You will be receiving from our Secretariat nomination forms for election to the next Council of our Institute. A number of present Council members, some of whom have served on the Council since the inception of our Institute have indicated their intention to stand down this time to allow others to take their share of the direction of the Institute's affairs.

It is the privilege and duty of all members to see that suitable candidates are nominated. Nomination forms must be returned by 30 November 1984 at the latest.

Ballot forms will be mailed to members in January 1985.

Jean Brullé, Ernst J. Schönhofer, Ken Veryard

EPI Information 3-1984
LETTERS TO THE EDITOR

From: Mr. R.A.A. Hurst, British member of the EPI

Dear Sirs,

THE EUROPEAN QUALIFYING EXAMINATION

My younger colleagues who have recently sat the European Qualifying Examination have drawn my attention to the increasing use of non-English documents in that Examination, as presented to English speaking candidates.

The Examination includes papers involving claim drafting (Paper A), preparation of a response to an Official Letter (Paper B) and preparation of an Opposition (Paper C). In previous years, non-English language prior art has been provided, without translation, in Paper C only - one document was supplied in each of the Official Languages. This year however, in the specialist chemical papers, non-English language prior art was also provided, without translation, in Papers A and B. In Paper C, only one of four relevant prior art documents was in English. These changes are in line with an amendment to Article 11 of the Examination Regulations which came into effect in June 1983 and there is every reason to believe that further changes may be introduced in coming years.

Whilst accepting that it is high time that we British improved our knowledge of the other official languages, it is my strong feeling that examination should be designed primarily to assess a candidate's competence to deal with patent-related issues. However, the examination format which appears to be developing lays undue emphasis on a candidate's linguistic abilities. Since, as increasingly seems to be the case, candidates are required to work with information gleaned from their own, possibly inadequate, translation of non-English language documents, a fair assessment of a candidate's true ability in the more important patent-related matters, may not in fact be realised. Some candidates may not be competent linguists, but this should not, in my view, prejudice their chances of qualifying. In principle, a candidate's ability to translate prior art in one of the official languages has no more bearing on his competence as a Patent Attorney than does his ability to translate prior art in any other language, for example Japanese or Dutch. The use of non-English language documents in the Examination imposes an unnecessary burden on candidates and puts some candidates at a considerable disadvantage, particularly those whose mother tongue is not one of the Official Languages.

I can appreciate that some officials of the EPO wish to encourage Patent Attorneys to be more competent in the three official languages. If, in practice extra time and expense are involved in having a translation made, then this will be reflected in reduced income for the professional representative and/or increased costs to the client. This economic incentive to increased language ability should be sufficient and the matter should not, in my view, be a concern for the Examination Board nor should it be an objective of the Qualifying Examination.

Yours faithfully,

R.A.A. Hurst

EPI Information 3-1984
DATIMTEX

Bericht über die jüngsten Entwicklungen


An beiden Sitzungen waren nicht nur Mitglieder von DATIMTEX, sondern darüber hinaus ein oder mehrere Vertreter nationaler Patentämter aus den meisten Mitgliedsstaaten erschienen.

Bei der Sitzung im November waren außerdem zwei Vertreter von WIPO und zwei Vertreter des U.S. Patent- und Markenamtes anwesend, nämlich Brad Huther, Assistant Commissioner, und Dr. Howard Bryant, den das amerikanische Patentamt zwei Jahre zuvor mit der speziellen Aufgabe eingestellt hatte, einen Automationsplan einzuführen.

Der Vorsitzende von DATIMTEX, Herr Dornow (EPA-Vizepräsident, DG-4) referierte die Zielvorstellungen dahingehend, daß der Qualitätsstandard aufrecht zu erhalten und die Personal- und sonstigen Kosten durch Benutzung der modernen Technik niedrig zu halten seien. Veränderungen könnten nicht plötzlich eingeführt werden, weil die existierenden Verträge mit den Druckereien zu beachten seien; außerdem mußten die Druckaufträge aus politischen Gründen auf Mitgliedsstaaten verteilt werden.

Die anwesenden Mitglieder der nationalen Patentämter der Mitgliedsstaaten wurden um ihre derzeitige Meinung gebeten. Der Vorschlag, die A-Schriften im Satzdruck herzustellen, wurde im Grundsatz begrüßt. Hierzu führte insbesondere ein Vertreter der Schweiz aus, daß dieser Vorschlag das schwierige Lagerungsproblem lösen würde, das die Bibliotheken mit der derzeitigen Form der europäischen Dokumente haben.


Die Ergebnisse der durchgeführten Tests zeigten eine Fehlerrate von unter 0,5% mit den meisten Disketten (0% bei bestimmten Diskettentypen) und weniger als 1% bei OCR-B-Dokumenten beim ersten Lese-Durchlauf. In jedem Fall müssen die Unterlagen korrekturgelesen und bei Bedarf korrigiert werden, um Fehler vor dem Druck auszuschließen. Hierfür sind je Anmeldung DM 85,-- in der Kostenplanung berücksichtigt worden.

Es ist die Absicht des EPA, sämtliche Anmeldungstexte baldmöglichst nach Einreichung in digitalisierter Form auf Magnetband zu speichern. Disketten sollen mit Hilfe eines Konverters gelesen werden, von dem erwartet wird, daß er eine breite Typenvielfalt von Disketten und vor allem alle weit verbreiteten Diskettentypen liest und in digitale Form zur Speicherung auf den Magnetbändern umsetzt, die dann den Druckereien geschickt werden. Es wurden drei verschiedene OCR-Lese Geräte untersucht, von denen jedes bezüglich Leistungsfähigkeit, Kosten, automatischem Einzug und Leseergebnissen eigene Vor- und Nachteile hatte.

Diejenigen Anmeldungstexte, die auch weiterhin in der bisherigen Weise eingereicht werden, wird das EPA intern oder
über Unteraufträge digitalisieren.

Es ist beabsichtigt, den Anmeldern deren Disketten zusammen mit dem Recherchenbericht wieder zuzuschicken. Die während des Verfahrens zu machenden Textänderungen sollen vom EPA intern oder von den Druckern auf das Magnetband aufgebracht werden, von dem anschließend die Patentschriften (B-Schriften) hergestellt werden.

