Article 54 E

Travaux Préparatoires
(EPC 1973)

Comment:

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| E 1972                                                    | 52                          | M/16                                   | S. 138                |
| "                                                        | 52                          | M/18                                   | S. 160                |
(d) Regarding the problem of the account taken of so-called prior rights, the two proposals are based on a fiction.

The Reimer proposal (first variant) is based on the fiction that prior rights form part of the state of the art. Prior rights are therefore treated vis-à-vis the more recent application as though the patent specification or examined application had already been published on the day the more recent application was filed.

The Draft Nordic patent law (second variant), insofar as its ideas are correctly reflected in the translation, seems on the contrary to raise only the fiction that, as regards the more recent application, only those parts of the prior application which are subsequently protected by the patent are deemed known. That variant is obviously more concerned with preventing a single invention being patented twice.

The first variant is certainly easier to apply in practice while the second would apparently oblige the European Patent Office to check in each case that the subject-matter of the two applications is identical, something which experience has shown to be very difficult.

(e) It will be necessary to examine to what extent patent applications that have to be kept secret for reasons of national defence or secret patents can be considered as forming part of the state of the art vis-à-vis European patent applications. It would seem expedient to defer study of this problem. The whole problem under European patent law of inventions that have to be kept secret for national defence reasons should be considered on another occasion.
The content of the two proposals should be the same for they are based on a concept of novelty without any limitation as regards territory, time or substance.

The difference between the two proposals lies rather in the systems adopted. While the Reimer Proposal gives a non-exhaustive detailed list of the various forms of disclosure, the Nordic draft gives a more general definition of the concept of novelty.

For the advantages and disadvantages of the two systems, reference is made to the von Zweigbergk study (the top of page 10 of the French text and page 12 et seq. of the unofficial German translation).

One advantage of the Reimer proposal is perhaps that it is based on the concept of "state of the art" a well known term commonly used in practice but one which has not yet been used in any national law. Cf. also the von Zweigbergk study (page 10, paragraph 3 of the French text; page 13, last paragraph of the unofficial German translation).

(b) The word "essentially" inserted in brackets in the Nordic draft does not in fact refer to the concept of novelty but to that of inventive level. It therefore seems appropriate to consider insertion of that word and the consequences that would ensue in connection with Article 16 of the Preliminary Draft.

(c) Apart from Article 15 of the Preliminary Draft, is it necessary to make provision for other restrictions on the concept of novelty with regard to territory, time or substance and if so what restrictions?
1. Documents:
   (a) Haertel Study, French text, p. 17 et seq. and Annex, p. 2; German text, p. 18 et seq. and Annex, p. 6
   (b) Gajac Study, French text, p. 7 et seq.; German text, p. 8 et seq.
   (c) von Zweigbergk Study
   (d) Reimer Proposal Section 3
   (e) Draft Nordic patent law Section 2

2. Comments:

   The Patents Working Party was instructed by the Co-ordinating Committee to base European patent law on the principle of absolute novelty with any modifications that might be necessary (cf. Report of the Co-ordinating Committee of 10 November 1960, II, No. 6, paragraph 1).

   The Preliminary Draft contains two alternative proposals for the concept of novelty. The first is derived from the Reimer Proposal (Section 3, paragraphs 1, 2 and 4), the second from the Draft Nordic patent law (Section 2, paragraphs 1 and 2). Both proposals are based on the principle of absolute novelty.

   The full proposals of Reimer and the Nordic patent law also contain exceptions to the concept of absolute novelty. They are summarised in Article 15 of the Preliminary Draft.

   The following individual questions in particular will have to be studied in greater detail:

   (a) Which of the two alternative proposals is to be preferred in principle?
Comments

on the first Preliminary Draft Convention
relating to a European patent law
of 14 March 1961
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(Articles 11 to 29)
The Working Party unanimously approved the principle of the Reimer draft. It thought that it was the only practical solution for the European procedure. But it left open the possibility of returning to the question of inventive level when examining Article 16 of the Preliminary Draft. The Working Party also wished to tackle the thorny problem of priority rights again at its next meeting.

The Working Party then turned to the question of what account should be taken of prior national applications. It decided unanimously that they should be taken into consideration when examining a European patent application. This would not give rise to any difficulties since under the European system examination could be deferred for up to five years. Such a time-lag would even allow prior-examination countries to publish the prior application before the European Office began its examination.

The first variant of Article 14, paragraph 3, was transmitted to the Drafting Committee.

Discussion of Article 15 of the Preliminary Draft

Discussion of sub-paragraph (a) of Article 15 was deferred until the Working Party had available the text of the 1928 Paris Convention on International Exhibitions, which had been referred to by Mr. De Reuse. But the opening discussions revealed no unanimity as to the obligation to take account of Article 11 of the Paris Convention for the Protection of Industrial Property. However, since the Co-ordinating Committee had clearly expressed its intentions regarding that Convention, it seemed appropriate to accept those provisions voluntarily.

The meeting was adjourned at 12.30 hrs. and resumed at 15.00 hrs.
Continuation of the discussion of Article 14, paragraph 3

The Chairman explained the principle embodied in the Reimer draft. A patent was granted to an inventor as a reward for his contribution to the state of the art. As the public was informed by the publication of the first application, there were no grounds for giving such reward to the second inventor. Under this approach, therefore, the first application was presumed to be known to the second inventor when he filed his application. Because of the fiction it established, this system was somewhat prejudicial to the second inventor since he did not in fact know of the first application. In this respect the Nordic draft was more logical. However, the Reimer draft had one very substantial advantage over the Nordic draft in that, under the former, the Patent Office did not have to decide *in abstracto* on the question of the extent of protection afforded by the patent, a question which was normally reserved for the courts. Another drawback to the Nordic draft was that it extended the examination time since the second applicant had to wait until a patent was granted to the first applicant. Furthermore it would oblige the European examiner to evaluate the scope of protection of a prior national patent on the basis of national principles.

Mr. van Benthem pointed out that the Reimer proposal would mean that a patent could be granted for a subsequent application only insofar as it possessed the requisite inventive level vis-à-vis the first application.
Under the Reimer draft, account had to be taken of the prior application in its entirety in evaluating the novelty of the more recent application. The prior application was treated as having been published on the day the more recent application was filed.

The Nordic draft provided that the evaluation of the novelty of the more recent application had to take account only of those elements of the prior application which had been protected by the grant of a patent as a result of the prior application. The aim of this system was to prevent the grant of two patents for a single invention.

The Chairman pointed out that the two solutions would have different consequences for the practical work of the European Patent Office.

Applying the first solution, the task of the Office would merely be to compare all the elements of the prior application with the more recent application. Applying the second solution, on the other hand, the Office would, in addition, have to examine whether elements of the prior application were to be found in the elements of the patent resulting from the prior application, a factor which would substantially complicate its task.

The Chairman adjourned the meeting at 18.00 hrs.
The Working Party agreed on a combination of the two variants using the criterion of the state of the art but with the list in the Reimer draft replaced by a more general definition as in the Nordic draft.

The Working Party then examined the question of the best wording to express the concept of absolute novelty. Discussion was focussed on the terms "rendered public" and "generally available". In order to avoid any risk of a restrictive interpretation, the Working Party decided to adopt the wording "available to the public". The word "available" emphasised the possibility of taking note of the invention. The word "public" was less broad than the term "generally" \textit{à tous} in French and expressed the idea that it was enough for the invention to be available to an unrestricted number of persons for it to lose its novelty.

Replying to Mr. Roscioni, the Chairman stated that an invention was only disclosed if, by virtue of the disclosure, a person skilled in the art could carry out the invention. It did not seem necessary for this principle to be expressly stated in the Convention. If the matter made available to the public did not allow the invention to be carried out, the invention remained novel.

A suggestion by Mr. De Muyser that the duration of the effects of oral disclosure be limited was rejected by the Working Party on the grounds that what had once been made available to the public could never again become secret. Provision of evidence was the key issue here.

The Working Party instructed the Drafting Committee to draw up the text of paragraphs 1 and 2 of Article 14 in accordance with the results of the discussions.

Finally, the Working Party turned to the question of prior rights in Article 14, paragraph 3.

The Chairman explained the different principles of the Reimer draft and the Nordic draft.
withdrawn, they would have to consider a special provision that protection would not be effective in that State.

Mr. Fressonnet asked whether it would not be possible to dispense with Article 13 by suitably amending Article 11.

The Chairman replied that the aim of Article 13 was to avoid any restrictive interpretation of the industrial nature of patentable inventions.

Mr. De Muysen argued that in the expression "for industrial or agricultural purposes", the word "agricultural" placed next to the word "industrial" effectively restricted the sense of "industrial", since the industrial application of an invention could relate to other human activities.

In response to this observation, the Working Party instructed the Drafting Committee to find a formulation allowing as wide an interpretation as possible. In view of the importance of agriculture, it would be appropriate to mention it by way of example in the text using the adverb "particularly".

Mr. van Benthem was afraid that the words "in any other way" placed too great a stress on the industrial nature and underplayed the need for practical implementation of the invention. The expression could lead to patents being granted for inventions not susceptible of application.

The Chairman decided to leave resolution of that question until later.

Discussion of Article 14 of the Preliminary Draft

The Chairman pointed out that the Co-ordinating Committee had given specific instructions that the concept of absolute novelty be used.

There were two variants to Article 14.

The first (Reimer draft) was based on the criterion of the state of the art. The second, based on the Nordic draft, provided for a more general criterion.
Proceedings of the 1st meeting of the Patents Working Party held at Brussels from 17 to 28 April 1961
Article 14
Novelty

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

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

(3) Additionally, patent applications or patent specifications published either by the European Office or by the competent authorities of one of the Contracting States on or after the date mentioned in paragraph 2 of this Article shall be considered as comprised in the state of the art, provided that such patent applications or patents are based on a priority application. If several applications are filed on the same day, the order in which they were filed shall be decisive for the application of this paragraph.
Proceedings of the 1st meeting
of the Patents Working Party
held at Brussels from 17 to
28 April 1961
Mr. van Benthem pointed out that that proposed wording amounted to a change of substance. The condition proposed by Mr. Fressonnet was to be found in the Netherlands law and in practice it was a very strict criterion. Very often the descriptions given in patent applications were not sufficient to carry out the inventions. If the French wording were adopted, such prior applications and patents could not be regarded as forming part of the state of the art. Furthermore, there were also purely theoretical publications which could not technically be carried out directly. They were, however, still part of the state of the art.

Mr. Fressonnet said that it was not the intention of the French delegation to change the substance of Article 14(2). He therefore agreed with the majority of the Working Party.

Article 14 was adopted without any change beyond those agreed on earlier.

Article 15

All the delegations except the German delegation thought that temporary protection for exhibitions should be confined to recognised exhibitions. The Belgian delegation maintained its reservation that they should hold to the provisions of the special Convention of 1928.

The Working Party thought that the European Convention should include a provision on temporary protection for certain exhibitions in order to comply with the obligations under Article 11 of the Paris Convention for the Protection of Industrial Property. But clearly only joint measures by all the countries of the Paris Union could afford proper protection. Any protection afforded by the European Convention might well deceive inventors by giving them a false sense of security which would be non-existent if they went on to file applications in non-Contracting States.
national law on pharmaceutical products would not be limited by European law.

Mr. Fressonnet reserved his views on this matter without wishing to go back on the principle set out in the European Convention.

The Working Party decided to delete the words in brackets in Article 13.

To take account of Mr. Roscioni's wish to simplify the task of national judges applying the European Patent Convention and the Council of Europe Convention by harmonising the texts of the two Conventions, the Chairman envisaged expanding Article 13 by inserting in the first sentence the provision in Article 2(1) of the Council of Europe Convention and then continuing the text of Article 13 after inserting the word "particularly".

Mr. van Benthem, who had taken part in the drafting of the Council of Europe text, pointed out that it had not been discussed in detail. He preferred a precise wording such as that in Article 13, which could be regarded as a wide interpretation of the Council of Europe provision.

The Working Party felt that Article 2(1) of the Council of Europe text was merely a programme containing no definitions. It was therefore possible to fill in the details in that programme in the national law of the Contracting States and in the European Convention. Article 13 was in any case compatible with the Strasbourg text. The Article was adopted. The words in brackets would be deleted.

**Article 14**

The French delegation proposed removing mention of prior rights from paragraph 3 of Article 14 and inserting it in Article 12.

The Chairman pointed out that there were two alternative methods of dealing with
The Chairman said that, having deleted those words from Article 14(3), they were left with two options: either the Office would take account of no national prior rights or it would take account only of those national prior rights of which it was aware.

Mr. van Benthem considered a third possibility. The Office would merely have to notify the person concerned of prior national rights of which it was aware.

The Working Party endorsed Mr. van Benthem's proposal.

The Chairman submitted to the Working Party another solution regarding prior national rights. It was feasible in view of the fact that, in its discussion of Article 171, the Working Party had decided to allow transition to the national procedure not only up to the time the provisional European patent was granted but up to the time of the final confirmation of that patent. The following solution might possibly be the most effective: Article 14(3) would not be altered. In other words, prior national rights would also be included in the state of the art by means of the fiction under Article 14(3). In that way prior national rights would have the same affect as lack of novelty. Those prior national rights might not be referred to in the novelty opinion of the IIB at The Hague since the European Office would receive that opinion at a fairly early stage. But it can be assumed that the Examining Division of the European Office would be aware of prior national rights in 90% of cases once it began examination of the provisional patent, that is generally within 5 to 7 years after filing. The Examining Division would then be able to rely on the prior national rights against the applicant in the course of the examination procedure. The applicant could, pursuant to Article 171, file an application for a national patent in those Contracting States where no prior rights existed. For the relatively few cases in which prior rights had not come to the attention of the Examining Division in time and where the European patent was confirmed in ignorance of those rights, the solution could be to apply Article 20a excluding prior national rights as grounds for revocation. It would be enough to limit the scope of Article 20a to the definitive European patent and to expand Article 122.
where disputes arose, national courts would have to check on the existence of prior rights and their scope vis-à-vis the European patent. Furthermore the judgment would only be effective *inter partes*. The possibility would also exist of contradictory judgments. If Article 14(3) was not amended, the proprietor of the prior right could have the European patent revoked and the decision would have universal affect.

