Information

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

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We as an Editorial Board are charged with producing this publication for our readers and hope that the articles which appear are interesting, educational, and sometimes at least provocative, in short we are concerned with the message. We also have concern for the Medium and while the Medium may not always be the message, we hope our readers are as pleased as we are with the «New Look».

This being issue No. 2 of this «New Look», with no real adverse comment expressed thus far, we nevertheless welcome any input from our readers. We can say however that we are looking at the possibility of using a larger character size for this and future issues. We also welcome articles, letters, comments and the like in any of the Official languages, - it seems quite a long time since we received an article in French from a French reader, for example!

As to this issue, trying as ever to be ahead of the times, you will find an article by Arthur Huygens on DNA sequencing, one on possible European Community Utility Model Law by Karl-Hermann Meyer-Duhlauer, and a report on the recent Council Meeting in Copenhagen.
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Short Report
32nd Council Meeting in Copenhagen
11-12 May 1992

The 32nd EPI Council Meeting was held in Copenhagen, Denmark. Of the 84 full Council members 82 were present or represented by substitutes. There were no delegates from Monaco. Furthermore 11 substitutes not representing a full Council member or only temporarily representing one attended the meeting as well as two invited guests.

EPI President David Vatier chaired the meeting and particularly welcomed the delegates from the new member country Portugal and extended greetings to those from the new member country Monaco.

The President reported on the Institute’s activities since the last Council Meeting, in particular on the symposium in Budapest on ‘Patent Protection and Market Economy: Czechoslovakia, Hungary and Poland’, the last Administrative Council Meeting, the Diplomatic Conference for the revision of Article 63 EPC, EPI’s opposition to granting exemptions from the nationality requirement of Article 134 (6) EPC which go beyond the established practice, the last SACEPO meeting, the Tri lateral Users’ meeting and the AIPPI Congress in Tokyo, the British Government’s proposal for mixed disciplinary practices, and WIPO proposals for amending the Patent Cooperation Treaty. He thanked for the support he had received last year. For details of his report see the full text of the President’s report published in this edition.

The Secretary General, Mr. Dries, reported on the considerable changes and progress made in the General Secretariat on modernization and streamlining of work. Mass copying for EPI will be done by EPO. EDP facilities have been improved, now connecting all work stations in a network and allowing more sophisticated word-processing activities. Cooperation with the EPO on electronic data processing has been intensified in order to avoid double work. An expert group is working on direct data exchange possibilities between EPI and EPO. Negotiations on the collection of EPI fees from EPO accounts are under way. The General Secretariat took care of the necessary steps for integrating our colleagues from the new member states. For preparing smooth Council elections at the end of this year and early next year the General Secretariat has elaborated a series of amendments of the By-Laws, election rules and election papers.
The Treasurer, Mr. Büchel, reported on the financial situation of the Institute. In 1991 it remained healthy and the expenses were kept within the limits of the amended budget.

The amended rules for payment of EPI fees, as proposed by the Treasurer, were accepted by Council (published in this edition).

The auditors' report led to the discharge of the Board and of the Treasurer for 1991.

Council discussed reports on the Trilateral Users' Conference, the UNION Round-Table Conference on European Utility Model Protection and the reports on activities of the EPI committees. The committee reports were given by Mr. Feldmann for the Finance Committee, Mrs. Thouroule-Lemaitre for the Professional Qualification Committee, Mr. Jenny for the European Patent practice Committee (EPPC), Mr. Huygens for the Committee on Biotechnology Inventions, Mr. Petersen for the Harmonization Committee, and Mr. Neukom for the EPO Fees Working Group.

Council adopted slightly modified deadlines for Council elections and set up a working group for the final revision of the proposed rules for Council elections and election papers. It amended the By-Laws to provide for by-elections for vacant Council seats on request of at least one delegate of the respective constituency/group or the EPI Board.

The size of the Board was increased by two so that the new member countries Portugal and Monaco are properly represented.

Council elected the Portuguese Board member and the Portuguese members for EPI committees and made the nomination for a Portuguese member to SACEPO. For details see the list of Council decisions.

Mr. Votier thanked our Danish colleagues for the splendid organization of this Council meeting.

A. J. M. Dries
The Secretary General

List of Decisions
32nd Council Meeting in Copenhagen
11-12 May 1992

1. The minutes of the last meeting in Munich were approved with minor modifications.

2. The auditors agreed to delete the text in brackets on page 8, last paragraph, of the auditors' report containing a superfluous reference to the budget provisions for a committee.


4. The Board was discharged for the year 1991.

5. In the report on the Trilateral Users' meeting at the Japanese Patent Office in February 1992 by Mr. Beckham, Annex IV, to the President's report, 152/92, minor corrections were suggested.

6. For future elections Council approved the deadlines given in the working papers on amendments of Rules for Election to Council, 171 e, g, f, but decided for Rule 2 to replace «on 1 October» by «at the closing time of the EPO Munich on the last working day of September».

Council adopted the following changes in the By-Laws:

By-Laws Art. 2.4, page 28,
- line 5, after «number shall» insert «only»;
- line 9, after «Council» add «if demanded by a member of the newly elected Council who belongs to the respective constituency or group or by the newly elected Board».

Art. 2.5 and the Rules for Election to Council have to be brought into line with these amendments.

Council also decided that the nomination of candidates should not be limited to self-nomination.

Council set up a working group of which Mr. Casalonga, Mr. Wavre and Mr. Mohr are the members. The group will look into the details for amendments of the Rules for Elections to Council and new election papers. It is to present respective drafts to the Board which will decide on them at its next meeting and thus have new regulations enter into force.

7. Council approved the stance taken by the EPI President in a letter to Mr. Braendli informing him of EPI's opposition to granting exemptions from the Nationality Requirement which go beyond the established practice.
8. The By-Laws Committee will let Council know if amendments of Rule 102 are desirable with respect to members who do not pay their annual fees after a reminder by registered mail.

9. Council approved the amended Rules governing Payment as laid down in working papers 175/92 and 176/92 with the following modifications:
   - in clause 6 delete the last sentence;
   - in clause 7 delete the last sentence;
   - delete clause 9.
   Council left it to the Treasurer to resubmit the deleted items to Council when he feels necessary.

10. PQC will discuss at its next meeting if each of the documents of examination paper C should be drawn in two of the official languages so that the candidates have the choice which of the given languages they want to use.

11. EPPC will prepare a letter for the EPI President asking WIPO for the establishment of reciprocity for European representatives when they want to use PCT in the US with an international search and preliminary examination done by the US PTO. In PCT matters European representatives should be able to directly represent their clients before the US PTO just as US patent attorneys may represent their clients before the EPO.

12. With respect to the UNION project for the creation of a European utility model EPPC will keep a watching eye on UNION and will get involved only if UNION continues its activities.

13. Council appointed Mr. Daniel Davids as successor of Mr. A. Catherine who had resigned as member of EPPC.

14. Vice-president Holzer will attend a WIPO meeting for the preparation of an arbitration scheme for the settlement of industrial property disputes between private persons.

15. Reactions within EPI to the first year of the new system of annual fee adjustments will be discussed at the next EPI Council Meeting so that proposals for next year’s fee adjustments can be given to the EPO in time.

16. Council agreed to have the spring 1994 meeting in Holland, possibly Maastricht, and the autumn 1994 meeting in Portugal, possibly Lisbon or Madeira.

17. In order to have the new member countries Portugal and Monaco represented on the Board Council approved an increase of the size of the Board by two members.

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As Board member for Portugal Council elected Mr. Jorge Pereira da Cruz.

18. Council nominated Mr. Joao Pereira da Cruz for SACEPO. The EPO President has already accepted this nomination.

19. Council appointed the following Portuguese Committee members:
   - Mr. Antonio de Sampaio (PQC)
   - Mr. Joao Arantes-Oliveira (Discipline)
   - Mr. Jose Luis Arraut (EPPC)
   - Mr. Jorge Pereira da Cruz (Professional Conduct)

A. J. M. Dries
Secretary General

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Bericht

32. Ratssitzung in Kopenhagen
11.-12. Mai 1992


Der EPI-Präsident David Votier leitete die Tagung. Er begrüßte besonders die Delegierten aus dem neuen Mitgliedsland Portugal und sandte Grüße an diejenigen aus dem neuen Mitgliedsland Monaco.


Der Schatzmeister, Herr Büchel, berichtete über die finanzielle Situation des Instituts. Sie war auch 1991 gesund und die Ausgaben blieben im Rahmen des Budgets.

Die Änderungen der Regeln für die Zahlung des EPI-Mitgliedsbeitrags wurden in der vom Schatzmeister vorgeschlagenen Fassung angenommen (siehe die Veröffentlichung in dieser Ausgabe).


Der Rat beschloß geringfügige Änderungen bei den Fristen für die Ratswahlen und setzte eine Arbeitsgruppe zur endgültigen Fassung der vorgeschlagenen Regeln für Ratswahlen und der Wahlen unterlagen ein. Er änderte die Geschäftsordnung, um Nachwahlen für vakante Ratssitze auf Antrag mindestens eines Delegierten der betroffenen Wählerschaft oder des EPI-Vorstands zu ermöglichen.

Der Vorstand wurde um zwei Mitglieder erweitert, um den neuen Mitgliedsländern Portugal und Monaco eine angemessene Vertretung zu ermöglichen.

Der Rat wählte das portugiesische Vorstandsmitglied sowie das portugiesische Mitglied in EPI-Ausschüssen und nominierte das portugiesische Mitglied in SACEPO. Einzelheiten sind aus der Beschlüsseliste des Rates ersichtlich.

Herr Votier dankte den dänischen Kollegen für die großartige Organisation dieser Ratstaging.

A. J. M. Dries Generalsekretär

Beschlüsse

32. Ratssitzung in Kopenhagen
11.-12. Mai 1992

1. Das Protokoll der letzten Ratssitzung in München wurde mit geringfügigen Änderungen angenommen.

2. Die Rechnungsprüfer stimmten einer Stichung des in Klammern gesetzten Textes auf Seite 8, letzter Absatz, des Prüfberichts zu, der eine überflüssige Anmerkung zur Budgetbereitstellung für einen Ausschuß enthieilt.


Der Rat beschloß die folgenden Änderungen der Geschäftsordnung; Seite 28, Art. 24 Geschäftsordnung,
- Zeile 5 nach »fehlenden Ratsmitglieder« einfügen »nur dann«;
- nach Zeile 7 anfügen », falls dies von einem Mitglied des neu gewählten Rates, das dem betreffenden Wahlbezirk oder der betreffenden Gruppe angehört, oder vom neu gewählten Vorstand gefordert wird.

Art. 2.5 und die Regeln für die Wahlen zum Rat sind entsprechend anzupassen.

