Rule 87 E

Travaux Préparatoires (EPC 1973)

Comment:

The collection represents purely an internal research tool for the purpose of Directorate Patent Law of the European Patent Office. No guarantee can be given for its completeness or correctness. The documents produced before 1969 cannot be provided in English as this was not an official language in the period before that date. These documents therefore are provided in French and German.
Regel 87

MPÜ

Unterschiedliche Patentansprüche, Beschreibungen und Zeichnungen für verschiedene Staaten

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designated Contracting States. The valid interests of an assumed infringer in the retroactive revocation of the patent may thus be upheld. In this connection it may be noted that this amendment has raised the opposition proceedings another step towards the level of actual revocation proceedings.

A further procedural amendment was made to Article 104 whereby any person who has been given notice by the proprietor as a result of a claimed patent infringement may also intervene in the opposition proceedings, if he proves that he has instituted proceedings to establish that the act in question did not infringe the patent. This text takes into account the fact that national laws of Contracting States allow such actions for negative declaratory judgments.

9. Appeals procedure (Articles 105-111/Rules 65-68)

Corresponding to the amendment to Article 96 with reference to the possibility of continuing the opposition proceedings despite the lapse of the patent, the Committee decided also to allow an appeal against a decision of the Opposition Division in such cases and to amend Article 105 accordingly. It was consequently made clear in Article 106 that all parties to proceedings of the first instance are also parties to appeal proceedings, even if they do not actively participate in the proceedings, so that for example a decision concerning costs by the Boards of Appeal which differ from the decision of the lower department will be binding for all parties.

The discussions during the earlier stages of the negotiations concerning the length of the time limit for filing an appeal were — as was to be expected — resumed in the Main Committee. An exchange of opinions showed that the division of the time limit for filing an appeal, as provided for in Article 107, into a time limit for filing the appeal and a time limit for filing the grounds for appeal, was generally welcomed. In the interests of the applicants and especially of their representatives who have such a multiplicity of time limits to observe, the Main Committee divided the time limits into one of two months for the notice of appeal, which also applies to the payment of the fee for appeal, and one of four months for filing the grounds for appeal; both time limits are to commence from the time when notification is given of the contested decision. This amendment made it necessary to adjust the one-month time limit for interlocutory revision, which now begins from the receipt of the grounds for appeal (Article 108). If the potential appellant waits until the end of each time limit — which experience leads us to expect — an appeal which is not immediately allowed will not reach the Board of Appeal earlier than five months after the contested decision has been taken! Whether this is compatible with the previously defended principle of streamlining the proceedings, remains to be seen.

In Article 109, paragraph 3, it was specified in respect of the appeals procedure that the deemed withdrawal of a European patent application in the event of failure to reply to an invitation from the Board of Appeal is not valid in proceedings against decisions of the Legal Division. In Article 111 the Committee expressly maintained in the interests of clear legal relationships that the parties to appeal proceedings should also be parties to any proceedings before the Enlarged Board of Appeal. Such a principle could easily be derived from Articles 112/115.

10. General principles governing procedure (Articles 112-126/Rules 69-92)

Some points of the general rules governing procedure were discussed in the Main Committee. In order to avoid improper delays in proceedings an assurance was given in Article 115 that repeated requests for oral proceedings could be refused by the European Patent Office under certain conditions. In Article 116 and in Rule 73 the peculiarities of the national laws of Contracting States were taken into account in respect of the taking of evidence, on the basis of letters rogatory, by authorities in the Contracting States and, in addition to the giving of evidence under oath by a party, witness or expert, provisions were made for other binding forms of evidence which enable the truth to be established. With reference to the communication of the possibility of appeal in accordance with Rule 69, paragraph 2, the principle that parties may invoke errors in the communication was abandoned; errors are however almost entirely excluded because reference must always be made in the communication to the relevant provisions of Articles 105-107, the text of which must be attached.

The rules governing time limits and the arrangements for dealing with unobserved time limits were adopted by the Committee with the following amendments. In Article 120 the time limit concerning the request for further processing of the European patent application was adapted to the new time limit for filing appeals and was therefore quite rightly reduced from three to two months. There was a detailed discussion on the concept of "force majeure" required in accordance with Article 121 for the re-establishment of rights. This condition was generally felt to be too strict because it would justify re-establishment only in the rarest of cases. The Committee also considered conditions such as those of the "unavoidable event" or of the "legitimate excuse" which are based on national laws of Contracting States. After comparing the laws of various States, the Committee finally agreed, in accordance with the conclusions of the Working Party which it had set up, that the justification for the re-establishment of rights was an impediment which, in spite of all due care required by the circumstances having been taken, had led to the non-observance of the time limit. The Committee also endorsed the general opinion that in reality justice is done to this obligation to take all due care only if the applicant or proprietor and his assistants, especially his representatives, have complied with it. In addition, the Committee considered that Article 121 was to be interpreted in a restrictive manner.

