

The Working Party considered it sensible, for the purposes of inspection of the files and entry in the Register, to take the point in time of the publication of the application by the International Patent Office, since once this had taken place, anyone could acquaint himself with the content of the application. To this end, the Working Party adopted a new paragraph 6 to Article 123.

116. The Working Party found that the provision Re. Article 34, No. 1 would have to be altered, not as the result of the amendments decided upon for Article 34, but for another reason. In the text as it stood, this provision covered in particular revocation proceedings and infringement proceedings. This was not intended, because a third party involved in such proceedings ought to be able to rely on the wording of the patent in the language in which it had been granted.

The Working Party therefore decided to restrict to proceedings before the European Patent Office the rule that in the event of the application being translated into an official language, the original text should be decisive for the purposes of determining the extent of the protection (paragraph 1). The remaining amendments to paragraph 1 and paragraph 2 are textual.

Article 137a - European divisional application

117. On the basis of Article 137a, paragraph 2, which provided that in the special case of a divisional application, the claims of the divisional application should not contain any subject-matter for which protection was

sought in the original application and vice-versa, the British delegation raised the question of whether the considerations at the basis of this rule ought not to be extended to all cases where a person with several European applications claimed protection for the same invention; a provision of this nature would be formulated in Part Two of the Convention. This would prevent an applicant being able to apply for several patents for one and the same invention, which was also excluded at national level, although by other means.

The Working Party found that it was sometimes difficult to determine whether the same invention was involved, even where two identical claims were contained in two different applications. The Swiss delegation produced several examples showing that identical claims combined with other claims could result in different objects of invention.

In the course of the discussion, the Working Party agreed that an applicant wishing to protect the same invention by means of several applications filed at the same time, could only be granted a single patent. It was of the opinion that this was a generally recognised, if unwritten, legal principle and that a specific provision in the Convention was therefore not necessary.

118. The Working Party then discussed the problem of whether an applicant for a European patent should be allowed to claim the priority of an earlier European patent application and in such a case to designate one or more States which were already designated in the earlier application.

The majority of the delegations considered that Article 73 of the Convention did not in principle prevent an applicant from claiming the priority of an earlier European patent application, while Article 8 of the PCT in fact makes provision for this in respect of international applications. It did appear doubtful whether a State which had been designated in the earlier application could be designated again in the later European application, as this could lead to the term of the patent being extended by the time between the filing of the two applications in the case of the earlier application being withdrawn during that time.

On this last point, it was remarked that in practice the problem of the term would almost never arise, as very few patents ever reached the last year of their term. In the Paris Union, moves were afoot to make the term of a patent begin on the priority date; if these moves should be successful, the problem would thus be solved.

The Working Party came to the conclusion that even when an applicant claimed the priority of an earlier European patent application, he should not be able to obtain the same

patent twice for the same invention in the same designated States. It was not necessary, however, to provide a rule to this effect in the Convention. Under the present version of the Paris Convention, there would have to be an extended term for those States which were designated twice.

119. The Working Party finally decided that the minutes of the Diplomatic Conference would have to contain a declaration explaining that it was not possible for an inventor to obtain two patents for the same invention.

120. To prevent Article 137a, paragraph 2, being interpreted as meaning that - except in the case of a divisional application - the claims of later applications might contain the same subject-matter as the claims of earlier applications, the Working Party decided to delete the first sentence of this provision. The wording of the second sentence had to be modified to take account of this deletion.

B. NOTE BY THE NETHERLANDS DELEGATION ON THE SETTING UP OF
AN INTERNATIONAL UNION

(Working Document No. 1 of 12 November 1971)

121. The Netherlands delegation repeated its proposal that the European Patent Office and the Administrative Council should together form a European Patent Union; this proposal had already been made at the 4th Meeting of the Inter-Governmental Conference (1). While the European Patent Office and the Administrative Council would be institutions within the same organisation, a number of legal doubts existed. For example, to date legal personality had been

(1) Cf. BR/125/71, Point 94