Article 153 E

Travaux Préparatoires
(EPC 1973)

Comment:
The collection represents purely an internal research tool for the purpose of Directorate Patent Law of the European Patent Office. No guarantee can be given for its completeness or correctness. The documents produced before 1969 cannot be provided in English as this was not an official language in the period before that date. These documents therefore are provided in French and German.
Art. 153
MPÜ
Das Europäische Patentamt als Bestimmungsamt

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

(d) Deletion from the list of professional representatives

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

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

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

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

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

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

With regard to the grounds on which, pursuant to Article 138, a European patent may be revoked, the Main Committee made it clear that extension of the protection conferred can be a ground for revocation, irrespective of whether the extension occurs during opposition proceedings or national proceedings. This clarification takes account of the fact that a change in the claims of a European patent during national revocation proceedings or during national proceedings for partial surrender may result in an inadmissible extension of protection. Moreover, the Committee refused to impose, in paragraph 2 of the same Article, any restrictions on national laws in respect of the form in which limitations of European patent claims can be made in cases of partial revocation. A further proposal, in connection with the rules laid down in Article 139 governing the relationship between European and national patents, to provide that, in cases of collision, the European patent should always take precedence was also unsuccessful. The Committee, by a great majority, rejected this solution which would have been a further step towards adopting a maximum solution, principally in the belief that, in the interests of flexibility, the national laws of the Contracting States should be left to adopt such collision rules as they considered justified.

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

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

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

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

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

ANNEX IV
REPORT
by Mr. A. Fernandez Mazarambroz
Head of the Spanish Patent Office
on the results of the Credentials Committee's proceedings
with regard to full powers for signing the Convention
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MINUTES
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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
888. The Chairman noted the Committee's agreement to the Norwegian delegation's proposal on the grounds that Article 153 referred to the European Patent Office in its capacity as a designated Office and that it was therefore not appropriate for there to be a provision referring to the European Patent Office as an elected office.

Article 153a (154) — The European Patent Office as an International Searching Authority

889. The Committee examined the proposal for a new Article 153a submitted by the French delegation in M/101.

890. The French delegation stated that following the decisions taken by Main Committee II a new Article ought to be included to cover the eventuality of the European Patent Office acting as an International Searching Authority.

891. The Chairman noted that the French delegation's proposal met with support.

892. After congratulating the French delegation on this proposal, the WIPO delegation made two comments. Firstly, it wondered whether this provision should not be made clearer so that it would also apply in an eventuality which did not appear to be covered in paragraph 2 of this new Article. Paragraph 1 covered the eventuality of the European Patent Office acting as a PCT searching authority on behalf of nationals and residents of Contracting States to the Convention and paragraph 2 enabled the European Patent Office also to act as a searching authority for applicants who were nationals or residents of States other than PCT Contracting States. However there was an intermediate group, namely those States (and their nationals and residents) which were not Contracting States to the European Convention, although they were Contracting States to the PCT. It should be possible to cover this case as well by a suitable provision. The WIPO delegation's second remark was on the wording of paragraph 2 of this Article, which made reference to the Office being appointed as a competent International Searching Authority by the Assembly of the International Patent Co-operation Union. In the sort of case referred to in Rule 19.1 of the PCT, it seemed more appropriate to speak of a receiving Office.

893. The French delegation was in favour of the first suggestion put forward by the WIPO delegation.

894. The Committee agreed to the French delegation's proposal as amended in the manner suggested by the WIPO delegation. This Article was referred to the Drafting Committee.

Article 155 (156) — The European Patent Office as an elected Office

895. The Committee examined the Norwegian delegation's proposal (see M/71, page 3) for the addition of a new paragraph 2 to this Article.

896. The Norwegian delegation said that its proposal was the logical corollary to the proposal adopted by the Committee with regard to Article 153, paragraph 2. The final sentence in this new paragraph was designed to meet the eventuality of an "elected" State making use of the option of making a reservation, as provided for in Article 64, paragraph 2, of the PCT.

897. The Chairman proposed that the Committee approach these two problems separately. The first problem was the inclusion in Article 155 of a provision corresponding to Article 153, paragraph 2, laying down that the application must be filed in one of the official languages of the European Patent Office and that the national fee specified in Article 39, paragraph 1, of the PCT must be paid. The second problem was where one of the elected States had availed itself of the reservation provided for in Article 64, paragraph 2, of the PCT.

