

WIPO



PCT/TCO/V/11

ORIGINAL: English

DATE: August 29, 1975

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

PATENT COOPERATION TREATY

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

Fifth Session

Geneva, October 29 to November 3, 1975

COMPATIBILITY AND CONSISTENCY OF THE SOLUTIONS
ENVISAGED IN THE FRAMEWORK OF THE PCT AND THE
EUROPEAN PATENT ORGANISATION

Report prepared by the International Bureau

INTRODUCTION

Background of this Document

1. The PCT Interim Advisory Committee for Technical Cooperation (hereinafter referred to as "the Interim Committee"), at its fourth session, held in Geneva in November 1974, requested that the International Bureau review the compatibility and consistency of solutions envisaged within the framework of the Patent Cooperation Treaty (PCT) and the European Patent Organisation (EPO), as far as questions within the jurisdiction of the Interim Committee are concerned.

Purpose of this Document

2. This document is designed to report on the compatibility of the solutions envisaged in the PCT and the EPO and on the major activities presently taking place within the framework of the Interim Committee of the EPO which are within the jurisdiction of this Interim Committee.

Contents of this Document

3. This document first considers the compatibility between some of the major provisions of the PCT and the European Patent Convention (hereinafter referred to as the EPC).

4. This document then deals with the relevant activities within the framework of the Interim Committee of the EPO. It apprizes the PCT Interim Committee in particular of the work being carried out by the Working Parties of the EPO, the activities of which are of interest for this Interim Committee, in implementing work preparatory to the start-up of the EPO and considers the compatibility of the results of such work and of the solutions envisaged with the PCT.

5. For the purpose of the Interim Committee, the compatibility of the provisions of the EPC and the PCT has been treated in two general categories of provisions, i.e., (1) the provisions relating to the functioning of the EPO as an International Searching Authority and (2) the provisions relating to the functioning of the EPO as an International Preliminary Examining Authority.

6. As some of the major provisions of the EPC under comparison may not be as well-known to this Interim Committee as the counterpart PCT provisions, they have been reproduced in Annex A, whereas only a reference will be made to the counterpart PCT provisions and conclusions on their compatibility will be made. The full text of the provisions of the EPC is contained in the February 1974 issue of Industrial Property, which is readily available to the Interim Committee.

7. Furthermore, a concordance list of the provisions of the EPC and the PCT presented in Annex A to this document may provide this Interim Committee with a useful tool to facilitate correlation of a particular EPC provision with that of the PCT.

Harmonization of the PCT and the EPC in general

8. With respect to the harmonization of the PCT and EPC, the Interim Committee is referred to paragraphs 8 and 9 contained in document PCT/AAQ/VI/10.

Advantages of Harmonization

9. With respect to the advantages of harmonization of the PCT and EPC in general, reference is again made to document PCT/AAQ/VI/10, paragraphs 10 - 12 inclusive. Additionally, the attention of the Interim Committee is drawn to the fact that the manner of searching and examining a European application is very similar to the manner of performing an international search and preliminary examination. Consequently, the EPO will perform certain searching and examining functions as an International Searching Authority and International Preliminary Examining Authority under the PCT for international applications filed with it as for European Patent applications it will receive under the EPC.

COMPATIBILITY OF PROVISIONS RELATING TO THE FUNCTIONING OF THE EPO AS AN INTERNATIONAL SEARCHING AUTHORITY

Scope of European Search Report

10. The scope of the European search report under Article 92(1) EPC, being based upon the claims with due regard to the description and any drawings, is harmonized with the scope of international search under Article 15(3) PCT. (See Article 92 EPC, Annex A).

Content of European Search Report

11. The contents of the European search report under Rule 44 EPC are essentially in harmony with that of the international search report. (See Rule 44 EPC, Annex A).

Unity of Invention

12. Article 82 EPC which sets forth the basic principle governing unity of invention under the EPC is in harmony with the principle of Rule 13.1 PCT. (See Article 82 EPC, Annex A).

Category of Claims under Unity of Invention

13. Rule 30 EPC, which sets forth the different categories of claims which are permissible under the principle of unity of invention, is in harmony with the PCT except for sub-paragraph (c) which allows a combination of claims in different categories which is not provided for in Rule 13.2 PCT. It is to be noted that Rule 13.2 PCT is a minimum requirement. Any national or regional law may be more liberal. (See Rule 30 EPC, Annex A).