The Main Committee extended the maximum duration of time limits to be set by the European Patent Office under Rule 85 from four to six months for certain special circumstances. However, a proposal was not accepted which aimed to make provision for a one-month extension, on request, of any time limit for representatives who in the proceedings had to draw up documents to the European Patent Office in a language other than the official language of their State or residence. The Committee recognised unanimously that during a transitional period such translation difficulties should be deemed to be "certain special circumstances" within the meaning of paragraph 1 of Rule 85, in so far as the parties complied with their obligation to take due care in obtaining translations.

The provision in Article 124 concerning the procedure for drawing up supplementary search reports provided a large amount of material for discussion. This Article was deleted. The Committee considered it unnecessary to impose search costs on the applicant in the event of his making necessary an additional search due to an amendment to the claims. This financial problem could be settled by slightly increasing the standard amount of the main search fee. After lengthy discussions the Committee reached the majority decision that additional fees for additional searches which were drawn up outside the procedure for international search reports under Article 156, could be dispensed with, especially since such an additional cost would have an unfavourable visual effect in the Convention. At the same time the Committee stated expressly
ANNEX I

REPORT

by Mr. Paul Braendli, Lic. iur.
Vice-Director of the Federal Intellectual Property Office (Switzerland)

on the results of Main Committee I's proceedings

ANNEX II

REPORT

by Mr. R. Bowen
Assistant Comptroller, British Patent Office

on the results of Main Committee II's proceedings

ANNEX III

REPORT

by Mr. Fressonnet
Deputy Director of the Institut National de la Propriété Industrielle (France)

on the results of Main Committee III's proceedings

ANNEX IV

REPORT

by Mr. A. Fernandez Mazarambroz
Head of the Spanish Patent Office

on the results of the Credentials Committee's proceedings

with regard to full powers for signing the Convention
paragraph 1 of this Rule provided the necessary flexibility to allow for other difficulties which representatives might encounter during the initial period of operation of the European Patent Office.

**Rule 86 (85) — Extension of time limits**

2395. The Italian delegation wondered whether the text of this Rule in fact achieved the desired aim. In the event of it being impossible for documents to be delivered on the day on which the time limit had expired, the Rule extended the deadline to the first day thereafter on which the European Patent Office was open for receipt of documents. However, it was highly unlikely that in the event of a strike the mail would be delivered immediately on the day the strike ended. The Italian delegation therefore thought that the text should be amended.

2396. The Chairman stated that paragraph 1 did not cover the case of a strike, but the case where a time limit expired on a day on which the European Patent Office was not open for reasons other than a strike. In such a case the time limit was extended automatically to the next day. The problem raised by the Italian delegation only applied with regard to paragraph 2.

2397. The United Kingdom delegation pointed out that paragraph 2 was drafted to cover the case with which the Italian delegation was concerned. This paragraph stipulated that the President of the European Patent Office should determine the end of the period in which there was a general interruption in the delivery of mail and he would therefore be able to take into account the time necessary for normalising the situation after the interruption of work.

2398. The Italian delegation was satisfied with this interpretation.

2399. The Committee agreed to instruct the Drafting Committee to harmonise the German language version with the English and French versions.

**Rule 87 (86) — Amendment of the European patent application**

2400. The German delegation withdrew its proposal as given in M/47, page 16, since it referred to a proposal made by the Belgian delegation concerning Article 64, and this matter had been settled by an amendment to Article 122.

2401. The CEIF delegation suggested that the following sentence should be added to the end of paragraph 3: "except where such amendments will bring restrictions to the scope of the application which are borne out by the description and/or the drawings" (M/22, point 12). The intention of this provision was to permit the applicant to amend the claims and the drawings not just once but more than once.

2402. No Governmental delegation supported this suggestion by the CEIF.

**Rule 88 (87) — Different claims, description and drawings for different States**

2403. The Norwegian delegation wondered what the situation would be should the European Patent Office discover the existence of a prior national right in a given Contracting State. In such a case, would not the European Patent Office be obliged to disregard this national application, and leave the problem to the national legislation concerned?

