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Freie Stellen - positions vacant - vacances d'emploi

EPI- INFORMATION 2-1991
EDITORIAL

The newly elected Council at its meeting in Beaune on May 6th and 7th 1991 elected David Votier as our President. As well as having a new President a completely new Board was elected and you will find the names and functions on the last page. The members of the various committees were elected or re-elected and their names will be also be found at the end of this issue. This time we give an indication of the country of each member to assist you in contacting your nearest committee member when you have comments or suggestions to make about the work of that committee. Such comments are always welcomed.

We learned recently of the death of Bernard Fisher, a Council member of this Institute. A brief memorial is included herein. We hope you will find the article on the protection of a mouse of interest. Our readers will have strong views on the possible extension of European patent protection to animals and we look forward to receiving and publishing your letters on this subject.

This is the last edition proposed with the assistance of Ken Veryard who announced at Beaune his retirement from the Editorial Board. Jean Brullé and Joachim Herzog will continue as editors and Terry Johnson was appointed to replace Ken Veryard.

Jean Brullé, Joachim Herzog, Ken Veryard

IN MEMORIAM BERNARD FISHER

Bernard Fisher spent his early years in Belgium where his mother tongue was Flemish but he was then educated in England where he became an electrical engineer and later qualified as a chartered patent agent. He was elected to the Council of the Chartered Institute and became its President in 1983. He was elected to the Council of the European Patent Institute in 1985 and was re-elected to the Council just before his death. He had been a prominent member of the Fédération Internationale des Conseils en Propriété Industrielle (FICPI) and at the time of his death on the 19th March 1991 he was the President of that body. He had been looking forward to presiding over its Congress at Harrogate in October this year.

Ken VERYARD
SHORT REPORT OF
THE 30TH EPI COUNCIL MEETING IN BEAUNE
6TH AND 7TH MAY 1991

The 30th epi Council meeting took place in Beaune, France. It was well arranged by Mr. MADEUF and his colleagues who deserve thanks for their great efforts.

76 Council Members, 8 Substitutes not representing a Council Member, 4 Institute Members as "invited guests", and 3 other guests attended the meeting.

The meeting was opened by the past President, Mr. SPEISER. He also presented the results of the 1990/1991 Council elections referring to the report of the Election Committee and the Objection Committee. Council approved these reports and Mr. SPEISER confirmed the validity of the elections.

Having decided to maintain the current size of the Board which is composed of 17 members, one member per country plus an additional member for the three large countries (United Kingdom, France and Germany) Council elected the new Board. Its composition is reflected in the "List of Decisions" also published in this edition.

The past President, Mr. SPEISER, thanked Council, Board, and particularly the Secretary General, Mrs. PAPACONSTANTINOU, the Treasurer, Mr. WEYLAND, and the staff of epi for supporting him in such a difficult period. He then handed over the chair to the new President, Mr. VOTIER.

Mr. VOTIER thanked Mr. SPEISER and the previous Presidents present and indicated that the new Board will have to face problems of continuity due to the large number of new Board Members.

L'ancien Président et l'ancienne Secrétaire Générale présentent leurs rapports qui sont approuvés par le Conseil. Les points les plus importants de ces rapports sont l'inquiétude exprimée en ce qui concerne les augmentations récentes des taxes de l'OEB, la représentation de l'EPI à la "Tripartite Users Conference", de même qu'à la réunion du Conseil d'Administration de l'OEB, à l'inauguration du bureau de l'OEB à Vienne (anciennement INPADOC), à la Commission d'Intérêt CPC et aux élections. Les sujets se rapportant au Secrétariat Général concernent le recrutement du nouveau directeur, les problèmes de personnel, les services du bureau et l'exposition des artistes de l'EPI.

Le Trésorier, M. WEYLAND, présente son rapport sur la situation financière de l'Institut, qui s'avère être bonne. Les Commissaires aux comptes présentent leur rapport et il est proposé une motion donnant le quittance au Trésorier et au Bureau pour l'exercice 1990. Le Conseil approuve les comptes pour 1990; le Trésorier et les membres du Bureau précédent reçoivent le quittance.

Le Conseil élit ensuite les membres des différentes Commissions et Groupes de travail.

Les Commissions et Groupes de travail présentent leurs rapports et soumettent leurs propositions. Les décisions prises par le Conseil sont notées dans la "Liste des décisions".

Le Conseil confirme les dates des prochaines réunions du Conseil et fixe les dates éventuelles des réunions suivantes jusqu'au printemps 1993. Pour plus de détails, se reporter à la "Liste des décisions".

Le Président clôture la séance en remerciant les participants pour leur participation active et constructive.

Le Secrétaire Général
A.J.M. DRIES
LIST OF DECISIONS
OF THE 39TH EPI COUNCIL MEETING IN BRAUNFELS
6TH AND 7TH MAY 1991

1. Mrs. LE PENNEC and Mr. SALVADORI were appointed scrutineers.
2. The results of the elections to Council were approved.
3. As before, the future Board will be composed of 17 Members.
4. The Members of the new Board are:
   President: Mr. VOTIER (GB)
   Vice Presidents: Mrs. THOURET-LEMAITRE (FR)
                      Mr. HOLZER (AT)
   Secretary General: Mr. DRIES (NL)
   Treasurer: Mr. BÜCHEL (LI)
   Deputy Secretary General: Mr. KEIL (DE)
   Deputy Treasurer: Mr. J. GEVERS (BE)
   The remaining members are:
   Mr. WAVRE (CH)
   Mr. MEYER-DULZEUER (DE)
   Mr. VINGTOFT (DK)
   Mr. ELZABURU (ES)
   Mr. MADEUF (FR)
   Mr. PETERSEN (GB)*
   Mrs. PAPACONSTANTINOU (GR)
   Mr. MODIANO (IT)
   Mr. WEYLAND (LU)
   Mr. NORDIN (SE)

* Note of the Secretariat: Mr. PETERSEN had erroneously thought that he would be able to serve on the Board for one more term. Yet, since he had been elected for the same position for three consecutive terms he is no longer eligible. Thus his election is invalid. Another UK Board Member will be elected during the next Council Meeting.

5. Mr. VOTIER nominated Mrs. THOURET-LEMAITRE as Deputy President for the first year.
6. The minutes of the last Council Meeting in Liechtenstein were approved with a few minor amendments.
7. Draft minutes are to be circulated to all Council Members within a few weeks after the Council Meeting with the request to react and adapt the minutes and report on the amendments to the Secretariat.
8. The reports of the President and the Board were approved.
9. The Auditors’ report 150/91 was adopted by Council.
10. Council approved the 1990 accounts.
11. Concerning cost generating activities of EPO and EPO fees Council decided that epi should not get involved in EPO policy issues but concentrate on activities relevant to patent granting procedures.
    The EPO Fees Committee is to work out general guidelines for further epi positions on this matter and advise Council as early as possible on possibilities to get involved.
12. The Personal Liability ad hoc Committee and the Working Group on DATIMTEX were dissolved.
13. Although SACEPO members are nominated personally by the EPO President and consequently cannot be regarded as belonging to an official committee of epi, Council decided to have
the SACEPO representation reflected in the "epi Information" list of committees as a service to epi Members.