Man geht davon aus, daß die Zeichnungen derzeit separat gehendhebt werden müssen, weil die Technik noch nicht so weit ist, diese in wirtschaftlich vertretbarer Weise zu digitalisieren. Dasselbe gilt für die Texte eingebettete chemische Formeln. Das Vorhandensein von (chemischen) Formeln in den Texten vieler Anmeldungen wurde bei der Kalkulation der Kosten berücksichtigt. Man hofft, daß es zu einem späteren Zeitpunkt möglich sein wird, auch diese Formeln (und letztlich auch die Zeichnungen) zu digitalisieren und die digitalisierten Abbilder der Formeln mit den digitalisierten Textzeichen auf einem gemeinsamen Magnetband zusammenzuführen. In diesem Zusammenhang laufen zur Zeit lediglich Experimente.

In Europa ist jetzt ein Stand erreicht, bei dem Druckereien aus den Mitgliedsstaaten aufgefordert wurden, Angebote für den anfänglichen Digitalisierungsvorgang (von Disketten oder OCR-B-Papieren) und für den Satzdruck der A-Schriften (Offenlegungsschriften) auf der Grundlage der sich ergebenden Magnetbänder abzugeben.


Das amerikanische Patentamt erwartet von den Anmeldern derzeit keine Änderung der Einreichungs-Gewohnheiten. Die Digitalisierung wird intern vom Amt oder durch Subunternehmer auf der Grundlage von OCR- oder anderen üblichen Schriften vorgenommen werden. Wenn es in der Zukunft möglich werden wird, Textinformationen und Bildinformationen auf derselben Diskette zu mischen, dann wird man

Anläßlich der Sitzung im Juli 1984 wurde vom EPA nichts zu einem finanziellen Anreiz für die Anmelder gesagt. Die EPI-Vertreter machten jedoch deutlich, daß diejenigen Anmelder und Vertreter, die das Amt freiwillig mit Disketten oder in OCR-B geschriebenen Texten unterstützen werden, wirtschaftlich schlechter dastehen werden als diejenigen, die ihre Anmeldungen in der bisherigen Form einreichen. Sofern kein Anreiz gegeben wird, der die zusätzlichen Kosten und die zusätzliche Arbeitszeit mindestens ausgleicht, wird die Anzahl der erwarteten Anmeldungen in der neuartigen Form weitestgehend von der Höhe abhängen.

Angus Duncan, Dieter Speiser, André van der Auweraer
accompanied by a disk and a further 40% in OCR-B (the EPI members pointed out their figures would depend on the incentives offered), there would be an increased outlay in the first four years, but a net saving at least from 1995 onwards, in addition to the improvement in quality (i.e. a typeset first document) from the start. The intention is now to start accepting OCR-B or floppy disks from 1st July 1985, so that the first typeset 'A' documents will appear in January 1986.

The test had shown an error rate below 0.5% with most diskettes (zero with certain types) and less than 1% with OCR-B on the initial scan. In each case proof reading and correction would be necessary to eliminate errors before printing but DM 85.-- per application had been allowed for this.

The EPO intention is to reduce all application texts to standard digital form on tape as soon as possible after filing; floppy disks would be read on a converter which was expected to be able to handle a wide range of disks, in fact all the widely-used ones, and convert the digital information on to a single standard for the tapes to be sent to the printers. Three different OCR readers had been tested, each with its own advantages and drawbacks with regard to speed, cost, automatic feed and results.

On those applications which continue to be filed in the existing manner the EPO will digitise the text in-house or by contract.

It is intended to return the floppy disk to the applicant with the search report. Amendments made during prosecution will be incorporated eventually on the master tape by the EPO (in-house or through the printers) for the printing of the patent 'B' document.

It is accepted that drawings will have to be treated separately, as at present since we are not yet in a technical position to digitise them on a commercially acceptable basis. The same applies to chemical formulae in the text but, the presence of chemical formulae in the text of a substantial proportion of specifications has been taken into account in the cost calculations. It is hoped that ultimately it will be possible to digitise these formulae (and possibly also the drawings) and merge the digitised images of the formulae with the digitised character of the text on the same disk or tape; at present this is only in the experimental stage.

The stage now reached in Europe is that invitations to tender are now in the hands of the printers in the member states, for both for the initial digitising step (from disk, from OCR-B and from ordinary specifications) and from typesetting the 'A' documents (first publications) from the resulting tapes.

The November meeting heard from Dr. Bryant an outline of the Master Automation Plan of the U.S. Patent and Trade Mark Office. Its scale is vast, involving expenditure of $320 million over eight years and it is already well in hand. The objective is a virtually paperless office. They have a contract with Compumark in Belgium to digitise and store 460,000 existing trademarks, and automation of the Trademark section, including digitising symbol (design) marks, was due to be completed by April 1984. Electronic printing will be introduced before the end on 1984. Dr. Bryant believes the saving in staff and other costs will equal the expenditure on the Plan.

On the Patents side, each U.S. Examiner will have a work-station with a micro-processor and two screens, one for the text of the application in suit, and other for calling up citations and other documents. The screen resolution is 50 pixels per centimetre. Full texts of U.S. Patents from 1970 are already available in digital form and selec-
ted fields will be digitised back to earlier dates, requiring a total of about 30 gigabytes for the text but around 3000 gigabytes (3 terabytes) for the drawings and the text formulae. A single sheet of drawings needs 70 kilobytes. The regularly used material will be in high-speed storage with an access time of 3 seconds. Less frequently used material will be available with an access time of 15 seconds. There will be full-text searching facilities, including alternate search of associated or adjacent words.

In the U.S. Office applicants will not be expected at present to change their filing procedures; the digitising will be done by the Office, in-house or by contract, using OCR, reading any standard typeface. In the future, when it is possible regularly to merge text information and image information on the same floppy disk, they may then welcome disks from applicants.

The EPI representatives are discussing amongst themselves some draft 'Guidelines to Applicants' prepared by the EPO, and will be making their comments before the next meeting of DATIMTEX in Berlin in November.

At the meeting in July 1984 nothing was said on the EPO side about the financial incentive to applicants, but it was made clear by the EPI representatives that applicants and their representatives who were to co-operate voluntarily with the EPO in supplying disks or using OCR-B typeface would be at a financial disadvantage as compared with those who filed in the existing manner unless the incentive at least equalled the full added cost of the added work involved, and so the proportion of applications filed in the desired manner would depend almost wholly on the amount of this incentive.

