interest in the affaire of his previous employer, and maybe is not the type of man
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 10 September 1973

M/ 48/I

Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: PICPI

Subject: Memoranda on:

- representation
- evidence of transfer of the inventor's right
- multiple priorities and partial priorities
- withdrawal of the European patent application
- extension of periods as related to language problems
However, the Danish Government would like to propose the following amendments for acceptance at the Diplomatic Conference:

I.

3. Article 58, paragraph 2, should be formulated as follows:

"For the purpose of proceedings before the European Patent Office, the applicant shall be deemed to be entitled to exercise the right referred to in paragraph 1 provided that the applicant when the invention is obtained from the inventor has submitted a deed of assignment executed by the inventor".

If this proposal is accepted, it is to be supplemented by the following amendments:

Article 90 by adding that the deed of assignment is to be examined and that the application shall be deemed to have been withdrawn, if the deed of assignment is not submitted in its correct form despite a warning, and

Article 79 in such a way that the identification of the inventor is to be compulsory without reference to the provisions of the national laws of the countries concluding the Treaty and that the same regulations may be applied as above in respect of the documents making up the application.

Finally some amendments to the Implementing Regulations will be necessary.

4. Explanatory note: The Draft Convention and Protocol concerning the Recognition of Decisions in respect of the Right to the Grant of a European Patent contain various provisions, the main aim of which is to ensure that the inventor does not lose his rights to the invention.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Brussels, 4 July 1973
M/35
Original: German

PREPARATORY DOCUMENT

Drawn up by: Danish Government

Subject: Observations on the Draft Convention establishing a European System for the Grant of Patents
anderen Person eingereicht wird, wird sein Recht auf die Erfindung nicht aufgehoben.

(2) Die Frist, in der die fehlende Erfindernennung nachvollzogen und die fehlende, vom Erfinder unterschriebene Zustimmungserklärung eingereicht werden kann, darf nur einen kleinen Teil des Prioritätsjahres — höchstens drei oder vier Monate — ausmachen.

Der geeignetste Zeitpunkt, der auch zu den verläßlichsten Ergebnissen führt, ist in der Regel der Zeitpunkt, zu dem der Patentanwalt mit der Abfassung der Patentschrift beginnt und sich an den Erfinder wenden muß, um die Art der Erfindung festzustellen, die er zu beschreiben hat.

(3) Der grundlegende Schutz des Rechts des Erfinders, wie unter den Nummern 1 und 2 beschrieben, sollte in Artikeln niedergelegt und keinen Ausnahmen in der Ausführungsordnung unterworfen werden (wie beispielsweise in Artikel 90 Absatz 5). Etwa notwendige Ausnahmen sollten in die Artikel selbst aufgenommen werden.

(4) Falls es aus rechtlichen Gründen zur Zeit nicht möglich ist, die in Absatz 1 wiedergegebenen Vorschläge als eine allgemeine Bedingung für alle europäischen Patentanmeldungen anzunehmen, so sollten die darin enthaltenen Bestimmungen doch auf alle Fälle dann angewandt werden, wenn sie bereits in den Vorschriften des nationalen Patentrechts zumindest eines der benannten Staaten vorgesehen sind.

2 Veröffentlichung von Patentanmeldungen vor ihrer Erteilung

IFIA hat immer scharf das System kritisiert, bei dem noch nicht vollständig geprüfte Patentanmeldungen vorzeitig veröffentlicht werden, und hält diese verhältnismäßig junge Neuerung beim Patentsystem für einen äußerst großen Rückschritt. Dadurch kann nur bewirkt werden, daß die allgemeine Unsicherheit der Lage hinsichtlich der Monopolechte auf dem Industriesektor vergrößert, potentiellen Verletzern Vorschub geleistet, Werkspionage gefördert und dem schon riesigen Umfang technischer Veröffentlichungen eine Vielzahl anderer Patentanmeldungen hinzugetragen wird.

3 Notwendigkeit einer Kostensenkung

Die Schaffung eines zentralen Amts zur Erteilung europäischer Patente mit der Konsequenz, daß die in mehreren nationalen Patentämtern Europas bereits bestehenden Möglichkeiten nicht mehr benutzt werden, muß zwangsläufig mit einem großen Kapitalaufwand verbunden sein. Von größerer Bedeutung ist jedoch — vom Standpunkt der „Kunden“ des Europäischen Patentamts aus gesehen —

(4) If for legal reasons it is impossible at present to accept the proposals in (1) above as a general condition for every European patent application, they should in any case be applied if they already form part of the provisions of the national patent law of at least one of the designated States.

