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**EDITORIAL**

Here is the first issue of EPI Information. In future issues your Editorial Board would like to publish letters from members particularly on controversial matters and matters where you wish to comment or criticize actions or decisions taken on your behalf by our Council or where you think the Council ought to act.

This is your publication. Use it.

Jean Brullé · Ernst J. Schönhofer · Ken Veryard

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Mes Chers Collègues,

C'est avec un grand plaisir que je vous adresse ces quelques lignes pour présenter le premier numéro du Bulletin d'Information de notre Institut.

Depuis longtemps déjà, vos représentants au Conseil souhaitaient disposer d'un moyen informel de liaison et de communication avec les autres membres de l'Institut afin que celui-ci ne soit pas pour vous simplement une espèce de monstre froid dévoreur de cotisations mais au contraire un organisme vivant et en évolution constante.

Avant de réaliser ce souhait, le Conseil a dû résoudre de nombreux problèmes d'organisation et de fonctionnement inhérents à la création de toutes pièces d'un organisme multinational aussi complexe. Ces problèmes sont maintenant pratiquement résolus grâce aux efforts et à la compréhension de tous et votre Conseil peut consacrer l'essentiel de ses travaux à ce qui doit être son rôle fondamental, à savoir travailler constamment à l'amélioration des conditions de votre activité professionnelle dans le cadre de la Convention sur le Brevet Européen.

Grâce au dévouement de notre ancien Président K. Veryard, de notre Vice-Président E.J. Schönhofer et de notre membre français du Conseil J. Brullé, notre Bulletin d'Information peut maintenant paraître et je les remercie tout particulièrement ici de vouloir bien consacrer leurs efforts et leur temps à cette œuvre d'intérêt commun.

Je suis sûr que vous ferez bon accueil à notre Bulletin et que vous tiendrez à y collaborer pour le plus grand bien de tous.

C'est pourquoi c'est avec la plus grande confiance que je souhaite longue vie et plein succès au Bulletin de l'Institut.

G. BRESSAND

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Meine lieben Kollegen,

mit großer Freude richte ich diese wenigen Zeilen an Sie, um die erste Ausgabe der Informationszeitschrift unseres Instituts vorzustellen.

Schon lange wünschten Ihre Ratsmitglieder über ein informelles Mittel der Verbindung und der Kommunikation mit den anderen Institutsmitgliedern zu verfügen, damit das Institut für diese nicht lediglich eine Art Ungetüm bleibt, das nüchtern die Mitgliedsbeiträge verschlingt, sondern ein lebendiger Organismus ist, der sich beständig entwickelt.

Bevor dieser Wunsch in die Tat umgesetzt werden konnte, mußte der Rat über eine Reihe organisatorischer und funktionaler Probleme befinden, wie sie der Gründung einer multinationalen Organisation eigen sind. Diese Probleme sind nun, dank der Anstrengungen und dem Verständnis aller, praktisch gelöst. Ihr Rat kann nun seine Arbeit im wesentlichen der Hauptaufgabe widmen, die Bedingungen Ihrer beruflichen Tätigkeit im Bereich des Europäischen Patent-Übereinkommens ständig zu verbessern.


Ich bin sicher, daß Sie unsere Zeitschrift gut aufnehmen und daß Sie zu unser aller Nutzen an ihr weiter mitarbeiten werden.

Mit großer Zuversicht wünsche ich deswegen der Zeitschrift des Instituts ein langes Leben und viel Erfolg.

G. BRESSAND
My Dear Colleagues,

It is with great pleasure that I write these few lines to introduce the first edition of the Information Bulletin of our Institute.

For a long time, your representatives on the Council have wished for an informal means of communication with other members of the Institute to show that the Institute is not just a kind of monster devouring your membership fees but a living organism in constant evolution.

Before realising this wish, the Council had to resolve a number of organisational problems and functions inherent in setting up such a multinational body. These problems are now practically resolved thanks to the efforts and understanding of all and your Council can concentrate on the essential work of improving the conditions of your professional work in the field of the European Patent Convention.

Thanks to the efforts of our former President K. Veryard, our Vice-President E.J. Schönhöfer and of our French member of Council J. Brullé, our Information Bulletin can now appear and I thank them especially for devoting their efforts and their time to this work of common interest.

I am sure that you will welcome our Bulletin and that you will contribute and collaborate with it for the good of all of us.

That is why I wish with high confidence, long life and success to the Institute's Bulletin.

G. Bressand

SUMMARY OF IMPORTANT ITEMS
PUBLISHED IN THE EPO OFFICIAL JOURNAL - 1983
(EPO Public Relations Dept.)

Boards of Appeal

The Rules of Procedure of the Boards of Appeal together with information concerning the composition of the Boards of Appeal was published in Official Journal 1/1983. The Rules particularly deal with the role of rapporteurs (Article 4), the attendance of interpreters (Article 6) and other procedural points. The Boards of Appeal consist of:

1. Enlarged Board of Appeal
2. Legal Board of Appeal
3. 4 Technical Boards of Appeal
4. There is a further Board of Appeal for disciplinary matters relating to professional representatives before the EPO.

Organisation of the EPO

In Official Journal 3/1983 a full organisational plan of the European Patent Office was published. Further copies of this plan are obtainable from the European Patent Office, Munich (Department 4.5.1. (Information)).

Witnesses' and experts' expenses in oral proceedings

In Official Journal 3/1983, page 100, procedural details were given concerning the compensation and fees payable to witnesses and experts in oral proceedings before the European Patent Office, and the Regulation concerning compensation and fees payable was published.

Changes to the Guidelines for Examination

In Official Journal 4/1983, page 144, a summary of the main changes to the guidelines concerning substantive examination in the European Patent Office was published. Subscribers to the guidelines will automatically receive the full text of the changes. The Official Journal provided a summary of the main points which concerned, amongst other matters, the following:

1. Claims defining the products in terms of a process of manufacture are admissible only if the products as such fulfil the requirements of patentability.

2. A claim for an apparatus which seeks to define the invention by reference to features of the use to which the apparatus is to be put may lack clarity.

3. An immediate refusal of the application should not take place provided the applicant has made a bona fide attempt to deal with the examiner's objections, and the applicant should be given an opportunity to produce further arguments or amendments.
Prevention of publication of the application

Official Journal 4/1983, page 147 dealt with the important matter of withdrawal of the application in order to prevent publication.

In particular it was drawn to the applicant’s attention that declarations of withdrawal should be sent to the Receiving Section in The Hague with a clear indication that publication is to be stopped immediately. The completion of the technical preparations for publication of the application is in normal office practice 10 weeks before the expiry of the 18th month from the date of filing, ie the date of priority, and prevention of publication during this 10 week period can only be dealt with on a case by case basis.