Angus Duncan, Dieter Speiser, André van der Auweeraer

**DATIMTEX**

**Rapport sur les dernières évolutions**


Etaient présents aux deux réunions non seulement les membres de DATIMTEX, mais aussi un ou plusieurs représentants des Offices nationaux de la plupart des États Membres.

Deux représentants de l'OMPI ainsi que deux représentants de l'Office américain des brevets et des marques ont, d'autre part, participé à la réunion de novembre, à savoir : Monsieur Brad Huther, Assistant Commissioner, et Dr. Howard Bryant à qui l'Office américain des brevets avait, deux ans auparavant, confié la tâche spéciale d'élaborer un plan d'automatisation.

Le Président de DATIMTEX, Monsieur Dornow (Vice-Président de l'OEB, DG-4), a présenté un rapport sur les objectifs à réaliser, à savoir conserver les normes de qualité et maintenir les frais de personnel et autres aussi bas que possible grâce à l'emploi de techniques modernes. Des modifications incipitantes ne peuvent être apportées au système en raison des contrats passés avec les imprimeurs ; pour des raisons politiques, les commandes d'impression doivent, d'autre part, être réparties entre les États Membres.

Les membres présents appartenant aux Offices des brevets nationaux des États Membres ont été priés de donner leurs premières réactions sur la question. La proposition consistant à produire les documents A sous forme composée a été adoptée en principe. Le représentant suisse a
mentionné à ce propos que cette solution résoudrait le
problème délicat du classement qu'ont actuellement les
bibliothèques avec les documents européens.

Des estimations de coûts ainsi que les résultats des tests
effectués ont alors été présentés. En se basant sur 30 000
demandes par an (150 par jour ouvrable) comprenant en
moyenne 18 pages, dont 30 % seraient déposées sous forme
de disquettes et 40 % en caractères OCR-B (les membres de
l'EPI ont mentionné à ce propos que ces chiffres étaient
fonction de certains avantages économiques proposés aux
déposants), le surplus de frais cesserait de croître
durant les quatre premières années, et des économies
pourraient être réalisées au moins à partir de l'année
1995. Une meilleure qualité (obtenue grâce à la composi-
tion des documents A) apparaîtrait dès l'introduction du
système. Les prévisions actuelles envisagent l'acceptation
de documents écrits en caractères OCR-B ou enregistrés sur
disquettes à partir du 1er juillet 1985, de sorte que les
premiers documents A composés pourraient paraître à partir
de janvier 1986.

L'évaluation des résultats des essais effectués a donné un
taux d'erreurs inférieur à 0,5 % pour la plupart des
disquettes (0 % pour certains types de disquettes) et in-
férieur à 1 % pour la première lecture des documents é-
crits en caractères OCR-B. Les documents devront en tout
cas être relus et, si besoin est, corrigés, afin de sup-
primer toute erreur avant leur impression. La somme de 85
DM par demande est prévue pour cela dans l'état financier.

L'OEB envisage de mémoriser le plus rapidement possible,
sur bande magnétique, tous les textes de demandes dès leur
dépôt sous forme digitalisée. Les disquettes seront lues
au moyen d'un convertisseur dont on espère qu'il sera en
mesure de lire un grand nombre de types de disquettes et

surtout tous les types de disquettes les plus largement
répandus, de convertir les textes en une forme digitale
pour qu'ils puissent être mémorisés sur bandes magnétiques
et être ensuite envoyés aux imprimeurs. Trois appareils de
lecture OCR différents ont été étudiés, chacun d'eux
présentant différents avantages et inconvénients quant à
la rapidité de lecture, aux coûts, à l'entrée automatique
et aux résultats de lecture.

L'OEB convertira sous forme digitalisée soit lui-même,
soit en utilisant des sous-traitants, les textes de dem-
mandes déposées sous la forme traditionnelle.

On envisage de renvoyer aux déposants les disquettes ac-
compagnées du rapport de recherche. Les modifications de
texte qui devront être effectuées au cours de la proce-
dure seront faites soit par l'OEB lui-même soit par les
imprimeurs sur les bandes magnétiques à partir desquelles
seront alors réalisés les fascicules de brevets (documents
B).

Il est admis que les dessins devront pour l'instant être
traités à part, étant donné que la technique n'a pas en-
core évolué de façon satisfaisante pour permettre de digi-
taliser les dessins de façon rentable. Il en est de même
pour les formules chimiques insérées dans les textes. La
présence de formules (chimiques) dans les textes de beau-
coup de demandes a été prise en considération lors de l'é-
valuation des coûts. On espère qu'il sera ultérieurement
possible de digitaliser ces formules (ainsi que les des-
sins) et de joindre les reproductions digitalisées des
formules aux caractères digitalisés sur une même bande ma-
gnétique. On n'en est encore, à ce sujet, qu'au stade ex-
périermental.

Le stade actuellement atteint en Europe est le suivant : on
a demandé aux imprimeurs des États-Membres de faire des
offres pour le premier procédé de mise en forme digitali-
sée (de disquettes ou de documents OCR-B) et pour la com-
position des documents A (première publication) à partir
des bandes magnétiques ainsi obtenues.

Pour ce qui est des USA, le Dr. Bryant a donné, lors de la
réunion tenue en novembre, un aperçu sur le "Master
Automation Plan" de l'Office américain des brevets. Le do-
maine compris dans les prévisions est extrêmement vaste.
Les prévisions envisagent des dépenses s'élevant à 320
millions de dollars sur une période de 8 ans, et l'exé-
écution du plan a déjà commencé. L'objectif de ce plan est
d'avoir un office pratiquement dépourvu de tout papier.
L'Office américain a passé un contrat en Belgique avec
Compup-Mark pour la transformation en forme digitale et la
mémorisation de 460 000 marques déposées américaines, et
l'automatisation du domaine des marques déposées y compris
l'informatisation de symboles doit être terminée d'ici
avril 1984. L'introduction de l'impression électronique
doit se faire avant la fin de l'année 1984. Dr. Bryant est
persuadé que les économies réalisées sur les frais de per-
sonnel et autres compenseront les frais entraînés par le
plan.