Der Rat entschied ferner, daß die Kandidatenaußenstellung nicht auf eine Selbstnominierung beschränkt wird.


8. Der Geschäftsordnungsaußerschluß wird überprüfen, ob Änderungen der Regel 102 im Hinblick auf Mitglieder, die ihren Beitrag auch nach einer mit eingeschriebenem Brief versicherten Mahnung nicht zahlen, anzuwenden sind.

9. Der Rat billigte die geänderten Regeln für die Zahlung des Mitgliedsbeitrags, wie sie in den Arbeitspapieren 175/92 und 176/92 niedergelegt sind, mit den folgenden Abweichungen:
   - den letzten Satz unter Ziffer 6 streichen;
   - den letzten Satz unter Ziffer 7 streichen;
   - Ziffer 9 streichen.

Der Rat stellte dem Schatzmeister anheim, dem Rat die gestrichenen Punkte gegebenenfalls wieder vorzulegen.

10. PQC wird in seiner nächsten Sitzung darüber beraten, ob jede der Unterlagen des Examenpapiers C in zwei offiziellen Sprachen erstellt wird, so daß die Kandidaten die Wahl haben, welche der Sprachen sie benutzen wollen.


12. EPCC wird das UNION-Projekt zur Schaffung eines Europäischen Gebrauchsmusters wachsenen Auges verfolgen und nur aktiv werden, wenn UNION dies Aktivitäten weiter vorantreibt.

13. Der Rat ernannte Herrn Daniel David zum Nachfolger von Herrn Alain Catherine im EPCC, aus dem letzterer wegen eines Tätigkeitswechsels ausgeschieden ist.


15. Auf der nächsten Ratsitzung werden die Erfahrungen im ersten Jahr des neuen Gebührspankungsverfahrens für Streitigkeiten zwischen Privatpersonen auf dem Gebiet des gewerblichen Rechtsschutzes geteilt werden.

16. Der Rat beschloß, die Frühjahrstagung 1994 in Holland, möglicherweise in Maastricht, und die Herbsttagung 1994 in Portugal, möglicherweise in Lissabon oder Madeira, abzuhalten.

17. Der Rat beschloß, den Vorstand um zwei Mitglieder zu vergrößern, um Portugal und Monaco eine angemessene Vertretung zu ermöglichen. Zum neuen Vorstandsmitglied für Portugal wurde Herr Jorge Pereira da Cruz gewählt.

18. Der Rat nominierte Herrn João Pereira da Cruz für SACEPO. Der EPA-Präsident hat diese Nominierung bereits angenommen.

19. Der Rat wählte die folgenden portugiesischen Ausschußmitglieder:
   - Herrn Antonio de Sampaio (PQC)
   - Herrn João Arantes-Oliveira (Disziplinarbeit)
   - Herrn José Luís Arrota (EPCC)
   - Herrn Jorge Pereira da Cruz (Standesregeln)

A. J. M. Dries
Generalsekretär
Rapport Succinct
32ème Réunion du Conseil à Copenhague
11-12 mai 1992

La 32ème réunion du Conseil de l'EPI s'est tenue à Copenhague, Danemark. 82 des 84 membres titulaires du Conseil étaient présents ou représentés par leurs suppléants. Monaco n'était pas représenté. 11 suppléants ne remplacant pas un membre du Conseil, ou seulement temporairement, assistaient à la réunion ainsi que deux invités.

La réunion est présidée par M. David Votier, Président de l'EPI, qui ouvre la séance en souhaitant la bienvenue aux délégués des nouveaux pays membres, le Portugal et Monaco.

Le Président, M. D. Votier, présente son rapport sur les activités de l'Institut depuis la dernière réunion du Conseil, et mentionne particulièrement un symposium sur « La Protection par brevet de l'Economie de Marché en Tchécoslovaquie, Hongrie et Pologne », la dernière réunion du Conseil d'Administration de l'OEB, la Conférence Diplomatique pour la révision de l'Article 134 (6) CPE, l'opposition de l'EPI à accorder des dérogations à la condition de la nationalité selon l'Article 134 (6) CPE qui va au-delà de la pratique établie, la dernière réunion du SACEPO, le « Trilateral Users' meeting » et le congrès AIPPI à Tokyo, la proposition du gouvernement britannique concernant les pratiques professionnelles multidisciplinaires et les propositions d'amendements par l'OMPI du Traité de Coopération en matière de Brevets. Il remercie pour le soutien qui lui a été apporté l'année dernière. Pour plus de détails se reporter au texte intégral du rapport du Président, publié dans ce numéro.

Le Secrétariat Général, M. Dries, présente dans son rapport les changements considérables et les progrès réalisés au Secrétariat Général en vue d'en moderniser et rationaliser les travaux. Les photocopies à grands tirages de l'EPI sont maintenant effectuées par l'OEB. L'équipement informatique a été amélioré, les ordinateurs sont maintenant reliés à un serveur central et les possibilités de traitement de texte ont été perfectionnées. La coopération avec l'OEB en ce qui concerne l'échange de données informatiques a été augmentée dans le but d'éviter un double travail. Un groupe d'experts étudie actuellement les possibilités d'échange direct de données informatiques entre l'EPI et l'OEB. Des négociations sont en cours pour permettre l'encadrement des cotisations de l'EPI par l'intermédiaire des comptes de l'OEB. Le Secrétariat Général a fait le nécessaire pour intégrer nos collègues de Monaco et du Portugal. En vue de la préparation des élections à la fin de l'année et au début de l'année prochaine, le Secrétariat Général a élaboré une série d'amendements au Règlement Intérieur, aux règles pour les élections et aux documents pour les élections.

Le Trésorier, M. Büchel, fait son rapport sur la situation financière de l'Institut qui s'avère saine pour 1991. Les dépenses n'ont pas dépassé les limites du budget révisé.

Le Conseil accepte les règles relatives au paiement des cotisations de l'EPI avec leurs modifications, ainsi que proposées par le Trésorier (publiées dans ce numéro).

A la suite du rapport des Commissaires aux comptes le Bureau et le Trésorier reçoivent le quitus pour l'année 1991.

Le Conseil discute les rapports sur la Trilateral Users' Conference, la « UNION Round-Table Conference on Utility Model Protection » et les rapports sur les activités des différentes commissions de l'EPI.

Le Conseil adopte les légères modifications des dates limites pour les élections et met en place un groupe de travail chargé de la révision finale des Règles proposées pour les élections du Conseil et des documents des élections. Il modifie le Règlement Intérieur pour assurer des élections secondaires dans le but de pourvoir les sièges vacants du Conseil à la demande du collègue ou groupe intéressé ou du Bureau de l'EPI.

Le nombre des membres du Bureau est augmenté de deux personnes afin que la représentation des nouveaux pays membres, le Portugal et Monaco, soit assurée.

Le Conseil procède à l'élection du membre portugais du Bureau de même qu'à celle des membres portugais des différentes commissions de l'EPI et il nomme un membre portugais au SACEPO. Pour plus de détails, se reporter à la liste des décisions du Conseil.

M. Votier remercie nos collègues danois pour la merveilleuse organisation de la réunion du Conseil.

A. J. M. Dries
Le Secrétariat Général
Liste des Décisions
32ème Réunion du Conseil à Copenhague
11-12 mai 1992

1. Le protocole de la dernière réunion du Conseil est approuvé avec quelques amendements d'ordre mineur.

2. Les Commissaires aux comptes approuvent la suppression du texte entre parenthèses, page 8, dernier paragraphe, du rapport des Commissaires aux comptes.


6. Pour les prochaines élections le Conseil approuve les dates limites proposées dans les documents de travail relatifs aux amendements des Règles pour les élections au Conseil, 171c, g, f, mais décide pour la Règle 2 de remplacer «le 1er octobre» par «à l'heure de fermeture de l'OEB à Munich, le dernier jour ouvrable du mois de septembre».

Le Conseil adopte les amendements suivants au Règlement Intérieur:
Règlement Intérieur, Article 2.4, page 29,
- ligne 6, après «Conseil», insérer «seulement»;
- ligne 9, après «question» ajouter «à la demande d'un membre du Conseil nouvellement élu appartenant au collègue ou au groupe intéressé ou par le Bureau nouvellement élu».

L'article 2.5 et les Règles pour les élections au Conseil doivent être révisions pour être en accord avec ces amendements.

Le Conseil décide également que la nomination de candidats ne doit pas être limitée à la nomination du candidat lui-même.


7. Le Conseil approuve la position prise par le Président de l'EPI dans une lettre à M. Braendli, informant ce dernier de l'opposition de l'EPI à accorder des dérogations à la condition de la nationalité allant au-delà de la pratique établie.

8. La Commission du Règlement Intérieur fera savoir au Conseil si des amendements à la Règle 102 sont souhaitables à l'égard des membres qui n'ont pas payé leur cotisation annuelle après avoir reçu un rappel par courrier recommandé.

9. Le Conseil approuve les amendements aux Règles relatives au paiement, telles que proposées dans les documents de travail 175/92 et 176/92 avec les modifications suivantes:
- dans la clause 6, supprimer la dernière phrase;
- dans la clause 7 supprimer la dernière phrase;
- supprimer la clause 9.

Le Conseil confie au Trésorier le soin de soumettre de nouveau au Conseil les points qui ont été supprimés, quand il le jugera nécessaire.

10. Au cours de sa prochaine réunion, la Commission de Qualification Professionnelle étudiera la question de savoir si chacun des documents de l'épreuve C devrait être rédigé dans deux des langues officielles de sorte que les candidats puissent utiliser la langue de leur choix.

11. L'EPPC préparera une lettre pour le Président de l'EPI, demandant à l'OMPI l'établissement de la réciprocité pour les mandataires européens désirant faire usage du PCT aux USA avec une recherche internationale et un examen préliminaire fait par le US PTO. Dans les questions de PCT les mandataires européens devraient être en mesure de représenter directement leurs clients devant le US PTO de la même manière que les conseils en brevets américains peuvent représenter leurs clients devant l'OEB.

12. En ce qui concerne le projet de l'UNION pour la création du «European Utility Models», l'EPPC restera vigilant et n'y participera que si l'UNION continue ses activités.

13. Le Conseil nomme M. D. David successeur de M. A. Catherine à l'EPPC, ce dernier ayant dû démissionner en raison de changements dans ses activités professionnelles.

14. Le Vice-Président, M. Holzer, assistera à la réunion de l'OMPI pour la préparation d'un plan d'arbitrage pour le règlement des litiges de propriété intellectuelle entre personnes privées.

15. Les réactions au sein de l'EPI à la suite de la première année du nouveau système de réajustements des taxes annuelles seront discutées à la
prochaine réunion de l’EPI afin que les propositions de réajustement des taxes pour l’année suivante puissent être communiquées à l’OEB en temps utile.


