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Information

4 - 1985



Institut der beim Europäischen Patentamt
zugelassenen Vertreter
Institute of Professional Representatives
before the European Patent Office
Institut des mandataires agréés près
l'Office européen des brevets

Schriftleitung – *Editorial Board* – Comité Rédaction

Jean Brullé · Ernst J. Schönhöfer · Ken Veryard

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Jan 86*

Editorial	1
Training Programme on the European Patent	2
Bericht und Beschlußliste des Rates	3
Report and List of Decisions from Council	8
Rapport et Liste des Décisions du Conseil	12
EPPC Report	16
Community Patent Convention (COPAC)	18
Presse-Mitteilung	20
Press Release	22
Communiqué de Presse	23
SACEPO Report	25
EPO Long Term Budget Outlook	30
Training of Future Members	36
EPO President's Speech to Council	39
DATIMTEX System	49
Ausschüsse/Committees/Commissions	54

EDITORIAL

Mr. Braendli, who took office as President of the European Patent Office in May 1985, addressed the Council of our Institute on 5 November 1985 to give the Council a review of the operations of the Office's first seven years. A copy of a summary of his talk is printed herein.

We are also publishing the text of the Institute's submissions to the Governmental Conference of the Council of the European Communities which was held in Luxembourg in December 1985.

In the list of decisions taken at our Council meeting you will notice that the subscription for 1986 will be DM 175.-. This fell due on 1 January 1986.

This edition should reach you in the first week of January and we would like to wish all readers a peaceful, healthy, happy and prosperous year for 1986.

Jean Brullé · Ernst J. Schönhöfer · Ken Veryard

TRAINING PROGRAMME ON THE EUROPEAN PATENT

10-11-12 February 1986

The Training Programme on European Patent Law and Practice is an intensive 3-day course designed for students who are preparing for the European Qualifying Examinations.

The course is open to persons who are interested in an English language course.

Course Instructors

Papers A & B

Mr. Angus Duncan, CPA, EPA

Mr. David Votier, CPA, EPA

Paper C (Opposition)

Mr. Keith Weatherald, CPA, EPA

Mr. Walter Weston, CPA, EPA

Paper D (Legal Matters)

Dr. Günter Gall

Director Legal Affairs

European Patent Office

Syllabus

Treatment will be given to the four papers of the European Qualifying Examination.

A detailed programme and a full set of 1985 examination papers will be sent to all registrants.

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BERICHT ÜBER DIE RATSSITZUNG

Die 19. Sitzung des Institutsrates wurde in München am 4. und 5. November 1985 abgehalten.

Zu Beginn nahm der Rat mit großer Zufriedenheit die Bereitschaft von Herrn Braendli zur Kenntnis, an einem Teil der Sitzung teilzunehmen, eine Rede zu halten und Fragen zu beantworten. Herr Braendli war von zwei seiner Vize-Präsidenten, den Herren Wallace und Zwartkruis, begleitet.

Der Präsident des Instituts berichtete über die Juni-Sitzung des Verwaltungsrates der EPO und unser Generalsekretär berichtete, die Aufgaben des Institutsvorstandes innerhalb der nächsten Jahre werden sich auf Vorbereitungen für den Anschluß Spaniens an das EPÜ, auf die Einführung und Verbesserung der Vorbereitungsprogramme für die Europäische Eignungsprüfung, auf die Einführung einer langfristigen Budgetplanung, auf die Mitarbeit des Institutes im Zusammenhang mit internationalen Angelegenheiten und auf Vertretungsfragen im Zusammenhang mit dem Gemeinschaftspatent, der Gemeinschaftsmarke und des COPAC beziehen.

Der Präsident des Finanzausschusses, Herr Gasslander, legte die erste langfristige Analyse der Einnahmen und Ausgaben des Institutes vor, die jemals erstellt wurde. Die Schlußfolgerungen des Finanzausschusses waren nicht sehr optimistisch und hoffentlich wird Herr Gasslander in der EPI-Information über die Überlegungen des Finanzausschusses über die langfristigen Perspektiven berichten; die gemachten Ausführungen veranlaßten den Rat, sich für eine größere Erhöhung des Jahresbeitrages für das nächste Jahr zu entscheiden, als vom Schatzmeister und vom Finanzausschuß empfohlen worden war.

Der Ausschuß für die Europäische Eignungsprüfung kündigte gute Fortschritte des neuen Vorbereitungsprogramms an, das zur Vorbereitung der Kandidaten auf die Europäische Eignungsprüfung bestimmt ist. Insgesamt haben 23 Experten aus Großbritannien, Deutschland, Frankreich, Belgien und den Niederlanden ihre Bereitschaft erklärt und 82 zukünftige Kandidaten haben ihr Interesse erklärt, an dem Programm teilzunehmen.

Der Ausschuß für die Standesregeln hat eine eingehende Studie im

Zusammenhang mit dem Konkurs eines zugelassenen Vertreters sowie mit den Mitgliedern, die beim Institut ihre Jahresbeiträge nicht begleichen, eingeleitet. Zusätzliche Meinungen wurden von weiteren Ratsmitgliedern dargelegt und es wurde beschlossen, die eine zusätzliche Überprüfung benötigende Angelegenheit an der nächsten Ratssitzung weiter zu behandeln.

Angesichts des zunehmenden Prüfungsrückstandes im Europäischen Patentamt sorgte der Vorstand für zwei Referenten, die das Pro und Kontra für eine aufgeschobene Prüfung darlegten.

Die nächste Ratssitzung wird in Wien am 21. und 22. April 1986 stattfinden.

Zur Vorbereitung dieser Sitzung wird sich der Vorstand am 14. März 1986 zu einer Sitzung in Bremen treffen.

Der Generalsekretär,

Christer Onn

BESCHLUSSLISTE

der 19. EPI-Ratssitzung vom 4. und 5. November 1985 in München

1. Die Herren Schenkman und Braun wurden als Stimmzähler gewählt.
2. Die Tagesordnung wurde mit geringfügigen Änderungen angenommen.
3. Das Protokoll der vorherigen Ratssitzung in Cannes wurde angenommen.
4. Das vorgeschlagene Budget für 1986 wurde angenommen. Der Rat beschloß, den Jahresbeitrag für 1986 auf DM 175,- zu erhöhen.
5. Als Nachfolger der zwei verstorbenen Mitglieder des Disziplinarausschusses wurden die Herren Edouard Fobe (BE) und Claude Madeuf (FR) ernannt.
6. Im Zusammenhang mit den im 16. Bericht des EPPC behandelten Angelegenheiten beschloß der Rat:

EPPC 16 - Allgemeine Zahlungserinnerungen für die Jahresgebühr: die Angelegenheit nicht weiterzuverfolgen;

EPPC 41 - Caveat-System: dies solle vom Ausschuß als eine dringende Angelegenheit behandelt werden;

EPPC 55 - Änderung der Regel 6(1): die Angelegenheit als erledigt zu betrachten; -

EPPC 68 - Doppelseitige Patentanmeldungen und Numerierung der Seiten: die Angelegenheit als erledigt zu betrachten;

EPPC 72 - Vorentwurf eines Protokolls über die Regelung von Streitigkeiten über die Verletzung und die Rechtsgültigkeit von Gemeinschaftspatenten (COPAC-System): den dem Interim Ausschuß eingereichten Kommentar des Ausschusses anzunehmen;

EPPC 78 - Regel 90: eine Änderung der Regel zu einem späteren Zeitpunkt zu beantragen, wenn andere, vom Ausschuß für die Standesregeln erarbeitete Änderungsanträge beschlossen werden;

EPPC 81 - Fonds für die Beschwerdegebühr: dem Vorschlag des Ausschusses

ses zu folgen und von der Einrichtung eines Fonds in diesem Zusammenhang abzusehen;

EPPC 82 - Änderung von Ansprüchen bei mündlichen Verfahren vor den Beschwerdekammern: nicht nur ein Schreiben an das EPA zu richten, sondern auch zu versuchen, einen persönlichen Kontakt mit Herrn Gori herzustellen; die hierfür zuständigen Personen sollen vom EPI-Vorstand ernannt werden;

EPPC 83 - Harmonisierung der Patentverfahren im EPA, in den USA und in Japan: keine offizielle Liste der in diesem Zusammenhang zu behandelnden Angelegenheiten zu erstellen.

7. Der Rat beschloß, die Einladung des Rates der Europäischen Gemeinschaften anzunehmen und sich durch Mitglieder mit Beobachterstatus an der Regierungskonferenz in Luxembourg vom 4. bis zum 18. Dezember 1985 vertreten zu lassen; diese Konferenz wird sich nicht nur mit COPAC sondern auch mit der Möglichkeit beschäftigen, das Luxemburger Übereinkommen über das Gemeinschaftspatent so rasch wie möglich in Kraft zu setzen. Der Rat ernannte seine Delegierten an diese Konferenz anlässlich einer früheren Ratssitzung. Da Vize-Präsident Schönhöfer jedoch nicht daran teilnehmen kann, ernannte der Rat Herrn Casalonga zum Delegierten, sowie Herrn Huygens als stellvertretenden Delegierten.