Dans le secteur brevets, chaque examinateur de l'Office
américain se verra attribuer une station de travail munie
d'une petite calculatrice et de deux écrans dont l'un ser-
vra à présenter les textes des demandes, l'autre à ap-
peler les publications de l'art antérieur et autres docu-
ments. La définition de l'image sur l'écran serait de 50
pixel par centimètre. Il existe déjà des textes complets
de brevets américains datant de 1970 qui ont été mémorisés
sous forme digitale. Pour ce qui est de la quantité néces-
saire d'enregistrement, on cite des chiffres tels que 30
gigabytes pour les textes et environ 300 gigabytes (3 te-
rabytes) pour les dessins et les formules incorporées aux
textes. La mémoire nécessaire pour une page de dessins est
de 70 kilobytes. Les documents dont se servent les exami-
nateurs régulièrement sont enregistrés sur des mémoires à
grande vitesse et apparaissent sur l'écran 3 secondes
après avoir été appelés. Les documents utilisés moins sou-
vent doivent pouvoir être appelés en un temps d'accès de
15 secondes. Il existera des possibilités de recherche
dans l'ensemble du texte ainsi que des possibilités de re-
pérage de mots associés ou avoisinants.

L'Office américain des brevets n'attend actuellement pas
des dépôts que ces derniers modifient la façon de dépo-
sérer leurs demandes. L'informatisation sera effectuée par
l'Office lui-même ou bien par des sous-traitants à partir
des documents OCR ou d'autres documents usuels. Dans la
mesure où il sera, à l'avenir, possible d'enregistrer des
informations de textes et des informations d'images sur
une même disquette, on acceptera alors de telles disquet-
tes des dépôts.

Les membres de l'EPI travaillent actuellement entre eux à
un projet de "Directives pour les déposants" que leur a
soumis l'OEB pour discussion. A ce propos aura lieu une
discussion qui se tiendra avant la prochaine réunion de
DATIMTEX prévue en novembre à Berlin.

Lors de la réunion tenue en juillet 1984, l'OEB ne s'est
pas prononcé sur l'avantage financier qui pourrait être
proposé aux déposants. Les représentants de l'EPI ont ce-
pendant insisté sur le fait que les déposants et leurs
mandataires qui aideront volontairement l'Office en lui
remettant des disquettes ou des textes écrits en carac-
tères OCR-B seront défavorisés sur le plan économique par
rapport à ceux qui déposeront leurs demandes sous la forme
traditionnelle à moins qu'il existe des avantages pour
compenser au moins le surplus de frais ou de temps de tra-
vail et sur le fait que le nombre de demandes déposées
sous la nouvelle forme souhaitée dépendrait dans une large
mesure de ce stimulant.

Angus Duncan  Dieter Speiser  André van der Auweraer
GRACE PERIOD - ARGUMENTS AGAINST

Jean Brullé, French member of the EPI

INTRODUCTION

Is it necessary, or at least useful, to afford to an inventor a period of grace for the disclosure of his invention prior to the filing of a patent application?

This question has been widely debated in recent months and in the framework of the AIPPI at its Buenos Aires Congress in November 1980 and at its meeting in Moscow in April 1982. The 1984/1985 program of the International (Paris Convention) Union for the Protection of Industrial Property provides that the International Bureau of WIPO will prepare a study on the arguments - for and against - a grace period. The first draft of the WIPO study will be considered by a Committee of Experts in Geneva (May 7 to 11, 1984). Both the AIPPI and the WIPO studies argue against the "cons", and, for the "pros", and it is therefore up to the writer to do the opposite, arguing against what is "for" and putting the stress on what is "against" the grace period.

ARGUMENTS IN FAVOUR OF A GRACE PERIOD

In these studies, the main reasons presented in favour of a general grace period are:
- by ignorance or by mistake the inventor is led to disclose all part of his invention and it is unfair that as a consequence he should lose all patent rights;
- an invention must be finalised (or at least optimised) in order to be ready for filing a patent application, there is thus a need to carry out trials which result in a risk of disclosure;
- the inventor may need to obtain scientific and technical advice, with, again, a risk of disclosure;

- the inventor must disclose his invention to an enterprise when submitting an offer or a response to an invitation to supply;
- the inventor may have to disclose his invention without being able to insist on confidentiality in order to seek financial or technical assistance before he is able to apply for protection.

Those in favour of the grace period say that its usefulness and need are particularly great in the case of "isolated inventors", or of "Small Entities" and notably those to be found in "developing countries".

They contend that the grace period is not a "priority right" afforded to the inventor in respect of other persons and is only a matter simply of protecting him against himself (to free him from the disclosure he may have made during this grace period).

They also consider that the use of the grace period provision will be an exception to the general rule which remains that of absolute novelty.

They also consider that the provisions of Article 11 of the Paris Convention (protection in very few exhibitions) is inadequate (no practical application) and that Article 55 of the EPC (abuse) is only of limited scope.

Taking into account the foregoing they propose the conclusion of an International Treaty because corresponding harmonisation of National Laws would be a lengthy procedure.

ARGUMENTS AGAINST A GRACE PERIOD

What are the arguments of the opponents?

The claim that the concept of absolute novelty in connection with patentability should be integrally maintained and that to grant a period of grace would lead to its
adulteration. They consider that the compromise solution adopted in Article 55 of the EPC is satisfactory and should not be called into question.

Another argument against the grace period is the objection that the granting of a period of grace would in fact be against the inventor's own interests and far from protecting him would make him run the risk of being despoiled. The granting of a period of grace will encourage disclosure on account of the impression of immunity it creates and therefore will multiply the risks of litigation. In addition, the opponents claim that the period of grace is a cause of uncertainty for others since those who have knowledge of the disclosed matter may believe that it is freely open to exploitation.