Secondly, in the case of territorially restricted revocation, the question arose of whether a national or a European body should rule on the revocation. The Chairman would prefer a European body.

In cases of partial revocation it would be necessary to modify the content of the patent. It was undesirable for such modification to be carried out by national bodies. Moreover the principle hitherto had been that national courts did not rule on the validity of European patents.

Mr. Pfanner, supported by Mr. Fressonnet, argued that the European body should not rule on the revocation of European patents where prior rights existed. In cases of partial revocation, the European Office would still have to examine whether the part that had not been revoked still constituted an invention. If so, its content would have to be reshaped. Two European patents with the same number would then exist, the first valid in five countries and the other in one country for example. That was a source of confusion that had to be avoided.

The Chairman recognised the force of that argument. After further discussion, the Working Party opted for national courts having jurisdiction and endorsed the principle of the French and German proposals. The Drafting Committee would decide whether a special article was required or whether Article 20 could be expanded as in the French proposal.

The Working Party decided to delete from Article 14(3) the words: "or the competent authority of a Contracting State".
Mr. Fressonnet, supported by Mr. Roscioni, pointed out that the effect of Article 14(3) was to make the European filing (second filing) void although the applicant could not have known of the first filing. In view of that he felt that inventors would prefer to file six national applications rather than a European application. He therefore proposed that the paragraph be deleted.

The Chairman pointed out that the European Office could never be absolutely certain of recording the existence of all prior national rights during the examination procedure. Two solutions could be envisaged. First where prior national rights existed, the European patent could be revoked following proceedings brought before a national court. Secondly, the Convention could provide that in such a case the European patent had no effect on the territory of the State in which prior rights existed.

Mr. Fressonnet and Mr. Pfanner advocated the second solution on the lines of the French and German proposals.

Mr. van Bentchem wondered whether there wasn't a third possibility. The European Office itself could rule on the validity. The advantage of that solution would be that the decision would have universal effect.

The Chairman resumed consideration of the two possible solutions. First, if the European patent was granted without taking account of a prior right, the patent had no effect in the country where that prior right existed. Consequently

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**Text of the German proposal: Article 20a - Prior national rights**

(1) A European patent cannot be relied on in a Contracting State where a national patent with the same subject-matter exists or has existed if the national patent is based on an application which precedes that for the European patent but which was only published by the competent national authority on or after the date mentioned in Article 14, paragraph 2.

(2) Where, in the case referred to in paragraph 1, a national application has been filed at the same time as a European patent application, the latter shall be presumed to have been filed later unless the proprietor of the European patent can show that the application was made by the same inventor.
Discussion of Article 14 of the Preliminary Draft (continued)

The Chairman opened the meeting at 09.30 hrs.

The Working Party continued its discussions on paragraph 3 of Article 14 and the French and German proposals. The latter sought to restrict the territorial scope of European patents by excluding any effects on the territory of a State where prior rights existed. (1)

The Chairman stated that under Article 14(3), a European patent would be void for the whole territory if a prior national right existed resulting from a filing prior to that of the European patent application even if it was not public at the time the latter was filed. That position was more unfavourable for an inventor than if he had applied for six national patents. There was a danger of the European patent becoming less attractive.

Replying to Mr. Roscioni, the Chairman reiterated the aim of Article 14(3). The article was based on a fiction. It incorporated in the state of the art something that did not exist when the European application was filed in order to avoid a check on whether applications are identical in the course of the European procedure.

(1) Text of the French proposal: "However, if in one of the Contracting States a third party has been granted for the whole or part of the invention which is the subject of a European patent, a national patent not yet published on the priority date of the European patent but with an earlier priority date, the effects of the European patent shall not extend, insofar as the invention is the same, to the territory of the State in question."

Text of the German proposal: see footnote on following page.
question and the European patent while retaining the other five national patents. Clearly such a solution was prejudicial to the European patent since it would encourage applicants to take out national patents as well.

Mr. Fressonnet endorsed the Chairman's comments. He stressed that the aim of the French proposal was to avoid having European patents placed in a worse position than national patents. Consideration might be given to extending the blocking effect of a national application beyond the frontiers of that State to the whole of the territory of the Contracting States.

Mr. Roscioni largely shared the views of the previous speakers. But he felt obliged to point out that in Italy a fairly serious problem existed because, according to a decision of the Court of Cassation, a prior application in any country whatsoever was a bar to the grant of an Italian patent.

The Working Party decided to continue the discussion the following day.

The meeting was adjourned at 18.00 hrs.
Discussion of Article 14, paragraph 3

The French and German delegation submitted proposals regarding this provision to the Working Party.

The Chairman explained that the rule in paragraph 3 could have very harsh practical consequences. If, for example, a first application had been filed in Germany, it formed part of the prior art vis-à-vis a subsequent application to the European Office.

Under the German system, it would be possible for the first application not to be published in Germany until after examination of the provisional European patent based on the second application had begun. It was possible that the European Office might confirm the European patent without knowing of the German publication. Nonetheless the prior German application would constitute grounds for revoking the European patent under paragraph 3. To counter that danger a prudent applicant would simultaneously file applications for a European patent and coexistent national patents. Then if prior national applications existed, he would lose only the national patent of the State in
Proceedings of the 5th meeting of the Patents Working Party held at Brussels from 2 to 18 April 1962
Article 11 (14)
Novelty

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

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

(3) Additionally, the content of European patent specifications published on or after the day referred to in paragraph 2, insofar as the patents in question are based on a prior filing, shall be considered as comprised in the state of the art. If several European patent applications have been filed on the same date, the order of filing shall be decisive for the application of this paragraph.

Note:
The question whether inventive step must be required vis-à-vis the prior rights referred to in paragraph 3 will have to be re-examined.
VE MAY 1962
PRELIMINARY DRAFT CONVENTION
RELATING TO A
EUROPEAN PATENT LAW
the Working Party decided to allow the conversion of the European application or provisional European patent until the latter was confirmed. The effect of the proposal was to provide that prior national rights formed part of the state of the art and thus destroyed novelty. Consequently the provisional European patent would have to be revoked by the Examining Division of the European Patent Office if a prior national right existed in any one Contracting State. In that case the proprietor of the provisional European patent would be able to convert the provisional European patent into national applications in those Contracting States where no prior right existed. Moreover, under the German proposal, Article 19(20a), paragraph 1, was confined to the definitive European patent and revocation proceedings under Article 126(122) were excluded when they were based on the existence of prior national rights if the previous patent application or specification had been published by the competent authority of one of the Contracting States.

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

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

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

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

**Article 13(16)**

The Working Party compared the text of Article 13 with that of Article 4 of the Strasbourg Draft. It then decided to delete the word "particularly" from the wording of the Preliminary Draft.
Article 10(12)

Mr. Fressonnet proposed that a note be inserted in this article that the special question of patents for pharmaceutical products, which also fell under the jurisdiction of Ministers of Health, would be considered later.

Mr. van Bentham said that such a note would oblige his delegation to ask for another concerning agricultural products.

The Chairman pointed out that any possible new exceptions to patentability would call the whole Preliminary Draft Convention in question again.

In the light of those factors, Mr. Fressonnet withdrew his request and agreed to accept an indication in the minutes that the French delegation wanted the question of whether patents for pharmaceutical products should be subject to specific rules to be examined later.

Article 11(14)

Regarding paragraph 3, Mr. Pfanner explained to the Working Party the German delegation's new proposal concerning prior national rights (Doc. Bonn, 6 June 1962). He first reminded the Working Party that at its 5th meeting it had adopted the solution appearing in Articles 11(14) and 19(20a) of the Preliminary Draft. Contrary to what had been provided previously, prior national rights did not form part of the state of the art within the meaning of Article 11(14), paragraph 3. Furthermore European patents had no effect in Contracting States in which prior national rights existed.

The drawback of that solution was that it breached the territorial unity of the European patent. The basis for the new German proposal was that at the 5th meeting...
the Netherlands proposal in Strasbourg for the incorporation of the European Convention provision in the Council of Europe Draft. He also thought that the question of micro-organisms should be left to the courts since there was a risk of any express rule distorting the sense of the provision by introducing an a contrario argument.

Replying to Mr. Briganti, Mr. van Benthem stated that inventions with national defence implications were now covered by Article 67 (62).

Article 10 was approved.

**Article 11(14)**

The discussion was deferred until the following week pending a proposal to be made by the German delegation.

**Article 12(15)**

Mr. van Benthem explained that the Drafting Committee had wondered whether complete protection should not be afforded against unauthorised disclosure. The Netherlands delegation could now accept the current text in view of the fact that priority based on exhibitions would require a check that the subject-matter of the subsequent application was identical with the matter exhibited which would entail considerable problems.

Mr. Sünner and Mr. van Benthem wondered about the significance of the note at the end of Article 12.

The Chairman informed them that it merely meant that the Working Party would have to discuss a new solution for the European Convention if the Council of Europe Draft came to nothing. But he thought that the prospects for the Strasbourg Draft could be viewed with some optimism.

With a view to co-ordinating the six delegations from the EEC countries for the
Proceedings of the 6th meeting of the Patents Working Party held at Munich from 13 to 23 June 1962
PART II—PATENT LAW

CHAPTER I—PATENTABILITY

Article 9. Patentable inventions

European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.

Article 10. Exceptions to patentability

European patents shall not be granted in respect of:

(a) inventions the publication or exploitation of which would be contrary to 'ordre public' or morality (the mere prohibition of the exploitation of the invention not making it so contrary);

(b) plant or animal varieties or essentially biological processes for the production of plants or animals.

Article 11. Novelty

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

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

(3) Additionally, the contents of European patent specifications published on or after the date referred to in paragraph 2, shall be considered as comprised in the state of the art, provided that such patents have an earlier priority date. If several applications for European patents have been filed on the same day, the order in which they were filed shall determine how this paragraph is to be applied.

Article 12. Non-prejudicial disclosures

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

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

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

Note:
This article reproduces exactly one of the provisions in the draft Convention for the unification of patent laws drawn up under the aegis of the Council of Europe.
Translation of a Draft Convention relating to a European Patent Law

LONDON
HER MAJESTY'S STATIONERY OFFICE
FIVE SHILLINGS NET
5. **Article 11, paragraph 3**

The Working Party was unanimous that the word "published" in Article 11, paragraph 3, should include making the application available to the public. The Drafting Committee was to take account of that when drawing up the final text.

Mr. van Benthem added that the mention of the 18 month time-limit would also help to resolve the problem of prior rights since the period within which such rights could arise was further curtailed by the availability to the public.

The Working Party finally decided that the Drafting Committee should draw up an aide-mémoire on all aspects of the question raised by the Swedish proposal and should further try to make the necessary changes in the wording of the Draft Convention. Those documents would be sent to the members of the Working Party and of the Co-ordinating Committee. That would certainly facilitate discussions on a national level and preparation for the Strasbourg discussions.

The Chairman congratulated the Working Party on the excellent results of the discussion on this problem and adjourned the meeting at 12.35 hrs.
Proceedings of the 12th meeting of the Patents Working Party held at Brussels from 26 February to 6 March 1964

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Mr. Fressonnet proposed that the purely practical reasons in support of the draft text should be put forward at the meeting to be held with UNICE and possibly other international organisations.

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

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

Article 12

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

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

Article 13

Mr. Froschmaier read the opinions of the international associations.
Inventive step would first be assessed having regard to the whole mosaic of the state of the art without taking account of prior rights. The inventive step found by that examination would be reassessed, but this time as against each of the prior rights. That proposal could be implemented by means of an addition to Article 13.

Mr. Pfanner added that by adopting that proposal the Working Party would curtail the effects of the fiction under Article 11, paragraph 3, which the German interested circles considered unfair, without going all the way to satisfy their wishes. For the majority wanted to return to the old system of prohibiting duplicated protection with a check on whether inventions were identical.

Mr. De Muyser endorsed Mr. Pfanner's proposal. Mr. van Benthen asked whether it was in line with the Strasbourg draft.

Mr. Pfanner replied that the Strasbourg draft allowed of any solution in this respect.

Mr. Fressonnet expressed his great surprise at the protests by the interested circles. A fiction similar to that of paragraph 3 existed under French law. It had never given rise to any such protests. He therefore thought that the current text of the Convention was a good solution since it enshrined the principle of the first applicant obtaining a patent. He was against the compromise solution. Not only would it impose an extra burden on the European Office but it failed to satisfy the interested circles.

The Chairman opposed the traditional system which he considered ill-founded, impractical and, above all, irreconcilable with the system of deferred examination. The basic idea of patent law was to grant a monopoly to persons making technical knowledge available to the public. It was therefore logical to give that monopoly to the first applicant, as the draft provided. Finally, he pointed out that it was important for the Convention to adopt a system corresponding to an overriding logical concept such as that of the Preliminary Draft.