17. Le Conseil approuve d’augmenter le nombre des membres du Bureau de deux personnes afin que les nouveaux pays membres soient représentés.
M. Jorge Pereira da Cruz est élu membre du Bureau.


19. Le Conseil nomme les membres portugais suivants aux commissions de l’EPI:
- M. Antonio de Sampaio (Qualification Professionnelle)
- M. Joao Araujo-Oliveira (Discipline)
- M. José Luis Arnaud (EPPC)
- M. Jorge da Cruz (Conduite Professionnelle)

A. J. M. Dries
Le Secrétaire Général

President’s Report
32nd Council Meeting in Copenhagen
11-12 May 1992

As previously reported, an invitation to speak at a Symposium in Budapest on «Patent Protection and Market Economy: Czechoslovakia, Hungary and Poland» was passed to Vice-President Thouret-Lemaître, who attended and spoke at the meeting.

At the Administrative Council Meeting on December 10-12, 1991 I was represented by Heinz Bardelle and Walter Holzer.

Alain Gallochat and I attended the Diplomatic Conference in Munich on December 16-17, 1991 for the purpose of revising Article 63 EPC. Formal reports of that Conference have already appeared in print.

In November 1991 I received a letter from the President of the European Patent Office, referring to Article 134 EPC, and particularly to the nationality requirement imposed by Article 134 (2) (a) and the President’s right to vary the nationality requirement of Article 134 (6). The President of the European Patent Office had wondered whether the presently-adopted ten year rule was perhaps now outdated, and sought my views. I immediately replied that my view was that it is not appropriate at this time to contemplate changing the EPO’s policy on this topic, but I promised to consult the Board of the EPI on this subject. This has been done.

I represented the Institute at a SACEPO Meeting held in Munich on March 12-13, 1992.

I was able to arrange for the Institute to be represented at the Trilateral Users’ Meeting in Tokyo in February, and it was gratifying that that was possible. It is expensive to send representatives to these Trilateral Users’ Meeting, and we therefore must express our thanks to those Companies and Firms who are willing to underwrite the expense of our representatives’ travel and accommodation.

I was asked by the AIPPI to nominate an Institute Representative for the 35th AIPPI Congress in Tokyo. Since I had already registered to attend the Congress I took the liberty of nominating myself.

On March 12, 1992 I signed a contract with Carl Heymanns Verlag K.G., for the production and distribution of EPI Information. It is hoped that the format of the magazine, and the arrangements made for its production, will meet with approval.

The British Government is proposing rules for mixed disciplinary practices, and those rules purport to legislate in respect of mixed practices including European Patent Attorneys. The Institute was not originally consulted on the British Government’s proposals, but I was able to persuade the relevant officials that the Institute had a very substantial interest in the proposed legislation. The British Government has accordingly given the Institute an opportunity to comment on its proposed rules, and these rules have been discussed by the Institute Board and our comments sent to the British Government.

The Institute received an invitation from WIPO to send a representative to a discussion on March 27th 1992 on proposals for further amending the Patent Cooperation Treaty. I was pleased that Dr. Felix Jenny was able to represent the Institute at this meeting.

In conclusion, I would like to say that I have greatly enjoyed my first year as your President, but as you know I have had some difficulties. I should therefore like to pay a tribute to my Vice-Presidents, the Board of the Institute and, not least, the Secretariat, who have worked extremely hard to cover my deficiencies. I am grateful to all of them.

S. D. Votier
President
## EPI Balance Statement on 31st December 1991

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## EPI Expenses & Income 1991

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<th>Amended Budget 91</th>
<th>Actual 91</th>
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<td><strong>3. Secretary</strong></td>
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<td>3.1 Treasurer (+ Deputy)</td>
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<td>4,000</td>
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<td>52,000</td>
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<td>40,578</td>
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<td>4.4 Travel Personnel</td>
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<td>4.13 EPI Info</td>
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<td>4.19 By-Laws</td>
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<td><strong>TOTAL</strong></td>
<td>483,834</td>
<td>504,078</td>
<td>604,078</td>
<td>613,132</td>
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</table>
### Council Meeting

5. **Other**
   - Cancellation: 0
   - Doubtful Credits: 0
   - Members deleted: 0
   - Non-foreseeable: 1,621
   - Securities (Loss): 52,975

**TOTAL**: 54,790

**EXPENSES TOTAL**: 1,080,281

### INCOME

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<td>Securities (Gain)</td>
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**INCOME TOTAL**: 1,061,894

Excess of income over expense (18,387)

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Rules Governing Payment of the EPI Annual Membership Fee

Decision taken by the EPI Council at its Meeting in Copenhagen on 11/12 May 1992

1. The EPI annual membership fee has to be paid within two months after its due date.
2. The due date for members being on the list of professional representatives at the beginning of the year is 1 January.
3. The due date for members entering the list of professional representatives in the course of the year is the moment of entry on this list.
4. The annual membership fee is waived if:
   - a member's written demand for deletion from the list of professional representatives arrives at the European Patent Office prior to 1 April;
   - a person is registered on the list of professional representatives after 30 September.
5. In all other cases the entire annual membership fee has to be paid. No instalments, extensions of the term of payment, or reduction of payment may be granted.
6. Members on the list of professional representatives on 1 January who fail to pay their membership fee prior to 1 May (reception on EPI account) will have to pay a surcharge of DM 50.-. The same applies to members who entered the list during the course of the year if they have not paid the fee within four months after being notified of its amount through »EPI-Information« or by letter.
7. Payments have to be made by money transfers, in German Marks, and free of bank charges for EPI. They must indicate the name and registration number of each member for whom the fee is paid.
8. Due to the substantial bank charges and furthermore to the enormous additional administrative requirements no checks, bankers drafts, cash, or the like will be accepted.
9. The EPI Council decides on modifications of the amount of the annual membership fee before the beginning of a year. It informs all members through »EPI-Information« of the new amount of the fee and the conditions for payment. All members deemed to have received the respective »EPI-Information« will have to make provisions for payment within the above mentioned time-limit without further request. The Treasurer will, however, also send out fee invoices to all members at the beginning of the year or to new members after their registration. Late payers deemed to have received the before mentioned »EPI-Information« may not plead not having received this invoice.

Die deutsche und französische Fassung werden in »EPI-Information 3-1992« veröffentlicht.

Les versions allemande et française seront publiées dans »EPI-Information 3-1992«.
Meetings between EPI, IFIA and Unice Members and Members of the Boards of Appeal
Inaugural Meeting on 14th October 1991

by J. L. Beton

In his opening remarks Mr Gori welcomed the representatives of the interested circles, EPI, IFIA and UNICE, referring to the importance of the Boards established the jurisprudence of the EPO and their meetings with the judges to discuss problems of mutual concern and the harmonization of patent law in Europe. He now wished to have talks with the interested circles. He hoped that meetings between members of the Boards and the Sacepo would be fruitful for both sides.

EPI referred to its desire EPI to contribute to these important discussions, especially on the procedural items on the agenda. Its delegates would speak as individual patent attorneys. UNICE referred to its great interest in the patent system. There was in fact much cross membership between the EPI and UNICE groups and the UNICE group would also speak as individuals, representing the patent attorneys in industry. UNICE was well aware of the importance of the agenda items on procedure before the Boards but wished also to consider some items of substantive law, upon which however there was no concluded UNICE view. The following items were discussed:

1. Communications by the Rapporteur in inter partes proceedings

The members of the Boards were of the opinion that usually they send communications when appropriate, but they will not be sent if the file is complete. Also the Boards feel they must be impartial and are reluctant to send out a Communication if it merely helps one of the parties. The reason for a Communication is Article 113(1) - the need to avoid surprise. Also sometimes a point is obscure or amendment is required.

2. Late submissions in inter partes proceedings

The Boards were asked to follow the requests made in EPI's 1989 submission to the EPO. These had been accepted by DG2. The Boards said they would usually do so. The relevancy principle is usually applied, especially if a written document forming the state of the art is submitted. Prima facie the late submission must be capable of changing the Board's position if it is to be admitted. If a wholly new matter is raised the Board likes to remit it to the Opposition Division, recognizing however that there are not really two instances, since a very fact that the matter was remitted demonstrates its pertinence.

It is really up to the patentee to decide whether to ask for an adjournment or to deal with a new issue there and then. A late submission requires arguments to be based on it so that its pertinence can be judged. Sometimes this is indeed best judged by the first instance. There should be a punishment for making late submissions, especially if they cause an adjournment or remission to the Opposition Division. This could be in the form of costs, but it is necessary to be realistic, since this sanction will not always be effective. From the EPI side it was requested that the patentee should always be given a fair opportunity to deal with new submissions at a hearing. The following points of detail were made:

Printed references should always be considered for relevancy if part of the state of the art. They are to be distinguished for this purpose from late submitted grounds or evidence. Late filed opinions are a special problem. The question of whether the Board has the power to go beyond the extent to which a patent has been opposed has been referred to the Enlarged Board of Appeal. Perhaps there should be no new grounds! Should an Appeal be a retrial or only a review of the decision below? The later submitter should give good reasons for lateness and only a few minutes should be spent on relevance. Costs of reconvening should be borne by the party who caused the adjournment unless there are good reasons.

One EPI member wanted quick decisions with no referrals, but others were worried that late submissions to show lack of novelty are unfair to the patentee if he is not given adequate time and opportunity to deal with them, especially where the patentee or his representative is in another Continent. The patentee must be given a fair opportunity to defend his patent.

3. Inter partes proceedings - Claims

EPI submitted that the patentee should be allowed latitude, even during oral proceedings, to claim as much as possible of the invention as he deserves. It was pointed out that no Board will refuse to consider a plainly allowable claim but if a Communication suggest the need for new claims, it also depends on the degree of surprise for the other party. If the Communication pointed out the need of amendments and these were not put in until the hearing the amendments may be refused. It was argued that there is a risk for the patentee that he may put in an auxiliary set of claims too early with the result that the Board rejects the main request. It was denied that this would be happen. In the EPI view it is important to put in all necessary auxiliary and subsidiary request before the hearing. Sometimes a Board will hint at the presence of patentable subject matter. At other time it will indicate that it
sees no reason to alter the decision below. Both are signals to submit auxiliary or subsidiary requests.

4. *Inter partes proceedings - the right to be heard*

This concerned a request for the last word for the patentee in the written proceedings. It was pointed out that this cuts both ways, since if the patentee loses below and has to appeal, on the basis of the suggestion the opponent would have the last word. Nevertheless in oral proceedings the patentee usually does have the last word. The procedure usually works quite well on the present basis. The importance of requesting oral proceedings was stressed. In a very high proportion of cases the Board's preliminary leads to a firm view on the case and in about a quarter of the cases this view is changed at the hearing.