2404. The Chairman replied to this question in the affirmative. The European Patent Office would take account only of prior European rights and not of prior national rights. During the Luxembourg Conference, it had been clearly stated that the European Patent Office could inform the applicant of the existence of a prior national right in a certain State, but that it could not itself take such a prior national right into account since it was only in the event of subsequent national proceedings that such a prior national right could form the basis for any claim.

**Rule 89 (88) — Correction of errors in documents filed with the European Patent Office**

2405. The Irish delegation owned that this provision corresponded to Rule 91, paragraph 1(b) of the PCT, but wondered whether it was really necessary to stipulate that "anyone" would immediately realise that nothing else would have been intended than what was offered as the correction. In view of the complexity of some chemical formulae, a general rule of this nature seemed extremely harsh.

2406. The Swiss delegation thought that in practical terms this provision was hardly likely to apply. Patent applications were in fact prepared with a man skilled in the art in mind and should be comprehensible to a man skilled in the art. For that reason the Swiss delegation thought that the word "anyone" should be deleted and replaced by a reference to the knowledge of a man skilled in the art.

2407. The Committee agreed to refer this point to the Drafting Committee for more satisfactory wording.

**Rule 94 (93) — Parts of the file not for inspection**

2408. The UNICE delegation wondered whether the name of the inventor should be included in the communicable documents where he had expressed the wish not to be mentioned by name.

2409. The delegation of the Federal Republic of Germany recalled that this problem had already been discussed, and the conclusions reached had been that the mention of the inventor by name could be omitted from the parts of the file for inspection if the inventor expressed such a wish. The President of the European Patent Office should therefore have the power to exclude reference to the inventor by name from the parts of the file for inspection.

2410. The UNICE delegation declared itself satisfied by this reply.

**Rule 95 (94) — Procedures for the inspection of files**

2411. The Finnish delegation observed that Rule 99 provided that no administrative fee was payable where files were communicated to third parties by Courts or Public Prosecutors’ Offices of the Contracting States. It wondered whether it would not be advisable to apply the same principle in Rule 95 by deleting the last sentence of paragraph 1.

2412. The Swedish and Norwegian delegations supported this proposal.

2413. The delegation of the Federal Republic of Germany believed that to do away with the administrative fee would cause a significant increase in the number of requests to inspect files. In view of the unavoidable administrative costs involved in the organisation of this service it seemed only reasonable to charge an administrative fee for it.

2414. The French delegation also opposed this proposal, on the grounds that it did not seem fair that applicants as a body should bear financial costs incurred for the benefit of an individual.

2415. The Committee rejected the Finnish delegation's proposal by eight votes to five, with one abstention.
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MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Munich, 10 September to 5 October, 1973)

published by the
Government of the Federal Republic of Germany
Rule 87

Different claims, description and drawings for different States

If the European Patent Office notes that in respect of one or some of the designated Contracting States, the content of an earlier European patent application forms part of the state of the art pursuant to Article 52(2), paragraphs 3 and 4, the European patent application or European patent may contain for such State or States claims and, if the European Patent Office considers it necessary, a description and drawings which are different from those for the other designated Contracting States.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/ 146/R 11
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Implementing Regulations: Rules 83 to 106
(2) Nach Erhalt des europäischen Recherchenberichts und vor Erhalt des ersten Bescheids der Prüfungsabteilung kann der Anmelder von sich aus die Beschreibung, die Patentansprüche und die Zeichnungen ändern.

(3) Nach Erhalt des ersten Bescheids der Prüfungsabteilung kann der Anmelder von sich aus die Beschreibung, die Patentansprüche und die Zeichnungen einmal ändern, sofern die Änderung gleichzeitig mit der Erwiderung auf den Bescheid eingereicht wird. Weitere Änderungen können nur mit Zustimmung der Prüfungsabteilung vorgenommen werden.

Vgl. Artikel 122 (Änderungen)

(2) After receiving the European search report and before receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend the description, claims and drawings.

(3) After receipt of the first communication from the Examining Division the applicant may, of his own volition, amend once the description, claims and drawings provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the Examining Division.

Cf. Article 122 (Amendments)

Regel 88
Unterschiedliche Ansprüche, Beschreibungen und Zeichnungen für verschiedene Staaten

Stellt das Europäische Patentamt fest, daß für einen oder mehrere der benannten Vertragsstaaten der Inhalt einer früheren europäischen Patentanmeldung nach Artikel 52 Absätze 3 und 4 zum Stand der Technik gehört, so kann die europäische Patentanmeldung oder das europäische Patent für diesen Staat oder diese Staaten unterschiedliche Patentansprüche und, wenn es das Europäische Patentamt für erforderlich hält, unterschiedliche Beschreibungen und Zeichnungen enthalten.