Having weighed up the pros and cons briefly stated above the AIPPI accepted the principle of the institution of a grace period and specified the conditions of application at its Moscow Executive Committee, which appears in the following proposition:

**AIPPI PROPOSITION**

AIPPI declares itself in favour of the principle of introducing a period of grace under the following terms and conditions:

1. A disclosure originating or derived from the inventor shall not by itself establish a right of priority but rather shall not be considered as part of the state of the art against the inventor or his successor in title if it occurs within the grace period;

2. Such disclosure shall include all acts of disclosure to the public by means of a written or oral description by use, or in any other way, notwithstanding where such disclosure takes place;

3. The grace period shall be six months preceding the filing date of the patent application, or, if an Union priority is claimed, the date of the first filing according to Article 4 of the Paris Convention;

4. The burden of proof shall be on the applicant or patentee to prove that such disclosure originated with the inventor or was derived from the inventor;

5. The inventor or his successor in title shall benefit from the grace period without being required to deposit a declaration of such disclosure;

6. The grace period shall apply to patents of invention, inventors' certificates and utility models.

The above conditions of application were drafted after discussions on the following main items:

- The period of grace should be afforded in respect of all acts of disclosure and not only in respect of certain specified acts. It was in fact proposed to restrict the period of delay to disclosure resulting from trials of the invention or from scientific communication but this was discarded under the consideration that if the institution of a period of grace was of utility there was no justification for limiting its application. It was also decided that disclosure may happen anywhere;

- The duration of the period of grace should be very short but nevertheless adequate;

- The secondary disclosure should be exempted on condition that the inventor-patentee prove that it derives directly or indirectly from his act;

- To ensure the security of others, it was proposed that the inventor be required to file a declaration but it appeared that it would constitute an excessive burden upon him;

- Finally the institution of the period of grace should become a general phenomenon (i.e. worldwide).

**GENERAL COMMENTS ON GRACE PERIOD**

The question has been studied many times in the past. In London in 1934, it was decided to leave it to each country to decide whether to provide for a grace period or not. Germany used the grace period from 1936 to 1980 and now
regrets having abandoned it. The U.S.A. and Canada should be excluded from the study because of their “first to invent” concept instead of the usual “first to file” one. Japan (6 months grace period) has provided for a declaration filed within one month from filing an application under certain conditions (scientific congresses, etc). It should be noted that the nationals of the above countries are generally well aware of the absolute novelty condition in force in other countries and take into account its existence avoiding early disclosures to file valid patents abroad.

It must be recalled that many opportunities were provided to raise the question of the period of grace in Strasbourg (1960), in Munich (EP Convention), in Luxemburg (Community patent) as well as in Washington (PCT, Rule 33).

Is there really a need or a necessity to provide for a grace period? In our opinion, the answer is "no" as far as the European Patent Convention is concerned if Article 55 thereof is correctly applied (confidentiality clauses, abuse, etc.).

DETAILED ARGUMENTS AGAINST

Ignorance of the law by the Inventor

Ignorance is not an excuse. Those in favour of the grace period say that the inventor is led to disclose his invention before applying for a patent application and this disclosure is fatal in view of the absolute novelty rule. This is true, but if he is unaware of this rule he will also be unaware of the length of a grace period if any. If he knows that a grace period is offered to him he will use it and file his patent application at the very last minute. He may even decide not to file after his disclosure if the commercial prospects of the invention are not attractive enough. The grace period will then encourage hasty, incomplete, not easily accessible disclosures outside of a patent application which would have been disclosed fully in a patent application.

Everybody knows that novelty searches reveal at present old inventions which could not be reduced to practice when they were made but which can form the basis of further patentable developments later. With the absolute novelty system if an inventor “misses” an invention he may still exploit it with the know how he possesses. Having learned the rules, he will file in due time improvement patents when he finalises his invention.

The applicant must be shown the rule of absolute novelty. One of the fundamental tasks of the Patent Council is to teach his client the rules of the game as soon as he meets him, pointing out that it is a “fair game” that everybody plays honestly.

It should be noted that as soon as contact is established between the inventor and the Patent Agent, the latter can provide advice, draft confidentiality agreements, file a preventive patent application, effect documentary searches with a view to smoothly applying the rules. In fact, the best way to “finalize” an invention is to get in touch with a patent agent. Most individual inventors are generally unable to determine alone when their invention is sufficiently complete to form the basis of a patent application.

Trials, Confidentiality

In our opinion, the problem of disclosure in the course of tests, or of confidential disclosure to obtain technical advice or financial assistance should be solved by a broad interpretation of Article 55 EPC, which in fact provides for a grace period in such cases.
It should however be stated that the filing of a patent application is the best way to be safe in all cases and this would be particularly true with the grace period in force to avoid any possible future litigation (burden of proof).

Isolated inventor, small entities

The precautionary filing of an application is not a problem. The cost of filing is not that high when compared with the cost of the prototypes and their testing. In view of the assistance given by most governments to private inventors or to small companies, their problem of financing the cost of a patent is less acute.

If the invention is not fully disclosed in the first application filed, the inventor will have one year (the Convention Year) and not six months (the proposed Grace Period), to file patent applications which will amplify the first one.

The various foreign applications based on a combination of the original applications may claim multiple priorities under the Paris Convention. The inventor has normally eighteen months in which to file subsequent applications after the first one without the later being opposable thereto as far as novelty is concerned.

There exists a peculiar type of inventor, the "scientist", who may disclose inventions before scientific audiences or succumb to the temptation of publishing. It is true that a grace period would be welcomed by such an inventor. The research industry is in favour of the grace period to take into account such people. In our opinion, the solution is to teach them to "hold their tongue" and to see the patent people before disclosing any new development.

Absolute novelty

The concept of absolute novelty is the "key stone of the arch" when considering the framework of the EPC (Article 54) and of the PCT (Rule 33). For years everybody appreciated everyday the advantages of the absolute novelty rule:

"No patent in the case of a prior disclosure made, even by the Applicant". Prior art searches need only take into account the date of the first filing (without ambiguity). It is a "clear cut" situation. This is at least one point of certainty in a complex structure - a solid basis for a documentary search.

An exception to the rule has been provided for according to the harmonisation to protect against abusive disclosure by third parties without the consent of the inventor (Article 55 EPC).

Effects of the possible institution of a general period of grace

Assuming that the institution of a General Period of Grace were established what kind of contact will be created between the inventor and the Patent Counsel?

The new rule of the game will provide the inventor with the facility of not having to worry with respect to protecting his invention. He will certainly want to have the benefit of the new provision of the Law. The new Law being so applied, the Patent Agent will have clients coming to see him in respect of their invention which may already have been disclosed, or be in the process of being tested or evaluated by a potential purchaser, etc. The Patent Agent will have to ask them questions so as to determine the various disclosures that have occurred (dates, places, content, etc.) even before starting to
talk about the invention. It will be necessary to determine whether they are still within the period provided by the new Institution and, in the affirmative, try to obtain the necessary proof which might be necessary later in case of litigation. This will result of course in additional costs to the inventor.