Harmonisation and national law

OFFICIAL JOURNAL 7/1983, page 301 contained a report on the work of the working party set up to harmonise national legal requirements following grant of a European patent. The administrative Council of the European Patent Organisation passed a resolution calling for harmonisation of time limits and translation requirements in the national phase following European grant. Three broad areas of harmonisation were reported on:

- filing of the translation of the European patent specification under Article 65 EPC
- filing a translation of the claims in the published European patent application under Article 57(3) EPC
- payment of renewal fees for European patents

Application number and publication number

OFFICIAL JOURNAL 8/1983, page 342 contained an explanation of how the European application number and publication number were made up. A European application is identified only by an application number or a publication number, and no separate number is issued on grant of the patent.

Tenth anniversary of the signing of the European Patent Convention


Statistics


European Patent Bulletin

OFFICIAL JOURNAL 11/1983, page 458 brought to the attention of applicants certain changes to the contents of the European Patent Bulletin from 4 January 1984. These changes effect the layout, and also include a new entry in the Register indicating that the period for opposition has expires without notice of opposition having been filed.

Published decisions of the Legal Board of Appeal

Further to the cases dealt with in the last issue a resumé is given below of further cases handed down by the Legal Board of Appeal reported in the Official Journal.

Case JO/81 – Payment of fees

The applicant paid a sum to his bank one day before the due date, and this sum was not entered in the account of the EPO until after the deadline had passed. The decision concerned Article 8(1) of the Rules relating to Fees, under which the date on which a payment or transfer takes effect is the date on which the amount in question is entered into a bank account held by the EPO. The due date for payment was a public holiday in Munich and, according to a Notice of the President of the EPO published in the Official Journal, also a date on which the EPO in Munich was closed for the receipt of documents. The Board held that as the time limit for payment expired on a day on which the payment could not have been effected in Munich (e.g. by putting a cheque in a letter-box) the date for payment was extended by one day, which (on the facts) meant that the payment had been validly made (Official Journal 2/1983, page 53).

Case JO/82 – Calculation of Aggregate Time Limits

Here the Board held that the provisions of Rule 83 EPC are clear and a period expired in months expired “on the day which has the same number as the day” on which the reference event occurs. Further time limits to be added are calculated from the expiry of this time limit. A full explanation of calculation of time limits had been given by the Office in Legal Advice number 5/80 published in Official Journal 6/1980, page 149 (Official Journal 2/1983, page 57).

Case JO/81 – Cash payment at a bank

The Board held that a sum of money paid at the counter of a bank must comply with the provisions of Article 8(1)(a), Rules relating to Fees, i.e. be entered in a bank account held by the EPO and the date of such entry is the date of payment. A cash payment made to a bank in a national currency of the location of the bank constitutes a payment to a bank account and not a cash payment (Official Journal 3/1983, page 89).

J14/82 – Correction of a mistake in a declaration of priority

The case concerned the omission of a series of priorities and the Board held (in accordance with past decisions) that a mistake
in a document filed with the European Patent Office may result from an omission and that correction may take the form of adding omitted matter. In the case in question the facts were slightly different from Case No. J04/12 (OJ EPO 1982, 385) in so far as the application had been published without any warning concerning the missing priorities. The Board therefore had to consider whether the public interest would be adversely affected by allowing the correction. The Board held that as a request for correction had been made and was still pending, the Receiving Section should not have published the application without including a warning to the public. As, however, the applicant had filed a further application containing the correct priorities the Board held that the public interest would not be adversely affected by allowing the appeal. Further the Board held that the Receiving Section had been wrong in not giving the appellants an opportunity to present their comments, which they had wished to present, this was in contravention of Article 173(1) EPC and ordered reimbursement of the appeal fee in accordance with Rule 67 EPC (Official Journal 4/1983, page 121).

J23/82 - Selection among designations where payment of designation fee is not sufficient

The Board ruled that Article 7(2) first sentence of the Rules relating to Fees must first be applied before Article 9(2) of the Rules relating to Fees is applied. If insufficient designation fees are paid by an applicant in respect of the designated States he has chosen, correct procedure is for the EPO to ask the applicant to make the payments to apply to before applying the provisions of Article 9(2), Rules relating to Fees (Official Journal 4/1983, page 127).

J12/82 - Late filing of request for examination

The Board had to consider whether payment of the examination fee can itself be treated as being equivalent to filing the request for examination. The Board held that although the intention to file the request for examination could perhaps be assumed from the act of paying an examination fee, the provisions of Article 94 EPC specifically require that a written request be filed accompanied by payment. The time limit for submitting the written request is excluded form "restitutio in integrum" (Article 122(5) EPC). The Board held that the restriction on restoration in integrum for an Article 94(2) EPC default cannot be circumvented by arguing that Rules 85(a) and 85(b) are not excluded under the terms of Article 122(5) EPC. The Board observed that it would be paradoxical to be more liberal to someone who has failed to observe a period of grace than towards somebody who had been unable to observe the normal time limit.

OPPOSITIONS

The present rate of opposition is approximately 10-11%, although there are variations in the opposition rate from one technical field to another.

By way of summary, applicants are reminded that the opposition procedure is dealt with in Articles 99 - 105 EPC, and in Rules 55 - 63 of the Convention. Part D of the Guidelines for Examination also expands on these provisions. A summary of the opposition procedure has been published in the Official Journal of the European Office (OJ 3/1981, pages 74 - 82).

Any person may oppose the grant within a period of 9 months from the date of publication of the mention of the grant of the European patent (in the European Patent Bulletin). The basic grounds for opposition are the following:

(a) The subject-matter is not patentable (Articles 52 - 57 EPC);

(b) The European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

(c) The subject-matter of the European patent extends beyond the content of the application as filed.

Oppositions arise generally when third parties bring to the attention of the Office materials relating to the granted patent, which indicate that one of the above grounds for opposition exists. The European Office treats the opposition as if it were in respect of all the States designated at the time of grant of the European patent, although an opposition division hearing the opposition may take a Decision, which may lead to the patent being revoked for different claims for different Contracting States (in accordance with Rule 16(2) EPC or Rule 87 EPC) or where, for instance, the claims have been redrafted to take account of different prior art and under the provisions of Article 54(3) EPC. It is therefore possible, as a result of an opposition, that a European patent may be revoked in respect of certain Contracting States and maintained in the old or amended form for others.

The identity of the opponent needs to be known to the Office, and a recent decision of a Board of Appeal reported in Official Journal 10/1983 (Case T10/82, OJ 10/1983, 407) has established that professional representatives filing oppositions on behalf of clients must reveal the identity of their principals.

STATISTICS ON OPPOSITIONS

As of 5 October 1983 80 decisions have been taken to reject the opposition, 88 decisions have been taken to revoke the granted European patent, and 26 decisions have been taken to maintain the patent with amendments.

Furthermore, appeals have been filed against 24 decisions to reject opposition and 13 appeals have been filed against decisions to revoke the granted European Patent.

To 1 October 1983 there were 9,259 granted European patents where the time limit for opposition had run out of which 988 had been opposed giving a percentage opposition rate of 10.67.

