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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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Editorial

WHO is what? This is a quiz kind of question, and no doubt our esteemed readers will immediately answer »The World Health Organisation«. Acronyms such as WHO serve a useful short-hand purpose whilst being readily accessible to the public at large. Some acronyms are, however, little more than jargon, obscure even to aficionados in a particular field. We are prompted to these observations following a browse through that essential reading for practitioners, the European Patent Office Annual Report 1992. Excluding obvious ones (EPO, EPI) we counted nearly 30 acronyms some of which would probably be difficult for even the most erudite reader in the field of intellectual property to decipher. Would all our readers instantly know the meaning of *Bacon*, *Casex*, *Caesar*? The Office has a record of which it is justifiably proud and has placed itself at the forefront of patent protection not only in Europe, but in the world stage. Could it not though limit the use of jargon and become a truly UFO - User Friendly Office (not unidentified flying object)?

From 1994 on EPI members may have their annual EPI subscription withdrawn from their EPO deposit account. You will find more about this important and cost-saving measure printed on blue paper in the central part of this edition.

We would also like to draw your attention to an interesting decision by the disciplinary committee on advertising.

Jean Brullé · Joachim Herzog · Terry Johnson

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Council Elections (addendum)

PT: Change in the allotment of seats - results of by-election

Since the last Council elections earlier this year the following changes have occurred in the Portuguese representation to the EPI Council: Mr. José Luis Arnaut resigned from his function as full Council member. Mr. Jorge Cruz, so far a Portuguese substitute member, has become a full Council member. In a recently held by-election Mr. José Luis Arnaut has been elected a substitute member.

EPO Fees Working Group Report to Council*

(Summary)

J. U. Neukom (GB), Rapporteur

Technical Assistance/Co-operation

The 1993 Budget of the EPO envisages expenditure of nearly DEM 8 million split almost equally between co-operation with EPC contracting states and co-operation with non-contracting states. If the number of patent applications filed in the year is 70,000, this figure represents slightly more than DEM 100 for each application.

The co-operation with non-contracting states covers the activities described under the heading »Technical Assistance« in the EPO's Annual Reports: As was said in the 1991 Report »Numerous developing countries and regions receive technical assistance from the EPO in building up and modernising their patent offices«. Activity of this kind is funded partially by the EC Commission, and/or WIPO, so that more work is done than is actually paid for by the EPO. However the central question still remains of whether the EPO should pay anything towards the cost of activities specifically for the benefit of third parties.

* Continuation of reports to the 34th Council meeting in Knokke 3/4 May 1993; at this Council meeting the EPO Fees Working Group's status and name has been changed to »Committee on EPO Finances«.

If the EPC contracting states regard activities by the EPO for third party benefit as being desirable (and better done by the EPO than by the national offices), would it not be more logical and proper for the contracting states themselves to cover the EPO's costs? This point of view seems even more valid in relation to the expenditure on co-operation with the contracting states themselves since these states retain, for their own enrichment, so much more of the renewal fee income on European patents than would be put towards the granting of these patents on a national basis. Perhaps the distribution key, by which the sharing of renewal fee income is determined under Article 39 EPC, might be increased by a few percentage points, say from 50% to 55%, to establish a co-operation fund from which to cover the EPO costs in full.

Backlog on Examinations

Now that the backlog is being reduced, the number of operations carried out in a year exceeds the number of fees received in that year. This reveals that much of the money received in past years for backlog cases has already been spent on other things. This means, in turn, that the money to cover the excess of operations over fee income must, at least to some extent, be found a second time. Replying to the suggestion that an element of double payment must therefore be necessary, the EPO points out that the actual increases of fee levels, far from supporting this suggestion, are even less than the inflation rate. However, this still leaves in doubt whether applicants are receiving the full benefit of productivity improvements.

It may be too late to seek remedies, eg by a scheme under which the examination fee would become payable only when the EPO is ready to start the examination. However, it seems wrong that the EPO should still be budgeting for an appreciable operating surplus when it ought to be drawing from reserves. If the EPO were to revise its estimates to reflect this point of view by lowering to an appropriate extent the figure for the operating surplus in 1994, the fee level increases currently under discussion for taking effect 1 October later this year would no longer be needed.

Notes on the EPPC Meeting of 23rd June 1993

I. R. Muir (GB)

CPC Compulsory Licences

A resolution of the CPC relates to the establishment of common rules for Member States for the granting of compulsory licences in respect of Community Patents.

Prior, it is believed, to any action being taken on the resolution by the Interim Committee of the European Community or any Member State the EPPC has, for the EPI Council, prepared a document to initiate discussion on the subject and which gives an outline of the provisions which the EPPC believes should be incorporated in such common rules. The final form of this document was settled at the meeting and, if approved by Council, it is hoped that this paper will be given the broadest possible circulation.

Forthcoming DG3 Meeting

There was an extensive discussion of *amicus curiae* briefs as one subject to be raised at the meeting of EPI, UNICE and IFIA representatives with DG3 to be held on 8th November 1993.

A majority of the EPPC was in favour of enabling the introduction of *amicus curiae* briefs into the proceedings of the Enlarged Boards of Appeal and believe that this could be done by amending the Rules of Procedure of the Enlarged Boards of Appeal. This majority considered that:

- any person should have the right to file such a brief but that the *amicus curiae* should not become a party to the proceedings;
- the brief should be filed in one of the three official languages;
- no consent of any parties to the proceedings or leave should be required to permit the filing of such a brief;
- no filing fee should be required and no costs should be apportioned to or against the person filing the brief;
- to ensure consideration by the Enlarged Board of Appeal, the brief should be filed within three months from the first publication in the Official Journal that a case had been referred to the Enlarged Board;
- any brief filed later than this period of three months should only be considered at the Enlarged Board of Appeal's discretion;

no additional brief or appearance before the Enlarged Board should be permitted except at the express request of the Enlarged Board; if the *amicus curiae* brief is filed within the period of three months, the Enlarged Board should be obliged to study it but it would be entirely for them to decide whether or not to take the brief into account in their decision and the Board would not need to give any reason for not having taken the brief into account.

It was felt that the introduction of the possibility of *amicus curiae* briefs would help to ensure that as many aspects of a question as possible would be considered by the Enlarged Board.

When a question is referred to the Enlarged Board by a Board of Appeal, it is not uncommon for similar cases before other Boards to be stayed until a decision is given by the Enlarged Board. In such circumstances, it seems reasonable that a party whose case has been stayed may submit an *amicus curiae* brief to ensure that any points he wishes to make are considered by the Board of Appeal when making their decision on the referred case. Theoretically, a decision in respect of one question by the Enlarged Board is only binding on the Board of Appeal that has referred the case to the Enlarged Board. In practice, however, the legally binding nature of such decisions is much greater and the decision will invariably be followed in the stayed cases.

Similarly, when a point of law is referred to the Enlarged Board by the President of the EPO as a result of two Boards of Appeal having given different decisions on a question, the decision of the Enlarged Board is in principle not binding. However, in practice it will be and, therefore, interested parties should be able to put forward arguments in an *amicus curiae* brief if they feel that such points have not been previously considered or properly aired in the submission of the case to the Enlarged Board.

Voluntary amendment

There was discussion of the need for Rule 86(3), under which consent of the Examining Division is necessary after a reply to the first communication from the Examining Division has been submitted. It is believed that, in practice, Examining Divisions invariably give their consent for amendment, if the applicant's request for amendment is reasonable. However, it is understood that the Japanese Patent Office may harmonise their system

by copying this EPC rule and the interpretation of the rule in the JPO may be less generous with the desire to cut down examiners' workloads.

Before pressing for removal of this restriction in the EPC Rules, it would be useful to establish whether or not there have been any difficulties or loss of rights caused by the exercise of Rule 86(3) to prevent amendment. A notice elsewhere in this publication therefore requests information from members about any difficulties that may have arisen. The EPPC will consider any replies received by the end of the year to determine what further steps should be taken, if any.

**Decision of the Disciplinary Committee
of the Institute of Professional Representatives
before the European Patent Office**

Disciplinary Case: CD 4/91

Composition of Chamber:

E. Lyndon-Stanford	Chairman
R. E. Perry	Rapporteur
G. Tasset	Member
J. L. Laget	Deputy Member

The Language is English.

Decision

The Members (»The Members«) against which complaint is made are reprimanded, under Article 6 (2) (b) of the Regulation on Discipline for Professional Representatives.

Under Article 20 of the Additional Rules of Procedure of the Disciplinary Committee of the EPI, the Chamber authorises the President of the Council of the Institute to communicate the Decision in full to Members of the Institute without revealing the identities of the professional representatives concerned and the Complainant, unless they consent to be named.

Under Article 21 of the given Regulation and Article 19(1) of the given Additional Rules, the Complainant is to be informed of the result of the proceedings by being sent a copy of this Decision.

Facts relating to the complaint

The following documents are available to the Chamber:

- D1: Three parallel letters dated 2nd October 1991 from one of The Members, addressed to different companies near ... (GB).
- D2: Letter of complaint dated 22nd October 1991.
- D3: Letters from The Members to the EPI dated 31st October 1991 and 5th August 1992 (the latter of which has been referred by the EPI to the Professional Conduct Committee).
- D4: Letters from the Chamber to the Complainant dated 3rd January and 22nd October 1992, and respective replies dated 6th January and 9th November 1992.
- D5: Letters from the Chamber to The Members dated 22nd June, 22nd October and 13th November 1992, and respective replies dated 20th August and 9th and 16th November 1992.
- D6: Various articles and advertisements placed in the British press and directories by British patent agents and solicitors, and examples of mailshots by British patent agents.
- D7: Extracts from a report from the UK Office of Fair Trading, dated September 1986, entitled »Review of Restrictions on the Patent Agents' Profession«.
- D8: Extracts from a research report from the University of Warwick, dated 1988, entitled »Infrastructure for the Protection of Intellectual Property: Patent Agents and Patent Monopolies« by Derek Bosworth and Robert Wilson.
- D9: A letter dated 12th November 1992 from ...

The subject of the complaint lies in the mailing (»The Mailshot«) of the letters exhibited as D1, i.e. in October 1991. D9 shows that 600 companies were selected (in ... and the surrounding areas according to their location). The Chamber understands that a letter of the D1 type was sent to each such company. The three D1 letters at least were received.

The UK Law Society currently, and for at least the past 10 years, has no restrictions on advertising for its members, i.e. solicitors. D6 provides evidence of such advertising.

Following the OFT report (D4), the Chartered Institute of Patent Agents (CIPA) amended its regulations to remove the ban described at Section 4.8 of D7. As acknowledged in Section 4.11 etc of D4, the action of CIPA did not remove obligations of European Patent Attorneys under the EPI rules »which were broadly similar to the CIPA's existing rules«.

The Complainant specifically refers to paragraphs 2(c) and 2(d) of the EPI Code of Conduct. The Complainant states that he has not considered whether there is a basis for complaint under any other paragraph, but this is not determining. The Chamber has a duty to consider the entire Code.

Reasons

The Complaint is admissible. The Complainant and The Members concerned are members of the European Patent Institute.

The Code of Professional Conduct is »to govern the conduct and other activities of the Members insofar as such activities are related to the Convention on the Grant of European Patents (European Patent Convention) signed at Munich on 5th October 1973, as may be amended from time to time.« In order for the Complaint to be considered, The Members must have either directly or indirectly represented themselves as European Patent Attorneys. In this case, there is a clear European Patent Attorney element to be considered. The Mailshot refers to The Members as »Chartered Patent Agents and European Patent Attorneys« (emphasis added).

The Members have expressed uncertainty as to the current scope of the Code of Professional Conduct, in view of the paragraph stating that the »Code is therefore to govern the conduct and other activities of the Members insofar as such activities are related to the Convention on the grant of a European Patent« and the footnote indicating that this paragraph is to be deleted if and when the use of the title European Patent Attorney (and the French and German equivalents) is allowed to all members and in all contracting states. The paragraph is still in force, as the French and German titles are not yet open to use by all members in all states.

The Chamber is also aware that The Members have referred the applicability of the Regulation to the European Commission. This has had no effect on The Chamber's deliberations since they must relate to the Regulation as it is presently in force.

During oral proceedings, The Members accepted joint responsibility for The Mailshot. In so far as Article 12(2) of the Additional Rules of Procedure is relevant, although only one complaint has been made albeit relating to different professional representatives, it is hereby stated for the avoidance of doubt that this Decision applies equally to all three of The Members.

The Members submit that, since the Code of Professional Conduct sets out *recommendations* (emphasis added) that have been formulated to promote compliance with the Rules of Professional Conduct, the Code is to be interpreted as providing only guidelines that are to be interpreted according to the prevailing circumstances in the country in which any alleged offence took place. In particular, The Members argue that Section 2 of the Code, referring to advertisements, is unreasonable having regard to the freedom to advertise that is enjoyed in the United Kingdom in professions such as solicitors and, within the CIPA Rules, by its members.

Although it is possible that their understanding and the local circumstances may have some bearing on the mitigation to be taken into account when considering activities that violate the Rules of Professional Conduct, the Chamber does not accept the given arguments, for a number of reasons. Firstly, there is no suggestion in the Regulation or the Code that national circumstances should be take into account. On the contrary, they both clearly apply to all professional representatives before the EPO, just as the European Patent Convention applies to their activities throughout the states in which the Convention applies and in which the professional representatives conduct their business. Thus the effect of the Regulation and of the Code is the same in every state that has ratified the European Patent Convention.

Secondly, although the respective wordings of the Regulation and the Code are somewhat difficult to understand, the use of »recommendations« to characterise the provisions of the Code must be seen in the context of both the Regulation and the Code. Paragraph 1(b) of the Code clearly indicates that the Code lays down principles of professional conduct, and the Chamber does not doubt that the intention behind, for example, Section 2 of the Code was to give circumstances in which advertising breached those principles. The Chamber takes the view that the unambiguous wording of the Code's paragraph 2(a), indicating circumstances in which »it is con-

trary to the dignity of the profession ...«, means that non-observance of this paragraph violates Article 1(1) of the Regulation.

Further, Article 17(1) of the Additional Rules indicates that a Rule of Professional Conduct as set out in the Regulations can be violated without non-observance of any recommendation. The recommendations therefore provide a list, albeit non-exclusive, of circumstances which, if not observed, may infringe the Rules of Professional Conduct.

Thirdly, the existence of both national and EPI requirements for standards of professional conduct follows logically from the existence of different bodies and the use of different titles, although it is accepted that qualification for one may entail automatic qualification for another body. A member of both bodies must observe the standards of both; a member of one need not observe the standards of the other.

Further, the Chamber notes the Decision of the Disciplinary Board of Appeal of the European Patent Office of 15th November 1990 D12/88 (appearing in EPO OJ 12/91 at pages 591-600) which rejects defence based on the alleged »general trend of liberalisation«.

Paragraph 2(a) of the Code includes categories of allowable advertising. The D1 letters do not fall into any of these categories, since no national association is involved, nor do they relate to the specified establishment or change in the allowed form. Under paragraph 2(c) of the Code, therefore, it falls to be decided whether the D1 letters »offer unsolicited services«. The D1 letters clearly offer services. The Complainant shows that the services were unsolicited. The Members agreed that this was the case, during oral proceedings. Paragraphs 2(a) and 2(c) of the Code were not observed. Article 1(1) of the Regulation was therefore violated.

Paragraph 2(d) of the Code states that: »The circulation of schedules of charges, Powers of Attorney and information on current patent issues is to be restricted to clients and associates«. It is evident from D9 that no restriction to clients and associates was made. Indeed, it was stated during the oral proceedings, on behalf of The Members, that any letter to an existing client would have been removed. By definition, clients and associates are parties whose addresses the member will already have, and for which no marketing consultant is necessary. Since the D1 letters include a schedule of charges relating, inter alia, to the costs of filing patent applications at the European Patent Office, paragraph 2(d) of the Code was not observed. Article 1(1) of the Regulation was therefore violated.

Paragraph 5(a) of the Code requires »careful avoidance of any direct or indirect attempt to entice the clients of other members«. It is accepted that The Mailshot was sent out without prior knowledge that the addressees were already the clients of other members, but it is equally clear that no attempt was made to avoid contacting such parties. D9 is evidence that the addressees were selected for the likelihood that they were involved in work which might involve their contacting a member for advice. The Chamber observes that a simple search could have been made to determine whether any addressees were Applicants or Proprietors of patent rights, particularly as European Patent Applicants or Proprietors; although that would not have excluded parties seeking advice from members which did not lead to patent applications or patents in their names, the Chamber concludes that no care was taken to avoid contacting the clients of other members. Since the clear intent behind The Mailshot was the hope of obtaining the addressees as clients, more deliberately than advertising, which could reach unknown readers, paragraph 5(a) of the Code was not observed. Article 1(1) of the Regulation was therefore violated.

It is submitted by The Members that there cannot be enticement because it is »an outmoded view to regard companies as clients in the sense of *belonging* to particular Members«. Whether or not outmoded, the Chamber believes that the emphasis on »belonging« is irrelevant. The consideration is simply whether the addressees of The Mailshot were or were not clients of other members; at least three clearly were, without derogation from the right of any party to be the client of more than one member.

It is argued by The Members that, despite paragraph 1(h) of the Code, they might understandably believe that no complaint could lie because the activities which are the subject of complaint were confined to a state where such activities are permitted within the national rules. It is alleged that »most UK Patent Agents (and we have talked to many Patent Agents since we were first aware of the complaint against us) seem to consider that the Code is not enforced (when) the advertising makes mention (of a European Patent Attorney or European patent activities) but is confined within the state where the national rules permit advertising«.

Neither the Complainant nor the Chamber is aware of any such understanding. There is no evidence for the reference to »most UK Patent Agents«. The allegation is contradicted by D7, on which The Members have relied. The advertisements by patent agents under D6 indicate that

reference to European Patent Attorneys is often avoided, and there is no evidence that the patent agents' mailshots were sent to addressees who had not previously been clients or associates of those patent agents. In the absence of any basis for the alleged understanding among UK patent agents in the Code itself, and the unambiguous nature of its paragraph 1(h), the alleged understanding of the ability to advertise within national boundaries is disregarded.

The Chamber accepts that the information given in The Mailshot is factually correct. The Chamber accepts also that there is some degree of mitigation surrounding its organisation and execution, given the circumstances under which British solicitors or UK patent agents operate. The Chamber has considered the submission by The Members that their office (from which The Mailshot was despatched) constituted a newly-established practice, but notes that none of The Members was a new member of the EPI; on the contrary, two of them had been members since the inception of the EPI in 1978.

The Members have argued that the reaction of the addressees to their receipt of The Mailshot is a relevant consideration. The Chamber disagrees, since Section 2 of the Code refers to the act of advertisement rather than its effect, while Section 5 refers to relationship with other members, and is therefore independent of any effect on individuals who are not members.

The Members point out that there is only the one Complainant. The Chamber considers this not to be relevant to its considerations, which are simply to determine whether, if any complaint is made, the activities about which the complaint is made violate the Rules.

Under Article 6(2) of the Regulation, and in view of the conclusions reached above, Disciplinary Committee can decide either to issue a warning or reprimand, or refer the matter to the Disciplinary Board of the European Patent Office. The Chamber accepts in good faith the suggestion on behalf of The Members that »if, through lack of knowledge we have contravened the rules, we will not do so again«. Therefore, despite the various instances of non-observance of the Code, and the evident lack of care, the Chamber is also persuaded of the need to establish, by early publication of this Decision, what the position of the EPI is with respect to the particular activities of The Members.

Right of appeal

The Members affected by the Decision, the President of the Council of the Institute and the Present of the European Patent Office have the right to file appeals against this Decision with the Disciplinary Board of Appeal of the European Patent Office. The appeal should be filed in writing within one month of notification of the Decision and written grounds are to be filed within two months of this Decision (Articles 8 and 22 of the Regulation on Discipline for Professional Representatives, according to the Official Journal of the EPO (1978) page 91 et seq).