Vgl. Artikel 95 (Prüfung der europäischen Patentanmeldung), 97 (Veröffentlichung des europäischen Patents), 102 (Veröffentlichung einer neuen Patentschrift) und 122 (Änderungen)

Rule 88
Different claims, description and drawings for different States

If the European Patent Office notes that in respect of one or some of the designated Contracting States, the content of an earlier European patent application forms part of the state of the art pursuant to Article 52, paragraphs 3 and 4, the European patent application or European patent may contain for such State or States claims and, if the European Patent Office considers it necessary, a description and drawings which are different from those for the other designated Contracting States.

Vgl. Articles 95 (Examination of the European patent application), 97 (Publication of a European patent), 102 (Publication of a new specification) and 122 (Amendments)

Cf. Articles 95 (Requirements of the European patent application) and 86 (Claiming priority)

Regel 89
Berichtigung von Mängeln in den beim Europäischen Patentamt eingereichten Unterlagen

Sprachliche Fehler, Schreibfehler und Unrichtigkeiten in den beim Europäischen Patentamt eingereichten Unterlagen können auf Antrag berichtigt werden. Betrifft jedoch der Antrag auf Berichtigung die Beschreibung, die Patentansprüche oder die Zeichnungen, so muß die Berichtigung derart offensichtlich sein, daß jedermann sofort erkennen kann, daß nichts anderes beabsichtigt sein konnte als das, was als Berichtigung vorgeschlagen wird.

Vgl. Artikel 76 (Erfordernisse der europäischen Patentanmeldung) und 86 (Inanspruchnahme der Priorität)

Rule 89
Correction of errors in documents filed with the European Patent Office

Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns a description, claims or drawings, the correction must be obvious in the sense that anyone would immediately realise that nothing else would have been intended than what is offered as the correction.

Cf. Articles 76 (Requirements of the European patent application) and 86 (Claiming priority)
ENTWURF EINER AUSFÜHRUNGSORDNUNG
ZUM ÜBEREINKOMMEN
ÜBER EIN EUROPÄISCHES PATENTEILUNGSVERFAHREN

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

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

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

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

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

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

DOCUMENTS PRÉPARATOIRES
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
because the file would be open for public inspection as from publication. Nevertheless, a new provision, Re. Article 60, No. 1, was laid down, authorising the President to take measures for the publication of these claims by means of an entry in the European Patent Bulletin of information relating to them.

**Article 138 (Different claims, description and drawings for different States)**

87. The Working Party, which had been entrusted with examining the advisability of maintaining the second sentence of this provision, found no grounds for its deletion. It was noted, in this respect, that if the European Patent Office requested an amended description or amended drawings in order to take account of the situation referred to in this Article, this would not imply the publication of separate specifications, since a single specification could, if necessary, comprise one or more different descriptions.

**Article 141 (Time limits)**
**Article 142 (Restitutio in integrum)**
**Re. Article 141, No. 2 (Extension of time limits)**

88. The Working Party had been instructed to study the problem of the re-establishment of rights following the expiry of a specified time limit, excluding the cases of application of Article 142, and drawing on the system in force in the Scandinavian countries. It based itself on a note submitted by the Swedish delegation for this purpose (BR/GT I/148/72).

This system was based on the fact that the applicant could be re-established in his rights even if he had not respected a time limit conditioned before the payment of a fee prescribed for this purpose. He enjoyed a time limit
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 13 April 1972
BR/177/72

--- Secretariat ---

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 ovd/AH/prk

.../...
Article 138 (Different claims, description and drawings for different States)

137. The ICC had doubts as to whether it was wise to provide in the second sentence, that the European Patent Office could require an applicant to produce a different description and different drawings for certain designated States in the event of the content of an earlier European patent application forming part of the state of the art for the States in question, pursuant to Article 11, paragraph 3. In its opinion the content of the (later) European application should be considered in its entirety. In such cases it would be preferable if the European Patent Office were to insert before the different sets of claims a note explaining how these sets of claims could be understood in the light of the description and drawings. It therefore recommended that the second sentence be deleted.

138. BRMA proposed that Article 138 be extended to cover the case of a Contracting State taking advantage of the reservation option provided for in Article 159, paragraph 1(a); in this case too the applicant ought to be allowed to file different claims for the State concerned.