898. The WIPO delegation said that, with regard to Chapter II of the PCT, the effect of the Norwegian proposal would be to do away with the uniformity of treatment between European patent applications based on a PCT application. Under the new wording proposed by the Norwegian delegation, the European States would be given the opportunity to decide, each on their own account, whether or not to avail themselves of the reservation provided for in Article 64, paragraph 2. If a State availed itself of this option, the practical consequence would be that even under Chapter II the applicant would have to produce the translations after twenty months and not after twenty-five months as laid down in Chapter II. Thus, if a European State so decided, the European Patent Office would receive the translations after twenty months and would examine the application at that time; this would mean that a decision by one State would automatically apply to all the other States. The WIPO delegation pointed out that although compatible with the PCT, this measure represented an important decision on which the Committee ought to conduct a searching examination.

899. The Norwegian delegation pointed out that the problem had a much broader scope, since the present text of the Convention did not prevent a Contracting State from making use of the right to enter reservations as provided for in Article 64, paragraph 2. Furthermore, a State could also avail itself of the option to make a reservation under Article 64, paragraph 1, and declare that it was not bound by the provisions of Chapter II of the PCT. As for the more specific problem mentioned by the WIPO delegation, the Norwegian delegation thought it was correct that if a PCT international application designated the European Patent Office and a European State which had only accepted Chapter I of the PCT the translation of the international application would have to be submitted within twenty months, in order to obtain a European patent for that State. However, if the applicant submitted the translation of his application four months afterwards, he could nevertheless obtain a European patent in respect of the other States which had accepted both Chapter I and Chapter II of the PCT.

900. The delegation of the Federal Republic of Germany considered that this problem was rather theoretical and wished the existing wording to be maintained. Bearing in mind the fact that Chapter II was designed to facilitate the working of the offices in the elected States, by making provision for a preliminary international examination, it was hardly likely that the European Patent Office or a number of European States would forgo the advantages conferred upon them by Chapter II. The German delegation was of the opinion that even if a State availed itself of the reservation under Article 64, paragraph 2, this would not have any effect either upon the other States or the European Patent Office since a reservation under Article 64, paragraph 2, merely implied that the national office was not obliged to wait before proceeding with the examination of the international application; it did not mean that the national office of an elected State was obliged to start examination straight away.

901. The United Kingdom delegation shared the point of view of the delegation of the Federal Republic of Germany. The new paragraph proposed by the Norwegian delegation was not acceptable, in that it was not advisable to lay down a provision the effect of which would be that translations of an international application would be sent at two different times. If, in order to take account of the fact that certain States had acceded to Chapter II of the PCT, examination of international applications had to be postponed until expiry of the twenty-five month period, examination should also be deferred in the case...
Situations might arise where the renewal fees for the European patent were payable by the proprietor very soon after the date of the mention of the grant of the patent. This would give rise to difficulties for the proprietor. The Member States of the European Communities therefore proposed a solution which would in any event allow a minimum of two months for payment as from the date of the mention of the grant of the patent.

869. The Committee agreed to this proposal.

**Article 142 — Unitary patents**

870. The Committee referred the comment by the Swiss delegation concerning the **title** of this Article to the Drafting Committee for examination (see M/54, page 22).

871. The Netherlands delegation wondered whether Article 35 of the Community Patent Convention pursuant to which the applicant was required to file at the European Patent Office a translation of the claims in one of the official languages of each of the Contracting States to that Convention which did not have English, French or German as an official language was covered by Article 63 of the European Patent Convention, which provided that any Contracting State may prescribe that the applicant for or proprietor of the patent must supply a translation of the text in which the European Patent Office intends to grant a European patent. If Article 63 were considered as not authorising the Member States of the European Communities to lay down a requirement such as that contained in Article 35 of the Community Patent Convention, an appropriate provision would have to be inserted, if necessary, in Article 142 of the European Patent Convention. This delegation also wondered if the words "supply to its central industrial property office" could be interpreted under the Community Patent Convention as covering the "central department" set up by the Contracting States by a special agreement.

872. The Committee considered that Article 63 of the Convention did in fact authorise the Contracting States of the Community Patent Convention to stipulate the requirement laid down in Article 35 thereof and also gave an affirmative reply to the question of interpretation raised.

873. The Netherlands delegation finally wondered whether Article 63 covered Article 35, paragraph 4, of the Community Patent Convention, which provided that translations of the claims were to be published by the European Patent Office.

874. The United Kingdom delegation considered that this provision was covered by Article 143, paragraph 1, which stated that the group of Contracting States could give additional tasks to the European Patent Office.

875. The Committee agreed with the United Kingdom delegation's opinion.

**Article 143 — Special departments of the European Patent Office**

876. The delegation of the Federal Republic of Germany explained to the Committee the proposal submitted by the Member States of the European Communities for an addition to be made to paragraph 2 of this Article (see M/14, point 11). This proposal was intended to ensure that, for the running of the special departments set up under a special agreement, the President of the European Patent Office had all the powers provided under Article 10 for the general conduct of the Office's operations.