Mr. van Benthen reminded the Chairman that the inventor's reward should be determined having regard to the time when he made his invention public. That was not done by paragraph 3. He found the traditional system logical enough. It should be abandoned only if experience showed that difficulties arose in connection with the protection of prior rights.
Strongly though that inventive step should be required of each invention for which a new application had been filed.

Mr. Pfanner again expressed his support for the solution in paragraph 3 of Article 11. By way of a compromise, however, he put forward a proposal based on comments made by the interested circles in Germany. The majority of them thought that under the deferred examination system there could hardly be any other solution for prior rights than that of paragraph 3 of Article 11. But the effects of the paragraph 3 solution seemed unfair as regards the examination of the more recent invention.

Applying the fiction of Article 11, paragraph 3, prior rights were included in the state of the art not only for assessing the novelty but also the inventive step of the more recent invention.

In evaluating inventive step, the invention in question was not compared with each prior right in isolation or with each prior application. On the contrary, the invention was compared with the composite picture of all prior rights and publications.

In examiners' parlance, the composite picture was called a mosaic. The interested circles were afraid that if prior rights were incorporated in that mosaic of the state of the art, the inventive level of the more recent invention would very often be insufficient. It was however possible to make some concession to the views of the interested circles while not altogether dropping the system of Article 11, i.e. dispensing with checking that applications were identical, by regarding prior rights as comprised in the state of the art insofar as the novelty examination was concerned, but not including them in the mosaic for assessing the inventive step of the more recent invention. Thus inventive step would only be examined individually as against each prior right. The assessment of inventive step would be divided in two.
When the meeting resumed, Mr. Pfanner again opposed Mr. van Bentheim's proposal. He reminded the Working Party of the experience of the German Patent Office where the check that two applications were identical had proved particularly difficult in practice. Seen in that light, it had to be remembered that, under Mr. van Bentheim's proposal, the Office would still have to carry out such an examination which would of course be confined to the subject-matter of the application. The fact remained that such difficulties would exist and they ought to be avoided. The proposal might, moreover, produce bizarre results. It would be enough to alter the subject-matter of the application slightly to obtain a new patent. It seemed undesirable to have protection granted for such an invention since the public was already informed of the inventive idea by the publication of the first application.

Mr. Pfanner went on to point out to the Working Party that the grant of a European patent would already take a number of years. After seven years the inventor could expect to have maximum certainty regarding the protection granted him. Under Mr. van Bentheim's proposal, he would not have such certainty until after the decision of the Revocation Board. The result would be to prolong too much the inventor's lack of certainty. Finally, the fact that the value of a patent would be finally decided following infringement proceedings made the situation still worse. National courts could hardly decide such cases since they would be faced with two legally valid patents.

He reiterated that the interested circles had been too concerned with the interests of the second applicant without taking sufficient account of the first applicant.

Mr. van Bentheim pointed out to Mr. Pfanner that his intention was not to introduce a check on whether applications were the same; on the contrary he wanted to reduce such checking to a minimum. He thought that the problem was one of wording. But he was sure that the problem of duplicated protection was inevitable. He again put the case of the interested circles who were afraid that they would no longer be able to make subsequent filings following a basic invention. He argued
Following Mr. van Benthem's remarks, Mr. Fressonnet made two comments:

(1) Mr. van Benthem had said that there were many examples of duplicated protection, particularly in the case of dependent patents. It should be noted that there was a further factor in such cases, namely inventive step.

(2) Mr. van Benthem had said that the courts could perhaps take account of factors not considered by the examiner. Consequently Mr. van Benthem's proposal gave rise to two different standards depending on whether the Examining Division or the Revocation Board had jurisdiction. Such differences caused major problems. The existence of the patent could easily be called in question again.

Mr. van Benthem replied that he had merely wanted to emphasise that under the solution he proposed, the risk of duplicated patents was not excessive and could be eliminated, if necessary, by means of revocation.

The Chairman then summarised the discussion stressing that the basic idea was that only one patent could be granted for one invention. He pointed out that duplicated patents did exist sometimes. It was not possible for the Offices to be aware of all the possible effects of a patent. This problem should not be confused with the distinct question of dependent patents.

The basis of Mr. van Benthem's proposal was that the Offices should be spared the need to check that applications were identical because that was too involved. The same idea underlay the solution in paragraph 3. But the effect of Mr. van Benthem's solution was to reduce the check on prior applications. Such examination would no longer relate to the effects of prior applications but only to their subject-matter. Under that proposal, the examination would not really be carried out until the revocation proceedings. It was that which constituted the very serious breach of the fundamental rule that there could only be one patent for one invention.

The meeting was adjourned at 12.30 hrs. and resumed at 15.00 hrs.
Mr. Pfanner was in favour of the paragraph 3 solution. He put forward various arguments. A general point was that it was undesirable to grant a monopoly to an applicant for an invention that had already been filed and published. He went on to give various practical arguments. Drawing on experience at the German Patent Office, he stressed that the European Office should be spared the heavy burden of checking that applications were identical. The task of comparing the extent of the protection under two patents would be made still more complex because of the deferred examination system.

Mr. van Benthem, however, wanted paragraph 3 amended. He thought that the unanimous objections of the interested circles could not be ignored. He supported the solution suggested by CNIPA, illustrating his arguments with the following example: a first application is for the use of a relay in a radio. A second application, filed before publication of the first, is for the same relay for a calculating machine. If the Preliminary Draft was retained, the first application would be considered as comprised in the state of the art and no patent could be granted for the application of the relay in the calculating machine. Adopting the system proposed by CNIPA on the other hand, the examiner would have to confine himself to comparing the subject-matter of the first application and of the second application and he would then be able to grant a patent for the application of the relay in the calculating machine. The subject-matter of the invention was different.

Mr. van Benthem pointed out that such a system entailed a risk of duplicate patents being granted but he thought that the risk was fairly small. He stressed particularly one advantage of this proposed solution pointing out to the Working Party that one single invention by a laboratory could lead to a number of different filings, perhaps over a span of four or five months, each one an improvement over the previous application and each ineligible for a patent of addition. Such filings would not be possible under the Preliminary Draft as it stood and that was something to be avoided.
as part of the state of the art. Furthermore, all the associations wanted the Preliminary Draft to confine itself to ruling out double protection in principle but to specify that only the content of the claims in the prior application would be retained.

UNICE proposed the following wording: "Inventions already protected by European patents with an earlier date shall not be patentable". However the German UNICE delegation preferred the fiction of paragraph 3. But it wanted the fiction to apply only to assessing the novelty of the subsequent invention. It did not wish the fiction to extend to assessment of inventive step as well and therefore wished Article 13 to be retained.

Finally the Committee of National Institutes of Patent Agents (CNIPA) proposed the following wording: "Inventions for which a provisional or final European patent has been granted with an earlier priority shall not be patentable. For the purpose of this provision, inventions for which a patent has been granted shall include all the possible ways of carrying out the invention claimed described in the patent or any obvious changes to those possibilities covered by the claims".

The United Kingdom drew the Working Party's attention to the problem of multiple priorities. The Austrian Government thought that a rule simply preventing two patents being granted was preferable.

Mr. Pfanner pointed out that the Scandinavian draft was based on this Preliminary Draft Convention with the addition of a further requirement.

The Chairman said that according to the letter from Mr. Morff, the Swiss Government seemed prepared to accept paragraph 3.

The Chairman suggested that the Working Party confine its discussions to whether they should simply rule out duplicated patents or whether they should adopt the solution of paragraph 3 whereby the contents of European patent specifications published on or after the date of the subsequent European patent application were considered to comprise part of the state of the art insofar as the patents in question were based on a prior filing.
proof. It was important to remember that it was up to the inventor to prove that the invention was new. Following Mr. van Bentem's suggestion, the Working Party considered that paragraph 1 could be brought into line with the corresponding provision in the Strasbourg draft. The paragraph was transmitted to the Drafting Committee.

AIPPI wanted formal proof to be required of the content and date of oral disclosure.

UNICE felt that a general description of an inventive idea should not destroy its novelty and proposed the following wording: "the state of the art shall be held to comprise everything made available to the public, in a manner sufficient to enable the invention to be carried out...". Finally UNION would like the term "public" to be defined.

The views of the Austrian Government were similar to those of UNION.

The Chairman summarised the problems regarding paragraph 2:

1. Additional evidence is wanted in connection with oral disclosure.
2. Further definition is wanted of the description.
3. Further definition of the word "public" is also wanted.

Regarding the first problem, the Working Party was unanimous that there was no need for specific evidence regarding oral disclosure.

The question could safely be left to the courts which were used to such evidence.

The Working Party also rejected the second suggestion. It preferred the current, more objective wording. It also rejected the third suggestion on the grounds that it would be very dangerous to give too precise a definition of "public".

Mr. Froschmaier set out the views of the international associations on paragraph 3. All but one proposed that matter disclosed in a prior patent should be treated
the corresponding article of the Strasbourg draft, the wording of which seemed better.

Article 10

Mr. Froschmaier set out the views of the international associations which wanted sub-paragraph (b) to provide that the exception to patentability in that sub-paragraph should not apply to microbiological processes and the products thereof in accordance with the Strasbourg draft. He then read a note from UNICE requesting clarification at the Diplomatic Conference that the Convention allowed all conceivable objects to be patented, even those that were not eligible for national protection. He added that the United Kingdom shared the views of the international associations on microbiological processes and that Austria wanted a number of additional exceptions to patentability.

After a short discussion, the Working Party accepted the proposal on microbiological processes and referred the text in question to the Drafting Committee for harmonisation with the wording of the Strasbourg draft. UNICE's request was not approved as it was clear that the provisions in the Convention on patentability were not the same as national provisions.

Article 11

Mr. Froschmaier read the views of the international associations on paragraph 1. The International Association for the Protection of Industrial Property (AIPPI) and UNICE proposed the following wording: "An invention shall not be considered as new if it forms part of the state of the art".

The United Kingdom raised the problem of multiple priorities.

Mr. Pfanner then explained the provisions of the Scandinavian draft on novelty.

The Chairman thought that the UNICE proposal should not be adopted. The drawback was that it was expressed as a negative. It seemed to shift the burden of
Proceedings of the 10th meeting of the Patents Working Party held at Brussels from 16 to 27 September 1963

MINUTES
provide any remedy against that report. His opinion was endorsed by Mr. van Benthem and Mr. De Muysers.

Mr. Fressonnet again emphasised that information about prior rights would be very valuable for potential licencees who should not be deprived of such information.

The Chairman noted that the majority of the Working Party was in favour of entering prior national rights in the patent specification provided that attention was drawn to the fact that the list of prior rights was merely for information purposes and those rights had not been examined by the Office.
Mr. Roscioni supported publication of prior rights in the novelty report; if they were not published, it would deprive third parties of information that was possibly incomplete but potentially very important.

The Chairman, with the support of the Working Party, decided that the novelty report would include prior national rights. Under the system of the Preliminary Draft Convention the proprietor of the patent had to prove his title. Under such a system it was normal for the greatest possible publicity to be given to anything that might be used to challenge the grant of a patent. The Implementing Regulations would be amended accordingly. They would also stipulate that the novelty report should state that the list of prior rights was purely for information and set out only those prior rights known when that report was published.

The Chairman then proposed that the Working Party examine the comments under Article 19, paragraph 2(b). The question was whether prior national rights found by the European Patent Office during the procedure for the confirmation of the provisional European patent should be mentioned in the printed specification of the definitive European patent or merely notified to the proprietor of the patent. The Chairman thought that in this respect as well it was desirable for the information to be as comprehensive as possible. But it would again be necessary to point out that prior rights were listed purely for information and that they had not been examined by the Office.

Mr. Fressonnet endorsed that viewpoint. But he thought that the Office should not be required to search for prior rights systematically.

Mr. Pfanner did not share the Chairman's view. He thought that prior rights as well should be disclosed only to the proprietor of the patent, because the proprietor would have no means of redress if they were entered in the specification.

Mr. Fressonnet countered that the list of prior rights did not constitute a decision taken by the Office but was merely a report for purposes of information. It was not binding on the Office or on national courts. There was therefore no need to
The Chairman suggested that the Working Party discuss the question raised in sub-paragraph (a) of the second comment under Article 19. Should prior national rights be mentioned in the novelty report or should they be disclosed only to the applicant for the European patent?

Mr. van Benthem replied that prior national rights should be cited in the novelty report. The purpose of publishing that report was to inform third parties as comprehensively as possible of the factors determining the validity of the patent.

Mr. Pfanner for his part thought that prior national rights should be communicated to the proprietor alone. He argued that the list of prior national rights would be very incomplete and would depend on chance alone. Listing those prior rights would also intimidate the public. It could only be accepted if the applicant was able to contest the status of the rights, something that the Convention made no allowance for since the Office was not going to check that applications were identical.

The Chairman replied that the novelty report was merely a source of information setting out what could be used to challenge the patent. That source of information had to be disclosed to the public in its entirety. He further reminded them that under Article 11, paragraph 3, prior national rights had to be treated in the same way as matter destructive of novelty.

Mr. Degavre supported publication of prior national rights in the novelty report. Third parties wishing to judge those prior rights, like anything else destructive of novelty, would necessarily have to call on specialists.