Re. Article 141, No. 1, IR (Calculation of time limits)

139. In connection with paragraph 2, second sentence, the question was raised as to when a time limit should begin when determined by a measure taken in respect of a party to the proceedings: it would have to begin either with the dispatch of the document concerned by the European Patent Office or with the receipt of the document by the party to the proceedings.

BR/169 e/72 ley/SL/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 138 (Different claims and description for different States)

149. Regarding the request by one organisation that the second sentence should be deleted, it was pointed out that it would be primarily in the interests of the Contracting States not belonging to the EEC if the applicant could submit a different description or drawings in respect of those Contracting States for which the content of an earlier European application pursuant to Article 11, paragraph 3, formed part of the state of the art.

The Conference referred to Working Party I the question whether the second sentence should be deleted without replacement.

150. The Conference rejected the proposal by one organisation that the applicant should, in the event of a Contracting State having recourse to a reservation pursuant to Article 159, paragraph 1(a), also be able to file different claims in respect of that State. The Conference was of the opinion that in this case it should be left to the Contracting State concerned to decide how it wished to deal with applications worded identically for all States. It was pointed out that those Contracting States which might wish to have recourse to the reservation provided for in Article 159, paragraph 1(a), could in any case still take this question up later in connection with Article 159.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Secretariat

Brussels, 15 March 1972
BR/168/72

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)

BR/168 e/72 eld/KM/gc
Article 138

Different claims and description for different States

If the European Patent Office notes that in respect of one or some of the Contracting States designated in respect of a European patent application or patent, the contents of an earlier European patent application form part of the state of the art under Article 11, paragraphs 3 and 4, the applicant or patentee may submit different claims effective for such State or States. In such a case, where the European Patent Office considers it necessary, a different description or drawings shall be submitted for such State or States at the request of that Office.

Note to Article 138:
- deleted -

3R/139 e/71 prk
SECOND PRELIMINARY DRAFT OF THE CONVENTION

ESTABLISHING

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

Brussels, 6 December 1971
BR/139/71

- Secretariat -

DOCUMENT CORRECTING

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

FIRST PRELIMINARY DRAFT
OF THE IMPLEMENTING REGULATIONS

and

FIRST PRELIMINARY DRAFT
OF THE RULES RELATING TO FEES

- Stage reached on 26 November 1971 -

BR/139 e/71
Aligning itself with a proposal from the German delegation, the Working Party considered it expedient to provide for such a right, not merely with regard to the description but also with regard to drawings. The exercise of such a right should however be subject to a request from the European Patent Office. Without such a limitation the problem of interpreting the application would in many instances be considerably complicated, since, under Article 20, the description and drawings assist in the interpretation of claims.

**Article 142 (Restitutio in integrum)**

20. The Working Party examined the question of extending the field of application of Article 142 to the proprietor of the patent and to the opponent, in conformity with the remark contained in the Second Preliminary Draft.

With regard to the proprietor of the European patent, the Working Party was of the opinion that it was logical and necessary that he be granted, throughout the period within which opposition could be brought or when an opposition procedure was pending, the right to have his rights re-established. Article 142 was supplemented accordingly.

With regard to the opponent, on the other hand, the Working Party was, in the majority, of the opinion that it would not be advisable to grant him such a right, since he had other means of availing himself of his rights, in particular by bringing an action for revocation before the national courts, if prevention through force majeure had as a direct consequence the loss of a right or of the grounds of appeal within the context of opposition proceedings.

BR/144 e/71 ico/jas
After discussion, the Working Party preferred to adopt a solution to the effect that divisional applications could be filed only with the European Patent Office and that no State could therefore make provision for or authorise the filing of such applications with its central industrial property office. Consequently it followed that a divisional application could no longer be filed before the initial application had been received by the European Patent Office.

This decision involved the addition of a new paragraph 3 to Article 64 and the amendment of Article 137a, paragraph 1(a).

Consequent upon this decision, the Working Party was led to provide for a new provision in the Implementing Regulations, Re Article 65, No. 1, introducing an obligation for the European Patent Office to inform the applicant that it had received his application from the national office. Indeed, it was only after having received such a communication that the applicant, if his application had been filed with a national office, might divide his initial application.

Article 138 (Different claims, descriptions and drawings according to the States designated)

19. The Working Party examined the question raised in the note contained in the Second Preliminary Draft Convention on the question of whether it would be expedient to extend to the description the right to submit different claims with respect to one State or to a group of States.