877. The Committee agreed to this proposal.

**Article 144 — Professional representation before special departments**

878. The Chairman noted that a proposal had been put forward as regards this Article by the delegation of the Federal Republic of Germany (see M/47, point 19), and another by the United Kingdom delegation (M/64, page 3). If the German proposal were adopted it would not be necessary to examine the United Kingdom proposal, the substance of which was contained in the German proposal.

879. The delegation of the Federal Republic of Germany suggested that this Article be simplified in order to make it as flexible and comprehensive as possible. It therefore proposed that the provision in question be confined to stating that the group of Contracting States could lay down special arrangements to govern representation of parties before the special departments without any limitations being applied.

880. The Netherlands delegation supported this proposal.

881. The United Kingdom delegation was prepared to support the German proposal and withdraw its own. It wondered whether the **title** of the Article should not be amended by deleting the word "professional" in order to broaden its scope and render it applicable also to representation by employees.

882. The Committee agreed to the German proposal and the amendment suggested by the United Kingdom delegation.

**Article 149 — Joint designation**

883. The Committee referred the proposals of the Netherlands delegation (see M/52, page 14) and of the delegation of the Federal Republic of Germany (see M/47, point 44) to the Drafting Committee for examination.

**Article 150 — Application of the Patent Co-operation Treaty**

884. The Committee referred the proposal by the Luxembourg delegation (see M/9, point 28) to the Drafting Committee for examination.

**Article 153 — The European Patent Office as a designated Office**

885. The Committee examined the Norwegian delegation's proposal (see M/71, page 3) concerning paragraph 2 of the Article, to the effect that the reference to Article 39, paragraph 1, of the Co-operation Treaty, should be deleted.

886. The Chairman said that if the Committee subscribed to the Norwegian delegation's opinion that Article 153 should refer only to Chapter I of the PCT, whereas the fee referred to in Article 39 related to Chapter II, it would have to be considered whether another provision, the content corresponding to that of Article 153, paragraph 2, with a reference to Article 39 of the PCT, should not be included, possibly in Article 155. Failing such a provision the Convention would contain no stipulation regarding the national fee for the procedure under Chapter II of the PCT.

887. The WIPO delegation considered that this problem could be resolved in one of two ways: either by adopting the Norwegian delegation's proposal and adding a provision to Article 155, as mentioned by the Chairman, or else keeping Article 153, paragraph 2, as it stood — which would have the advantage of making superfluous one part of the Norwegian delegation's proposal on Article 155, paragraph 2, first sentence, i.e. the addition of a sentence regarding the periods of time laid down in Article 39 of the PCT.
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MINUTES
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FOR THE SETTING
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(Munich, 10 September to 5 October, 1973)

published by the
Government of the Federal Republic of Germany
Article 145
Only concerns German text

Article 153
(2) ..., the Examining Divisions shall be competent to take decisions ...

Article 164
(1) The Implementing Regulations, the Protocol on Recognition, the Protocol on Privileges and Immunities, the Protocol on Centralisation and the Protocol on the Interpretation of Article 69 shall be integral parts of this Convention.

Article 166
Only concerns German text

Article 167
(2) ...

(a) ..., this reservation shall not affect protection conferred by the patent in so far as it involves a process of manufacture or use of a chemical product or a process of manufacture of a pharmaceutical or food product;

Article 175
Only concerns German text

Article 176
Only concerns German text
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 4 October 1973
M/160/K
Original: English/French/German

CONFERECE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Amendments to the texts of document, M/146/R.1 to 15
Article 153

The European Patent Office as a designated Office

(1) The European Patent Office shall act as a designated Office within the meaning of Article 2(xiii) of the Cooperation Treaty for those Contracting States to this Convention in respect of which the Cooperation Treaty has entered into force and which are designated in the international application if the applicant informs the receiving Office in the international application that he wishes to obtain a European patent for these States. The same shall apply if, in the international application, the applicant designates a Contracting State of which the national law provides that designation of that State shall have the effect of the application being for a European patent.

(3) When the European Patent Office acts as a designated Office, the Examining Division shall be competent to take decisions which are required under Article 25, paragraph 2(a), of the Cooperation Treaty.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

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

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Convention: Articles 140 to 166
Article 153

The European Patent Office as a designated Office

(1) The European Patent Office shall act as a designated Office within the meaning of Article 2(xiii) of the Cooperation Treaty for those Contracting States to this Convention in respect of which the Cooperation Treaty has entered into force and which are designated in the international application if the applicant informs the receiving Office in the international application that he wishes to obtain a European patent for these States. The same shall apply if, in the international application, the applicant designates a Contracting State of which the national law provides that designation of that State shall have the effect of the application being for a European patent.