Angesichts der dem Rat der Europäischen Gemeinschaften unterbreiteten Vorschläge nahm der Rat des EPI folgende Resolution an:

"Der Rat des EPI ist der Meinung, die Inkraftsetzung des Gemeinschaftspatentes für weniger als alle Länder der Gemeinschaft hätte höchst unerwünschte und entzweiende Wirkungen auf die Entwicklung des Europäischen Patentrechts."

8. Die nächsten Ratssitzungen werden:

in Wien am 21. und 22. April 1986,
in Den Haag am 27. und 28. Oktober 1986 und
in Rom im Frühling 1987
stattfinden.

REPORT FROM COUNCIL

The 19th meeting of the Institute Council was held in Munich on 4 and 5 November 1985.

Council noted with high appreciation Mr. Braendli's courtesy to attend a part of the meeting and give a speech and reply to several questions. Mr. Braendli was assisted by his Vice-Presidents, Messrs. Wallace and Zwartkruis.

The President of the Institute reported on the meeting of the EPO Administrative Council in June, and the Secretary General reported that the tasks of the Board during the next years will include preparations for Spain joining the EPC, an introduction and improvement of the tutorial programme for the European Qualifying Examination, the introduction of long-term budgeting, promotion of the Institute in international matters and questions of representation in matters related to the Community Patent, Community Trademark and COPAC.

The President of the Finance Committee, Mr. Gasslander, presented the first long-term analysis of the Institute's income and costs that has been made. The conclusions of the Finance Committee were not totally optimistic. Mr. Gasslander has written an article in this Newsletter about the observations made by the Finance Committee for the long-term future, observations that now made the Council decide on a greater increase in the annual subscription for next year than had been recommended by the Treasurer and the Finance Committee.

The Committee on the European Qualifying Examination reported good progress with the new tutorial programme being set up to prepare candidates for sitting the European Qualifying Examination. In all, 23 tutors from Great Britain, Germany, France, Belgium and the Netherlands have volunteered, and so far 82 future candidates have expressed their interest in participating.

The Professional Conduct Committee had made a thorough study of matters related to bankruptcy of a European Patent Attorney and members not paying their subscriptions to the Institute. Additional views were

presented by other Council members and it was decided to postpone the matters for additional study until the next Council meeting.

In view of the growing examination back-log at the European Patent Office, the Board arranged for two members to present the "pros" and the "cons" of the proposed system of deferred examination.

The next Council meeting will be in Vienna on 21 and 22 April 1986.

To prepare for the next Council meeting, the Board will meet in Bremen on 14 March 1986.

Secretary General

Christer Onn

LIST OF DECISIONS
of the 19th EPI Council Meeting
on 4 and 5 November 1985 in Munich

1. Mr. Schenkman and Mr. Braun were appointed scrutineers.
2. The agenda was adopted with minor amendments.
3. The minutes of the previous Council meeting in Cannes were approved.
4. The proposed budget for 1986 was approved. Council decided to increase the subscription to DM 175 for 1986.
5. To succede the two deceased members of the Disciplinary Committee Council elected Mr. Edouard Fobe (BE) and Mr. Claude Madeuf (FR).
6. With respect to the matters dealt with in the 16th report of the European Patent Practice Committee, Council decided:

EPPC 16 - Renewal fee reminders; not to pursue the matter further,

EPPC 41 - Caveat system; that the Committee shall treat it as an urgent matter,

EPPC 55 - Amendment of Rule 6(1); to regard the matter as settled,

EPPC 68 - Double sided patent specifications and numbering of sheets; to regard the matter as settled,

EPPC 72 - Draft protocol on the settlement of litigation concerning the infringement and validity of Community Patents (COPAC system); to approve the written comments by the Committee that were submitted to the Interim Committee,

EPPC 78 - Rule 90; to request an amendment of the Rule on a later occasion when other requests for amendments based on the work of the Professional Conduct Committee have been decided,

EPPC 81 - Funds for appeal fees; to follow the Committee's proposal and refrain from setting up a fund in this matter,

EPPC 82 - Amendment of claims in oral proceedings before the Boards of Appeal; not only to send a letter to the EPO but also to

try to establish a personal contact with Mr. Gori, the delegates for such a contact are to be appointed by the EPI Board,

EPPC 83 - Harmonisation of patent procedures in EPO, USA and Japan; not to establish an official list of matters to be dealt with in this connection.

7. Council decided to accept an invitation from the Council of the European Communities to participate as an observer at the Intergovernmental Conference in Luxemburg on 4 to 18 December 1985 which will deal with not only COPAC but also the possibility of making the Luxemburg Convention on the Community Patent come into force as rapidly as possible. Council appointed its delegates to this conference at a previous Council meeting. However, Vice President Schönhöfer will not be able to participate, so Council now appointed Mr. Casalonga to replace him and also appointed Mr. Huygens to be a substitute delegate, should the need arise.

In view of suggestions made to the Council of the European Communities, the EPI Council passed the following resolution:

"This Council believes that the bringing into effect of the Community patent for less than all community countries would have most undesirable and divisive effects on the development of the European Patent Law".

8. The next Council meetings will be held in:

Vienna on 21 and 22 April 1986

The Hague on 27 and 28 October 1986

Rome in spring 1987.

RAPPORT DU CONSEIL

La 19^{ème} réunion du Conseil de l'Institut s'est tenue à Munich les 4 et 5 novembre 1985.

Le Conseil a été très sensible au fait que Monsieur Braendli accepte de participer à une partie de la réunion, de prononcer un discours et de répondre à diverses questions. Monsieur Braendli était assisté de ses Vice-présidents, Messieurs Wallace et Zwartkruis.

Le Président de l'Institut a présenté un rapport sur la réunion du Conseil d'administration de l'Organisation Européenne des Brevets tenue en juin et le Secrétaire général a précisé que les tâches du Bureau porteraient, dans le courant des prochaines années, sur la préparation de l'entrée de l'Espagne dans la CBE, sur la mise en place et le perfectionnement du programme de préparation à l'examen européen de qualification, sur l'élaboration d'une planification à long-terme, sur la promotion de l'Institut dans le cadre des affaires internationales et sur les questions de représentation ayant trait au Brevet Communautaire, aux Marques Communautaires et à COPAC.

Le Président de la Commission Finances, Monsieur Gasslander, a présenté la première analyse à long-terme des revenus et des dépenses de l'Institut qui ait été jamais faite. Les conclusions de la Commission Finances n'étaient pas totalement optimistes. Monsieur Gasslander a écrit dans ce bulletin un article portant sur les constatations de la Commission Finances quant aux prévisions à long-terme, constatations qui ont incité le Conseil à se décider pour une augmentation de la cotisation annuelle pour l'année prochaine qui soit plus forte que celle qui avait été recommandée par le Trésorier et la Commission Finances.

La Commission pour l'Examen Européen de Qualification a signalé de grands progrès dans l'évolution du nouveau programme de préparation mis en place pour préparer les candidats à l'examen européen de qualification. En tout, 23 tuteurs originaires de Grande-Bretagne, d'Allemagne, de France, de Belgique et des Pays-Bas se sont portés volontaires et jusqu'à présent, 82 futurs candidats ont exprimé leur désir de participer à ce programme.

La Commission pour les Règles de Conduite Professionnelle a procédé à une étude approfondie du problème concernant la faillite d'un Conseil en brevet européen ainsi qu'à celui des membres qui ne paient pas leurs cotisations annuelles à l'Institut. D'autres membres du Conseil ont en outre exprimé leur point de vue et il a été décidé de reporter à la prochaine réunion du Conseil la discussion sur les questions qui nécessitent une étude complémentaire.

En raison de l'accroissement des délais d'examen à l'Office européen des brevets, le Bureau a nommé deux membres chargés de présenter le pour et le contre d'une proposition relative à l'examen différé.

La prochaine réunion du Conseil se tiendra à Vienne les 21 et 22 avril 1986.

Afin de préparer la prochaine réunion du Conseil, le Bureau se réunira à Brême le 14 mars 1986.