BR/144 e/71 inc/jas
MINUTES
of the 10th meeting of Working Party I,
held in Luxembourg from 22 to 26 November 1971

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

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

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

3. The Working Party I Drafting Committee met first under the chairmanship of Mr. van BENTHEM, President of the Octrooiraad, and, following his departure, under that of Mr. LABRY, Embassy Counsellor at the Ministry of Foreign Affairs (France).
n'a pas comparu malgré une assignation en bonne et due forme. La même sanction peut être infligée à tout témoin qui, sans motif légitime, refuse de déposer ou de prêter serment. Le témoin qui produit des excuses légitimes peut être déchargé d'une amende.]

[(5) Chaque État contractant regarde tout faux serment prêté devant l'Office européen des brevets par des témoins ou des experts comme constituant le délit correspondant commis devant un tribunal national statuant en matière civile. Sur dénonciation du Président de l'Office européen des brevets, il poursuit les auteurs de ce délit devant la juridiction nationale compétente.]

(6) Les intéressés, les témoins et les experts peuvent être entendus par les autorités judiciaires de leur domicile. Les témoins et les experts peuvent être entendus sous la foi du serment par les autorités judiciaires de leur domicile, même lorsque l'audition a été demandée par la section d'examen, la division d'examen ou la division d'opposition.

**Article 137**

Avis documentaire complémentaire sur l'état de la technique

(1) L'Office européen des brevets peut demander à tout moment à l'Institut International des Brevets de La Haye un avis documentaire complémentaire sur l'état de la technique, s'il le juge utile.

(2) Le coût de l'avis documentaire mentionné au paragraphe 1 est à la charge du demandeur,

a) si la demande d'avis est rendue nécessaire du fait du demandeur, en particulier, lorsqu'il a modifié les revendications, ou

b) si l'avis est demandé aux fins de compléter un rapport de recherche internationale au sens de l'article 122.

(3) Dans les cas mentionnés au paragraphe 2, l'Office européen des brevets invite le demandeur à acquitter dans un délai d'un mois la taxe complémentaire prévue par le règlement relatif aux taxes pris en exécution de la présente Convention. Si la taxe n'est pas versée en temps voulu, la demande de brevet européen est réputée retirée.

(4) Les dispositions ci-dessus s'appliquent sans préjudice de l'article 79, paragraphes 5 et 6.

**Article 138**

Revendications différentes selon les États désignés

Si l'Office européen des brevets constate que dans un ou plusieurs des États contractants désignés dans une demande de brevet européen ou un brevet européen, le contenu d'une demande antérieure de brevet européen est compris dans l'état de la technique au titre de l'article 11, paragraphes 3 et 4, le demandeur ou le titulaire du brevet peut présenter des revendications différentes pour cet État ou ces États.

Note to Article 136, paragraphs 4 and 5:
These paragraphs are to be re-examined.

Remarque concernant l'article 136, paragraphes 4 et 5:
Ces paragraphes doivent faire l'objet d'un nouvel examen.

**Bemerkung zu Artikel 137 Absatz 2:**
Absatz 2 Buchstabe b muß noch überprüft werden.

Note to Article 137, paragraph 2:
The provision of paragraph 2(b) is to be re-examined.

Remarque concernant l'article 137, paragraphe 2:
La disposition du paragraphe 2, lettre b), doit faire l'objet d'un nouvel examen.

**Bemerkung zu Artikel 138:**
Es soll noch geprüft werden, ob die in diesem Artikel für die Patentansprüche vorgesehene Möglichkeit auch auf die Beschreibung ausgedehnt werden soll.

Note to Article 138:
It will have to be examined later whether the option provided for in this Article for amendment of the claims should be extended to the description.

Remarque concernant l'article 138:
Il conviendrait d'examiner ultérieurement si la faculté prévue à cet article pour les revendications devrait être étendue à la description.
eine Geldbuße bis zu ... verhängen. Dieselbe Geldbuße kann auch gegen einen Zeugen verhängt werden, der ohne berechtigten Grund die Aussage oder die Eidesleistung verweigert. Die Geldbuße kann aufgehoben werden, wenn der Zeuge berechtigte Entschuldigungsgründe vorbringt.


Artikel 137
Ergänzender Bericht über den Stand der Technik

(1) Das Europäische Patentamt kann beim Internationalen Patentinstitut in Den Haag jederzeit einen ergänzenden Bericht über den Stand der Technik einholen, wenn es dies für erforderlich erachtet.