14. The Searching Division of the EPO, in its searching functions will be confronted with different standards of unity of invention. A European patent application containing the categories permissible under Rule 30(c) EPC would comply with the requirement of unity of invention as contained in the EPC. The Searching Division of the EPO in its capacity as an International Searching Authority, confronted with the same application filed under the PCT would, however, have to state lack of unity of invention. In other words, there are cases where unity of invention exists under the EPC, but not under the PCT on an identical application, despite the fact that the same basic principle governing unity of invention (Article 82 EPC and Rule 13.1 PCT) is applicable under both Treaties.

15. One of the undeniable consequences of the special solution in Rule 30(c) EPC is that the EPO will not follow the general trend towards harmonization of national laws with Rule 13.2 PCT in attaining a uniform interpretation of the concept of unity of invention. Harmonization in this rather important and complex field of international patent practice which has long been the subject of diverse requirements and interpretations would, however, be particularly desirable.

European Search Report where Inventions Lack Unity

16. It is to be noted that under the procedure provided in Rule 46(1) EPC, the Search Division of the EPO searches where unity of invention is lacking only the invention or inventions first mentioned in the claims and then requests a fee for the other inventions. A separate search report is drawn up for each invention searched. Under PCT Article 17(3)(a), in case of lack of unity of invention, the International Searching Authority first requests additional fees and then performs one search and establishes one search report for as many inventions as fees were paid. (See Rule 46 EPC, Annex A).

Definitive Content of the Abstract

17. The procedure under Rule 47 EPC whereby the Searching Division determines the definitive content of the abstract and transmits it and copies of documents cited in the search report to the applicant is well harmonized with Rules 38, 44.2 and 44.3 PCT. (See Rule 47 EPC, Annex A).

Supplementary Search

18. Article 157 of the EPC 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 that--and, if so, under what conditions and to what extent--the supplementary European search report and the search fee in connection with it are to be dispensed with. While this procedure is compatible with the PCT, since the latter does not exclude such supplementary search, it is not in harmony with the major objective of PCT to avoid duplication of search. Undeniably, there is a transitory period during which the aim of uniform international search may not yet be fully reached. For that reason, the PCT provides as a particularly important task of the PCT Interim Committee for Technical Cooperation and, after its entry into force, of the Committee itself, to achieve as soon as possible the aim set forth in Article 56(3)(ii) of the PCT, namely 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 the said main objective of the PCT, that is, the elimination of duplication of effort in searching. The International Bureau has repeatedly expressed the hope that, in implementing Article 157, the Administrative Council of the EPO would bear the said objective in mind and would endeavor, in the interest of the users of the patent system all over the world, to remove unnecessary duplication of search effort as soon as possible. (See Article 157 EPC, Annex A).

Progressive expansion of the field of activity of the European Patent Office

19. It should be noted that, for the purposes of Article 65 PCT, it does not appear likely that the EPO will include limitations as regards the areas of technology of the international applications it can search in the agreement to be concluded with the International Bureau with respect to the functions of the EPO as International Searching Authority. However, in application of Article 162 EPC, the EPO in its capacity as an International Preliminary Examining Authority may limit the areas of technology it will examine. (See Article 162 EPC, Annex A).

PREPARATORY WORK OF WORKING PARTY II RELATING TO THE
FUNCTIONING OF THE EPO AS AN INTERNATIONAL SEARCHING AUTHORITY

Activities of the EPO Interim Committee

20. The Diplomatic Conference for the setting up of a European System for the grant of patents concluded with the adoption of the EPC signed on October 5, 1973 (see document PCT/AAQ/IV/6). At the conclusion of this Conference, an Interim Committee was instituted comprising representatives of all States which had signed the EPC. The EPO Interim Committee established seven Working Parties in order to carry out the implementation work to prepare for the opening of the EPO : I (Organization), II (Searching), III (Examination), IV (Staff Matters), V (Finance), VI (Legal Matters) and VII (Building); Working Parties II and III being of particular interest to this Interim Committee.

Guidelines for Search

21. Reference is made to document PCT/TCO/V/12, with which the said Guidelines have been submitted to the Interim Committee for consideration.