All the patent filing work currently carried out under the rule of the absolute novelty will still have to be done but it will be increased because it will be necessary first to locate and then to take into account the prior art documents published by third parties during the six months grace period. With an application filed six months earlier this supplemental work would have been avoided.

It should be borne in mind that the inventor will probably visit his counsel at the last minute (even, perhaps, too late) because he will forget the date of his first disclosure, this being understandable since his main concern will be to finalise his invention (technically and financially). This will result in filing a hastily prepared application.

Prior art searches

With the grace period concept in force, making a validity search will be much more complex and expensive.

For each technically relevant "document" published in the six months period preceding the possible filing date of an application, the Searcher will have to endeavour to determine whether it results directly or indirectly from the inventor, his successors in right or from a third party. The search will be of course even more tricky in the case of an employee invention in which case the search should in addition be made through the relevant company publications. It is doubtful whether the general reference collections at Patent Offices will permit so detailed a search.

Questionable advantages of the grace period to the inventor

From the practitioner’s view point, the only advantages of the period of grace may be to the inventor. In fact, those advantages appear to be slight and illusory.

The number of inventors that might nowadays be concerned is infinitesimal when considering the mass of applications filed. The private inventor would not be substantially helped by a grace period of six months (or even more) which is not enough to permit finalising and financing his invention. The search for financial help will not be favoured if an application has not been filed and a search report obtained. The industry partners are very firm on this point and the inventor who can show a copy of his patent application will be regarded more favourably by an interested party as all the legal problems will already have been overcome (for example: confidentiality, waiver letter, certainty of date and of inventorship or ownership).

Burden of proof

The burden of proof shall be on the applicant or patentee to prove that the disclosure originated with the inventor or was derived from him. This will unquestionably be a source of possible litigation.

In the case of multiple, successive disclosures which one will be considered to define the beginning of the grace period?

What will be the situation if they originated from multiple inventors or from third parties having worked with the inventor(s)?
How should improvements in the invention as first disclosed be considered when they are made by a third party who files a patent application before the end of the grace period and argues later that such improvements do not derive from the invention first disclosed?

How will the proof be established after some years have passed, the patent may have another owner being unaware of the situation, the witnesses are no longer available ..., the employee-inventor may have left the company. Since no declaration will be required the burden of proof will still be heavier.

In case of litigation a small inventor or entity will spend a fortune when facing a big company. The service rendered to the inventor in giving him the grace period may well cost him dearly some years later. It may be said the best all-risk insurance policy is the filing of an application under the present absolute novelty rule.

CONCLUSIONS

It would be a big mistake to suggest that the proposal of a General Grace Period would merely be a slight modification of present Patent Law. It would in fact be a complete change in International Patent Law. Article 55 (EPC) is really an exception, a general grace period would suppress this exception and would be used, contrarily to its defendants' belief.

This "absolute novelty" system which works perfectly worldwide for the industry would be rendered unexploitable and uncertainty would be created for the benefit of a few isolated inventors who can be protected if they know how to use Article 55 (EPC).

The advantages seen by a few supporters far outweigh the disadvantages.

INFORMATION FROM THE
EUROPEAN PATENT PRACTICE COMMITTEE

1. Premature Refusal of a European Patent Application

The European Patent Practice Committee has informed the European Patent Office that there is a tendency on the part of some examiners of Directorate General 2 to issue a refusal with second official action. The Institute of Professional Representatives (EPI) therefore has requested the EPO to apply Article 96(2) in an objective way and to take into consideration, when assessing whether further official actions are necessary within the meaning of Article 96(2) EPC, the aspect of fairness towards the applicant and the economy of the procedure with respect to the EPO as a whole and not to issue refusals before such time as the points in dispute have been conclusively discussed and thus have taken on a form rendering them suitable for appeal.

In response to this request, the EPO has expressed the following comments:

C-VI, 4.3 of the Guidelines for Examination have been amended* and it is believed that the amended version defines a procedure which is not unfair to applicants. In particular, as is now clearly stated in C-VI, 4.3, if the applicant has made a "bona fide attempt" to deal with the examiner's objections, the examiner will not refuse the application immediately but will first give the applicant a warning and allow him time to produce further evidence or to make amendments.

Although this answer does not appear fully satisfactory to the EPO, the Committee has decided to wait and see how

this amended version of C-VI, 4.3 of the Guidelines will be applied.

2. Reference signs relating to drawings in claims (Rule 29(7))

The Institute of Professional Representatives (EPI) has suggested to the EPO that examiners should be flexible regarding the insertion of reference signs into claims and, in particular, should not insist on the insertion of reference signs against the wishes of the applicant.

The EPO has delivered the following answer:

- The EPO is already flexible regarding the insertion of reference signs into claims.
- The EPO cannot agree to the suggestion that insertion of reference signs should not be effected against the wishes of the applicant (such an approach leading to disregarding an EPC Rule).
- The EPO does not agree that Rule 29(7) should be interpreted as relating to the "principal features" rather than the "detailed features" of a claim. EPO argues that often it is precisely for the more detailed features in a claim that reference signs are particularly helpful.
- Although the EPO doubts that, despite the clear explicit statement of non-limitation in the last sentence of Rule 29(7), certain national courts may nevertheless be influenced in specific cases by the presence of reference signs in a claim, the EPO will also accept, as an alternative, the insertion of the reference signs in a statement of invention in the description corresponding in words to the claims.

EPPC

RE-ESTABLISHMENT OF RIGHTS (RESTITUTIO IN INTEGRUM) IN THE PROCEDURE BEFORE THE GERMAN AND THE EUROPEAN PATENT OFFICES

H. Tiedtke, German member of the EPI

I. GENERAL

The re-establishment eliminates legal detriments which occurred by failure to observe time limits. Both according to the German Patent Law (hereinafter called GPL) as well as according to the European Patent Convention (hereinafter called EPC) the failure to observe time limits entails serious legal detriments. Failure to observe time limits can, however, not be avoided in spite of all due care being taken so that provisions are made by law to eliminate such detrimental consequences of failures to observe time limits.