The Chairman of the Chamber:

E. Lyndon-Stanford

Date: 26th January, 1993

European Patents in Spain: Reservations on chemical and pharmaceutical products and problems concerning priority claims

Marcelino Curell Suñol (ES)

I. Historico-Legal Background

1. The former trend of many national patent systems to exclude the patentability of chemical and pharmaceutical products was represented in Spain by the Industrial Property Statute of 1929. According to its provisions concerning patents, which were repealed on 26 June 1986, products in general were not patentable, whereby not only were chemical and pharmaceutical products excluded, but also other products such as foodstuffs, alloys, cosmetics, phytosanitary products, detergents, etc.

2. As is known, under the impulse of the prospects of Spanish accession to the European Community, Spain adopted a step-by-step line of action, the goal of which was full protection of chemical and pharmaceutical products as from 7 October 1992¹.

3. This line of action was established in the Treaty of Accession to the EEC, in force from 1 January 1986, the new Spanish Patent Act nº 11/1986 (PA-1986), in force from 26 June 1986, the Instrument of Spain's

¹ EPI Information 4-1987, pag. 51 ss (Marcelino Curell Suñol, Spain and the European Patent System)

Accession to the EPC, in force from 1 October 1986, and the Royal Decree nº 2424/1986 of 10 October 1986 concerning the application of the EPC in Spain. This line of action comprised the following steps:

- 1.01.86: Application of reversal of the burden of the proof to process patents filed on or after 1 January 1986,
- 26.06.86: Abolition of patents of introduction, indirect protection of all products as such, patentability of all products as such except chemicals and pharmaceuticals,
- 1.10.86: Accession of Spain to the European patent system with reservations on the protection of chemicals and pharmaceuticals,
- 7.10.92: Patentability of chemicals and pharmaceuticals as such, extension of the reversal of the burden of the proof to process patents filed before 1 January 1986, introduction of a system of enquiries to substantiate facts in legal actions for patent infringement.
- 4. The path towards the goal of full protection for chemicals and pharmaceuticals has not been free from problems, particularly as far as the application by the Spanish Patent Office (SPO) of the reservations regarding European patents in Spain is concerned. These reservations were drawn up by the Spanish government in a declaration stating:

»In conformity with the provisions of Art. 167(2)a), to the extent that they confer protection to chemical or pharmaceutical products as such, European patents shall not be effective in Spain«²

5. It is the object of this paper to explain the two main problems that have arisen in the application of the Spanish reservations: the publication of the validation in Spain of the European patents covered by the reservations (II) and the claim of Convention priority for certain European patent applications (III). The author considers that the interest of this paper lies in setting out the present situation of these problems in Spain and not in giving his own personal opinions on them.

2 In a way parallel to this reservation for the European patents, the First Transitional provision of the 1986 Patent Act provides, for national patents, that »1. Inventions concerning chemical and pharmaceutical products shall not be patentable before 7 October 1992.- 2. Until that date, none of the Articles contained in the present Act dealing with the patentability of inventions of chemical and pharmaceutical products nor other Regulations indissolubly linked to their patentability shall be in force«. In this provision also postponed is the patentability of products obtained by microbiological processes.

II. Publication of the European Patents covered by the Reservations

i) Initial handling by the Spanish Patent Office

- 6. A granted European patent (or a published application) having Spain as a designated State, is effective in Spanish territory, provided that national validation has been obtained, i.e. that the application had lodged a Spanish translation of the patent specification (or claims) at the SPO and the patent specification (or application) has been published in the SPO Official Gazette.
- 7. During a first stage, when the SPO considered that the subject matter of one or several claims was affected by the reservations under Art.167(2)a), for conferring protection on chemicals or pharmaceuticals, it followed the practice of refusing to publish the translation and inviting the applicants - assuming that there were claims not affected by the reservations - to file a new set of claims from which all reference to protection of chemicals or pharmaceuticals had been deleted. Furthermore, the SPO advised the applicant of the possibility of lodging a reconsideration appeal within the term of one month³.

ii) Present handling: Arrangement SPO/EPO

- 8. Subsequently, the SPO understood that the filing of a new set of claims for Spain, during the national validation procedure, was extemporaneous and had no legal support whatsoever, since such filing is only possible at the EPO, taking advantage of one of the various opportunities offered by the European procedure.
- 9. In view of the above, a further stage consisted of an arrangement between the SPO and the EPO. According to this arrangement, the SPO publishes the Spanish translations of applications containing claims covered by Spain's reservations without requiring amendment or deletion⁴. It will, however, indicate such claims with a note to the effect that they are

3 As an example of this handling, see: SPO Resolution of 22.05.1989 rejecting a reconsideration appeal lodged against the refusal to publish the validation of a European patent application, *Actas de Derecho Industrial (ADI)*, Tomo 13, Año 1989-1990, page 411.

4 As an example of the new handling by the SPO, see: SPO Resolutions of 25.01.1993 and 28.01.1993 allowing two reconsideration appeals lodged against the refusal to publish the validations of European patents nos 0220103 and 0292348.

covered by the reservations⁵. Furthermore, applicants are advised to submit a separate set of appropriate claims when a European patent designating Spain is proceeding, if it is pertinent. A notice of the EPO President, dated 13 May 1992, containing said arrangement, as well as further information concerning the reservations, was published in the EPO Official Journal⁶ and in the SPO Official Gazette⁷.

10. It should be pointed out here that the SPO considers a claim to be covered by the reservations not only when the wording thereof is drawn up expressly as a chemical or pharmaceutical product claim, but also when the wording is drawn up as a method claim or as a use claim with a scope equivalent to that of a product claim.

III. Convention priority claim for certain European Patent Applications

i) Controversy over priority date and filing date approaches

11. We have seen that the deadline of 7 October 1992 is of remarkable significance in various aspects of Patent Law in Spain and most particularly

5 The note consists of the indication: »Reservation of Article 167.2 EPC. Claims: X, Y,...« inserted at the end of the corresponding mention published in the SPO Official Gazette, as well as the indication: »Reservation of Article 162.2 EPC« inserted at the end of each claim covered by the reservation in the Spanish specification published by the SPO, completed at the end of the claims by the additional indication: »The claims bearing the mention of Art. 167.2 EPC shall not be effective in Spain to the extent that they confer protection to chemical or pharmaceutical products, as per the transitional provision of the RD 2424/1986 of 10 October 1986, concerning the application of the EPC«.

6 EPO Official Journal no 6/1992, pages 301-302. It should be pointed out that this notice, when it mentions the expire of the reservation in paragraph 6, expresses the opinion that, under Art. 167(5) EPC, it is the filing date of a European patent application which is decisive, whether or not priority of a previous application is claimed.

7 Boletín Oficial de la Propiedad Industrial (SPO Official Gazette) 1 October 1992, no 2532, Vol. II, page 4751. It should be highlighted that in this publication, as a footnote applicable to the section on the expire of the reservations, the SPO states that »The content of this section reproduces an construction made by the EPO and in no case that this is the official construction of the SPO«.

along the path towards full protection of chemicals and pharmaceuticals⁸. When trying to apply this deadline to the expire of the reservations, the question arises as to whether it should be considered with reference to the priority date claimed in the application (priority date approach) or with reference to the filing date of the application, whether the priority of a prior application is claimed or not (filing date approach).

12. Both approached have had and have their defenders, which has opened up a controversy⁹, most particularly concerning the SPO and the EPO, and which has provoked requests for clarification from certain interested sectors, among them the EPI¹⁰.

ii) Reasons in favour of the priority date approach

13. With the intention of obtaining a clarification of the question, the SPO consulted several Spanish bodies and leading figures¹¹. The opinions given were favourable to the priority date approach, for several reasons¹². The most significant reasons may be summarized as follows:

a) The spirit of the national and international regulations affected by this question was always to prevent any chemical or pharmaceutical product

8 See: IIC no 6/1992, pages 868-871 (Spain, Chemical and Pharmaceutical Product Protection; information submitted by Dr. Ing. M. Curell Suñol).

9 A first manifestation of this controversy was a question asked of the Director-General of the SPO during the General Meeting of the Spanish Group of the AIPI held in Barcelona on 25 November 1991. Other manifestations of the controversy may be seen in IIC, no 3/1992, page 449 (Spain: Uncertainty about Priority Claims for Pharmaceutical Products).

10 See: J. Beton, Report on EPPC related items to Council, EPI Information 4-1992, page 23, where the attempts at clarification by the EPI are explained. In this sense, the meeting with the Director-General of the SPO and representatives of the Bundesverbände der pharmazeutischen Industrie, held at the SPO on 28 July 1992 may also be cited.

11 The SPO consulted the following bodies and leading figures: Legal Service of the Ministry of Industry, Commerce and Tourism (opinion of 1 September 1992), Professor Carlos Lema Devesa (opinion of 31 July 1992) and Council of State (opinion issued by the Plenary Meeting of 18 February 1993).

12 The study published by Professors Carlos Lema Devesa and Jesús Gómez Montero (*Régimen Jurídico de las Patentes Químicas y Farmacéuticas en España*, La Ley 22.09.1992, pages 1058 and 1059) is very interesting in this respect.

patent having effects in Spain prior to 7 October 1992, which would not be avoided if the priority of Art. 4 Paris Convention were allowed.

b) Since the priority right is an inseparable accessory right of the patent application, the object of both must be the same and, therefore, it is not correct that the priority should fall on a product that was not patentable in Spain at the time the priority was generated.

c) The possibility of claiming the priority of the patents concerned would cause a discrimination against residents in Spain, since these were not allowed to file and obtain chemical or pharmaceutical product patents before 7 October 1992, either inside or outside Spain.

d) The admission of the filing date approach would imply the consequence that product patents filed after the raising of the legal prohibition to protect chemicals and pharmaceuticals (7 October 1992), could have legal effects prior to such date, which would infringe the principle of non-retroactivity of the laws, recognized in the highest Spanish provisions.

e) The admission of the priority would prejudice the interests of the holders of a right based on prior use, recognized in Art. 54 PA-1986.

f) Art. 4 of the Paris Convention does not have to have automatic application since, as provided for in the German legislation when chemical and pharmaceutical protection was introduced in 1967, the priority of the patents concerned did not affect the prior users. Consequently, in conformity with the German opinion, it is admissible to limit the effects of the priority in certain cases.

g) The admission of the priority could have the prejudicial effects of creating a situation of lack of novelty or of dependence of a process patent for a new product filed in Spain before 7 October 1992, but after the priority claimed by a third party for such product.

iii) Reasons in favour of the filing approach

14. The main argument in favour of the filing date approach was based on the text of Art. 167(5) EPC. This article provides that any reservation »shall apply to European Patents granted on European Patent Applications filed during the period in which the reservation has effect«. It has been understood that this text unequivocally extends the legal effects of the reservations only to applications filed while the reservations were in force, but does not include later applications claiming a priority falling within such period.

15. Within this context, the EPO has expressed the opinion, shared by the EPPC-EPI¹³, that it is the filing date of the European application which is the decisive, whether or not priority of a previous application is claimed, and that, therefore, the reservations entered by Spain only apply to European patent applications filed before 8 October 1992 and to patents granted on the basis of such applications, their effect continuing for the term of the patent concerned. It should be noted, however, that in the event of litigation concerning the scope of said reservation, it shall be for the competent national Courts to decide¹⁴.

16. Whether this construction is correct or not, depends on the construction made of the EPC and, most particularly, of the text of Art. 167(5) EPC. Various reasons¹⁵ have been alleged for constructing this article in favour of the filing date approach, based mainly the Vienna Convention of 23 May 1969 on Treaty Law, the system and mechanism of the Paris Convention (of which the EPC is a Special Agreement) and in the EPC itself. The following reasons may be summarized, among others:

a) Since the EPC is a Special Agreement of the Paris Convention, it must be deemed to be certain that the Member States, when making the reservations, knew the mechanism of the Convention priority and had borne it in mind for the legal effects of the reservations. Therefore, they knew that the text of Art. 167(5) EPC does not exclude the case of patent applications filed after the period of reservations, but claiming a priority falling within the time the reservations were in force. This being so, it must be construed that these cases, not being »applications filed during the period in which the reservation has effect« are free from the legal effects of the reservations.

b) To construe Art. 167(5) EPC from a point of view of international law, it should be remembered that the admission of reservations in the EPC

13 See: Doc EPPC-C/30 (8.08.92), Report no 30 to the EPI Council prepared by the EPPC (Question 124: End of Reservations made by Spain under Art. 167 EPC).

14 See: EPO Official Journal, loc cit.

15 The study published by Dr. Hans Peter Kunz-Hallstein (*Ablauf des Stoffschutzvorbehalts für Spanien - Fragen der Inanspruchnahme der Unionspriorität in europäischen und nationalen Patentanmeldungen*, Mitteilungen der Deutschen Patentanwälte, 1993, Heft 1/93, pages 19-24) is very interesting in this respect.

system is an exception and that the reservations made on acceding to the EPC are only possible within narrow limits. Particularly, the EPC provides that for nullity of a European patent, only the motives cited in the EPC itself are admissible. Other national nullity motives based on the reservations may only be admitted, therefore, exceptionally and for clearly determined reasons. In international convention law, it is a principle recognized by the practice of the States and even by the Spanish Supreme Court, that the exceptional provisions must be construed strictly and that their meaning must be limited to the express content of the provision. Thus also, therefore, Art. 167(5) EPC should be construed in this way.

c) The filing date approach is in agreement with the practical application that certain Member States have made of the EPC. This practical application bears great weight in the construction of international law. Thus, when the Austrian reservations under Art. 167(2)a)b) EPC ran out, no doubt was raised as to whether from then on there could be European patent applications designating Austria, claiming an earlier priority. Greece has also made statements in this sense.

d) It is unacceptable that the declaration of reservations made by Spain on acceding to the EPC and the Spanish national provisions may be a reason for evaluating the legal situation in a different way. The declaration made by Spain is subject to Art. 167(2)a) EPC and there is nothing allowing it to be assumed that the Spanish Government had intended to confer on the reservations a scope other than the one expressly contemplated in the EPC. In this respect, it should be borne in mind that international law obliges States to make their declarations on conventions precisely and with sufficient clarity and that, according to a traditional rule of construction, the lack of clarity operates in any case to the detriment of the declarer.

17. Based on other points of view, the following reasons have also been raised against the priority date approach:

e) The argument that the filing date approach could imply a prejudicial discrimination for the Spanish applicants is not conclusive, since it is within the reach of the Spanish legislator to avoid the alleged prejudice for his subjects by appropriately amending the national provisions obliging the Spanish applicants always to file their patent applications in Spain first.

f) Within Spanish patent law itself, there is the precedent that as from 26 June 1986 (the date on which the PA-1986 entered into force) no objection has been raised by the SPO against the patentability of numerous products

(foodstuffs, alloys, cosmetics, phytosanitary products, detergents, etc), in spite of the fact that an earlier priority was claimed.

g) Spain, like any other Member State of the Paris Convention, is only competent to reject a priority claim when it does not meet the formal and time requirements of Art. 4, Paris Convention.

iv) Position of the Spanish Patent Office

18. European (or Spanish national) patent applications relating to the protection of chemicals or pharmaceuticals as such, filed after 7 October 1992 and claiming a priority of before this deadline, have not yet matured sufficiently to receive an action from the SPO. Nevertheless, there is no doubt that, at this time, the SPO has adopted the priority date approach.

19. The position of the SPO in favour of the priority date approach is clear after the recent statements of its Director-General¹⁶. The SPO considers that to admit the priority claim in said European patents would mean restricting the period of reservations agreed between Spain and the EEC (Protocol no 8 of the Treaty of Accession) and with the European Patent Organization (Art. 167 EPC), further to the fact that it would mean recognizing that the chemical and pharmaceutical product patents are effective in Spain as from before 7 October 1992, harming certain acquired rights. Furthermore, said possibility would be an attempt against the spirit of a Spanish regulation, the First Transitional Provision of PA-1986, which provides that »inventions for chemical and pharmaceutical products shall not be patentable before 7 October 1992«. It is categorically stated in this Transitional Provision that inventions for chemical and pharmaceutical products shall not be patentable before 7 October 1992.

20. Also, the Director-General of the SPO, in his statements, has expressed additional SPO reasons which follow the lines of the reasons given in paragraph 13, paragraphs b) to f) of this paper.

21. Finally, it is highly significant that the Council of State - i.e. the highest consultive body in Spain - in a Plenary Meeting has accepted the ideas of the SPO in an Opinion issued on 18 February 1993 and has reached the following conclusions:

16 Julio Delicado, Director-General of the SPO, Modernización del nuevo Derecho español de Patentes en el Ambito Farmacéutico, Estudios CEFI, no 0, Barcelona, May 1993, pages 4-8.

1st. The priority right on chemical and pharmaceutical product inventions, provided in Art. 4 Paris Convention, cannot extend its effects to a date prior to 7 October 1992.

2nd. Consequently, the SPO should not admit any priority claim based on an interpretation contrary to the above conclusion and, therefore, to the First Transitional Provision, paragraph 1, of the Spanish Patent Act.

Quelques remarques sur l'interprétation nationale du droit européen

Axel Casalonga (FR)

1. Dans un article paru dans le fascicule 2 de Juin 1993 de EPI INFORMATION, intitulé «Der Einfluß des EuGVU auf europäische Einspruchsverfahren und auf nationale Nichtigkeitsverfahren bei europäischen Patenten», Hans Raible fournit d'intéressants développements en faveur d'une meilleure connaissance et d'une application plus fréquente de la Convention de Bruxelles en matière de droit des brevets.

Il est certes déplorable, comme le note Hans Raible, que les tribunaux nationaux, ayant à juger de la validité de revendications identiques ou quasi-identiques à celles de brevets européens qui ont été jugées valables par une Chambre de recours à la suite d'une opposition, prennent des décisions contraires, ce qui entraîne la désagréable impression de se trouver en présence d'une «loterie juridique».

Hans Raible emporté par son élan semble cependant considérer que les tribunaux nationaux appliquent, tout au moins pour les brevets nationaux, un droit différent du droit européen. A l'appui de sa thèse il cite des décisions allemande (*Faser Herstellungsverfahren*) et française en particulier relatives à la délicate question du sursis à statuer.

2. Sur le sursis à statuer

Hans Raible cite en particulier le jugement du Tribunal de grande instance de Paris du 13 Mars 1992 dans l'affaire *Calendriers Jean Lavigne c/Etablissements Plancher*, ayant donné lieu à un sursis à statuer dans une action en contrefaçon fondée à la fois sur une demande de brevet français et sur le brevet européen correspondant. L'auteur précise que le Tribunal a sursis à statuer en ce qui concerne l'action intentée sur la base de la demande de brevet français, jusqu'à la délivrance du brevet français correspondant et

non pas jusqu'à la clôture de la procédure d'opposition engagée à l'encontre du brevet européen. L'auteur poursuit en indiquant que la décision de l'Office Européen des Brevets quant à l'opposition formée contre le brevet européen, ne pouvait avoir aucun effet sur la décision relative au brevet français, car cette dernière décision devait suivre le droit national et non pas le droit européen.

Ces points méritent quelques éclaircissements.

Dans l'action en contrefaçon intentée par les *Calendriers Jean Lavigne* ont été invoqués d'une part la demande de brevet français n° 87 14557 et, d'autre part, le brevet européen n° 0 312 925 revendiquant la priorité de la demande de brevet français précitée.

Dans les motifs du jugement, le Tribunal a prononcé deux causes de sursis à statuer, à savoir, la première, jusqu'à ce que le brevet français soit délivré et, la deuxième, jusqu'à ce que l'Office Européen des Brevets ait statué sur l'opposition formée contre le brevet européen correspondant.

Il ressort de la décision du Tribunal que le sursis à statuer relatif au brevet européen est prononcé «dans l'intérêt d'une bonne administration de la justice», tandis que le sursis à statuer relatif à la demande de brevet français est motivé par l'application de l'article 55 de la loi française du 2 Janvier 1968 modifiée (maintenant Article L 615-4 du Code de la Propriété Intellectuelle).

Néanmoins, après avoir, dans un premier paragraphe, invoqué la bonne administration de la justice à propos du sursis à statuer relatif au brevet européen, le Tribunal applique les dispositions de l'article 55 de la loi à propos de la demande de brevet français, dans un second paragraphe débutant par «en tout état de cause». Il est donc bien certain, compte tenu de la formulation employée, que, même si le brevet français avait déjà été délivré, rendant alors caduque l'application de l'article 55, le Tribunal aurait malgré tout sursis à statuer compte tenu de l'opposition en cours portant sur le brevet européen correspondant.