2 Publication of patent applications before grant

IFIA has always been a strong critic of the system of premature publication of patent applications which have not been fully examined, and regards this comparatively recent innovation into patent systems as a retrograde step of first magnitude. Its effect can only be to increase the general uncertainty of the position with regard to monopoly rights in the industrial field, to aid a would-be infringer, to encourage industrial espionage, and to add to the already overwhelming volume of technical publications a great many patent applications in a transitional stage of drafting.

3 The need for reduction of costs

The setting up of a central Office to grant European patents, with the consequent abandonment of the use of the facilities already existing in several national patent offices of Europe, must necessarily involve a large outlay of capital. More important, however, from the point of the "customers" of the European Patent Office is the fact that it is the intention to meet the running costs of the European
In Ländern, in denen solche Verträge zulässig sind, ist das wirtschaftliche Interesse am Patent — soweit der Erfinder betroffen ist — verschwunden, und es verbleibt für ihn lediglich das moralische Recht, als Erfinder anerkannt zu werden.


Zusammenfassend möchte IFIA nachdrücklich darauf drängen, daß der Schutz des grundlegenden Rechts des Erfinders — der in Artikel 58 ausdrücklich wie folgt anerkannt wird: „Das Recht auf das europäische Patent steht dem Erfinder oder seinem Rechtsnachfolger zu“ — wie folgt sichergestellt wird:

(1) Die europäische Patentreinmel dung sollte den Erfinder immer nennen und, falls der Anmelder nicht der Erfinder ist, eine vom Erfinder unterzeichnete Übertragungsurkunde oder Erklärung enthalten, in der zum Ausdruck kommt, daß er der Einreichung der Anmeldung zustimmt.

Durch eine solche Erklärung, in der der Erfinder darin einwilligt, daß eine Anmeldung von einer

parties. To enable employee inventors in such countries to enjoy in practice the rights apportioned to them by law, it is essential that they should be informed, ab initio, of the filing of the patent application. Such information is automatically and conveniently achieved if a written declaration of assent signed by the inventor has to be filed together with the application. Any time lag between the filing of the application and of the signed declaration may adversely affect the inventor's position. For instance, if the employer has not acquired the whole right to the invention, the inventor must have ample time within the priority year to decide in which countries he wishes to make his own foreign applications.

Article 79 acknowledges the inventor's right to be named where the national law of one designated country requires it. However, it overlooks the fact that the identification of the inventor in the national patent laws of the countries referred to above is always combined with a stipulation that the applicant, if he is not the inventor, shall establish his right to make the application. In fact, the identification alone of the inventor does not give him the legal protection, which is the purpose of these stipulations in the national laws. The acknowledgment of national law therefore ought to be extended to include both the identification of the inventor and the verification of the right to the invention.

Summing up, IFIA strongly urges that the safeguarding of the inventor's basic right — recognised expressly in Art. 58: viz. "The right to a European patent shall belong to the inventor or his successor in title" — should be implemented in the following way.

(1) The European patent application should always identify the inventor and, if the applicant is not the inventor, contain an assignment or a declaration signed by the inventor stating that he asents to the making of the application.

Such a declaration stating that the inventor asents to an application being made by another person does not thereby abrogate his right to the invention.

(2) The time limit for correcting the omission of the identification of the inventor and of the document of assent signed by the inventor must be only a small fraction of the priority year — not more than 3 or 4 months.

The easiest moment, and the one that gives the most reliable result, is usually when the patent agent starts writing the specification, and must turn to the inventor to find the nature of the invention which he has to describe.

(3) The basic protection for the inventor's right as given in (1) and (2) above should be stated in Articles and not be subject to any exceptions in the Rules (as for instance in Art. 90 (5)). Exceptions, if necessary, should be included in the Articles themselves.

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1 Implementation of the inventor’s basic right to a European patent

Article 58 of the EPC expressly recognises the fundamental principle which lies at the basis of almost all Patent Systems of the world, and which is indeed explicitly stated in most national Patent Laws. This principle is that “the right to a patent shall belong to the inventor or his successor in title”.