In the European system in principle two possibilities are given, that is the further processing of a European patent application (Article 121 EPC) and the re-establishment (Article 122 EPC). A request for further processing can be made when a time limit set by the European Patent Office (hereinafter called EPO) has not been observed and the party involved, by paying a fee, requests the further processing of the application. In the case of failure to observe legal time limits (time limits stipulated by law) according to the European system only re-establishment is possible.

In the German Patent Law also two possibilities are given, that is the appeal (§ 73 GPL) and the re-establishment (§ 123 GPL).

The German Patent Law does not include a provision corresponding to the "further processing". If a time limit set by the German Patent Office (GPO) is not observed, the
application can be rejected. The legal remedy of appeal is then given against the rejection of the application.

In the case of non-observance of legal time limits, as in the European system, only re-establishment is possible.

In both systems the grant of re-establishment is subject to strict pre-requisites which will now be explained in detail.

II. PRE-REQUISITES

II.1. Parties entitled to make a request for re-establishment

Pursuant to Article 122 EPC re-establishment can only be granted to the applicant for or the owner of a European patent. Thus, re-establishment of rights within the time limits for other parties participating in the proceedings, for example the opponent - within the time limit for lodging opposition - is excluded. In Article 123 GPL one arrives at a similar result, although here the provision regarding the parties entitled to the request is worded more generally.

II.2. Time limits open to re-establishment

Pursuant to Section 1 of Article 122 EPC re-establishment of rights is only allowed in respect of time limits which have to be observed by the applicant for or owner of a patent vis-à-vis the EPO. By virtue of this legal provision all time limits are excluded which have to be observed by third parties, e.g. also the German Patent Office (according to Article 77(5) EPC) vis-à-vis the EPO.

According to the European Patent Convention the failure to observe a time limit must result in the immediate loss of the application, the patent or any other right (e.g. priority right) or of a legal remedy.

Pursuant to the German Patent Law the failure to observe a time limit in accordance with the provision of the law must entail legal detriments. Time limits to be re-established are for example time limits for paying the granting fees or annuities.

II.3. Time limits which cannot be re-established

II.3.1. Article 122, Section 5 EPC provides for some time limits for which re-establishment cannot be granted. These are the following time limits:

a) The time limit of 2 months for filing the request for re-establishment (Art. 122(2) EPC),

b) the time limit of one year for filing the request for re-establishment (Art. 122(2) EPC),

c) the time limits for payment of the filing, search and designation fee when filing a new patent application through a person entitled to apply (Art. 61(3) EPC) as well as when filing a divisional application (Art. 76(3) EPC),

d) the time limit of 1 month for payment of the filing and search fee (Art. 78(2) EPC),

e) the time limit of 12 months for payment of the designation fee (Art. 79(2) EPC) with the extension provided therein,

f) the time limit of 12 months for filing a European patent application claiming the priority of a first application (Art. 87(1) EPC),

g) the time limit of 6 months for filing the request for examination and paying the examination fee (Art. 94(2) EPC).
II.3.2. According to the German Patent Law there cannot be re-established

a) the time limit of 3 months for lodging opposition (§ 59(1) GPL),

b) the time limit of 1 month, to which the opponent is entitled for lodging appeal against the maintenance of the patent (§ 73(2) GPL),

c) the time limit for filing applications for which a priority can be claimed, that is the time limit of 12 months according to Art. 4C (1) PVC as well as according to § 40(1) GPL (internal priority).

It is clear from the above compilation that the European system handles the re-establishment more restrictively than the German Patent Law.

III. PRE-REQUISITES AS TO FORM

III.1. The pre-requisites as to form in the German and the European system are largely identical.

a) The request for re-establishment has to be filed in writing (Art. 122(2) EPC; § 123(2) GPL),

b) the request must be filed within two months from the removal of the cause of non-compliance (Art. 122(2) EPC; § 123(2) GPL),

c) the request must be provided with grounds within the time limit of 2 months (Art. 122(3) EPC; § 123(2) GPL),

d) the omitted act must be completed within the time limit of 2 months (Art. 122(2) EPC; § 123 (2) GPL).

Ad a): "In writing" means that the request has to be signed in hand-writing by a natural person. Telegrams and telexes are deemed to be equal to the written form although they are not signed by hand. According to Rule 36(5) of the Implementing Rules EPC a document reproducing the contents of such telegram or telex and being signed in hand-writing must be filed within 2 weeks as from receipt of such telegram or telex, as otherwise the telex or telegram shall be deemed not to have been received. According to the German Patent Law such a confirmation of the telegram or telex is not required.

Ad b): The removal of the cause of non-compliance is the time when the party concerned taking all due (or ordinary) care is no longer prevented from completing the omitted act. As a rule, the date of the beginning of the time limit of 2 months will be that day, at the latest, on which the party concerned will have positive knowledge of the failure to observe the time limit, e.g. when the EPO informs the party concerned of the loss of rights in accordance with Rule 69, section 1. In both systems re-establishment of rights is no longer possible if one year has lapsed after the expiry of the time limit. This time limit of one year serves for legal security and is valid independent of the fact whether or not the party concerned is aware of the failure to observe the time limit.

Ad c): The facts on which the re-establishment of rights is based must be set out within the time limit of 2 months. Here, it must be stated, above all, when and which person was prevented from observing the time limit and when the cause of non-compliance was removed and in how far the party concerned has exercised all due care required by the circumstances.
The facts set forth within the time limit of 2 months must be substantiated. According to the German Patent Law it is sufficient in this respect that the substantiation documents, for instance medical certificates or statutory declarations are submitted after the expiry of the time limit of 2 months. In contrast, it appears to be established according to the European system that substantiation documents should be submitted within the time limit of 2 months for making the request.

The substantiation of the facts on which the re-establishment is based represents a less strict way of giving evidence. Here, the principle holds that there need not be furnished full evidence, but there has only to exist a predominant probability for the truth of the fact set forth.

Ad d): If it was e.g. omitted to pay the granting fees for a patent or an annuity, these fees must now be remitted within the time limit of 2 months.

III.2. Special features in both systems

As regards the pre-requisites as to form in the European system it has also to be borne in mind that a corresponding fee (Art. 122(3) EPC) must be paid as otherwise the request is deemed not to have been made. The German Patent Law does not require a corresponding fee.