ANNUAL REPORT 1982 AND CURRENT YEAR 1983

During 1982 there was a further increase of 13% in European patent applications, and this increase is also reflected in the first
half year figures for 1983. Strong interest is being shown in the European system by Japanese and American applicants. Comparing 1982 with 1981, 6,195 applications were received from US applicants as compared with 5,307 in 1981, and 3,495 applications were received from Japanese applicants as compared with 2,449 in 1981.

A copy of the Annual Report 1982 may be obtained by writing to the European Office in Munich (Department 4.5.1 Information).

Statistics - Granted European Patents

The number of granted European patents to date appear as follows:

- 1980 - 483
- 1981 - 335
- 1982 - 5430
- 1983 - 9760

Designation of Contracting States in granted European patents for 1983* appears as follows:

- GB - 91%
- FR - 87.3%
- DE - 86.5%
- IT - 70.1%
- NL - 67.9%
- BE - 57.8%
- CH/LI - 54.7%
- SE - 52.9%
- AT - 36.9%
- LU - 21.9%

The 1984 forecast is that notification of publication of grant will run at 15,000 for 1984.

Statistics - European applications

The European patent granting system appears to have stabilised at around 30,000 applications a year of which approximately 10% will be Euro-PCT applications. Some increase in the number of Euro-PCT applications is expected, although this increase will not (in absolute terms) be very significant, although in percentage terms will show a steady growth in Euro-PCT applications.

Applicants are reminded that in the case of international applications (PCT) in Japanese the further European publication (Article 158(3) EPC) in pamphlet form is made by the EPO of the translation supplied by the applicant in one of the official languages of the EPO, following entry of the application into the (regional) European phase. In these cases of republication in an official language of the EPO, the EPO pamphlet bears the European publication number and the reference to the international publication number. Further, the period for calculating the time limit for submitting the written request for examination and payment of the fees for examination is calculated from the international publication and NOT the second European publication.

* these figures are estimated and the final figures may show some slight variation.

EPI Information 1-1984
Es ergab sich darüberhinaus, daß es die Mehrzahl der Kollegen bevorzugt würde, wenn nicht nur die Patentschriften (B-Schriften), sondern auch die Offenlegungsschriften (A-Schriften) in gesetzter Form gedruckt würden. Ein Satz auch der A-Schriften hätte den gewünschten Sinn, da das Papiervolumen gegenüber dem derzeitigen Offsetdruck drastisch reduziert würde.

Gestützt auf das sehr positive Ergebnis der Fragebogenerhebung werden dann von der Arbeitsgruppe DATIMTEX erste praktische Vorversuche durchgeführt. Hierfür stellten die EPI-Mitglieder der Arbeitsgruppe Anmeldungs texte zur Verfügung, die teilweise auf Diskette vorlag und in OCR-B-Schrift geschriften war. Die Ergebnisse ermutigend waren, wurde anschließend ein umfassender Test vorbereitet und durchgeführt, an dem etwa 30 Büros aus der freien Praxis und der Industrie beteiligt waren, die insgesamt 76 Anmeldungs texte zur Verfügung stellten. Weitere 24 Anmeldungen wurden am Ende dazu vereinbart. Mit diesem Fundus an Anmeldungen wurde fortgesetzt, inwieweit eine Digitalisierung der Anmeldungs texte mit dem derzeit am Markt befindlichen Lesegeräten und Diskettenkonvertlern grundsätzlich möglich ist und welche technischen Probleme auftreten. Gleichzeitig sollte dieser Test die Basis für die weiteren technischen, organisatorischen und finanziellen Überlegungen bilden. Die Auswertung aller Testergebnisse hat die Arbeits gruppe DATIMTEX in ihren Überlegungen bestätigt und gezeigt, daß grundsätzliche Probleme nicht zu erwarten sind.

Bei der Bewertung der Testergebnisse wurde davon ausgegangen, daß man bei manueller Schreibweise von Anmeldungs texte mit einer Fehlerquote von 1% gerade noch tolerieren kann, d. h. rund 20 falsche Zeichen pro Schreibmaschinenseite. Die Korrekturarbeiten halten sich, nach Auffassung des EPI bei einer solchen Fehlerquote noch in einem vertretbaren Rahmen. Bei der automatischen Erfassung von Anmeldungen war in Übrigen eine Fehlerquote von 0,24% = 5 falsche Zeichen pro Seite festgestellt worden.

Die in den OCR-B geschriftenen Anmeldungs texte wurden versuchsweise auf verschiedene Lesegeräte digitalisiert, anschließend in eine für die Datenverarbeitungsanlage des Amtes lesbare Form konvertiert und danach versuchsweise auf die Eingabe in die Datenspeicherung der EPI erforderliche Form umgesetzt. Sie wurden dann mit dem Laser-Drucker wieder ausgedruckt. Das Digitalisieren mit den besten untersuchten OCR-B-Lesegeräte führte dazu, daß 17% der Eingabe fehlerhaft waren. Bei der Überschreibung der Fehlerquote von 1% lagen und folglich einen deutlichen Korrekturaufwand erforderlich.

Die auf Disketten eingereichten Texte wurden zunächst in ein gemeinsames Zwischenformat konvertiert und anschließend in die für die Datenverarbeitungsanlage des EPI erforderliche Form umgesetzt. Das Digitalisieren mit den besten untersuchten OCR-B-Lesegeräten führte dazu, daß 17% der Eingabe fehlerhaft waren. Bei der Überschreibung der Fehlerquote von 1% lagen und folglich einen deutlichen Korrekturaufwand erforderlich.
Bei der Bewertung der Konvertierungs-Fehler muß berücksichtigt werden, daß diese Fehler dann nicht zu rechtlichen Problemen führen, wenn die Grundlage für das Patentrecht der ursprünglich eingereichte Urtext bleibt und wenn Konvertierungsfehler nicht zu Lasten des Patentinhabers gehen.

Insgesamt gesehen waren die Ergebnisse des Tests sehr zufriedenstellend, so daß die Tätigkeit der Arbeitsgruppe DATIMTEX mit dem vom Präsidenten des EPA vorgegebenen Ziel fortgesetzt wird, allen Anmeldern ab 1. Januar 1985 auf freiwilliger Basis die Möglichkeit zu geben, neben den Urtexten auch Disketten einzureichen oder aber die Urtexte in OCR-B-Schrift abzufassen. Die Freiwilligkeit wird auch in Zukunft gelten.

Die EPI-Mitglieder von DATIMTEX haben von Anbeginn an darauf gedrungen, daß diejenigen Anmelder, die die Digitalisierungsbe- scheidung des Patentamtes durch und OCR-B geschriebene Texte oder Disketten woran unterstützen, einen angemessenen Gebührenersatz bekommen müssen, weil sie es sind, die die Kostensenkungen durch eigenen Mehraufwand ermöglichen.