The patent is in fact in most countries the only means which the law affords for protection of an inventor’s intellectual creation. Where the inventor himself files a patent application, no difficulty can arise in the implementation of this principle, and the inventor has no difficulty in securing his right. Frequently, however, another person or body, e.g. an entrepreneur, contractor or a company is interested in the exploitation of the invention, and is anxious to apply for the patent. This usually is also in the inventor’s interest, in which case there will be no difficulty in obtaining his consent to the filing of an application by someone other than himself. Article 56 of the Convention clearly recognises the possibility of a patent application being filed by anyone, but makes no provision for ensuring that the applicant is properly entitled to apply. As a result of this omission, and especially in view of the fact that applications are secret, it is quite possible for an application to be filed without the inventor’s knowledge, so that in effect the applicant usurps the inventor’s right to the patent. On the basis of this application, of which the inventor is still blissfully ignorant, the applicant may also start negotiations for selling or licensing the patent right or marketing the products of the invention. It ill accords with the basic principle of law in Western civilised countries, that it should be possible for somebody to handle and use another person’s property without that person’s knowledge and consent.

It is perhaps surprising that some national patent laws, though by no means all, are similar to the proposed European system in recognising the basic right of the inventor to the patent, while having no provisions for ensuring that an applicant other than the inventor is properly authorised. This probably arises from the concept current in some countries that inventions made by an employee within the field of his employment automatically belong to the employer without any duty on the employer’s part to pay the inventor anything more than his normal salary. Sometimes a clause to this effect is actually included in an employee’s contract. In countries which permit such contracts the economic interest in the patent has so far as the inventor is concerned, and all that remains for him is the moral right to be acknowledged as inventor.

Other European countries have introduced special laws about employees’ inventions, regulating the conditions under which the employer is empowered to take, wholly or in part, the right to the invention, and apportioning its economic value between the
STELLUNGNAHME DER

IFIA
International Federation of Inventors Associations

COMMENTS BY

IFIA
International Federation of Inventors Associations

PRISE DE POSITION DE

L'IFIA
International Federation of Inventors Associations
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN
PATENTERTeilungsVERFAHRENS 1973
(München, 10. September bis 6. Oktober 1973)

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

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

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

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

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

1973

5 Die schwedische Regierung schlägt daher vor, dem Artikel 58 Absatz 2 eine Einschränkung folgender Wortlauts hinzuzufügen: „sofern der Anmelder, falls ihm der Erfinder die Erfindung übertragen hat, eine vom Erfinder ausgestellte Abtretungsurkunde vorgelegt hat.“ Artikel 90 sollte dann so geändert werden, daß dieser Punkt in die Prüfung einbezogen wird. Wird die Urkunde nicht vorgelegt, obgleich Gelegenheit zur Beseitigung dieses Mangels gemäß Artikel 90 Absatz 2 gegeben war, so sollte die Anmeldung als zurückgenommen gelten. Aus diesem Vorschlag ergibt sich, daß die Erfordernisse unabhängig davon, welche Länder in der Anmeldung benannt werden, zwingend vorgeschrieben werden müßten und daß dieselbe Sanktion wie hinsichtlich der Abtretungsurkunde gelten müßte.

6 Sollte diese Regelung nicht hinreichend unterstützt werden, so schlägt die schwedische Regierung als Alternative vor, eine ähnliche Lösung wie für das Erfordernis der Erfidernennung (Artikel 79 und Artikel 90 Absatz 5) auch für die Frage der Erbringung des Nachweises darüber, daß die Erfindung dem Anmelder abgetreten worden ist, zu treffen; die Anmeldung gilt für die benannten Vertragsstaaten, die einen solchen Nachweis für nationale Patentanmeldungen vorschreiben, als zurückgenommen, wenn diesem Erfordernis nicht entsprochen worden ist.

7 Sicherlich werden das im Übereinkommensentwurf vorgesehene Erteilungsverfahren und das hohe fachliche Niveau des Europäischen Patentamts ausreichende Gewähr dafür bieten, daß Patente nicht zu Unrecht erteilt werden. Indes werden nach Auffassung der schwedischen Regierung die Öffentlichkeit und die Konkurrenten nur dann hinreichend geschützt sein, wenn für sie klar ist, was sie tun dürfen, ohne durch ein Patent behindert zu werden. Die schwedische Regierung ist daher der Ansicht, daß der Entwurf der Erklärung zu Artikel 67 einen zu großen Spielraum zur Bestimmung des Schutzbereichs einräumt. Bei der Vorarbeit zur nordischen Patentgesetzgebung wurde ganz besonders betont, daß der Patentinhaber nicht in der Lage sein dürfte, aus Unklarheiten in den Patentansprüchen Nutzen objectives are most easily achieved if — as in the Nordic legislation — the inventor must be named and the presentation of an assignment signed by the inventor is compulsory when a patent application is filed. Experience has shown that these conditions once established are easily complied with also by applicants from outside the Nordic countries. The Swedish Government hopes that these views — which are actually aimed at strengthening the patent system — will gain general recognition at the Diplomatic Conference.