14. The epi members proposed by the Institute for SACEPO are as follows:

- Austria: Mr. W. HOLLER
- Belgium: Mr. F. GEVERS
- Switzerland: Mr. V. BALASS
- Germany: Mr. F.A. JENNY (for EPPC)
- Denmark: Mrs. E. JUNG
- Spain: Mr. M. CURELL SUNOL
- France: Mr. B. PHELIP
- United Kingdom: Mr. J. BROWN
- Greece: Mr. T.M. MARGELLOS
- Italy: Mr. V. FARAGIANA
- Liechtenstein: Mr. R. WILDI
- The Netherlands: Mr. T.A. SMULDERS
- Sweden: Mr. B. ERIXON

15. Report no. 165/91 of the Disciplinary Committee was noted.

16. The EPPC report 118/91 was noted and its motions were approved with some minor changes.

On the issue of whether or not prior use should be limited exactly to the acts that have taken place or whether it should also include the obvious equivalents Council voted in favour of the acts as such.

17. Council noted the report 148/91 of the Professional Qualification Committee.

18. Retired EPO examiners should be regarded as EPO employees for the purpose of, inter alia, being involved in qualifying examination procedures.

19. Council invited the Professional Qualification Committee to reconsider the extreme time pressure and the non-availability of Board of Appeal decisions during qualifying examinations with the Examination Board.

20. Concerning a suggestion that the persons involved in the professional qualifying examination should be allowed to have two more hours available when originating from countries of non-official languages Council decided to refer this matter to the Professional Qualification Committee with the request to advise Council of an appropriate solution.

21. Assets of the Institute are to be deposited in the currency in which majority of expenditures take place, i.e. "DM".


23. The report of the By-Laws Committee 117/91 was approved.

24. Council approved the report of the Harmonization Committee and the stance to be taken at the forthcoming Diplomatic Conference.

25. The dates for the next Council Meetings are as follows:

- 1992 spring: Copenhagen 11 and 12 May
- 1992 autumn: Luxembourg, tentatively 12 or 19 October
- 1993 spring: Belgium, in May, preferably outside the period 23 to 26 because of a UNION meeting in the United Kingdom.

The Secretary General
A.J.M. DRIESE
BERICHT
DER 30. EPI RATSITZUNG IN BEAUNE
AM 6. UND 7. MAI 1991

Die 30. EPI Ratsitzung fand in Beaune, Frankreich, statt. Sie war von Herrn MADEUF und seinen Mitarbeitern gut vorbereitet. Ihnen gebührt Dank für ihre großen Anstrengungen.

76 Ratsmitglieder, 8 Vertreter ohne Vertretungsfunktion, 4 Institutsmitglieder als "eingeladene Gäste" und 3 weitere Gäste waren anwesend.


Der Rat beschloß, die gegenwärtige Anzahl der Vorstandsmitglieder bei 17 zu belassen, einem Vorstandsmittel für jedes Land und jeweils einem weiteren Vorstandsmitglied für die drei großen Länder (Vereinigtes Königreich, Frankreich und Deutschland). Die Zusammensetzung des anschließend gewählten Vorstandes ergibt sich aus der "Beschlußliste", die ebenfalls in dieser Ausgabe veröffentlicht ist.


Herr VOTIER dankte Herrn SPEISER und den anwesenden Altpresidenten und deutete an, daß der künftige Vorstand wegen der großen Zahl neuer Vorstandsmitglieder Kontinuitätsprobleme haben könnte.

Herr VOTIER ernannte Frau THOURET-LEMAITRE zur Vizepräsidentin für das erste Amtsjahr.


Nach der Wahl der Mitglieder für Ausschüsse, Arbeitsgruppen und andere offiziellen Funktionen erstatteten die bisherigen Komitees und Arbeitsgruppen ihre Berichte. Soweit sie damit Anträge verbunden, entschied der Rat hierüber. Einzelheiten ergeben sich aus der "Beschlußliste".

Der Rat bestätigte die Daten für die nächsten Ratsitzungen und legte Termine für weitere Sitzungen bis zum Frühjahr 1993 fest. Über Einzelheiten gibt die "Beschlußliste" Aufschluß.

Mit Dank unter anderem für die lebhaft und konstruktive Beteiligung schloß der Präsident die Sitzung.

Der Generalsekretär
A. J. M. Dries
DESLÜSBLISSTEN

DER 10. EPI RATSITZUNG IN BRAUNE

6. UND 7. MÄRZ 1991

1. Frau LE PENNEC und Herr SALVADORI wurden als Stimmenzähler benannt.

2. Die Ergebnisse der Ratswahlen werden bestätigt.

3. Wie zuvor, wird sich der künftige Vorstand aus 17 Mitgliedern zusammensetzen.

4. Die Mitglieder des neuen Vorstandes sind:

   Präsident: Herr VOTIER (GB)
   Vizepräsidenten: Frau THORET-LEMAITRE (FR)
                 Herr HOLZER (AT)
   Generalsekretär: Herr DRIES (NL)
   Schatzmeister: Herr BUCHEL LI
   Stellv. Generalsekretär: Herr KEIL (DE)
   Stellv. Schatzmeister: Herr J. GEVERS (BE)

   Außerdem:
   Herr WAVRE (CH)
   Herr MEYER-DULHUEVER (DE)
   Herr VINGTOFT (DK)
   Herr ELZABURU (ES)
   Herr MADEUF (FR)
   Herr PETERSEN (GB)*
   Frau PAPACONSTANTINOU (GR)
   Herr MODIANO (IT)
   Herr WEYLAND (LU)
   Herr NORDEN (SE)


   Herr VOTIER benannte Frau THORET-LEMAITRE als Vizepräsidentin für das erste Jahr.

5. Das Protokoll der letzten Ratssitzung in Liechtenstein wurde mit einigen geringen Änderungen bestätigt.


8. Der Rechnungsprüfer-Bericht 150/91 wurde vom Rat angenommen.

9. Der Rat genehmigte die Bilanz für 1990.

10. Der bisherige Vorstand wurde entlastet.

11. Im Hinblick auf kostenverursachende Aktivitäten des EPA und auf EPA-Gebühren entschied der Rat, daß das epi nicht auf "policy issues" einwirken, sondern sich auf Einflußnahme bei Vorgängen beschränken soll, welche die Erteilung von Patenten betreffen.

   Der EPA-Gebührenausschuß soll allgemeine Richtlinien für
weitere epi-Positionen in diesem Bereich ausarbeiten und den Rat schnellstmöglich über Einflussnahmemöglichkeiten beraten.

12. Der ad-hoc Ausschuß Berufliche Haftung der Mitglieder und die Arbeitsgruppe DATIMTEX wurden aufgelöst.


Folgende epi-Mitglieder wurden für SACEPO vorgeschlagen:

Österreich
Belgien
Schweiz
Deutschland
Dänemark
Spanien
Frankreich
Großbritannien
Griechenland
Italien
Liechtenstein
Niederlande
Schweden
Herr W. HOLZER
Herr F. GEVERS
Herr V. BALASS
Herr F.A. JENNY (EPPC)
Frau E. JUNG
Herr K.E. VINGTOFT
Herr M. CURELL SUNOL
Herr B. PHELIP
Herr J. BROWN
Herr T.M. MARGELOS
Herr V. FARAGGIANA
Herr R. WILDI
Herr T.A. SMULDERS
Herr B. ERIXON

15. Der Bericht Nr. 165/91 des Disziplinarrates wurde zur Kenntnis genommen.


Hinsichtlich der Frage ob Vorbenutzung nur auf die Handlungen als solche, die stattgefunden haben, beschränkt werden solle, oder ob sich dies auch auf offensichtliche Äquivalente erstrecken solle, entschied der Rat sich für die Handlungen als solche.

17. Der Rat nahm den Bericht 148/91 des PQC zur Kenntnis.

18. Pensionierte EPA-Prüfer sollten u. a. zum Zwecke einer Beteiligung in Qualifizierungsexamen als EPA-Bedienstete betrachtet werden.