International Patent Institute (IIB)

22. As a consequence of the incorporation of the International Patent Institute (IIB) into the EPO, the Search Divisions of the EPO will take over the task of the IIB with respect to the searching of applications. European searches will be carried out in the Search Divisions of the Search Department in the Hague and in the sub-office thereof in Berlin, and may, during a transitional period, also be entrusted to the central industrial property offices of certain Contracting States. It is expected that after the incorporation of the IIB into the EPO the latter will undertake the tasks as International Searching Authority, formerly expected to be carried out by the IIB.

Search Scope Definition

23. Reference is again made to the Guidelines for Search in the EPO contained in document PCT/TCO/V/12, Annex A, Chapter III, Section 2.2, p. 11, which has been submitted to this Interim Committee for consideration. It is to be noted that the PCT search definition in Article 15(4) PCT has been incorporated in the EPO Guidelines for Search.

Form and Content of Search Report

Search Report Form

24. Working Party II agreed that the European search report should be aligned, as far as possible, with the PCT search report, and that the work of the Working Party in this respect should be coordinated as closely as possible with that of the Interim Committee. The EPO search report form elaborated by Working Party II with this principle in mind is almost completely identical with the PCT search report form. Since, according to Rule 43.10 PCT, the PCT search report form will be prescribed for all Searching Authorities by the Administrative Instructions in order to ensure uniform international publication and since therefore the EPO will have to use it as well, as far as international applications are concerned, this far-reaching harmonization will considerably facilitate search work.

Oral Disclosure

25. Oral disclosure under EPC constitutes prior art. Working Party II decided, however, that citation of such disclosures by the search examiner of the EPO must be supported by a written disclosure. This solution is fully harmonized with the relevant provision of the PCT (Rule 33.1(b)).

Documents involved in the Search

26. With respect to the form of identification of documents in the search report, Working Party II came to the conclusion that Section 503 of the PCT Administrative Instructions (see Document PCT/AAQ/VI/2) provides a suitable solution. It decided therefore that this part of the EPO search report form should be fully harmonized with the PCT.

Additional Information after Searching

27. Working Party II decided that, where the search examiner discovered additional information after the search report had been forwarded to the applicant, he could, exceptionally, communicate this information to the applicant up to the deadline for the publication of the search report, so that this information could also be included in the search report as published.

28. The Interim Committee has not yet considered this problem, but might wish to examine it in the light of the solution proposed by Working Party II.

Search ReportUnity of Invention Lacking

29. Working Party II decided that, if possible, a search should not be limited to the invention first-mentioned in the claims, but should be performed at the same time for other inventions claimed as far as they belonged to the classification units consulted for the main search, in order to organize work economically. In the search report, however, only references for the invention first-mentioned in the claims should be cited. If, in such a case, an exceptionally complete search on the second subject matter for invention were possible, within the limits of the same classification unit as the invention first-mentioned in the claims, then no objection of lack of unity would be justified and the result of the further search would be included in the search report.

30. The approach taken by the EPO should be examined with a view to determining whether such approach might be desirable for prospective International Searching Authorities when carrying out an international search.

Lack of Unity stated in Supplementary EPO Search

31. Working Party II has considered the problem of whether a supplementary EPO search following a PCT search can state a lack of unity of invention not revealed by a PCT search. It was agreed that, if there is no objection on unity of invention by an International Searching Authority, then it was preferable not to raise any objection in case of a supplementary search by the EPO.

32. This Interim Committee should note that the EPO must follow for PCT applications Rule 13 PCT and not applicable EPO rules. This means that, for the question of unity of invention, the EPO might take a more liberal approach to the question of unity of invention, but may not apply any requirements stricter than Rule 13 PCT. Of course, if the EPO discovers a lack of unity of invention according to Rule 13 PCT not revealed during a preceding PCT search, the EPO is free to raise an objection.

Rules for Content of Abstract

33. Working Party II agreed that there should be no substantial difference between the Guidelines for abstracts for PCT purposes and those for the purpose of the EPO. It fully supported the conclusions of this Interim Committee as set out in PCT/TCO/IV/18, points 52 to 59, and in particular point 58.

34. The draft Guidelines for Abstracts (see document PCT/TCO/V/10) are now before the Interim Committee for consideration. The results of discussions of this draft will be conveyed to the EPO, so that a maximum degree of harmony can be achieved between the guidelines for abstracts under the PCT and those under the EPC.

Gradual Extension of Activity in the EPO

35. It was decided that the gradual extension of fields of examination activity in the EPO after its opening would cover five rather than four years.