(2) Deleted.

(3) When the European Patent Office acts as a designated Office, the Examining Division shall be competent to take decisions which are required under Article 25, paragraph 2(a), of the Cooperation Treaty.
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

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Article 153
The European Patent Office
as a designated Office

(1) Only concerns German text.

(2) Deleted.

(3) Unchanged from 1972 published text.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 20 September 1973

M/113/L/R 6

Original: English/French/German

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

Articles of the Convention:

Articles 52
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Article 153
The European Patent Office
as a designated Office

(1) Only concerns German text.
(2) Unchanged from 1972 published text.
(3) Unchanged from 1972 published text.

* The Drafting Committee will review this paragraph.
MUNICH DIPLOMATIC CONFERENCE

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

- 1973 -

Munich, 18 September 1973

M/98/I/R 4

Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
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PROPOSALS ON ARTICLES 153 AND 155

Article 153, paragraph 2, should read:

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

Article 155 should read:

(1) (Article 155 of the draft)

(2) If the applicant has not previously supplied the application in one of the official languages of the European Patent Office, and paid the national fee according to Article 153, paragraph 2, he shall do so as provided in Article 39, paragraph 1, of the Co-Operation Treaty. However, in respect of elected States having made use of the reservation under Article 64, paragraph 2, of the Co-Operation Treaty, the furnishing of the application in one of the official languages of the European Patent Office shall take place as provided for in Article 22, paragraph 1, of the Co-Operation Treaty.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 12 September 1973

M/71/1

Original: English

CONFERENCE DOCUMENT

Drawn up by: Norwegian delegation

Subject: Proposals for amendments to Articles 124, 130, 153, 155 and 157 of the Convention and Rules 56, 67, 69 and 97 of the Implementing Regulations
43. Article 134

Text for the proposal by the Government of the Federal Republic of Germany in M/11, No. 6:

"(7) .... of an institute constituted by the persons entitled to act as professional representatives on the basis of the European qualifying examination or, pursuant to Article 152, paragraph 7, without having taken that examination and any ...."

"(8 new) If a person whose name appears on the list of professional representatives, and who has established a place of business in the Federal Republic of Germany or the Netherlands pursuant to paragraph 4, repeatedly or seriously infringes ...."

44. Article 149

If the Netherlands proposal in M/32, No. 22, is adopted:

"(2) .... shall apply if the applicant has indicated in the international application that he wishes to obtain a European patent for one or more of the designated States of the group. The same shall apply if the applicant designates in the international application one of the Contracting States in the group, whose national law provides that the designation of that State shall have the effect of the application being for a European patent."

45. Article 153 (only concerns German text)
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 10 September 1973
M/47/I/II/III
Original: German

CONFERENCE DOCUMENT

Drawn up by: The delegation of the Federal Republic of Germany

Subject: Proposals for amendments to the draft texts
Europäische Patentamt eine Anmeldung als zurückgenommen ansehen können, wenn der Anmelder einer Aufforderung nicht nachkommt.


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

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

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

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

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

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

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

COMMENTS
BY THE NORWEGIAN GOVERNMENT

PRISE DE POSITION
DU GOUVERNEMENT NORVÉGIEN
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN
PATENTERTeilungsVERFAHRENS 1973
(München, 10. September bis 6. Oktober 1973)

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

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

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

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

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

------------------------

1973

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

*Artikel 154*

Das Europäische Patentamt als mit der internationalen vorläufigen Prüfung beauftragte Behörde


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

*Artikel 155*

Das Europäische Patentamt als ausgewähltes Amt

Das Europäische Patentamt wird als ausgewähltes Amt im Sinn des Artikels 2 Ziffer xiv des Zusammenarbeitsvertrags tätig, wenn der Anmelder einen der benannten Staaten, auf die sich Artikel 153 Absatz 1 oder Artikel 149 Absatz 2 bezieht, ausgewählt hat und für diesen

*Artikel 154*

The European Patent Office as an International Preliminary Examining Authority

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

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

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

*Artikel 155*

The European Patent Office as an elected Office

The European Patent Office shall act as an elected Office within the meaning of Article 2(xiv) of the Co-operation Treaty if the applicant has elected any of the designated States referred to in Article 153, paragraph 1, or Article 149, paragraph 2, for which Chapter II of that Treaty has become binding. Subject to the prior
(3) Subject to the prior approval of the Administrative Council, the European Patent Office may also act as a receiving Office if the applicant is a resident or national of a State party to the Paris Convention for the Protection of Industrial Property in respect of which the Assembly of the International Patent Co-operation Union has appointed the European Patent Office as a competent receiving Office, in accordance with an agreement concluded between the Organisation and the International Bureau of the World Intellectual Property Organization.