20. Der Rat verwies, die Anregung, daß Personen aus Ländern mit "nicht offiziellen Sprachen" während des Examens zwei weitere Stunden zur Verfügung gestellt werden sollten, an das PQC mit der Bitte, dem Rat eine geeignete Lösung vorschlagen.

21. Institutsvermögen soll in der Währung angelegt werden, in der die Mehrzahl der Ausgaben stattfindet, d. h. in "DM".

22. Der Rat billigte die Zuständigkeitsregeln für den Finanzausschuß, die Rechnungsprüfer und den Harmonisierungsausschuß.

23. Der Bericht des Geschäftsordnungsausschusses 117/91 wurde gebilligt.

24. Der Rat billigte den Bericht des Harmonisierungsausschusses und den einzuhemmenden Standpunkt bei der bevorstehenden Diplomatischen Konferenz.

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EPI-INFORMATION 2-1991 15
La 30ème réunion du Conseil de l'EPI s'est tenue à Beaune en France. M. MADEUF et ses collègues qui s'formaient chargés de l'organisation méritent de sincères remerciements.

76 membres du Conseil, 8 suppléants ne remplaçant pas un Membre du Conseil, 4 Membres de l'Institut présents en qualité d'"invités" et trois observateurs assistaient à la réunion.


Après avoir décidé de maintenir la taille actuelle du Bureau, composé de 17 membres, un membre par pays plus un membre supplémentaire pour les trois plus grands pays (Royaume Uni, France et Allemagne), le Conseil procède à l'élection du nouveau Bureau dont la composition est donnée dans la "Liste des décisions" de ce numéro.

L'ancien Président, M. SPEISER, remercie le Conseil, le Bureau et particulièrement la Secrétaire Générale, Mme PAPAKONSTANTINOU; Le Trésorier, M. WEYLAND et le personnel de l'EPI de l'avoir aidé dans une période si difficile. Puis il cède la place au nouveau Président, M. VOTIER.

M. VOTIER remercie M. SPEISER et les Présidents précédents en précisant que le nouveau Bureau aura à faire face à des problèmes de continuité vu le grand nombre de nouveaux Membres du Bureau.

M. VOTIER nomme Mme THOURET-LEMAITRE Vice-Présidente Adjointe pour la première année du Conseil.
L'ancien Président et l'ancienne Secrétaire Générale présentent leurs rapports qui sont approuvés par le Conseil. Les points les plus importants de ces rapports sont l'inquéitude exprimée en ce qui concerne les augmentations récentes des taxes de l'OEB, la représentation de l’EPI à la "Trilateral Users Conference", de même qu’à la réunion du Conseil d'Administration de l'OEB, à l’inauguration du bureau de l'OEB à Vienne (anciennement INFADOC), à la Commission d'Intérêts CPC et aux élections. Les sujets se rapportant au Secrétariat Général concernent le recrutement du nouveau directeur, les problèmes de personnel, les services du bureau et l'exposition des artistes de l'EPI.

Le Trésorier, M. WEYLAND, présente son rapport sur la situation financière de l'Institut, qui s'avère être bonne. Les Commissaires aux comptes présentent leur rapport et il est proposé une motion donnant le quittance au Trésorier et au Bureau pour l'exercice 1990. Le Conseil approuve les comptes pour 1990; le Trésorier et les membres du Bureau précédent reçoivent le quittance.

Le Conseil élit ensuite les membres des différentes Commissions et Groupes de travail.

Les Commissions et Groupes de travail présentent leurs rapports et soumettent leurs propositions. Les décisions prises par le Conseil sont notées dans la "Liste des décisions".

Le Conseil confirme les dates des prochaines réunions du Conseil et fixe les dates éventuelles des réunions suivantes jusqu'au printemps 1993. Pour plus de détails, se reporter à la "Liste des décisions".

Le Président clôt la séance en remerciant les participants pour leur participation active et constructive.

Le Secrétaire Général
A.J.M. DRIES

LISTE DES DECISIONS
DE LA 30ÈME RÉUNION DU CONSEIL DE L'EPI
BRUXELLES
LES 6 ET 7 MAI 1991

1. Mme LE PENNEC et M. SALVADORI sont désignés comme scrutateurs.

2. Le Conseil approuve les résultats des élections.

3. Le nouveau Bureau sera composé de 17 membres comme auparavant.

4. Les Membres du nouveau Bureau sont:

   Président:
   M. VOTIER (GB)

   Vice-Présidents:
   Mme THOURET-LEMAITRE (FR)
   M. HOLZER (AT)

   Secrétaire Général:
   M. DRIES (NL)

   Trésorier:
   M. BÜCHEL (LI)

   Secrétaire Adjoint:
   M. KEIL (DE)

   Trésorier Adjoint:
   M. J. GEVERS (BE)

Les autres membres sont:

   M. NAVRE (CH)
   M. MEYER-DULHEUER (DE)
   M. VINGTOFT (DK)
   M. ELZABURU (ES)
   M. MADEUF (FR)
   M. PETERSEN (GB) *
   Mme PAPACONSTANTINOU (GR)
   M. MODIANO (IT)
   M. WEYLAND (LU)
   M. NORDEN (SE)
   M. ELZABURU (ES)

* Note du Secrétariat: M. PETERSEN avait pensé pouvoir
faire partie du Bureau pour la durée d’un nouveau mandat. Mais ayant été élu trois fois consécutives à la même fonction, il n’est plus éligible. Son élection est par conséquent invalidé. Un nouveau membre du Bureau sera élu pour le Royaume Uni au cours de la prochaine réunion du Conseil.

M. VOTIER nomme Mme THORET-LENAITRE Vice-Présidente Adjoints.

5. Le protocole de la dernière réunion du Conseil du Liechtenstein est approuvé avec quelques amendements d’ordre mineur.

6. Un projet de protocole doit être envoyé à tous les membres du Conseil dans les quelques semaines suivant la réunion du conseil afin que ceux-ci puissent faire part au Secrétariat de leurs commentaires sur les changements adoptés.


8. Le Conseil approuve le rapport 150/90 des commissaires aux comptes.


10. Les Membres du Bureau précédent reçoivent le quitus.

11. En ce qui concerne l’augmentation des coûts et des taxes officielles de l’OEB, le Conseil décide que l’EPI ne doit pas être impliqué dans les questions de politique de l’OEB et qu’il doit se concentrer sur des activités relatives aux procédures de délivrance de brevets.

La Commission Taxes OEB a pour tâche d’élaborer les grandes lignes de la future politique de l’EPI relative à cette question et d’avisser le Conseil le plus tôt possible des possibilités d’intervention.

12. La Commission ad-hoc responsabilité professionnelle et le groupe de travail DATIMTEX sont dissous.

13. Les membres de SACEPO étant nommés personnellement par le Président de l’OEB, ils ne peuvent par conséquent pas être considérés comme membres d’une commission officielle de l’EPI. Le Conseil décide cependant que la liste des membres de SACEPO paraîtra dans epi- Information avec les autres commissions, ceci en tant qu’information pour les Membres de l’EPI.

14. Les membres de l’EPI proposés par l’Institut pour SACEPO sont les suivants:

- Autriche M. W. HOLZER
- Belgique M. F. GEVERS
- Suisse M. V. BALASS
- Allemagne M. E. JADORSKI
- Danemark M. K.E. VINGTOFT
- Espagne M. M. CURELL SUNOL
- France M. J. BROWN
- Grèce M. T.M. MARCELLOS
- Italie M. V. PARAGINNA
- Liechtenstein M. R. WILDE
- Pays Bas M. T.A. SMULERS
- Suède M. B. ERIXON


Sur la question de savoir si le droit de premier usage devrait être limité exactement aux actes qui ont eu lieu ou bien s'il doit aussi inclure les équivalents évidents, le Conseil vote en faveur des actes en tant que tels.


