

WIPO



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**PATENT COOPERATION TREATY**

**INTERIM ADVISORY COMMITTEE FOR ADMINISTRATIVE QUESTIONS**

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REPORT ON THE RESULTS OF THE  
MUNICH DIPLOMATIC CONFERENCE FOR THE SETTING  
UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

prepared by the International Bureau

Introduction

1. From September 10 to October 5, 1973, the Diplomatic Conference for the Setting Up of a European System for the Grant of Patents took place in Munich at the invitation of the Government of Germany (Federal Republic of). The preparatory work for the Munich Diplomatic Conference had been accomplished by the Inter-Governmental Conference for the Setting Up of a European System for the Grant of Patents which had met periodically between 1969 and 1972 and in which twenty-one States had participated, namely the nine member States of the European Economic Community (Belgium, Denmark, France, Germany (Federal Republic of), Ireland, Italy, Luxembourg, Netherlands and the United Kingdom) as well as twelve other States (Austria, Finland, Greece, Liechtenstein, Monaco, Norway, Portugal, Spain, Sweden, Switzerland, Turkey and Yugoslavia). WIPO had the opportunity to follow the preparatory work very closely since it was invited to participate in the sessions of the Inter-Governmental Conference and of its major Working Parties as an observer. The same twenty-one States also participated in the Munich Diplomatic Conference; moreover, four intergovernmental organizations (Council of Europe, Commission of the European Communities, International Patent Institute, and WIPO) as well as sixteen non-governmental organizations from interested circles were represented in the Diplomatic Conference. The representatives of WIPO (present, with one exception, for only part of the time) were the following: Professor G.H.C. Bodenhausen, Director General; Dr. A. Bogsch, First Deputy Director General; Mr. K. Pfanner, Senior Counsellor, Head of the Industrial Property Division; Mr. L. Baeumer, Counsellor, Head of the Legislation and Regional Agreements Section, Industrial Property Division; and Mr. J. Kohnen, Legal Officer, PCT Section, Industrial Property Division.

2. The Diplomatic Conference concluded with the adoption of the Convention on the Grant of European Patents (hereinafter referred to as "the Convention") signed on October 5, 1973, by the following fourteen States: the nine member States of the European Economic Community plus Greece, Liechtenstein, Norway, Sweden and Switzerland. The Convention will remain open for signature until April 5, 1974.

In addition, the Munich Diplomatic Conference adopted the following instruments: the Implementing Regulations, the Protocol on Jurisdiction and the Recognition of Decisions in Respect of the Right to the Grant of a European Patent (Protocol on Recognition), the Protocol on Privileges and Immunities of the European Patent Organization (Protocol on Privileges and Immunities), the Protocol on the Centralisation of the European Patent System and on its Introduction (Protocol on Centralisation), and the Protocol on the Interpretation of Article 69 of the Convention. Finally, the Munich Diplomatic Conference passed several resolutions, in particular a resolution on technical assistance to developing countries.

3. The Convention provides for the setting up of a "European Patent Organisation" whose task will be to grant "European patents"; this task will be performed by a "European Patent Office" which will act under the supervision of an Administrative Council and will be established in Munich, with a branch in The Hague. European patents will be granted upon European patent applications which have to be filed in English, French or German, either directly with the European Patent Office or with the national office of a Contracting State, and which must contain the designation of the Contracting States for which protection is sought. For each European patent application a European search report will be drawn up, which will be published together with the application, as soon as possible after the expiry of eighteen months from the priority date. Within six months from that publication, the applicant may request examination of the application. The granted European patents will have in the designated States the same effects as national patents; the Contracting States, however, are bound to apply a uniform duration of protection (twenty years from the filing date) and a uniform standard for revocation.

4. In addition to the Convention adopted by the Munich Diplomatic Conference, the member States of the European Economic Community plan to conclude, in a Diplomatic Conference to be held at Luxembourg in the spring of 1974, a second Convention, which will provide for a system of mandatory joint designation of the said group of States and uniform effects of European patents in the whole territory of the European Economic Community.

#### Relationship with Instruments Administered by WIPO

5. The Convention adopted by the Munich Diplomatic Conference is of particular interest to the members of the Paris Union since express references are made in it to the Paris Convention for the Protection of Industrial Property, the Patent Cooperation Treaty and the Strasbourg Agreement Concerning the International Patent Classification. It can be stated that all these instruments were taken into consideration during the preparation of the Convention, as well as at the Diplomatic Conference, and that WIPO was continuously consulted on these matters.