Diejenigen von uns, die noch keine Textverarbeitungsgeräte haben und das EPA gleichwohl bei der Digitalisierung unterstützen wollen, werden dies mit geringem Aufwand tun können. Erforderlich ist lediglich ein Kugelkopf oder ein Schreibrad mit der OCR-B-Schrift.

THE DATIMTEX WORKING GROUP OF THE EUROPEAN PATENT OFFICE

By: Angus Duncan · Dieter Speiser · André van der Auweraer

In the search for possible ways of reducing costs in the printing of European Patent Specifications the thought arose in the EPO in 1981 of asking the applicants to file the applications with the text in machine-readable form in order to reduce the heavy keyboarding costs at the printers. It was then decided by the EPO to form a working group which could look into the question of digitalisation application texts and the President of the EPO invited the EPI to cooperate in this working group. The Council of the Institute subsequently appointed Messrs. van der Auweraer (BE), Duncan (GB) and Speiser (DE) to the working group, which started its work on 3rd and 4th May 1982 and in the meantime has been given the title DATIMTEX.

The EPO had already had some initial thoughts on the technical possibilities and on the legal problems. From the legal point of view the starting point was that the European Patent Convention - historically understandable - made clear at a number of places the requirement that the text should be in written form. This fact led to the overall further activities of the DATIMTEX working group proceeding on the assumption that it would not be possible to depart from the requirement for application texts to be filed in a form written on paper.

From the technical aspect two possibilities stood out. One possibility was seen as being the filing of applications written on paper in OCR-B script, and the other possibility was seen as the filing of an application written on paper in any desired typeface but accompanied by a diskette containing the whole of the application text already in digitalised form. There was thus a distinction between a digitalisable text (OCR-B) and a digitalised text (diskette); they are referred to jointly in the following as "digital text".

Applications often contain chemical and/or mathematical formulae, Greek characters and/or drawings. In this field there will still be difficulties in digitalisation for some time to come. Moreover the texts written in OCR-B typeface have to be converted into digital form by means of a reader and the texts available in digitalised form on diskettes have to be converted in a converter into digital form, which can be stored in the electronic data processing department of the EPO and then employed directly for setting up the patent specification in type.

At the suggestion of the EPI members of the DATIMTEX working group the EPI engaged in the questionnaire exercise sent to all our colleagues in the summer of 1982, as is well known. The extent of the participation in this exercise was unusually high and so was the readiness expressed by the various offices to support the EPO in the matter of digital text.
It transpired furthermore that the majority of our colleagues showed a preference that not only the patent specifications (the B documents) but also the patent applications (A documents) should be published in typeset form. Typesetting of the A specifications as well would have the substantial advantage that the volume of paper would be drastically reduced as compared with offset printing.

With the support of the very positive result of the questionnaires the DATIMTEX working group then carried out its first practical tests. For this purpose the EPI members on the working group provided application documents of which some were available on diskette and/or written in OCR-B typeface. As the results were encouraging, a subsequent more extensive test was prepared and carried out, in which about thirty offices, some in private practice and some in industry, took part, making altogether seventy-six application documents available. A further eight applications were prepared by the Patent Office internally. With this basic group of applications investigations were made on the extent to which digitalising of texts was possible with the readers and diskette converters available on the market at the time, and what technical problems arose. At the same time these tests formed a basis for further technical, organisational and financial investigations. The evaluation of all the test results has supported the view of the DATIMTEX working group that there are no fundamental problems to be expected.

In the analysis of the test results the basic assumption was made that in the manual typing of applications a typing error percentage of 1% is just tolerable, i.e. around 20 wrong characters per typewritten page. According to the estimates of the EPO, with such a degree of error the work involved in correction is within acceptable limits. In the above-mentioned internal capture of eight applications a typing error rate of 0.24% was obtained, that is to say 5 wrong characters per page.

The application texts written in OCR-B were digitalised experimentally using various different reading equipments and then converted into a form readable by the data processing equipment within the Office, and finally printed out by means of a laser printer for comparison purposes. The digitalisation with the best of the OCR-B readers which were tested resulted in 17% of the original texts lying above the error limit of 1% and consequently requiring significant effort in correction.

The texts filed on diskettes were first converted into a common intermediate format and then converted into the form required for the data processing equipment in the EPO. They were again printed out using the laser printer. Comparison of the original texts filed with diskettes with the electronic printouts showed that all the texts lay below the 1% error level. Apart from two exceptions having error quotes of 0.37% and 0.43%, all the remaining applications had conversion errors of only 0.07% or lower. Accordingly, the error rate in the diskette processing step was a long way below that in the processing of the OCR-B.

In the analysis of the conversion errors account must be taken of the fact that these errors do not lead to any legal problems if the basis for the patent right remains the originally filed text and if conversion errors are not the responsibility of the patentee.

Looked at overall, the results of the test were very satisfactory, so that the activity of the DATIMTEX working group is continuing with the aim, set by the President of the EPO, of giving all applicants the possibility from 1st January 1985, on a voluntary basis, of filing the original texts accompanied by diskettes or of typing the original texts in OCR-B typeface. The voluntary nature of this will also apply in the future.

From the beginning the EPI members of DATIMTEX have emphasised that those applicants who assist in the digitalisation sought by the Patent Office by providing diskettes or texts written in OCR-B must be given an appropriate reduction on the fees because it is they who allow the reduction in costs by their own additional outlay.

Those of us who still do not have any word processing equipment yet who wish to support the EPO in its digitalisation will be able to do this with a minimum outlay. All that is necessary is to buy a golf ball or daisywheel with an OCR-B typeface.
LE GROUPE DE TRAVAIL DATIMTEX DE L'OFFICE EUROPÉEN DES BREVETS
par : Angus Duncan, Dieter Speiser, André van der Auweraer

En 1981, à la recherche des possibilités de faire des économies lors de l'impression des fascicules de brevets européens, l'OEB a eu l'idée de prêter les déposants de remettre le texte des demandes de brevet sous une forme déchiffrable par la machine en vue de réduire, dans les imprimeries, les frais de composition considérables. Par la suite, l'OEB a décidé de former un groupe de travail qui s'occupera de questions de transformation en forme digitale du texte des demandes de brevet et le Président de l'OEB a invité l'EPI à collaborer dans ce groupe de travail. Après cela, le Conseil de l'Institut a désigné les collègues Van der Auweraer (BE), Duncan (GB) et Speiser (DE) au sein du groupe de travail qui a commencé ses activités le 3 et le 4 mai 1982. En même temps, ce groupe a reçu le nom DATIMTEX.

L'OEB s'était déjà fait une idée des possibilités techniques et des problèmes juridiques. Au point de vue juridique, il fallait partir du fait que la Convention sur le brevet Européen accorde à plusieurs endroits la nécessité de la forme écrite, ce qui, d'ailleurs, se comprend dans la perspective historique. Cette circonstance a eu pour effet que pour toutes ses activités futures, le groupe de travail DATIMTEX était contraint à partir du principe selon lequel on ne peut pas s'écarter de l'exigence de déposer le texte des demandes écrit sur papier.