Le Secrétaire général,

Christer Onn

LISTE DES DECISIONS

de la 19^{ème} réunion du Conseil de l'EPI
tenue les 4 et 5 novembre 1985 à Munich

1. Messieurs Schenkman et Braun sont élus scrutateurs.
2. L'ordre du jour est adopté après légère modification.
3. Le procès-verbal de la réunion du Conseil précédente tenue à Cannes est adopté.
4. Le budget proposé pour 1986 est approuvé. Le Conseil décide d'augmenter la cotisation de 1986 qui est fixée à 175 DM.
5. Le Conseil élit Messieurs Edouard Fobe (BE) et Claude Madeuf (FR) membres de la Commission de Discipline en remplacement de deux membres décédés.
6. En ce qui concerne les questions traitées dans le 16^{ème} rapport de l'EPPC, le Conseil décide comme suit :

EPPC 16 - Rappels de paiement de la taxe annuelle ; ne pas poursuivre cette affaire ;

EPPC 41 - Système Caveat ; la Commission doit traiter cette question comme affaire urgente ;

EPPC 55 - Modification de la règle 6(1) ; considérer l'affaire comme réglée ;

EPPC 68 - Demandes de brevet présentées Recto/Verso et numérotation des pages ; considérer l'affaire comme réglée ;

EPPC 72 - Projet de procès-verbal préliminaire sur le règlement de litiges en ce qui concerne l'infraction et la validité de brevets communautaires (système COPAC) ; approuver les commentaires écrits de la Commission qui ont été soumis à la Commission Intérimaire ;

EPPC 78 - Règle 90 ; demander ultérieurement une modification de la règle, lorsque d'autres demandes de modification fondées sur le travail de la Commission pour les Règles de Conduite

Professionnelle auront été décidées ;

EPPC 81 - Fonds pour les taxes de recours ; suivre la proposition de la Commission et s'abstenir de prévoir des fonds pour cette affaire ;

EPPC 82 - Modification de revendications au cours des procédures orales auprès des Chambres de Recours ; non seulement envoyer une lettre à l'OEB, mais aussi essayer d'entrer personnellement en contact avec Monsieur Gori ; les délégués chargés d'établir un tel contact seront nommés par le Bureau de l'EPI ;

EPPC 83 - Harmonisation des procédures sur les brevets pratiqués à l'OEB, aux USA et au Japon ; ne pas établir une liste officielle des questions à traiter dans ce contexte.

7. Le Conseil décide d'accepter l'invitation du Conseil des Communautés Européennes et de participer en tant qu'observateur à la Conférence Intergouvernementale qui se tiendra à Luxembourg du 4 au 18 décembre 1985, laquelle doit traiter non seulement de COPAC, mais aussi de la possibilité de faire entrer en vigueur la Convention de Luxembourg sur le Brevet Communautaire le plus rapidement possible. Le Conseil a nommé ses délégués à cette conférence lors d'une précédente réunion du Conseil. Cependant, le Vice-président, Monsieur Schönhöfer, étant dans l'impossibilité de participer à cette conférence, le Conseil nomme Monsieur Casalunga pour le remplacer ; il nomme également Monsieur Huygens en tant que suppléant.

En raison des suggestions soumises au Conseil des Communautés Européennes, le Conseil de l'EPI adopte la résolution suivante :

"Le Conseil est d'avis que la mise en vigueur du Brevet Communautaire pour moins que la totalité des pays de la Communauté aurait des conséquences déplorables et aurait des effets de division dans l'évolution de la loi sur le Brevet Européen."

8. Les prochaines réunions du Conseil se tiendront à :

Vienne les 21 et 22 avril 1986

La Haye les 27 et 28 octobre 1986

Rome, au printemps 1987.

NOTE ON EPPC ITEMS

discussed at EPI Council meeting on 4 and 5 November 1985

The EPI Council discussed and acted on numerous proposals from the European Patent Practice Committee (EPPC).

Concerning EPO matters:

- EPI Council approved proposed changes of Rule 90(4) to correct the English text (see page 13 of EPI Information 3-1985) and to take account of the MOUCHET decision (EPO Official Journal 5/1984). However other amendments to Rule 90 are being considered by the Professional Conduct Committee concerning difficulties which might arise if a professional representative became bankrupt or otherwise suffered financial incapacity. When these other amendments have been settled a combined proposal for revision of Rule 90 will be made to the Administrative Council.
- It was decided not to support the initiative for a general renewal fee reminder system. The present EPO system of reminders for overdue renewal fees only should be retained.
- EPI Council decided to continue its pressure for an early Caveat system, despite the current EPO view that this cannot be implemented within the next few years.
- It was agreed to drop a proposal for filing double-sided patent specifications in view of technical problems pointed out by the EPO.
- EPO has informed the EPI that in principle it is in favour of allowing the filing by telecopy of documents subsequent to a European patent application, when current technical and legal investigations have been completed.
- EPI Council did not support a proposal to provide funds for payment of appeal fees in cases of general interest.
- EPI Council agreed to write to the EPO Vice-President in charge of appeals requesting more flexibility for amendments (see page 14 of EPI Information 3-1985).
- A list of items to be considered for tripartite harmonisation (EPO, JPO and USPTO) was approved but, as this list is rather extensive, it will

be kept as an aide-memoire and will not at present be sent to the EPO.

- EPO has advised that it is not convinced that there is an imperative need to extend the time limit of Rule 6(1) but has put the EPI/EPO correspondence on the matter before the Administrative Council. The matter is now regarded as settled as far as the EPI is concerned, and any further initiatives must be taken at the national level.
- In connection with the DATIMTEX project, it appears that the working group on the latter and the EPPC are of the same opinion that the copy to be used in substantive examination should be the hard copy filed by the applicant and not a copy of the application as published. The EPI Council agreed.

Concerning COPAC and the Community Patent Convention:

- Representations on the revised draft Protocol for COPAC had to be made to the EEC Council of Ministers by 31 October. In view of the urgency, EPPC prepared a memorandum of representations which was duly filed by EPI. This was retrospectively endorsed by the EPI Council.
- Regarding the Community Patent Convention, EPI Council appointed the following persons as EPI representatives at the Intergovernmental Conference on 4 to 18 December 1985:

Mr. G. Bressand
Mr. F.A. Jenny
Mr. A. Casalonga

and as substitute:

Mr. A.V. Huygens

- Regarding the proposal that the Community Patent Convention and COPAC should come into force for less than all Community countries, the EPI Council decided by a large majority to deplore this as having "most undesirable and divisive effects on the development of European patent law".

COMMUNITY PATENT CONVENTION - COPAC

EPI has submitted by 31 October 1985 comments on the Draft Protocol on the Settlement of Litigation concerning the Infringement and Validity of Community Patents and on the Draft Statute of the Common Appeal Court (CIBC 826/85).

The following points were made:

1. It is essential for the maintenance of the European patent system to avoid applicants reverting to filing by the national route in case the use of Community Patents has not proved satisfactory. Therefore the ten year time limit for unanimity in the Community Council of Ministers to end the option under Article 86 to obtain a European patent should be extended.
2. The Common Appeal Court should be an independent body and only judges with experience in patent law should be appointed to it.
3. The uniform interpretation of the Community Patent Convention should be ensured by the Common Appeal Court and the competence of the European Court of Justice should be limited to matters arising under the Treaty of Rome. In particular Article 63 CPC should be declared inapplicable to appeals in revocation proceedings.
4. Rules are needed to be able to obtain evidence in a country other than that of the Community Patent Court seized of the matter in an infringement action, in cases where infringement is in issue in the country of the Community Patent Court.
5. Provision is needed to be able to file a counterclaim for revocation, during the opposition period or during an opposition, as a defence against proceedings for provisional measures (interlocutory or preliminary injunctions).
6. Rules are needed to indicate which body will request and the time limits for filing translations of claims and fees when a patent has been maintained in amended form.

7. European Patent Attorneys should have a right of representation and audience before the Common Appeal Court.
8. If an action before Community Patent Court is staged during the pendency of revocation proceedings before another such court, the Common Appeal Court or the EPO it is essential to permit the defendant to intervene in the other proceedings and put his own case on invalidity.
9. The present version of Article 28 whereby the national final courts of appeal are excluded from considering infringement and validity should be maintained. The validity of an appeal before the Community Patent Court of the second instance should not be put in question.

PRESSE-MITTEILUNG

(vom EPI-Vorstand am 11. Dezember 1985 herausgegeben)

Betreff: Die Regierungskonferenz über das Gemeinschaftspatent (EWG-Patent), Luxemburg, 4. bis 18. Dezember 1985.

Das EPI ist die Berufsorganisation von 4.500 qualifizierten Patentvertretern aus den europäischen Ländern, die dem im Oktober 1973 in München unterzeichneten Europäischen Patentübereinkommen beigetreten sind.

Fast alle Angelegenheiten in Sachen europäischer Patente (bisher sind über 165.000 europäische Patentanmeldungen veröffentlicht worden) werden von diesen qualifizierten europäischen Patentvertretern behandelt. Die Mitglieder des EPI sind anerkannte Experten der europäischen Patentpraxis.

Der Rat des EPI, dessen Präsident Herr Jan D'haemer (CH) ist, besteht aus gewählten nationalen Delegierten aus allen elf Vertragsstaaten des Europäischen Patentübereinkommens. Er vertritt die 4.500 Mitglieder des EPI.