#### Compatibility with the Paris Convention

6. The provisions of the Paris Convention for the Protection of Industrial Property (Paris Convention) have been taken fully into account in the Convention. The Preamble states that the Convention constitutes a special agreement within the meaning of Article 19 of the Paris Convention. The principle of national treatment stated in Article 2 of the Paris Convention is implemented in Article 58 of the Convention, which permits the filing of European patent applications not only by nationals and residents of the Contracting States to the Convention, but by nationals and residents of any State. The priority right provided for in Article 4 of the Paris Convention is implemented, in compliance with the Stockholm Act of the Paris Convention, in Articles 87 to 89 of the Convention and Rule 38 of the Implementing Regulations. Thus, the substantive provisions of the Stockholm Act of the Paris Convention concerning priority rights with respect to inventors' certificates have also been fully respected.

#### Harmonization with the Patent Cooperation Treaty

##### I. In general:

7. The harmonization between the Convention and the Patent Cooperation Treaty (PCT) is of special importance since both instruments have essentially the same aim, namely, to simplify and render more economical the obtaining of protection for inventions where such protection is sought in respect of several countries.

The PCT promotes that aim by a system of international filing, searching and publication of applications as well as by their international preliminary examination with a subsequent continuation of national or regional procedures for the grant of patents or similar titles of protection. The system envisaged by the Convention provides for the grant of regional patents on the basis of a centralized procedure. The PCT expressly recognized the possibility of combining the PCT procedure with a regional patent system in a way that allows for the grant of regional patents on the basis of PCT applications. The Convention makes use of this possibility and implements it in a very satisfactory way, thanks to the express desire of the Inter-Governmental Conference and the Munich Diplomatic Conference to take the aims of the PCT into account and to the thorough preparatory work of the said Conferences. A special chapter of the Convention contains provisions which, in full conformity with the PCT, establish the basis for the continuation of the procedure initiated by an international application under the PCT with a procedure for the grant of a European patent. Moreover, the Convention on the whole reflects a considerable degree of harmonization, if not uniformity, with the PCT in so far as procedural provisions are concerned. The provisions on the form and content of the European patent application have been drafted in such a way that they are almost fully harmonized and even to a certain extent identical with the relevant provisions under the PCT. The high degree of harmonization between the two systems, which was achieved thanks to the spirit of international cooperation guiding the work of the Inter-Governmental Conference and the Munich Diplomatic Conference, has been particularly welcomed by WIPO. It will permit the practical implementation of a procedure for conjunctive use of the PCT and the European patent system, which will allow the advantages offered to applicants by both systems to be combined and thus benefit users of the patent system in all Contracting States of the PCT.

## II. Specific areas of harmonization:

### A. Functions of the European Patent Office under the PCT

8. Article 151 provides the possibility for the European Patent Office (hereinafter referred to as the EPO) to act as a receiving Office for residents or nationals not only of Contracting States to the Convention but also of non-Contracting States.
9. The EPO will act as a designated Office and as an elected Office under Articles 153 and 156, respectively, for those Contracting States to the Convention which are designated or elected in an international application taking the European route.
10. Article 154(1) empowers the EPO to act as an International Searching Authority for PCT applicants who are residents or nationals of Contracting States to the Convention. Paragraph (2) of the same Article sets forth in broad terms the possibility that the EPO may act as an International Searching Authority for any other PCT applicant, thus covering the possibility that the EPO may act as an International Searching Authority for PCT applicants from a State party to the PCT but which is not a Contracting State to the Convention and also for PCT applicants admitted by the Assembly under Article 9(2) of the PCT and for whom the EPO is appointed under Rule 19.1(c) of the PCT to act as receiving Office. It should be noted that the International Patent Institute in The Hague will, in accordance with Section I of the Protocol on Centralisation, be incorporated into the European Patent Organisation as part of the branch of the EPO to be established in The Hague. Under paragraph (2) of the said Section, the States parties to the Convention renounce in favor of the EPO any activities as International Searching Authorities, subject, however, to certain exceptions stated in Section III.
11. Article 155(1) empowers the EPO to act as an International Preliminary Examining Authority for PCT applicants who are residents or nationals of those Contracting States to the Convention which are bound by Chapter II of the PCT. Paragraph (2) of the same Article sets forth in broad terms the possibility that the EPO may act as an International Preliminary Examining Authority for any other PCT applicant, thus covering the possibility that the EPO may act as an International Preliminary Examining Authority for PCT applicants from a State party to the PCT and bound by Chapter II but which is not a Contracting State to the Convention and also for PCT applicants admitted by the Assembly under Article 31(2)(b) of the PCT and for whom the EPO is appointed under Rule 59.2 of the PCT to act as the International Preliminary Examining Authority. It should also be noted that under Section II of the

Protocol on Centralisation the States parties to the Convention renounce in favor of the EPO any activities as International Preliminary Examining Authorities, subject, however, to certain exceptions stated in Sections III and IV.