Du point de vue technique, tout d'abord deux possibilités se profilait. Comme première possibilité, on considérait le dépôt de demandes écrites sur papier en caractères OCR-B et comme deuxième possibilité, le dépôt d'une demande dactylographiée sur papier en caractères quelconques, en plus d'un disque contenant le texte complet de la demande déjà sous forme digitalisée. On distinguait donc entre un texte pouvant être digitalisé (OCR-B) et un texte digitalisé (disque), qui, ci-après, sont conjointement désignés "texte digital".

Sous la rubrique des demandes contiennent des formules chimiques et/ou mathématiques, des caractères d'identification grecs et/ou des dessins. Lors de la transformation en forme digitale, il y aura des difficultés pendant quelque temps encore. Par ailleurs, il est possible de transformer les textes écrits en caractères OCR-B au moyen d'un appareil de lecture et les textes présents sur disque sous forme digitalisée au moyen d'un convertisseur en une forme digitale capable d'être stockée dans la mémoire électronique de l'OEB et d'être ensuite utilisée directement pour la composition du fascicule de brevet.

En raison d'une suggestion des membres de l'EPI dans le groupe de travail DATIMTEX, l'enquête que vous connaissez a été menée par l'EPI en 1982 parmi tous les collègues. Le taux de participation à cette action fut particulièrement élevé, aussi bien que la disposition démontrée par les bureaux pour assister l'OEB en matière textes digitaux.

En outre, il s'est avéré que la plupart des collègues préféreraient voir imprimés sous forme composée non seulement les fascicules de brevet (documents B), mais aussi les demandes mises à la disposition de l'OEB (documents A). Une composition aussi des documents A aurait le grand avantage que la maquette de papier serait réduite de manière radicale en comparaison de celle de l'impression offset actuelle.

En se basant sur les résultats positifs de l'enquête, le groupe de travail DATIMTEX a alors effectué des premiers essais pratiques. Pour ceci, les membres de l'EPI du groupe de travail ont mis à sa disposition le texte de quelques demandes, qui se trouvait sur disque et/ou était écrit en caractères OCR-B. Les résultats étaient encourageants, on a ensuite préparé et effectué un essai étendu, auquel ont participé une trentaine de membres de divers secteurs de la profession et de l'industrie, qui, au total, ont mis à la disposition 76 textes de demandes. Huit autres demandes ont été préparées au sein des services de l'OEB même. Au moyen de cet ensemble de demandes, on a étudié dans quelle mesure une transformation en forme digitale du texte des demandes par des appareils de lecture et par des convertisseurs à disque se trouvant actuellement sur le marché est, en principe possible, et quelle est la nature des problèmes techniques qui surgissent. En même temps, cet essai devait constituer la base des considérations techniques, organisi er et financières ultérieures. L'évaluation de tous les résultats de ces essais a confirmé le groupe de travail DATIMTEX dans ses considérations et montré qu'il ne surgira point de problèmes fondamentaux.

Lors de l'évaluation des résultats des essais, on a pris comme point de départ qu'en dactylographiant des demandes à la main, un taux d'erreurs de 1 % est encore juste admissible, c'est-à-dire qu'en l'absence de fautes typographiques. Selon l'opinion de l'OEB, les travaux de correction de textes à une limite d'erreurs pareille restent encore dans un cadre justifiable. Lors de la préparation interne par les services de l'OEB même de huit demandes, par exemple, le taux d'erreurs était de 10 à 15 %. Un essai avec des demandes de haute densité de fautes typographiques, a d'ailleurs mis en évidence un taux d'erreurs de frappe de 0,24 % = 5 signes fautes par page.

A titre d'essai, le texte des demandes écrit en caractères OCR-B a été digitalisé sur différents appareils de lecture, transformé ensuite en une forme déchiffrable par l'ordinateur de l'OEB et enfin imprimé à nouveau au moyen d'une imprimante à faisceau laser à des fins de comparaison. La transformation en forme digitale avec le meilleur des appareils de lecture OCR-B examinés a montré qu'après la transformation, 17 % des textes originaux dépassaient la limite d'erreurs de 1 % et, par conséquent, exigendaient des frais de correction assez élevés.

Les textes déposés sous forme d'enregistrement sur disque sont tout d'abord été convertis en un format intermédiaire commun et ensuite transformés en la forme requise pour l'ordinateur de l'OEB. Après, ils ont été imprimés à nouveau par l'imprimante à faisceau laser.
Une comparaison des textes originaux déposés accompagnant les disques lors du dépôt, avec les impressions fournies par l'ordinateur, a montré que tous les textes se trouvaient au-dessous du taux de 1%. En dehors de deux cas aberrants avec 0,37 et 0,43% de taux d'erreurs, toutes les autres demandes accusaient des erreurs de conversion de 0,07% seulement et moins. Ainsi, le taux d'erreurs lors du traitement de disque était bien inférieur à celui du traitement OCR-B.

En évaluant les erreurs de conversion, on doit prendre en considération que ces erreurs n'aboutissent pas à des problèmes juridiques, si le texte déposé originellement reste la base pour le droit concernant les brevets et si les erreurs de conversion ne sont pas à charge au titulaire du brevet.

En général, les résultats des essais étaient très satisfaisants, de sorte que l'activité du groupe de travail DATIMTEX est poursuivie avec le but donné par le Président de l'OEB, à savoir de donner à tous les déposants à partir du 1er janvier 1985, sur base volontaire, la possibilité de présenter des disques ou autres textes originaux, ou bien de dactylographier ces derniers en caractères OCR-B. Le caractère volontaire restera valable dans le futur.

Dès le début, les membres EPI de DATIMTEX ont insisté pour que les déposants appuyant activement les efforts d'informatisation de l'OEB par le dépôt de textes écrits en caractères OCR-B ou enregistrés sur disque, doivent recevoir une détaxe, étant donné que ce sont eux qui permettent une diminution des frais par le propre surcroît de dépenses.

Ceux parmi nous qui ne disposent pas encore de machines de traitement de texte et pourtant voudraient appuyer l'OEB lors de l'informatisation, pourront faire ceci à peu de frais. Pour cela, il ne faut qu'une boule ou une marguerite à caractères OCR-B.

1. **Background**

Matters relating to representation before the European Patent Office are to be found in Part VII of the European Patent Convention (common provisions). Chapter III of Part VII comprises two articles, Article 133, general principles of representation, and Article 134, professional representatives. Article 134(8) EPC in particular empowers the Administrative Council to adopt provisions governing:

(a) the European Qualifying Examination, (1)
(b) the establishment of an Institute constituted by persons entitled to act as Professional Representatives before the European Patent Office, (2) and
c(c) any disciplinary power to be exercised by that Institute or the European Patent Office on such persons. (2)

The purpose of this article is to describe the disciplinary bodies set up under the Regulation on discipline and to examine the experience made so far in their operation in the first few years of the life of the Office.