Mr. Fressonnet felt some hesitation regarding the publication of prior rights. They would be published about nine months after the filing of the application. The publication would therefore be very fragmentary. Moreover the prior national rights would only partially cover the European patent and the applicant would have no opportunity of contesting them. He emphasised that if prior rights were to be published in the novelty report, special mention would have to be made of the fact that they were the prior rights known at that time.
Proceedings of the 11th meeting
of the Patents Working Party
held at Brussels from 22 to 24 October 1963

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

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

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

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

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

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

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

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

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

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

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

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

MINUTES
Article 11

Novelty

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

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

(3) Additionally, the content of European patent specifications published on or after the date referred to in paragraph 2 shall be considered as comprised in the state of the art insofar as the patents in question are based on a prior filing. This provision shall apply to the content of the documents of European patent applications or European patents made available to the public pursuant to Article 86(a). For the application of this paragraph, the chronological order of filing shall be decisive even if applications were filed on the same day.

Note: Paragraph (3) was approved by a majority of the Working Party. It will, however, have to be re-examined.
Amendments to the Preliminary Draft Convention
relating to a European Patent Law

(Articles 1 to 175)

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

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

Article 12 - Non-prejudicial disclosures

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

Article 13 - Inventive step

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

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

Article 14 - Industrial application

29. Article 14 corresponds to Article 3 of the 1963 Strasbourg Convention.
The British delegation declared its agreement with the text adopted by the Working Party. However, it pointed out that it reserved the right to re-examine the text in the light of the new national provisions being discussed in the United Kingdom.

26. The Working Party noted that paragraph 4 prevents a later application being taken into consideration if one or more of the Contracting States designated in this application have also been designated in the earlier application.

Such a solution - which is based on the consideration that it appears difficult to provide that different European patents can be granted for applications having the same content - nevertheless seemed too rigid to the Netherlands delegation.

This delegation put forward a solution consisting in allowing the applicant to divide his later application into two separate applications, one for the Contracting States for which there is no overlapping (in which case the later application would have to be dealt with as a European application), on the one hand, and one for the Contracting States designated in both applications, on the other hand. For the second application, the rule of paragraph 3 would then be applicable. The consequence of this solution is that two European patents having different contents would be granted for two European patent applications relating to different States.
A first solution consists in providing that the earlier application shall, in its entirety, oppose the novelty of the invention which is the subject of the second application. This solution corresponds to the possibility afforded the Signatory States by Article 4, paragraph 3, of the Strasbourg Convention.

A second solution, adopted in particular by the French law of 2 January 1968, consists, in accordance with Article 5 of the Strasbourg Convention, in allowing the grant of a patent for the second application, in so far as the claims contained in the first application are not opposed thereto and without this first application being considered as forming part of the state of the art.

The Working Party was of the opinion that the second solution would have the drawback of obliging the person making the later application to wait until a decision had been taken on the earlier application. In view of the practical difficulties arising from this solution, the Working Party adopted the first solution. In the opinion of the Working Party, the adoption of the latter does not imply that the provisions relating to inventive step (see Article 13) need to be as strict as those relating to novelty in Article 11, paragraph 3.

In addition it was noted that the person making the later application should, where necessary, be able to change his application into an application for a national patent if the national legislation offers a solution which appears to him to be more favourable.
However, the Working Party considered that this provision should form part of the Convention, as it was a substantial provision fixing the conditions for the grant of patents.

For the drafting of paragraph 2, it based itself on rule No. 39 of the PCT plan.

The Working Party points out that the text of paragraph 2 does not prejudice the question of whether computer programmes may be the subject of a European patent.

Article 10 - Exceptions to patentability

23. The Working Party points out that this Article corresponds to Article 2 of the 1963 Strasbourg Convention.

Article 11 - Novelty

24. Paragraphs 1 and 2 correspond to paragraphs 1 and 2 of Article 4 of the 1963 Strasbourg Convention.

25. As regards paragraph 3, the Working Party was faced with two possible solutions to the problem of knowing what effects the existence of an application for a European patent has on a later application designating the same Contracting States.
MINUTES

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

I

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

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

In addition to the Commission of the European Communities, the following inter-governmental organisations, which had been invited to take part in the work of the Working Party, were represented: BIRPI, the General Secretariat of the Council of Europe and the International Patent Institute (1).
(4) Paragraph 3 shall be applied only when a Contracting State designated in respect of the later patent application was also designated in respect of the earlier patent application as published under Article 86a.

Note:
- no change
- this note to be deleted.
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

CORRIGENDA

to BR/6/69 and BR/9/69

resulting from the work of Working Party I (24–28 November 1969)

and concerning

Articles 5, 11, 15, 16, 20, 20bis, 20ter, 24, 24a, 25, 26 to 30, 29, 34
56, 73, 80, 88 to 96

BR/13 e/69 mk
II

Articles 1 to 30

General provisions - Substantive Patent Law
(Report by the British delegation: BR/16/69)

13. The Conference noted, as regards Article 2a, that in view of the provisions of Article 68a an applicant may apply for a European patent for one Contracting State only. It therefore felt that the drafting of the English text of Article 2a should be adapted accordingly and that the note to the Article should be deleted.

14. The Conference observed as regards Article 2, that the present state of developments did not allow it to be determined whether computer programmes could be the subject of a patent.

15. A number of delegations stated that they would have preferred in Article 11 (3), a solution consisting in adopting the alternative laid down in Article 6 of the Strasbourg Convention, i.e. a solution which would simply avoid double protection for one and the same invention. It was pointed out by other delegations that this solution would not fit in with the system of deferred examination adopted for the present Convention. This was because, where examination is requested for the later application while no request for examination has yet been introduced for the earlier application, this solution does not allow a decision be taken in respect of the later application until the end of the procedure for the grant of the earlier application. For these reasons, the Conference retained the text adopted by the Working Party for Article 11 (3), subject to reconsidering the matter once the interested circles have had the opportunity to present their observations.

BR/26 e/70 kel/PA/mk
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 11
Novelty

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

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

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

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

Notes to Article 11 (1), (2) and (3):

1. Paragraphs 1 and 2 correspond to Article 4, paragraphs 1 and 2 of the Strasbourg Convention.
2. Paragraph 3 corresponds to Article 4, paragraph 3, of the Strasbourg Convention.

Note to Article 11 (4):

It is agreed to examine later the consequences to be drawn from this paragraph as to the possible division of the European patent application and/or its conversion to national applications in respect of States designated in both applications.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

- Secretariat -

Brussels, 21 December 1970
BR/70/70

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

(Articles drafted by Working Parties I, II, III and IV)
(w) Articles 152 to 154 - Professional representation, compulsory representation and authorisation

The question of representation should be discussed later (see point 78 above).

(x) Article 159 - Period within which a request for examination may be made during a transitional period

Should the Administrative Council's option be maintained of shortening the period for making the request for examination, the length of which still has to be specified for a transitional period? [Article 159, paragraph 1, second sentence] (CPCCI, FICPI)

81. Item 6 on the agenda: Discussion of procedure for the 4th Meeting of the Intergovernmental Conference from 20 to 30 April 1971

The Working Party discussed the question of how the results of their work and of the work of the Sub-Committees should profitably be dealt with at the next Meeting of the Conference. In this connection it considered that the delegations to the Intergovernmental Conference should be requested to submit in writing any requests for amendments to the texts.

Item 7 on the agenda: Other business

82. The Working Party agreed as follows for its future programme of work:

The reports of the delegations of Working Party I and of the General Rapporteur on amendments to the published First Preliminary Draft of 1970, which were to be submitted to the Conference, should reach the Secretariat by
(t) **Article 116** - Decision or opinion of the Enlarged Board of Appeal on certain points of law

The Working Party considered that the question of which text of paragraph 1(b) was preferable, should be discussed with the government legal experts. (See observations by the ICC and CPCCI)

(u) **Article 122** - International search report

Should the international search report completely replace the report on the state of the art to be drawn up by the IIB? Should the European Patent Office or the IIB decide on the need for a supplementary report on the state of the art? Should the IIB prepare in every case a report on the state of the art and only consider any international report that might be available? (ICC, CNIPA, CEIF, EIRMA, FICPI, UNEPA, UNICE)

Should fees be levied for any necessary additional report drawn up by the IIB? Could a proportion of the fees be refunded to the applicant if necessary? (CNIPA, FICPI)

(v) **Article 137** - Supplementary report on the state of the art

Should a fee be levied for a supplementary report on the state of the art or should it be incorporated into the fee for the main report on the state of the art or even into the filing fee? (FICPI)
(p) Article 79 - Obtaining of the report on the state of the art

(i) With regard to the question on combining the filing fee with the search fee, see under point (l) on Article 66.

(ii) With regard to the question, whether the report on the state of the art should be replaced by the international search report for PCT-applications, see under point (u) on Article 122.

(q) Article 80 - Transmission of the report on the state of the art

Should the report on the state of the art be transmitted by the IIB to the European Patent Office and to the applicant simultaneously? (CNIPA, IFIA)

(r) Article 88 - Request for examination

The Working Party considered that the question of whether a request for examination might in future be lodged by a third party, notwithstanding the new text of Article 88, paragraph 2, or whether this possibility should hold good for a transitional period, was one which should be discussed further with the interested circles. (See observations by the FICPI)

(s) Article 111 - Time-limit and form of appeal

Should the period within which the grounds for appeal could be set out in greater detail (Article 111, third sentence) be extended? Should it, if necessary, be fixed by the Board of Appeal? (FICPI, IFIA, UNEPA)
(m) **Articles 66 to 68**
Questions on organisation of the procedure: see under (o) on Articles 77 and 78.

(n) **Article 74 - Effect of priority right**
Should there be a reference in Article 74 to Article 21, paragraph 1? See under (g) on Article 21.

(o) **Article 77 - Examination of the European patent application for formal and obvious deficiencies**

**Article 78 - Notification and refusal of the application**

(i) Who should be responsible for carrying out the formal examination provided for in Article 77, paragraph 1: the EPO, the national receiving Office (in the case of Article 64, paragraph 1(b)), or the IIB? Which parts of the formal examination should be undertaken by which authorities if the work is divided up among them? (ICC, CNIPA, CEIF, EIRMA, UNICE)

(ii) Should the EPO carry out alone the examination for obvious deficiencies provided for in Article 77, paragraph 2, or should the IIB undertake a share of the examination, e.g. examination of unity of invention?(1) (ICC, CNIPA, CEIF, EIRMA, FICPI, UNICE)

(iii) Should not the EPO only enter the proceedings when the IIB has drawn up the search report? (ICC, CNIPA, CEIF, EIRMA; UNICE)

(iv) Would it be advisable to organise co-ordination of the EPO departments responsible for the novelty search with the IIB departments, which were preparing the search reports? (UNICE)

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(1) The majority of the Working Party refused to abandon altogether the examination for obvious deficiencies.
of the opinion that it would suffice to insert in Article 74 a reference to Article 21, paragraph 1. (CNIPA, EIRMA, FICPI, UNICE)

(h) Article 22 - Unitary character of the European patent application
Is it perfectly clear from this provision that a European patent application can be filed jointly by several applicants and that rights limited to certain countries can be assigned to different assignees in proceedings before the European Patent Office? (CEIF)

Apart from this question, the equivalence of the texts in the three languages should be examined. (CEIF)

(i) Article 23 - Assignment of a European patent application
Should the Convention specify that an entry in the European Patent Register had the same effect at national level as an entry in the national register? (CEIF)

(k) Article 28 - Contractual licensing of a European patent application
Should protection be granted to the licensee recorded in the European Patent Register against the proprietor of the application? (CEIF)

(l) Article 66 - Requirements of the application
Should the filing fee be combined with the fee for obtaining the report on the state of the art (Article 79)? (ICC, CNIPA, EIRMA, FICPI)

BR/94 e/71 aut/KM/prk
(d) **Article 15 - Right to the grant of a European patent**

If several people had made an invention independently of each other and had filed applications at different times, should the first application be deemed non-existent if it has been withdrawn or refused before publication? A provision of this nature would (according to EIRMA) make it possible for the person filing the second application to receive a patent notwithstanding Article 11, paragraph 3.

This would not be achieved (according to EIRMA) by deleting the third sentence of Article 15, paragraph 1.

(e) **Article 19 - Rights conferred by a European patent**

application after publication

Should there be a provision, corresponding to Article 29-PCT, that a published European patent application should be accorded at least the same provisional protection as national applications? (CNIPA)

(f) **Article 20 - Extent of the protection conferred by a European patent**

There should be an examination of the equivalence of the texts in the three languages concerning the words "Inhalt der Ansprüche", "terms of the claims" and "teneur des revendications" - also with reference to Article 8 of the Strasbourg Convention of 27.11.1963; if necessary, a legal definition might be introduced. (ICC, CNIPA, EIRMA, UNICE).

(g) **Article 21 - European patents of addition**

Should the beginning of the period for filing an application for a European patent of addition be based on the date of priority of the application for a national patent of addition? Several organisations were...
Apart from the textual amendments referred to under point 79, the Working Party decided to undertake no immediate amendment to the Preliminary Draft on the basis of the observations made by the international organisations, but to adopt the procedure set out under point 77 (recommendation to the Inter-Governmental Conference). The points on which the Working Party recommends acceptance or rejection of the proposal made by the international organisations can be found in the above-mentioned document BR/100/71. The only problems set out below are those for which the Working Party is to recommend further examination.