5. *Inter partes proceedings - the right to speak*

A problem arises with the technical expert who is not an employee of the party (who can be authorized if the party is European). It was pointed out that many Boards deal with this informally. The expert is considered to be speaking on behalf of the attorney. It is useful to have experts present to clarify difficult technical points. As there is free evaluation of the evidence, the Board can disagree if necessary. If one party brings in an expert and the Board can then decide which evidence to accept. This distinction should be noted between witnesses of fact and evidence that is pure allegation, whether by the expert or the attorney. Witnesses should be warned that they may have to repeat what they say under oath before a national court.

6. *Width of Claim*

The subject has been raised in the Administrative Council. In general, there is no disagreement with the jurisprudence but examiners should avoid the extreme situation of granting a patent where the applicant's claim is a mere paraphrase of the problem. This is contrary to UK and German Law. The claim should not go beyond the effect, when this is an essential feature of the inventive step. If a claim covers Inoperative species the invention has not been defined. There was a complaint that arguments which appear to be based on Article 84 but could be under Article 83 are too often dismissed as being on Article 84. It was requested that in opposition proceedings, such arguments be given more weight. There was an objection to open-ended claims where there is no upper limit. However there was some dissent from these views, especially when a pioneer invention is involved, but the principle that the scope of the claims should correspond to the nature of the invention disclosed was endorsed.

It was pointed out that the use of functional definitions is often the best way to define an invention adequately and their use together with other characteristics in the claims should be accepted if they provide a sufficient basis for the public recognize the scope of the claims and to find out without undue experimentation whether or not specific embodiments are embraced within the protection of the patent. Thus the claims must be clear and unambiguous. If functionality is wishful thinking it should not be allowed but if a functional expression is used a normal element of definition there should be no objection. One should differentiate between Article 83 and 84.

It was also pointed out that support for the claims is more than formal support, and sometimes real support comes into question, ie whether the description supports the width claimed. It is easy to see, sometimes, that a very wide claim is structurally unobvious, but that it really goes beyond the inventive step. This is a serious problem. There are may ways to attack an unduly broad claim. There is Article 83 where an attempt to repeat the examples fails and there is Article 56, where on varying the conditions the effect relied on is not obtained.

The consensus appeared to be that the law is satisfactory, and examiners should be careful about extreme situations where the applicant merely paraphrases the problem in his main claims. But all problems in this area cannot be solved - certainly not by formalistic approaches, such as by counting examples and species covered by the claims.

7. *Inventive Step*

Difficult questions sometimes arise for the industrial attorney with respect to patent clearances. In many jurisdictions subject matter is obvious because it is in the public domain, referring to some US and UK decisions, and also some EPO decisions where mere bonus effects have been ignored in the judgement of inventive step. Industry is expected to respect the patents of other and the industrial attorney often has to given opinions to business colleagues that such and such a patent is not infringed by what is proposed to be done or made. It was asked whether industry can rely on the one-way-street doctrine of the EPO and whether it ca. rely on combining the state of the art with common general knowledge.

It was pointed out from the EPO side that the granting and opposition procedures the notion of "prima facie obviousness" is disliked. Inventive step must be considered on the basis of the real problem and the effect must be
taken into consideration. The effect normally governs problem and solution analysis and the idea of a bonus effect detracts from it by making room for public domain obviousness on the basis that it is improper to take away from the skilled person that which is already obvious to him. There were serious objections to this approach. In response it was argued that the idea of public domain obviousness is not a new defence but it is a consequence of selection of the objective problem in the assessment of inventive step from the closest art. It can affect the allowable scope of the claims. There was some disapproval, from the attorney side of the use of problem and solution analysis for the determination of inventive step in all cases. It was asserted from the EPO side that this analysis always works and a challenge, made to the profession some years earlier, was repeated. The Boards would be glad to know of a case where this method of analysis has led to an obviously wrong result. Other approaches (e.g., combinability) have the disadvantage of making it difficult to protect an area close to the prior art.

8. Availability of Board of Appeal Decisions

The EPO intends to make available the full text of all decisions on CD-ROM. But there is a problem for attorney in finding the relevant decisions. The Board were asked to make headnotes, or at least to make keywords available; however they are reluctant to write headnotes at the time of making the decision. It was pointed out that it might be possible to write keywords in English and possible also to mention the relevant articles and rules.

The second meeting with Board of Appeal members will be on Monday, 9th November 1992.

Notes on EPPC Meeting 21 January 1992

Report of Liaison Committee Meeting

J. L. Beton, Rapporteur

The Search Division until mid 1990 had been refusing to carry out searches in cases of second medical indication where there was no pharmacological data to establish the indication. The policy has changed since mid 1990 and searches of second indication cases will always be made.

International applications - there is a difficulty in knowing when the search report is to be published so that an examination request can be made. In future when an A3 publication is generated a special form 1202 is now sent to

the international representative. The EPO representative, if different, is not regarded as valid by the EPO during the international phase.

Coloured drawings are not likely to be adopted. The Administrative Council dislikes this possibility and has said that if such drawings are to be accepted, they must be published coloured. This is not possible now and will not be possible in the planned electronic files.

Vague and unclear titles are not in accordance with the Rules and are rectified by the Search Division, but amended titles are not sent to the applicant. A title should at least be so clear that it corresponds to a subclass. It is not possible to change the title of a Euro-PCT application.

Premature rejections arise where the examiner thinks there was no bona fide answer, i.e., he cannot see a reasonable argument or amendment. The application is then refused. This is especially the case with applications from USA having many independent claims directed to the same matter. EPCC said that the Examining Division should build confidence with applicants so that they do not feel it is necessary to ask routinely for a hearing. Whether a reply is «bona fide» was intended to be an internal criterion but should never be an argument for rejecting a patent application. EPO ask to be informed if the Guidelines on early rejections are not followed.

It can take a long time before a Euro-PCT application is entered into the register and also before the EP file number is sent to the applicant. The delay is because of the fees but the time to enter the Bulletin should be 7-8 weeks. It has been as long as 7 months. The EPO will try to improve their practice. The EP application number should be sent to the European representative, but the EPO often only has the name of the applicant. Hence the representative should be appointed as soon as possible. When making a request to the EPO, cf. for information, one can use the EP number or the PCT number.

Studies are continuing on the possibility of an information system based on the register, extended to contain data beyond that printed in the Bulletin (which will require an amendment to Rule 92). The computer technology is possible. However, studies are needed on the data and how to make it available. These studies are in progress.

Tests are being made on an automatic debiting system. If all goes well the necessary rules will be published in Autumn 1992 and implemented in January 1993.

The Spanish patent office had been insisting that a translation of a European patent would not be published if the patentee did not delete product claims. Following EPO objections they will now be published with a note
that such claims do not give any protection. Applicants are nevertheless advised to file separate claims for Spain in their own interest.

Appointment of EPI Representative to the CPC Interim Committee

It was decided to appoint Dr F. A. Jenny. There will be an Intergovernmental Conference in May to determine the conditions for bringing CPC into force by December 1992. Both France and Germany have ratified the CPC.

Fee reductions for small entities

This subject is not accepted by the Administrative Council as belonging to the EPC - it is a national problem. It does not wish to discuss it again. The USA is going cold on the subject. There was no clear wish by EPPC to make further requests to the EPO and the Administrative Council. EPO fees will increase by 3% in October. There is no wish to alter the distribution of fees in favour of keeping down the fees on filing.

Amendment of Rule 29

The proposal was made that this rule should be amended to restrict freedom to use non-limiting phrases in claims since they are said to cause ambiguity. Many were against limiting drafting freedom in this way. It was agreed to await a Board of Appeals decision on this subject.

Interpretation of Article 55

Some years ago it was the general view in Sacepo and other quarters, in view of the discussions at the 1973 Diplomatic Conference, that the 6 months period in Article 55 runs from the date of filing and not the priority date. Since then opinion has swung in favour of the latter. An Opposition Division has so decided. It was decided to ask the EPO to publish this decision (Opposition against European patent number 85744).

Sacepo

The next meeting is on March 12-13. The agenda will include fee increases, a report of the meeting with DG3, Dr. Leberl’s report on EPO practice in the field of chemistry, amendments to the rules eg PCT protest fees where there is alleged unity and the compulsory introduction of DNA sequences, statistics on the use of the Rule 28 expert solution and a report on the status of the Community patent. Other items to discuss are prior use and compulsory licences, letters lost in the EPO, and patent law harmonization update. There is also referral G1/91 on whether the Opposition Division should consider lack of unity ex post.

Meeting with EPO and WIPO (Mr Kolle and Mr Bartels)

There was a discussion of the work done by the EPO under the PCT for non-European applicants (ie for US and JP applicants choosing the EPO as International Search Authority [ISA] or as International Preliminary Examination Authority [IPEA]). From the side of the EPPC it was stated that what was being done is unfair to European applicants who have to accept a lower position in the order of precedence while there are EPO backlogs, and that the European profession is cut out contrary to the principle of Article 133, EPC. There will be difficulties if preliminary examination work is done by American and Japanese attorneys working from their countries. This work should be done by those who understand the European system. The remedy is to reintroduce limitations in the number of applications that can be handled by the EPO. Also advice should be given by the EPO to always have an EPA alongside when such work is done. There should be reciprocity for European applicants and appropriate reductions of fees.

Mr Bartels said that it is a misunderstanding that work is increased for the EPO. They have to search and examine all cases directly under the EPC or acting as a regional office. The former 500 case limit was for IPEA work and not for searches. There is a general shifting of work towards the Euro-PCT route.

Mr Kolle referred to the disadvantages for the European profession and to the various submissions by the EPI. Despite these disadvantages, after intense discussions EPO has decided that on the basis of the 1978 Agreements it has a universal competence and wishes to play a central role under the PCT. In 1984 it was concluded that it was unwise to have a separate competence for examination depending on where the search was done, limited to EPO searched cases. When in 1987 USA joined Chapter II of the PCT the USPTO asked the EPO to do IPEA work. EPO agreed, subject to a 500 case limit for three years; but on expiry of that agreement it decided not to prolong the limitation. In the Administrative Council some delegates supported the EPO and others were silent. In general the workload should be the same whatever the EPO does. The search backlog will be cleared by 1992 subject to a 10% margin whether the applications are direct or via the PCT and so there will be no preferential features for PCT cases for searching. For examination the situation will get worse and there will be increased volume of work, but the fact that some cases use the PCT does not lengthen the prose-
the US national entry takes the form of a continuation or continuation-in-part of an existing US application it goes into the national route and is not on a PCT basis.