(2) Die Kosten für den Bericht gemäß Absatz 1 trägt der Anmelder,
a) wenn er die Einholung des Berichts, insbesondere durch Änderung der Patentansprüche, veranlaßt hat oder
b) wenn der Bericht eingeholt wird, um einen internationalen Recherchenbericht gemäß Artikel 122 zu ergänzen.

(3) Im Falle des Absatzes 2 fordert das Europäische Patentamt den Anmelder auf, innerhalb einer Frist von einem Monat die in der Gebührenordnung zu diesem Übereinkommen vorgeschriebene Zusatzgebühr zu entrichten. Wird die Gebühr nicht rechtzeitig entrichtet, so gilt die europäische Patentanmeldung als zurückgenommen.

(4) Artikel 79 Absätze 5 und 6 bleibt unberührt.

Artikel 138
Verschiedene Patentansprüche für verschiedene Staaten

Stellt das Europäische Patentamt fest, daß für einen oder mehrere der für eine europäische Patentanmeldung oder ein europäisches Patent benannten Vertragsstaaten der Inhalt einer früheren europäischen Patentanmeldung nach Artikel 11 Absätze 3 und 4 zum Stand der Technik gehört, so kann der Anmelder oder Patentinhaber verschiedene Patentansprüche für diese Staaten einreichen.

of a summons on him in proper form. A similar penalty may be imposed upon any witness who, without proper reason, refuses to testify or take an oath. The fine may be waived if the witness offers a legitimate excuse.

(5) Each Contracting State shall treat any perjury on the part of witnesses or experts before the European Patent Office as if the offence had been committed before one of its national courts dealing with civil proceedings. On notification by the President of the European Patent Office, it shall take proceedings before the competent national court against such persons.

(6) Interested parties, witnesses and experts may be heard by the judicial authorities of their country of residence. Witnesses and experts may be heard, under oath, by the judicial authorities of their country of residence, even when the hearing has been requested by an Examining Section, Examining Division or Opposition Division.

Artikel 137
Supplementary report on the state of the art

(1) The European Patent Office may at any time obtain a supplementary report on the state of the art from the International Patent Institute at The Hague, where it considers this to be expedient.

(2) The cost of the report referred to in paragraph 1 shall be borne by the applicant:
(a) where the applicant has made it necessary for such report to be obtained, in particular when the applicant has amended the claims; or
(b) where the report is obtained in order to supplement an international search report as provided for in Article 122.

(3) Where paragraph 2 is applicable, the European Patent Office shall request the applicant to pay within one month the additional fee prescribed by the Rules relating to Fees adopted pursuant to this Convention. If the fee is not paid in due time, the European patent application shall be deemed to be withdrawn.

(4) The above provisions shall be without prejudice to the provisions of Article 79, paragraphs 5 and 6.

Article 138
Different claims for different States

If the European Patent Office notes that in respect of one or some of the Contracting States designated in respect of a European patent application or patent, the contents of an earlier European patent application form part of the state of the art under Article 11, paragraphs 3 and 4, the applicant or patentee may submit different claims effective for such State or States.

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

SECOND AVANT-PROJET DE CONVENTION INSTITUANT UN SYSTÈME
EUROPÉEN DE DÉLIVRANCE DE BREVETS
ZWEITER VORENTWURF EINES ÜBEREINKOMMENS ÜBER EIN EUROPÄISCHES PATENTERTeilUNGSVERFAHREN
sowie ERSTER VORENTWURF EINER AUSFÜHRUNGSORDNUNG ZUM ÜBEREINKOMMEN ÜBER EIN EUROPÄISCHES PATENTERTeilUNGSVERFAHREN
und ERSTER VORENTWURF EINER GEBÜHRENORDNUNG

SECOND PRELIMINARY DRAFT OF A CONVENTION
ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS
with FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS TO THE CONVENTION ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS
and FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

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

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that Article 156, paragraph 3, was to be interpreted as an
authorisation for the Administrative Council to provide for the
levy of a search fee for each and every international patent
application, irrespective of whether additional searches within
the meaning of this provision should be carried out in the
individual cases.