La décision du Tribunal n'aurait alors pas suivi le droit français mais aurait bien été inspirée par le droit européen.

3. La question du sursis à statuer dans le cas d'une invention protégée à la fois par un brevet français et par un brevet européen, est réglée en France par l'article L.614-15 du Code de la Propriété Intellectuelle qui prévoit que lorsque le Tribunal se trouve saisi d'une action en contrefaçon d'un brevet

français qui couvre la même invention qu'un brevet européen demandé par le même inventeur, le Tribunal *devra* surseoir à statuer jusqu'à la date à laquelle, ou bien le brevet français aura cessé de produire ses effets par expiration du délai d'opposition ou maintien du brevet européen, ou bien la demande de brevet européen aura été rejetée, retirée ou réputée retirée ou le brevet européen révoqué.

La question se pose de savoir si le Tribunal doit également surseoir à statuer lorsqu'il est saisi d'une action en contrefaçon formée sur le seul fondement d'un brevet européen objet d'une opposition.

En droit interne français, l'article 55 de la loi française sur les brevets (Article L 615-4) ne s'applique pas dans ce cas puisque cet article ne concerne qu'une action en contrefaçon formée sur le fondement d'une demande de brevet français. En revanche, le nouveau Code de procédure civile accorde un pouvoir discrétionnaire au juge qui peut donc surseoir à statuer en considération de l'intérêt d'une bonne administration de la justice.

C'est en application de ce dernier texte, instaurant ainsi ce qui semble être maintenant la jurisprudence dominante de la 3ème Chambre du Tribunal de grande instance de PARIS, que cette Chambre surseoit généralement à statuer dans le cas d'actions en contrefaçon invoquant un brevet européen frappé d'opposition.

La dernière décision en date à ce sujet est celle du 1er Avril 1993 rendue par la 3ème Chambre, 2ème Section du Tribunal de grande instance de PARIS dans une affaire *Monsanto c/ Lilly* (non publiée à ce jour). Il convient néanmoins de citer une décision inverse rendue cette fois par la 1ère Section de cette même 3ème Chambre du Tribunal de grande instance de PARIS dans une affaire *L'Oréal c/ Estée Lauder* en date du 28 Avril 1993 (non publiée à ce jour) et dans laquelle les juges ont refusé le sursis à statuer dans une action en contrefaçon invoquant un brevet européen désignant la France et frappé d'opposition.

Il apparaît finalement que les décisions des tribunaux français en matière de sursis à statuer, lorsqu'une procédure d'opposition est en cours à l'OEB, ne diffèrent pas sensiblement, qu'il s'agisse d'un brevet français ou d'un brevet européen : c'est plus l'attitude des juges et les circonstances particulières de chaque affaire qui entraînent les variations que l'on peut éventuellement constater d'une décision à l'autre.

4. Application de la CBE en France

L'application de la Convention de *Munich* s'impose en droit interne français du seul fait de sa ratification conformément à l'article 55 de la Constitution française. La Convention de *Munich* prévoit il est vrai, notamment dans son article 2 alinéa 2, un renvoi au droit national qui a nécessité la promulgation dans chacun des Etats contractants d'une législation permettant d'établir un lien entre le droit national et celui découlant de la Convention de *Munich*. Cependant, mises à part quelques exceptions on observe une identité quasi-totale entre la loi française et la loi européenne, notamment en ce qui concerne les questions relatives à la brevetabilité.

La loi française en matière de brevets a été en effet modifiée le 13 Juillet 1978 afin de l'harmoniser de la manière la plus étroite possible avec les dispositions de la Convention sur le Brevet Européen.

En ce qui concerne les conditions de brevetabilité il y a lieu de noter que dès la loi du 2 Janvier 1968 la France disposait dans son droit positif de conditions de nouveauté et d'activité inventive pratiquement identiques à celles qui ont ensuite été reprises dans la Convention sur le Brevet Européen du 5 Octobre 1973. Cette identité n'est d'ailleurs pas surprenante puisque l'on sait que sur beaucoup de points et notamment sur les conditions de brevetabilité, la Convention sur le brevet Européen au même titre que la loi française, sont étroitement inspirées de la Convention de Strasbourg.

L'abandon des notions anciennes, développées autrefois par la jurisprudence française pour l'interprétation de la «nouveauté brevetable», telles que «l'application nouvelle» et «l'emploi nouveau», ne date donc pas d'hier. Si l'on peut encore voir apparaître certaines décisions des tribunaux français qui procèdent à une telle étude de la nouveauté par examen de l'emploi nouveau et de l'application nouvelle de moyens connus (comme la décision de la Cour d'Appel de Paris du 30 Janvier 1992 dans l'affaire *Tiru c/ Martin* citée par Hans Raible) il s'agit là en fait de décisions qui concernent encore des brevets déposés avant 1969, c'est-à-dire encore sous l'empire de la loi de 1844 et dont l'appréciation en matière de brevetabilité reste soumise aux dispositions antérieures de cette loi.

Au contraire, pour tous les brevets français déposés depuis l'entrée en vigueur de la loi du 2 Janvier 1968, les tribunaux se doivent d'appliquer et appliquent effectivement les dispositions nouvelles qui sont exactement

identiques à celles que l'on retrouve dans la Convention sur le Brevet Européen.

Les éventuelles divergences que Hans *Raible* croit détecter dans l'application du droit par les tribunaux français, en particulier en matière de sursis à statuer, ne peuvent donc pas provenir d'une application par le juge français de dispositions spécifiques telles que la notion d'emploi nouveau qui n'a plus cours en France depuis déjà bien longtemps. En réalité, le tribunal français, comme d'ailleurs les tribunaux de l'ensemble des Etats contractants de la CBE qui ont tous harmonisé leur législation dans les mêmes conditions, ne peuvent, surtout en matière d'appréciation de la brevetabilité, qu'appliquer des dispositions strictement identiques à celles que l'on retrouve dans la Convention sur le Brevet Européen. Il n'est pas possible de détecter une quelconque différence de rédaction dans les différentes lois nationales par rapport au texte de la Convention sur le Brevet Européen dans ses Articles 52 (inventions brevetables), 54 (nouveauté), 56 (activité inventive) et 57 (application industrielle).

5. Si dans certains cas, et notamment pour des situations limites dans les domaines de pointe de la pharmacie, de la biotechnologie ou des inventions dans le domaine du logiciel on peut constater des différences de sensibilité dans les jugements des différents tribunaux nationaux, ces différences ne peuvent provenir que d'un certain manque de maturité de la jurisprudence dans ces domaines nouveaux. De telles différences sont certes regrettables. Elles ne portent cependant que sur l'interprétation de textes de loi identiques et non pas sur l'existence d'un droit national distinct du droit européen.

Le fait qu'un brevet européen puisse alors être jugé valable dans un Etat et être annulé dans un autre Etat entraîne une situation qui est inhérente à la Convention sur le brevet européen et qui ne pourra être éliminée que par l'entrée en vigueur de la Convention sur le Brevet Communautaire ou, tout au moins, d'une instance juridictionnelle ou quasi-juridictionnelle analogue à la COPAC prévue par l'Accord sur le Brevet communautaire. Une telle instance aurait en effet un rôle central d'unification et d'harmonisation de l'interprétation du droit certainement plus efficace que celui tenu à ce jour par la grande Chambre de recours de l'Office Européen des Brevets.

6. Dans l'avenir les industriels et les inventeurs disposeront, du moins doivent l'espérer, d'un système de brevet en Europe complètement développé,

c'est-à-dire d'un système qui ne s'arrête pas, comme aujourd'hui, à la délivrance du brevet.

Mais, quelle que soit la structure juridique de ce futur système des brevets, il nous paraît essentiel de conserver en tout état la distinction entre l'organisme administratif qui délivre le brevet après examen et le tribunal qui juge en dernier ressort dans le cas de l'action en contrefaçon ou éventuellement de l'action en nullité principale. La procédure d'opposition s'apparente plus à une continuation de l'examen administratif par d'autres moyens qu'à une procédure judiciaire d'appréciation de la brevetabilité engagée à tout moment de la vie du brevet.

Il ne paraît pas souhaitable de vouloir revenir au plan européen à la distinction qui est faite dans certains pays tels que l'Allemagne, entre l'Administration seule responsable de l'appréciation de la validité du brevet et le juge uniquement compétent pour l'appréciation de la contrefaçon.

Précisément pour une bonne administration de la justice et pour que les justiciables puissent obtenir le plus rapidement possible une décision définitive, il paraît souhaitable d'adopter, au plan européen, la solution qui a été retenue par l'Accord sur le brevet communautaire et qui s'apparente aux procédures que l'on connaît aujourd'hui dans d'autres pays européens tels que la Grande-Bretagne et la France. Une telle procédure unifiée dans laquelle le juge connaît dans la même instance à la fois de la contrefaçon à titre principal et de la validité du brevet à titre reconventionnel, paraît préférable même s'il doit en résulter un risque plus grand de décisions contraires, du simple fait que les personnes prenant la décision ne sont pas les mêmes. Cette incertitude qu'il est impossible d'éliminer totalement dans une matière non scientifique comme le droit, est la rançon qu'il y a lieu d'accepter pour un tel système à deux niveaux, administratif et judiciaire.

Über den Unterschied zwischen mündlicher Verhandlung und persönlicher Rücksprache (Interview)

W. Weber (DE)

Einführung

Bei der schriftlichen Beantwortung des ersten Prüfungsbescheides wurde seitens des Anmelders zu der Auffassung des Prüfers Stellung genommen

und die Anspruchsfassung beibehalten. Gleichzeitig wurde hilfsweise um die Anberaumung eines Termins für ein Interview mit dem beauftragten Prüfer gebeten. Der Prüfer hat dieser Bitte nicht entsprochen und die Anmeldung ohne weiteren Bescheid zurückgewiesen. Gegen diese Entscheidung wurde Beschwerde eingelebt und mit der Begründung eine neue Anspruchsfassung, in der das Wort »gegebenenfalls« im Anspruch gestrichen war, eingereicht. Der Beschwerde wurde gemäß Art. 109 (1) EPÜ abgelehnt. Die beantragte Rückzahlung der Beschwerdegebühr wurde nicht gewährt, weil »die Anmelderin zu keinem Zeitpunkt des Prüfungsverfahrens eine mündliche Verhandlung beantragt habe«.

Stellungnahme

Die persönliche Rücksprache (auch Interview genannt) ist im EPÜ nicht vorgesehen, aber auch nicht ausgeschlossen. Dementsprechend sind die Regeln für die persönliche Rücksprache in den Richtlinien für die Prüfung im Europäischen Patentamt, Kapitel C VI 6.1a aufgeführt. Die persönliche Rücksprache kann von dem Prüfer, wenn er es für zweckmäßig hält, vorgeschlagen werden. Beantragt der Anmelder oder sein Vertreter eine Rücksprache, so ist (von dem Prüfer) diesem Antrag zu entsprechen, es sei denn, der Prüfer ist der Ansicht, daß eine solche Unterredung nicht sachdienlich ist.

Die gegenteilige Ansicht des Anmelders oder seines Vertreters ist demnach nicht einbringbar. Berücksichtigt er zusätzlich die mangelnde Rechtsverbindlichkeit der Richtlinien, die sich aus dem Abschnitt 1.2 der Einleitung zu den Richtlinien ergibt, muß der Anmelder oder sein Vertreter feststellen, daß der Antrag auf persönliche Rücksprache hinsichtlich seiner rechtlichen Bedeutung nur als eine höfliche Geste gegenüber dem Prüfer angesehen werden kann. Ein Rechtsanspruch seitens des Anmelders oder seines Vertreters auf persönliche Rücksprache besteht nicht.

Auf der anderen Seite stellt sich die persönliche Rücksprache, wenn sie von dem Prüfer gewährt wird, als eine ausgesprochen pragmatische Möglichkeit, die für das Prüfungsverfahren sehr förderlich ist, dar. Man möchte nur ungern auf diese Möglichkeit verzichten wollen.

Rechtlich institutionalisiert ist im Gegensatz zur persönlichen Rücksprache die mündliche Verhandlung gemäß Art. 116 EPÜ. Beantragt der Anmelder bzw. sein Vertreter die Anberaumung einer mündlichen Verhandlung, so muß die Prüfungsabteilung diesem Antrag folgen. Die Nichtberücksichtigung oder Ablehnung dieses Antrages hat zur Folge, daß die Entscheidung

zur Zurückweisung der Anmeldung nichtig ist. So wurde in der Entscheidung T 19/87 (Abl. 1988, 268) die Anmeldung an die Prüfungsabteilung mit der Auflage, eine mündliche Verhandlung nach Artikel 116 EPÜ durchzuführen, zurückgewiesen. Dies bedeutet, daß der Anmelder oder sein Vertreter ein Recht auf mündliche Verhandlung, auch wenn sie der Prüfungsabteilung nicht zweckdienlich erscheinen sollte, hat.

Es empfiehlt sich, in der Zukunft ausnahmslos einen Antrag auf mündliche Verhandlung zu stellen.

Die persönliche Rücksprache sollte nicht beantragt, sondern nur auf Vorschlag des Prüfers wahrgenommen werden.

Bei dem eingangs geschilderten Fall wäre die Durchführung einer persönlichen Rücksprache oder einer mündlichen Verhandlung sehr hilfreich gewesen. Da jedoch »nur« ein Antrag auf persönliche Rücksprache (Interview) - dem nicht entsprochen wurde - gestellt wurde, wurde das Prüfungsverfahren durch die Beschwerde und sofortige Abhilfe nach Art. 109 (1) EPÜ für den Anmelder um die Beschwerdegebühr teurer.

Sowohl in dem geschilderten Fall als auch in der Entscheidung T 19/87 ist die Frage der Rückzahlung der Beschwerdegebühr gegen den Anmelder entschieden worden. An dieser Stelle setzen zusätzliche Bedenken, die auch den Antrag auf mündliche Verhandlung betreffen, ein. Die Nichtrückzahlung der Beschwerdegebühr kann das Prüfungsverfahren um die Beschwerdegebühr verteuern, wenn allein die Prüfungsabteilung über die Anberaumung einer Rücksprache oder einer mündlichen Verhandlung gegen den Anmelder entscheidet, der Anmelder in der Beschwerde zwar sein Recht auf mündliche Verhandlung, aber nicht die Beschwerdegebühr zurückgezahlt erhält. Es bleibt zu wünschen, daß das Amt seine bisherige anmelderfreundliche und manchmal hilfreiche Haltung beibehält. Es wird vorgeschlagen, daß das Amt die Prüfer veranlaßt, grundsätzlich einem Antrag auf persönliche Rücksprache zu entsprechen.

Espace Legal The database on the European Patent Convention

Günter Gall¹

1. Introduction

The all-purpose database, with a ready answer to every question, has yet to be invented. Instead, databases specialise and try to meet individual user needs in various fields. However, they all use different kinds of software, and often require special hardware too. The potential user then thinks long and hard about their cost/benefit ratios - put more bluntly, are they worth it? With personal computers both decreasing dramatically in price whilst increasing appreciably in performance, PC applications are much in favour, and gaining market share along with big on-line databases.

For European patent law, I should like to present the Espace Legal database, which is available from the European Patent Office's Vienna sub-office².

2. Full Text Material

This new EPO database³ comprises the full texts of all Board of Appeal decisions (whether or not published in the Official Journal) - some 4 000 altogether. It is growing - increasingly rapidly - at between 600 and 700 decisions per year. The total storage capacity required - 150 megabytes - goes well beyond that of the normal hard disk. And it would be hardly economical to load a PC with an EPC database alone. The EPO has therefore opted for CD-ROM technology. This gives direct access to large quantities of data, but does also require a CD-ROM drive. Recent developments on the PC market have given this database a big boost: think of the sales cam-

¹ Member of the Boards and of the Enlarged Board of Appeal of the European Patent Office

² ESPACE LEGAL: Vienna sub-office, Schottenfeldgasse 29, PO box 82, A-1072 Vienna (tel. Vienna 52126-0, telex 136337 inpa, fax Vienna 52126-1493). The database is issued on two standard CD-ROMs per year, at an annual subscription of DEM 1 100 per year. The latest prices are given in a supplement to the EPO Official Journal (most recently in that to OJ 3/1993, under point 6.6).

³ The CD-ROM was first presented to the public at the 6th symposium of patent judges (The Hague, September 1992)

paigns last Christmas, pushing cheap PCs with CD-ROM drives as an optional extra. HIGH SIERRA standard (ISO 9660) drives were on offer at well under DEM 500. So users buying a new PC do not have to pay much extra for the CD-ROM drive. Adding a new or additional drive to an existing PC is more expensive, but still hardly prohibitive.

The database itself comes on a standard CD. The installation routine can go onto any PC hard disk drive. The database software⁴ is already integrated.

At present, two CDs are supplied per year, each new CD completely superseding its predecessor. In addition to decisions of the Boards and the Enlarged Board of Appeal, the CD-ROM also contains, in the three EPO official languages, the latest text of the EPC, PCT and, despite the ratifications still awaited, the CPC, plus various EPO forms in facsimile. A selection of national decisions as published in the EPO Official Journal will also be comprised in the CD-ROM. All these data fit onto a single ESPACE LEGAL CD, and are likely to continue to do so for the next few years. This is ideal, because it saves users having to change disks.

The database software permits full-text word-searching of the decisions and legal texts using the well-known Boolean operators. End- or front-masking (the latter naturally slower) are available, and users can move via cross-references from one document to another.

The second CD-ROM issued already contains the full texts of published decisions in German as well as English. The autumn 1993 update will contain the French texts too. Then the decisions published in the EPO Official Journal will be fully available in full text searchable form both in the original version and in the translations in the two other official languages of the EPO.

Unpublished decisions, or decisions scheduled to be published in the future⁵, are already on the CD in full text in the language of the proceedings.

A user only interested in the most recent case law on a particular point of law can limit his query accordingly, for example by entering »1990 ... 1992« under »Date of decision«. He can also combine his query with the relevant legal provision (e.g. Article 123 EPC), and confine it to a single

⁴ CD-Answer from Dataware, Barthstrasse 24, 8000 Munich 2.

⁵ »Unpublished« is used here in the sense of not being published or intended for publication in the EPO Official Journal.

language. ESPACE LEGAL's trilingualism is an interesting feature. Where a query covers all the decisions - both published and unpublished - the words used for interrogation will usually limit the search to just one language. But users can also do this actively, by entering »EN« for example under »document language«. They can also decide to search published decisions only, by entering »ALL« in the data field OFJ - »Official Journal«.⁶

The full-text of a decision is always in three parts:

- Summary of facts and submissions
- Reasons for the decision
- Order

The three parts can be searched together or separately. Once a decision has been located, it is very easy to move from one part to another.

From the 3rd CD-ROM onwards (autumn 1993), the newly added material will be indicated, enabling users to go straight to the latest decisions.

3. Facsimile coded material

Whilst the texts so far mentioned are stored in the database in coded form and are thus searchable via keywords, important EPO forms are stored in image (facsimile) form. These can be called up on screen in actual or enlarged size (»zoomed«), and printed out. Print quality however depends on the printer used. Of course, the forms thus stored will not be replacing paper copies for a while yet, but they do show the latest updates.

4. Main purpose of the data base

As an archive containing the decisions of the Boards and the Enlarged Board of the EPO, the searchable ESPACE LEGAL CD-ROM enables users to dispense with voluminous collections of paper. Anyone looking for a cited decision has easy access to its full text. This throws up new search possibilities going well beyond more formalised techniques using headnotes, keywords and specific articles and rules. The CD-ROM is a cheap and effective means to access important data on the EPC and the jurisprudence developed under this legal instrument.

6 »ALL« retrieves all documents where there is an entry in the respective data field.

Aspects of the interfaces between the European Patent Convention and the national patent law of its Contracting States*

Eugen Stohr**

* This article was originally published in German language in »Mitteilungen der deutschen Patentanwälte« 6/7 1993, S. 156 et seq., special issue, 15 years European patent applications.

The EPC has created a central patent grant system by which inventions can be effectively protected in several European States. This system is based on the regulations of the centralised European patent grant procedure, the harmonised law of the Contracting States on patentability and the rules of the national legal systems on the effects and enforcement of patents. The central European system and the national systems of the Contracting States interface at a considerable number of points to produce a total system for the protection of inventions in Europe.