Das Europäische Patentübereinkommen, in dessen Rahmen die EPI-Mitglieder praktizieren, wird von dem Inkrafttreten des Gemeinschaftspatents nicht unmittelbar betroffen. Das Gemeinschaftspatentübereinkommen (von 1975) sieht vor, daß das bestehende erfolgreiche Erteilungsverfahren für europäische Patente weiterhin vom Europäischen Patentamt durchgeführt wird. Wenn das Gemeinschaftspatentübereinkommen in Kraft tritt, wird es auch Aufgabe des Europäischen Patentamtes sein, einheitliche Gemeinschaftspatente für die EWG zu erteilen. Dieses Übereinkommen regelt nur die Ausübung der Patentrechte in der EWG nach der Erteilung. Es ist deshalb von Bedeutung für den freien Warenverkehr und wird die Patentpolitik der Anmelder beeinflussen. Zum Inkrafttreten des Gemeinschaftspatentübereinkommens für weniger als die Gesamtheit aller EWG-Staaten nahm der Rat des EPI auf seiner November-Sitzung nach eingehender Sachdiskussion unter den Vertretern aus allen europäischen Mitgliedsstaaten folgende Entschliessung an:

"Der Rat ist der Auffassung, daß die Inkraftsetzung des Gemeinschaftspatents (-übereinkommen) für weniger als die Gesamtheit der Gemeinschaftsstaaten unerwünscht, auf eine Spaltung hinauslaufende Auswirkungen auf die Entwicklung des europäischen Patentrechts hätte."

Nähere Auskünfte über das EPI und seine Auffassungen erteilt der Präsident, Herr J. D'haemer (CH), oder der Generalsekretär, Herr Christer Onn (SE).

PRESS RELEASE

(issued by the EPI Board on 11 December 1985)

Subject: The Governmental Conference on the Community Patent (EEC patent), Luxembourg, 4 December - 18 December 1985

The EPI is the professional organisation of 4,500 qualified European Patent Attorneys who come from European countries adhering to the European Patent Convention signed in Munich in October 1973.

Almost all European patent cases (in excess of 165,000) are dealt with through these qualified European Patent Attorneys. Members of the EPI are recognised as real experts on European patent practice.

The Council of the EPI of which Jan D'haemer (CH) is President consists of elected national delegates from all eleven Contracting States to the European Patent Convention and represents the 4,500 members of the EPI.

The European Patent Convention under which the EPI members practice will not directly be influenced by the entry into force of the Community Patent. The Community Patent Convention (of 1975) foresees that the existing successful European patent grant procedure will continue to be administered by the existing European Patent Office which is the authority empowered to grant unitary Community Patents for the EEC if the Community Patent Convention enters into force. This Convention regulates only the post-grant exercise of patent rights in the EEC and is, therefore, of importance for the free circulation of goods and will influence the patenting policy of applicants. As regards the entry into force of the Community Patent Convention for less than all EEC states the Council of the EPI after thorough expert discussion among representatives from all its European member states adopted at its November meeting the following resolution:

"This Council believes that the bringing into effect of the Community Patent (Convention) for less than all Community countries would have most undesirable and divisive effects on the development of European patent law".

Further details concerning the EPI and its views may be obtained from the President, Mr. J. D'haemer (CH) or from the General Secretary, Mr. Christer Onn (SE).

COMMUNIQUE DE PRESSE

(approuvé par le Bureau de l'EPI le 11 décembre 1985)

Objet : La Conférence gouvernementale sur le Brevet Communautaire (Brevet CEE), Luxembourg, du 4 au 18 décembre 1985.

L'EPI est une organisation professionnelle regroupant 4.500 conseils en brevets qualifiés provenant des pays européens qui ont adhéré à la Convention sur le Brevet Européen signée à Munich en octobre 1973.

Presque tous les dossiers de brevets européens (plus de 165.000) sont traités par ces conseils en brevets européens qualifiés. Les membres de l'EPI sont reconnus comme experts dans la pratique du brevet européen.

Le Conseil de l'EPI, qui a pour Président monsieur Jan D'haemer (CH), se compose de délégués nationaux élus originaires des onze Etats Contractants de la Convention sur le Brevet Européen et représente les 4.500 membres de l'EPI.

La Convention sur le Brevet Européen au titre de laquelle agissent les membres de l'EPI ne sera pas directement influencée par l'entrée en vigueur du Brevet Communautaire. La Convention sur le Brevet Communautaire (de 1975) prévoit que la procédure actuelle de délivrance de brevets européens, dont le succès est connu, continuera à être dirigée par l'Office européen des brevets actuel qui constitue l'autorité détenant le pouvoir de délivrer des brevets communautaires unitaires pour la CEE si la Convention sur le Brevet Communautaire entre en vigueur. Cette Convention ne régit que l'exercice des droits sur les brevets une fois délivrés dans la CEE. Elle est par conséquent importante pour la libre circulation des marchandises et influencera la politique des déposants en ce qui concerne les brevets. Quant à l'entrée en vigueur de la Convention sur le Brevet Communautaire pour moins que la totalité des états de la CEE, à l'issue d'une discussion approfondie d'experts choisis parmi les Représentants de tous les Etats membres européens, le Conseil de l'EPI a adopté la résolution suivante lors de sa réunion en novembre :

"Ce Conseil est d'avis que la mise en vigueur du Brevet communautaire (Convention) pour moins que la totalité des pays de la Communauté aurait des conséquences déplorables et aurait des effets de division dans l'évolutions de la loi sur le brevet européen".

De plus amples détails sur l'EPI et ses points de vue peuvent être obtenus auprès du Président, M. J. D'haemer (CH) ou du Secrétaire général, M. Christer Onn (SE).

13th SACEPO MEETING

Munich, 7 and 8 November 1985

The 13th meeting of the Standing Advisory Committee before the European Patent Office (SACEPO) was held on 7 and 8 November in Munich.

1. Report of the President of the EPO

- The meeting was presided over for the first time by Mr. P. Braendli, who assumed office as President of the EPO on 1 May 1985. The EPO expects the number of applications filed in 1985 (including PCT applications) to be in the region of 39,000, about 55% of which originate from EPC States. In 1985, Directorate General I (The Hague) will have carried out about 55,000 searches (including PCT and national applications from CH, FR, NL, TR, as well as standard searches). The search report for 30% of the applications has to be published belatedly. The first official action issues as a rule 12 months from receipt of the application by the Examining Division. Patents are granted on 70% of all applications, and 67% of the applications lead to patents that survive either the time-limit for lodging opposition or opposition proceedings themselves. Opposition is lodged against 11% of the applications.
- The EPO is considering various possibilities of reducing the backlog of search and examination. One idea being mooted is to combine search and examination.
- Spain and Greece should become Contracting States of the EPC by mid-1986. In the event of any delays, the duration of the reservations under Art. 167 EPC could not be extended to 1992.
- The EPO has formed a US-EPO Liaison Committee consisting of members of patent law associations and of Bar Associations from all over the United States. These members represent industry as well as patent attorneys in private practice. A parallel Japan-EPO Liaison Committee has also been formed. Both Committees will meet once a year. The EPO will keep SACEPO regularly informed of the activi-

ties of both Committees. The EPO intends to publish a Newsletter to keep both Liaison Committees and SACEPO informed of current developments in the EPO.

- The EPO is maintaining a joint Committee with the Chinese Patent Office. The next meeting is scheduled to take place in the spring of 1986. The EPO would welcome comments from applicant circles on first experiences made with Chinese prosecution. Comments received by the end of February 1986 can be put forward by the EPO in the Joint Committee.

2. Report on matters arising from earlier SACEPO Meetings

- The Brazilian INPI will now recognise the priority arising out of European or international applications.
- Current practice regarding the transmittal of A-3 documents to those ordering patent applications will be retained.
- The EPO will carry out PCT searches and preliminary examinations in respect of English language PCT applications originating from Japan. The number of applications per year will be limited to 200. The agreement shall run initially for three years.

3. Guidelines for Article 25 EPC

- Provision will be made that the Examining Division may accept written comments from the parties if the Court permits it.
- The main emphasis of Guideline 2.2 shall be put more on the technical aspects.
- The composition of the Examining Division must be communicated to the Court if a member was earlier involved in the same case.

4. Claim fees

- The EPO is seeking alternatives to reduce the work and expense involved in administering claim fees. No concrete result emerged from the discussion and the present regulation will remain in force.

5. Translation of priority documents

- At the first meeting of the Japan/EPO Liaison Committee, the suggestion was made to dispense with the translations of priority documents which may be required. However, the EPC itself makes such translations mandatory and the EPO's conclusion that they cannot be dispensed with was endorsed.

6. Payment of renewal fees when fees have been increased

- The views of the EPO were approved. In future, the day of payment and not the due date shall govern the amount of the renewal fee.
- Increases in fees are planned for 1987 at the earliest.