**TITLES AND PCT GAZETTE**

The PCT Gazette will have to be changed as it becomes too large. A CD Rom system is needed. The titles will have to be more informative and will have to be approved by the examiner and changed if necessary, whereas in the EPC system the search examiner has not by then always done his search (ie in cases published without the search report). If the examiner improves the title he will not ask for the approval of the applicant.

**MISCELLANEOUS (PCT)**

1. The priority document does not need to be filed on national entry - in particular not in Romania, or in USA if via section 371.
2. It is now possible to obtain a copy of the publication pamphlet on request from WIPO.
3. From 1st July 1992 it will be possible to obtain a certified copy of the priority document from WIPO (or from the receiving office) after publication of the PCT application.
4. Form 1200 will be sent to the European representative if known to the EPO. If not, it will be sent to the applicant. To notify the EPO the PCT number or the EPA number may be used.

**AMENDED RULES (PCT, coming into force on July 1st, 1992)**

1. These should be regarded as improved software where it is still valid to use the old rules. They enter into force on 1st July.
2. Liberalisation of access to the PCT in cases where there are two or more applicants will permit filing a PCT application even where only one of the applicants is a resident or national of a PCT contracting state, even where he is the only applicant for one country.
3. It was necessary for the applicant in a Chapter II case to be from the IPEA country where the demand is made. In future it will be sufficient if one of the applicants is from a Chapter II country and the demand is filed in any other Chapter II country (or the EPA).
4. The rules for forms (the Request and the Demand) will allow these to be computer generated.
5. The applicant’s file number can be indicated on all sheets.
6. The unity of invention rule will be the same as the EPC rule 30.
7. There will be a streamlined procedure for international preliminary examination. Only searched applications will be examined. To accelerate the start of the examination there will be a clear system in which the applicant is to indicate what is to be considered first. But where there are amendments under Article 19 or Article 34 this need not be stated.

8. There are safeguards if there are amendments, eg in cases of missing translations. At present an office can ask for either or both, eg original or amended claims and void the application if something is missing. In future if one complete application is translated the applicant is safe and he can only be requested to supply whatever is missing.

9. It will be possible to authorize a representative without immediately filing an express authorization.

10. There will be a single rule which lists all the possibilities for withdrawal of the application. Withdrawal of the priority claim can be made at any time up to the time of national entry, instead of the present 17½ months. If prior to the 30 month point you do not know whether to effect national entry it will be possible to withdraw priority, in effect to buy another year. All time limits that have not yet expired will be extended, but not any time limit that has already been passed.

11. Standards for amino acid and nucleotide sequences in machine readable form will be established. If presented in that form in the international phase the ISA and the IPEA cannot apply any different standards. Once national processing has commenced and it is necessary to supply a sequence list, if this does not comply with new Rule 13(ter) there are provisions for later supply.

Notes on EPPC Meeting 5th March 1992

by J. L. Beton, Rapporteur

Most items were in preparation for a Sacepo meeting on 11-12 March 1992.

1. Proposed changes in EPO fees. The EPO proposes to make a substantial increase in fees in the second part of the procedure, from request for examination onwards and to increase the PCT fees (Alternative A). In an alternative scheme it is proposed to delay the payment of the designation fees until examination is requested (Alternative B). Under this latter alternative a shortfall of DEM 112 million would have to be covered. Under Alternative A the shortfall is DEM 60 million. The EPPC agreed to the first alternative provided the examination fee is not increased quite so much (Re. to DEM 2902, not 3100) but the PCT fees should be at cost (ie international search at DEM 3000 and preliminary examination at DEM 5000). To make radical changes to the fee structure at a time when the EPO's finances are not buoyant seems wrong, even if otherwise it is a good idea, eg to make the direct European route more attractive compared with the PCT.

2. The proposed protest fee for PCT cases where there has been an allegation of non-uniformity, according to the EPPC should be at half the usual fee level, since less work is involved. This means a fee of DEM 1000 if the appeal fee is increased to DEM 2000 as has been proposed.

3. The cost of providing DNA sequence listings on paper as contrasted to supplying them on tape, diskette or the like was deplored. The cost of printing and of duplication in the EPO, JPO, and USPTO, not to mention the PCT is too great even though the same standard will be used. However, the EPO has said that it is only necessary to list sequences that are called for by the claims. State of the art sequences and illustrative unclaimed sequences need not be given. The data bases resulting from collections of sequences by the main patent office will be made available.

4. Leberl Report into EPO Chemical Practice. This produced a negative reaction from the EPPC on the subject of broad claims. The report appears to have been drawn up in the spirit of reducing work by the EPO rather than of protecting the inventor's substantive rights. Suggestions on ways of avoiding broad claims are contrary to the patent system. In particular the report proposes new Guidelines including the following: strict application of the problem and solution approach; that claims must be clear (vague terms such as alkyl and low not to be used); there must be support in the description (eg number of examples); assessment of unity (presumably to be more strict); how to search (how widely - only the examples or also the vicinity); and how to examine, especially after a partial search.

The Leberl Report was unanimously disapproved. It was noted that some voices are asking for article 84 to be made available in oppositions - but the EPPC is of the opinion that the correct position is that discussed with Members of the EPO boards of Appeal at the first meeting with the interested Circles on 14th October 1992: ie, a broad claim must not just claim the problem and the solution must not be broader than that justified by problem and solution analysis (usually this is a question of the credibility that the problem is solved by claimed solution). If a claim is too broad the grounds for attacking it should be on the basis of Articles 56 and 83.

Regarding novelty, the confusion between photographic novelty (T167/84, Nissan) and preventing the same invention being patented again (T198/84
Hoechst, T124/87 Du Pont and T12/90 Bayer) was noted. The general view of the EPPC is that while selection inventions must not be prejudiced, a conflicting junior application should at least show a technical difference compared with the senior application.

Regarding inventive step, most EPPC members agreed with Leberl. There was some objection to universal application of problem and solution analysis (PSA). Examples will be studied of the French approach, which analyses structure, function and results, gives a better analysis. In particular the objective selection of the relevant problem is often artificial and can give the wrong result when the invention represents a different functional way, in his opinion.

5. Meeting with DG3 in November 1992. Suggested questions which could be submitted to the Members of the Boards of Appeal are:
(a) Novelty in conflicting applications - in particular the effect of technical identity or difference where claims overlap.
(b) Prior use cases (T405/86 and T93/89).
(c) Inventive step - comparison between PSA and French law.
(d) Broad claims - discussion of the Leberl Report.

6. Expert solution. Apparently the EPO's opinion that the expert solution is little used is wrong. It is used considerably by European applicants (apparently to the extent of 80%). It is true that there are few requests for samples involving the expert, but this is not surprising as the requester does not get the pocket factory and if that is what he wants he has only to wait until the corresponding US patent has been issued, when the samples become available without restrictions.

There are implementation problems with the expert solution. Only one expert has been added since 1980 and in some areas of technology there are no experts. A majority of the EPPC support the EPO's Model A in which the availability of a microorganism is by the expert for 20 years, even if the application has been withdrawn or refused. A minority prefer Model B in which the sample is withdrawn if the application is withdrawn and refused. It is known that the majority of the Administrative Council support Model A.

7. Community Patent Convention. The Intergovernmental Conference called by the Portuguese Presidency will be held in early May. It is believed that Spain will not agree commencement with less than all 12 Member States.

8. Super-PCT. EPPC was against Dr. Bogsch's suggestion. The PCT is already too complicated and the suggestion to have a super-PCT in which searches are carried out in the three main patent offices and likewise preliminary examinations will only add to the complexity. The suggestions should be considered again when patent law harmonization has become effective. At present preliminary examination in all three offices is impracticable, the state of the art is different, the standards for inventive step are different and the time available is too short. An extended search in all three offices might find some customers if it is coupled with national and regional entry at 30 or 31 month in place of the international preliminary examination!

9. EPPC objects to the new USPTO disclosure rules as being too burdensome. This should be taken up at Sacepo to ask EPO to complain to the USPTO.

10. The majority of the EPPC is opposed to a European utility model.

11. The proposal to extend the 10 day benefit of Rule 78 to unrepresented applicants outside the EPC countries, e.g. international applicants making a regional entry was disapproved.

12. It was noted that receipts for the PCT demand are sent by the EPO to the applicants very late, e.g. after two month or more. This is a similar problem to the former receipt problem with direct European applications. It was suggested that the applicants should enclose a self prepared receipt, e.g. using form 1037.

13. The work being done by the sub-committee on Community patent compulsory licences was noted. Unice had made some comments on a draft prepared by the sub-committee and these will be considered.

Disciplinary Committee
Annual Report 1991

George F. van der Beek, Chairman

In 1991 six complaints were received.

In the single complaint of 1990 a decision was taken to issue a reprimand with authorization of the President of the Council of the Institute to have the decision published without disclosing the identity of the parties.

In none of the complaints received in 1991 the procedure was finished at the end of the year.
Disciplinary Board of the EPO

Appointment of members of the Disciplinary Board of the European Patent Office

1. Under Article 9 of the Regulation on discipline for professional representatives (OJ EPO 1978, 91 et seq.), the President of the European Patent Office has appointed the following four members of the Institute of Professional Representatives as members of the Disciplinary Board for a term of three years with effect from 1 May 1 1992:

Messrs R. Harlé, L. W. Kooy and J. U. Neukom (reappointed), and Mr M. Ruff (succeeding Mr D. Behrens).

2. The Disciplinary Board thus comprises five legally qualified members of the European Patent Office, namely Messrs B. I. Cawthra (Chairman), H. Niveau de Villedary, R. Cramer, C. Matthies and Ms T. Karamanli, and four members of the Institute of Professional Representatives, Messrs R. Harlé, L. W. Kooy, J. U. Neukom and M. Ruff.

Nomination de membres du Conseil de discipline de l'Office européen des brevets

1. En vertu de l'article 9 du règlement en matière de discipline des mandataires agréés (JO OEB 1978, 91 s.) le Président de l'Office européen des brevets a nommé pour une période de trois ans à compter du 1er mai 1992 les quatre membres suivants de l'Institut des mandataires agréés comme membres du Conseil de discipline:

MM. R. Harlé, L. W. Kooy et J. U. Neukom, dont le mandat est renouvelé ainsi que M. M. Ruff, qui succède à M. D. Behrens.


Ernennung von Mitgliedern des Disziplinarausschusses des Europäischen Patentamts


The European Qualifying Examination

by R. C. Petersen

As new countries join, and others consider joining, the European Patent Convention, patent attorneys in these countries may wish to know more about the qualifications of European patent attorneys. The purpose of this article is to review, in particular, the European Qualifying Examination which is an essential part of the qualifying process.