(a) **Article 9 - Patentable inventions**

Possible new text for Article 9, paragraph 2, especially sub-paragraphs (a), (b) and (e) (observations by CEIF and UNICE);

(b) **Article 11, paragraphs 2 and 3 - Novelty**

Should the expression "contents of earlier applications for European patents" in Article 11, paragraph 3 be aligned more closely on the Strasbourg Convention of 27.11.1963, by being replaced by "contents of applications for European patents, which have earlier filing dates ..."? (PICPI)

(c) **Article 11, paragraph 3 - Novelty**

Should an earlier European application form an obstacle to the grant of a European patent under Article 11, paragraph 3 even where the inventor is the same person in both cases? (so-called Self-collision (PICPI))

The Swedish delegation was asked in this connection to establish by the next meeting whether real difficulties had arisen in the Scandinavian countries in this context.
Article 9 - Patentable inventions

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

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

Article 11 - Novelty

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

Article 13 - Inventive step

25. The Working Party agreed to enlarge the first sentence of Article 13 by aligning it on Article 33, paragraph 3, of the PCT by addition of the words "to a person skilled in the art". The exact time at which the inventive step...
(b) Proposal by the Netherlands delegation concerning Articles 22 ff. (the patent application as an object of property - BR/GT I/95/71)

9. The Working Party agreed with the opinion expressed by the Netherlands delegation in BR/GT I/95/71 that the European patent application in which several Contracting States were designated represented a bundle of reversionary rights or, at the very least, was in effect equivalent to a bundle of such rights. It did not consider it necessary to enter into a discussion about the juridical basis of this opinion.

The practical outcome of this view was that the Working Party agreed to accept the new text of Articles 22 ff. proposed by the Netherlands delegation. It merely made certain textual improvements to this text; in particular, it re-introduced the expression "assignment" of the European patent application in paragraph 1 of Article 23, an expression employed in earlier texts.

10. Furthermore, the Working Party agreed to discuss Articles 22 ff. at a later date with the government legal experts.

(c) Proposal by the French delegation for a new version of Article 64, paragraph 2 (compulsory filing of a European patent application with the national patent office - BR/GT I/100/71)

11. The French delegation pointed out that the former text of Article 64, paragraph 2 could have undesirable consequences in several Contracting States.

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delegations stated that if need be it could even agree to the radical solution of deleting Article 11, paragraph 4.

7. The Working Party accordingly decided, by a majority, to specify in a new Article (Article 137a) that in the event of conflicting applications, as described, the applicant (or patentee if opposition proceedings are involved) may submit different claims for different States.

8. The main question still to be resolved was to what extent the description would have to be amended in the event of the claims being amended. Three possibilities were considered:

(a) The original description would be maintained for the amended claims.

(b) A new description would have to be filed with the amended claims.

(c) The Patent Office could request that a new description be submitted with the new claims.

The Working Party agreed to accept in the first instance the solution under (a), but to give a subsequent hearing to the interested circles on this point.
It was further agreed that it would not be appropriate to grant the patent for all the States designated in the later application. The conflict in question would not be resolved in this way, but be transferred to the scope of national law, which would perforce result in invalidating the European patent in the States designated in the earlier application.

6. Most of the delegations were in favour of a later European patent application being split into two parts, the first covering the States designated in the earlier application, and the second part covering the other States. An applicant would be able to file separate claims under each part of the application, which would then be dealt with separately by the European Patent Office. These delegations admitted that such separate treatment might lead to complicated situations if an application had to be sub-divided into several parts, but they felt this solution would be better than to convert a European application into national applications with regard to the States designated in the earlier application. A disadvantage of the latter course would be that the Contracting States would have to maintain their own patent offices, and this was not desired by all.

Two delegations were in favour of the aforesaid conversion into national patent applications, because they feared that the splitting of the later application as advocated by the majority would become quite complicated, particularly in cases where a later application conflicted with a number of earlier European patent applications, even if such cases were not likely to be frequent. One of these
3. The Working Party adopted the provisional agenda, subject to the inclusion of a sub-item 2(g), under which the Netherlands delegation's note on the amalgamation of the filing fee and the search fee (BR/GT I/104/71) was to be dealt with.

Item 2 on the agenda: Business carried forward from previous meetings of the Working Party (1)

(a) Proposal by the United Kingdom delegation concerning Article 11, paragraph 4 (conflicting European patent applications - BR/GT I/98/71)

4. The Working Party resumed discussion of the problem of how to deal with a later European patent application designating Contracting States, some of which had already been designated in an earlier published European patent application relating to the same object, while others had not.

5. The Working Party agreed that the grant of a patent could not be refused to all the States designated in the later application simply because some of them were designated in the earlier application. Such a solution, which in practice would mean deleting the present paragraph 4 of Article 11, would be too severe for the applicant, with regard to the new States designated in the later application.

(1) The texts which were drawn up as a result of the discussion of item 2 on the agenda are contained in BR/88/71.

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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.

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.../...
Artikel 11
Neuheit
(1) Eine Erfindung gilt als neu, wenn sie nicht zum Stand der Technik gehört.
(2) Der Stand der Technik bildet alles, was vor dem Tag der Anmeldung der Erfindung zum europäischen Patent der Öffentlichkeit durch schriftliche oder mündliche Beschreibung, durch Benutzung oder in sonstiger Weise zugänglich gemacht worden ist.
(3) Als Stand der Technik gilt auch der Inhalt früherer europäischer Patentanmeldungen, die erst an oder nach dem in Absatz 2 genannten Tag veröffentlicht worden sind.
(4) Absatz 3 ist nur dann anzuwenden, wenn ein für die spätere Patentanmeldung benannter Vertragsstaat auch für die frühere gemäß Artikel 85 veröffentlichte Patentanmeldung benannt worden ist.

Artikel 12
Unschädliche Offenbarungen
Eine Offenbarung der Erfindung im Sinne des Artikels 11 bleibt außer Betracht, wenn die Offenbarung innerhalb von sechs Monaten vor Einreichung der europäischen Patentanmeldung erfolgt ist und unmittelbar oder mittelbar zurückgeht:
a) auf einen offensichtlichen Mißbrauch zum Nachteil des Anmelders oder seines Rechtsvorgängers oder

Artikel 13
Erfinderische Tätigkeit
Eine Erfindung gilt als einer erfinderischen Tätigkeit beruhend, wenn sie sich für den Fachmann nicht in naheliegender Weise aus dem Stand der Technik ergibt. Gehören zu dem Stand der Technik auch Unterlagen im Sinne des Artikels 11 Absatz 3, so werden diese bei der Beurteilung der erfinderischen Tätigkeit nicht in Betracht gezogen.

Artikel 14
Gewerbliche Anwendbarkeit
Eine Erfindung gilt als gewerblich anwendbar, wenn ihr Gegenstand auf irgendeinem gewerblichen Gebiet einschließlich der Landwirtschaft hergestellt oder benutzt werden kann.

Article 11
Novelty
(1) An invention shall be considered to be new if it does not form part of the state of the art.
(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing the application for a European patent.
(3) Additionally, the contents of earlier applications for European patents published on or after the date referred to in paragraph 2 shall be considered as comprised in the state of the art.
(4) Paragraph 3 shall be applied only when a Contracting State designated in respect of the later patent application was also designated in respect of the earlier patent application as published under Article 85.

Article 12
Non-prejudicial disclosures
A disclosure of the invention within the meaning of Article 11 shall not be taken into consideration if it occurred within six months preceding the filing of the application for a European patent and if it was due to, or in consequence of:
(a) an evident abuse in relation to the applicant or his predecessor in title, or
(b) the fact that the applicant or his predecessor in title has displayed the invention at official, or officially recognised, exhibitions falling within the terms of the Convention relating to international exhibitions signed at Paris on 22 November 1928 and revised on 10 May 1948.

Article 13
Inventive step
An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 11, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

Article 14
Industrial application
An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.
ZWEITER VORENTWURF EINES ÜBEREINKOMMENS ÜBER EIN 
EUROPÄISCHES PATENTERTeilungsVERFAHREN

sowie
ERSTER VORENTWURF EINER AUSFÜHRUNGSORDNUNG ZUM ÜBEREINKOMMEN 
ÜBER EIN EUROPÄISCHES PATENTERTeilungsVERFAHREN

und
ERSTER VORENTWURF EINER GEBÜHRENORDNUNG

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

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

and
FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

SECOND AVANT-PROJET DE CONVENTION INSTITUANT UN 
SYSTÈME EUROPEÉEN DE DÉLIVRANCE DE BREVETS

ainsi que
PREMIER AVANT-PROJET DE RÈGLEMENT D’EXÉCUTION DE LA CONVENTION 
INSTITUANT UN SYSTÈME EUROPEÉEN DE DÉLIVRANCE DE BREVETS

et
PREMIER AVANT-PROJET DE RÈGLEMENT RELATIF AUX TAXES

— 1971 —
Other delegations, on the other hand, favoured a clause based possibly on the Japanese solution, in order to allay to some extent the anxieties expressed by many organisations.

Finally, the Conference decided to instruct Working Party I to study the consequences of the possible introduction of a clause concerning self-collision and to prepare proposals, if it considered it appropriate, for the next Meeting of the Conference (cf. also observations on Article 21, points 58 and 59 below, on this subject).

40. The Conference also instructed Working Party I to re-examine the wording of Article 11 in the light of the observations made by the interested circles, in particular the written proposals submitted by the ICC (BR/162/72, page 3) and COPRICE (BR/166/72, page 2).

41. The Drafting Committee was instructed to insert in paragraph 3, in accordance with the suggestion made by FICPI (cf. BR/169/72, point 64), a passage to the effect that an application filed on the same day as another application shall not be regarded as an earlier application, in such a way that this provision accords with the principle set forth in Article 68 (Date of filing).
Article 11 (Novelty)

38. Certain delegations requested that, in view of the position adopted by very many organisations in favour of the "prior claim approach", the Conference should once again consider the advisability of abandoning the "whole contents approach" on which the present Article 11 was based.

Other delegations drew attention to the advantages inherent in the system of the "whole contents approach". It was pointed out that the attitude of the interested circles appeared to be governed rather by anxieties with regard to the problem of self-collision.

After a broad exchange of views, the Conference decided by a majority to reject the proposal that the "whole contents approach" be replaced by the "prior claim approach".

39. The Conference then examined the problem of self-collision.

Certain delegations subscribed to the point of view, represented by the proposals of Working Party I, that it was not necessary to make provision for any special clause to this effect in the Convention. Experience of the Scandinavian countries at national level had, in fact, proved that such a solution did not, in practice, remove the difficulties (1).

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(1) Cf. minutes of Working Party I, BR/135/71, point 101 and Annex III to those minutes.

BR/168 e/72 eld/KM/gc
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
to apply only to the parts of the disclosure made in the previous application which tallied with the disclosure made in the application on which priority was based.

Article 13 (Inventive step)

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

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

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

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

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

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

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21. A number of organisations (IAPIP, ICC, and FICPI) criticised the present text of Article 11, paragraph 3, in respect of the fiction of still secret matter contained in an earlier application being considered as comprised in the state of the art. This was a question of approach which would be of importance in interpreting concepts, as the fact that an element of an application formed part of the state of the art would constitute a material obstacle to patentability, whereas the fact that it was already contained in an unpublished application would only be a legal obstacle.

The ICC, in an attempt to minimise this disadvantage without altering the basic principle underlying Article 11, submitted a drafting proposal (BR/162/72, page 3). EIRMA said that it could support this proposal, provided that the word "or" between sub-paragraphs (a) and (b) of paragraph 1 were replaced by "and".

COPRICE also submitted drafting proposals (BR/166/72, page 2).

22. FICPI, supported by IFIA, proposed that in Article 11 and indeed throughout the Convention and the Implementing Regulations, the term "content" (of the application) be replaced by "disclosure".

23. A large majority of the organisations stressed the disadvantages of the whole contents approach in respect of the problem of self-collision.
which might well tempt the applicant to file an application containing a very vague description as a precautionary measure. Delays were possible under this system too, in particular in drawing up a report on the state of the art which would take into account applications which had been filed but not yet published (if the period for claiming priority were taken into account, such a search could not be carried out until twelve months after the application had been filed).

In the light of this support for the prior claim approach, the suggestions made by a number of these organisations on the present text of Article 11 were intended to apply only if the Conference were to decide to retain the whole contents approach.

20. Two organisations (IAPIP and ICC) spoke in favour of the whole contents approach. This approach was also supported by minority groups within other organisations (CEIP, CNIPA, EIRMA and UNICE). It was pointed out that this approach had been recommended by the Banks Report and had proved itself in the systems applied by certain States. ICC drew attention to the advantage it had of allowing the public and industry to envisage more clearly, as soon as an application was published, the protection which was likely to be conferred in certain areas, thus making it easier for competitors to choose how to direct their research and investments. Under the prior claim approach, on the other hand, it was difficult to make a clear assessment of the protection on the basis of the description and claims as originally filed, such an assessment not being possible until the claims had been drawn up in their definitive form, which could involve a considerable delay.

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it would be more appropriate to leave it to the development of practice at the European Patent Office and in the national courts to determine the principles to be applied in this field.

CNIPA in particular urged that if computer programs were nevertheless to be excluded, it should at least be understood that items which were traditionally patentable should not be excluded merely because they contained computer programs.

Article 11 (Novelty)

19. A majority of the organisations (CIFP, COPRICE, CPCCI, EIRMA, FICPI, IFIA, UNIPA and UNICE) favoured the "prior claim approach" being introduced into the Convention. It was pointed out in particular that this approach would eliminate the problem of "self-collision"; it had been applied with satisfactory results for a number of years in several States and only recently had been adopted by French law; it could also operate within a system of liberal interpretation of the claims, as could be seen from experience in Germany. The possibility of a delay in determining the protection conferred was not a substantial drawback in a system under which there was practically no deferred examination. To reduce this possibility, EIRMA suggested that any prior claims should be assumed to be valid, without prejudice to any legal action challenging such an assumption after the grant of the patent.

These organisations also drew attention to the disadvantages of the "whole contents approach", the most serious of these being the possibility of self-collision,
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)
Nordic legislation, no concrete example has been given where application of the whole contents approach would have led to unacceptable results.