12. In connection with the functions of the EPO under the PCT, Article 150(2) makes it clear that, in respect of international applications which are the subject of proceedings before the EPO, the provisions of the PCT will be applied, supplemented by the provisions of the Convention. In the case of conflict, the PCT provisions will prevail.

B. Comparison of the Form and Content of the European Patent Application and the International Application

13. The elements comprising the European patent application under Article 78(1) (namely: a request, a description, one or more claims, drawings, and an abstract) are the same as those of the international application under Article 3(2) of the PCT.

14. The provisions governing the content of the request for grant set forth in Rule 26 correspond essentially to those of Rule 4 of the PCT.

15. Except for Rule 27(f), where it was considered that it would be too limiting to restrict the description in the European patent application to the best mode as provided for in Rule 5.1(a)(v) of the PCT, the content of the description required under Rule 27 is substantially the same as that in Rule 5 of the PCT.

16. The standard governing the substance of the claims which is set forth in Article 84 is the same as that in Article 6 of the PCT. The form and content of the claims set forth in Rule 29 are essentially aligned on those provided for in the corresponding PCT provisions. Thus, the manner of claiming set forth in Rule 29(1) is identical with Rule 6.3 of the PCT, except for the statement indicating the designation of the subject matter of the invention. Also, as to the number of claims allowed, it is noted that Rules 29(2) and (3) correspond to Rules 13.3 and 13.4 of the PCT. The only notable variance between the Convention and the PCT in respect of the provisions governing the claims is that Rule 29(4) is not restricted, as is the case of Rule 6.4(a) of the PCT, to multiple dependent claiming in the alternative.

17. The form of the drawings set forth in Rule 32 is practically identical with that provided in Rules 11.6(c), 11.11 and 11.13 of the PCT.

18. The purpose of the abstract set forth in Article 85 is the same as the purpose served by the abstract under Article 3(3) of the PCT. The required form and content of the abstract under Rule 33, except for the indication of the title of the invention under Rule 33(1), are the same as those required under Rules 8 and 3.3(a)(iii) of the PCT.

19. It is to be noted that Rule 34 dealing with prohibited matter corresponds to Article 21(6) and Rule 9 of the PCT. Furthermore, the general provisions governing presentation (i.e. physical requirements) of the application set forth in Rule 35 are practically identical in substance with the requirements of Rules 10 and 11 of the PCT.

C. Comparison of Certain Procedural Matters in the Processing of European Patent Applications and International Applications

20. The examination on filing, particularly the determining under Article 90(1)(a) whether the application satisfies the requirements set forth in Article 80 for the accordancy of a filing date, corresponds and is similar to the check under Article 11(1) of the PCT for according an international filing date.

21. The various formal requirements of the European patent application to be examined are collectively set forth in Article 91 whereas in the PCT the corresponding requirements are contained in separate provisions. The examination as to formal requirements under Article 91(1)(b) to (d) corresponds and is similar to the formalities check under Article 14(1) of the PCT. Furthermore, the examination as to formal requirements under Article 91(d) concerning the priority claim, Article 91(e) concerning the designation fees, Article 91(f) concerning the inventor, and Article 91(g) concerning the drawings is paralleled, respectively, by Rule 4.10, Article 14(3), Article 4(1)(v), and Article 14(2) of the PCT.

22. The requirement as to unity of invention under Article 82 is the same as that in Rule 13.1 of the PCT. The different categories of claims set forth in Rule 30 which are permissible under the requirement of unity of invention are the same as those provided for under Rule 13.2 of the PCT, except for the combination permitted under Rule 30(c), where the intent was to be more liberal than the PCT. Under Rule 46(1) the procedure applied where unity of invention is lacking is similar to the procedure under Article 17(3)(a) of the PCT in that the search proceeds on the invention first mentioned in the claims and in that other inventions are searched if additional fees are paid. The procedure under Rule 46(2) providing for a review of a protested payment of additional fees is in line with that provided in Rule 40.2(c) of the PCT.