Artikel 152
Einreichung und Weiterleitung der internationalen Anmeldung

(1) Wählt der Anmelder das Europäische Patentamt als Anmeldeamt für seine internationale Anmeldung, so hat er diese unmittelbar beim Europäischen Patentamt einzureichen. Artikel 73 Absatz 2 ist jedoch anzuwenden.

(2) Die Vertragsstaaten ergreifen im Fall der Einreichung einer internationalen Anmeldung beim Europäischen Patentamt durch Vermittlung der zuständigen Zentralbehörde für den gewerblichen Rechtsschutz alle geeigneten Maßnahmen, um sicherzustellen, daß die Anmeldungen so rechtzeitig an das Europäische Patentamt weitergeleitet werden, daß dieser den Übermittlungspflichten nach dem Zusammenarbeitsvertrag rechtzeitig genügen kann.

(3) Für die internationale Anmeldung ist die Übermittlunggebühr zu zahlen, die gleichzeitig mit der Anmeldung zu entrichten.

Vgl. Regel 105 (Weiterleitung der internationalen Anmeldung an das Europäische Patentamt)

Cf. Rule 105 (Transmittal of the international application to the European Patent Office)

Artikel 153
Das Europäische Patentamt als Bestimmungsamt


(1) The European Patent Office shall act as a designated Office within the meaning of Article 2(xiii) of the Co-operation Treaty for those Contracting States to this Convention in respect of which the Co-operation Treaty has entered into force and which are designated in the international application if the applicant informs the receiving Office in the international application that he wishes to obtain a European patent for these States. The same shall apply if, in the international application, the applicant designates a Contracting State of which the national law provides that designation of that State shall have the effect of the application being for a European patent.

Article 153
The European Patent Office as a designated Office
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
PATENTTEILUNGSVERFAHRENS 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
would be difficult in its opinion, to accept the possibility of the Co-operation Treaty being applicable vis-à-vis all the Contracting States parties to the Second Convention, if not all of these States had ratified that Treaty. Failing ratification of the Co-operation Treaty by all these States, the nationals of third countries which were contracting parties to the PCT would, within a Contracting State party to the Second Convention but which had not ratified the PCT, enjoy advantages which the nationals of the latter State would not enjoy in the said third countries.

On the other hand, it was pointed out that the Contracting States to the Second Convention had the faculty of providing that a Community patent could be granted on the basis of an international application, even if not all these States had ratified the PCT.

In this connection, it was also observed that the Second Convention provided in Article 96 that certain rules of an international convention (Continental shelf) were binding for all the Contracting States without all of them having to ratify that convention.

(c) Articles on which the delegations had made observations

Article 2, paragraph 2, and Article 3

14. Two delegations pointed out that these two provisions would be better placed in Part II, Chapter III, relating to the effects of the European patent."
paragraph 3, should he fail to reply to an invitation from the European Patent Office during opposition proceedings.

It was pointed out that indeed the legal position of an applicant for a patent differed from that of a proprietor of a patent and that the sanction consisting of revocation of the patent which was provided for in paragraph 3 was not justified, since the Opposition Division, for reasons of public interest, had to continue the opposition proceedings on the basis of the documentary evidence in the file submitted to it.

Following the deletion of Article 100, paragraph 3, the reference to this provision appearing in Article 109 was also deleted.

**Article 151**

12. The Committee decided by a majority to adopt the Drafting Committee's suggestion that, in paragraph 1, it should be stipulated that the European Patent Office should act as a designated Office for those Contracting States parties to the Convention for which the Co-operation Treaty had come into force. Since a similar stipulation appears in Article 153, in the absence of such a stipulation in Article 151 one might conclude by a contrario argument that the European Patent Office could act as a designated Office, even vis-à-vis the Contracting States parties to the Convention for which the Co-operation Treaty had not come into force.

13. During this discussion, one delegation observed that a problem would arise in the Second Convention, since it
MINUTES

of the

second meeting of the Co-ordinating Committee

held in Brussels from 15 to 19 May 1972

1. The second meeting of the Co-ordinating Committee was held in Brussels from 15 to 19 May 1972 with Dr HAERTEL, President of the German Patent Office, in the Chair.