5 The Swedish Government therefore proposes to add to Article 58, paragraph 2, a proviso of the following wording: “provided that the applicant when the invention is obtained from the inventor has submitted a deed of assignment executed by the inventor”. Article 90 should then be amended to include this item for examination. If the deed is not submitted although an opportunity to correct a deficiency in this respect has been given in accordance with Article 90, paragraph 2, the application should be deemed to be withdrawn. It follows from this proposal that the mention of the inventor should be compulsory regardless of the countries designated in the application and that the same sanctions should apply as those mentioned above with respect to the deed of assignment.

6 If this solution does not gain sufficient support, the Swedish Government alternatively proposes that a solution along the same lines as that governing the requirement to identify the inventor (Articles 79 and 90, paragraph 3)), should apply also to the question of submitting evidence that the invention has been assigned to the applicant, i.e. in the case of non-compliance the application shall be deemed to have been withdrawn in regard to any designated state requiring such proof in respect of national applications.

7 It is recognised that the administrative procedures and the high competence of the European Patent Office as foreseen in the Draft Convention provide sufficient security against the grant of patents which are not justified. In the view of the Swedish Government, however, the general public and competitors are not sufficiently protected, unless they can clearly see what they are free to practise without the hindrance of a patent. For this reason the Swedish Government considers that the draft declaration in respect of Article 67 provides too wide a margin for determining the scope of protection. In the preparatory work to the Nordic patent legislation it was strongly emphasised that the patentee should not be able to profit from obscurities in the patent claims. The description and the
STELLUNGNAHME
DER SCHWEDISCHEN REGIERUNG

COMMENTS
BY THE SWEDISH GOVERNMENT

PRISE DE POSITION
DU GOUVERNEMENT SUÉDOIS
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS, 1973
(Münch, 10 September to 6 October 1973)

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

STELLUNGNAHMEN
zu den vorbereitenden Dokumenten
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COMMENTS
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1973
b) die Benennung mindestens eines Vertragsstaats;
   c) Angaben, die es erlauben, die Identität des Anmel-
      ders festzustellen;
   d) in einer der in Artikel 14 Absätze 1 und 2 vorgesehe-
      nen Sprachen eine Beschreibung und einen oder mehrere
      Patentansprüche, selbst wenn die Beschreibung und die
      Patentansprüche nicht den übrigen Vorschriften dieses
      Übereinkommens entsprechen.

**Artikel 79**
Erfindernennung

In der europäischen Patentanmeldung ist der Erfinder zu
nennen, wenn das nationale Recht zumindest eines der
benannten Vertragsstaaten die Erfindernennung für
nationale Patentanmeldungen vorschreibt.

*Vgl. Regeln 17 (Einreichung der Erfindernennung), 18 (Bekannt-
   machung der Erfindernennung) und 19 (Berichtigung oder
   Widerruf der Erfindernennung)*

**Artikel 80**
Einheitlichkeit der Erfindung

Die europäische Patentanmeldung darf nur eine einzige
Erfindung enthalten oder eine Gruppe von Erfindungen,
die untereinander in der Weise verbunden sind, daß sie
eine einzige allgemeine erforderliche Idee verwirklichen.

*Vgl. Regeln 29 (Form und Inhalt der Patentansprüche) und 30
   (Patentansprüche verschiedener Kategorien)*

**Artikel 81**
Offenbarung der Erfindung

Die Erfindung ist in der europäischen Patentanmeldung
so deutlich und vollständig zu offenbaren, daß ein
Fachmann sie ausführen kann.

*Vgl. Regel 28 (Erfordernisse europäischer Patentanmeldungen
   betreffend Mikroorganismen)*

**Artikel 82**
Patentansprüche

Die Patentansprüche müssen den Gegenstand angeben,
für den Schutz begehrt wird. Sie müssen deutlich, knapp
gefaßt und von der Beschreibung gestützt sein.

*Vgl. Regel 29 (Form und Inhalt der Patentansprüche)*

(b) the designation of at least one Contracting State;
   (c) information identifying the applicant;
   (d) a description and one or more claims in one of the
      languages referred to in Article 14, paragraphs 1 and 2,
      even though the description and the claims do not
      comply with the other requirements of this Convention.