7. Application of Rule 58(4) in oral proceedings

- The communication according to Rule 58(4) shall also be adhered to in oral proceedings. The Boards of Appeal are free to decide on their own procedure within the scope of the EPC.

8. DATIMTEX System

- A users' meeting will be held at the beginning of 1986 to speed up the use of diskettes or OCR-B by applicants.
- Diskettes will be accepted, even if they do not comply in all respects with the Guidelines.
- Consideration is also being given to providing an incentive to use these possibilities. A fee reduction would come up against difficulties as a matter of principle.

9. Patent Register/Official Journal/Name Index

- The proposals for improvements approved by the EPO will be implemented in mid-1986.
- The new proposals were discussed by the SACEPO Subcommittee for Patent Documentation and Information on 29 October 1985. It is intended to implement the approved proposals in 1987.

10. State of the Community Patent Convention

- Discussion took place on the different viewpoints regarding the seven-member solution (coming into force of the CPC for seven EEC States only) and amendment of Art. 86 CPC, as well as on the proposal regarding the Rules Relating to Fees.
- The EPO supports the seven-member solution and the proposal regarding fees, according to which the patent owner shall pay the same amount of renewal fees as the average present patent owner under the EPC.
- The fee for the joint designation of EEC States shall be three times the amount of the designation fee for one Contracting State.

11. Trilateral Co-operation EPO/JPO/USPTO

- The EPO has up to now taken the view that the dissemination of the data and information in its possession should be reserved for Contracting States. The EPO is at present contemplating a possible departure from this principle. The problem of the dissemination of electronic patent information will be discussed at a seminar embracing all interested circles in May/June 1986.

12. Harmonisation of patent practice

- The EPO is entitled to decide on harmonisation solely within the scope of the present Convention (including the Implementing Regulations). The harmonisation of material provisions is a matter for the Contracting States, whereas the amendment of Rules is a matter for the Administrative Council. The EPO can, however, negotiate regarding amendments to Rules.
- The EPO intends to establish a Subcommittee for Harmonisation comprising three representatives each from UNICE and the EPI as well as one representative each from the CEIPI and the Max Planck Institute. It will be the task of this Subcommittee to discuss current specific questions relating to harmonisation.

- A warning was expressed against harmonisation to the detriment of the European patent system.

13. Period of grace for novelty

- An active approach by the EPO to the question of the period of grace will depend on the industrial circles achieving accord in the matter.

14. Next SACEPO Meeting

- The next SACEPO meeting will take place on 6 and 7 November 1986 in Berlin.
- Proposals for agenda items should be submitted early.

EPI LONG TERM BUDGET OUTLOOK

by Sten Gasslander

Chairman of the Finance Committee

The EPI has now been in existence for almost eight years and reached a phase of a more steady-state operation. The many various problems in connection with the building up of our Institute have been solved and time has come to consider our present financial status and make more long-range planning for the future.

The Treasurer and the Finance Committee have together worked on this problem using the development and experiences from the past seven years. The basis for our study has been the number in membership, the balance between income and expenses and the resulting remaining assets during this 7 1/2 years period.

Chart 1 illustrates the change in number of members during the period 1979-1985. The number reached a maximum in 1981 but started to decrease in 1982. The number of people resigning from the Institute is now considerably larger than the number of new members entering the Institute. This has been the case for the last three years and this tendency is expected to continue in the years to come due to the relatively low number of people passing the European Qualifying Examination.

Chart 2 illustrates the development of our economy during a seven year period. Not knowing much about the problems of establishing an international organisation of our type and making it workable in a proper way, the first Council decided on a subscription fee of DM 200.-. This was considered rather high at that time, but, as it turned out, not enough for saving our first Treasurer and first Secretary General from serious financial problems during the first year of operation. In order to prevent similar situations in the future, Council decided to keep this high fee a second year to build up a proper reserve and then make step by step reductions (to DM 100.- in 1983). The chart clearly shows the balance between income and expenses and the result thereof on remaining net assets. Expenses exceeded income for the first time in 1983 due to

increased activities and costs (i.a. the dollar rate) and the step by step decrease in the subscription. However, the high level of remaining assets justified some years of losses.

In October 1984 in Munich, Council discussed the financial situation and decided that for full freedom of action the Institute should maintain a reserve approximately equal to one year's expenses. At the same time the subscription fee was increased to DM 125.- in order to move by steps towards a balanced budget. So much for the past.

Based on Council's decision on the level of remaining net assets and the development of membership and economy (Charts 1 and 2), we made an estimation of income and expenses for the years 1986-1990 on the assumption that the activities of the Institute follow the same pattern as before. We looked at the income figures from various levels of the membership fee and compared them with the roughly estimated expenses year by year (see Chart 3). The conclusion from Chart 3 is quite univocal: for a balanced budget considerable increases in the subscription fee are necessary. In this connection the income from interest on investments should not be neglected. By maintaining a reserve of the suggested size, we have an additional income over the income from subscriptions of about 70,000 to 80,000 DM, which means DM 15-20 per member in a reduced fee yearly.

We then looked at the effect of the figures of Chart 3 on remaining assets and put them on Chart 4 as a proposal for reaching a balance in 1987. With an increase to DM 150.- for 1986 a further increase to DM 200.- would be necessary for 1987, to DM 225.- for 1988 and DM 250.- for 1989 and 1990. An increase of DM 175 for 1986 could probably result in maintaining the fee for 1987 followed by a raise to DM 225.- for 1988 and DM 250.- in 1989 and 1990.

As mentioned before these considerations are based on an unchanged mode of operation of our Institute, and any considerable changes in these operations decided at coming Council meetings could certainly have significant impact on our economic future.

EPI "MEMBERSHIP"

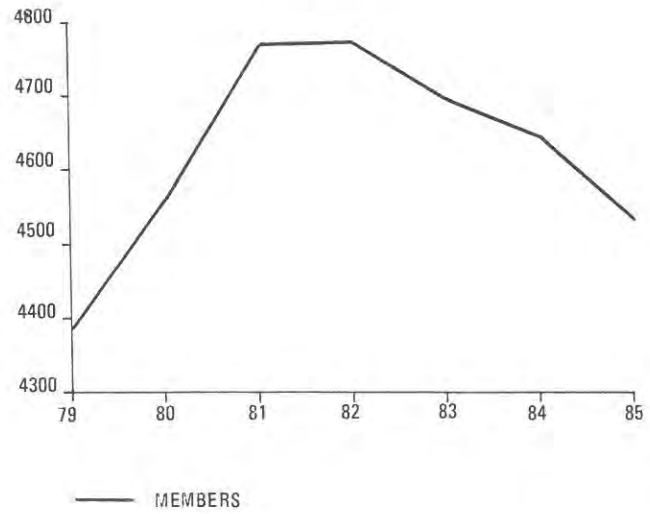


FIG 1

EPI FINANCIAL STATISTICS

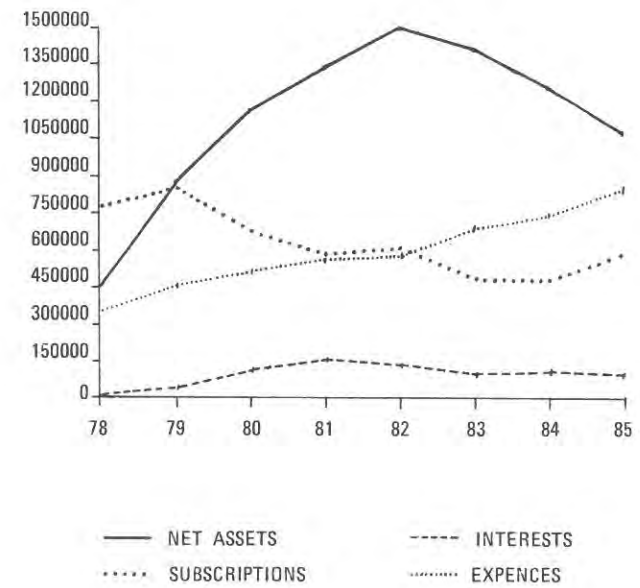


FIG 2

	INCOME			EXPENSES
	Subscr.	Interest	Total	
<u>1985</u> 4,500 members 125 DM/mem.			656	838
<u>1986</u> 4,450 members 150 DM/mem. 175 DM/mem.	667 778	80 80	747 858	892
<u>1987</u> 4,300 members 150 DM/mem. 175 DM/mem. 200 DM/mem.	645 752 860	70 70 70	715 822 930	928 4% increase
<u>1988</u> 4,150 members 175 DM/mem. 200 DM/mem. 225 DM/mem.	726 830 933	70 70 70	796 900 1,003	965 4% increase
<u>1989</u> 4,000 members 200 DM/mem. 225 DM/mem. 250 DM/mem.	800 900 1,000	70 70 70	870 970 1,070	1,004 4% increase
<u>1990</u> 3,800 members 225 DM/mem. 250 DM/mem.	855 950	70 70	925 1,020	1,044 4% increase