Representatives of the Commission of the European Communities, of the IIB and of WIPO took part as observers. The representatives of the Council of Europe sent their apologies for being unable to attend. The list of those taking part in the meeting is given in Annex I to this report.

2. The Co-ordinating Committee - hereinafter referred to as the Committee - adopted the provisional agenda as contained in BR/174/72, supplemented as follows:

BR/209 e/72 it:e/it/prk
Article 151 (121)

The European Patent Office as a designated Office

(1) The European Patent Office shall act as a designated Office within the meaning of Article 2(xiii) of the Co-operation Treaty for those Contracting States to this Convention in respect of which the Co-operation Treaty has entered into force and which are designated in the international application if the applicant informs the receiving Office in the international application that he wishes to obtain a European patent for these States. The same shall apply if, in the international application, the applicant designates a Contracting State of which the national law provides that designation of that State shall have the effect of the application being for a European patent.

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

(3) When the European Patent Office acts as a designated Office, the Examining Division shall be competent to take decisions which are required under Article 25, paragraph 2(a), of the Co-operation Treaty.

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

- Secretariat -

Brussels, 24 April 1972
BR/184/72

DRAFT CONVENTION
ESTABLISHING A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Text drawn up by the
Conference Drafting Committee
8 to 24 March and 10 to 20 April 1972)

BR/184 e/72
36. The Working Party finally discussed the question of which department of the European Patent Office in its capacity of designated Office is to be responsible for the decision under Article 25, paragraph 2(a) of the PCT; this provision states that a designated Office is to decide whether a refusal, declaration or finding was justified under the provisions of the PCT.

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

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

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

(a) the European Patent Office is to act as an International Preliminary Examining Authority for applicants who are residents or nationals of a Contracting State bound by Chapter II of the PCT, subject to the conclusion of an agreement between the Administrative Council and the International Bureau of the WIPO/OMPI (Paragraph 1; the content corresponds to the deleted Article 118, paragraph 2);
33. In connection with the provision referred to under point 32, the Working Party adopted a special provision in the new second sentence of paragraph 2, to cover the eventuality of a group of Contracting States having made use of the authorisation under Article 8 of the Convention and the international application designating one of the States in the group, whose law provides that the designation of that State always has the effect of an application for a European patent: in this case the group of States may prescribe that designation of this State is to be taken as designation of all the Contracting States of the Group.

34. The German delegation proposed that at the time of filing a PCT-application the designation fee under Article 67, paragraph 2, should not be levied for the first designated State, but only for the second and any subsequent designated States, so that the international applicant would not have to pay a further fee for the first designation in addition to the designation fee payable under the PCT. The Working Party rejected this solution as being too complicated and decided in favour of levying a designation fee for each designated State, provided both fees were relatively low. Paragraph 4 of Article 121 was accordingly deleted.

35. The Working Party was also unable to agree to a further proposal by the German delegation to reduce the filing fee (Article 66, paragraph 3) for a PCT-application, on the grounds that the European Patent Office would benefit from a certain saving in the volume of work as a result of the examination under the PCT procedure.

BR/94 e/71 aut/KM/prk
Article 120 - Filing and transmittal of the international application

29. The Working Party agreed to stipulate in a new paragraph 3 that the transmittal fee referred to in Rule 14.1 of the Regulations under the PCT should be payable for PCT-applications. This fee would be payable on filing the application; the amount will be prescribed in the Rules relating to Fees.

Article 121 - The European Patent Office as a designated or elected Office

30. The Working Party confined this Article to defining the function of the European Patent Office as a designated Office. The European Patent Office as an elected Office is dealt with in the new Article 121b.

31. In paragraph 1 the Working Party decided to undertake, apart from a textual correction, an alignment on Article 4, paragraph 1(ii) of the PCT, according to which the applicant now had to notify on the international application itself that he required a European patent for the Contracting States designated, instead of being given a period of 12 months as from the date of priority.

32. Furthermore, the Working Party laid down in paragraph 1 the legal consequence in the event of a Contracting State specifying pursuant to the last provision contained in Article 4, paragraph 1(ii), of the PCT, that its being designated had the effect of an application for a European patent; the European Patent Office would also be a designated Office in this instance.

BR/94 e/71 aut/KM/prk ...

.../...
MINUTES

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

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

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

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

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

(1) For the provisional agenda (BR/GT I/101/71), see Annex I.
(2) For the list of those attending the meeting of the Working Party, see Annex II.
Article 120 (former Article 113d)
Filing and transmittal of the international application

(1) If the applicant chooses the European Patent Office as a receiving Office for his international application, he shall file it directly with the European Patent Office. Article 64, paragraph 2, shall nevertheless apply mutatis mutandis.