Some of the interfaces which are of particular importance to the European patent system in practice and its smooth operation are to be discussed in more detail below. The objective is not so much to list and annotate the regulations with which applicants for and proprietors of European patents have to comply at such interfaces¹; rather, it is to give a critical appraisal of an area of European patent law which, under the heading of »National law relating to the EPC«, shapes practice to an extent that is not always fully appreciated in discussions on the future development of the European patent system.

Filing of European patent applications

Under Article 75(1) EPC, European patent applications may be filed at the EPO in Munich, its branch at The Hague and the Berlin sub-office or at

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The paper expresses the author's own views.

1 Cf. the information brochure »National law relating to the EPC« published by the EPO, 7th edition (the 8th edition is in preparation and will probably be available in the second half of 1993).

the competent authorities of Contracting States if their law so permits. As the structure and development of this provision show, the Convention gives special emphasis to the central filing of the European patent application at the EPO². Duplication in the receiving of applications is thus avoided, as are administrative effort and expense in forwarding them to the EPO (Art. 77 EPC). The opportunity for the decentralised filing of European patent applications was, however, provided primarily to take full account of the Contracting States' rules governing the secrecy of inventions of national importance in the case of European patent applications³.

Apart from the Netherlands, where the national patent office and the EPO branch at The Hague are housed in the same building, it is now possible to file European patent applications via the national patent offices in all the Contracting States.

Only Austria, Switzerland, Liechtenstein and Ireland allow central filing at the EPO without restrictions, however⁴. Otherwise, all Contracting States have rules restricting this route for reasons of national security within the terms of Article 75(2) EPC. Some States stipulate that European patent applications which, in the applicant's view, may be of relevance to the security of the State in question must be filed at the national patent offices of the appropriate Contracting State; this is either a blanket provision as in Germany, Luxembourg and the Netherlands or applies in certain cases according to the applicant's nationality and principal place of business or the place where the invention was made, as in Belgium, Denmark and Sweden. Other States go even further and permit the central filing of European patent applications only if the national Office in question has already had the opportunity to examine the invention for the need for secrecy (France, Greece, Italy, Spain, United Kingdom, Portugal).

As the filing practice of past years shows, approximately 40% of direct European patent applications are generally filed via the national Offices of the Contracting States. This illustrates that decentralised filing meets the

² Bossung, »Münchener Gemeinschaftskommentar«, Part 8, 1986, Article 75, marginal note 43.

³ Cf. e.g. Report on the 6th meeting of the Patents Working Party in Munich, 13.-23.6.1962 - 6551/IV/62, Report on the meeting of Working Party I in Luxembourg, 30.11.-2.12.1970 -BR/87/71.

⁴ Cf. »National law relating to the EPC«, Table II.

practical needs of European patent applicants more than was originally thought and seems to be diminishing in importance only gradually, even in an age of sophisticated methods of communication.

It is striking that filing via national Offices takes priority wherever national law precludes central filing if the invention has not already been the subject of a patent application in the State in question. This applies particularly in the United Kingdom, France and Italy⁵ and illustrates that arrangements of this kind influence filing strategy and act as a barrier to the filing of European patent applications first.

It should be pointed out that the UK Patent Office, which alone receives around 62% of all decentralised applications, also receives a large number of applications from third-party States. The reason for this is that applicants not having either a residence or their principal place of business within the territory of one of the Contracting States must be represented before the EPO (Art. 133(2) EPC). If they file European patent applications in English⁶, they evidently prefer to have recourse to professional representatives from the United Kingdom, who favour filing locally at the UK Patent Office.

As far as technical arrangements for filing go, there has been a gratifying trend over the past few years towards the general acceptance of new means of communication. As at the EPO⁷, so in most Contracting States⁸ European patent applications may be filed direct, by post or by facsimile. In the interests of the European patent applicant and, not least, to prevent discrimination, it would be desirable for the »facsimile application« to be allowed in the near future in those Contracting States that do not yet recognise it.

At this point mention should also be made of the project for filing patent applications in electronic form operated by the EPO, the USPTO and WIPO under the name EASY (Electronic Application System). Under this

⁵ In 1992 a total of 19 399 direct European patent applications were filed via the national Offices of the Contracting States. Of these, the United Kingdom accounted for 11 906, France 4 560 and Italy around 700.

⁶ In 1992 68% of all European patent applications were filed in English.

⁷ Cf. Notice from the European Patent Office dated 2 June 1992, OJ EPO 1992, 306.

⁸ Austria, Belgium, Denmark, France, Germany, Liechtenstein, Sweden, Switzerland, United Kingdom.

system, the applicant has the application recorded electronically and filed on diskette. Software developed for the project which guides and assists the applicant in drafting the patent application, is to be made available to interested parties free of charge. The new system is expected to simplify administrative procedures considerably and reduce costs. The filing of applications on diskette is also seen as a major step towards on-line filing, which is already possible in Japan now. EASY is to be tried out this year in an initial pilot phase at the EPO and WIPO.

The ambitious aim of the project is to make the electronic application a general standard in Europe in the long term. At the moment the EPO, together with the Contracting States, is looking at the extent to which the software developed for EASY can also take account of the specific needs of the national Offices.

In terms of the languages in which European patent applications may be filed via the national Offices, it is gratifying that the majority of offices accept applications drafted in one of the official languages of the EPO or a Contracting State (Art. 14(1), (2) EPC)⁹. Some Contracting States allow only the official language of the relevant State in addition to the official languages of the EPO¹⁰.

It is regrettable that there are still some Contracting States¹¹ that charge fees when the European patent application is filed via the national patent office. This is contrary to a 1983 Resolution by the Administrative Council¹² and, strictly speaking, is not compatible with the Convention¹³. For their involvement in the European grant procedure the Contracting States receive a proportion, currently 50%, of the renewal fees¹⁴ they charge for maintaining the European patents granted for their territory

⁹ Some States do, however, specify that a translation of the application or of specific information relating to it must be attached in the language of the country (cf. »National law relating to the EPC«, Table II, columns 3 and 5).

¹⁰ Belgium, Greece, Sweden.

¹¹ Austria, Luxembourg.

¹² Cf. point 4 of the 1983 Resolution of the Administrative Council on the harmonisation of certain provisions of the patent laws of the Contracting States of the European Patent Organisation, OJ EPO 1983, 301.

¹³ Bossung, »Münchner Gemeinschaftskommentar«, Part 8, Article 75, marginal note 78.

¹⁴ Cf. Decision of the Administrative Council of the EPO of 8 June 1984 (OJ EPO 1984, 296).

(Art. 39 EPC). Other possibilities for specifying national fees in connection with the European patent grant procedure are definitively regulated by the Convention (Art. 65(2), 137(2)(a) EPC).

Provisional protection

Article 67(1) EPC states that, as a rule, a European patent application shall, following its publication in the designated Contracting States, confer the rights associated with a corresponding European patent. This rule is, however, conditional on the Contracting State not having availed itself of the option of either restricting the scope of provisional protection or making it subject to specific provisos (Art. 67(2), (3) EPC).

As regards the scope of the provisional protection, in France, Greece, the United Kingdom, Italy and Ireland the basic rule of Article 67(1) EPC stands. In these States, the protection conferred by the published European patent application corresponds to that conferred by the European patent as granted. Prior to grant, legal action to enforce the provisional protection is possible only in Italy, however. The other States allow an action to be filed only following the grant of a patent or stipulate that such proceedings must or may be suspended until grant. This means that bans on use, based on published European patent applications, are not a factor in practice.

Furthermore, most Contracting States have availed themselves of the option allowed by Article 67(2) EPC and restricted the protection conferred by the published European patent application in that country. In these States, unauthorised use of the published invention can generally lead to claims by the applicant/patent proprietor only for compensation reasonable in the circumstances. Switzerland and Liechtenstein are, to some extent, exceptions since there a claim for damages may be brought following the grant of a patent¹⁵.

The options allowed under Article 67 EPC have therefore led to the development of, essentially, two forms of provisional protection in Europe, whereby the applicant's or patent proprietor's claims are either for damages or for reasonable compensation. In both cases, the tendency is for such claims to be made only after a patent has been granted. This is due to the fact that, in the period between publication of the application and grant of the patent, especially in systems without deferred examination, the invention has not yet been used to an appreciable extent and the risk of

¹⁵ Cf. »National law relating to the EPC«, Table III A, columns 1 and 3.

asserting claims based on the unexamined application often seems too high. Referring to the practice in Germany, *Neubaus*¹⁶ points out that, in the main, provisional protection is useful only where the infringing party continues to use the invention even after the grant of a patent. If, in such cases, the result is infringement litigation, claims usually include use of the invention prior to grant.

This is also the background to the conditions imposed by the Contracting States on the commencement of provisional protection for the purposes of Article 67(3) EPC if the European patent application is published in a language which is not one of the official languages of the State in question. All the Contracting States stipulate that protection is not effective until such time as the applicant has made the required translation of the patent claims available to the public in the manner prescribed by national law or has communicated it to the person using the invention in the said State (Art. 67(3) EPC).

In the majority of Contracting States, it is left to the applicant to choose one of the alternatives to meet the requirements for the commencement of provisional protection in the State in question. This is also the idea behind Article 32(2) CPC 89. The flexibility of this solution accords with needs in practice and allows the applicant to proceed according to the situation.

On the other hand, from the applicant's viewpoint there is no practical, discernible need for the general filing of the translation with the appropriate authority of a Contracting State, this being a requirement for the commencement of provisional protection in Denmark, Greece, Sweden, Spain and Portugal. Many States do, however, attach great importance to the provision of general information to the public although, at the same time, they accept that provisional protection will probably be enforced in practice only once in a blue moon especially if a person authorised to accept service or a representative has to be appointed for the filing of the translation (as in Greece, Spain and Portugal).

continuation see page 219

¹⁶ *Neubaus*, »The claim for compensation under Section 33 of the German Patent Law in practice«, IIC 1990, 526.

Withdrawal of EPI annual subscriptions from EPO deposit accounts

From 1994 on EPI members may have their annual EPI subscription withdrawn from their EPO deposit account. All members wishing to participate in the direct debiting procedure are invited to copy the direct debiting mandate published hereafter and return it straight away to the EPI General Secretariat, Postfach 26 01 12, D-80058 Munich.

**Administrative agreement dated 5 April 1993
between the EPO and the EPI**

The EPO and the EPI,

Having regard to Article 10 of the European Patent Convention and Article 4 (a) and (d) of the Regulation on the establishment of an Institute of Professional Representatives before the European Patent Office (OJ EPO 1978, 85),

Whereas the EPI constitutes an institution integrated in the framework of the European patent grant procedure and it is therefore desirable that the EPO should support the EPI in the performance of its duties,

Hereby agree that annual subscriptions to the EPI may be debited from the deposit accounts held with the EPO in accordance with the following provisions:

Article 1 Debiting deposit accounts

(1) The EPI may have its members' annual subscriptions debited from the deposit accounts held with the EPO upon submission of debit orders made out to the EPO. The debit order shall be based on one or more direct debiting mandates which shall be issued to the EPI by the account holder and not be submitted to the EPO. The Arrangements for deposit accounts have been amended accordingly by the decision of the President of the EPO dated 5 April 1993.

(2) Debit orders shall only be carried out with effect from 25 February and 25 June of each year as fixed debiting dates; Rule 85 (1) EPC governing the extension of time limits shall not apply. Debit orders shall be transmitted to the EPO on a data carrier specified by the EPO and shall include all the annual subscriptions to be debited from a deposit account in one overall sum. The date on which payment is considered to have been made shall be the date on which the account is debited.

Article 2 Insufficient funds

If after priority has been given to fees or costs in respect of EPO publications or services the credit balance of a deposit account on the debiting date is not sufficient to cover the EPI debit order, it shall not be carried out and shall be returned to the EPI. The EPI may only notify the EPI member and the account holder of insufficient funds in a deposit account.

Article 3 Reverse transfer

If the EPI discovers that a sum should not have been debited, or that the sum debited was excessive, it may transfer the amount debited back to the relevant account using a standard debiting text.

Article 4 Complaints

Complaints from EPI members or account holders relating to the implementation of the procedure shall be dealt with by the EPI. Complaints received by the EPO shall be passed on to the EPI for action.

Article 5 Co-operation

(1) The EPO and the EPI shall provide mutual assistance in implementing the procedure.

(2) This Administrative Agreement shall be published in the Official Journal of the EPO and in EPI-Information. The EPO and the EPI shall decide jointly on any other notices concerning its implementation.

Article 6 Written form

This Agreement shall constitute the entire agreement between the parties. No verbal agreements or understandings exist. The parties shall not be bound by any amendments or additions unless set down in writing and signed by both parties.

Article 7 Duration

(1) This Agreement shall enter into force on the date it is signed.

(2) This Agreement shall be concluded for an indefinite period. It may be terminated by either party giving six months' notice in advance of the end of the relevant calendar year. This shall not affect the right to terminate the Agreement without notice on serious grounds.

Done at Munich on 5 April 1993.

Paul Braendli

President of the European Patent Office

Sidney David Votier

President of the Council of the Institute of Professional Representatives before the European Patent Office

*Notice of the President of the European Patent Office dated 1 December 1992 concerning accelerated prosecution of European patent applications [»Seven Measures«]**

During the past, search and examination backlogs have built up in the EPO. While the backlog in search has now been cleared almost entirely, it will take somewhat longer to clear that in substantive examination.

In an effort to assist applicants requiring rapid search or examination the Office has, since 1988, operated a programme of »Seven Measures« designed to ensure quicker processing of European patent applications.

The Seven Measures have been improved again: the period for issue of the search report on a European first filing has been reduced from nine to six months (Measure 2).

* * * * *

Verwaltungsvereinbarung vom 5. April 1993 zwischen dem EPA und dem EPI

Das EPA und das EPI,
gestützt auf Artikel 10 des Europäischen Patentübereinkommens und Artikel 4 Buchstaben a und d der Vorschriften über die Errichtung eines Instituts der beim Europäischen Patentamt zugelassenen Vertreter (Abl. EPA 1978, 85),

in der Erwägung, daß das EPI eine in den Rahmen des europäischen Patenterteilungsverfahrens integrierte Einrichtung darstellt und es daher zweckmäßig ist, daß das EPA das EPI bei der praktischen Durchführung seiner Aufgaben unterstützt,

vereinbaren, daß EPI-Jahresbeiträge nach Maßgabe der nachstehenden Bestimmungen von den beim EPA geführten laufenden Konten eingezogen werden können:

* Republication of the notice published in OJ EPO 1992, 753.

Artikel 1 Abbuchungsaufträge von laufenden Konten

(1) Das EPI kann Jahresbeiträge seiner Mitglieder durch Vorlage von Abbuchungsaufträgen an das EPA von den beim EPA geführten laufenden Konten einziehen lassen. Dem Abbuchungsauftrag liegen eine oder mehrere dem EPI erteilte Einzugsermächtigungen des Kontoinhabers zugrunde, die dem EPA nicht vorgelegt werden. Die Vorschriften über das laufende Konto sind durch Beschluß des Präsidenten des EPA vom 5. April 1993 entsprechend geändert worden.

(2) Die Abbuchungsaufträge werden jährlich nur mit Wirkung vom 25. Februar und 25. Juni als festen Abbuchungstagen ausgeführt; Regel 85 (1) EPÜ über die Verlängerung von Fristen findet keine Anwendung. Sie werden dem EPA in Form eines vom EPA festgelegten Datenträgers übermittelt und umfassen alle einem laufenden Konto zu belastenden Jahresbeiträge in einem Gesamtbetrag. Der Abbuchungstag gilt als Zahlungstag.

Artikel 2 Mangelnde Deckung

Reicht am Abbuchungstag das Guthaben eines laufenden Kontos nach vorrangiger Berücksichtigung der Gebühren oder Auslagen für Veröffentlichungen und Dienstleistungen des EPA für den Abbuchungsauftrag des EPI nicht aus, so wird er nicht ausgeführt und an das EPI zurückgegeben. Mangelnde Deckung eines laufenden Kontos darf das EPI nur dem EPI-Mitglied und dem Kontoinhaber mitteilen.

Artikel 3 Rückbuchung

Stellt das EPI fest, daß ein Betrag nicht oder nicht in dieser Höhe hätte abgebucht werden sollen, so kann es den Betrag auf das betreffende Konto mit einem einheitlichen Buchungstext zurücküberweisen.

Artikel 4 Beanstandungen

Beanstandungen von EPI-Mitgliedern oder Kontoinhabern über die Durchführung des Verfahrens werden vom EPI behandelt. Beim EPA eingehende Beanstandungen werden zur Bearbeitung an das EPI weitergeleitet.

Artikel 5 Zusammenarbeit

(1) Das EPA und das EPI unterstützen sich gegenseitig bei der Durchführung des Verfahrens.

(2) Diese Verwaltungsvereinbarung wird im Amtsblatt des EPA und in EPI-Information veröffentlicht. Weitere Bekanntmachungen zu ihrer Ausführung werden vom EPA und vom EPI gemeinsam festgelegt.

Artikel 6 Schriftform

Diese Vereinbarung gibt die zwischen den Parteien getroffenen Absprachen vollständig wieder. Es bestehen keine mündlichen Vereinbarungen oder Absprachen. Die Parteien sind an etwaige Änderungen oder Ergänzungen nur gebunden, wenn diese schriftlich festgehalten und von beiden Parteien unterzeichnet worden sind.

Artikel 7 Geltungsdauer

- (1) Diese Vereinbarung tritt am Tage der Unterzeichnung in Kraft.
- (2) Diese Vereinbarung wird auf unbestimmte Zeit geschlossen. Jede Partei kann die Vereinbarung mit einer Frist von 6 Monaten zum Ende des jeweiligen Kalenderjahres kündigen. Das Recht zur fristlosen Kündigung aus wichtigem Grund bleibt unberührt.

Unterzeichnet in München am 5. April 1993.

Paul Braendli

Präsident des Europäischen Patentamts

Sidney David Votier

Präsident des Rats des Instituts der beim Europäischen Patentamt zugelassenen Vertreter

*Mitteilung des Präsidenten des Europäischen Patentamts vom 1. Dezember 1992 über die beschleunigte Bearbeitung europäischer Patentanmeldungen [»Sieben Maßnahmen«]**

In der Vergangenheit haben sich im EPA Recherchen- und Prüfungsrückstände eingestellt. Während der Rückstand in der Recherche nun fast vollständig abgebaut ist, wird dies in der Sachprüfung noch einige Zeit dauern. Um Anmeldern entgegenzukommen, denen an einer raschen Recherche oder Prüfung gelegen ist, hat das Amt 1988 ein aus sieben Maßnahmen bestehendes Programm zur rascheren Bearbeitung europäischer Patentanmeldungen eingeführt.

Die »Sieben Maßnahmen« sind erneut verbessert worden: Die Frist für die Erstellung des Recherchenberichts zu einer europäischen Erstanmeldung ist von bisher 9 Monaten auf 6 Monate verkürzt worden (Maßnahme 2).

* * * * *

* Wiederverlautbarung der in ABl. EPA 1992, 753 veröffentlichten Mitteilung.

Accord administratif du 5 avril 1993 entre l'OEB et l'EPI

L'OEB et l'EPI,

vu l'article 10 de la Convention sur le brevet européen et l'article 4, lettres a) et d) du règlement relatif à la création d'un Institut des mandataires agréés près l'Office européen des brevets (JO OEB 1978, 85),

considérant que l'EPI est un organe intégré dans la procédure européenne de délivrance de brevets et qu'il convient donc que l'OEB aide l'EPI dans l'exécution pratique de ses tâches,

sont convenus que les cotisations annuelles à l'EPI peuvent être prélevées sur les comptes courants tenus à l'QEB, conformément aux dispositions ci-après:

Article premier Ordres de débit des comptes courants

(1) L'EPI peut faire prélever les cotisations annuelles de ses membres sur les comptes courants tenus à l'OEB sur présentation d'ordres de débit à l'OEB. L'ordre de débit est fondé sur une ou plusieurs autorisations de prélèvement données à l'EPI par le titulaire du compte, qui ne sont pas présentées à l'OEB. La réglementation applicable aux comptes courants est modifiée en conséquence par décision du Président de l'QEB en date du 5 avril 1993.