Finally it is pointed out that according to the German Patent Law re-establishment can also be granted without request when the omitted act is completed within the time limit for filing the request and the facts justifying re-establishment have been placed on record. Such a simplification does not exist in the European system, rather is here in any case a special request in writing required.

IV. SUBSTANTIVE PRE-REQUISITES FOR THE GRANT OF RE-ESTABLISHMENT

According to § 123 GPL re-establishment can only be granted to the person entitled to make a request who through no fault of his own was prevented from observing the time limit. A petitioner who has taken ordinary care, which a third party in the same situation would also have taken, acts without any fault of his own. The requirements regarding care must be reasonable and must not be extensive. The required care depends on the person whose task it was to observe the time limit. This person can be the party to the proceedings himself, i.e. the applicant for a patent or the owner of a patent or his representative. As a rule, patent agents and lawyers are the representatives of the applicant. A patent agent has to exercise the same care as the applicant himself.

However, if the time limit has not been kept to by an employee, the same strict standards of care are not expected of the employee as are expected of the applicant or his representative. The representative must, however, see to it that he chooses and trains the employees carefully and also supervised them by way of spot checks so that errors might be regarded as being incurred through no fault of his. Therefore, the attorney must have his office organised such that failures to observe time limits cannot occur under normal circumstances and when attention is being paid to his instructions.

According to the European system re-establishment is only granted when the applicant or the owner of the patent "in spite of all due care required by the circumstances having been taken" was prevented from the observing the time limit. Such a wording is not contained in any of the other national legal systems, so that it is left to jurisdiction how this term is to be interpreted. In the decision of 7 July 1981 the Legal Board of Appeal of the European Patent Office had the opportunity of expressing some
fundamental reflections regarding the request for re-establishment according to Art. 122 EPC. In this decision it was established that the representatives, in particular the professional representatives authorised to act before the EPO in accordance with Art. 134 EPC, must take the same due care required as the applicant or owner of the patent. However, the same strict standards are not expected of applicant or his representative. Here too, the representative must have used the due care required under the given circumstances when choosing, instructing and supervising the office staff in order that a request for re-establishment proves successful.

If one compares the two systems with each other one comes to the conclusion that the substantive pre-requisites for the grant of the re-establishment in the European system are likely to be stricter than in the German system.

V. THE DEPARTMENT COMPETENT TO DECIDE

The department competent to decide on the omitted act decides on the request for re-establishment of rights. If, for example, a time limit was not observed in the examination procedure as to formal requirements the Receiving Section is competent for re-establishment of rights. In the usual examination procedure the examiner is responsible.

VI. INDIVIDUAL CASES

Within the scope of the German Patent Law there exists a very extensive jurisdiction with respect to re-establishment. Only a few individual cases shall be set forth.

Re-establishment was granted in the event of wrong information by the authority, errors on the part of the German Patent Office, illness, in which the observance of the time limit was impossible or could not be expected, mailing in due time so that according to the experience regarding normal conveyance times in postal services receipt in time could be expected. A loss of a document on the part of the party to the proceedings or his representative is no fault of his, provided this is not due to lack in care. However, in the event of an error in law, lacking knowledge of law or wrong interpretation of law, re-establishment was not granted. If a time limit was intentionally allowed to lapse, re-establishment of rights was also not granted.

If the applicant or the owner of a patent is represented by an attorney before the German Patent Office, then the following is valid on principle:

The applicant as well as his representative can fail to observe time limits. In cases were both had to observe a time limit (e.g. the time limit for paying the annuity), re-establishment is granted only then when this failure occurred through no fault of the applicant or his representative. The following graph makes this clear:

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applicant  representative
management  office staff  attorneys  office staff  Patent Office
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Complete evidence must be established of the chain of information leading to the failure to observe the time limit. Therein the activities of applicant as well as of his representative must be stated. The following would have to be included in detail:

a) when did the Patent Office, for instance, instruct the representative to pay the annuity;

b) was the time limit for paying the annuity noted down in the calendar for time limits of the representative;

c) when and how was applicant informed of this time limit;
d) If and when did applicant receive this information on the time limit;

e) Was this time limit noted down in applicant’s office;

f) How were the time limits supervised in the offices of applicant and of his representative;

g) Who failed to observe the time limit;

h) When was this failure to observe the time limit noticed (this is important to the observance of the time limit of 2 months);

i) What are the reasons for regarding this failure to observe the time limit as no fault of applicant or his representative.

Besides that, it must be taken into account that the failure to observe the time limit must not be the fault of either the management or of the attorney, since their failure to observe the time limit, as a rule, is not considered to be incurred through no fault of their own. Therefore failures to observe the time limit may be committed only by staff members, e.g. office staff. In this connection, however, it must be established that the office staff are selected and trained carefully and that they are supervised by spot checks. All above mentioned details are to be made plausible in the proceedings on the request for re-establishment, for instance by respective documentary material or by affidavits.

If a foreign attorney acts as intermediary between a foreign applicant and a national representative, then it is also necessary to establish that the failure to observe the time limit is no fault of this foreign attorney.

VII. LEGAL REMEDY

According to the German Patent Law the granted re-establishment is unappealable so that no legal remedy is possible against the granted re-establishment of rights. However, if the request for re-establishment of rights is rejected, appeal can be lodged against this decision in accordance with § 73 GPL.

The European Convention does not contain an explicit provision, as the German Patent Law, according to which the granted re-establishment is unappealable. The further development will show in how far a further nullity or infringement procedure the national courts are bound to the re-establishment granted by a competent department of the EPO. As a rule, it should however be assumed that the granted re-establishment is binding.

If the request for re-establishment of rights is rejected the petitioner, according to Art. 106 EPC, has the possibility of lodging appeal.

VIII. RIGHT OF CONTINUATION OF USE

Article 122(6) EPC provides a right of continuous use without payment for the user who started such use after the date of the loss of rights and before the mention of the granted re-establishment of those rights is published. Here, use must be effected in good faith, i.e. the user has not expected or could not expect that the rights of the owner or applicant could be re-established. Such use must have been made in one of the designated Contracting States, the term of use being subject to national law. It is also sufficient if, instead of the actual use, effective and serious preparations for such use have been made. The thus acquired right of continuous use is bound to the business and can only be transferred to another person together with the business.
The right of continuation of use according to § 123(5) GPL largely corresponds to that stipulated in the European Patent Convention.