(2) In the event of an international application being filed with the European Patent Office through the intermediary of the competent national central industrial property office, the Contracting State concerned shall take all necessary measures to ensure that the application is transmitted to the European Patent Office in time for the latter to be able to comply in due time with the conditions for transmittal under the Co-operation Treaty.

BR/70 e/70 fm.
FIRST PRELIMINARY DRAFT
OF A CONVENTION ESTABLISHING
A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Articles drafted by Working Parties I, II, III and IV)
had to be obvious to a person skilled in the art, did not, however, need to be defined any more precisely, since it was self-evident from the references to Article 11, paragraph 2 in Articles 13 and 74 that it was the filing date on the date of priority as the case may be.

**Article 14 - Industrial application**

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

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

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

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

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

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

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

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

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

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(1) For the provisional agenda (BR/GT I/101/71), see Annex I.
(2) For the list of those attending the meeting of the Working Party, see Annex II.
Article 118 (former Article 113b)
Functions of the European Patent Office in the context of the Patent Co-operation Treaty

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

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

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

BR/70 e/70 gc
FIRST PRELIMINARY DRAFT
OF A CONVENTION ESTABLISHING
A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Articles drafted by Working Parties I, II, III and IV)
which accepted Chapter II would also accept that their patent offices should act as an International Preliminary Examining Authority.

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

(a) As regards the first question, the Conference recognized the need for the Article since it provides an essential link between the Convention and the PCT. Some delegations pointed out that it might be useful, before adopting any final wording in the Preliminary Draft Convention, to discover the views third countries might take as regards the international search. Other delegations, however, felt that the European States might be in a better position if Article 113f clearly stated their intention to place all international searches on an equal footing, in order to avoid giving third countries the impression that the search carried out by the IIB would have a privileged status among the Contracting States to the Convention.
On the subject of Article 113b, the French delegation observed that, pursuant to paragraph 2, the European Patent Office would act as an International Preliminary Examining Authority. In view of the intentions expressed by a number of patent offices from States which were to take part in the European system for the grant of patents, these offices would also be International Preliminary Examining Authorities under the PCT. Such a situation was no doubt perfectly compatible with the PCT draft, but it would nonetheless mean that several routes would be open for applicants to obtain an international preliminary examination. This might present certain disadvantages. The French delegation thought it would be desirable to achieve a certain concentration of the search capacity of the various States taking part in the European Patent Office.

The Conference observed that no answer could be given to this question at the present stage, since it was not yet known which States would accept Chapter I and which would accept both Chapter I and Chapter II of the PCT draft and, furthermore, it was not known whether those States
INTER-GOVERNMENTAL CONFERENCE FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

Brussels, 30 January 1970
BR/26/70

- Secretariat -

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

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

OPENING OF THE MEETING

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

Item 2 on the agenda

ADOPTION OF THE PROVISIONAL AGENDA

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

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

BR/26 e/70 kel/PA/mk

.../...
Article 173b

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

Working Party text

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

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

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

BR/11 e/69 mk
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

Brussels, 5 December 1969
BR/11/69

- Secretariat -

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

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

compared synoptically with

- the 1962 and 1965 versions of the Draft Convention as established by the EEC "Patents" Working Party and

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

BR/11 e/69 mk
designated and the applicant has not expressly asked for national patents. However, the Working Party did not think it advisable to follow this suggestion. Consequently it chose for paragraph 1 a wording according to which the European Patent Office is not automatically regarded as the designated Office when the applicant fails to make the appropriate statement within the prescribed period.

67. During the discussion of paragraph 2 it was asked whether it was consistent with the PCT in its present form that the designation of one EEC State should be taken as the designation of all the EEC States. The Working Party determined that a provision of this type was necessary for the purposes of the special agreement prepared by the EEC States (the "second Convention"), and that such a provision did not in fact conflict with the PCT if the applicant was allowed the possibility of changing the European application into a national application for the EEC States which he had designated.

68. In paragraph 3 the Working Party has dealt with the case in which Chapter II of the PCT has already entered into force for some of the designated States, while for other designated States only Chapter I of the PCT is in force. Since the European application forms a whole and can therefore only be treated by a unitary procedure, it had to be laid down that in this case the European Patent Office must act as the designated Office for all the designated States.
with Article 113e, paragraph 1:

- At what time must the applicant state whether he wants a European patent or national patents? (see point 65).
- Which provisions are to apply in the event of the applicant failing to state this? (see point 66).