2. **The Rules of Professional Conduct**

The Regulation establishing the Institute of Professional Representatives (Article 4(c)) lays down that one of the objectives of the Institute is to promote compliance by its members with the Rules of Professional Conduct, inter alia through the formulation of recommendations. These recommendations - in the form of a Code of Professional Conduct - were approved by the Council of the Institute at its meeting in Brussels on 14 November 1979. (3)

The recommendations in the Code cover such topics as advertising by members, relationship with the public, relationship with clients, relationship with other members, with the European Patent Office and with the Institute of Professional Representatives.

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(2) The Regulation on the establishment of the Institute and the Regulation on discipline were both published in Official Journal 2/1978, at pages 86 and 91 respectively.

Une comparaison des textes originaux déposés accompagnant les disques lors du dépôt, avec les impressions fournies par l'ordinateur, a montré que tous les textes se trouvaient au-dessous du taux de 1 %. En dehors de deux cas aberrants avec 0,37 et 0,43 % de taux d'erreurs, toutes les autres demandes accusaient des erreurs de conversion de 0,07 % seulement et moins. Ainsi, le taux d'erreurs lors du traitement de disque était bien inférieur à celui du traitement OCR-B.

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THE DISCIPLINARY BODIES FOR PROFESSIONAL REPRESENTATIVES BEFORE THE EUROPEAN PATENT OFFICE by B.I. Cawthra Rapporteur Disciplinary Board

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The recommendations in the Code cover such topics as advertising by members, relationship with the public, relationship with clients, relationship with other members, with the European Patent Office and with the Institute of Professional Representatives.

(2) The Regulation on the establishment of the Institute and the Regulation on discipline were both published in Official Journal 2/1978, at pages 66 and 91 respectively.
3. Disciplinary measures

The Regulation on discipline (Article 4(1)) lays down that a professional representative who fails to comply with the Rules of professional conduct may incur one of the following penalties:

(a) a warning,
(b) a reprimand,
(c) a fine not exceeding DM 20,000,
(d) deletion from the list of professional representatives for not more than six months,
(e) deletion from the list of professional representatives for an indefinite period.

Article 4(2) goes on to provide that these penalties may also be incurred if a representative fails to pay within two months of the due date for his annual subscription to the Institute. The question of non-payment of subscription assumes importance in the context of the rule of compulsory membership.

4. Compulsory membership

The Regulation on the establishment of the Institute (Article 5(1)) lays down a rule of compulsory membership, viz., that all persons on the list of professional representatives shall be members of the Institute.

This Regulation, like the Regulations on the European Qualifying Examination, the Regulation on discipline, and the Regulation on proposals made by the "Committee of Four", four bodies representing the interests of the profession, CNIPA, FICPI, FEHIFI and UNION (4),

Compulsory membership was proposed by the four organisations and the Interim Committee considered that this was necessary in the interests of a strong unified profession, subject to the same ethical standards and disciplinary measures, and of providing a body which could be regarded as the privileged negotiating partner of the European Patent Office and one capable of exercising a considerable influence on the development of the European Patent system(5). It is significant that the rule of compulsory membership was proposed by the representatives of the profession; it was not something imposed on the profession by governments.

Writing in an article published in CIPA in 1976 (6) Ron Bowen, Assistant Comptroller, UK Patent Office, remarked on the difference in these matters between British thinking, based on a long and easy relationship between the Chartered Institute and the Patent Office, and the more rigid and legislative continental approach.

4. CNIPA - Committee of National Institutes of Patent Agents
FICPI - Federation Internationale des Conseils en Propriete Industrielle
FEHIFI - Federation Economique des Mandataires de l'Industrie Exemptees (CNIPA)
UNION - Union of European Practitioners in Industrial Property

5. Three Disciplinary Bodies

(a) Disciplinary Committee of the Institute

The first instance is the Disciplinary Committee of the Institute which, unlike the other instances, consists exclusively of members of the Institute. The Chairman is also a member of the Institute. The jurisdiction of the Disciplinary Committee is limited in two ways. It may only impose a penalty of a warning or reprimand; if it considers that a more severe penalty is warranted it must refer the matter to the Disciplinary Board of the European Patent Office. If the Committee does not take a final decision within nine months of the alleged breach of the Rules being brought to its notice, it must submit a report on the state of proceedings to the Chairman of the Disciplinary Board - Article 6(2) and (3) of the Regulation on discipline. On receiving the report or on expiry of the nine months time limit the Chairman of the Disciplinary Board may transfer the matter to the Board. The names of the Chairman and members of the first Disciplinary Committee of the Institute were published in the Official Journal(7).

(b) Disciplinary Board of the European Patent Office

The Disciplinary Board of the European Patent Office consists of three legally qualified members of the European Patent Office, including the Chairman, and two professional representatives. They are appointed by the President of the European Patent Office for a period of three years. The names of these first appointed members were published in the Official Journal(7). The Disciplinary Board considers any alleged breach of the Rules of Professional Conduct which is referred to it by the Disciplinary Committee or transferred to it by its Chairman on reviewing a case, may decide to dismiss the matter or to impose a penalty. Unlike the Disciplinary Committee, the Disciplinary Board may impose any of the five penalties listed in Article 4 of the Regulation on discipline.

(c) Disciplinary Board of Appeal of the European Patent Office

The second instance is the Disciplinary Board of Appeal which hears appeals against final decisions, including dismissals, of the Disciplinary Committee of the Institute and the Disciplinary Board. The Disciplinary Board of Appeal consists of three legally qualified members, including the Chairman, and two professional representatives.

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(5) See Interim Committee document CI/Final/876 Annex 2b, point 4.

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In particular he noted the natural distaste among many British patent agents for the notion of compulsory membership. Nonetheless British history and tradition differed remarkably from those on the Continent and, for success in setting up the first truly European profession, it was inevitable that the majority view must prevail.

6. Failure to pay annual membership subscription

The largest part of the work so far done by the disciplinary bodies has concerned the failure of thirty-two members to pay their annual membership subscriptions for 1978 and 1979 to the Institute of Professional Representatives.

By decision of 26 February 1981 the Disciplinary Committee came to the conclusion that their powers to deal with the cases were insufficient and referred them to the Disciplinary Board.

After the rapporteur had made certain enquiries the Disciplinary Board decided all the cases by decisions dated 31st January 1983.

7. 32 decisions of the Disciplinary Board

The Disciplinary Board dealt with the 32 decisions of non-payment in the following manner.

(a) In two cases the representative concerned had died before the Board took its decision not to take any further action. The Board was subsequently informed after taking its decision of the death of a third representative and decided in this case also to take no further action.

(b) In five cases the representatives concerned were no longer on the list of professional representatives before the EPO. The Board decided to take no further action in these cases, reserved the right to re-open proceedings in case any of the representatives applied to be restored to the list. The consideration in these cases was that the Board had no jurisdiction over persons who were on no longer on the list.