FIG 3
in 000's

REMAINING ASSETS		
		Rest
<u>1985</u> 125 DM/mem.	loss 173	1,075
<u>1986</u> 150 DM/mem. 175 DM/mem.	loss 145 loss 34	929 1,041
<u>1987</u> 175 DM/mem. 200 DM/mem.	loss 106 gain 1	935 1,042
<u>1988</u> 200 DM/mem. 225 DM/mem.	loss 55 gain 49	885 984
<u>1989</u> 225 DM/mem. 250 DM/mem.	loss 34 gain 65	950 1,049
<u>1990</u> 250 DM/mem.	loss 24	926

FIG 4

in 000's

TRAINING OF FUTURE MEMBERS OF THE PROFESSION

By Angus Duncan, Chairman of the
Committee on the European Qualifying Examination

The vast majority of representatives currently practising before the European Patent Office are unqualified, that is to say, whatever experience and in examinations we may have undertaken in our own countries we have never had to sit down and do the hard work of learning the working and effect of the European Patent Convention for the purpose of passing the Qualifying Examination. How many of us can be confident that we would do so? Only one person on the list has the proud distinction of having risked submitting himself to the examination although entitled to be on the list anyway.

For those interested in statistics, there are now one hundred and sixty five people on the list who have passed the Qualifying Examination, something over four thousand who have not.

It is therefore not always easy to remember that when the last of those initially on the list retires, the only people entitled to practice will in time be those who have sat and passed the Qualifying Examination; they are the future generation of membership of the Institute, and until they are qualified and on the list they have no voice whatsoever in the Institute. This puts the responsibility wholly on the shoulders of the present members to ensure that those future members receive adequate training.

Although, having initially decided it was too difficult to arrange any regular tuition or training, your Council has now changed its view and initiated a programme of tutorial instruction, the main burden of responsibility still lies with the individual practitioners.

The ways in which professional practices are run differ in detail from country to country and there are some differences attributable to the differing needs of private practice on the one hand and industrial patent departments on the other. But in all offices it is, I suggest, important that an assistant who is taken on should, whatever the size of the

practice, be made the responsibility of an individual representative, not necessarily the same one throughout his training period.

When the student enters for the Qualifying Examination he has to obtain a certificate from his employer indicating not only that he has worked for the required period called for by Article 16(2)b (basically a four year period) but also indicating that range of aspects of European practice in which he has engaged. I suspect that some employers only become aware of this when their pupils are on the point of entering for the examination and it comes something of a shock.

In Germany the Patentanwaltskammer provides a check-list which pupils for their examinations, and their employers, have to complete regularly at intervals throughout the training period, and this ensures that the pupil is given the necessary experience. A proposal for a similar idea in Europe was rejected but this need in no ways prevents employers voluntarily adopting such check-lists for their pupils. By providing his pupil with such a check-list the employer gives the pupil a powerful tool with which to keep the employer up to the mark in providing the pupil with regular European work in the different fields of drafting, amendment, opposition and legal matters. If the employer has no time to devise his own check-list the certificate under Article 16(2)b could be used, not just before the examination, but to be kept in front of the pupil throughout his four years.

There has been criticism of what has been regarded by some as the relatively low pass rate in the European Qualifying Examination. If blame is to be attached, the one person to whom it cannot rightly be directed is the candidate. The failure lies with us, the employers already on the list, either for selecting the wrong people when taking on new entrants to the profession, or for failing to give them sufficient close supervision and training. For a start, each pupil should be given his own copy of the light blue three-language version of the Convention so that over the four-year period he acquires total familiarity with it; this is the version he will have available to him in the Examination and he must be familiar not only with the words but with the layout and appearance, so that he can find the place he wants quickly, almost instinctively. Ideally he should have his own copy of the red paperback

PCT published by WIPO, or at least ready access to it and access easily and immediately to the European Patents Handbook. The other essential reading is Dr. Günter Gall's outstanding "Questions and Answers"; if your pupil can answer the questions in that book he can obtain the necessary grade in Paper D.

Finally I would encourage each employer to have his pupil working with him in the same room for at least six months. In a medium or large firm or department the pupil could share the room of more than one person in turn. Not all of us like to share a room; we have confidential matters to discuss and it is bound to disturb our concentration. But there is no substitute for the day-to-day contact achieved by the pupil being in the same room as his employer, hearing his dictation of letters, his conferences with clients, his manner on the telephone. If an employer cannot contemplate sharing his room he should at least, if he can, put the pupil in an adjacent room with a communicating door that is normally open.

To sum up, the responsibility is ours and no-one else's. There are courses at Strasbourg, courses at Queen Mary College, and in Germany, and the Swiss representatives in private practice and industrial practice have got together to organise test examinations. We are now setting up a tutorial system within the EPI and so far have 23 volunteer tutors and nearly seventy candidates. None of these courses or tests, excellent and useful though they are, can be a substitute for regular day-to-day practice in drafting, amending, opposing, under the supervision of the employer.

**EPO STATUS REPORT
ADDRESS BY PAUL BRAENDLI**

**President of the European Patent Office
to the EPI Council**

I would like to thank you most warmly for the invitation to address the EPI Council today. It is the first opportunity I have had, as President of the European Patent Office, of addressing the European patent attorney profession.

It is now more than 7 years since the European Patent office opened for the receipt of the European applications and it is, I believe, no exaggeration to say that the Office has an established place in Europe, if not in the world.

Under my predecessor, Bob van Benthem, the number of applications has risen to nearly 40,000 per year - an unimaginable number in the early days of the Office - and an examination procedure has been created, which produces carefully examined patents in a streamlined and unformalistic manner. This success is due in part to the staff of the European Patent Office, but also in no small measure to the European Patent Attorneys, without whose efforts and co-operative attitude the European patent system would not function as well as it undoubtedly does.

With the feverish activity of the build-up years behind us, we now are entering a phase in which different problems are beginning to emerge, additional tasks are arising and new relationships are being forged.

European Patent Convention

The European Patent Convention has, as I need hardly remind you, been ratified so far by 11 European States. The last state to ratify was Liechtenstein in 1980.

Recently the possibility of further states acceding to the Convention has increased considerably. Spain and Portugal have now completed their arrangements for joining the European Economic Community on 1 January 1986. Spain confidently expects to accede to the Convention by

mid-1986. The reason is that Spain intends to make a reservation under Article 167 in respect of chemical and pharmaceutical products and to request the Administrative Council for an extension of the related 10 year period. Such requests must be filed 1 year before the end of the 10 year period, i.e. before 1 October 1986, which means that Spain must deposit its instruments of ratification by 31 July 1986.

Greece is also giving serious consideration to acceding to the Convention in 1986. It is in a position similar to that of Spain, in that Greece too wishes to make a reservation under Article 167, and to request an extension of the 10 year period.

In Ireland a draft law to accede to the Convention is now on its way through the Irish parliamentary procedure.

In Denmark there are so far no fresh initiatives to ratify the Convention, but there are signs that the early strong opposition to the Convention is weakening somewhat.

In Turkey the Government has brought draft legislation into Parliament in order to change the national patent law, although there is no provision to enable Turkey to accede to the European Patent Convention.

Community Patent Convention

As regards the Community Patent Convention (CPC) - which provides for a unitary Community Patent for the Member States of the European Economic Communities - there has been some quite feverish activity this year. You all know the obstacles which have so far held up the entry into force of the CPC.

An intergovernmental Conference on the Community patent has been convened by the Presidency of the Council of the European Communities from 4 to 18 December in Luxembourg. The objectives of the Conference are to adopt:

- (a) an instrument to allow prompt entry into force of the Luxembourg Convention for the European Patent for the Common Market (Community Patent Convention);

- (b) a Protocol on the Settlement of Litigation concerning the Infringement and Validity of Community Patents (Protocol on Litigation) and related instruments (Statute of the Community Patent Appeal Court, COPAC and Protocol on Privileges and Immunities);

- (c) measures to enable Greece to accede to the Community Patent Convention.

The ten Member States, the two acceding States (ES, PO) and the EC-Commission will participate in the Conference. In addition the EC Court of Justice has been invited, if it so wishes, to participate as an observer at the technical meetings of the Conference. The following have also been invited to attend as observers:

- (a) the signatory States to the European Patent Convention which are not EC Member States, i.e. AT, CH, LI, MC, NO, SE;

- (b) WIPO, EPO, EFTA and the Council of Europe;

- (c) The EPI and thirteen other non-governmental international organisations.