**Article 79**
Identification of the inventor

The European patent application shall identify the
inventor where the national law of at least one of the
designated Contracting States requires such identification
to be supplied for national patent applications.

* Cf. Rules 17 (Designation of the inventor), 18 (Publication of
   the mention of the inventor) and 19 (Rectification or cancella-
   tion of the designation of an inventor)*

**Article 80**
Unity of invention

The European patent application shall relate to one
invention only or to a group of inventions so linked as to
form a single general inventive concept.

* Cf. Rules 29 (Form and content of claims) and 30 (Claims in
different categories)*

**Article 81**
Disclosure of the invention

A European patent application must disclose the
invention in a manner sufficiently clear and complete for
it to be carried out by a person skilled in the art.

* Cf. Rule 28 (Requirements of applications relating to micro-
   organisms)*

**Article 82**
The claims

The claims shall define the matter for which protection
is sought. They shall be clear and concise and be
supported by the description.

* Cf. Rule 29 (Form and content of claims)*
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
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(1973)
(Munich, 10 septembre - 6 octobre 1973)

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

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

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

1972
as far as that State was concerned. This posed the problem of whether compliance with the provision laid down in Article 67, paragraph 4, necessarily meant that designation of all the Member States of the EEC was deemed to be withdrawn.

The German delegation was aware of this problem, but it thought that it should first be examined within the context of the Second Convention. The delegations of States which were not parties to that Convention would be able to raise the problem at the Diplomatic Conference on the First Convention.

Finally, the Working Party took note of the United Kingdom delegation's observation.

Re. Article 70, No. 1 (Claims in different categories)

37. The Working Party examined a proposal made by the Swiss delegation (BR/GT I/158/72) with a view to increasing the number of possible combinations between independent claims in different categories in view of the requirement for flexibility in this area which had been voiced by the interested circles during the hearing.

The Working Party adopted by majority decision the Swiss delegation's proposal, which entailed the addition to this provision of a new sub-paragraph (c).
33. Furthermore, on the same subject, the Working Party agreed that for a divisional application the applicant could designate all the States designated in the initial application or just some of them; what he could not do was to designate other States. The Working Party made the appropriate addition to Article 137a, paragraph 3.

34. The United Kingdom delegation wanted to know whether it would be fairest to reimburse designation fees already paid in the case provided for in Article 124 where an application for a European patent was converted into an application for a national patent. It proposed that the third sentence of Article 67, paragraph 3, be deleted to this end.

The United Kingdom delegation reserved the right to raise this point at the next meeting of the Conference.

Article 68 (Date of filing)

35. The Working Party aligned the drafting of the French text on the German and English texts.

Article 69a (Naming of the inventor)

36. The United Kingdom delegation drew the Working Party's attention to the problems arising from the rules laid down with regard to naming of the inventor in the light of Article 67, paragraph 4. If, for example, naming of the inventor was required in one of the EEC Member States, the result of absence of naming would be, under the terms of Article 69a, Article 77, paragraph 2(g), and Article 78, paragraph 6, that the naming was deemed to be withdrawn
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
Article 69 (Failure to pay the fees required for the application or to provide a translation)

65. See point below for the reply to the question raised by UNEPA as to whether in certain cases referred to in the Convention, an application should be deemed to have been withdrawn or whether an extension of the time limit should be made for certain operations (cf. point 73 below).

Article 69a (Naming of the inventor)

66. COPRICE expressed the opinion that failure to name the inventor should result only in the designation of any State which required the inventor to be named being deemed to have been withdrawn, rather than in the fiction of the withdrawal of the whole application.

67. See also the observations on Article 17, points 31-33.

Re. Article 70, No. 1, IR (Claims in different categories)

68. CIIF expressed the wish that both this provision and Re. Article 70, No. 2, would not be too narrowly worded, so that some leeway would be left to administrative practice. To this end the words "specially adapted" (process) contained in (a) should be deleted, and a clause added at the end of (b) to the effect that the unity of the invention could not be refuted on the sole ground that products or processes were not defined co-extensively in such claims.

BR/169 e/72 ley/SH/prk
MINUTES

of the

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

Part II

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

(Luxembourg, 26 January to 1 February 1972)
Article 69a - Naming of the inventor

89. The Conference instructed the Drafting Committee to examine whether the desire expressed by one organisation, that the failure to name the inventor should not simply result in the application being deemed to be withdrawn (cf. BR/169/72, point 66), should be reflected in this Article.