(2) Les ordres de débit ne sont exécutés que les 25 février et 25 juin de chaque année, dates de débit fixes; la règle 85 (1) CBE régissant la prorogation des délais n'est pas applicable. Les ordres de débit sont transmis à l'OEB sur un support de données déterminé par l'OEB et correspondent au montant total de toutes les cotisations annuelles dont un compte courant doit être débité. La date de débit est réputée être la date de paiement.

Article 2 Provision insuffisante

Si, à la date de débit, le crédit du compte courant ne suffit pas pour couvrir l'ordre de débit de l'EPI, après règlement prioritaire des taxes ou des frais afférents aux publications et prestations de l'OEB, l'ordre de débit n'est pas exécuté et il est retourné à l'EPI. L'EPI est autorisé à informer uniquement son membre et le titulaire du compte courant de l'insuffisance de provision.

Article 3 Rectification

Si l'EPI constate qu'un compte n'aurait pas dû être débité ou que le montant débité est incorrect, il peut reverser la somme en cause sur le compte débité en utilisant une mention comptable normalisée.

Article 4 Réclamations

Les réclamations de membres de l'EPI ou de titulaires de comptes relatives à l'exécution des opérations sont traitées par l'EPI. Les réclamations adressées à l'OEB sont transmises à l'EPI pour suite à donner.

Article 5 Coopération

(1) L'OEB et l'EPI se prêtent mutuellement assistance aux fins de l'exécution des opérations.

(2) Le présent accord administratif est publié au Journal officiel de l'OEB et dans EPI-Information. L'QEB et l'EPI arrêtent conjointement toutes communications supplémentaires relatives à son application.

Article 6 Forme écrite

Le présent accord reproduit intégralement ce dont les parties sont convenues. Il n'existe aucun accord ou arrangement verbal. Les parties ne sont liées par d'éventuelles modifications ou dispositions complémentaires que si celles-ci sont écrites et signées par les deux parties.

Article 7 Durée

(1) Le présent accord entre en vigueur à la date de sa signature.

(2) Le présent accord est conclu pour une durée indéterminée. Chacune des parties peut le dénoncer moyennant un préavis de six mois avant la fin de chaque année civile. Il peut être dénoncé sans délai pour motifs graves.

Fait à Munich, le 5 avril 1993.

Paul Braendli

Président de l'Office européen des brevets

Sidney David Votier

Président du Conseil de l'Institut des mandataires agréés près l'Office européen des brevets

*Communiqué du Président de l'Office européen des brevets, en date du 1^{er} décembre 1992, relatif au traitement accéléré des demandes de brevet européen [«Sept mesures»]**

Dans le passé, des arriérés se sont formés au niveau de la recherche et de l'examen à l'OEB. Alors que l'arriéré de recherche a été presque entièrement résorbé entretemps, celui d'examen ne pourra être résorbé que dans quelque temps.

Soucieux d'assister les demandeurs qui souhaitent une recherche ou un examen rapide, l'Office a mis en oeuvre, depuis 1988, un programme en sept mesures conçu pour assurer un traitement plus rapide des demandes de brevet européen.

Les «Sept Mesures» ont été à nouveau améliorées: le délai pour l'établissement du rapport de recherche pour les premiers dépôts européens a été raccourci de neuf mois à six mois (2^e mesure).

* Nouvelle publication du communiqué publié au JO OEB 1992, 753.

Direct debiting mandate

Deadline for receipt by the EPI General Secretariat: 15 February

Einzugsermächtigung

Eingangsfrist im EPI-Generalsekretariat: 15 Februar

The Institute of Professional Representatives before the European Patent Office (EPI) is hereby authorised to debit from the deposit account held with the European Patent Office (EPO) as specified below the EPI annual subscription for the EPI member named below at the appropriate rate. This direct debiting mandate applies to the forthcoming and all subsequent subscriptions until it is revoked in writing. It also applies to outstanding subscriptions from previous years. Debiting will be on the basis of the Administrative Agreement dated 5 April 1993 between the EPO and the EPI (OJ EPO 1993, 367) and point 9 of the Arrangements for deposit accounts (OJ EPO 1993, 366).

Autorisation de prélèvement
Date limite de réception au Secrétariat général de l'EPI: 15 février

L'Institut des mandataires agréés près l'Office européen des brevets (EPI) est autorisé par la présente à prélever, sur le compte courant ouvert à l'Office européen des brevets (OEB) dont le numéro est indiqué ci-après, le montant en vigueur de la cotisation annuelle du membre de l'EPI dont le nom figure ci-dessous. La présente autorisation de prélèvement est valable pour la prochaine cotisation venant à échéance ainsi que pour les cotisations suivantes, jusqu'à sa révocation par écrit. Elle vaut également pour les cotisations des années précédentes non encore acquittées. Le prélèvement est opéré sur la base des dispositions de l'accord administratif en date du 5 avril 1993 entre l'OEB et l'EPI (JO OEB 1993, 367) ainsi que de celles du point 9 de la décision modifiant la réglementation applicable aux comptes courants (JO OEB 1993, 366).

Name/Vorname des EPI-Mitglieds:
EPI member's surname/first name:
Nom/prénom du membre de l'EPI:

EPI-Mitgliedsnummer:
EPI membership number:
Numéro d'affiliation à l'EPI:

Die Einzugsermächtigung gilt für mehrere EPI-Mitglieder
 Falls »ja«, bitte ein gesondertes Blatt mit den Namen und Mitgliedsnummer beifügen.
 This direct debiting mandate applies to more than one EPI member
 If »yes«, please list names and membership numbers on a separate sheet.
 L'autorisation de prélèvement s'applique à plusieurs membres de l'EPI
 Dans l'affirmative, prière de joindre au présent formulaire une feuille séparée portant le nom et le numéro de ces membres.

Name des Kontoinhabers:
Account holder's name:
Nom du titulaire du compte:

Kontonummer beim EPA:
EPO account number:
Numéro de compte auprès de l'OEB:

nein ja
 no yes
 non oui

Subscriptions are debited with effect from 25 February of each year. All fees and costs payable to the EPO on the debiting date have priority over the EPI subscription. The EPI will combine several subscriptions to be debited from the same account into one overall sum, for which it will then issue the EPO with a debit order. If, after priority payment of EPO fees and costs, the credit balance is not sufficient to carry out the EPI debit order, or if the direct debiting mandate is received by the EPI after 15 February, the debit order cannot be carried out. The EPI member will be informed. Then, if the annual subscription has not been credited to the EPI account through the standard banking procedure and at no expense to the EPI by 30 April, an attempt will be made to debit the higher annual subscription on 25 June. Should this attempt also prove unsuccessful, the higher annual subscription must be paid to the EPI through the standard banking procedure.

Der Einzug des Beitrags erfolgt mit Wirkung vom 25. Februar des laufenden Jahres. Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen gehen dem Einzug des EPI-Beitrags vor. Mehrere Beiträge, die vom selben Konto abgebucht werden sollen, faßt das EPI zu einem Gesamtbetrag zusammen. Demgemäß erteilt das EPI dem EPA einen Abbuchungsauftrag über den Gesamtbetrag. Reicht das Guthaben nach. Begleichung der vorrangigen EPA-Gebühren und Auslagen zur Ausführung des Abbuchungsauftrags des EPI nicht aus oder trifft die vorliegende Einzugsermächtigung beim EPI nach dem 15. Februar ein, kann der Abbuchungsauftrag nicht ausgeführt werden. Das EPI-Mitglied wird über den fehlgeschlagenen Einzugsversuch informiert. Überweist es den Beitrag, dann nicht bis spätestens 30. April (Kontoeingang) für das EPI spesenfrei im normalen Bankverkehr, erfolgt ein Einzugsversuch des erhöhten Jahresbeitrags am 25. Juni.

Le prélèvement de la cotisation prend effet le 25 février de l'année en cours. Le règlement de toutes les taxes et de tous les frais dus à l'OEB à la date de débit a priorité sur le prélèvement de la cotisation annuelle à l'EPI. L'EPI regroupe en un seul montant plusieurs cotisations devant être débitées du même compte. A cette fin, l'EPI donne à l'OEB un ordre de débit pour le montant total. Si, après règlement prioritaire des taxes et frais dus à l'OEB, la provision du compte ne suffit pas pleinement pour exécuter l'ordre de débit de l'EPI ou si la présente autorisation parvient à l'EPI après le 15 février, l'ordre de débit ne peut être exécuté, et le membre en est informé. Si celui-ci ne vire pas le montant de la cotisation le 30 avril au plus tard (date d'inscription au compte), par une opération bancaire normale et sans frais pour l'EPI, il sera procédé, le 25 juin, au prélèvement du montant majoré de la cotisation annuelle. Au cas où ce prélèvement non plus ne peut être

Subscriptions of EPI members who had not issued a direct debiting mandate by the previous debiting date may also be debited with effect from 25 June. The deadline for receipt of the direct debiting mandate by the EPI is then 15 June. If a separate sheet with the names of several EPI members is enclosed, it does not need a separate signature.

Schlägt auch dieser Versuch fehl, muß der erhöhte Beitrag im normalen Bankverkehr beglichen werden. Mit Wirkung vom 25. Juni kann der Beitrag auch für EPI-Mitglieder, die zum vorausgegangenen Abbuchungstag noch keine Einzugsermächtigung vorgelegt hatten, eingezogen werden. Eingangsfrist für die Einzugsermächtigung im EPI ist hierfür der 15. Juni. Falls ein gesondertes Blatt mit den Namen mehrerer EPI-Mitglieder beigefügt wird, braucht es nicht gesondert unterschrieben zu werden.

effectué, le montant majoré de la cotisation doit être acquitté par une opération bancaire normale. Avec effet au 25 juin, il est également possible de prélever le montant de la cotisation annuelle des membres de l'EPI n'ayant pas produit d'autorisation de prélèvement à la date de débit précédente. A cette fin, la date limite de réception des autorisations de prélèvement par l'EPI est le 15 juin.

S'il est joint une feuille séparée portant le nom de plusieurs membres de l'EPI, il n'est pas nécessaire de la signer.

Datum/Date

Unterschrift des Kontoinhabers /Account holder's signature /
Signature du titulaire du compte

Notice re debiting of EPI annual subscriptions from deposit accounts held with the EPO

Following a decision of the President of the EPO amending the Arrangements for deposit accounts¹ and under the terms of the Administrative Agreement between the EPO and the EPI², annual subscriptions payable by professional representatives to the EPI may be debited direct.

Professional representatives wishing to use this easy method of payment can issue a direct debiting mandate³ to the EPI (not the EPO) by 15 February of each year. This must be signed by the holder of the deposit account to be debited.

The EPI will combine several subscriptions to be debited from the same account into one overall sum, for which it will then issue the EPO with a debit order. The EPO will debit the account with effect from 25 February of each year.

If, after priority payment of fees or costs in respect of EPO publications or services, the credit balance of a deposit account is not sufficient to cover the EPI debit order, the latter will not be carried out and will be returned to the EPI. The EPI member will be informed. Then, if the annual subscription has not been credited to the EPI account through the standard banking procedure and at no expense to the EPI by 30 April, an attempt will be made to debit the *higher annual subscription* on 25 June. Should this attempt also prove unsuccessful, the higher annual subscription must be paid to the EPI through the standard banking procedure.

Subscriptions of EPI members who had not issued a direct debiting mandate by the previous debiting date may also be debited with effect from 25 June. The deadline for receipt of the direct debiting mandate by the EPI is then 15 June.

Information on the procedure is available only from the EPI⁴. The direct debiting mandate reproduced on page 399 will be sent to all EPI members in the second half of 1993. It can also be copied from the Official Journal and returned straight away to the EPI.

1 OJ EPO 1993, 366.

2 OJ EPO 1993, 367.

3 OJ EPO 1993, 399.

4 EPI General Secretariat, P.O.Box 26 01 12, D-80058 Munich, Tel.: (+49-89)
201 70 80, Fax (+49-89) 202 15 48

Mitteilung über die Abbuchung von EPI-Jahresbeiträgen von den beim EPA geführten laufenden Konten

Mit dem Beschuß des Präsidenten des EPA zur Änderung der Vorschriften über das laufende Konto (VLK)¹ und der Verwaltungsvereinbarung zwischen dem EPA und dem EPI² wird die Abbuchung von Jahresbeiträgen ermöglicht, die zugelassene Vertreter an das EPI zu entrichten haben. Der zugelassene Vertreter, der von diesem einfachen Zahlungsweg Gebrauch machen möchte, reicht eine Einzugsermächtigung³ beim EPI (nicht dem EPA) bis zum 15. Februar des laufenden Jahres ein. Sie muß vom Inhaber des zu belastenden laufenden Kontos unterzeichnet sein.

Mehrere Jahresbeiträge, die vom selben laufenden Konto abgebucht werden sollen, faßt das EPI zu einem Gesamtbetrag zusammen. Demgemäß erteilt das EPI dem EPA einen Abbuchungsauftrag über den Gesamtbetrag. Das EPA führt diesen Abbuchungsauftrag mit Wirkung vom 25. Februar des laufenden Jahres (Abbuchungstag) aus.

Der Abbuchungsauftrag wird nicht ausgeführt und an das EPI zurückgegeben, wenn das Guthaben eines laufenden Kontos nach vorrangiger Berücksichtigung der Gebühren oder Auslagen für Veröffentlichungen und Dienstleistungen des EPA für den Abbuchungsauftrag des EPI nicht ausreicht. Das EPI-Mitglied wird über den fehlgeschlagenen Einzugsversuch informiert. Überweist es den Jahresbeitrag dann nicht bis spätestens 30. April (Kontoeingang) für das EPI spesenfrei im normalen Bankverkehr, erfolgt ein weiterer Einzugsversuch des *erhöhten Jahresbeitrags* am 25. Juni. Schlägt auch dieser Versuch fehl, muß der erhöhte Jahresbeitrag im normalen Bankverkehr an das EPI beglichen werden.

Mit Wirkung vom 25. Juni kann der Beitrag auch für EPI-Mitglieder, die zum vorausgegangenen Abbuchungstag noch keine Einzugsermächtigung vorgelegt hatten, eingezogen werden. Eingangsfrist für die Einzugsermächtigung im EPI ist hierfür der 15. Juni.

Auskünfte zu dem geschilderten Verfahren erteilt nur das EPI⁴. Die auf Seite 399 abgedruckte Einzugsermächtigung wird allen EPI-Mitgliedern in der 2. Jahreshälfte 1993 übersandt. Sie kann auch aus dem Amtsblatt kopiert und sofort an das EPI zurückgesandt werden.

1 ABl. EPA 1993, 366.

2 ABl. EPA 1993, 367.

3 ABl. EPA 1993, 399.

4 EPI-Generalsekretariat, Postfach 26 01 12, D-80058 München, Tel.: (+49-89)
201 70 80, Fax (+49-89) 202 15 48

Communication relative au débit des cotisations annuelles à l'EPI des comptes courants tenus à l'OEB

La décision du Président de l'OEB modifiant la réglementation applicable aux comptes courants¹ et l'accord administratif entre l'OEB et l'EPI² permettent de débiter les cotisations annuelles que les mandataires agréés doivent régler à l'EPI.

Tout mandataire agréé qui souhaiterait faire usage de ce moyen de paiement simple remet à l'EPI (et non à l'OEB) une autorisation de prélèvement³ au plus tard le 15 février de l'année en cours. Cette autorisation doit être signée par le titulaire du compte courant à débiter.

L'EPI regroupe en un seul montant plusieurs cotisations annuelles devant être débitées du même compte courant. A cette fin, l'EPI donne à l'OEB un ordre de débit pour le montant total. L'OEB exécute cet ordre de débit avec effet au 25 février de l'année en cours (date du débit).

Si, après règlement prioritaire des taxes ou frais afférents aux publications et prestations de l'OEB, la provision du compte courant ne suffit pas pleinement pour exécuter l'ordre de débit de l'EPI, cet ordre de débit n'est pas exécuté et est restitué à l'EPI, et le membre de l'EPI en est informé. Si celui-ci ne vire pas le montant de la cotisation le 30 avril au plus tard (date d'inscription au compte), par une opération bancaire normale et sans frais pour l'EPI, il sera procédé, *le 25 juin*, au prélèvement du *montant majoré de la cotisation annuelle* de son compte. Au cas où ce prélèvement non plus ne peut être effectué, le montant majoré de la cotisation annuelle doit être payé à l'EPI par une opération bancaire normale.

Avec effet au *25 juin*, il est également possible de prélever le montant de la cotisation annuelle des membres de l'EPI n'ayant pas produit d'autorisation de prélèvement à la date de débit précédente. A cette fin, la date limite de réception des autorisations de prélèvement par l'EPI est le *15 juin*.

Les renseignements concernant la procédure décrite ne peuvent être obtenus qu'auprès de l'EPI⁴. L'autorisation de prélèvement reproduite à la page 399 sera envoyée à tous les membres de l'EPI au cours du second semestre de 1993. Il est également possible d'en faire une copie du Journal officiel et de renvoyer celle-ci dès à présent à l'EPI.

1 JO OEB 1993, 366.

2 JO OEB 1993, 367.

3 JO OEB 1993, 399.

4 Secrétariat général de l'EPI, boîte postale 26 01 12, D-80058 Munich, tél.: (+49-89) 201 70 80, Fax (+49-89) 202 15 48

continuation from page 202

The Convention rules governing provisional protection serve merely to provide security for the inventor in the event of unauthorised use of the invention as laid open to public inspection. By reason of their structure, they cannot effectively be made into an instrument for patent information purposes, primarily because provisional protection has only a subordinate role in practice (see remarks above); for this reason, a translation of the patent claims is filed for only a fraction of the European applications valid in individual Contracting States¹⁷.

Translation of the specification of the European patent

The specification of a European patent is published by the European Patent Office in one of its official languages -English, French or German- and includes a translation of the claims in the other two official languages (Art. 14(7) EPC).

The language ruling made for the Convention in Article 14 EPC is not definitive, however. As already mentioned, the Convention allows the Contracting States the option of stipulating further requirements for the European patent applications and patents effective in those States. In this context, Article 65 EPC is of considerable practical significance; it states that any Contracting State may require a translation of the European patent specification to be filed if the European patent granted for it is not drawn up in one of its official languages. This provision was created particularly to offset any likely disadvantages for the industries of those States whose official language is not one of the languages of the proceedings at the EPO or is per se only a relatively minor language¹⁸. Even though discussion of legal certainty, equal opportunities and patent information requirements always took precedence in this respect, it must be remembered that this provision is part of the political price paid for the language compromise otherwise reached.

17 Out of an annual total of around 42 000 European applications valid in Germany but not published in German, approximately 500 translations of the patent claims are filed with the German Patent Office each year.

18 In 1992, 68% of European patent applications were filed in English, 23% in German and 9% in French.

Even during the preparatory work for Article 65 EPC¹⁹ it was argued that ultimately this price would have to be paid by the European patent applicants - but the argument was to no avail. Major Contracting States such as Germany and the United Kingdom initially refrained from introducing a translation requirement, however. When passing the Law on International Patent Treaties (LIPT) in 1976, the German legislature explicitly pointed out in this context that the additional cost to the applicant associated with such a translation requirement was not justified and made the European patent less attractive²⁰.

Nevertheless, all Contracting States apart from Luxembourg and Monaco now require the filing of a translation of the European patent specification within the terms of Article 65 EPC. All States stipulate that, in the event of failure to observe this requirement, the European patent shall be deemed to be void (Art. 65(3) EPC)²¹. After the United Kingdom introduced the translation requirement in 1987²², Germany was no longer able to resist the trend and, since 1 June 1992, has prescribed that a translation be supplied for European patents valid in Germany but not drawn up in German²³.

The reasons why, after just on a decade and a half of the EPC without a translation requirement, the German legislature decided to avail itself of the option under Article 65 EPC will not be discussed in detail here. Mention should, however, be made of the reference which the grounds for the Law make to the language rules in the CPC: they state that the rule²⁴ for Community patents in CPC 89 dispensed with the considerations that had always favoured generally striving to achieve a ruling that generated the least possible translation costs for applicants. This proves that the low cost of cross-border patent protection in Europe has apparently taken a

19 Minutes of the 5th Meeting of the Inter-Governmental Conference for the Setting up of a European System for the Grant of Patents, BR/169/72, marginal note 110; BR/168/72.