#### D. European Search Report and the International Search Report

23. Article 157 of the Convention states the principle of replacement of the European search report by the international (PCT) search report in cases where PCT applications enter the procedure before the EPO, but requires a supplementary European search report and a search fee in all cases unless the Administrative Council of the European Patent Organisation decides--and under what conditions and to what extent--that the supplementary European search report and the search fee in connection with it are to be dispensed with. WIPO fully recognizes the importance of the task of the PCT Interim Committee for Technical Cooperation and, after its entry into force, of the Committee itself, in achieving as soon as possible the aim set forth in Article 56(3)(ii) of the PCT to secure the maximum degree of uniformly high quality international search reports among all International Searching Authorities. Such achievement is a necessary prerequisite to the attainment of one of the main objectives of the PCT, that is, the elimination of duplication of effort in searching. The International Bureau expressed the hope that, in implementing Article 157, the Administrative Council would bear the said objective in mind and would endeavor, in the interest of users of the patent system all over the world, to remove unnecessary duplication of search effort as soon as possible.

24. The basis for establishing the European search report under Article 92(1) upon the claims with due regard to the description and any drawings corresponds to the basis for establishing the international search report under Article 15(3) and Rule 33.3 of the PCT. The content of the European search report under Rule 44 corresponds in essence to that of the international search report under Rule 43 of the PCT.

25. The procedure under Rule 45 is similar to that provided for under Article 17(2)(a) of the PCT in that, if a meaningful search cannot be carried out on the basis of all the claims, a declaration to that effect will be made, and under Article 17(2)(b) of the PCT in that, if a meaningful search cannot be carried out on the basis of some of the claims, a search report will be established only on the searchable part.

#### E. Publication of the European Patent Application and International Publication

26. Article 158(1) of the Convention states the principle of replacement of the publication of a European patent application by the international publication under Article 21 of the PCT. Published international applications which enter the national phase before the EPO are considered as comprised in the state of the art with effect, under Article 54(3), from their filing date, or, where applicable, from their priority date under Article 89.

27. The publication of a European patent application under Article 93(1) after a period of eighteen months is the same as that under Article 21(2) of the PCT. The requirement under Rule 48(2) that publication will not take place if the European patent application is refused or withdrawn or deemed to be withdrawn before the termination of the technical preparations for publication is in line with Article 21(5) of the PCT.

28. The International Bureau noted with satisfaction the statements which were made during the Inter-Governmental Conference to the effect that the President of the EPO, in prescribing the form of the publication of the European patent application and especially the data to be included therein under Rule 49(1), should give due consideration to the aligning of these prescriptions with those of the international publication set forth in Rule 48 of the PCT in order to permit the users to take full advantage of a harmonized system of publications.

Application of the Strasbourg Agreement Concerning the International Patent Classification

29. As it is expected that, in the near future and probably before the entry into force of the Convention, the Strasbourg Agreement Concerning the International Patent Classification will replace the European Convention on that Classification at present in force, Rule 8 makes reference also to the Strasbourg Agreement, making it directly applicable as from the date of its entry into force.

Technical Assistance to Developing Countries

30. The Munich Diplomatic Conference unanimously adopted a Resolution requesting that the European Patent Organisation make use, taking into account efforts being made by other intergovernmental organizations (notably, WIPO), in order to avoid any duplication of efforts, of all the possibilities available to it to help the developing countries, irrespective of their geographical location, in patent matters, particularly as regards documentation, the training of staff and "all other means likely to bring these countries increasingly closer to the highly developed countries."

31. Moreover, Article 132(2) empowers the EPO to conclude agreements relating to the supply of publications. This broad power covers the possibility of the supply of these publications to the industrial property office or other authority of any State which is not a party to the Convention, or to intergovernmental organizations such as WIPO, and will acquire particular importance in the framework of WIPO's technical assistance program for developing countries to be instituted under Chapter IV of the PCT.

WIPO Participation in the Administrative Council

32. The International Bureau stated in the Munich Diplomatic Conference that it attached particular importance to Article 30(1) of the Convention providing for the representation of WIPO by observers in the meetings of the Administrative Council of the European Patent Organisation. The provision in question opens the possibility of contributing WIPO's advice on all matters of interrelationship between the Convention and the international instruments administered by WIPO, and, in particular, on all questions concerning the simultaneous application of the European patent system and the PCT.

33. The Interim Advisory Committee for Administrative Questions is invited to take cognizance of this report.

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