Re. Article 70, No. 1 - Claims in different categories

90. The Conference agreed that Re. Article 70, No. 1, of the Implementing Regulations required to be re-examined in relation to the definitive version of Re. Article 66, No. 3.

Article 71 - Disclosure of the invention

91. The Conference instructed Working Party I to examine whether, at the request of one organisation, the problem of the depositing of a micro-biological culture not available to the public could be settled in a manner similar to that recommended for British law by the Banks Report (No. 552).

Article 71a - The claims

92. The Conference decided that Working Party I should examine the questions whether, as most of the organisations proposed, the word "fully" should be deleted and whether it should be replaced by a less restrictive wording.
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)
(4) Sofern eine Gruppe von Vertragsstaaten von der Ermächtigung in Artikel 8 Gebrauch gemacht hat, kann sie vorschreiben, daß ihre Benennung nur gemeinsam erfolgen kann und daß die Benennung eines Teils der Vertragsstaaten der Gruppe als Benennung aller dieser Vertragsstaaten gilt.

Artikel 68
Anmeldetag
Der Anmeldetag einer europäischen Patentanmeldung ist der Tag, an dem die folgende Erfordernisse erfüllt sind:
(a) die Anmeldung muß einen Hinweis enthalten, daß sie eine europäische Patentanmeldung darstellt, und mindestens einen Vertragsstaat gemäß Artikel 67 Absatz 1 benennen;
(b) die Anmeldung muß Angaben enthalten, die es erlauben, die Identität des Anmelders festzustellen;
(c) die Anmeldung muß in einer der in Artikel 34 Absätze 1 und 2 vorgesehenen Sprachen eine Beschreibung und Patentansprüche enthalten, selbst wenn diese nicht den anderen Vorschriften dieses Übereinkommens entsprechen.

Artikel 69
Nichtentrichtung der Anmeldegebühr und fehlende Übersetzung
Die europäische Patentanmeldung gilt als zurückgenommen,
(a) wenn die in Artikel 66 Absatz 3 vorgesehene Gebühr nicht innerhalb der vorgeschriebenen Frist entrichtet wird oder
(b) wenn im Fall des Artikels 34 Absatz 2 die Übersetzung der Patentanmeldung nicht innerhalb der dort genannten Frist vorgelegt worden ist.

Artikel 69 a
Erfindernennung
In der europäischen Patentanmeldung ist der Erfinder zu benennen, wenn das nationale Recht zumindest eines der benannten Vertragsstaaten vorschreibt, daß für eine nationale Anmeldung der Erfinder im Zeitpunkt der nationalen Anmeldung oder zu einem späteren Zeitpunkt zu benennen ist.

Artikel 70
Einheitlichkeit der Erfindung
Die europäische Patentanmeldung darf nur eine einzige Erfindung enthalten oder eine Gruppe von Erfindungen, die untereinander in der Weise verbunden sind, daß sie eine einzige allgemeine erfinderische Idee verwirklichen.

(4) In so far as any group of Contracting States has availed itself of the authorisation given in Article 8, this group may provide that these States may only be designated jointly, and that the designation of one or some only of such States shall be deemed to constitute the designation of all the States of the group.

Artikel 68
Date of filing
The date of filing of a European patent application shall be the date on which it satisfies the following conditions:
(a) an indication is given that the application is for a European patent, and at least one Contracting State is designated in accordance with Article 67, paragraph 1;
(b) information has been given identifying the applicant;
(c) there are, in one of the languages referred to in Article 34, paragraphs 1 and 2, a description and claims, even though they do not comply with the other requirements of this Convention.

Artikel 69
Failure to pay the filing fee or to provide a translation
An application for a European patent shall be deemed to be withdrawn:
(a) if the fee provided for in Article 66, paragraph 3, has not been paid within the prescribed time limit, or
(b) if the translation of the application, in the case provided for in Article 34, paragraph 2, has not been produced within the time limit referred to in that Article.

Artikel 69 a
Naming of the inventor
The application for a European patent shall identify the inventor where the national law of at least one of the designated Contracting States requires such identification to be supplied at the time of filing a national application or at any time thereafter.

Artikel 70
Unity of invention
The application for a European patent shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.
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

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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

APRIL
— 1971 —
5. Filing and requirements of the European patent application (Articles 73-84 and Rules 24-37)

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

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

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

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

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

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

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

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

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

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

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

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

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