In the second preliminary draft of the European Patent Convention adopted in April 1971, there appears in Article 153 a requirement that representation be undertaken only by those on an EPO List. National patent attorneys were to be able to be entered on that List if qualified nationally or after five years experience in countries not having any qualification. The extent of representation was to be limited to that granted nationally and legal practitioners were to be allowed to act, though not to be entered on the List. Article 154 demanded compulsory representation for those applicants or opponents not in an EPC country. There was no reference to any examination or any way of getting on the EPO List without national qualification or experience.

During June 1971, FICPI held a Congress in Stockholm, where Dr. Haertel sounded out those present and concluded that some general principles were agreed. One was that existing rights of national patent attorneys were to be preserved in relation to the EPO as to the national patent office; another that future entry on the EPO List should be by training and examination; and a third that the examination should be European and not national. As a result, Article 134(7) of the preparatory documents published in 1972 for the Munich Conference in 1973, refers to the adoption by the Administrative Council of provisions governing the qualification and training required of a person for admission to the European qualifying examination and the conduct of
that examination. This was adopted with minor editorial amendments as Article 134(8)(a) of the European Patent Convention signed on 5 October 1973. The existing rights of national patent attorneys were covered in Article 153(1) to (5), and provision was made in Article 163(6) for patent attorneys of those countries joining later.

The drafting of the necessary provisions was then the responsibility of the official Working Party VI which called for the assistance of the »interested circles«. There was at that time a Committee of Nine considering the question of representation, three from UNION, three from FICPI and three from CNIPA. All came from different countries, two CNIPA members were from industry and the remaining members from the free profession. That committee became the Group of Four when three FEMIPI members from industry joined it. Much discussion ensued, but, after compromises, references back and official hearings, a consensus was reached which enabled the Administrative Council to adopt three Regulations on 21 October 1977, which established a compulsory Institute (EPI) for European patent attorneys, provided for disciplinary powers over them, and set up an examination system. The latter is to be found in its present amended form in the Official Journal of the European Patent Office (OJ EPO) 1/2 1991, on pages 79 to 87, and in its original in OJEPO 2/1978 on pages 101 to 108. In that early issue were also the names of 3,356 professional representatives entered on the List by 17 January 1978 under the transitional provisions, so that there were enough European patent attorneys to handle the initial flow of applications.

In December 1978, an Examination Board was set up under the Regulation and organized the first examination in November 1979. Experience led to a brief delay until the second was held in April 1931, but since then one has been held every year in April. At one time, it was thought that there might be very few candidates (18 in 1981), and a provision was added that if less than 20 were admitted, the examination could be deferred until the following year. This provision has never been implemented and the number of candidates has steadily increased until nearly 300 were admitted to the 1391 examination.

The Examination Board is required to have nine members of whom four are to be EPI members and five, including the Chairman, EPO members. Originally the »interested circles« had sought an examination wholly controlled by professional representative following the example of the United Kingdom. However, the officials in Working Party VI were unwilling to accept this as it would have meant a radical change for most countries, and the joint body was adopted. In view of this, the EPO is required to provide the Board with the administrative facilities needed to enable it to carry out its tasks. Thus, the EPO pays for the examination and receives the fees of the candidates. The advantage for the EPO is that there is a category of persons who can be relied upon to represent applicants and other parties competently before the EPO, as has been confirmed in several decisions of the Boards of Appeal. The first Chairman was M. Jacques Delorme, Vice-President in charge of the Search Directorate in the Hague. His successor was Mr. Norman Wallace, Vice-President in charge of the Examination Directorate in Munich. When the latter was about to retire, the Regulation was amended to place retired EPO members in the same position as EPO members, which eased the burden of finding members of the Board and of Examination Committees from Directorates with heavy backlogs. From the Appeals Directorate, no EPO members could be appointed to Examination Committees, but retired members may now be appointed to the benefit of the system.

The Examination Committees, of which there are three, prepare the examination questions and subsequently mark and assess the answers given by the individual candidates. They also prepare reports upon the answers expected and received, for the assistance of those training candidates. At first, the numbers of EPO and EPI members were to be equal, or substantially so, but after some time it became clear that large committees were needed to deal with the increasing numbers of candidates. Accordingly, the requirement was changed to a proportion of EPO members between ¾ and ½ of the total numbers. By chance, this proportion was that originally recommended by the »interested circles« during the earlier discussions. A maximum of three Board members may be on Examination Committees, and the practice is for the Committee to be chaired by three of the four EPI Board members. They are thereby debarred from taking part in the Board decision whether a candidate has passed or failed. Such decisions, whilst automatic for those who passed or failed all papers, became difficult when only two or three papers were passed. In borderline cases reported by the Examination Committees with recommendations, decisions were taken only after Board examination of the answers. As candidates had to pass all four papers, it was not possible for a Committee to know when a case was borderline, which term was undefined. After some difficulty in several appeal cases, the Regulation has been amended so that the Committees propose grades for the candidates and the Board decides to pass those passing all papers and those who pass at least two papers and obtain minimum grades as set out by the Board in advance. The grades are from 1 (Excellent) to 7 (Fail) with the pass set at 4. The grades are based upon independent marking of answers by two examiners and confirma-
tion by the whole Committee. A system of partial passes, introduced in 1990, allows the Board to permit a candidate to resist only the papers failed, once during the next two years.

Candidates enrolling for the examination must have educational and training qualifications. Whilst the possession of a university degree was sought as indicating an acceptable level of scientific or technical knowledge, a compromise was reached referring to university level qualification and allowing the Board to accept other proofs of educational attainment. This has resulted in a List A of educational establishments and qualifications satisfying the requirements, and a List C of those calling for three years of activity pertaining to patent matters in addition to the years of training required. The original training period was four years, a compromise between the three years usual for several countries and the five years called for in countries without examination. For the 1992 and subsequent examinations, only three years will be needed. Training must be full-time either under a European patent attorney or working as an employee representative of an applicant employer or as an assistant under the direct supervision of such an employee. It has been held that a national patent attorney working on his own account cannot be considered as undergoing full-time training under the supervision of another attorney. Although the training requirements refer to activities pertaining to European patent applications and patents, a realistic attitude is adopted in the provision that account shall be taken of activities in national proceedings. Reductions of the three year period are possible for EPO examiners of four years standing and for those taking specialised courses successfully.

There are four papers in the examination, three of which are specifically called for by the Regulation, namely, A (drafting), B (amendment) and C (opposition). Paper A calls for the drafting of claims and introduction for a European application, whilst Paper B calls for a response to an official action. In both papers, there is a choice between chemical and non-chemical specialities. Paper C requires the preparation of an opposition to a European patent, including a statement of grounds. The fourth Paper D is one to test knowledge of patent law, particularly EPC, PCT and Paris Convention, and also some matters of national patent law. The questions are written in all three official languages, except that prior art in Paper C includes three documents, each in only a single different official language. Answers may be given in any official language or in the national language of a candidate. The examination is held simultaneously in several centres, EPO locations in Munich, the Hague and, if necessary, Berlin, and, if called for, London, Paris, Rome, Berne, Stockholm, and other national centres where five candidates choose.

Detailed provisions and instructions appear from time to time in the OJEPO and are available from the Secretariat of the Board in pamphlet form. It will be appreciated that, with the number of candidates presenting answers, the operation of marking and reconciling the marks takes time and the grade list is usually only available to the Board in time for a meeting in October. Candidates are then advised of their results and a pass list appears in the November issue of OJEPO. Anonymity is retained for those who fail or are only partially successful. Successful candidates are invited to have their names entered on the EPO List, and if they do so, become members of the EPI which calls for a subscription.

The examination is a severe test of a candidate’s abilities and the pass rate has been in the region of 50%. However, candidates may take the examination as many times as are needed to satisfy the examiners, and the cumulative rate of pass has gradually improved to about 75%. Preparation is essential and several training courses are available. There is a joint EPI/CEIPI scheme for basic training in European patent law, which is held in many cities across Europe and takes two years in the form of private study supervised by local tutors. On completion of this course, candidates can take special courses directed more closely at the Examination, for example, EPI runs a scattered tutorial system. CEIPI has a seminar in Strasbourg, Queen Mary & Westfield College has a three day programme in London, and the Swiss profession has a four day course. The EPO also offers training within EPO at Munich to those who have passed the EPI/CEIPI course or an equivalent, especially those whose mother tongue is not one of the official languages. The opportunities are there, but commitment is needed by both candidate and employer.

The Examination is to enable the Board to be satisfied that a candidate is fit to practise as a professional representative before the EPO, and thus to bring forward succeeding generations of competent European patent attorneys. New entrants to the profession will probably find it commercially necessary to be European patent attorneys as well as having a national qualification. As the latter often involves examination in patents, trade marks and designs, the increased burden on candidates is leading to consideration of the extent to which the results of examination in Europe should be accepted in EPC countries generally. Much work remains to be done, but a start has been made by the EPO.
Arguments for the Introduction of an European Utility Model

by K.-H. Meyer-Dulheuer (DE)

A. The Necessity of a Harmonization of the Protection by Utility Models in Europe

In a considerable number of Contracting States of the EPC the utility model is used in addition to the patent as a national legal instrument for the protection of technical innovations. International developments indicate a clear tendency to provide to the inventors a simpler system for the protection for smaller inventions which supplements the patent system. An extensive evaluation of the AIPPI in the economic and legal significance of the utility model protection (Question 83) has revealed, that more and more countries which up to now have had no utility model protection realize its obvious advantages for the support of small or short-living inventions. This applies equally to developing countries as well as to industrialized countries. The tendency to introduce utility model protection increases. The most recent examples for newly created utility model laws are found in Finland and Denmark - unfortunately with remarkable differences in their legal substance.

In view of the growing international attraction of utility models it is amazing that so far they have found not much attention in the efforts of harmonization of industrial property rights. Unjustly, the utility model is labeled as an industrial property right which fits only for small inventions of small enterprises which have commercial interest only within their national boundaries and do not need equal protection elsewhere.

In reality, companies of all economic sizes are presently found among the applicants of utility models. Utility model applications are directed to innovations of all degrees of technical difficulty. More than ever, the utility model is specifically employed to get an additional easily obtainable and immediately effective protection for inventions for which a patent has also been applied for.

Even in cases where the utility model is not used as an additional instrument to safeguard a patentable invention but is directed to an otherwise not protectable invention it satisfies a strong legal demand which is not restricted to the home country of the inventor. Moreover, the international efforts against product piracy have shown how difficult it is to protect the home market against imports of infringing products if there are no means available to prevent the first import in one of the states of the European Community.

It also should be kept in mind that the harmonization of the patent laws may lose much of its effect if side by side a patent and a national utility model coexist and the latter is not subject to the rules of a harmonized international law but is formed by each state individually at its own discretion. In the Common Market such development is bound to result in considerable disturbances which impair the free merchandise traffic.