11. Information to the public of official authorities,
legal and administrative co-operation (Articles
127-132, Rules 93-100)

Only a few amendments were made to these provisions. The
inspection of files under Article 128 was supplemented so as to
provide more precise information for the general public; thus,
before the publication of the European patent application, not
only the date of filing may be made known to third parties, but
also the date, State and file number of any application of which
the priority is claimed. The provisions of Articles 130/132 were
drafted more generally so that the European Patent Office
could make agreements concerning exchanges of information
and exchanges of publications not only with States which were
not a party to the Convention and with international patent
granting authorities, such as WIPO, but also with any other
organisations, especially documentation centres such as
INPADOC. It was also specified at the same time that the
substantive content of applications which had not yet been
published could not be the subject of such exchanges of
information. In addition, the Administrative Council was
authorised in Article 130, paragraph 3, to make provisions in
respect of exchanges of information with the last-named
organisations which derogated from the restrictions on the
inspection of files, in so far as the confidential treatment of the
information was guaranteed.

While dealing with the provisions of Article 131, the Main
Committee discussed a proposal which, in the light of the
procedure laid down in the Protocol on Recognition, aimed to
supplement the prescribed legal co-operation between the
European Patent Office and the Contracting States by an
obligation for the Contracting States to provide legal
assistance amongst themselves. This interesting idea was
rejected generally because the proposed extension was
considered to be an intrusion into international legal aid
between Contracting States and also an obligation which far
exceeded the purpose of the Convention. A further idea to
allow the European Patent Office to intervene as an
international notification authority in certain proceedings
congering European patents, also found little approval.

12. Representation (Articles 133-134, 162/Rules
101-103, 107)

The provisions of the Convention and the Implementing
Regulations concerning representation before the European
Patent Office were already discussed with the organisations
considered during the earlier stages of the negotiations and
were, as far as possible adapted to their proposals and wishes.
Fortunately this situation meant that the principles established
by the Inter-Governmental Conference were no longer
questioned as to their substance. In particular, the principle that
during a transitional period the representatives' status would
basically be controlled by the national law of Contracting
States and afterwards by European law, remained uncontested.
The general principles concerning representation in Article 133
were also unchanged. The Main Committee generally
considered that these principles should also be valid for the
transitional period. The Committee also specified that legal
persons could be represented not only by their employees — as
laid down in paragraph 3 of Article 133 — but also by their
departments. Such representation by their departments is
regarded as a matter of course, is understood from paragraph 1
of Article 133 and does not need to be expressly laid down.

However, material for discussion was provided by the
following points: the uninterrupted change from the transitional
period to the permanent arrangements, in particular with
reference to the continued effects of national requirements, the
reasons for the deletion of professional representatives from
the list, questions concerning place of business and other
individual problems. The following is a report on the main
questions:

(a) Conditions of admission

The Main Committee again discussed the question raised in
the earlier negotiations concerning possession of the
nationality of a Contracting State as a condition of entry on the
list of professional representatives. The majority concluded
that this condition should be laid down in Article 162 not only in
respect of the permanent solution, but also in respect of the
transitional period, in order to avoid the improper acquisition
of representation rights after the publication of the
Convention. The status quo was taken into account in so far
that failure to have the nationality of a Contracting State would
not prevent entry on the list, if the representative had a place
of business or employment and the right of representation in a
Contracting State on 5 October 1973, i.e. at the time of the
signing of the Convention.

(b) Restrictions on authorisation to represent

The question arose as to whether restrictions on
representation arising from national law should also be valid in
respect of proceedings before the European Patent Office
during the transitional period. The Committee unanimously
considered that such restrictions based on specific rules of
national law, in particular on the legislation of the Federal
Republic of Germany, are not justified in respect of European
proceedings. The corresponding provisions of Article 162,
paragraphs 2 and 6, were therefore deleted.

(c) Questions concerning place of business

Article 134 provided that the representatives entered on the
list were entitled to establish a place of business in the Federal
Republic of Germany and the Netherlands for the purpose of
practising their profession before the European Patent Office.
In view of proceedings before national authorities carrying out
duties on behalf of the European Patent Office, as provided for
in the Protocol on Centralisation, the Main Committee
supplemented Article 134 accordingly. Professional
representatives should consequently also be able to establish a place
of business in the Contracting States concerned. There was also
discussion of a provision which would have expressly granted
the right to practise a profession to a professional
representative, his associates, employees and colleagues and
the right of establishment to these persons including their
families. It was said in reply to the advocates of such a
provision, who considered it to be a necessary adjunct to the
right of residence, that this would be to bring a "foreign body"
into the Convention and might possibly conflict with existing
agreements in the field of public law. The Committee
thereupon rejected the proposed supplement, but noted on the
other hand that the stipulated right to a place of business in
accordance with Article 134, paragraphs 3 and 4, would be
meaningful only if its recognition were dealt with sensibly. A