36. In this connection, it was thought that this extension of examination activities should be achieved in five steps, these steps being, in principle, at one-year intervals; the first step should cover such classes of the IPC as would correspond to approximately 25 per cent of the expected European applications, the remaining 75 per cent being opened in four steps over a period of 4 years, according to experience in the European Patent Office.

37. Notwithstanding the field of activity, EPO search activities will cover all areas of technology as from the opening of the Office.

COMPATIBILITY OF PROVISIONS RELATING TO THE FUNCTIONING OF THE
EPO AS AN INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

Requirements for Patentability

38. It is noted that the three substantive requirements for patentability set forth in Article 52(1) EPC, are well harmonized with those examined for the PCT international examination report under Article 33(1). (See Article 52 EPC, Annex A).

PREPARATORY WORK OF WORKING PARTY III RELATING TO THE FUNCTIONING
OF THE EPO AS AN INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

Substantive Examination

39. Working Party III has completed its study of Guidelines for Substantive Examination. The Guidelines deal with the substantive examination of European applications under the EPC and its Implementing Regulations, as it will be carried out by the examiners in the Munich headquarters of the EPO. They give instructions as to the practice to be followed in the various aspects of the substantive examination of European applications. The Guidelines do not have the binding authority of a legal text. For the ultimate authority on examination practice, it is necessary to refer to the EPC itself.

40. The Guidelines include some procedures dealing with international applications, but are not involved with the operation of Chapter II of the PCT (International Preliminary Examination), since this is considered not to be effective for some time; instructions on the impact of this aspect of the PCT will be added later.

Introduction to Guidelines for Substantive Examination

41. Working Party III included a reference to the PCT in the introduction to the guidelines, stating the capacities in which the EPO could act under the PCT, and making it clear that, in the event of conflict between PCT and European procedures, the PCT procedure should be applied.

Language of Cited Documents

42. Working Party III decided that a translation of the relevant parts of a document concerned should be provided when such document was cited by the EPO and was in a language other than English, French or German.

Amendment

43. Working Party III decided that the EPO could not refuse to make an amendment proposed by the applicant, but would have to object to the application as amended, if the amendment had the effect of extending the subject matter. It further agreed that, where in such a case the amendment was so substantial as to require a further search, the examiner should make the objection before the further search was undertaken.

44. Article 28(2) of the PCT provides that "amendments shall not go beyond the disclosure in the international application." The solution envisaged seems compatible with the principle of the PCT.

Form of Publication of Guidelines

45. Working Party III came to the following conclusions with regard to the form which the publication of the Guidelines should take :

- (i) it should be in loose-leaf form so that amendment sheets could be inserted whenever the Guidelines were revised;
- (ii) the various sets of Guidelines produced by the Working Parties should all be in one volume;
- (iii) it should be produced in litho-offset;
- (iv) different type faces should be used for the purpose of indicating quotations from the Convention;
- (v) the Working Party stated a clear preference for A4 rather than A5 for the size of the pages, since it is easier to consult larger manuals written in fairly large typescript.

46. When later faced with the question of form of publication of PCT guidelines, the Interim Committee might consider a solution similar to that envisaged by the EPO.

[Annex A follows]

Rule 30

Claims in different categories

Article 82 shall be construed as permitting in particular that one and the same European patent application may include:

- (a) in addition to an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for a use of the product; or
- (b) in addition to an independent claim for a process, an independent claim for an apparatus or means specifically designed for carrying out the process; or
- (c) in addition to an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for an apparatus or means specifically designed for carrying out the process.

Rule 44

Content of the European search report

- (1) The European search report shall mention those documents, available to the European Patent Office at the time of drawing up the report, which may be taken into consideration in deciding whether the invention to which the European patent application relates is new and involves an inventive step.
- (2) Each citation shall be referred to the claims to which it relates. If necessary, the relevant parts of the documents cited shall be identified (for example, by indicating the page, column and lines or the diagrams).
- (3) The European search report shall distinguish between cited documents published before the date of priority claimed, between such date of priority and the date of filing, and on or after the date of filing.
- (4) Any document which refers to an oral disclosure, a use or any other means of disclosure which took place prior to the date of filing of the European patent application shall be mentioned in the European search report, together with an indication of the date of publication, if any, of the document and the date of the non-written disclosure.
- (5) The European search report shall be drawn up in the language of the proceedings.
- (6) The European search report shall contain the classification of the subject-matter of the European patent application in accordance with the international classification.