18. Les examinateurs à la retraite de l'OEB devraient être considérés comme des employés de l'OEB dans le but, entre autres, de les impliquer dans les procédures de l'Examen de Qualification.

19. Le Conseil invite la Commission de Qualification Professionnelle à reconsidérer l'extrême pression de temps et la non-disponibilité des décisions de la Cour de recours pendant l'Examen de Qualification avec le jury d'examen.

20. En ce qui concerne la proposition d'accorder, à l'Examen de Qualification, deux heures de plus aux candidats dont la langue maternelle est autre que l'une des trois langues officielles, le Conseil décide d'en référer à la Commission de Qualification Professionnelle en lui demandant de proposer au Conseil une solution appropriée.

21. L'actif de l'Institut doit se trouver dans la monnaie dans laquelle sont effectuées la majorité des dépenses, c. à d. en "EHU".


23. Le rapport de la Commission du Règlement Intérieur 117/91 est approuvé.

24. Le Conseil approuve le rapport de la Commission d'Harmonisation et la position à prendre à la prochaine Conférence Diplomatique.

25. Les dates des prochaines réunions du Conseil sont les suivantes:
   printemps 1992 - Copenhague, 11 et 12 mai
   automne 1992 - Luxembourg, le 19 ou le 12 octobre
   automne 1993 - Belgique, en mai, de préférence avant ou après la semaine du 23 au 26, date à laquelle a lieu une réunion de l'UNION au Royaume Uni.

Le Secrétaire Général
A.J.M. DRIES
NOTE ON THE ELECTIONS

The results of the 1990/91 elections were published in epi-information 1/1991 already. Due to an error in the ballot papers a second voting procedure was necessary in the United Kingdom constituency. The following chart will inform you about its results.

The information given in the previous edition on the election results of the Spanish constituency is incorrect. Three full Members were shown as Substitutes and vice versa. A correct publication follows on the next pages.

All election results were validated at the Beaune Council Meeting.

The General Secretary
A.J.M. Dries

UNITED KINGDOM

Unitary

Total ballots received: 373

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* Mr. FISHER died on 19 March 1991
UNITED KINGDOM

The Council of the Institute of Professional Representatives

Unitary

Full members

1. VOTIER Sidney David 307
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** alphabetical order, equal number of votes

SPAIN

Unitary

Total ballots received: 69

ARMIJO NAVARRO-REVERTER Enrique 59
CURELL SUNOL Marcelino 69
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ELOSEQUI DE LA PENA Inigo 59
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IBANEZ GONZALEZ José Francisco 57
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MORGADES Y MANONELLES Juan Antonio 60
POLO FLORES Carlos 58
PONTI SALES Adalaida 60
SUGRANES Pedro 63
The main purpose of the meeting was to prepare for the SACEPO meeting on 6-7 March at Munich, other than Patent Law Harmonisation items which had been prepared by the EPPC sub-committee on Harmonisation.

**UPC Convention**

The possible lifting on the ban on double protection was welcomed. However the weaknesses in the WIPO proposals for definition on a plant "variety" were deplored. The EPO analysis was agreed, especially the effects on Article 53b, EPC. There is a positive attempt in UPC to encroach on the patent law. In the circumstances "variety" should no more be defined than "invention": but if there must be a definition it should be scientifically respectable and not mixed up with extent of protection notions. In particular it should not be broadened to matter which goes beyond the usual meaning of variety (distinctive, homogeneous and stable) and it should not refer to parts of plants as these read onto single cells and the definition then gets into the field of microbiology.

**Patent term restoration**

The proposal by the EPO that Article 63, EPC should be amended to enable the Contracting states and the European Commission to provide for patents term restoration was approved in principle. However, the proposed amendments by the EPO should be restricted to the first two paragraphs, i.e. national or regional authorities should have the power to extend the term of a European patent on any grounds, there should be no upper limit to the patent term - this should be left to those authorities, and there is no need for implementation provisions in the amended article. They should be in the rules.
A large majority were against doing this straight away but agreed to the need for an umbrella provision. A small majority were for the proposal to limit Article 63 to the first two sentences and a large majority were for deleting the EPO's proposed paragraphs (3)(4) and (5). Article 63 would then read:

1. The term of the European patent shall be 20 years as from the date of filing of the application.

2. Nothing in the preceding paragraph shall limit the right of a Contracting state to extend the term of a European patent under the same conditions as those applying to its national patents.

Payment of protest fees under ECT rules 40.2a and 68.3e
A large majority were in favour of the proposed fee, but it should not be higher than one third of the appeal fee.

Rule 101 - Authorisations
The EPO proposal is in line with the wishes of the EPI, however the EPPC desires clarification from the EPO of the position of employees who are not on the list and the requirements when there has been a change of representative.

Discussions between SACEPO and the Appeal Boards
This was welcomed. The following were mentioned as possible subjects for discussion - late filed documents, amendments made in response to the development of the case, whole contents novelty and inventive step.

Short report on Harmonisation from the Harmonisation Sub-Committee
1. The package is acceptable if USA agrees to first to file (It later transpired that USA had backed away from first to file)
2. There is a danger USA may propose further changes (It later transpired they wish to write in their first to invent system as a permanent option).

3. Best mode - if this retained we will have to adopt the best mode standard.

4. Unity of invention - it is not clear whether if the main claim has to be cancelled, the remaining claims can be continued with or whether it is necessary to divide.

5. Rule 6, Correction - it is not clear that the proprietor can correct.

6. Article 7, late claim to priority and failure to file within the 12 months - These are important provisions and should be supported.

7. Article 8, replacing description by a reference to another application - provided the number is given and there is adequate certification, i.e. telex filing - this should be mandatory - disagree with alternative B.

8. Article 9, first to file - agree.

9. Article 10, technical fields - agree with alternative B.

10. Article 11, novelty - against the option for local novelty for oral disclosures and use abroad. EPO is concerned about the first medical use but this is wrong - they confuse invention and product.

11. Article 13, whole contents - must be novelty only - 'delete the whole contents and obviousness option - delete 4(b) as a clause against self collision is desired.

12. Article 14, amendment - delete from "however" (EPC type restriction on amendment after reply to the substantive examiners first letter).

13. Article 16, time limits for search and examination - these are unrealistic. The imbalance of getting a late search report could be redressed by making the publication at 24
months provided the search report is received sufficiently early for the applicant to be able to prevent publication. (An advisory vote of the EPPC on this was roughly even - 7 for and 8 against).


15. Article 21, extent of protection - there is a difficulty with equivalents - it would be best to delete (2) as (1)(b)(the EPC Protocol) is wide enough.

16. Article 24, burden of proof - prefer alternative B without (b) (which gives a choice of provisions (i) and (ii) particularly to USA).

17. Articles 25 and 26 - should not be in the treaty.

Prior use in the European Community
As part of its work on the Community patent the Community Patent (COPAC) Sub-Committee examined the question of prior use and its report was reviewed by the EPPC. A final report has been prepared and its main points are:

1. The acts establishing a right of prior use before the priority date of a patent are use of the invention for commercial purposes in good faith, or serious and effective preparations for such use intended to be on commercial scale. Prior importation can be such an act as can manufacture, use and sale.