European grant procedures

- (a) European and Euro/PCT applications

The number of applications for European patents while tending towards steady state is nevertheless still growing. During the first 10 months of this year 7% more applications were filed than in the same period last year. The total for 1985 will probably be around 38,500 applications (including 3,500 Euro/PCT applications). Clearly the steady state figure is going to be well over 40,000 applications per year. This number may not seem very large by for instance Japanese or American standards, but since on average more than 6 European countries are designated per European application, 38,500 applications estimated for 1985 represent 250,000 national applications.

Approximately 55% of European applications now originate from the

Contracting States and 45% from non-Contracting States. The main countries of origin are USA (25%), Federal Republic of Germany (23%) and Japan (17%).

The number of national applications filed in the Contracting States has continued to decrease as of course expected. Today the national offices taken together receive only around 50% of the number filed in 1977. However, the reduction differs widely from office to office. For example, the Dutch Office receives only 27% of the number of applications it received in 1977, whereas the German Office still receives 73%, although a considerable number of the latter are first filings providing priority rights for a later European application. It is interesting to note that, overall, these reductions have been more than compensated by the number of European designations. In 1977 around 250,000 national applications were filed in the present Contracting States, whereas in 1984 the number of national applications (135,000) together with the number of European designations (235,000) amounted to an equivalent of 370,000 national applications, i.e. an overall increase of 50%.

(b) Search

It is expected that the Office will produce around 55,000 searches this year, comprising 33,000 European applications, 17,000 national applications, 3,500 international applications, together with around 3,000 special searches for the public.

However, the backlog of searches - at present equal almost to the annual production - is continuing to grow due to the higher than expected number of European applications. For non-first filings the average delay is around 20 months, although in certain technical fields the backlog is much longer. This has resulted in around 40% of search reports on European applications having to be published separately after publication of the corresponding applications. The Office is doing all it can to correct this situation but we cannot at the moment recruit and train enough search examiners (max. 60 per year) to prevent the backlog from increasing. Only at steady state will the Office have a chance of reducing it.

As much use as possible is of course made of automated search techniques, such as internal and external data bases. As from 1986, we shall begin on a trial basis the automated search of English language Japanese applications, provided the Administrative Council, as already recommended by the Budget and Finance Committee, approves the project.

(c) Substantive examination

In the field of substantive examination the backlog situation is not a great deal better. At present the delay is around 12 months - that is the time from receipt of the application by the Examining Division to the issue of the first communication. The backlog has arisen partly due to the increased number of applications but also due to the increased proportion of applications proceeding to examination, which is now approximately 90 out of every 100 European applications filed. Again we have increased the recruitment of substantive examiners, but there are, as for the search, limits on the number which can be recruited and trained per year.

The proportion of applications on which a patent is granted is currently 70%, which figure drops to about 67% after the opposition phase.

There has been some discussion recently (FICPI Congress) on the patentability criteria - in particular as regards inventive step - applied by the European Patent Office. It has been claimed in some quarters that in view of the high granting rate the standards applied by the Office are too low. Some have even connected this rate with the increasing number of European applications. However, I am not convinced that our standards are too low. The last questionnaire submitted to the European interested circles, revealed that in 86% of cases the standard was correct, in 11% too high and in only 3% too low. A further indication that the standard is not too low is the opposition rate. Originally it was estimated that 25% of the granted patents would be opposed, but in fact the rate has remained fairly stable at 10 to 11%. Furthermore, the Boards of Appeal have in general supported the applied standards.

Trilateral co-operation

Trilateral co-operation between the European, Japanese and United States' Patent Offices was started in 1983, with the object of tackling common problems on a joint basis.

The third annual trilateral conference was held last month in Tokyo. It may interest you to know the results of this conference and, in particular, to see how the trilateral co-operation could influence the future development of the European Patent Office.

It has already been mentioned that the increasing numbers of European applications point to a steady state figure of well over 40,000 applications. This situation has led the Office to begin thinking of ways in which such numbers of applications can be managed without the need to increase our staff in direct proportion, particularly the search and examining staff. This goal might be achieved, for example, by rationalisation of the patent granting procedure and/or greater use of automated techniques. In these two respects some of the projects in the trilateral programme could have a major impact.

Documentation/Search

As a result of the first trilateral projects, namely the DATIMTEX project and the BACON project, there will be two new kinds of electronic file, one containing documents captured in facsimile form (or images) and the other containing documents the full text of which is digitalised (character coded) and thereby becomes machine readable.

As regards the DATIMTEX project, the EPO was the first Office of the three to realise that project. As you know it has been possible to file applications under the DATIMTEX procedure, that is either with a diskette or in OCR-B form, as from 1 July. Although the proportion of DATIMTEX applications is very much lower than expected, the rate is nevertheless generally increasing with the majority of applications being filed with diskette. I very much hope that applicants and their patent attorneys will use the new procedure to a greater extent in the future.

Concerning the BACON project (the facsimile record), the JPO has now completed the capture of its backfile; the USPTO hopes to finish by the end of 1987. The EPO will begin capturing the European part next year.

Revolutionising documentation means revolutionising the search. This is less obvious as far as the facsimile file (BACON) is concerned since classification must remain the main key for accessing this file, but some completely new search techniques can be used, such as combined use of different classification systems (IPC and US) as a screening tool, or use of indexing terms as a supplement to a given classification. Tests in this direction are currently being carried out under one of the trilateral projects.

A completely new possibility for conducting state of the art searches will be provided by key-word searching in the future digitalised or character coded file (DATIMTEX). Tests carried out within the trilateral framework have shown that in specific technical fields full text searching, while much less time consuming, already matches manual searching also in respect of quality.

Computerisation of documentation and search will not only affect the internal operation of the three co-operating offices. It will lead to a situation in which the three offices hopefully possess identical search documentation and search tools. As a consequence the quality of the search produced by the three offices - assuming harmonised search techniques - should become more and more alike. Even the language barrier might be able to be overcome with automated translation, which is now being developed as the trilateral project.

The final result of the on-going revolution in documentation and search techniques is hard however to forecast, but you could imagine a situation in which, for those inventions for which world wide protection is sought, searches could be carried out on a work sharing basis. Alternatively, each office could carry out the full search, which would then be recognised by the other two. Such prospectives are certainly not of immediate concern, but might offer realistic possibilities in the not too distant future.

Examination

Although the immediate impact of the current trilateral automation projects will be in the field of documentation and search, the practical processing of applications at the stage of substantive examination will also be effected.

Both the JPO and the USPTO have decided to aim for a "paperless office". Although the EPO is still far from subscribing to such an overall concept, it nevertheless intends, on a pragmatic step by step basis, to increase the level of computer support in application processing. This goal might be described as a "less paper office".

Of greater importance is the trilateral project concerned with the harmonisation of the patent practice of the three offices. So far the three offices have agreed to harmonise only those aspects directly connected with the trilateral automation plans, namely the standardisation of the bibliographic data and a common application cover sheet. Nevertheless the three offices have agreed to make comparative studies regarding unity of invention and procedural and administrative practices - as a first priority - followed by patent practice in the field of biotechnological inventions, patentability of computer software related inventions and inventive step. Conclusions on effective harmonisation, if any, will be made only after completion of these studies. In this connection I might mention that the JPO announced at the conference its intention to revise before the end of 1986 its current regulations concerning unity of invention, claiming priority and the terms for filing oppositions.

How far this harmonisation effort will lead us is difficult to say. One thing is certain: we must not expect too much in too short a time.

Contrary to the search, it is perhaps unlikely that the three offices will in the foreseeable future reach a stage of harmonisation that could lead to mutual recognition of their examination results. However the elimination of at least some of the differences in the three systems would be of benefit not only to the three offices but to their clients too.

Dissemination of patent information

Another trilateral project concerns the dissemination to the public of electronically stored patent information. The three offices are committed to the goal of effective and widespread dissemination of such information, but differ on the mechanisms by which such dissemination can be achieved.

The JPO and USPTO are both of the opinion that such patent information should be freely available to the public in their public reading rooms and deposit libraries. The EPO - or more correctly the Contracting States - consider that dissemination to the public should in principle be carried out by commercial hosts (or vendors, as they are sometimes called), although they have allowed restrictive public access to the EPO's information systems in the public reading room of the USPTO in Washington.

At present the EPO's information systems comprise the family system (FAMI), the inventory system (INVE) and the classification system (ECLA). In the near future, however, two more information systems will be available, namely the facsimile system (BACON) and the digitalised or character-coded system (DATIMTEX).

These two new systems will add a completely new dimension to the question of dissemination of patent information to the European public. It is the intention of the EPO to hold a seminar on this subject next year, probably in June, to which the Contracting States, the European hosts and, above all the European users of such information, namely European industry and European Patent Attorneys, will be invited. It is my hope that this seminar will provide fresh indicators for the European Patent Organisation's future patent documentation policy, the aim of which must be to harness and co-ordinate all Europe's patent information resources.