(c) In three cases the representatives who are still on the list gave an adequate explanation of why they had paid the subscriptions late. Accordingly the Disciplinary Board decided to take no action in these cases. It should be pointed out the offence is not so much failure to pay the membership subscription as failure to pay the subscription in due time - see Article 4(2) of the Regulation on Discipline.

(d) This is made clear in three further cases where the representatives who are still on the list paid the subscriptions late but gave no explanation. These were the first cases in which the Board decided to impose a penalty, in this case a reprimand.

(e) In the remaining eighteen cases where the subscription remained unpaid and the representative concerned had given no explanation the Board imposed a fine, to be paid to the EPO.

The amount of the fine was DM 800 where the subscription for both years 1978 and 1979 was unpaid and DM 400 where only one year's subscription was unpaid. The fine amounted to 200% of the annual subscription which was DM 200 for each year in question. In addition the decision required the representative to pay the unpaid subscription(s) to the Institute.

8. Action following the decisions taken by the Disciplinary Board

In three cases out of eighteen the fine was paid together with the subscription to the Institute. In three further cases an appeal against the decision was lodged with the Disciplinary Board of Appeal. In another case new facts came to light after the decision had been taken and as a result the Board decided to take no further action.

In the remaining eleven cases the Board decided to take steps to enforce payment of the fines imposed through the Bank. Furthermore the Registrar of the Disciplinary Board filed complaints with the Disciplinary Committee of the Institute against the eleven representatives who had failed to pay the fine. Such failure is, in accordance with Article 28(1) of the Regulation on discipline, a further breach of the Rules of Professional Conduct. Finally the Board decided to publish the full text of one decision imposing a fine of DM 800 in the Official Journal. It is expected than the decision will appear in the Journal before the end of this year. One more representative paid the fine imposed as a result of the enforcement procedure.

9. Conclusion

These were the first disciplinary cases involving the non-payment of subscriptions to the Institute of professional representatives before the EPO. It is hoped that the action taken by the Disciplinary Board, particularly the publication of the decision imposing a fine of DM 800, will lead to an increasing awareness of the rules amongst the members of the Institute. This increasing awareness should help to reduce the number of such cases in future. Furthermore the experience gained by the Board in dealing with these first cases will be invaluable to the Board when it comes to deal with the cases arising from years subsequent to 1979.
EUROPEAN JURISDICTION REGARDING THE PROTECTION OF COMPLEXES OF INVENTIONS, CONSISTING OF CHEMICAL PRODUCTS, INTERMEDIATE PRODUCTS OBTAINED IN THE COURSE OF PREPARING THE PRODUCTS AND PROCESSES OF THE END PRODUCTS AS WELL AS INTERMEDIATE PRODUCTS.

by

GERHARD BURLING

Two basic questions are of importance for the patent protection of the a.m. complex of inventions:

A) Are products and intermediates including a greater number of products of several intermediate steps obtained in the course of preparation of the products, and the preparation of all these products patentable as uniform invention in one and the same patent or must they be regarded as separate inventions for which separate patents must be applied for in each case?

B) Are intermediate products patentable which are not useful by themselves except that they are suitable for further processing resulting in a commercially useable end product?

Question A can be of considerable importance for reasons of costs, because the necessity to apply for separate patents would mean that the costs multiply for a European patent that are already high, i.e. the costs for application, search, translation, annuities etc. would multiply.

Question B is quite obviously of considerable importance, because intermediate products, on the one hand, can be independent commercial products which are delivered to companies finishing the product and, on the other hand, a complete patent protection exists only if it is precluded that the patent is circumvented by preparing and delivering just an intermediate of the patented product to a patentfree country for preparing the end product in that country.

This complex of questions has now been answered in principle by the Board of Appeal of the European Patent Office in 3 decisions (regarding applications of the company Bayer). These are the following decisions:


It must be pointed out that decisions I and II deal only with the question of unity but not with the question of inventive step, i.e. with the question outlined under A), while decision III comments on the question of an inventive step as defined under B).

In the case of the decision I "Copoly carbonates", the question had to be studied whether the complex: intermediate product-end product can be recognized as uniform invention in a case where an intermediate product, namely a monomer compound, is polycondensed to a thermoplastic copoly carbonate of high molecular weight, and the copolycarbonates can be mixed with other thermoplastics.

The Examining Division of the European Patent Office had rejected such a complex of inventions for lack of unity. Only the claims directed to the copolycarbonates, their preparation and mixtures containing such copolycarbonates were uniform, while the claim concerning the intermediate product, namely the monomer compound, can be regarded as being in unity with the claim directed to the further processing but not with the complex concerning the copolycarbonate and its mixtures.

In the appeal procedure the Technical Board of Appeal of the European Patent Office revised then the decision of the Examining Division and stated that the end products (copolycarbonates) and the intermediate products (monomer compound) necessary for the preparation of the end products must be regarded as a group of inventions according to Article 82 of the European Patent Convention, and the inventions of this group are interconnected in such a way that they realize one single, general inventive idea. The connection between the groups of invention: intermediate product and end product, consisted in the fact that the intermediate product is provided with view to its property i.e. to lead to valuable new end products resp. their mixtures by means of the method of further processing the intermediate product to the end product. Thus a technological interconnection existed of the parts of the invention: intermediate product and end product, combining both constituent parts of the invention in a single overall concept.
Result: In an invention claiming a monomer and a polymer as well as a process of preparing the polymer from the monomer, the claims are uniform which comprise the intermediate product (monomer), the end product (polymer) and the preparation of the end product (polycondensation of the intermediate product).

The preparation of the intermediate product (i.e. of the monomer compound) was not claimed in the present case. However, the reasons of the decision indicate that even a claim must be regarded as being in unity with the remaining claims.

Decision II "Benzy1 ester/BAYER" concerns a case where intermediate products as well as end products are monomer compounds. The special point is that four different intermediate products were claimed besides the end product, i.e. the four intermediate stages of the process leading to the end product, namely benzy1 alcohols, benzy1 halides, benzy1 aldehydes and benzy1 amine. Besides, the process for preparing the end products and the process for preparing the intermediate products were claimed, too.

Also in this case the Examining Division of the European Patent Office had viewed the complex of inventions as lacking unity and therefore rejected the patent application. The Examining Division based the decision, among other things, on Rule 46 of the European Patent Convention. According to this Rule, the Examining Division had divided the invention into six parts and included only the first part in the search. As regards the other parts, the Search Division demanded the payment of additional search fees in case these parts were maintained. Accordingly, the Examining Division demanded the filing of further divisional applications. Since applicants (Bayer) considered the demand to be unjustified, they refused the filing of divisional applications as well as the payment of further search fees. Thereupon the Examining Division rejected the patent application.

This decision was revised by the Board of Appeal. The Board of Appeal stated that Rule 46 EPC concerns the Search Division and authorizes this Division to ascertain provisionally the unity and consequently to demand additional search fees, while this Rule does not concern the Examining Division, i.e. the Examining Division must decide totally independently of the opinion of the Search Division and it can, if necessary, revise the provisional opinion of the Search Division.