In conclusion, the Working Party did not adopt the French delegation's proposal and decided to retain the approach of Article 11 in its present form.

16. The Working Party had been instructed to consider the drafting proposals made by the interested circles (ICC and COPRICE; cf. BR/169/72, point 21). While one delegation was in favour of abolishing the fiction that the content of hitherto unpublished European patent applications was considered as forming part of the state of the art, other delegations pointed out that the adoption of the proposals in question would only lead to the substitution of one fiction for another, and would also require a very considerable number of textual amendments to the Preliminary Draft Convention. In conclusion, the Working Party did not adopt these proposals.

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

17. The Working Party examined the question of whether the last sentence of paragraph 1 should be retained or deleted; this stipulates that if several persons have made an invention independently of each other the right to the European patent shall belong to the first person to file the application (cf. BR/168/72, point 43).
15. During the discussion of the French delegation's proposal the latter stated that the approach it recommended would not necessarily imply that the possibility of obtaining patents of addition should be generally accepted, nor that the renewal fees be waived.

However, it was pointed out that in reality it would be very difficult to limit the granting of patents of addition to cases of self-collision alone.

As regards the proposal as such, doubts were expressed on both the legal structure and the practical use. With regard to legal structure, it was pointed out that the same invention could not be the subject of two patents and therefore the problem of making a distinction between the parent patent and the patent of addition must necessarily arise. It seemed inevitable that in the proposed approach the question of the prior claim approach would arise once more. Moreover, it was stated that this approach could lead to discriminations depending on whether the subsequent application was made by the original applicant or by a third party. With regard to the practical use of a special ruling of this kind for cases of self-collision, it was noted that in reality it was extremely rare for an idea contained in an application to be insufficiently exact to justify a claim and at the same time sufficiently exact to be invoked against a claim developing that idea, within the framework of a subsequent application by the same person. Furthermore, attention was drawn to the possibilities offered by Article 137a. It was also noted that, both in the framework of this Convention and in
2. Prevent two applications, containing parts of the description which are identical, from being maintained by different applicants.

3. Prevent the total duration of the protection being extended.

However, it appeared that the whole contents approach did not meet the first condition, and the prior claim approach did not satisfy the second and third conditions.

Consequently, the French delegation proposed an approach under which, by derogation from Article 11, paragraph 3, the contents of earlier European patent applications would not form part of the state of the art with regard to applications for European patents of addition based on such earlier applications. Conditions 1 and 3 would thus be satisfied, and the second condition could also be satisfied if:

(a) the parent patent and the patent(s) of addition could not be assigned independently of each other.

(b) conversion of the patent of addition into an independent parent patent resulted *ipso facto* in the loss of the derogation mentioned above.

14. The Swiss proposal was not adopted by the Working Party, which considered that this solution would be too far removed from the whole contents approach and would require a complicated specific ruling.
particularly since Article 13 gave the applicant the freedom to include in his application non-inventive variants or developments of anything disclosed in an unpublished application for a European patent. Furthermore, the priority provisions and the facilities offered by Article 137a would allow the applicant satisfactory devices.

12. The Swiss delegation was in favour of providing for a derogation to take sufficient account of reality, where the majority of inventions form part of a continuous line of development by the same inventor. It therefore proposed that the following should be added to paragraph 4:

"and in so far as both patent applications originate from different applicants".

Attention was drawn to the word "originate", which, in the opinion of that delegation, would limit fairly the category benefiting from the exception.

13. Finally, in the document it submitted to the Working Party, the French delegation had set out its ideas on the possibility of using European patents of addition to solve difficulties arising from self-collision. According to that delegation, any solution to the problem of self-collision would have to satisfy the following three conditions:

1. Allow the applicant to base the claims of the second application on a text repeating in part the description of the earlier application.
(d) Finally, the Working Party considered the problem raised by the Netherlands delegation at a previous Working Party meeting, as to whether surgical treatment not intended for therapeutic purposes, but on the contrary for destructive purposes (e.g. the sterilisation of insects) should be explicitly excluded from this provision. The Working Party was of the opinion that treatment of this kind was not in fact intended to be included in this provision, but did not consider it necessary to draft a text stating this explicitly.

Article 11 (Novelty)

10. The Working Party had to examine whether provision should be made within the framework of this Article, for a derogation in the event of the two applications in question being made by the same person ("self-collision"). In this connection, positions were submitted in writing by the Swiss (BR/GT I/146/72), United Kingdom (BR/GT I/150/72) and French (BR/GT I/155/72) delegations, and also by the Chairman (BR/GT I/145/72).

11. The United Kingdom delegation and the Chairman thought that the legal complications of determining exactly where to draw the line and the possibility of infringement which would arise from such a derogation were not sufficiently offset by possible advantages for the applicant. They recalled that the absence of a derogation of this kind would not cause any practical difficulties in Swedish legislation, similar on this point to the Preliminary Draft Convention. Moreover, the United Kingdom delegation pointed out that self-collision presented no real difficulty.
REPORT

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

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

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

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

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

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

BR/177 e/72 cyd/AH/prk
documents as they stood on the priority date (description, claims, drawings), excluding any subsequent amendments or additions, would be considered. The Working Party also considered that this interpretation was sufficiently clearly implied in the text and that there was therefore no need to amend it before the interested circles had stated their position on the matter.

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

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

In opposition to this proposal, it was said that the text in question was aligned on a provision of the Strasbourg Convention and was the result of a compromise between, amongst others, the German and United Kingdom delegations, being part of a version that had been even more precisely worded than the version eventually adopted. It was also pointed out that the proposal would result in a provision of such a general nature as to render it more or less superfluous.
Article 11, paragraph 3 (Novelty)

Article 13 (Inventive step)

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

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

The Working Party were in agreement that the term "the contents of earlier applications for European patents" would have to be interpreted in the sense that the priority date would be decisive as regards anteriority and that only the
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

Brussels, 17 November 1971
BR/135/71

MINUTES

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

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

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

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

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

BR/135 e/71 prk
(Unrevised translation)

.../...
Article 11

Novelty

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

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

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

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

Notes to Article 11 (1), (2) and (3):

1. Paragraphs 1 and 2 correspond to Article 4, paragraphs 1 and 2 of the Strasbourg Convention.

2. Paragraph 3 corresponds to Article 4, paragraph 3, of the Strasbourg Convention.

Note to Article 11 (4):

Cf. Article 137a and the note thereto.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

Brussels, 15th February 1971
BR/88/71

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

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

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

Article 13 (Inventive step)

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

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

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


BR/125 e/71 ley/KM/prk
MINUTES
of the
4th Meeting of the Inter-Governmental Conference
for the setting up of a European System
for the Grant of Patents
(Luxembourg, 20 to 28 April 1971)
Article 52 (11)

Novelty

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

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

(3) Additionally, the content of European patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published under Article 92 on or after that date, shall be considered as comprised in the state of the art.

(4) Paragraph 3 shall be applied only when a Contracting State designated in respect of the later application was also designated in respect of the earlier application as published.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

DRAFT CONVENTION
ESTABLISHING A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Stage reached on 20 May 1972)
The Conference took a decision along these lines, but the United Kingdom delegation did not rule out the possibility of submitting to the Diplomatic Conference a proposal concerning the requirement of industrial application. The French delegation for its part reserved its position with regard to paragraph 3 of Article 50, since it would have preferred the text in Working Document No. 28. The Yugoslav delegation reserved its position entirely with regard to paragraph 5 of Article 52.

**Article 52**

33. The Austrian delegation expressed a reservation concerning the Conference's decision not to lay down specific rules for the case of "self-collision" and not to allow for patents of addition.

34. The Conference had before it a proposal from the United Kingdom delegation concerning paragraph 3 of this Article (cf. BR/210/72). This proposal had previously been examined by the Co-ordinating Committee (cf. BR/218/72, point 6).

35. The Conference recorded its agreement on the conclusions of the Co-ordinating Committee, to the effect that the wording of this paragraph should not be altered.

**Article 68, paragraph 2**

36. The Conference had before it a proposal from the Belgian delegation (cf. Working Document No. 18). This proposal had previously been examined by the Co-ordinating Committee (cf. BR/218/72, point 8).
MINUTES

of the

6th meeting of the Inter-Governmental Conference for the setting up of a European System for the grant of Patents
(Luxembourg, 19 to 30 June 1972)
extended to cover the content of European patents, so that if the translation of the application as published contained less than the original text, the missing elements which were restored during the course of the proceedings would be considered as comprised in the state of the art.

7. The Committee first examined whether it would be advisable to provide that elements missing from the translation into the language of the proceedings and subsequently inserted should only be comprised in the state of the art after the 18-month period pursuant to Article 127, paragraph 4, or whether it should be considered that the fiction of Article 52, paragraph 3, also covered the elements which had appeared in the application in the original language but which had not been translated into the language of the proceedings.

The Committee was unanimously in favour of the second solution, which corresponded to the system laid down in Article 52, paragraph 3.

One delegation then asked whether the wording of Article 52, paragraph 3, ought not to be amended, to avoid any ambiguity, to read: "... the content of European patent applications as filed, either in an official language or in another language, of which the dates ..."

It was considered that the present text already covered this interpretation. The Committee concluded that the clarification proposed by the United Kingdom delegation was unnecessary.
During the discussion it was pointed out that the proposed wording was too restrictive as it only mentioned "a substance", whereas the text of Article 50, paragraph 2(d), also referred to "compounds". Moreover, in a system which allowed the patentability of new substances, it was indispensable that this provision should refer specifically to known substances. It was also observed that the term "medicament" was too restrictive and that reference should be made to use for the purposes of methods referred to in Article 50, paragraph 2(d). While the justification for inserting a new provision of this nature in Article 52 on novelty was not disputed, it was also asked that a provision along the same lines be inserted in Article 50 on patentability, in order to avoid any possible doubt.

Under these circumstances, the Committee considered it preferable to suspend the examination of this point at this stage, to enable the delegations to seek a solution which would take account of all the points raised and which could be submitted to the Conference.

Article 52, paragraph 3

6. Subsequent upon the Co-ordinating Committee's examination at its meeting held from 15 to 19 May 1972 of FICPI's observations, (cf. BR/209/72, page 32), the United Kingdom delegation had submitted a proposal (cf. BR/210/72) intended to fill a gap which it considered had been left open in the system of Article 52, paragraph 3, Article 68, paragraph 2, and Article 92. The United Kingdom delegation proposed that the scope of Article 52, paragraph 3, be
MINUTES

of the

3rd meeting of the Co-ordinating Committee

(Luxembourg, 23, 24 and 27 June 1972)

1. During the 6th Meeting of the Inter-Governmental Conference the Co-ordinating Committee met several times under the Chairmanship of Dr. K. HAERTL to prepare the Conference's discussions of the proposals submitted to it by various delegations.
Den Stand der Technik bildet alles, was vor dem Anmeldetag der europäischen Patentanmeldung der Öffentlichkeit durch schriftliche oder mündliche Beschreibung, durch Benutzung oder in sonstiger Weise zugänglich gemacht worden ist.

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

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

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

Artikel 53
Unschädliche Offenbarungen

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

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


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

Vgl. Regel 23 (Ausstellungsbescheinigung)

Artikel 54
Erfinderische Tätigkeit

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

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

(3) Additionally, the content of European patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published under Article 92 on or after that date, shall be considered as comprised in the state of the art.

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

(5) The provisons of paragraphs 1 to 4 shall not exclude the patentability of a substance or composition mentioned in Article 50, paragraph 3, even when the substance or composition in question is disclosed in the state of the art, provided that the state of the art does not include a disclosure of that substance or composition for any method referred to in Article 50, paragraph 2d).

Cf. Rule 23 (Certificate of exhibition)

Article 54
Inventive step

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the
ZWEITER TEIL
MATERIELLES PATENTRECHT
Kapitel I
Patentierbarkeit

Artikel 50
Patentfähige Erfindungen

(1) Europäische Patente werden für Erfindungen erteilt, die neu sind, auf einer erfinderischen Tätigkeit beruhen und gewerblich anwendbar sind.

(2) Als Erfindungen im Sinn des Absatzes 1 werden insbesondere nicht angesehen:
   a) Entdeckungen als solche sowie wissenschaftliche Theorien und mathematische Methoden;
   b) rein ästhetische Formschöpfungen;
   c) Pläne, Regeln und Verfahren für rein gedankliche Tätigkeiten, für Spiele oder für geschäftliche Tätigkeiten sowie Programme für Datenverarbeitungsanlagen;
   d) Verfahren zur chirurgischen oder therapeutischen Behandlung des menschlichen oder tierischen Körpers und Diagnostizierverfahren, die am menschlichen oder tierischen Körper vorgenommen werden;
   e) die bloße Wiedergabe von Informationen.

(3) Absatz 2 Buchstabe d steht der Patentierbarkeit eines Stoffes oder Stoffgemisches zur Anwendung in einem in der genannten Vorschrift bezeichneten Verfahren nicht entgegen.

Artikel 51
Ausnahmen von der Patentierbarkeit

Europäische Patente werden nicht erteilt für:
   a) Erfindungen, deren Veröffentlichung oder Verwertung gegen die öffentliche Ordnung oder die guten Sitten verstoßen würde; ein solcher Verstoß kann nicht allein aus der Tatsache hergeleitet werden, daß die Verwertung der Erfindung in allen oder einem Teil der Vertragsstaaten durch Gesetz oder Verwaltungsverordnung verboten ist;
   b) Pflanzensorten oder Tierarten sowie für im wesentlichen biologische Verfahren zur Züchtung von Pflanzen oder Tieren; diese Vorschrift ist auf mikrobiologische Verfahren und auf die mit Hilfe dieser Verfahren gewonnenen Erzeugnisse nicht anzuwenden.