20 Official substantiation of Art. II Section 3 LIPT, Bl. f. PMZ 1976, 322 et seq., 325.

21 Cf. »National law relating to the EPC«, Table IV.

22 Cf. OJ EPO 1987, 263.

23 Cf. OJ EPO 1992, 97, 380.

24 According to this, the applicant has to file a full translation of the patent specification in the official Community languages that are not a language of the proceedings (Art. 30 CPC 89). With 12 EC States, 8 translations are required.

back seat at the very time when its importance will increase in the context of the Single European Market and the European Economic Area. It is unfortunate for users of the European patent system that this development has come about by reference to a system that could not be effective or, at least, could not have any real practical significance for precisely that reason.

For European patent applicants this development has already led to additional costs which are making it very much more difficult - particularly for small and medium-sized businesses - to gain access to patent protection which matches the requirements of the Single Market geographically. Thus, for example, at the moment an applicant seeking patent protection in an average of, say, 7 to 8 European countries, faces translation costs which, along with the national fees and costs of filing the translation, are roughly equivalent to the cost of filing a patent centrally (procedural fees and representatives' fees). The likely accession of other Contracting States²⁵ and the trend in Europe towards seeking protection in an increasing number of States illustrate the fact that Article 65 EPC and the way the Contracting States are implementing it could become the Achilles' heel of the European patent system.

Small and medium-sized businesses are faced with a paradoxical situation since it is the very translation requirements introduced by the Contracting States, allegedly in the interests of these enterprises, that are making it increasingly difficult for them to use the European patent system for reasons of cost. This calls for an analysis of the real practical significance of the required translations for the innovation process, competition and the enforcement of rights.

In practical terms the additional cost to patent applicants in Europe as a result of translation requirements (at the moment probably totalling just under DEM 400 million a year) is justifiable only if the translations really do help to promote innovation and competitiveness in European industry. This would be the case particularly if the classic functions of the patent, such as the provision of protection and information, could only be performed in the Contracting States if there were a translation of the European patent in the language of the country in question.

25 Finland is contemplating accession to the EPC in 1995 and Iceland in 1997. Norway has expressed renewed interest in membership of the European Patent Organisation.

The provision of protection by a patent depends on its extent of protection being determined. For European patents this is governed by Article 69 EPC and the Protocol on the Interpretation of Article 69, which state that the extent of protection is determined by the terms of the claims, and the patent specification is to be used to interpret the claims. The authentic text in any proceedings before the European Patent Office and in any Contracting State is normally the text of the claims in the language of the proceedings (Art. 70[1] EPC). The translation filed for the purposes of the existing translation requirements therefore has no other significance, legally, when determining the extent of protection than a translation to be submitted under the relevant regulations of the Contracting States when taking legal action to enforce claims based on the patent in an individual case²⁶. Bearing in mind that only a tiny proportion of all European patents are the subject of infringement proceedings, the requirements for the general filing of a translation of the European patent specification are definitely not justifiable in this respect.

But even given that mere knowledge of the existence and scope of an industrial property right makes it possible for third parties to respect it and is normally the basis for making claims for damages (based on wrongdoing), current practice in the matter of translation is difficult to justify, at least for the States in which one of the languages of the proceedings at the EPO is an official language.

This becomes clear if it is remembered that the claims of a European patent are generally in a language which is an official language in 10 out of the 17 current Contracting States (Art. 14[7] EPC). Bearing in mind also the different proportions of designations in respect of the individual Contracting States, it emerges that around two-thirds of all European patent specifications contain claims drafted in one of the official languages of the Contracting State for which the patent is granted.²⁷ Furthermore, through the languages of the proceedings at the EPO, i.e. English, French and German, relevant members of the public who have an interest in patents are now reached even in European countries where these do not rank among the official languages.

26 The special case in Article 70(3) EPC will be disregarded in this context.

27 Cf. EPO Annual Report 1991 - out of a total of 181 971 designations in the European patents granted in 1991, 120 392 were for States in which English, French or German is an official language.

There is still the question of the extent to which access to the text of the description, other than the claims, is of practical relevance in this context. Where the claims already give a clear picture of the subject-matter protected by the patent, recourse to the description is unnecessary. Where that is not the case, however, the services of a patent attorney or other patent expert will almost always be required to assess the extent of protection. The experts will, however, generally look at the text in the language of the proceedings, which alone determines the scope of protection of the patent according to Article 70(1) EPC. This also explains why the translations of European patent specifications filed at the national Offices are so little in demand in practice.

In terms of the information role of the patent, it is doubtful whether translations of European patent specifications are of practical significance. The patent specification plays no part in determining the prior art, if only because reference is generally made to the A document for this purpose; through this document the whole of the content of the application becomes prior art even if the subject-matter of the application is restricted and parts of the description deleted in the course of the procedure up to grant. Since over 90% of European patent applications are based on a prior national application, the prior art search will generally include the prior published applications as well. That may be interesting, especially if the prior application was not published in the language of the proceedings selected before the EPO.

If the translation of the European patent specification has, at most, a subordinate role in determining the relevant prior art, however, it is questionable whether the need to build up relevant national documentation or data bases justifies the burden placed on European patent applicants for this purpose.

Assignment of the European patent

According to the structure of the Convention, in the designated Contracting States the European patent is normally subject to the same conditions as a national patent granted by that State (Art. 2[2] EPC). This applies also to the transfer of ownership of the European patent since the Convention does not specify otherwise in this respect, there being no rule in respect of European patents as granted corresponding to Article 72 EPC which, for the assignment of the European patent application, sets out independent,

standard requirements that take precedence over national regulations to that effect (Art. 74 EPC).

This means that, unlike with European patent applications²⁸, the registration of transfers in the case of patents, as made by the EPO on request during the opposition period or during opposition or opposition appeal proceedings in accordance with Rule 61 in conjunction with Rule 20(1) EPC, basically has no effect in the Contracting States. In practice this is unsatisfactory because, in such cases, the transfer of the patent not only has to be entered in the Register of European Patents but generally in the registers of the designated Contracting States as well.

In the interests of the patent proprietors concerned, some of the Contracting States²⁹ have evolved pragmatic procedures for such cases and, for the purposes of keeping the national registers, recognise registrations of transfers entered in the Register of European Patents on the basis of Rule 61 in conjunction with Rule 20 EPC. It is to be hoped that this practice will also become established wherever national registration of transfer is required even when evidence meeting the national requirements has already been produced to the EPO.

Representation

As indicated above, the central European patent grant procedure does not release the applicant from his obligation to take certain action before the patent authorities of the Contracting States at the start of, during and after the European procedure. In this context, the differing rules and regulations on representation before these bodies may also be very significant for European applicants.

For example, in Belgium, Luxembourg, Austria, Spain and Portugal a representative has to be appointed to file translations of the claims or the European patent specification if the applicant or patent proprietor has neither a place of residence nor a place of business in the State in question. This is also mandatory for the payment of renewal fees in Belgium, Spain and Portugal.

28 Registrations of transfers based on assignments must, as a rule, be recognised by the Contracting States here and taken as a basis for the ensuing national procedure (cf. Decision of the Appeal Division of the Austrian Patent Office dated 13 December 1983, OJ EPO 1984, 276).

29 Switzerland, Liechtenstein, Denmark, Sweden, France, Monaco, and evidently Spain and Portugal as well.

Although these rules may be perfectly in keeping with the national legal tradition that has evolved on the basis of Article 2(3) of the Paris Convention for the Protection of Industrial Property, there are certain misgivings about their application in the context of the European patent system³⁰. This applies in particular when non-compliance with national representation requirements is associated with sanctions which the Convention allows only where the conditions definitively referred to there prevail.

For example, Belgium, Spain and Portugal stipulate that the filing of a translation required under national law in accordance with Article 65(1) EPC, other than through a national representative, is invalid and therefore the effects of the European patent are deemed to be void *ab initio* in that State. Article 65(3) EPC does not provide a basis for such a ruling.

It is also doubtful whether such representation requirements can actually be objectively justified nowadays in a system for the grant and administration of patents with transnational effect such as has been created for Europe with the Convention and its links with the national law of the Contracting States. It must also be remembered that the national legal systems of the Contracting States and the EPC have now grown together to form a system which is one, despite its decentralised components. The degree of harmonisation achieved in Europe in the area of patent law has also led to a considerable approximation of procedural-law structures, which makes it possible to dispense with the requirement to appoint a national representative, at least for routine actions such as the payment of renewal fees or the filing of prescribed translations³¹.

Most Contracting States take account of this fact and dispense with the appointment of a representative in such cases. In the few States where these conditions do not as yet prevail, the representative appointed to act in the grant procedure before the EPO should at least be entitled to act before the national authorities on those matters that generally have to be dealt with at the interfaces between the EPC and the national legal systems or that serve to maintain the European patent.

30 This may not be the case where such actions involve special procedures before the national authorities (restitutio in integrum, reminder of non-payment, etc.).

31 Cf. point 2 of the 1983 Resolution of the Administrative Council on the harmonisation of certain provisions of the patent laws of the Contracting States of the European Patent Organisation, loc. cit.

A ruling of this kind would also have the advantage of dispelling misgivings about some Contracting States' rules on representation in the light of EC legislation (Article 59 EEC Treaty).

This brings to mind the European Court of Justice judgment of 25 July 1991 in the Säger/Dennemeyer case³². There the Court had to examine whether the monitoring of patents (ensuring compliance with time limits, payment of fees, etc.), carried out in the context of business activities, can be reserved for the members of a specific profession in the light of Article 59 EEC Treaty.

In this context the Court of Justice again stressed that the freedom to provide services - a basic tenet of the EEC Treaty - may be restricted by national regulations only if this is absolutely justified in terms of the public interest. In so ruling, the Court emphasised that this applies only in so far as account has not already been taken of the public interest by legislative provisions to which the provider of the service is subject in the Member State in which he is resident. It is remarkable that the Court found that this also applies to rules defining professions that may restrict the freedom to provide services (concealed discrimination). This establishes the principle that, in cases of doubt, the rules applicable in the country of origin are to be recognised as equivalent; it also creates a further precedent which interprets the original ban on discrimination (national treatment principle) as a ban on restrictions and surmounts restrictions on the freedom to provide services wherever they are not absolutely necessary to protect the public interest.

Although the Court did not explicitly comment on the subject of national representatives in this decision, it is more than doubtful whether the appointment of a national representative as stipulated by some Contracting States for the payment of renewal fees can be upheld in the light of this precedent. The same is likely to be true of the representation requirements prescribed by a few States for the filing of translations of the patent claims and the European patent specification.

It cannot be ruled out that as the ban on discrimination continues to evolve towards a ban on restrictions of access, and with the transition from the destination principle to the origin principle in the Single European Market, in the long term there may well cease to be any justification for the national representative as we know him.

³² GRUR Int. 1991, 807.

International searches and examinations and reciprocity

C. Jones (GB)

In EPI Information 2/1992 pages 8 and 31 and 4/1992 page 24, there were references to the above subject which have been repeated elsewhere. In EPI Information 2/1993 at page 97 it is stated that International Searches and Preliminary Examinations for US and Japanese Applications can be made by the EPO. It is said that reciprocity is sought from the USPTO. I should be interested to know precisely what reciprocity is sought and who wants it? I have already written to two EPI Council Members with these questions but they have not replied (which makes me wonder whether they represent EPI Members).

Reciprocity already exists in as much as European Patent Attorneys may represent Applicants from USA and Japan before the European Patent Office as searching or examining authority if the Applicants choose to appoint them. They would also have the right to represent their own clients, who they represent before the Receiving Office, also before the USPTO as searching or examining authority (if appointed).

Is Council only concerned with those cases when the EPO is the Receiving Office or also in those cases in which all the National Offices of the EPC countries are the Receiving Offices? According to information published in PCT Gazette 06/93, in 1992 the EPO was Receiving Office for 2956 International Applications, whereas the EPC National Offices were Receiving Offices for 7061 International Applications. If the reciprocity is to include International Applications filed at the National Offices, then agreement from the National Offices will also be required if the USPTO is to be a competent International Authority for those Offices.

What really interests me is why anyone should prefer the US Patent Office to be a searching or examining authority rather than the EPO. Perhaps there is an advantage, particularly a cost advantage, if the USPTO is a designated office but the EPO is not. Does this happen very often? I would have thought not.

Rules establishing jurisdiction of the EPO cannot be part of the Implementing Regulations to the EPC

Hans Raible (DE)

Rule 60(2) sentence 2 of the Implementing Regulations to the EPC says:

»(The opposition proceedings may also be continued by the European Patent Office) when the opposition is withdrawn.«

The meaning of this has been discussed in this journal: In EPI-Information 1/1993, 40-51, the author explained why, in his opinion, this rule cannot give jurisdiction to the EPO to continue opposition proceedings after an oppo was withdrawn. This was put into question by J. L. Steenbeek in EPI-Information 2/1993, 111-113, based on art. 164 EPC.

As far as appeals are concerned, the question is settled now by two decisions G 7/91 and G 8/91 (OJ EPO 1993, 346-360) of the Enlarged Board of Appeal (EBA): If the opponent is the appellant, and he withdraws his appeal, that is the end of the matter, and »exclusive jurisdiction« for questions of validity instantly passes to the national courts as stipulated in art. VD of the 1978 Protocol to the Brussels Convention on Jurisdiction of 1968:

»Without prejudice to the jurisdiction of the EPO under the EPC, the courts of each Contracting State shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any EP granted for that state ...*.«

Thus, the EPO cannot continue oppo proceedings of its own motion when an oppo is withdrawn in the appeal stage.

It is submitted that there is no legal basis, either, for continuing an opposition before the Opposition Division (OPPO DIV) after it was withdrawn by the opponent.

* EPH, chapter 74.2. This article amends art. 16(4) of the Brussels Convention. Its language is dark, but its meaning is clear: Either it is in the EPC; then the EPO has exclusive jurisdiction in oppo proceedings. Or it is not in the EPC; then the courts of the contracting states have exclusive jurisdiction for questions concerning validity of EPs. - In technical terms, this is called a conflicts rule (Deutsch: Kollisionsnorm).

The purpose of the Implementing Regulations to the EPC is to implement regulations contained in the EPC. Administrative detail in the rules can be changed by the Administrative Council whereas the EPC itself can be amended by the member states only.

Good examples are to be found in articles 99(3), 105 and 106(2) EPC. All confer jurisdiction on the EPO for specific oppo situations:

Art. 99(3): The EP has lapsed for all designated states. Yet the EPO obtains jurisdiction if an oppo is lodged.

Art. 106(2): The same for the appeal stage: An appeal may be filed after the EP has lapsed entirely. The EPO retains jurisdiction.

Art. 105: A third party may intervene - on certain conditions - after the end of the oppo period, and the third party then obtains the full status of an opponent, maintaining jurisdiction of the EPO even if the original opponent later withdraws his opposition.

These regulations are implemented in the rules:

Rule 60(1) implements what happens when the EP lapses in the course of an opposition: A request has to be made within two months. If this is done, the opposition may be continued. This applies both to the proceedings before the OPPO DIV and to the appeal stage, and it is clearly based on articles 99(3) and 106(2).

Rules 55 and 56 lay down what is needed and r. 57(4) what is not needed in the case of a third party intervention. This implements art. 105.

Rule 60(2) sentence 1 says what the EPO shall do when an opponent dies. The EPO continues the - existing - opposition on its own (in order not to delay proceedings too much). However, it cannot go beyond what the opponent requested. The existing opposition still sets the framework for any activities of the EPO. This was also recognized by the EBA in G 9/91 (OJ EPO 1993, 408-420): »The competence of the patent office to deal with the patent depends on the action taken by the opponent.« (For »competence« read »jurisdiction«.)

All these rules implement articles of the EPC, and jurisdiction is conferred upon the EPO by the articles of the EPC, not by the Implementing Regulations, in accordance with the conflicts rule contained in art. VD of the cited Protocol.

Rule 60(2) sentence 2 is an exception. It says that the oppo proceedings may be continued by the EPO after the oppo is withdrawn.

Such a rule would be in order if the EPC contained an article saying that the EPO shall have a public prosecutor who, of his own motion, may oppose EPs that in his opinion are not valid. Such a public prosecutor would then, a fortiori, also have the power to continue abandoned oppositions, and such ancillary questions could therefore be implemented in the rules if a corresponding article existed.

However, there is no such article in the EPC that would or could be implemented by r. 60(2) sentence 2. This rule, if valid, would confer jurisdiction upon the EPO to begin amendment proceedings: An opposition without an opponent automatically becomes an amendment proceeding since the OPPO DIV cannot be both public prosecutor and impartial judge at the same time.**

A comparison of the EPC and the CPC shows that - quite regrettably - the EPC does not provide for amendment proceedings. Therefore, r. 60(2) sentence 2 has no basis in the EPC and cannot confer jurisdiction upon the EPO after an oppo was withdrawn. To create a new jurisdiction for the EPO clearly is outside the scope of implementing regulations.

It would no doubt have been within the powers of the contracting states to install amendment proceedings within the EPC, and in retrospect, one very much regrets that this was not done. The EPO would be much better qualified to do this than most national offices, being an efficient and mo-

** In T 197/88 (OJ EPO 1989, 412-414), the opposition was withdrawn, before the decision of the OPPO DIV, on November 5, 1986. Therefore, the oppo ceased to exist, and third party interventions (art. 105 EPC) became impossible from that day on. The applicants appealed on March 15, 1988 because they wanted to amend their EP, and TBA 3.3.2 decided on August 2, 1988 that the oppo proceedings should be continued under rule 60(2).

Quaere:

- If an abandoned opposition is continued under r. 60(2), does third party intervention then become possible again?
- Will such an intervention fulfill the demands of art. 105 of »intervening in the opposition proceedings«?
- Will successful intervention in such cases convert what are in fact amendment proceedings back into full-fledged oppo proceedings, replacing one opponent by another after an interregnum of almost two years?

Decision G4/91 »Intervention/Dolezych II« (OJ EPO 1993, 339-345), should be considered when trying to answer these questions. The answers are also pertinent under art. 164(2) EPC.

dern patent office with excellent experts in most arts. However, amendment proceedings were not provided for, and therefore, withdrawing an opposition before the OPPO DIV automatically and instantly terminates the jurisdiction of the EPO, and the national courts obtain exclusive jurisdiction for all questions concerning validity of the EP. This, incidentally, has nothing to do with the Vienna Convention which cannot be used to repair errors or omissions in the drafting of a convention.

As to the Brussels Convention on Jurisdiction of 1968, this is a basic convention provided for in art. 220 of the Treaty of Rome, and it is the constitution of the court system within the EC. Therefore, it has to be amended every time a new court of law is created in the EC:

When the EPO was created, art. VD of the Protocol cited above had to be added to bring the EPO within the framework of the Brussels Convention and to give it jurisdiction in oppo proceedings, cf. *Micklethwaite* in CIPA, August/September 1979, 489-494 at 491.

When the CPC was drafted, special regulations had to be made likewise to bring the COPAC within the ambit of the Brussels Convention, cf. articles 66-70 CPC and articles 13-15 CPC Protocol on Litigation (EPH, chapters 66,1 and 66,2). These regulations are extremely complex.

The contracting states thus have to operate within the limits set by the Brussels Convention, and when these do not fit, they have to amend the Convention. This may either be done unanimously, cf. art. 57, first paragraph, of the Convention, or by »conventions on a particular matter« as provided in art. 25(2) of the Accession Convention of Denmark, Ireland and the UK. However, in each case, the respective convention will determine jurisdiction, not its implementing regulations.

This is quite comparable to an EP: The claims will determine scope, not the embodiments. Even if an embodiment is copied exactly, a patentee can do nothing if the claims of his EP fail to cover it. Likewise, any rule of the Implementing Regulations has to be »covered« by an article of the EPC, and if there is no coverage, the rule is inoperative, at least as far as jurisdiction is concerned.