2. This implies a substantial financial commitment and not mere personal possession.

3. A prior use must be in good faith and the invention in question must not have been obtained unlawfully from the inventor. But deriving it from a publication by the inventor is lawful and in good faith.

4. A prior use right can be held only by the natural or actual legal person that performed the prior acts which established it, but such person has the right to sub-contract the use to another EC country, in particular the same concern, and the goods may freely flow throughout the Community after having been placed on the market by such person.

5. Extensions of the prior acts should be permitted quantitatively but there are restrictions to changing ist category. Thus importation can be extended to use and sale but not to importation and manufacture; sale can only be extended to use.

6. A majority of the EPPC would permit the judge to decide on a case by case basis that a technical variant of what was done before the priority date amounts to the same prior use; but if any leeway is permitted, it should be narrow and any technical changes should be limited. A minority are against any technical extension.

7. Any such changes must be independent of the way the patent is worded.

8. A prior use right should be transferable only with the business in which it arose.

Conclusion A European Community right of prior use will be broader than the rights available in the member states, since free flow of goods and probably manufacture have to be aligned with the single European market. However this broadening should be compensated in other directions, particularly with respect to its technical scope and its transferability. The purpose of the prior use right is to protect prior investments and not to confer an expanding privilege or a foot in the door.

J.L. Beton, Rapporteur
LIFE AND PATENTS ...  
or the story of a little mouse

by Alain GALLOCHAT  
Paris

Just ten years ago, the question of whether a being is patentable or not would have seemed somewhat improper. However, it is obvious that since then there has been a phenomenal expansion in the Life Sciences, particularly in genetic engineering techniques. These techniques have made it possible to alter the genetic inheritance of certain plants or animals to the point where they can exhibit properties that have been deliberately chosen by man. And so, without any fuss and almost naturally, the stage has been reached whereby patents are granted for microorganisms and lower forms of life which can be exploited by research and industry.

However, on 12 April 1988 a considerable step was taken in our history. The United States Patent and Trademark Office (USPTO) granted a patent protecting an animal. The holder of the patent, in this case Harvard University, thus found itself given the exclusive ownership of a mutant animal, i.e. an animal which had been given new genetic properties; this was achieved by inserting foreign genes into the fertilized egg.

From bacteria to oysters

One has to go back to 1980 in order to understand the decision of the USPTO. At that time, the United States Supreme Court decided in the case of DIAMOND versus CHAKRABARTY that living matter, insofar as it owed its existence solely to the intervention of man, was in itself patentable. This decision concerned a microorganism - in this case, a genetically modified bacterium for degrading hydrocarbons - and was of capital importance in the field of biotechnology. It relied on a basic principle of substantive patent law according to which inventions resulting from the endeavours of man are patentable, whereas discoveries - for example, products found in nature - are not.

Having been reminded of this principle, it took another seven years before a new decision was handed down in the area of biotechnology, also in the United States. The question was important and no longer concerned a microorganism, as in the CHAKRABARTY case, but a higher life form, namely an oyster. Its inventor was S. ALLEN of Washington University and he had inserted some additional chromosomes into an oyster, thereby altering the mollusc's taste, especially at those times of the year when oyster consumption is low due to their bitter taste. Thus, on 3 April 1987, USPTO handed down a decision which has remained celebrated even though it was fundamentally similar to the decision taken by the Supreme Court in the CHAKRABARTY case.

In its decision, the USPTO confirmed that animals were perfectly patentable once they met the classical criteria for patentability. However, in this specific case, the claims protecting the oyster were rejected on the grounds of their lack of inventiveness. The decision also took care to clearly specify that human beings were not included in the scope of this provision. In other words, a mutant human being could not be the subject of appropriation by patent.
Myc-mouse

It therefore came as no surprise when on 12 April 1988 the USPTO granted a patent for a mutant animal to Harvard University with a particularly broad general claim, reading as follows:

"Non-human mutant mammal whose cells contain a recombinant oncogene sequence introduced into the aforesaid mammal, or ascendant of the latter, at the embryo stage".

More specifically, the patent protects a mouse in which various oncogenes have been introduced. As a reminder, oncogenes are genes which normally mediate cell growth and differentiation but which, under certain conditions (e.g. modification of their structure or regulation of their expression) are the cause of anarchical cell proliferation, disturbances in differentiation and cancers. In the present case, the oncogene "myc" was among the genes which were introduced, whence the name sometimes given to this mouse, "MYC-MOUSE". Thus modified, the animal is able to develop certain forms of cancer and enables certain drugs to be tested for oncogenicity or the antimitotic properties of other drugs to be verified (Living cells usually divide by the method of mitosis, ensuring that the same number of chromosomes is preserved, while antimitotic drugs are intended to stop cell division and therefore multiplication; they are notably used in the chemotherapy of certain cancers).

Thus, the progress made by the USPTO since the decision by the Supreme Court in 1980 has been in total conformity with the latter decision. And, contrary to some opinions which were voiced against the Harvard patent, it can be maintained that the Office has not violated patent law, at least not as it is currently drafted.

The role of such an Office is to see that a patent is only granted when the invention for which protection is desired meets the classical criteria of patentability prescribed by law. This was the case for MYC-MOUSE.

It should be noted that twenty or so files concerning mutant animals are currently in abeyance at the USPTO.

Will they succeed? This is doubtful, inasmuch as several bills have been submitted to the American Congress designed to ban temporarily or conclusively the granting of patents protecting such animals or to limit the effects of such patents.

And what about Europe?

The results of the American legislative battle have been awaited impatiently, all the more so since they might affect the European situation which is markedly different from that prevailing in the United States.

In fact, Article 53b) of the European Patent Convention (EPC) provides that European patents are not granted for:

"... plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof".

Exactly the same terms are found in the 1978 French law (Article 7c), apart from "plant varieties". However, French law included special provisions for plant varieties.
Thus, for the moment, legislation appears to prohibit the granting of any patent for animals, whether mutant or otherwise. However, can a mutant mouse be considered as an "animal variety"? Some authors are prepared to give a negative reply. An initial factor in judging was provided in June 1988 when a European patent was granted to the AGRIGENETICS ADVANCE SCIENCE company for a genetically modified plant, in spite of the aforementioned Article 53b). In this case, the argument accepted was that products obtained through a patentable process are themselves patentable, and that mutant plants and animals do not generally constitute new varieties.

Be that as it may, the decision of the European Patent Office concerning the mutant mouse was delivered on 14 July 1989 and rejected the patent application involved, N° 85 304490.7. Prior to this decision, oral proceedings had taken place on 26 June 1989 at which the applicants had presented a set of claims in support of main request. The essential claims read as follows:

1. A method for producing a transgenic non-human mammalian animal having an increased probability of developing neoplasms, said method comprising introducing an activated oncogene sequence into a non-human mammalian animal at a stage no later than the 8-cell stage.

17. A transgenic non-human mammalian animal whose germ cells and somatic cells contain an activated oncogene sequence introduced into said animal, or an ancestor of said animal, at a stage no later than the 8-cell stage, said oncogene optionally being further defined according to any one of claims 3 to 10.

18. An animal as claimed in claim 17 which is a rodent.

The remaining claims were dependent either directly or indirectly upon claims 1 or 17 and therefore followed the fate of the aforementioned claims.

In its decision of 14 July 1989, the Examining Division relied in particular on the following three grounds:

1) Article 53b) of the EPC excluded "animal varieties" from protection by patent.

The applicant had pointed out that:
- the claim did not concern an animal variety
- the process claimed was not essentially biological
- the animals which were the subject of claims 17 and 18 were patentable since they were derived from a microbiological and therefore patentable process.