*Rule 46*European search report
where the invention lacks unity

(1) If the Search Division considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up the European search report on those parts of the European patent application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims. It shall inform the applicant that if European search reports are to be drawn up in respect of the other inventions, the necessary search fees for obtaining such reports must be paid within a period to be fixed by the Search Division and which may not be shorter than two weeks and may not exceed six weeks. The Search Division shall draw up European search reports for those parts of the European patent application which relate to inventions in respect of which the fees referred to were paid.

(2) Any fee which has been paid under paragraph 1 shall be refunded if, during the examination of the European patent application by the Examining Division, the applicant requests a refund and the Examining Division finds that the communication referred to in the said paragraph was not justified.

Rule 47

Definitive content of the abstract

- (1) At the same time as drawing up the European search report, the Search Division shall determine the definitive content of the abstract.
- (2) The definitive content of the abstract shall be transmitted to the applicant together with the European search report.

Article 52

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, scientific theories and mathematical methods;
 - (b) aesthetic creations;
 - (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
 - (d) presentations of information.
- (3) The provisions of paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.
- (4) Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph 1. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

Article 82

Unity of invention

The European patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Article 92

The drawing up of the European search report

- (1) If a European patent application has been accorded a date of filing and is not deemed to be withdrawn by virtue of Article 90, paragraph 3, the Search Division shall draw up the European search report on the basis of the claims, with due regard to the description and any drawings, in the form prescribed in the Implementing Regulations.
- (2) Immediately after it has been drawn up, the European search report shall be transmitted to the applicant together with copies of any cited documents.

Article 157

International search report

- (1) Without prejudice to the provisions of paragraphs 2 to 4, the international search report under Article 18 of the Cooperation Treaty or any declaration under Article 17, paragraph 2(a), of that Treaty and their publication under Article 21 of that Treaty shall take the place of the European search report and the mention of its publication in the European Patent Bulletin.
- (2) Subject to the decisions of the Administrative Council referred to in paragraph 3:
- (a) a supplementary European search report shall be drawn up in respect of all international applications;
 - (b) the applicant shall pay the search fee, which shall be paid at the same time as the national fee provided for in Article 22, paragraph 1, or Article 39, paragraph 1, of the Cooperation Treaty. If the search fee is not paid in due time the application shall be deemed to be withdrawn.
- (3) The Administrative Council may decide under what conditions and to what extent:
- (a) the supplementary European search report is to be dispensed with;
 - (b) the search fee is to be reduced.
- (4) The Administrative Council may at any time rescind the decisions taken pursuant to paragraph 3.

Article 162Progressive expansion of the field of activity
of the European Patent Office

- (1) European patent applications may be filed with the European Patent Office from the date fixed by the Administrative Council on the recommendation of the President of the European Patent Office.
- (2) The Administrative Council may, on the recommendation of the President of the European Patent Office, decide that, as from the date referred to in paragraph 1, the processing of European patent applications may be restricted. Such restriction may be in respect of certain areas of technology. However, examination shall in any event be made as to whether European patent applications can be accorded a date of filing.
- (3) If a decision has been taken under paragraph 2, the Administrative Council may not subsequently further restrict the processing of European patent applications.
- (4) Where, as a result of the procedure being restricted under paragraph 2, a European patent application cannot be further processed, the European Patent Office shall communicate this to the applicant and shall point out that he may make a request for conversion. The European patent application shall be deemed to be withdrawn on receipt of such communication.

CONCORDANCE LIST OF THE PROVISIONS
OF THE EPC AND THE PCT

The following concordance list identifies those provisions of the EPC which are of interest to WIPO. The citation of the pertinent Article or Rule of the EPC is given along with its title. Following each citation the relevant provision of the PCT, etc. is set forth in brackets.

For the purpose of this list, it appears best to divide the provisions of the EPC of interest into two categories: namely, the interlocking provisions and the harmonizing provisions.

By "interlocking provisions" is meant those provisions which tie the EPC into certain conventions of particular concern to WIPO: namely, the Paris Convention (PC), the Patent Cooperation Treaty (PCT), and the Strasbourg Agreement (IPC). Broadly, the interlocking provisions relate to the application of the PC priority right within the EPC system, state the functions of the European Patent Office (EPO) within the PCT system, define the effects on the EPC system of certain features occurring with the PCT system (e.g., the international search report, the publication of the international application), and provide for the use of an international patent classification system within the EPC system.