Artikel 52
Neuheit

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

PART II
SUBSTANTIVE PATENT LAW
Chapter I
Patentability

Article 50
Patentable inventions

(1) European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.

(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:
   a) discoveries as such, scientific theories and mathematical methods;
   b) purely aesthetic creations;
   c) schemes, rules and methods for performing purely mental acts, playing games or doing business, and programs for computers;
   d) methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body;
   e) mere presentations of information.

(3) The provision of paragraph 2(d) does not exclude the patentability of a substance or composition for use in a method referred to in that provision.

Article 51
Exceptions to patentability

European patents shall not be granted in respect of:
   a) inventions the publication or exploitation of which would be contrary to “ordre public” or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States;
   b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof.

Article 52
Novelty

(1) An invention shall be considered to be new if it does not form part of the state of the art.
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
PATENTVERTEILUNGSVERFAHRENS 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
Artikel 50 Abs. 2, 50 Abs. 3 und 52 Abs. 5

Die in Artikel 50 Abs. 2 enthaltene Aufzählung ist recht zufriedenstellend und berücksichtigt die Vorschläge der interessierten Kreise.

Artikel 50 Abs. 3 stellt eine nützliche Ergänzung des vorangehenden Absatzes dar.

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

8 Artikel 52 Abs. 3 und 54


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

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

Artikel 67 Abs. 1

Der Inhalt dieses Artikels könnte klarer gefaßt

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

The list given in Article 50, paragraph 2, is quite adequate and takes account of the suggestions made by the interested circles.

Article 50, paragraph 3, constitutes a useful addition to the previous paragraph.

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

8 Article 52, paragraph 3 and Article 54

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

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

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

9 Article 67, paragraph 1

This Article could be clarified by deleting the words
STELLUNGNAHME DES
COPRICE
Comité pour la Protection de la propriété industrielle dans la
Communauté économique européenne

COMMENTS BY
COPRICE
Comité pour la Protection de la propriété industrielle dans la
Communauté économique européenne

PRISE DE POSITION DU
COPRICE
Comité pour la Protection de la propriété industrielle dans la
Communauté économique européenne
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN
PATENTERTEILUNGSVERFAHRENS 1973
(München, 10. September bis 6. Oktober 1973)

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

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

________________________

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

________________________

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

________________________

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

________________________

1973
Die STÄNDIGE KONFERENZ möchte sich darauf beschränken, einige wesentliche sachliche Bemerkungen vorzubringen. Sie nimmt zum Wortlaut des Übereinkommensentwurfs wie folgt Stellung:

Artikel 50 — Patentreife Erfindungen

Die STÄNDIGE KONFERENZ legt zu Absatz 2 Buchstaben a, c und d ausdrücklich Vorbehalte ein.

Zu Buchstabe a) Hinsichtlich der Entdeckungen als solche sollte im Übereinkommen präzisiert werden, daß diese Ausnahme nicht für die unbekannten Formen oder Beschaffenheiten von in der Natur vorkommenden Stoffen gilt.

Zu Buchstabe c) Da sich die Frage, ob Programme für Datenverarbeitungsanlagen patentfähig sind, derzeit im Fluß befindet, ist es äußerst gefährlich, für sie im Übereinkommen selbst eine negative Lösung vorzusehen. Die STÄNDIGE KONFERENZ be

Artikel 52 Absatz 3 — Neuheitsschädlichkeit europäischer Patentanmeldungen, die am Einreichungstag nicht veröffentlicht sind

Nach Ansicht der STÄNDIGEN KONFERENZ muß der Stand der Technik strikt durch das definiert bleiben, was vor dem Anmeldetag der europäischen Patentanmeldung der Öffentlichkeit zugänglich gemacht worden ist. Die in Artikel 52 Absatz 3 aufgestellte Fiktion kann zu Verwirrungen führen, insbesondere soweit sie die Anwendung des Artikels 54 beeinflussen könnte. Das Problem, das durch Artikel 52 Absatz 3 gelöst werden soll, liegt nicht in der Beurteilung der Neuheit, sondern in einem Konflikt zwischen zwei Anmeldungen; das Problem muß also unter diesem Gesichtspunkt geregelt werden.

THE STANDING CONFERENCE has decided to confine itself to important basic observations. It would make the following comments on the Draft Convention:

Article 50 — Patentable inventions

The STANDING CONFERENCE has strong reservations on paragraph 2(a), (c) and (d).

Re. (a) With respect to discoveries as such, it should be laid down in the Convention that this exclusion does not apply to unknown forms or states of substances existing in nature.

Re. (c) In view of the fact that the question of the patentability of computer programs is unsettled, it is extremely dangerous for a negative solution to be applied to it in the Convention itself. The STANDING CONFERENCE therefore requests that the provision concerning computer programs be deleted or at least that it be transferred to the Implementing Regulations.

Re. (d) This provision should not be capable of being interpreted as generally comprising a new therapeutic application of known products. As a compromise, the STANDING CONFERENCE could accept a solution similar to that laid down in Article 10 of the French law of 2 January 1968 which provides that the first therapeutic application of an already known product, substance or composition may be patented.

Article 52, paragraph 3 — Possibility of invoking European patent applications not published at the date of filing

In the view of the STANDING CONFERENCE, the state of the art must remain strictly defined by what has been made available to the public before the date of filing of the European patent application. The situation created by Article 52, paragraph 3, could be a source of confusion, in particular since there is a danger that it will influence the application of Article 54. The problem which Article 52, paragraph 3, sets out to cover does not relate to the assessment of novelty but to a conflict between two applications; it is as such that it should be dealt with.
STELLUNGNAHME DER
StKIHK
Ständige Konferenz der Industrie- und Handelskammern
der Europäischen Wirtschaftsgemeinschaft

COMMENTS BY
CPCCI
Standing Conference of the Chambers of Commerce and Industry
of the European Economic Community

PRISE DE POSITION DE LA
CPCCI
Conférence Permanente des Chambres de Commerce et d'Industrie
de la Communauté Économique Européenne
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN PATENTVERTEILUNGSVERFAHRENS 1973
(München, 10. September bis 6. Oktober 1973)

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

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

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

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

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

1973
ARTICLE 16

1. The French text should be improved in order to make it clear that the Receiving Section will cease to be responsible once the two conditions mentioned in Article 16 are both fulfilled.

ARTICLE 18, PARAGRAPH 2

2. This Article provides that the Opposition Division may include one examiner who has taken part in the proceedings for grant of the European patent. It should be specified that this examiner may be neither the Chairman nor the rapporteur of the Opposition Division.

ARTICLE 31, PARAGRAPH 1(a)

3. Under this Article the Administrative Council may decide that any Examining Division may be composed of only one technical examiner. In general UNICE would wish the Examining Divisions to be composed of three technical examiners.

ARTICLE 52, PARAGRAPH 5

4. The present wording could lead to a substance used in human medicine no longer being patentable for veterinary medicine and vice versa under the "first disclosure" rule. To avoid this effect, which is certainly not intended, the wording of Article 52, paragraph 5, should be clarified.

ARTICLE 58, PARAGRAPH 1

5. This provision would be rendered clearer if the two questions which it covers were dealt with in two separate sub-paragraphs.

ARTICLE 67, PARAGRAPH 2

6. Although this provision solves the problem of provisional protection in cases of a limitation or extension of the claims, it would appear that the problem of provisional protection in the case of a shifting of claims remains open. In the latter case provisional protection on the basis of the claims first filed would not be justified and this point should therefore be clarified.
STELLUNGNAHME DER
UNICE
Union der Industrien der Europäischen Gemeinschaft

COMMENTS BY
UNICE
Union des Industries de la Communauté européenne

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

(1) Deutsche Übersetzung der Stellungnahme und der Anlage 2 vorgelegt von UNICE
(2) Annex 3 to these Comments submitted by UNICE in English
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN
PATENTETERTEILUNGSVERFAHRENS 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
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(1973)
(Munich, 10 septembre - 6 octobre 1973)

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PRISES DE POSITION
sur les documents préparatoires
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1973
7. **Article 38, par. 4:**

Certain international applications (PCT-applications) in respect of which a Contracting State is designated, will not be communicated (under article 20 of the PCT-Treaty) to that State because of a withdrawal of its designation or will not reach that State when the applicant does not furnish a copy of the international application under Article 22 PCT. In our opinion those international applications cannot be taken into account for the purpose of paragraph 3 of Article 38. Therefore we propose to read paragraph 4 of Article 38 as follows:
"For the purpose of paragraph 3 international applications received by any State as designated State shall be regarded as applications filed in that State."

8. **Article 50, par. 3:**

In order to avoid the possibility that this paragraph is interpreted to exclude a contrario the patentability of any product other than a substance or composition for use in therapeutical treatment (like a medical instrument), we propose to draft Article 50, par. 3, as follows:
"The provision of paragraph 2(d) does not exclude the patentability of any product, in particular any substance or composition, for use in a method referred to in that provision".

9. **Article 52, par. 5:**

We are of the opinion that Article 52, par. 5, without changing its meaning, can be clarified and lined up with the provision of Article 50, par. 3, as follows:
"The provisions of par. 1-4 shall not exclude the patentability of any substance or composition, disclosed as such in the state of the art, for use in a method referred to in Article 50, par. 2(d), provided that its use for no such method has been disclosed in the state of the art."

10. **Article 59:**

The title seems to connect this Article 59 with Article 56, whereas in fact Article 59 is related to the matter dealt with
MUNICH DIPLOMATIC CONFERENCE

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

- 1973 -

Brussels, 1 June 1973
M/32
Original: English

PREPARATORY DOCUMENT

Drawn up by: Netherlands Government

Subject: Observations and proposed amendments concerning the Draft Convention and the Draft Implementing Regulations
7. Proposal of the Netherlands Delegation to Article 52, paragraph 5.

Article 52, paragraph 5 should be amended to read:

"The provisions of paragraph 1 to 4 shall not exclude the patentability of any substance or composition, disclosed as such in the state of the art, for use in a method referred to in Article 50, paragraph 2 (d) provided that its use for no such method has been disclosed in the state of the art."

See also the Netherlands proposal to Article 50, paragraph 3
6. Proposal of the Netherlands Delegation to Article 50, paragraph 3

Article 50, paragraph 3 should be amended to read:

"The provision of paragraph 2 (d) does not exclude the patentability of any product, in particular any substance or composition, which can be used for a method referred to in that provision."

See also the Netherlands proposal to Article 52, paragraph 5.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 10 September 1973

M/52/I/II/III
Original: English

CONFERENCE DOCUMENT

Drawn up by: Netherlands delegation

Subject: Proposals for amendments to the draft texts
Proposal: The first part of paragraph 2 of Article 74 should be replaced by the following text:

"(2) The whole technical content of a European divisional application or of a European patent granted on the basis thereof shall not extend beyond the content of the earlier application as filed; in so far ...".

Reason: Since the Inter-Governmental Conference has decided in favour of the "whole content approach" (Article 52, paragraph 3), all the consequences must be taken into consideration:

(a) In Article 53, paragraph 1 there is no justification to limit the preclusive period to 6 months before the date of filing because otherwise it would only apply with reference to Article 5 paragraph 2 and not to paragraph 3. (In support of the United Kingdom proposal in M/10, No. 8).

(b) In accordance with Article 74, paragraph 2, European divisional applications are to receive the date of filing of the earlier application; they are therefore added "retrospectively" to the state of the art within the meaning of Article 52, paragraph 3. In relation to other applicants it would be unjust to allow technical matter, such as new methods of carrying out the invention, examples, diagrams etc. which were not contained in the earlier application, to become part of the state of the art. Divisional applications should therefore be backdated, only when their whole technical content is taken substantively from the earlier application. However, the "whole content approach" does not disallow deviations in drafting only from the earlier application and even allows changes to a particular passage of the description in the earlier application to a claim in the divisional application.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

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

CONFERENCE DOCUMENT

Drawn up by: The Swiss delegation

Subject: Proposals for amendments to the draft texts
Article 52
Novelty

(1)

(2) Unchanged from 1972 published text.

(3) Only concerns German text.

(4) Unchanged from 1972 published text.

The provisions of paragraphs 1 to 4 shall not exclude the patentability of any substance or composition, disclosed in the state of the art, for use in a method referred to in Article 50, paragraph 4, provided that its use for any method referred to in that paragraph has not been disclosed in the state of the art.
MUNICH DIPLOMATIC CONFERENCE

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

- 1973 -

Munich, 13 September 1973
M/ 74/I/R 1
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 12 SEPTEMBER 1973

Articles of the Convention:

Article 14
Article 50
Article 52
Article 53
Article 58
Article 59
Article 63
Article 65
Article 68
Article 87

Rules of the Implementing Regulations:

Rule 1
Rule 2
Rule 13
Rule 16
Article 52

Novelty

(1) } Unchanged from 1972 published text.
(2) }

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

(5) The provisions of paragraphs 1 to 4 shall not exclude the patentability of any substance or composition, disclosed in the state of the art, for use in a method referred to in Article 50, paragraph 4, provided that its use for any method referred to in that paragraph has not been disclosed in the state of the art.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 17 September 1973

M/88/I/R 3
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 15 SEPTEMBER 1973

Articles of the Convention:

| Articles | 52 | 53 | 63 | 86 | 87 | 95 | 104 | 105 | 107 | 108 | 111 | 113 | 115 | 116 | 120 | 121 | 122 | 123 | 124 | 125 | 128 | 130 | 131 | 132 | 135 |

Rules of the Implementing Regulations:

| Rules | 56 | 65 | 73 | 96 |
Article 52

Novelty

(1) Unchanged from 1972 published text.