All arguments which are valid for a harmonization of the patent law within the Common Market are equally valid for a harmonization of the utility model law. The idea is not convincing that on the one hand in the Common Market the patent has to be a supranational uniform right, the supplementing protection by a utility model on the other hand may be left to the national legislator.

The so far omitted harmonization of the national utility model laws has had the effect that the protection which is obtainable by utility models varies considerably from country to country with respect to the protectable subjects, the prerequisites of protection and the terms of protection which even by an expert can hardly be kept track of. Whereas, in some countries, the utility model protection corresponds in substance to the patent protection but is shorter in time, in other countries the subjects differ which may be protected by utility models from those capable of being protected by patents, whether a lower degree of inventiveness is sufficient for utility models as compared to patents or the subject of the protection is limited to utility articles and labour equipment.

In addition, in several Contracting States of the EPC a utility model is not even obtainable due to the complete lack of a necessary law. For instance, neither in the Benelux-countries nor in Great Britain, Austria, Switzerland, Liechtenstein, Portugal or Sweden the legislator has so far provided a legal basis for the grant of utility models. If one would wait until the national legislator in said countries would create utility model laws, this would exclude the introduction of the utility model protection in all-Europe for non-predicable periods of time. Moreover, the final result of this development would be a utility model protection in Europe which would be still more diversified and more difficult to survey than presently.

B. The Relief of the EPO by European Utility Models

The foregoing arguments should justify an initiative for the creation of a European Utility Model. They are underlined by further developments and findings.
1. As presently on a uniform basis technical inventions may be protected in the Western European Countries only by the filing of patent applications it is necessary to proceed in this manner even in cases when it is doubtful whether the significance of an invention justifies such expenditure and effort and whether the invention may satisfy the stringent criterions of patentability as required by the EPC. If the applicant under such circumstances does not completely abandon the idea to seek protection for his invention he has no choice but to assume the high costs of an European patent grant procedure and at the same time to contribute to the flooding of the EPO with more and more patent applications which to cope with becomes harder and harder. The explanation for the high number of European patent applications is not only found in the high standards of the European search reports and the examination but also in the complete lack of a uniform alternative which comprises all countries of Western Europe.

2. The so created overburden of the EPO and the delay in the grant procedure connected therewith have lead to a situation which shows many parallels to the situation of the German Kaiserliche Reichspatentamt 100 years ago. For its relief from the examination of numerous small inventions the first German utility model law had been set up. All arguments which 100 years ago spoke for the introduction of the German utility model are valid today in the same manner for the introduction of a European utility model. They are convincingly summarized in the publication of F.K. Beier «Gebrauchsmusterreform auf halbem Wege: die überholte Raumform» in GRUR 1986, page 1 ff and shall not be repeated here.

3. The increasing duration of the European grant procedure makes it moreover evident that for many inventions the patent protection starts too late. The timely separation of the publication of a patent application on the one hand and the commencement of the full legal protection of the invention after the final grant of the patent on the other hand exposes the invention for a much too long period of time to the risk of imitation by third parties which cannot be prevented. In addition, there are inventions which already have lost their economic significance when after years the patent has been granted. In all these cases the insufficiency of the present European system for the protection of inventions which is only based on patents is evident.

C. Possible Legal Provisions for an European Utility Model Law

A future European utility model law should adopt the provisions of the most modern utility model laws which have recently been introduced in the Contracting States of the EC. The experiences which the applicants and the patent offices have gained with their practical uses as well as the acceptance which these laws have found by the users and the public should be a guide for a European utility model law. Some principles should be considered as a basis for such law:

1. The range of inventions which may be protected by a European utility model should not be restricted so far that important categories of inventions are excluded.

2. The European utility model should be examined before registration only for formal requirements, but not for novelty or an inventive step. This has to be left to a special cancellation procedure before the EPO.

3. The registration of European utility models should be as simple as possible in order to ensure that the procedure can be completed quickly and inexpensively.

4. The applicant should be entitled to request a Search Report. He should be entitled to enforce his utility model against third parties only after a Search Report has been issued.

5. The term and the scope of a European utility model could be defined in accordance with the most recent Utility Model Law of some of the contracting states of the EC. The cumulative protection of patent and utility model should be allowed as well as the branching-off applications from prior patent applications.

Moreover, the European legislator has the benefit of the detailed analyses which the AIPPI has elaborated in connection with Question 83.

Summarizing, the opinion is expressed that it is important and necessary to start with the harmonization of the European utility model protection by creating a European Utility Model Law without delay.
Genetic Sequences in patent specifications

by A. V. Huygens, Chairman of the Biotechnology Committee

1. Many professional representatives who are working in the field of biotechnology appear to have difficulties with the new provisions relating to the so-called Sequence Listings in patent specifications. The preparation of Sequence Listings is proving time-consuming and, consequently, expensive. Furthermore, the legal framework leaves room for questions.

2. The EPI Committee on Biotechnology Inventions has established an informal liaison with the EPO to permit early discussion of issues arising in the field of biotechnology. One of such issues concerns the problems relating to the Sequence Listings.


4. The EPO reviewed the developments since the December 1989 announcement of the experimental period of testing the PATENTIN software system. Sequence Listings have become mandatory in the USPTO and the PCT (as of 1 July 1992) and a WIPO Standard system have been adopted for this procedure. The EPO test program proved successful and it was felt appropriate now to introduce a mandatory system through EPC Rules 27(a), 40, 104(a) and (b) on the lines indicated in the SACEPO document. It was explained that subject to certain minor amendments Rule 27(a) EPC was now virtually accepted.

5. On the basis of comments that it had received, the Committee explained that Sequence Listings was not a universally popular practice amongst the European patent profession. This Committee was concerned inter alia with four main points:
   (1) the preparation of sequence listings was a time-consuming and therefore costly exercise.
   (2) sequence listings were apparently required for sequences disclosed even though not claimed.
   (3) the provision of separate sequence listings for the EPO, USPTO, and JPO meant substantial duplication of work.
   (4) the legal consequences of errors were uncertain.

6. The EPO representatives felt that they could allay the fear expressed in (2) above. Although Rule 27(a) EPC was broadly worded as an enabling Rule, it was their belief that Sequence Listings would be required only for those pertaining to the invention (presumably those present in the claims).

7. The EPO observed that in the trilateral EPO/USPTO/JPO cooperation it was proposed to adopt the WIPO Standard form so that duplication would not arise. When the EPC Regulation was finalised, it would use the WIPO Standard form of sequence listing. Moreover, it was believed that a single sequence listing filed in any of the three Offices would suffice (a «Budapest» type system). Duplication was only a temporary problem.

8. The EPO explained that in trilateral cooperation all sequences received would be entered into a database which would be continually expanded and made available to the public. The Offices were planning to compile this database by capturing sequences from 1962 onwards and it was hoped to be made available by early 1993. The Committee expressed the wish that this database, which applicants collectively will have paid to create, would be available at reasonable cost.

9. The EPI Committee on Biotechnology Inventions will continue its efforts to serve the interests of the European patent attorneys working with the Sequence Listings and to assist the EPO in the further evaluation and improvement of this project. The EPI-members are therefore encouraged to send any comments or suggestions to the Committee, preferably through the EPI Secretariat.

Letters to the Editor
US Designation in PCT Applications

The letter by V. Morstad in EPI Information, No. 3, 1991, pp 56-57 had the merit of bringing about the very complete and instructive replies on the part of D. J. Lucking, of F. Guchod and of F. Macchetta (EPI Information, No. 1, 1992, pp 32-41).

I would like to supplement these replies by a point which was not raised and which would appear to show that having recourse to PCT proceedings
for filing a US application can be a handicap for non-Americans. It is true
that the case which I am going to describe is very rare, but nevertheless exis-
ts, because I encountered it recently.
This involves the interference proceedings and more particularly the con-
tions for initiating such proceedings.
As is known interference proceedings are initiated when two conditions
are fulfilled: one of a fundamental nature: two Applicants (or an Applicant
and a Patentee) claim the same patentable invention; the other of a formal
nature: the filing dates of the two applications (or an application and a patent)
are close to one another.
With regards to the date condition, Americans have recourse to the notions of
the «filing date» and the «effective filing date».
The «filing date» (abbreviated subsequently to FD) is the date allocated to
an application by virtue of article 35 USC 111, last sentence: «The filing date
of an application shall be the date on which the specification and any re-
quired drawing are received in the Patent and Trademark Office».
In many cases (and particularly when the Applicant is a non-American),
the first date to be taken into account is not the date on which the Patent and
Trademark Office received the application, but an earlier date linked with
another application, either a first filing made outside the USA and creating a
convention priority right (35 USC 119), or an international PCT application
(35 USC 365) or an application which has given rise to another application
(«continuation», «continuation-in-part») (35 USC 120). In these three cases
reference is made to the «effective filing date» (abbreviated to EFD sub-
sequently).
Thus, for a Frenchman filing his application at the end of the priority year
in the USA and validly claiming this priority to dates would have to be taken
into account, namely the filing date in the USA («filing date» or FD) and the
priority date («effective filing date» or EFD).
For an American making a first filing in the USA, only one date would
have to be taken into account, namely the filing date («filing date» or FD),
which coincides with the «effective filing date» (EFD).
These dates having being defined, the general rule concerning the initiating
of interference proceedings is as follows:
Interference is not declared between two applications if there is a difference
of more than three months between their effective filing dates, in the case of
inventions of a simple nature, or if there is a difference of more than six
months in their effective filing date in other cases.

The following diagram illustrates this rule, where the «critical period» is 3 or
6 months:

Rule: no interference between A and B
interference between A and C

In the case of confrontation between non-Americans each benefiting from a
priority right, the rule applies through the priority dates, which constitute
the effective filing dates.
As is often the case in US legislation concerning patents, a simple rule is
accompanied by an exception, which seriously complicates the question. This
is also the case with interference proceedings, where an exception exists
when one of the applications benefits from the earlier EFD and the other
benefits from the earlier FD, in other words when the chronology of the ef-
eective filing dates is not the same as that of the filing dates.
This case can occur in several circumstances, e.g. when there is
confrontation between a non-American benefiting from a priority date (EFD)
and an American who has filed his application in the USA during the priority
year.
In such a situation, interference could be initiated even if the second appli-
cation (that of the American) was filed after the critical 3 or 6 month period
starting at the first EFD. However, it will be necessary for the second appli-
cation to be filed before the FD of the first application. The chronological di-
agram is as follows:
interference would be declared between A and B or between A and C, due to the PCT procedure.