Invitation to all EPI members re.: Rule 86

According to Rule 86 the applicant may amend his application of his own volition without the consent of the Examining Division only until the reply to the first communication from the Examining Division. After this time, voluntary amendments are, according to Rule 86(3), only permitted with the consent of the Examining Division.

The European Patent Practice Committee (EPPC) of the EPI would like to learn whether this Rule 86(3) has caused applicants or their representatives any difficulties or has even resulted in loss of rights.

All EPI members are therefore invited to inform the EPPC of such difficulties or loss of rights. By providing such information you will support the endeavours of the EPPC to liberalize Rule 86.

Please outline your case in a memorandum of *at most one page*, stating all *essential* details. This memorandum should be sent

by 31th December 1993 at the latest

to the EPPC of the EPI
 Mr. Felix A. Jenny
 Casinostrasse 4
 CH-4052 Basel

* * * * *

Einladung an alle EPI-Mitglieder betr. Regel 86

Gemäß Regel 86 kann der Anmelder von sich aus seine Anmeldung ohne Zustimmung der Prüfungsabteilung nur bis zur Erwiderung auf den ersten Prüfungsbescheid ändern. Nach diesem Zeitpunkt sind freiwillige Änderungen gemäß Regel 86(3) nur noch mit Zustimmung der Prüfungsabteilung gestattet.

Die Kommission für Europäische Patentpraxis (EPPC) des EPI möchte gerne wissen, ob die Regel 86(3) bisher für Anmelder oder ihre Vertreter zu Schwierigkeiten oder sogar zu Rechtsverlusten geführt hat.

Alle EPI-Mitglieder sind deshalb eingeladen, das EPPC über solche Schwierigkeiten oder Rechtsverluste zu informieren. Sie unterstützen damit die Bemühungen des EPPC, die Regel 86 zu liberalisieren.

Bitte schildern Sie Ihren Fall in einem Memorandum *von höchstens einer Seite* und geben Sie darin alle *wesentlichen* Einzelheiten an. Senden Sie dieses Memorandum bis

spätestens am 31. Dezember 1993

an das EPPC des EPI
 Herrn Felix A. Jenny
 Casinostrasse 4
 CH-4052 Basel

* * * * *

Invitation à tous les membres de l'EPI en ce qui concerne la Règle 86

Selon la Règle 86 le demandeur ne peut modifier la demande de sa propre initiative, sans autorisation de la Division d'Examen, que jusqu'à la réponse à la première notification de la Division d'Examen. Par la suite et conformément à la Règle 86(3) les modifications volontaires ne sont autorisées qu'avec l'accord de la Division d'Examen.

La Commission pour la Pratique du Brevet Européen (EPPC) de l'EPI souhaite savoir dans quelle mesure cette Règle 86(3) a pu créer des difficultés à des demandeurs ou à leurs mandataires ou même entraîner une perte de droits.

Dans ces conditions, les membres de l'EPI sont invités à informer la Commission EPPC de telles difficultés ou de pertes de droits. En fournissant de telles informations, vous facilitez les efforts de la Commission EPPC en vue de libéraliser la Règle 86.

Veuillez exposer la situation dans un mémoire *d'*au plus une* page*, en indiquant tous les détails *essentiels*. Ce mémoire doit être adressé

au plus tard le 31 Décembre 1993

à la Commission EPPC de l'EPI
 à l'attention de M. Felix A. Jenny
 Casinostrasse 4
 CH-4052 Bâle

The disadvantages of young candidates facing the EPO examination

G. Modiano (IT)

As is known there is a high number of German and British candidates which sit and pass the EPO examination (to become professional representatives), which probably will soon saturate the German and British market and will pose problems just by their continuously increasing number.

On the contrary, there is a need for more European Patent Attorneys (professional representatives) in certain countries, like Italy, Spain, Sweden, etc., also belonging to the EPC.

Up to the beginning of 1992, while there were 314 Germans who passed the Examination, only 17 Italians made it.

There were 208 British candidates who successfully sat the Examination, but only 6 Swedes and no Spanish candidates made it up to now, this last fact being only partly due to Spain having much more recently joined the EPC.

There were about 90 candidates from French speaking countries (France, part of Belgium, part of Switzerland) which successfully sat the exams, but none from Greece, Portugal, Denmark (but those countries joined the EPC only lately).

Notwithstanding all such and other attenuating circumstances, it is an unchallenged fact that the candidates coming from countries where the native language is not one of the working languages (English, German, French) have a passing rate which is almost ten times less than the passing rate which is shown by candidates coming from countries where the spoken language is either German or English or French.

Accordingly there is obviously something not fair in the way the Examination is organized for candidates not having German, English or French as a native language. Or, one can see it in another way: in order to get parity of chances, there has to be a disparity of conditions between candidates having German, English or French as a native language and the other ones; otherwise, the number of European Patent Attorneys having German, English or French as their native language will increase excessively,

and the number of European Patent Attorneys not having such languages as their native language will decrease excessively.

Although a disparity to get parity will ultimately be the best approach, there is a solution which now circulates and which may help all (even those having German, English or French as a native language).

In fact, as is known the Examination is made of four parts:

- a) drafting of the best claims in view of a sufficiently disclosed invention
- b) replying to an Official Examination Report
- c) preparing an opposition
- d) given a not small number of problematic situations, advising, through legal suggestions, a hypothetical client afflicted by said situations.

In one of such parts, i.e. in the preparation of an opposition, it is supposed that there are three different prior art references, hereafter indicated with M, N and P, each in a different language (German, French and English).

The proposal herewith made is the following: one of such papers, M, N or P, and only one, should be made available to the candidates in, optionally, any of the two other languages, provided the candidate who requests it belongs to one of the countries which do not have German, English or French as a national language.

There is another proposal which has been made by Alberto de Elzaburu which is also targeted towards reducing the knowledge of languages to two only, inasmuch as a candidate may receive for inst.

- document M in French and English,
- document N in French and German,
- document P in English and German.

In keeping with the argument that any European Patent Attorney should know at least three languages, in order to preserve an edge of advantage over for inst. American Patent Attorneys, the above proposals are only fair if such documents are made available, as said, only to candidates originating from countries not having German, French or English as a native or official language. In this way, beyond the knowledge of their national language, such candidates will be obliged to know other two ones. This three-language-knowledge will be the common rule, inasmuch as the same criteria will be applicable also to the candidates of countries having Eng-

lish, French or German as a native language. They also must know a total of three languages, one being their native one.

Otherwise, the EPO Examination will in reality consist of two Examinations, one for the substantive part of the profession, the other one for language knowledge.

Those who defended the reliance on prior art documents in the three working languages for all candidates argue that what is needed is a passive knowledge of the two other languages, where passive stands for the fact that one had neither to write nor to correctly read in such two other languages. But this is a misleading argument. If a prior art is pertinent, it is mostly so because it has paragraphs hidden in the text, where even a nuance can transform their contents into a novelty or inventive activity defeating weapon. If one does not know very well - much above the normal level of excellency - the related language, the fact that those advocating the inclusion of prior art documents in the three working languages call such knowledge a »passive one« will not help the poor candidate at all during the examination: he will readily feel that he has poor chances to pass the examination.

Over the years, we succeeded in improving such chances, but we only got really minor concessions.

So for instance, while it is true that each candidate can prepare his paper or answer the exam's queries in his native language, the candidates of countries not having French, English or German as their native language must read the questions in one of the above languages.

To some, this may only seem to be a minor effort; however, in reality, the questions not only expand over many many pages, but many questions are very sophisticated indeed, and often just a nuance in the interpretation prompts a correct or incorrect answer. For inst. in one of the questions set forth in a recent exam, the correct answer depended on the verb »must« rather than »can« or »might«. This is an example of how much the perfect knowledge of the nuances as well influence the outcome.

Furthermore, we succeeded in allowing the candidate to consult a dictionary. But this, which seemed to be a major concession, is just a cosmetic one: give anyone a dictionary of Japanese, even with the words written in Latin or English characters, and he will not even open such a dictionary if confronted with a text in Japanese (written in Latin or English characters).

In fact, if one does not know the language sufficiently well, the dictionary will not help.

We instead did not succeed in securing for candidates coming from countries not having German, English or French as a native language a supplementary time for sitting the exams, which seemed to be only fair. Those who opposed such different times contended that a disparity of treatment could not be envisaged, forgetting that the expedient was suggested to heal an inherently existing disparity.

I had recently the occasion to read the questions of paper D - i.e. the legal questions.

The paper D comprised *Part I*, with 11 - not easy - questions. They expanded over 6 pages. It further comprised *Part II*, which expanded over further 6 pages: it comprised four different unrelated questions, each highlighting a series of problems.

Half the marks available were awarded for the 11 questions, and half for part II. So it is clear that sufficiency could be reached only by attempting to solve at least a large part both of part I and of part II.

It takes over one hour to just read paper D once, including the time spent on focusing on the complex situations depicted, for which the best of the European Patent attorney, would spend a further number of hours, for consulting the law, the rules, the guidelines and the decisions.

The candidates were given - I believe - 4 hours to answer, and to include citations of applicable articles or rules, or decisions.

The factual complexity of the exam translated in a complex language. Now if one now refers to a candidate which does not have one of the working languages as a native language, the two difficulties, factual and language difficulties merge, giving raise to synergic effect afflicting such candidates.

In fact many times, when dealing with the Examination problems, there is a tendency to forget all the problems which burden *upstream* a candidate from countries not having English, German or French as a native language.

- (a) The candidates from countries which do not have French, German and English as their native language have to study all the Decisions of the Board of Appeal in a foreign language.
- (b) Most of the practical training, i.e. preparing claims, replies to Official Examination Reports, etc., has to be done in a language which is not their native one.

(c) Most commentaries, text books, etc., are not in their native language, etc.

The consequence is that all such candidates surely start from a level of serious disadvantage in comparison with the other candidates.

If all the above is taken into account, it appears that it amounts to a rude injustice to oblige such candidates to know three working languages rather than say two, in connection with at least one of which they deployed incommensurate efforts in order to be linguistically on a par with those candidates which, without any effort, are linguistically inherently excellent, and have had an ease of training.

This being said, a less fair proposal is to offer to all candidates, regardless of their country (and language) of origin the first solution here set forth (possibility of replacing one only of the prior arts, by the same paper in one of the two other languages) or the Elzaburu solution (each prior reference in two languages, with a mix of languages such that the knowledge of at least two working languages are always needed).

Those candidates coming from countries where the native language is one of the working languages, will have the advantage of needing to know only one further language, if the proposal to reduce to two the number of working languages the candidates must know is approved, which will again give them an edge, but an acceptable one.

In fact, this second language for native English, French and German speakers is already a third one for such candidates not having German, English or French as a native language. So if it is asked that each candidate from German, English or French speaking countries knows two languages, one being the native language, while requiring from those candidates which come from countries not having English, German or French as a native language, are implicitly obliged to know three languages (one being their native language) such candidates will still remain on a disadvantageous level but at least the rude injustice inherent to this disadvantage will be mitigated.

Among the arguments which have been set forth by those defending the need of knowledge of the three working languages, one can list the point made by them - as already stated - that a European Patent Attorney should always be able to retain an edge of multilingual advantage over the American Patent Attorneys. If the proposal passes, the attorneys coming from countries not having one of the working languages as a native language will

still retain this edge, since beyond their native language they will still know two further languages, thus ensuring the multilingual aspects of our profession.

Now, about the complexity of paper D, it is believed 99% of the best European Patent Attorneys belonging to any linguistic group may not have passed with good marks this examination, in view of the short time given to them.

It is to remember that most of the European Patent Attorneys entered the EPI under the transitional provisions (»grandfather« clause), an extremely low number of us had studied beforehand all the many details of the convention: for inst. few, I believe, knew, *inter alia*, whether the Examiner *must* or *might* accept certain amendments (*not implying new matter*) after the Communication under Rule 51 (4) has been issued (which was one of the many tricky questions). And still, since the number of errors statistically made by the old European Patent Attorneys are really small, this means that the excellency of a patent attorney may not necessarily be measurable by the number of questions of this kind he may be ready to answer offhand, comprising the citation of all the articles, the rules, the decisions, etc.

So it follows that even the complexity or perhaps the number of questions included in paper D should be attenuated, to reflect what occurs in the real world.

The European Qualifying Examination A fair proposal?

J. C. Boff (GB)

There appears to be some dissatisfaction with the pass rates in the European Qualifying Examination (EPI Information 2/1993, at pages 99-105 [see particularly the EPO proposals at pages 102-104]; at pages 140-145; and at pages 146-150).

Leaving aside the question of whether there is enough work to give employment to those currently acting as patent attorneys there is the additional question of a perceived geographical imbalance in the number of patent attorneys per country (EPI Information 2/1993 page 149).

To equate the number of patent attorneys per million inhabitants with the demand for patent attorneys services assumes an equal level of inventive activity in each Member State. This is clearly not the case as the most cursory examination of the EPO Annual Report 1992 would reveal (see Table 2.3).

If it is desired that the inventors of each Member State have an equality of access to patent attorneys in their own Member State then an approximate indication of ease of access is given by the number of applications per patent attorney: a high number of applications per attorney would indicate that on average each attorney is serving a high number of inventors and a low number would indicate that on average each attorney is serving a low number of inventors.

The following table, derived from the statistics given in the EPO Annual Report 1992, lists for each Member State, and for the Member States as a whole, the number of applications originating from that Member State, the number of patent attorneys, and the number of applications per patent attorney:

Country	Applications	Patent Attorneys	Applications/ Patent Attorney
LI	107	5	21,4
NL	2420	234	10,34
FR	4738	550	8,61
IT	2227	270	8,25
CH	2199	304	7,23
AT	546	81	6,74
DE	11474	1991	5,76
BE	560	103	5,44
EPC	29027	5507	5,27
LU	52	11	4,73
MC	12	3	4
SE	875	257	3,40
DK	342	110	3,11
IE	56	21	2,67
GB	3107	1205	2,58
ES	284	221	1,29
GR	20	85	0,24
PT	8	56	0,14

If equality of access for inventors to patent attorneys in the same Member State is desired, say to the average EPC figure, then it is clear that one must reduce the number of patent attorneys in the Member States having below the EPC average number of filings per patent attorney and increase the number of patent attorneys in the Member States having above the EPC average number of number of filings per patent attorney.

As the quickest way of achieving this desirable state of affairs I suggest that no candidates be accepted for the European Qualifying Examinations from each of Luxembourg, Monaco, Sweden, Denmark, Ireland, United Kingdom, Spain, Greece, and Portugal until such time as their ratio of applications to patent attorneys reaches the average figure of 5.27 shown in the Table. This could take a long time for Portugal where at 1992 filing rates the »fair« number of patent attorneys would be 1.4.

Equally all applicants who are capable of signing their name from each of Liechtenstein, Netherlands, France, Italy, Switzerland, Austria, Germany and Belgium should automatically be allowed onto the list of professional representatives before the European Patent Office until such time as their ratio of applications to patent attorneys reaches 5.27. For Liechtenstein this would require just 15.30 candidates, for Netherlands it would require a near doubling of the size of the profession.

By this simple expedient fairness of access would be guaranteed to all inventors.

Another suggestion to equalise the applicant to patent attorney ratio is to compel one's compatriots to make or not make inventions as appropriate.

It is a fact of life that the demand for patent attorney's services varies from country to country and even within countries. The same applies for all professions - there are not many bullfighters in the United Kingdom, nor deep-sea fishermen in Austria - the demand for cricket bat makers in Italy is particularly low. No one suggests State aid or preferential treatment in the case of those activities.

Dissatisfaction with the relative pass rates for each country in the European Qualifying Examination is however justified. This is not the fault of the European Qualifying Examination (although I for one would favour scrapping the language requirement) Mr. Denerley at pages 141-145 of EPI Information correctly points out that the reason for failure in most cases is due to insufficient or inadequate preparation. The profession in each Member State should reflect on whether their relative pass rates are due to

the quality of the candidates, the quality of the candidates' teachers (whether employers or academic teachers), or such other factors as the size of the profession in the Member State concerned (with the increased possibilities of contact with other patent attorneys that large size provides).

If nationalistic murmurings of discontent are about at least let them be well informed nationalistic murmurings.

Reform of the European Qualifying Examination

B. Cronin (GB)

Action is underway to bring proposals for basic reform of the European Qualifying Examination before the Administrative Council, and our President has called for members to express their views.

In my opinion, four main lines of reform are needed.

1. Statement of Purpose

In the first place, I suggest the examination regulations be amended to contain a statement of purpose. The present regulations have empowered the Board to run the exam in a manner which finds widespread support in the profession, namely to prevent those who do not demonstrate certain abilities under the exam conditions from being »let free upon the public« to practice under the title European Patent Attorney.

The philosophy with which the exam is run needs to be brought in line with the title European *Qualifying* Examination and with the Office's declared long-term policy on training. My suggestion is that something along the following lines be written into the regulations:

The examination has been established as part of the Organisation's policy to promote professional training of European Patent Attorneys in all member states.

The purpose of the examination is to test whether candidates have a good knowledge of European patent law and have reached a level of competence showing they can act as professional representatives before the European Patent Office.

The Board and the Examining Committees shall cooperate with all parties concerned in all aspects relating to preparation and training of candidates for the examination, and shall publish information to assist candidates and trainers.

Subject to obligations regarding secrecy (under Article 22, in relation to the papers submitted by candidates and any internal deliberations; also in relation to the content of future papers) members of the Board and of the Examining Committees are encouraged to participate in activities relating to preparation and training of candidates for the examination.

The Board and the Examining Committees shall provide candidates with indications in what respects their answers were considered insufficient.

The Board and the Examiners have done an excellent job under the existing regulations, but have been unjustly criticised. It has never been their task to set the policy and purpose of the exam, but to run the exam under the regulations laid down. It is high time for the policy makers to give proper instructions, in line with the policies of the Organisation, to those with the task of running the exam.

2. Opening Membership of the EPI to Trainees

The second main reform concerns not the examination regulation as such, but the status of examination candidates, or rather their lack of status, within the European Patent Organisation. When the EPI was set up, membership was restricted to persons on the list. Trainees were excluded. That was not a problem at the time, but has become a factor that has handicapped training especially in the less privileged countries, thus reinforcing undesirable differences in training opportunities between the member states.

Is it by coincidence that the country with the best pass rate in the European exam has a well-tried training system run principally by the student members?

Can the EPI afford to let its future members be more-or-less well trained according to national affiliations, and can the EPO continue to tolerate this against its long-term training policy?

The responsibility for achieving professional competence lies with the individual trainees themselves. Trainees should be encouraged to assume this responsibility as soon as possible, when they enter the profession. They should furthermore be welcomed into the European profession and encouraged to take part in its activities, especially those related to training.

I therefore propose that the Regulations of the Institute be modified to create a class of membership for trainees. Here are a few suggestions, leaving details to be worked out:

Trainee membership should be voluntary. Perhaps, after a trial period, trainee membership could be made compulsory as a condition for enrollment to the exam.

Revenue from an annual fee of, say, DM 100.-, should be allocated entirely towards funding tutorials and other training activities.

Trainee members should be encouraged to participate in the organisation of their own training (like the UK »informals« - the CEIPI/EPI decentralised groups and the EPI tutorial groups already constitute a European-wide network).

Trainee members would not have full voting rights but should be able to elect representatives to the professional qualification committee, perhaps as observers like those from the examining board/committees. Trainee members should vote as a single European body and should not be organised into national groups, because national groups tend to promote or maintain national differences.

Trainee members should be authorised to use a title, for instance »Trainee European Patent Attorney«.

Trainee members should be covered by the Code of Conduct.

Hopefully, this second reform would lead to a consolidation of training and an improvement in the examination system in the short and medium term. In addition, in the long term, it ought to improve the Institute itself.

In its 15 years existence, the EPI has not done much for most of its members. Conversely, not many members have done much for the EPI. Surely, however, the relationship between the EPI and its members is bound to become better if, in the future, trainees are brought into the Institute and are able to participate as members of the Institute during their training period of 3 to 6 years or more.

With this proposed reform, the future of the Institute is at stake.

3. Conversion to a Modular Examination

The third basic reform is to make the exam modular, not keep the »monolithic« exam and add a pre-registration test. Reforming the examination is not an easy job. To be effective, any reforms to the examination at the present time need to meet the following criteria:

- no increase in administrative cost or difficulty
- no increase in work for the examiners
- contribute to efficient training
- promote »high« professional standards
- fairness to candidates.