(2) Only concerns German text.

(4) Unchanged from 1972 published text.

(5) The provisions of paragraphs 1 to 4 shall not exclude the patentability of any substance or composition, disclosed in the state of the art, for use in a method referred to in Article 50, paragraph 4, provided that its use for any method referred to in that paragraph has not been disclosed in the state of the art.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

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

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

Articles of the Convention:

Articles 52
153
157
Article 52

Novelty

(1) } Unchanged from 1972 published text.
(2) }

(3) Only concerns German text.

(4) Unchanged from 1972 published text.

(5) The provisions of paragraphs 1 to 4 shall not exclude the patentability of any substance or composition, disclosed in the state of the art, for use in a method referred to in Article 50, paragraph 4, provided that its use for any method referred to in that paragraph has not been disclosed in the state of the art.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 27 September 1973
M/136/I/R 10

Original: English/French/German

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

Articles of the Convention:

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Article 52 S4

Novelty

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

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

(3) Additionally, the content of European patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published under Article 93 on or after that date, shall be considered as comprised in the state of the art.

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

(5) The provisions of paragraphs 1 to 4 shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Article 52, paragraph 4, provided that its use for any method referred to in that paragraph is not comprised in the state of the art.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/146/R 2

Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Convention: Articles 27 to 54
I. The Committee of the Whole decided unanimously to forward to the Plenary the texts of the European Patent Convention, the Implementing Regulations and the four Protocols annexed to the Convention, as they appear in M/146/R 1 to 14, subject to the following amendments. (the references have been amended and typing errors and the punctuation have been corrected in the printed text, but not in the present document):

**Convention:**

**Article 1 (new title)**

European law for the grant of patents

Text unchanged

**Article 54**

(4) ... in so far as a Contracting State ...  

**Article 55**

... 22 November 1928 and last revised on 30 November 1972.

**Article 66**

Only concerns German text

**Article 76**

(1) ...; in so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and ...

**Article 88**

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

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee
Subject: Amendments to the texts of document M/146/R.1 to 15
official languages instead of only the language of the proceedings.

2. Patentability (Articles 50-55)

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

II. Report on the work of Main Committee II

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

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

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

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

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

13. The Austrian delegation suggested that in the English version of point 22, in the middle of page 14, the words "some search work" be used so as not to preclude the possibility that the amount of such search work, which had deliberately been left open. The text would therefore read: "difficulties resulting from a renunciation under Section 12, to entrust some search work to national offices whose language is ...".

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

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

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

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

15. Main Committee III's rapporteur, Mr. Fressonnet, Deputy Director of the National Intellectual Property Office
MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Munich, 10 September to 5 October, 1973)

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Article 54 (56) — Inventive step

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

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

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

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

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

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

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

83. Finally, the Chairman noted that the Swiss proposal was supported by none of the Government delegations and was therefore rejected.
Article 51 (53) — Exceptions to patentability

44. The Swiss delegation pointed out that under sub-paragraph (a) patents could not be granted for inventions, the publication or exploitation of which were contrary to “ordre public” or morality. In most instances this provision would not fulfill its purpose because at the examination on filing and the examination as to formal requirements, no check was made on whether the publication of the invention was contrary to “ordre public” or morality and, consequently, the application would normally be published in full. If, however, such an application had already been published, there would no longer be any point in refusing the patent or even revoking a patent which had already been granted. It therefore requested (M/54/II/III, page 7) either the deletion of the words “publication or” in Article 51 (53), sub-paragraph (a) or alternatively changing Rule 34, paragraph 2, into a mandatory provision.

45. The Chairman drew attention to the fact that if the main proposal were accepted, the European Patent Office would be obliged to grant patents the publication of which was contrary to morality and that once patents had been granted it would no longer be possible to revoke them on account of such an infringement.

46. The Swiss delegation withdrew its main proposal. However, it maintained its subsidiary request concerning Rule 34, paragraph 2 (see below points 2226 et seq.).

47. In connection with Article 51 (53) the Turkish delegation said that it proposed to raise the question of the patentability of methods used to obtain medicines, foodstuffs and fertilisers and question of the patentability of chemical substances when the Main Committee discussed the final provisions.

Article 52 (54) — Novelty

48. The IAPIP delegation requested that paragraph 3 be drafted in such a way that a previous application which was published later did not form part of the state of the art, if filed by the same applicant as filed the later application.

49. The Chairman noted that none of the Government delegations wished at this point to raise the problem of “self-collision”.

50. The Belgian delegation asked whether it was clear from paragraph 4 that paragraph 3 was only to be applied if the Contracting State designated in the later application was also designated in the earlier published application and that paragraph 3 did not apply to a Contracting State which had not been designated in the earlier application.

51. The Main Committee affirmed that this was clear, in agreement with the United Kingdom delegation, which drew attention to Rule 88 (87), according to which different claims could be presented for different Contracting States.

52. In order to make this situation quite clear, the Main Committee decided at a subsequent meeting, at the request of the Netherlands delegation, to reword the first words of paragraph 4 as follows: “Paragraph 3 shall be applied only in so far as...”.

53. At the request of the Netherlands delegation, the Main Committee stated that, further to paragraph 4, the words “a Contracting State designated in respect of the later application, was also designated in respect of the earlier application as published” were to be understood as follows: if the designation of a State which appeared in the earlier application as published is later withdrawn, that State may no longer be designated in respect of the later application.

54. The Netherlands delegation proposed that the wording of paragraph 5 (M/32, point 9) should be improved. It said that on no account did it wish, with its proposal, to break away from the principle that only the first application in respect of the use of a known substance or composition in a method for treatment of a human or animal body by surgery or therapy is patentable, and not the second and subsequent applications.

55. The Main Committee referred the proposal to the Drafting Committee.

56. The Yugoslav delegation also considered that the present text of paragraph 5 was insufficently clear and asked the meaning of the words “even when the substance or composition in question is disclosed in the state of the art”.

57. The Chairman replied to the Yugoslav delegation and said that, in his opinion, the aim in paragraph 5 was to make clear that a known substance (or a known composition) which, since it formed part of the state of the art, was no longer patentable, nevertheless could be patented for the first use in a method for treatment of the human or animal body by surgery or therapy; however, a further patent could not be granted if a second possible use were found for the same substance, irrespective of whether the human or animal body was to be treated with it.

58. The Chairman noted that his views were shared by the Government delegations.

59. The UNICE delegation said that although it also shared these views, it had understood until now that a known substance which was patentable for its first use in a method for treatment of the human body, had also to be patentable for a first use, which was found subsequently, in a method for treatment of the animal body, and vice versa.

60. The Chairman noted that the Main Committee did not wish to endorse this interpretation.

Article 53 (55) — Non-prejudicial disclosures

61. At the Netherlands delegation’s request the Chairman noted that the Main Committee was agreed that in the introductory part of paragraph 1 the “date of filing” should be understood as the actual date on which the patent application was filed. The Drafting Committee subsequently amended paragraph 1 accordingly.

62. The United Kingdom delegation pointed out that the existing text of paragraph 1, which was taken from Article 4, paragraph 4, of the 1963 Strasbourg Convention on the Unification of Certain Points of Substantive Law on Patents for Invention, contained a loophole; it proposed substituting the words “not more than six months preceding the date of filing” for the phrase “within six months preceding the date of filing” (M/10, point 8).

63. In order to illustrate the problem raised by the United Kingdom delegation, the Chairman gave the following two examples: a European patent application is fraudulently filed on 1 January 1980 and published on 1 July 1981. On 1 October 1981 an application relating to the same subject-matter is filed.
Article 50 (52) — Patentable inventions


17. The FICPI delegation feared that in paragraph 2(c) the term "programs for computers" might be broadly interpreted in the future. There was a danger that the structures or algorithms on which such programs were based would also not be considered an invention. This could give rise to problems for large sections of industry operating in the field of data processing in particular or of communications technology in general. And, in any case the Conference should be on its guard against excluding from being patentable certain technologies which had not even been thought of today.

18. As regards this comment the Chairman recalled that the Luxembourg Inter-Governmental Conference had already tried in vain to define the term "programs for computers". The European Patent Office would simply have to be relied upon subsequently to interpret this expression unequivocally.

19. The Italian delegation considered that the English expression "computer" denoted a much more complex system than the German term "Datenverarbeitungsanlage" and the French expression "ordinateur". It was therefore perhaps appropriate to choose the phrase "data handling systems" in the English version.

20. The United Kingdom delegation stated in this connection that in its view the expression "computer" should be retained in English, even though linguistically it could mean more than a simple piece of calculating equipment. The definition of such terms could safely be left to the practical work of the European Patent Office.

21. The Austrian delegation proposed examining the German text with a view to ascertaining whether the expression "Datenverarbeitungsanlage" was not too broad a term compared with the English expression "computer" and the French term "ordinateur". Otherwise there was perhaps a danger that this provision would be interpreted too broadly on the basis of the German text.

22. The Main Committee finally agreed to retain the English term "computer" as the appropriate expression. It also requested the Drafting Committee to examine whether a more restrictive term could perhaps be found instead of the German expression "Datenverarbeitungsanlagen".

23. With reference to paragraph 2, sub-paragraph (d) (now paragraph 4, first sentence), the Main Committee endorsed the United Kingdom delegation's interpretation of the text (see M/10, point 6) whereby "treatment of the animal body by therapy" means the treatment of illness or disease and not, for example, treatment effected with a view to increasing the quality or quantity of the production of an animal product.

24. The delegation of the Federal Republic of Germany proposed (M/11, point 21) making the content of paragraph 2(d) into a new first sentence of paragraph 4, since in the case of methods for treatment by surgery or therapy actual inventions were involved for which only the industrial application was lacking, whereas the subject-matter or activities referred to in sub-paragraphs (a), (b) and (c) would not in practice be considered as inventions.

25. The IAPIP delegation, supported by the Belgian, French and Netherlands delegations, proposed simplifying the German delegation's proposals still further by deleting paragraph 3 and including the substance thereof at the beginning of paragraph 2. It promised to put forward a written proposal about this.

26. The Main Committee decided to forward the German proposal, along with the IAPIP drafting proposal which would be submitted later (subsequent M/66/1), to the Drafting Committee.

27. The CNIPA delegation, supported by the United Kingdom and Irish delegations, was in favour of transferring sub-paragraphs (c), (d) and (e) to the Implementing Regulations in order to be able to take more account of scientific and technological developments (see M/20, point 10).

The United Kingdom delegation pointed out that the questions about patentability which were dealt with here were also primarily politico-legal matters which were the responsibility of the Administrative Council in its capacity as the political body of the Patent Organisation.

28. The Netherlands delegation considered that, without wishing to take up a position on the problem itself, the same result could be achieved by supplementing Article 31 (33), whereby the Administrative Council was competent to amend certain provisions of the Convention.

29. The delegation of the Federal Republic of Germany thought it was inadmissible, as a matter of principle, for the question of the patentability of such subject-matter or activities to be left to the Administrative Council to settle.

30. The Yugoslav delegation, too, believed there was little likelihood of such an arrangement being accepted for the additional reason of legal certainty.

31. The Swedish and Portuguese delegations also shared the German delegation's views.

32. Furthermore, the French delegation pointed out that Article 50 (52) was a fundamental Article of the Convention. The provisions governing patentability laid down in this Article should not be left to the Administrative Council, the latter ought not to be able, irrespective of the legal and technical means employed, to amend the individual provisions on its own responsibility.

33. The Swiss delegation was also against transferring the three provisions mentioned to the Implementing Regulations. It emphasised that if the CNIPA proposal were adopted, the Administrative Council would also be afforded the possibility, which nobody wanted, of adding new conditions relating to patentability to the Convention and of amending the grounds for revocation connected with Article 50.

34. Consequently, the United Kingdom delegation renounced the idea of transferring sub-paragraphs (c), (d) and (e) to the Implementing Regulations.

35. The delegation of the Federal Republic of Germany proposed (M/11, point 21) transferring paragraph 3, which at the moment related solely to substances and compositions for use in a method for treatment by surgery or therapy, to the proposed new paragraph 4 as the second sentence. The proposal was referred to the Drafting Committee.

36. The Netherlands delegation proposed (M/32, point 8) making it clear in paragraph 3 that a medical instrument for use in a method for treatment by surgery or therapy was patentable.

37. The delegation of the Federal Republic of Germany said that, although it considered the existing text sufficiently clear on this point, it did not wish to oppose the proposal.

38. The Main Committee adopted the proposal which was supported by the United Kingdom and the French delegations.

39. The Main Committee also discussed the proposal by the Netherlands delegation (M/52/11/II/III, point 8) that the words "any substance which can be used for a method" be substituted for "a substance for use in a method".

40. The United Kingdom delegation was not in favour of this wording. It said that the purpose of paragraph 3 was to make it clear that a claim for a product for use in a method for treatment by surgery or therapy should be patentable, even if the method itself in which such a product was used was not
are not based on written proposals are not mentioned as a general rule.

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

A. General

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

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

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

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

The Main Committee agreed with this interpretation.

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

Article 14 — Languages of the European Patent Office

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

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

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

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

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

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

The Turkish delegation said it was satisfied with this explanation and withdrew its proposal.
MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Munich, 10 September to 5 October, 1973)

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Bonn, 14 March 1961

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