The Examining Division did not accept this argument, stating that the exclusion of Article 53b) of the EPC actually extended to animals in general and not to such and such a specifically claimed variety.

The argumentation of the Examining Division considers in particular the fact that the French text of the EPC mentioned "races animales"; while the German text quoted "Tierarten" and the English text used the expression "animal varieties". According to the Examining Division, this diversity of expression showed that the authors of the EPC intended to exclude animals in general.
One might quite rightly be surprised at this interpretation, especially since Article 53b) repeats the terminology of the Strasbourg Convention - as is stressed, moreover, by the Examining Division - concerning the standardization of certain components of substantive patent law for inventions dating from 1962. At that time, genetic engineering was in its infancy and it is probable that by envisaging the exclusion of animal varieties from patentability the authors of the Strasbourg Convention were certainly not thinking of refusing patentability to inventions deriving from techniques that were unknown, or almost unknown, thirty years ago.

This being the case, why give a meaning to Article 53b) that the authors of the Strasbourg Convention could not even have imagined?

The problem is complicated even further by the fact that there is no legal definition of an "animal variety".

Moreover, the Examining Division points out altogether appropriately that the (animal) products in claim 17 are in fact of two different natures. There are those which have been the subject of genetic manipulation by gene insertion, particularly by microinjection, and which are therefore derived from a process which is not essentially biological, and there are those which are the single product of sexual reproduction, which is by definition exclusively biological. The Examining Division accordingly concluded that the latter products are not concerned by Article 53b) of the EPC, second member of the sentence.

It is true that the Applicant had argued that the process should be taken as a whole and was essentially non-biological in nature. To which the Examining Division replies that the second member of the sentence in Article 53b) must be interpreted in the light of the first member of the sentence of the aforementioned Article and concludes that "the processes which allow plant varieties or animal varieties within the meaning of the first member of the sentence of the aforementioned provision to be obtained should not be considered as microbiological processes".

In the interpretation by the Examining Division, the Applicant's claims 1 to 19 are rejected by application of Article 53b).

2) Application of Article 83 of the EPC

The Examining Division also objects that the Applicant has carried out experiments with only a single oncogene, the myc gene, and that the mouse is the only mammal in which the gene has been inserted. In contrast, the invention in its broadest scope concerns any gene and any mammal apart from a human being. The Examining Division finds that Article 83 of the EPC envisages that the invention must be set out sufficiently clearly and completely and quotes decision T 226/85 which specifies that the conditions set out in Article 83 are only fulfilled if "any realization of the invention such as it is defined in the widest scope of the claim can be performed on the basis of the account of the invention".

According to the Examining Division, these conditions are not fulfilled, since it is not "reasonably possible" to extrapolate the results obtained using the mouse to all mammals such as anthropoid apes or elephants which have a different number of genes and immune systems which are equally different. However, it should be noted that the Examining Division considers that "if claims 1 and 17 apply to rodents rather than to mammals other than a human being, this would not amount to unduly extending the subject of the application".
In turn, the Applicant relied on decision T 292/85 stipulating that an invention is sufficiently explained if at least one method of realization is clearly indicated that would allow a professional to perform the invention and that it is unnecessary for the account to include special indications on how to obtain all the possible variants of an element covered by a functional definition. The Examining Division does not agree with this argumentation, reasserting that mammals as different as rodents, carnivorous animals and primates cannot be compared to the aforementioned "variants".

3) Consideration of Article 53a) of the EPC

The Examining Division also turned its attention to ethical questions by examining Article 53a) of the EPC providing that European patents are not granted for inventions whose publication or implementation would be contrary to public order and accepted standards of behaviour. Moreover, the Examining Division explicitly referred to the problems encountered in the United States, as has already been mentioned, and to the bill submitted to the House of Representatives.

The Examining Division also refers to the Guidelines relating to the examination carried out at the European Patent Office (EPO) (Part C, heading IV, 3.1.) and giving examples of inventions in which accepted standards of behaviour might be put forward; these Guidelines specify that the objective of Article 53a) of the EPC is to exclude the patentability of inventions liable to provoke licentiousness, disturb law and order, or to incite to criminal or reprehensible behaviour.

Having made this analysis, and remembering that the invention concerned might have beneficial effects for humanity, the Examining Division concluded that:

a) Article 53a) of the EPC is not applied for the rejection of the patent application in question

b) substantive patent law is not, in the present case, the correct legal tool...

The Examining Division used these various grounds and considerations as the basis when it handed down its decision on 14 July 1989 while at the same time having taken care to indicate in its account of the facts that "the novelty of the invention has never been disputed during the examination and the applicant was able to put forward plausible reasons to demonstrate inventiveness".

Obviously, the Applicant lodged an appeal, notably requesting that the file be referred to the Enlarged Board of Appeal.

It is true that the importance of animal patentability might justify a decision by the Enlarged Board, while discussions continued on the draft of the Brussels Directive concerning biotechnological inventions notably envisaging the non patentability of animal varieties.

The Technical Board of Appeal handed down its decision (T 19/90) on 3 October 1990, again going over the three aforementioned points of the Examining Division.

1. Article 53b) of the EPC

The Board of Appeal challenges the Examining Division interpretation inasmuch as, according to the latter, Article 53b) excluded animals as such from the area of patentability.
To do this, the Board of Appeal first of all insists on the fact that Article 53b) is an exception and, as such, must be interpreted selectively, the general rule being the patentability of inventions with potential industrial applications, which are new and show inventiveness.

In addition, according to the Board of Appeal, nothing in the preliminary documents of the Strasbourg or Munich Conventions indicates that the intention of the legislation was to exclude animals from patentability. Curiously, moreover, the Board of Appeal draws on the fact that the French ("races animales"), English ("animal varieties") and German ("Tierarten") terms in the EPC are different and concludes that the legislator's meaning was not to exclude "animals" in general from patentability.

The Board of Appeal also stresses the fact that, unlike "plant varieties" for which other industrial property rights exist, there is nothing which pertains to "animal varieties".

Finally, the Board of Appeal sends the question back to the Examining Division in order to determine whether a mutant animal is or is not an animal variety. If the reply is negative, Article 53b) cannot obstruct the granting of a patent. If the answer is positive, the refusal of the application could only be justified, according to the Board of Appeal, inasmuch as it corresponds to the correct interpretation of Article 53b). The Board of Appeal also draws the attention of the Examining Division to the fact that if the latter supposition is correct, Article 53b) would apply to any animal obtained by genetic manipulation, and this was not envisaged by those who drafted the Strasbourg Convention or the Munich Convention ...

The Board of Appeal is also interested in the Examining Division's assertion that the fact that the Applicant included animals obtained genetically and animals obtained by sexual reproduction in the same claim was clear proof that the Applicant wished to circumvent the exception of Article 53b). On this subject, the Board of Appeal "expresses some doubts" as to the legality of such a conclusion and contends that, in any case, the main question of the exception to patentability of animals remaining unanswered, this point is not under study. Furthermore, the Board of Appeal observes that the claim is of the "Product by process" type, i.e. it is a product claim and not a process claim, adding moreover that products (mutant animals) could perfectly well be obtained by routes that are not essentially biological, especially by cloning, i.e. by an asexual method.

Finally, the Board of Appeal continues its analysis of Article 53b) and the second part of the sentence stipulating that the 1st part of the aforementioned sentence does not apply to microbiological processes and the products derived from them.