By "harmonizing provisions" is meant those EPC provisions pertaining to the form or contents of the European application or pertaining to a procedural or substantive matter involved in the processing of an application under the EPC system for which corresponding provisions exist under the PCT. Harmonization between the EPC and the PCT in respect of these provisions benefits from the advantages to be derived from the functioning of the two systems in like manner.

A. List of interlocking provisions

The following provisions are considered to be the interlocking provisions.

1. Interlocking provisions in respect of the Paris Convention:

Preamble

PRIORITY

Article 87 - Priority right (cf. PC Article 4 et al)

Article 88 - Claiming priority (cf. PC Article 4(D); PCT Article 8)

Article 89 - Effect of priority right (cf. PC Article 4(A)(B); PCT Article 8(2)(a))

Rule 38 - Declaration of priority and priority documents (cf. PCT Rules 4.10(a)(b), 17)

2. Interlocking provisions in respect of the Patent Cooperation Treaty:

Preamble - (cf. PCT Article 45(1))

INTERNATIONAL APPLICATION PURSUANT TO THE PATENT COOPERATION TREATY

Article 150 - Application of the Patent Cooperation Treaty (cf. PCT Article 27, particularly 27(1), (4))

Article 151 - The European Patent Office as a receiving Office (cf. PCT Article 2(xv), Rule 19)

Article 152 - Filing and transmittal of the international application (cf. PCT Rule 19)

Article 153 - The European Patent Office as a designated Office (cf. PCT Article 2(xiii))

- Article 154 - The European Patent Office as an International Searching Authority (cf. PCT Article 16)
- Article 155 - The European Patent Office as an International Preliminary Examining Authority (cf. PCT Article 32)
- Article 156 - The European Patent Office as an elected Office (cf. PCT Article 2(xiv))
- Article 157 - International search report (cf. PCT Articles 17(2)(a), 18, 21, Rule 16)
- Article 158 - Publication of the international application and its supply to the European Patent Office (cf. PCT Articles 21, 22, 39)
- Article 104 - Transmittal of the international application to the European Patent Office (cf. PCT Rule 22.3)

3. Interlocking provisions in respect of the International Patent Classification (Strasbourg Agreement):

- Rule 8 - Patent classification (cf. PCT Rule 43.3(a))

4. Interlocking provision in respect of the World Intellectual Property Organization:

- Article 30 - Attendance of observers

- Article 33(4) - Competence of the Administrative Council (cf. PCT Articles 16(3)(b), 32(3))

[Other noteworthy provisions are those set forth in Articles 142-149 (Part IX) which interlock the EPC with the prospective community Patent Convention of the European Common Market States.]

B. List of harmonizing provisions

The following provisions are considered to be the harmonizing provisions.

1. Articles

PATENTABILITY

- Article 52 - Patentable inventions (cf. PCT Article 33(1), Rules 39, 67)
- Article 53 - Exceptions to patentability (cf. PCT Article 21(6), Rules 9, 39.1(ii), 67.1(ii))
- Article 54 - Novelty (cf. PCT Article 33(2), Rules 33, 64)
- Article 55 - Non-prejudicial disclosures (cf. PC Article 11)
- Article 56 - Inventive step (cf. PCT Article 33(3))
- Article 57 - Industrial application (cf. PCT Article 33(4))

PERSONS ENTITLED TO APPLY FOR AND OBTAIN EUROPEAN PATENTS - MENTION OF THE INVENTOR

- Article 58 - Entitlement to file a European patent application (cf. PCT Articles 9, 45(1), Rules 18.1, 18.2)
- Article 59 - Multiple applicants (cf. PCT Rule 18.3, 18.4)
- Article 60 - Right to a European patent (cf. PCT Rule 3.3(a)(ii))

Article 62 - Right of the inventor to be mentioned (cf. PC Article 4ter,
PCT Articles 4(1)(v), 22(1))

EFFECTS OF THE EUROPEAN PATENT AND THE EUROPEAN PATENT APPLICATION

Article 67 - Rights conferred by a European patent application after
publication (cf. PCT Article 29)

FILING AND REQUIREMENTS OF THE EUROPEAN PATENT APPLICATION

Article 75 - Filing of the European patent application (cf. PCT Article
27(8))

Article 78 - Requirements of the European patent application (cf. PCT
Article 3(2), Rules 15.4, 16.1(b))