This situation is made clear by the following true example:


Therefore the French Applicant (FR) has an EFD of 17.10.1984 and the Japanese an EFD of 23.5.1985, so that there are seven months and 6 days between the two EFD’s. On applying the general rule, there would be no interference between these two applications. However, the Japanese Applicant benefits from a FD of 23.5.1986 earlier than the FD of the French Applicant (16.6.1986). According to the previously discussed exception, interference would be initiated between the Frenchman and the Japanese:

Thus, by using the PCT procedure, the Frenchman would have placed the Japanese in the pole position in the race for the title of first inventor.

However, it should be noted that in the case of interference proceedings in such circumstances, the invention dates which would be granted to the Frenchman and the Japanese would respectively be the priority dates of 17.10.1984 and 23.5.1985. Therefore the Frenchman would finally win, but would have been involved in long and expensive interference proceedings. If he had not used the PCT procedure, he would have obtained his patent by the normal procedure (ex parte) and would not have had to do battle with his Japanese competitor (in inter partes proceedings).

R. Signore (FR)
Language Requirements for the European Examination

During the discussion following the report of the Professional Qualification Committee at the May 1992 Council Meeting once again a view was voiced as to reduction of the linguistic requirements for candidates.

No doubt there are persons who have one of the official languages as their mother tongue but who are equally fluent in the two other. Provided they are also proficient in European patent matters they must be considered to be the ultimate as European Patent Attorneys go. Alas, there are far too few to fulfill the demand! Hence it is necessary to compromise. It has been suggested that candidates should only need to understand two of the three languages, and furthermore that candidates from non-official-language countries should be given further benefits. I regard this as a very dangerous proposal (like lowering the inventive step in order to grant more patents). I feel that any client must expect his or her Professional Representative to be able to evaluate documents and files in all of the official languages. Otherwise, how will the client be assured of responsible advice in all matters relating to European patent practice? The European examination should reflect this.

The degree of compromise should be determined by what is desired and by what is the current state of affairs. One efficient way to determine this would be to ask a representative sample of EPI members to subject themselves to a proper test of linguistic ability. The sample and the test should be drawn up by a professional in language tuition, perhaps a suitable work for a post-graduate student. The result should indicate in particular the degree of comprehension of a written technical text. I suggest that this test should be anonymous. I expect that there will be no material difference in 3-language comprehension between a sample of EPC-language persons and a sample of non-EPC-language persons. The difference will lie in the ability to express oneself in just one of the official languages.

In conclusion I would stress that there is absolutely no shame connected with the requirement to sharpen the tools of our profession: the official languages. But it may be hard work.

G. Brock-Nannestad (DK)

Harmonization of the Regulations Governing Representation in Patent Matters before the National Patent Offices of EPC Contracting States - Liechtenstein

The tables of Dietrich Bernecker's contribution in EPI Information 1-1992 require some amendments with regard to Liechtenstein.

While Switzerland and Liechtenstein form a united patent territory (as provided for in the PCT) and while both countries have designated the Swiss Patent Office in Bern as their National Patent Office, the Regulations governing representation before this common Patent Office differ widely:

- Any natural legal person having either a residence or principal place of business in Liechtenstein could be admitted to act before the Swiss Patent Office in trademark matters only; this is not so (contrary to Swiss residents or businesses) in patent matters unless the person is a »Patentanwalt« or a »Rechtsanwalt«. The left side of D. Bernecker's Table 1 therefore has to be amended accordingly.

The same applies to the first column of Table 2: Either the Liechtenstein employer must have a place of business (it need not be the principal one) in Switzerland, or the employee must reside in Switzerland for being allowed to act for the Liechtenstein employer before the Swiss Patent Office.

A Liechtenstein Patent Attorney must be a Liechtenstein national and have his residence in Liechtenstein. Furthermore, he or she must be a graduate from a university or technical high school recognized by the Liechtenstein government (this usually applies to all such schools in the German speaking countries) and confirm having had a 2-3 years experience in patent matters. These circumstances therefore require corresponding amendments of Table 3.

No examination is provided so far. A new »Patentanwaltsgesetz«, however, is just now under consideration which might (but not yet sure) accept the European Qualifying Examination for patent matters but eventually might require an additional examination covering the Liechtenstein laws and regulations on trade marks, industrial designs, author's rights and unfair competition.

Dr. K. Büchel (LI)
Information from the General Secretariat

Guide from Munich’s new Airport to the EPO

Munich's new Airport opened on 17 May 1992. No more planes will go to the old one. People from Munich have been betting how to get to and from the airport quickest, by S-Bahn (Metro), bus, or car. A newspaper sent out three reporters from the center of the city between 8.30 and 8.50 o'clock in the morning. The S-Bahn (Metro) won the race in a smooth 36 minutes trip. The lucky second and third runners (no major traffic jams) were the bus, needing 45 minutes, and the private car, needing 48 minutes. The usual traffic jams might have considerably prolonged the trip for the highway users.

In case you belong to those who need to travel to the EPO or EPI, we give you some further information for making up your mind which means of transportation you want to choose:

- A taxi will cost you some 100 DM, the bus (Hauptbahnhof-Flughafen) 12 DM for a one way trip and 20 DM for a round trip. You have to add 2,50 DM for the S-Bahn ticket from Hauptbahnhof to the Isartor station. The S-Bahn remains the cheapest with 10 DM.
- S-Bahn tickets are available at the S-Bahn counter in aisle »A« near the »Central Area« or you can get them at the automatic ticket distributor.

The S-Bahn automatic ticket distributor will no longer frighten you if you follow this advice:

- Have a 10 DM or 20 DM bank note or respective German coins ready (or get them at the airport bank).
- At the ticket distributor push the button »4 Zonen« (4 fare stages) for 10 DM.
- Insert your money.
- Get your ticket and cancel it at the automatic stamping machine.

And here is the schedule for the S-Bahn airport line (no. »8«). For the EPO main building you have to leave at »Isartor« station, for the Pschorrhöfe building you continue 4 more stations till »Hackerbrücke«. The trains run every 20 minutes:

| Departure | Airport | .15 / .35 / .55 |
| Arrival   | Isartor | .50 / .10 / .30 |

| Departure | Isartor | .07 / .27 / .47 |
| Arrival   | Airport | .41 / .01 / .21 |

There are modifications between midnight and 5 a.m. Have a nice trip!

Deadline for EPI Information 3-1992

Our redaction deadline for the next issue of EPI Information is 31 July 1992. The documents for publication should have reached the General Secretariat by this date.

Redaktionsschluß für EPI Information 3-1992


Date de Remise des Documents pour EPI Information 3-1992

La date limite de remise des documents pour le prochain numéro de EPI Information 3-1992 est le 31 juillet 1992. Les textes destinés à la publication doivent être envoyés au Secrétariat Général avant cette date.
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**Berufliche Qualifikation Professionnel Qualification Qualification Professionnelle**

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**Standesregeln Professional Conduct / Conduite Professionnelle**

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**Kommentar**

Von Prof. Dr. Dr. Romuald Singer, Vorsitzender der Großen Beschwerdekommer des Europäischen Patentamts a.D., und Margarete Singer, Amtsgerichtsrätin a.D.

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Kommentar

Von Prof. Dr. Dr. Romuald Singer, Vorsitzender der Großen Beschwerdekanzlei des Europäischen Patentamts a. D., und Margarete Singer, Amtsgerichtsrätin a. D.

(– Heymanns Taschenkommentare zum gewerblichen Rechtsschutz)

Der »Singer« ist nach wie vor der erste und einzige abgeschlossene Kommentar, der das Europäische Patentübereinkommen und den PCT aus der Anwendungspraxis des Europäischen Patentamts heraus erläutert.

Er ist, gemessen am Umfang der Materie, knapp gehalten, geht aber trotzdem über einen reinen Kurzkommentar hinaus, weil er die einzelnen Bestimmungen immer auch im Gesamtzusammenhang den Übereinkommens, in ihrer Absicht und in ihrer Problematisabhanget. Dadurch ist er auch für Benutzer wertvoll, die sich in die Materie Europäisches Patentrecht erst einarbeiten müssen. 20jährige Lehre erfreuung des Verfassers Romuald Singer auf dem Gebiet des Patentrechts finden hier ihren Niederschlag.

Verwertet wurden über 300 im Amtsblatt veröffentlichte oder zu veröffentlichten und mehr als 200 im Amtsblatt nicht veröffentlichte Entscheidungen der verschiedenen Beschwerdekanzleien des Europäischen Patentamts. Unter den letzteren vor allem solche, die auf eine Weiterentwicklung der Festigung der Rechtsprechung hinweisen.


Der Anhang umfaßt die vollständige Ausführungsordnung, die Protokolle, die Gebührenordnung und einige weitere wichtige Vorschriften. Ein Entscheidungsregister und ein umfangreiches Sachverzeichnis erleichtern die Benutzung des Kommentars.
Handkommentar zum EWG-Vertrag

Von Professor Dr. Kay Hailbronner (Universität Konstanz), Professor Dr. Eckart Klein (Universität Mainz), Professor Dr. Siegfried Magiera (Hochschule für Verwaltungs- wissenschaften Speyer), Professor Dr. Peter-Christian Müller-Graf (Universität Trier)


Der vorliegende Kommentar will diese Funktion des Vertrages aufzeigen und überwiegend anhand der Rechtssprechung des Europäischen Gerichtshofs – über die Grundprinzipien des Vertragswerkes informieren. Industrie- und Dienstleistungsunternehmen, wirtschaftsberatende Rechtsanwälte, Steuerberater, Unternehmensberater und Verwaltungsjuristen erhalten damit die wichtigen rasanten Überblick über den aktuellen Stand des Gemeinschaftsrechts. Sie haben so die Möglichkeit, fallsbezogen zu prüfen, ob gemeinschaftsrechtliche Regeln zu beachten sind und ob weitere Quellen herangezogen werden müssen: Gerade für die Praxis ist eine Voraussetzung für sicheres Handeln in einem Bereich mit hoher Regelungsdichte.


»Kompetenz für Europa«

Hailbronner / Klein / Magiera / Müller-Graf

LICENCE AGREEMENTS
LIZENZVERTRÄGE

Patents, Utility Models, Know-how, Computer Software
Annotated Sample Contracts under German and European Law
Patente, Gebrauchsmuster, Know-how, Computer-Software
Kommentierte Vertragsmuster nach deutschem und europäischem Recht

Von Dr. Jochen Pagenberg und Dr. Bernhard Geissler
3rd newly revised edition

Carl Heymanns Verlag

Zweisprachig
Bilingual

The book combines the advantages of a book of contract forms with a systematic licensing commentary which comprises German as well as the EC Licensing Law in its full scope. While the first edition contains 16 contract forms of patent licensing, since the second edition a further category of "technical property rights" was added in the form of two software license contracts. The most recent case-law and legislation in Germany and Europe including the Group Exemtion Regulation for Know-how Contracts are reprinted and have been included in the comments.

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