The Board of Appeal does not share the opinions of the Examining Division whereby the 2nd part of the sentence could not be applied once it involved products excluded from patentability within the meaning of the 1st part of the sentence in Article 53b). The conclusion is evident for the Board of Appeal, i.e. a patent may be granted for animals obtained by a microbiological process, and it sends back the question to the Examining Division for verification that the process concerned is a microbiological process within the meaning of Article 53b).

2. Article 83 of the EPC

The Board of Appeal deems that the Applicant's invention is sufficiently described within the meaning of Article 83 of the EPC, contrary to the Examining Division's assertions.
According to the Board of Appeal, a broad claim is not in itself a reason for considering that the application does not meet the requirements of Article 83. It is only in the face of serious doubts, supported by verifiable facts, that the inadequacy of the description may be used to bar the patent application.

While admitting that a mouse is genetically different from other mammals, thereby agreeing with the Examining Division, the Board of Appeal nevertheless concludes that it knows of no verifiable fact that is liable to call into question the implementation of the invention by a professional person, for the invention as claimed, i.e. involving mammals other than the mouse.

It should be remembered that the Examining Division appeared to be ready to accept a claim limited to rodents; yet again, the Board of Appeal has "reservations", emphasizing that even within the order or rodents it is arbitrary to imagine that all rodents react in the same way. The Board of Appeal refers the discussion back to an opposition or invalidation procedure.

At the conclusion of its analysis of Article 83 of the EPC and the arguments of the Applicant and the Examining Division, the Board of Appeal considers that there is no reason to reject the application on the grounds that it includes an extrapolation from the mouse, supported by actual examples, to mammals in general.

3. Article 53a) of the EPC

On this third point, the Board of Appeal also disagrees with the Examining Division which considered that substantive patent law was not suitable for resolving the problems linked to genetic manipulations in animals.

Quite the opposite, according to the Board of Appeal, it is precisely the duty of the Examining Division to determine whether Article 53a) is applicable, notably by striking the balance between animal suffering and environmental risks, and the benefits that humanity might reap from the invention.

To summarize, the Board of Appeal handed down a decision running counter to the position adopted by the Examining Division regarding the three points that the latter had put forward, namely Articles 53a), 53b) and 83 of the EPC. The Board of Appeal finally judged that there was no reason to submit the matter to the Enlarged Board of Appeal, and the file therefore comes before the Examining Division once again.

Even assuming that the patent is finally granted to Harvard for its mutant mouse, the questions will still not be altogether settled. What rights will the patentee have?

Rights and Use thereof

It is precisely concerning this point that certain questions remain. It is one thing to obtain rights, notably through granting a patent, but their ensuing use is another matter. The distinction is important, especially since two different competent jurisdictions are concerned. In the first case, the Patent Office is involved as the administrative authority, while in the second it is the legal authority which provides the ruling. It is not so much obtaining rights (which follow the general rules governing patentability) which raises problems for mutant animals as the use to which those rights are put.

In fact, the fundamental right conferred on a patentee is to be the only person able to exploit his invention and thus to benefit
from the exclusivity of the invention. The use of this invention by a third party is thus submitted for his prior agreement and may occasion the payment of fees. In addition to the resources arising from his own marketing, this then allows the patentee to be able to amortize his research expenses which are especially high in the area of human health. With this notion, the patentee has a right of inspection of all commercial use of his invention by a third party. Moreover, the patented invention is circulated by means of marketing under the patentee's control, with the patentee being the sole person able to control the exploitation of his invention. This idea of controlled exploitation is perfectly comprehensible when the invention consists of an object or a chemical product, such as a drug. On the other hand, the question is much more tricky when an animal or even an animal liable to reproduce without human assistance is involved.

Could a patentee who has sold a mutant animal protected by patent to a farmer ask the farmer for fees for the animal’s descendants? An American bill was submitted on this subject to the House of Representatives on 30 June 1988, excluding certain acts of exploitation relating to patented mutant animals from infringement. It is not sure that such a bill can succeed. All the more so since, more generally, numerous pressure groups have been formed since 1987 in the United States seeking to oppose the granting of patents for such animals. The motivation of these groups is highly variable since they cover ethical, social, economic and religious aspects at the same time. Such motives are highly commendable but have little to do with substantive patent law. Thus, the various pressure groups would be better advised to address themselves to those authorities which regulate trials and research work which involves mutant animals rather than to the American Patent Office which is not comparable to such an authority.

Obviously, there is always the possibility that animals, especially mutant animals, are formally excluded from the domain of patentability, as happened in the United States in the case of nuclear arms (Bill of 1st August 1946, modified in 1954). However, this exception was not extended to the civil applications of nuclear science which remained, in their case, patentable.

As for Europe, the problem of patenting animals, whether mutant or not, is in a very confused situation. Numerous pressure groups have been formed in protest against potential patentability, and governments themselves are very divided - the progress made in drafting the Brussels Directive concerning biotechnological inventions is sufficiently convincing on this point.

Doubtless this subject will remain open to debate for many months or even years. In the meantime, there is no legal tool available to companies and research institutes for protecting their inventions in this area of living matter, inventions which require increasing means in both human and financial terms.
LETTER TO THE EDITOR

Yet another personal view on Art. 123 (2)

Dear Sir,

Like Mr. Caldwell (EPI Information 4/90) I very much enjoyed the paper by Mr. Michel Guérin in EPI Information 3/90.

I lost two cases of claim broadening before Boards of Appeals last year. In one of the cases (T 118/89) I had tried hard to convince the Board that it is a fundamental question whether or not claim broadening is allowable, a question which should be submitted to the Enlarged Board of Appeals. I have pointed out that the two headlines on interpretation of Art. 123 (2) published in the Official Journal 3/90 contradict each other. I have tried to explain why the decision T 194/84 (which was one of them) cannot be based on a correct interpretation of Art. 123 (2). That decision is based on the assumption that this information content of an application is increased when features are deleted from the claim. In the end you get infinite information if you delete the claim altogether. You can replace the whole Library of Congress by publishing an application without claims.

On that basis no feature can be deleted from a claim whether "essential" or not, unless the description explicitly says that the feature could be deleted. That is why the Boards of Appeals with such an interpretation of Art. 123 (2) equate "implicit" with "explicit" as Mr. Guérin noticed.

In the decision T 118/89 the Board of Appeals expressed the opinion that the purpose of Art. 123 (2) is "Richtigheit", just as Mr. Neville suggests for a new Art. 123-2A in EPI Information 4/90. That this cannot be the intended purpose of Art. 123 (2) can be seen directly from Mr. Caldwell’s observation. What indication on the intended scope of protection would a competitor have if the published claim contains nothing but the title of the invention? The present interpretation of Art. 123 (2) by the Boards of Appeals forces applicants to file such ridiculously broad claims, to say nothing of the prior art known to the applicant in the description and to state as problem to be solved: "to make an improved device".

As stressed by Mr. Guérin Articles of the EPC should be read and interpreted in view of their intended purpose. The purpose of publishing the application quite early in the proceedings is to make known to the public the disclosure - not the intended scope of protection. The publication of the disclosure is directly connected to the basic principle of the patent system explained in Mr. Guérin’s paper.

Mr. Neville’s case of unallowed claim broadening is not actually a proper case of claim broadening but rather a case of added subject matter. Mr. Neville says that in Garrod’s Application the original claim mentioned three flaps and the amendment to at least two flaps was not allowed. I can understand that because apparently two flaps was a specific new teaching which added subject matter. The amendment should have been drafted differently: the claim should have been amended to several flaps, which includes two flaps but does not disclose two flaps.