In concluding my report I should like to express the hope that the close and fruitful relations which have hitherto existed between the European Patent Institute and the European Patent Organisation will continue in the future. These good relations are reflected above all in the routine

and time consuming work carried out jointly by our two organisations, for example in the Examination Board and its three Examination Committees. But there are many other examples too. Rest assured that the European Patent Office will, as far as the Institute wishes and within the limit of our resources, do all we can to assist the Institute in the valuable work it carries out.

INFORMATIONEN DES EUROPÄISCHEN PATENTAMTES ÜBER DAS DATIMTEX SYSTEM

1. Es wird daran erinnert, daß das Amt seit 1. Juli 1985 europäische Patentanmeldungen zusammen mit Diskette oder in OCR-B-Schrift entgegennimmt (siehe Beilage zum Amtsblatt 6/1985 über das DATIMTEX-System).

Diese Form der Einreichung hat mittelfristig positive Auswirkungen auf die Gesamtdruckkosten des Amtes. Das Amt bittet deshalb die Anmelder und ihre Vertreter von dieser Form der Einreichung Gebrauch zu machen.

2. Bis zum 30. November 1985 sind insgesamt 391 Anmeldungen mit Diskette und 130 Anmeldungen in OCR-B-Schrift beim Amt eingereicht worden.

Diese verhältnismäßig geringe Zahl von Anmeldungen im Verhältnis zum Gesamteingang erklärt sich u.a. aus der späten Veröffentlichung o.g. Beilage. Die hauptsächlichen Gründe für die geringe Beteiligung seitens der Anmelder und ihrer Vertreter scheinen jedoch in einer gewissen Unsicherheit in der Anwendung der Richtlinien für die Gestaltung der Anmeldungen und in den Fragen des eigenen Nutzens aus dem System zu liegen.

3. Das Amt möchte deshalb die bisher von den Anmeldern und ihren Vertretern eingegangenen Anmerkungen zum DATIMTEX-System - insbesondere zu den Richtlinien - aufgreifen und sie zusammen mit einer entsprechenden Stellungnahme einer breiten Öffentlichkeit bekanntgeben.

Im einzelnen handelte es sich um folgende hauptsächlich Anmerkungen bzw. Anregungen:

- a) Die Richtlinien sind zu starr und zwingen die Anmelder und ihre Vertreter zu teilweisen kostspieligen ablauforganisatorischen Änderungen bei der Erstellung ihrer Anmeldungen.

- b) Die Anmelder und ihre Vertreter sehen derzeit keinen finanziellen Nutzen aus dem System.
- c) Problem der Geheimhaltung noch nicht veröffentlichter Anmeldungen durch externe Vergabe der Digitalisierungs- und Druckerarbeiten durch das Amt.
- d) Die Zeilenummerierung in der Beschreibung und in den Ansprüchen, sowie eventuelle Referenzzeichen (internes Aktenzeichen) sollten beibehalten werden.
- e) Werden Disketten an Anmelder zurückgegeben und wenn ja, wann?
- f) Probleme bei der Beschaffung von OCR-B-Typenrädern bei deutschsprachiger Tastatur der Schreibmaschine/des Schreibsystems.

Das Amt nimmt zu diesen Anmerkungen wie folgt Stellung:

- zu a) Auf Grund der Komplexität dieser neuen Techniken sowie bisher fehlender nationaler und internationaler Normen und Standards auf diesem Gebiet, hat das Amt in Zusammenarbeit mit den in der Arbeitsgruppe DATIMTEX vertretenen Repräsentanten der Anmelder und ihrer Vertreter den Versuch unternommen, solche Richtlinien in einfacher und verständlicher Form auszuarbeiten und sie der Öffentlichkeit anzubieten. Werden diese Richtlinien im Einzelfall nicht beachtet, so führt dies keineswegs zu einer Beanstandung der Anmeldung, wenn die Unterlagen ansonsten den Formvorschriften der Ausführungsordnung des EPÜ entsprechen.

Das DATIMTEX-System befindet sich derzeit in einer Einführungsphase.

Das Amt ist deshalb darauf angewiesen, daß möglichst viele Anmeldungen in den genannten Formen eingereicht werden, um entsprechende Erfahrungen sammeln zu können.

In dieser Phase werden auch Anmeldungen verarbeitet, die nicht in allen Punkten den Richtlinien für die Gestaltung von

Anmeldungen entsprechen. Zweck dieser Phase ist es u.a., durch ein laufendes "feed back" mit den Anmeldern und ihren Vertretern zu weiteren Verbesserungen der genannten Richtlinien und damit letztlich zu einem gemeinsamen Standard zu kommen.

Das Amt ist deshalb für weitere Anregungen zu diesen Richtlinien dankbar.

- zu b) Im Rahmen der Einführungsphase plant das Amt eine Anhörung durchzuführen, in der insbesondere die Frage des wechselseitigen Nutzens aus dem neuen Verfahren erörtert werden soll.

Das Amt wird weiterhin prüfen, wie die Einreichung von Anmeldungen in maschinenlesbarer Form gefördert werden kann. Vor einer abschließenden Bewertung der Einführungsphase kann jedoch noch keine Aussage hinsichtlich einer Mehrkostenerstattung gemacht werden.

- zu c) Im DATIMTEX-System werden Anmeldungen ca. 5 Monate vor der Erstpublikation an einen externen Vertragspartner für einen Zeitraum von vier Wochen zur Digitalisierung gegeben.

Eine weitere Abgabe zur Durchführung des Drucks der Erstpublikation (A-Schrift) erfolgt 6 1/2 Wochen vor dieser Veröffentlichung.

Bei der Ausarbeitung der neuen Digitalisierungs- und Druckverträge wurde deshalb größte Sorgfalt auf die Geheimhaltung und den Datenschutz der Anmeldungen gelegt. Der Auftragnehmer ist vertraglich dazu verpflichtet, nach Beendigung der Arbeiten die temporär angelegten EDV-Dateien zu löschen und die vom Amt übergebenen Anmeldungsunterlagen umgehend zurückzugeben. Für das Amt ist dies im übrigen keine neue Situation, da auch im derzeitigen Veröffentlichungssystem Anmeldungen acht Wochen vor der Erstpublikation außer Haus gegeben werden.

- zu d) Das Amt hat die Absicht, eine Kopie der Originalunterlagen und nicht die gedruckte A-Schrift als Arbeits- und Druckexemplar im

Prüfungsverfahren zu benutzen. Insofern kann die Zeilennumerierung auf dem Papierausdruck beibehalten werden, wobei jedoch gebeten wird, diese bei OCR-B-Anmeldungen außerhalb des Satzspiegels, d.h. am linken Rand, anzubringen.

Dies gilt auch analog für interne Referenzzeichen des Anmelders oder seines Vertreters. Diese Zeichen sollten ebenfalls außerhalb des Satzspiegels, vorzugsweise am oberen Rand rechts angebracht werden.

Unabhängig davon sollten jedoch, soweit technisch möglich, die Zeilen-Nummern und die Referenzzeichen nicht auf der Diskette gespeichert sein. Die Ziffern 4.3 d) sowie 6.2 h) der Richtlinien sind in diesem Sinne zu verstehen.

zu e) Die Disketten werden zum Zeitpunkt der Publikation der A-Schrift an den Anmelder zurückgegeben. Bei entsprechend großem Diskettenaufkommen könnte auch eine Sammelrückgabe in Betracht gezogen werden.

Die verzögerte Rückgabe hat folgende Gründe:

- im Falle einer fehlerhaften Konvertierung kann die Diskette für eine erneute Konvertierung verwendet werden,
- Gründe für eine fehlerhafte Konvertierung können geklärt werden,
- Geheimhaltungsgründe (Vermeidung einer irrtümlichen Rücksendung an Dritte vor Veröffentlichung).

zu f) Dem Amt liegen Informationen von einigen Anmeldern vor, daß Hersteller von Schreibmaschinen bzw. Schreibsystemen mit deutscher Tastatur teilweise keine oder keine "passenden" OCR-B-Typenräder liefern können.

Das Amt wird in dieser Sache nach weiteren Lösungsmöglichkeiten suchen und die Öffentlichkeit entsprechend weiter unterrichten.

Anmeldern, die mit diesem Problem konfrontiert sind, wird empfohlen, ihre Anmeldungen vorerst noch in der herkömmlichen Form zu erstellen und nicht die teilweise von den Herstellern als Alternative angebotenen internationalen OCR-B-Typenräder zu benutzen, da diese nicht den für deutschsprachige Anmeldungen notwendigen Zeichenvorrat enthalten (z.B. Umlaute).

Das Amt bittet diese Anmelder oder Vertreter, die Namen der Hersteller sowie die Modellbezeichnung ihrer Schreibmaschine oder ihres Schreibsystems dem Sekretär der AG DATIMTEX unter folgender Adresse mitzuteilen:

Europäisches Patentamt
z.H. Herrn Walter Layes
Referat 4.1.1
Erhardtstraße 27
D - 8000 München 2

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