A modular exam, where candidates could take one or two papers at a time, if they wish, meets these criteria without great disturbance to the content of the exams. Based on experience with the present partial pass system, it should not be too difficult to convert to a more flexible system. There are several benefits to be gained from a modular exam.

The existing examination papers (which are not as bad as some critics think) can be maintained with a few easy-to-implement simplifications, e.g. as set out below. This is in line with point 1 of the PQC's motion to the EPI Council.

The enrollment fee can be adjusted (e.g. DM 300.- per single paper; DM 550.- for two; DM 700.- for three; DM 800.- for all four papers taken together). This would mean extra income for the EPO without extra work, which seems to meet its main concern. On the other hand, the proposed pre-enrollment test at DM 300.- would involve a lot of work setting it up. Either it would be a stiff eliminating test, meaning unnecessary extra work and training for the candidates, or would not eliminate many candidates and therefore serve no useful purpose.

The modular exam would reduce the burden on examiners by eliminating re-marking candidates' entire papers several years in a row. This is particularly important given the increasing numbers of candidates and the present pass rate. In days gone by, the smaller number of candidates could not justify a modular exam. This is no longer the case.

From the training perspective, candidates would be able to concentrate their preparation on one or two papers at a time, and achieve a good level in each subject, which will make the Examiners' task easier. This training aspect is all-the-more important now the qualifying period has been reduced to 3 years, making preparation for the »monolithic« exam more difficult.

Another aspect of a modular exam, not to be neglected, is that a decision on qualification is needed only after the full cycle of papers has been completed. This could simplify the decision-taking process, perhaps even further reducing the likelihood of an appeal and, hopefully, speed up the an-

nouncement of the exam results. The present system takes much too long, to the detriment of the training of »failed« candidates.

Having made the exam easier to prepare for and easier to pass in several sittings, would it be desirable to set a higher pass level for individual papers? I think not. A pass grade (4) certainly does not represent high quality professional work, but passing the exam should be regarded as a step in professional development, not a culminating point. Practically all candidates who take the exam derive benefit from what they learn in preparation, and continue their training after passing. Many participate as tutors or help training their colleagues etc.

Maintaining the 4 pass grade for papers taken alone could perhaps be associated with stricter compensation, e.g. only one 5 grade could be compensated by a maximum of, say, 15 for the four papers.

Of course, many details would have to be worked out, but this should be well worth the effort in terms of the probable saving in the examiners' marking time, the advantages for most candidates in their training, and the hoped-for better image of a system that should produce less failures.

4. Modification of the Existing Papers A, B, C, D

The fourth line of reform is that the individual papers require some modification. But really not a great deal of change seems necessary. Here are some comments on the individual papers:

(A) Paper A can be maintained without change. But the definition in Article 10(2)(a) of the regulation is obsolete and misleading (»on the basis of such information as is normally available...«). This could be amended to »on the basis of instructions provided by a client, including a description of an invention and prior art«.

Future simplification of paper A could be along the lines of the US exam: by indicating to the candidates the gist and the number of claims to be drafted. This provides an adequate test and is easier to mark.

(B) The task in Paper B should be redefined as »The preparing of a reply to an official letter in which prior art has been cited, on the basis of instructions given by a client«. The present format of paper B is unfair to candidates and difficult-to-mark by the Examiners because it leaves the candidates with too much freedom to produce their own creative answers. The client should give clear instructions as to which remnant aspect(s) he wants protected. The candidate/representative's job

should be to implement these instructions. This is none-the-less a test of ability, and marking would become easier.

- (C) Paper C has been »overlegalised« in contravention of Article 10(2)(c) and (3), which state clearly that the content of paper C is drafting of a notice of opposition. »Other items to be tested«, i.e. legal questions, ought to be covered in other papers, namely in paper D. Therefore, no change in the rule is required, but paper C should be realigned to what it was supposed to be, a test on drafting a notice of opposition with less legal trick points. With the present format, candidates well prepared on legal can pass paper C with a poor notice of opposition, which is not the aim of the exam. Removing most of the legal tricks would not lead to an easy exam: it would uncover the weakness in arguing lack of patentability that is sufficient for the present exam, and instead would require the candidates to be better prepared to argue lack of patentability. This should lead to improved training in this vital area, and will be for the good of the system.
- (D) Contrary to the EPO's short-term measure 4, I do not think paper D's content needs to be changed in its structure. The maximum points allocated should also be indicated for each segment of Part II, where the absence of mark allocation is more critical than in Part I. To alleviate preparation for paper D, consideration should be given to providing candidates with the annual review, for the previous two years, of the Board's decisions published with No. 6 of the Official Journal. This presents no organisational problem: there must be hundreds of spare copies; if not, candidates could bring their own. Another possibility would be to consider making Part I and Part II of paper D modular. Under the present rules, many candidates do poorly on Part II and some nevertheless succeed. In working out the details to make the whole exam modular, it would be worth considering allowing a partial pass on Part I of paper D (e.g. 30+ marks) so the candidate would only have to re-sit part II. This would decrease the difficulties facing the candidates in their preparation, reduce the examiners' work, and contribute to training and the maintenance of professional standards. Candidates who have already shown they can do well with the short questions would learn a lot by specially preparing for Part II of Paper D.

The Part I questions, taken alone, would be a good test which could serve as the proposed pre-registration test. If the EPO is really minded to introduce such a test, it could be Part I of paper D.

Otherwise, a recommendable improvement to place the candidates under less time pressure would be simply to reduce the number of legal points covered in each of Part I and Part II of paper D, as would reducing the amount of subject matter that needs to be covered in papers A, B and C.

In addition, Article 10 of the regulation should include a general guideline for the practical papers, in line with the actual situation, in order to highlight what is required in the exam:

Papers A, B and C shall test the candidate's ability to obtain the best protection/result that is compatible with the facts and instructions given, and complies with all official requirements.

This is nothing new, but much of the difficulty candidates experience with these papers of the exam comes from the simple fact that in their jobs they are not faced with situations which *simultaneously* bring out these three aspects: obtaining the maximum protection/result - being confined to given facts/instructions - and ultra compliance with official requirements.

This artificial situation makes special training necessary to obtain the best possible result in the exam. Such training is at the same time very beneficial for the development of professional skills, by compensating for what may not come up in the everyday work of most trainees. Dealing simultaneously with these three aspects constitutes the crux of the examination in its present form and makes it a valuable training tool to achieve professional competence.

5. Summary

The above-outlined four main lines of reform go hand-in-hand and would enable a satisfactory overhaul of the examination system with relatively little disturbance to the existing examination papers. These reforms can all be implemented in the short term and should produce short and long term benefits in line with the Office's long term policy.

The examination system should cease to be regarded as an elimination system, but regarded as part of an ongoing training program. Once a candidate has reached a reasonable level of competence it can safely be assumed he/she will continue to improve. Most will reach a »cruising«

level of high professional competence a few years after having passed the exam.

In our profession, it's difficult to achieve a consensus on matters like this. Nevertheless, I hope that after gathering the members' views, our council will see fit to present to the Office, for submission to the Administrative Council, a comprehensive proposal for basic but easy-to-implement reforms designed to remove the defects that have been bringing the examination system into discredit and making it unnecessarily costly to administer. When presenting such a proposal, our council could point out that the examination system, despite its defects, has been successful in leading to the setting up of training schemes where none existed, and to the qualification of members from countries where previously no training or examination existed. Those who have taken the exam - passes and »failures« alike - have learnt a lot about the European Patent System they wouldn't have learnt otherwise, as have the »grandfathers« with the task of training them, which in many cases meant learning from the trainees. Our profession can be proud of the new generation of European Patent Attorneys qualified by the examination. The number of candidates that pass is perhaps not satisfactory when expressed as a percentage, but the ever-growing absolute number of passes forms an impressive body of trainers across Europe training the next generation, and is growing like a snowball.

The more trainees who pass the exam, the better our profession will become. I hope the above suggestions will help towards this.

Letters to the Editor

Corrections of European Patent Applications

Opinion G3/89 and Decision G11/91 of the Enlarged Board seem to rule out the possibility of adding subject matter by way of correction of the description, claims and drawings. Nevertheless, the Enlarged Board specifically leaves open the possibility of drawing upon the disclosure in a document incorporated by reference, as material for substitution in the text or drawings, not merely as external evidence of the Author's intention. I wonder therefore if it would be advantageous for us to draft patent specifications always incorporating a paragraph such as the following:

»This invention was first disclosed in the Patent Application(s), mentioned in the Request for Grant, from which the present Application claims priority, and which is available to order from the European Patent Office. That first disclosure should be scrutinized wherever it differs materially from the present description, claims or drawings, in order to alert the reader to any possible error herein, including an error by omission, and to assist in deducing what was intended«.

With reference to the Guidelines for Examination, C.II.4.18, it would be advisable to file the priority document(s) with the initial Application, to be able to rely on their disclosure in matters relating to the invention.

I readily admit that this proposal is inelegant and is open to the charge of abusing the system, but would it not be worth trying?

R. P. Maury (GB)

Solon and the Second Medical Indication

The famous Greek lawyer and philosopher Solon taught a very intelligent but poor student and agreed to credit him the payment of the tuition fee if the student could show success after he finished his studies with Solon: If the student should win his first law suit, he would have to pay the tuition fee; should he, however, lose his first law suit, he apparently would not have been properly taught by Solon and need not to pay anything.

After the student's studies were completed, Solon sued his student for payment of the tuition fee: If Solon won the law suit, the student according to the judgement - would have to pay; according to the previous agreement with Solon, however, he need not pay, because he would have lost his first law suit; and vice versa. So: what should the judge decide?

Very similarly, the second medical indication can be interpreted. Let us set aside the case where the second medical indication depends on an earlier (prior right); in such a case, a cross, or a compulsory, license will most probably prevail.

Let us consider the case, where there is no (more) product protection, except perhaps a protection on the first (or any previous) medical indication. In this case, the distributor of the pharmaceutical according to the first (or any prior) medical indication - following the requirements of the Health Authorities - will have to indicate all side effects known to him, in other

words the second medical indication too, on the explanation sheets (Beipackzettel). However, based on the patent granted to his competitor on the second medical indication, this is exactly what his competitor could forbid him to do, because this would in essence mean an - even if hidden - publicity for the second medical indication.

Is this paradox similarly impossible to solve as in the Solon case? Contrary to Solon, however, in the second medical indication, there are topical problem cases which will have to find a solution.

K. Büchel (LI)

Examinations

What a fascinating contrast (EPI information 2/1993) between the thoughtful contributions by Mr. Denerley, M. Charpail, Mme. Thouret-Lemaître, and the E.P.I. Council, and the blatantly outrageous proposals of the EPO. No wonder the attempt was made to keep them confidential.

Given the various national pass rates, the simplest way of improving the rate overall would be to accept only candidates from the U.K. I am surprised so obvious an idea did not commend itself to the EPO. Candidates from France and Germany might perhaps enter a draw in which one would-be candidate in five got an entry ticket, so their numbers did not depress the overall figures too far. The rest would certainly be banned.

Any more unjust than the proposed three attempts and then the chop? Are the EPO unaware that this is people's *livelihoods* that are in question? They officially bewail failure of the professions in various different countries to produce enough newly qualified members to serve clients, yet make the one proposal that will ensure professions in countries with low pass rates never do grow.

I well remember the bitter resentment in the U.K. years ago when the Chartered institute merely limited sitting to every other year for candidates who had failed before. Yet what was that compared with this proposal?

Beside it the proposed preliminary test is nothing, even if it does have to be passed every year in the three months before enrolment for the main examination. Perhaps we will all have to jump through hoops as well, wearing paper frills folded from copies of the EPC. We can always while

away the time waiting for our turn by reading the sets of candidates answers proposed in place of proper examiners' reports.

W. R. Farwell (GB)

Accelerated Prosecution - »Seven Measures« in Practise One (?) example how it does not work

Since 1988 the European Patent Office operates the programme of »Seven Measures« designed to ensure quicker processing of European patent applications (Official Journal 12/91). In the following a case is described in which first the administrative handling within the EPO did not comply with the announcements of the EPO and second - after a lot of lost time - the examination devision unduly refused a method claim; a decision which prolongs the time for getting the patent as requested for a further year.

The application was filed in September 1989 within the EPO without claiming a priority. In view of license interest a request for accelerated search and examination together with a reasoned statement in writing was filed (Measure 1) in March 1990. The examination fee also was paid. Within eight months from the priority date the EPO prepared the European Search Report; a time period which complies with the intention of the EPO to provide the Search Report within nine months.

After one month (18 June 1990) the applicant filed amended claims together with a discussion of the prior art cited in the Search Report. In January 1991 (seven months after filing of the amendment), the EPO was asked by telephone concerning the whereabouts of the application. The EPO in The Hague informed the applicant that the docket inadvertently was not transferred to the Examination division, but the docket will leave The Hague immediately via Munich (date: 21 January 1991). At 19 March (two months later) the applicant asked again by telephone and got the information that the docket has left The Hague at 4 March (!) and is at the moment in the container, but not unpacked yet. One and a half month later the docket further was in the container and not unpacked. Four (!) months after the telephone call with the EPO in The Hague and two months after having received Munich, the responsible examiner informed the applicant by telephone that he has received now this case.

The first communication which reached the applicant a few days later now built up the hope that finally all thing will run quickly now. Five days after the communication applicant filed the reply on the communication (measure 6) together with a request for oral proceedings if the examiner feels unable to follow the arguments presented in the reply. The examiner had objected the category »method« in the claims 1 to 9. The application refers to an apparatus and a method for drying articles. The method did comprise activities in which the use of material products were implied with the essential features of positioning articles in a process chamber, generating a partial vacuum in a closed vacuum storage and instantaneously connecting said vacuum with the process chamber thereby generating an air blast across said article. In the opinion of the examining division the method claim had to be objected as being not clear (Art. 84 EPC) because the difference between the invention and the prior art cannot be described by steps of a method but only by constructional features.

Within the next month applicant received an invitation for oral proceedings. In several telephone conversations with the examiner applicant got the feeling that the opinion of the division would not change during the oral proceedings. Thus, a new amended method claim was filed together with the request for a decision according to the files. The request for oral proceedings was withdrawn. One month after the amendment the division settled a second communication further objecting the method claim and on 22 October 1991 applicant informed the Examination Division that he does not agree in granting only the apparatus claims. Five months later the decision to reject the application was made by the Examination Division consisting of one sheet under reference to the second communication.

Applicant filed immediately an appeal in April 1992 and on 21 May 1993 the Technical Board of Appeal remitted the case to the first instance with the order to grant a patent on the basis of a method claim which was already presented the Examiner in an auxiliary request and the apparatus claim. Five days later Rule 51(6) notice was send by the Examination Division.

Thus, this case needs more than 4 years with acceleration, 20 months between filing and the first communication and finally 1 year was lost in view of unjustified rejection of category »method« claim. Doubts in view of this acceleration program are opportune.

P. Klocke (DE)

The EPO - from bad to worse ?

I would like to comment on the above cited article which appeared in the June part on page 150 as follows:

Cost of the EPO

I am afraid that the article in EPI Information June 93, p. 150 - 152, »The EPO - from bad to worse?« is neither realistic nor quite fair:

If the author of that article suggests that US patent practice is more complex than EPC practice, then he forgets that the EPO has to deal with 3 official languages and a remarkable number of non-official languages. Did you ever find a U.S. Examiner speaking English, German, French, and even more languages? I feel that Europe has to pay a certain amount for its culture diversity.

Further, does the author of that article really believe, that the low procedural fees of the National Patent Offices cover the working time of the Examiners concerned with the respective cases? Did you ever find somebody in private practice doing a qualified prior art search for a few 100 £? Obviously, the National Patent Offices subsidize their procedural fees by patent annuities, whereas at least a part of those patents comes from EPO - without any prior expense for the National Patent Office.

According to my experience, if I include attorney fees in the costs for foreign applications, and exclude such fees for my direct filings with the EPO, then the EPO proceedings until grant cost basically the same as a filing in the U.S. or in Japan, namely about 7000...8000 CHF. Only after grant the EPO costs exceed dramatically the costs in the U.S. and Japan, because then the translations for the national filings must be done. For such translations in the average we have to add about another 9000 CHF per patent.

I therefore strongly suggest that all people participating in the EPO proceedings, and suffering from the high procedural costs, exert any possible influence upon their governments to abolish that unnecessary and costly requirement to file translations in the national languages. For anybody who is aware of the great ability of Dutch or Scandinavian people to understand English, or of Latin countries to understand French, it does not make any sense that patent owners are forced to spend a hell of a lot of money for translations into Spanish, Italian, Dutch, Swedish, and so on. English, French, and German would certainly be sufficient.

Thus, let us first blame our diplomats who introduced the translation requirements, before we blame the EPO - although I would certainly not object to any reduction of the fees of the EPO which neither I would consider to be low.

G. Lück (CH)

Spring exhibition of EPI-Artists 1994

K. Hoffmann (DE)

Vom 10. bis 30. März 1994 soll erneut eine EPI-Künstler-Frühjahrssausstellung im Hauptgebäude des EPA in München stattfinden. Voraussetzung ist eine Mindestbeteiligung von 10 Ausstellern. Bei Interesse an einer Teilnahme melden Sie sich bitte bis 29.10.1993 beim EPI-Generalsekretariat. (Siehe hierzu auch die nachfolgende ausführlichere englische Ankündigung.)

* * * * *

Une exposition de printemps des artistes de l'EPI aura lieu de nouveau du 10 au 30 mars 1994 dans le bâtiment principal de l'OEB à Munich. Une participation d'au moins 10 exposants est nécessaire. Les personnes intéressées sont priées d'en informer le Secrétariat Général avant le 29.10.1993. (Pour plus d'informations, voir le texte ci-après en anglais.)

* * * * *

The first exhibition of the EPI-artists opened on March 19, 1991 by the EPO President, Dr. Braendli, was a pleasant event and showed that there are artists also amongst the EPI representatives who can get an exhibition off the ground. Due to the election to the EPI Council, which takes place every 2 years, the second exhibition of the EPI-artists already planned for this spring had to be postponed. It is now to take place in spring 1994 from March 10 to March 30 in the main building of the European Patent Office in Munich. However, a prerequisite to presenting the exhibition is the participation of at least 10 EPI representatives.

The idea for the exhibition of EPI-artists stems from the summer exhibition of the EPO-artists. This exhibition already celebrated its 10th anniversary.

sary in 1993. The number of EPO-exhibitors tripled in this period. We very much hope that the EPI-exhibition develops in a similar manner.

Painting, graphical and fine art works are to form part of the exhibition. Initially, seven artists gave notice of their participation in the first EPI-exhibition. However, two colleagues unfortunately cried off at the last moment, presumably on account of the fear of problems with customs, which we do not expect this time.

Therefore, should you like to temporarily entrust the EPO for three weeks with your own artistic intellectual property in addition to European patent applications, **please contact the Secretariat of the EPI up to October 29, 1993**, so that one can determine as soon as possible whether the required number of participants is achieved and the exhibition can take place. Some colleagues have already given notice of their wish to participate.

Information concerning delivery and formalities to be followed can be obtained from the EPI General Secretariat (Tel.: 49 89 201 70 80, Fax: 49 89 202 15 48).

Deadline for EPI Information 4/1993

Our deadline for the next issue of EPI Information is *8 November 1993*. The documents for publication should have reached the General Secretariat by this date.

Redaktionsschluß für EPI Information 4/1993

Redaktionsschluß für die nächste EPI Information ist der 8. November 1993. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Generalsekretariat eingegangen sein.

Date de Remise des Documents pour
EPI Information 4/1993

La date limite de remise des documents pour le prochain numéro de EPI Information est le *8 novembre 1993*. Les textes destinés à la publication doivent être envoyés au Secrétariat Général ayant cette date.

Disciplinairrat und Ausschüsse		Commission de Discipline et autres Commissions		Ausschuß für Biotechnologie Erfindungen		Committee on Biotechnology Inventions Commission pour les inventions de Biotechnologie	
Geschäftsordnung By-Laws		EPI-Mitglieder EPI-Members Membres de l'EPI		SACEPO			
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