The Board of Appeal stated that unity exists also in the present case, because the end product as well as all intermediate products contain a common structural feature forming the "core" of the benzy1 esters (end products) as well as of their intermediates.

The Board of Appeal stated that there is a difference to the case "Copolymerization" (decision 1) inasmuch as the polymers are prepared on polymerization - normally in a single-stage process - from a single monomer which forms the basis. In contrast thereto, a plurality of intermediates comes into consideration in the preparation of monomer compounds, each of which being suitable not only for the production of the desired end product but also for different reactions. For this reason it must be taken care that the technical interconnection between intermediate and end product does not get lost with the increasing disparity of this pair. However, the technical interconnection did not exist in the present case, because all claimed intermediate products, the end product as well as all intermediate products, share an essential structural feature. Thus the comprehensibility of the whole complex of the inventions was maintained also for the documentation so that a group of inventions existed in accordance with Article 82 EPC, the inventions being interconnected in such a way that they realize a single general inventive idea.

Result: even in the field of monomers, a complex of inventions has unity that comprises an end product and a greater number of intermediate products which are the direct and indirect intermediates of the end product. The Board of Appeal stated, however, that the present case must be regarded as border case for the recognition of unity.

Decision III "Cyclopropane/BAYER" deals with the inventive step of a complex of inventions consisting of new intermediate products being further processed in a non-inventive analogous process for the production of end products which are inventive due to their properties.

The Examining Division of the European Patent Office had negated the inventive step in the case of the intermediate products, because the intermediate products have no own patentability properties, and the properties of the end product are only partly due to the structure of the intermediate product. The Examining Division had taken into account that compounds belong to the prior art which have the same structure as the analogous intermediate compounds of the intermediate products. The intermediate products are special carboxylic acids converted by esterification to the respective esters with insecticidal effect. The claimed intermediate products represent a selection from a known group so that the further processing to the end product by means of the esterification known per se was predictable for the chemist and thus not inventive. Insofar as the special insecticidal properties of the end product could be attributed to the intermediate product, these properties could be also transferred to known analogous compounds, because the latter led to respective end products when they were further processed by means of the non-inventive process.

The Board of Appeal revised the decision of the Examining Division and stated the patentability. In this connection, the Board of Appeal mentioned the following criteria in favour of the patentability of a complex of inventions consisting of intermediate and end products:

When assessing the patentability of intermediates, these must be compared with a prior art which is relevant for the intermediate itself as well as with a prior art which is relevant for the end product prepared from the intermediate. This means that the prerequisite for the patentability of the intermediate is the
possibility to derive the intermediate either from the prior art close to the end product. This means with view to the prior art close to the end product (ester) must not contain the claimed intermediate (carboxylic acid) as acid constituent. This means with view to the structure of the claimed intermediate which is introduced into the end product ("structure contribution") must show features which differentiate the end product from the compounds of the prior art which is close to the product ("contribution to the structural differentiation"). In more concrete words, the following conclusion can be drawn herefrom:

If the carboxylic acid claimed as intermediate in the present case had been contained already as acid constituent in a known ester differing from the claimed ester end product only by the alcohol content, there would be no inventive step for the claimed intermediate. In other words, the carboxylic acid (intermediate) would have been obvious to the skilled man in this case, because he would have recognized it easily as an intermediate suitable for the production of the known ester. The non-inventiveness of the intermediate in this case is given by the fact that the differences between end product and end product-close known products is not caused by the intermediate, i.e. not caused by the structure contribution of the intermediate to the end product.

As regards the prior art close to the intermediate an inventive step exists only if the known compounds which are close to the claimed intermediate do not show that a product with the properties of the claimed end product can be prepared by further processing. In the present case, the known products had a structure analogous to that of the claimed intermediate. However, this does not yet mean that the preparation of the claimed end product was obvious, because even very similar compounds do not show that a new variant due to its changed structure causes a surprising difference in the effect of the end product. Although the known compounds by an analogous further processing lead to compounds which are analogous with the claimed end product and thus, the skilled man can easily prepare a product which is identical with the claimed end product, an inventive step exists in the present case, because it had not been obvious that the specific end product (with specific properties) can be prepared in this way. The definite changes necessary in comparison with the prior art which is close to the intermediate are unpredictable without the knowledge of the problem to produce the desired end product. For this reason an inventive step exists also as regards the prior art close to the intermediate, i.e. as regards the known compounds which are very closely related to the claimed intermediate.

The decision further indicated that also an advantage of the process comes into question as criterion of the inventive step. Such an advantage substantiating the inventive step would be that the claimed intermediate, due to the changed structure, shows an unexpectedly good reactivity in the further processing in comparison with relevant known compounds, or leads to a surprisingly higher yield. Still, it must be stressed that there is a difference to the German jurisdiction regarding intermediates inasmuch as it is sufficient for a German "intermediate patent", if the intermediate is new in comparison with comparable known compounds provided that the surprising technical progress of the end product is due to the structure contribution of the intermediate product ("causal connection"). According to the European jurisdiction, the intermediate in contrast thereto must be inventive, besides being new, in comparison with known compounds (prior art which is close to the intermediate).

If the intermediate is new in comparison with comparable known compounds provided that the surprising technical progress of the end product is due to the structure contribution of the intermediate product ("causal connection"). According to the European jurisdiction, the intermediate in contrast thereto must be inventive, besides being new, in comparison with known compounds (prior art which is close to the intermediate).

Result: The complex of inventions consisting of intermediate, end product and a non-inventive process for preparing the end product from the intermediate is patentable if the end product shows effects which are surprisingly advantageous in comparison with comparable known compounds, and

1. the intermediate product renders a structural contribution to the end product, which contribution differentiates the end product from known products (end product-close prior art),

2. the intermediate is new in respect of the prior art close to the intermediate as well as the prior art close to the end product, and is inventive - when considered separately in each case. This is the case if

   a) the claimed intermediate cannot be derived from known compounds which are close to the claimed end product, and

   b) it is not recognizable from known compounds close to the claimed intermediate that the claimed end product with special effect can be prepared therefrom i.e. by (slightly) changing the structure.

Summary:

1. According to recent European jurisdiction, a complex of inventions consisting of intermediate end product and process for their preparation is uniform

   a) in the case of a complex of inventions where a polymer is prepared from a monomer compound (one intermediate product), and

   b) in the case of a complex of inventions where from a monomer compound another monomer compound is prepared via several intermediate stages (several intermediate products).
II. The complex of inventions: intermediate product-end product and non inventive process for producing the end product from the intermediate is inventive if

X) the claimed end product has surprising properties, and

Y) the intermediate product renders a structure contribution to the end product which structure contribution differentiates the end product from prior art products and the intermediate product can be derived neither from the prior art which is close to the end product, nor from the prior art which is close to the claimed intermediate product.