In Great Britain claim broadening by deleting inessential features is generally allowed. The Manual of Patent Practice, 1988 states under Section 76.11:

"The fact that an amendment has the effect of broadening the scope of the claims does not necessarily mean that it will be regarded as adding matter. The question to be asked is, does the amendment alter the teaching of the whole specification as originally filed? The omission from an amended claim of a feature specified in the original claim may be allowable if it is apparent from the whole document that its inclusion as a characterising feature was arbitrary and unnecessary."

I fully share Mr. Guérin’s opinion that it is high time and that it is important for the Board of Appeals to reflect on the intended purpose and the meaning of Art. 123 (2).

Yours faithfully,

Otto Münch (CH)
EXCESS LIABILITY INSURANCE

Clients' claims may ruin the economical and professional situation of a patent attorney. For this reason, EPI has provided for the possibility that its members join an excess liability insurance policy. The necessary arrangements were made two years ago through the Hamburg insurance broker Funk International. The group of insurers is lead by Albingia Versicherung AG.

A claim made against an EPI member is insured as far as it exceeds DM 2 million/equivalent (Excess Liability Policy) per loss. The limit of indemnity per loss amounts to DM 3 million/equivalent in excess of basic policy (ies) and is limited to DM 30 million p.a. for all participating EPI members.

So far the insurance contract has been renewed on a yearly basis beginning on 1st of October and ending on 30th of September. Negotiations are under way for having a contract for the 1991/1992 period and we are optimistic that an agreement for renewal will be achieved in due time.

There might be a slight increase in premium for each joining EPI member from DM 668.80 to DM 687.50 due to a rise in German insurance tax.

All EPI members interested in joining or renewing the policy should ask the General Secretariat for further information.

The Institute is also negotiating terms for insurance coverage below the amount of the actual policy. These negotiations were just started and we do not know when we shall be able to present results.

We feel that this insurance scheme covering all of the fourteen contractual countries to the EPC is necessary in order to provide coverage for EPI members regardless of where they exercise their profession. Each member should carefully consider joining this policy.

CHANGE OF ADDRESS OF EPI MEMBERS

Professional representatives should promptly inform the European Patent Office, service 5.1.1., of any changes of address or other relevant data. The EPO registers these changes and then automatically communicates them to the EPI. Only after reception of these data from the EPO the EPI General Secretariat makes the necessary changes in its files.

ADRESSENÄNDERUNG VON EPI MITGLIEDERN

Zugelassene Vertreter sollten den Europäischen Patentamt, Referat 5.1.1., Adressenänderungen oder Änderungen anderer einschlägiger Daten unverzüglich mitteilen. Das EMA bearbeitet die Änderungsmitteilungen und gibt sie anschließend automatisch an das EPI weiter. Erst dann werden die Vertreterdaten im EPI Generalsekretariat geändert.

CHANGEMENT D'ADRESSE DES MEMBRES DE L'EPI

Les mandataires agréées doivent communiquer le plus rapidement possible leur changement d'adresse ou tout autre changement important à l'Office Européen des Brevets, département 5.1.1. L'OEB enregistre ces changements et les fait suivre automatiquement au Secrétariat Général de l'EPI qui à son tour en prend note.
The EPI Council has set up a "EPO Fees Committee". Since fee levels are influenced by the expenditure of the EPO, this Committee will be considering relevant aspects of the EPO's expenditure plans.

Members of the EPI are invited to give the Committee views and information whether, and where, EPO expenditure (present or planned) might be excessive, insufficient, or misdirected.

To reach the Committee, such views and information should be sent either to the Secretariat or to any of the Committee's members, they being Messrs. ARMIJO (ES), KOEPE (DE), LE VAGUEREESE (FR), and NEUKOM (GB).

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Le Conseil de l'EPI a créé une "Commission Taxes OEB". Le montant des taxes étant dépendant des dépenses de l'OEB, cette commission est chargée de considérer les questions se rapportant aux projets de dépenses de l'OEB.

Les Membres de l'EPI sont invités à soumettre à la commission leurs points de vue et informations, à savoir si et où les dépenses actuelles ou prévues de l'OEB sont excessives, insuffisantes ou mal orientées.

Envoyez s.v.p. vos points de vue et informations au Secrétariat Général de l'EPI ou bien à l'un des membres de cette Commission, ceux-ci étant M. ARMIJO (ES), M. KOEPE (DE), M. LE VAGUEREESE (FR) et M. NEUKOM (GB).

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Der EPI Rat hat einen "EPA- Gebühren- Ausschuß" eingerichtet. Da die Gebührenhöhe von den Ausgaben des EPO abhängt, wird dieser Ausschuss sich mit den Grundlagen der EPO-Ausgabenplanung befassen.

Die EPI Mitglieder werden gebeten, den Ausschuss Meinungen und Informationen zu übermitteln, ob und wo getätigte oder geplante EPA Ausgaben übermäßig, ungenügend oder fehlgeleitet erscheinen.

Bitte senden Sie Ihre Ansichten und Informationen an das EPI Generalsekretariat oder eines der Ausschußmitglieder, nämlich Herrn ARMIJO (ES), Herrn KOEPE (DE), Herrn LE VAGUEREESE (FR) und Herrn NEUKOM (GB).
Golf Tournament
between Examiners of the European Patent Office
and Professional Representatives

EPO-AGENTS TROPHY

Following a longstanding and successful tradition of the British Patent Office, private golf tournaments took place in the years 1989 and 1990 at the suggestion of members of the European Patent Office, in which examiners of the European Patent Office played against professional representatives in a team competition. As an international office, the European Patent Office has numerous golf players among its staff. So as to foster social contacts, particularly for the foreign employees of the European Patent Office, the golf tournament was arranged with professional representatives resident in the Munich area on a private basis in the last two years. The event was a great success with all participants, who agreed that it should be repeated and, if possible, become a permanent institution.

The donated EPO-AGENTS-TROPHY went to the examiners of the European Patent Office both times and stands in the 5th floor of the main building of the EPO in Munich.

As the tournament should not be limited to golf-playing representatives residing in the Munich area, any person interested in participating is asked to contact:

Dr. Wolfhart Körber,DE
C/o Mitscherlich & Partner
Steindorfstr. 10, Postfach 260132
W-8000 München 22
Tel. 089/296684, Tfx. 089/226831

The tournament, which is intended to take place on various golf courses in Upper Bavaria in future, will be held at the

Golfclub Margarethenhof
Waakirchen, Tegernsee

on Tuesday, July 9, 1991

Any professional representatives who are interested and able to come to Munich on that date are invited to take part in the event.
STAFF NEWS

Mrs. Dominique MOREGER has been employed as a part time secretary in the EPI General Secretariat so far. We are happy that she agreed to accept a full time job as of 1st June 1991.

Besides Mrs. MOREGER, the staff is composed of Mrs. Irene ANWENDER, part time secretary, Mr. André ZERAPA, secretary and deputy manager, Mr. Josef A. MOHR, manager.

FREIE STELLEN
POSITIONS VACANT
VACANCES D'EMPLOI

Cabinet de Conseils en Brevet établi au Luxembourg servant une clientèle locale et internationale tant au niveau européen qu'au niveau mondial cherche un

ingénieur brevets confirmé

Si vous avez accompli de solides études universitaires, si vous avez une bonne maitrise des langues française, anglaise et allemande, si, en plus, vous êtes diplômé du CEIP et/ou mandataire agréé et si vous êtes prêt à vous engager dans une firme dynamique, envoyez votre candidature avec curriculum vitae à:

Secrétariat Général de l'EPI
Postfach 26 01 12
W- 8000 München 26
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