Article 79 - Designation of Contracting States (cf. PCT Article 4(1)(ii),
4(2), Rules 15.4(b), 32.1(b))

Article 80 - Date of filing (cf. PCT Article 11(1))

Article 81 - Designation of the inventor (cf. PCT Article 4(1)(v))

Article 82 - Unity of invention (cf. PCT Rule 13.1)

Article 83 - Disclosure of the invention (cf. PCT Article 5)

Article 84 - The claims (cf. PCT Article 6)

Article 85 - The abstract (cf. PCT Article 3(3))

PROCEDURE UP TO GRANT

Article 90 - Examination on filing (cf. PCT Articles 11(1), (2), 14(3)(a))

Article 91 - Examination as to formal requirements (cf. PCT Article
14(1), 2, 3(b))

Article 92 - The Drawing up of the European search report (cf. PCT Articles
15(3), 20(3), Rules 33.3, 42)

Article 93 - Publication of a European patent application (cf. PCT Article
21, Rule 48.2(a))

COMMON PROVISIONS GOVERNING PROCEDURE

Article 120 - Time limits (cf. PCT Rule 80.5)

Article 122 - Restitutio in integrum (cf. PCT Article 48(1), Rule 82.2)

Article 123 - Amendments (cf. PCT Articles 28, 41, Rules 52, 78)

INFORMATION TO THE PUBLIC OR OFFICIAL AUTHORITIES

Article 128 - Inspection of files (cf. PCT Article 30)

Article 132 - Exchange of publications (cf. PCT Article 50)

REPRESENTATION

Article 133 - General principles of representation (cf. PCT Article 27(7))

TRANSITIONAL PROVISIONS

Article 162 - Progressive expansion of the field of activity of the European Patent Office (cf. PCT Article 65)

2. Rules

MENTION OF THE INVENTOR

Rule 17 - Designation of the inventor (cf. PCT Articles 4(v), 22(1), Rule 4.6)

PROVISIONS GOVERNING THE APPLICATION

Rule 26 - Request for grant (cf. PCT Rule 4)

Rule 27 - Content of the description (cf. PCT Rule 5)

Rule 29 - Form and content of claims (cf. PCT Rules 6, 13.3, 13.4)

Rule 30 - Claims in different categories (cf. PCT Rule 13.2)

Rule 32 - Form of the drawings (cf. PCT Rule 11.6(c), 11.13)

Rule 33 - Form and content of the abstract (cf. PCT Rule 8)

Rule 34 - Prohibited matter (cf. PCT Article 21(6), Rule 9)

Rule 35 - General provisions governing the presentation of the application documents (cf. PCT Rules 10, 11)

Rule 36 - Documents filed subsequently (cf. PCT Rule 11.14)

EXAMINATION BY THE RECEIVING SECTION

Rule 39 - Communication following the examination on filing (cf. PCT Article 11(2), Rule 20.6)

Rule 40 - Examination for certain physical requirements (cf. PCT Article 14(1)(a)(v), Rule 26.3)

Rule 41 - Rectification of deficiencies in the application documents (cf. PCT Article 14(1)(b), Rule 26.1, 4.10(b), 4.10(d))

Rule 42 - Subsequent identification of the inventor (cf. PCT Articles 4.1(v), 22(1))

Rule 43 - Late-filed or missing drawings (cf. PCT Article 14(2), Rule 20.2(a)(iii))

EUROPEAN SEARCH REPORT

Rule 44 - Content of the European search report (cf. PCT Rule 43)

Rule 45 - Incomplete search (cf. PCT Article 17(2))

Rule 46 - European search report where the invention lacks unity (cf. PCT Article 17(3), Rule 40)

Rule 47 - Definitive content of the abstract (cf. PCT Rules 38, 44.2, 44.3)

PUBLICATION OF THE EUROPEAN PATENT APPLICATION

Rule 48 - Technical preparations for publication (cf. PCT Article 21(5))

Rule 49 - Form of the publication of European patent applications and European search reports (cf. PCT Rule 48)

EXAMINATION BY THE EXAMINING DIVISION

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TIME LIMITS

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AMENDMENTS AND CORRECTIONS

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Rule 88 - Correction of errors in documents filed with the European Patent Office (cf. PCT Rule 91)

REPRESENTATION

Rule 100 - Appointment of a common representative (cf. PCT Rule 4.8)

Rule 101 - Authorizations (cf. PCT Rule 90)

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