65. As regards the time limit for stating that the application is for a European patent, the Working Party considered that it was desirable to prescribe the latest possible time. The time of publication of the international application seemed to be obviously too late, since it had to be clear from the international publication whether the European Patent Office has been chosen as the designated Office. It was not possible to adopt the suggestion that the time of transmittal of the international search report should be chosen since this time is not clearly defined. The Working Party finally came to the conclusion that a period of twelve months from the priority date is the safest, and agreed unanimously upon this time limit.

66. As to how the application is to be dealt with when the applicant does not make the required statement within the specified period, it was suggested that the European Patent Office should always be regarded as the designated Office when Contracting States to the European Convention are

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too. In this way advance provision would also be made for the eventualty of the national patent offices of certain Contracting States being wound up in the course of time. The European Patent Office could then take over the function of receiving Office in place of the national office. For these reasons, the Working Party in no way restricted the possibility of the European Patent Office being chosen as a receiving Office.

63. The Working Party finally discussed whether, on filing an international application for which the European Patent Office could be the receiving Office, the applicant must file the application directly with the European Patent Office, or whether he can forward it to the European Office via a national office. The Working Party decided in favour of providing only for direct filing with the European Patent Office (2nd variant of paragraph 1), in order to enable the short time limit for the transmittal of the documents to the International Bureau to be met. It was in any case agreed that it must be open to every Contracting State to prescribe that international applications intended for filing with the European Patent Office must be introduced via its own national office. It is for this reason that the last sentence of paragraph 1 refers to Article 66, paragraph 2. In this case too, the European Patent Office would be responsible for examining whether the formalities of the PCT have been met.

Article 113e - The European Patent Office as a designated or elected Office

64. The following questions were discussed in connection
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 18 December 1969
BR/12/69

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

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I.

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

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

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

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

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

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

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.../...
(1) The European Patent Office shall act as a designated Office within the meaning of Article 2(ii) of the Co-operation Treaty for those Contracting States to this Convention which are designated in the international application if the applicant informs the receiving Office or, where appropriate, the International Bureau provided for in that Treaty, within twelve months of the priority date, that he wishes to obtain a European patent for those States.

(2) In so far as any group of Contracting States has made use of the authorisation under Article 68a, such group may prescribe that it may only be designated as a whole and that the designation of some only of the States in the group shall be taken as the designation of all of these States, if the applicant has indicated that he wishes to obtain a European patent for the designated State or States of the group.

(3) The European Patent Office shall act as an elected Office within the meaning of Article 2(iii) of the Co-operation Treaty if the applicant has elected any of the designated States referred to in paragraph 1 or 2 for which Chapter II of that Treaty has entered into force.

(4) The fee provided for in Article 68a, paragraph 2, shall not be payable for international applications.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

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- Secretariat -

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

Articles 88 to 152

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

compared synoptically with

- the 1962 and 1965 versions of the Draft Convention as established by the EEC "Patents" Working Party and

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

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

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

60. No comment.

Article 113d - Filing and transmittal of the international application

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

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

INTERNATIONAL APPLICATION PURSUANT TO THE PATENT CO-OPERATION TREATY

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

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

58. No comment.

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

59. The Working Party agreed that paragraph 3 simply sets out the conditions under which the European Patent Office
MINUTES
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(2) It was originally agreed at the October meeting that the German delegation should produce a report for Articles 88 to 104.
Article 113b

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

Working Party text

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

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

(3) Subject to the provisions set out below, the European Patent Office shall act as an elected Office within the meaning of Chapter II of the Co-operation Treaty, once that Chapter has entered into force for at least one Contracting State to this Convention.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

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

**Articles 88 to 152**

prepared by Working Party I
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compared synoptically with

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

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

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

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

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

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

III Protocol on Recognition

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

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

The Main Committee approved the Recommendation which provides for the setting up of an Interim Committee responsible for preparatory work for the opening of the European Patent Office. In addition, in the interests of a clear delimitation of responsibilities the preparation both of the five-year plan mentioned in the Protocol on Centralisation and of the study on the extension of searches to the documentation of the Contracting States, introduced into that Protocol by Main Committee II, was assigned to the Interim Committee.

With regard to the point that the Working Parties of the Interim Committee should, as a general rule, each be composed of six signatory States, the Committee decided that the Federal Republic of Germany and the Netherlands, as the countries in which the European Patent Office was based, should always be admitted as observers at meetings of Working Parties of which they were not members, and that other States should be admitted as observers at meetings where problems of special interest to them were dealt with. Furthermore, it was made clear that not only inter-governmental but also private international organisations could be invited as observers.

V Resolution on training staff for the European Patent Office

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

D Final remarks

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

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