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Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets
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**Anzeigen • Advertisements • Publicité**

**Druck • Printing • Imprimeur**

**ISBN 3-452-23187-9**

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**Beilagehinweis:**
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# TABLE OF CONTENTS

**EDITORIAL** .......................................................... 90

**DISCIPLINE**


**COMMITTEE REPORTS**

Report of the EASY Working Group, by D. Speiser ........................................ 93

Report of EPPC Meeting of 14th June 1995, by R.J. Burt ................................. 93

**EUROPEAN QUALIFYING EXAMINATION**

Exam technique and tactics, by M. Herzog ....................................................... 95

EPI Students ................................................................................. 98

EPI Tutorial fee reduction for EPI Students ....................................................... 98

Vorbereitung auf die Europäische Eignungsprüfung 1996 (CH) ....................... 102

**EUROPEAN PATENT CONVENTION**

The Powers of the EPO Boards of Appeal in determining the Admissibility or Inadmissibility of Appeals, by B. Cronin ....................................................... 103

EPI Answer to the Request for Observations by the Enlarged Board of Appeal in case G2/94 ........................................................... 106

Exclusive Jurisdiction under the Brussels and Lugano Enforcement Conventions - A hidden poison Pill in the EPC, by H. Raible .................................................. 108

Chers Brevets, par S. Le Vaguèrese ................................................................. 115

**LETTERS TO THE EDITOR**

Res judicata effect of decisions in EPO opposition cases with regard to national revocation proceedings, by L.J. Steenbeek ................................................. 118

Former examiner’s reaction to the open letter of Mr. Funke to the President of the EPO, by P.W. Grubb ................................................................. 119

Loss in the mail of EPO notifications, by L. Bosotti ........................................... 120

**INFORMATION FROM THE SECRETARIAT**

EPI Excess Liability Insurance 1995/1996 ....................................................... 121

Deadline 4/1995 ........................................................................ 122

Personal .................................................................................. 122

Reissue of back copies of the Official Journal of the European Patent Office ................................................................. 122

Regulations implementing the European Patent Convention, Selection 1995 ........................................................................ 123
Editorial

This being the holiday season we on
the Editorial Board, having taken time
to reflect, recall that an eminent
predecessor used to write on impor-
tant matters from a retreat in Spain.
Despite being good Europeans, we
find ourselves somewhat further
afIELD. This year has seen the election
of a New Council of the Institute.
There will be much for them to do,
with the installation during their term
of a new President of the EPO and,
before that, a scheduled public hear-
ing in Munich, before the next Coun-
cil Meeting, on the subject of the
strategies of the EPO for the future.
As Members will be aware, those
strategies mention the profession.
The Institute is mixed, covering both
the employed and free professions,
but one thing we believe is sure is that
the best interests of business in
Europe will be served by a strong,
independent profession in every
country signatory to the Convention.
Also as all our Members are also
Members of National Associations,
local business will also be served best
by the continuance of National Of-
fices working perhaps in conjunction
with the EPO. No National Office will
mean that many SMEs will be barred
from the patent system in Europe, on
cost grounds at least. The “entry fee”
to the patent system is generally low-
est via a National application before
a “Euro” is filed.

It is time to return to the koala
watching in an antipodean field and
wish our readers a continued good
summer.

Jean Brullé · Joachim Herzog · Terry Johnson
Decision of the Disciplinary Committee of the Institute of Professional Representatives before the European Patent Office

Mr. XYZ
against
ABC and others

Disciplinary cases CD 5/94-12/94

Composition of the Chamber:

Mr. N. Waddleton: Chairman
Mr. G. Lehnert: Member (Rapporteur)
Mr. F. Charpail: Member
Mr. R. Pidgeon: Deputy Member

Language: English

The Chamber therefore strongly recommends that the Institute should issue further guidelines and recommendations on the matter of advertising. Pending such guidelines and recommendations the Chamber is of the opinion that members of the Institute should adopt a particularly careful and conservative behaviour in matters of advertising, not only in the international arena but also nationally, in situations where the status of Representative before the European Patent Office may be explicitly or implicitly relevant.

Under Article 20 of the Additional Rules of Procedure of the Disciplinary Committee of the EPI, the Chamber therefore recommends to the President of the Council of the Institute to publish the Decision, in whole or in part, without revealing the identity of the Professional Representatives concerned and the complainant.

Summary of the facts

The facts underlying a series of complaints from Mr. XYZ are the following:

CD 5/94. There is a box advertisement under the heading "Patent agents" on page XXX of the YYY Yellow Pages. There is a reference to "International" patents, but no reference to European patents.

CD 6/94. There is a box advertisement under the heading "Patent agents" on page XYX of the XYX Yellow Pages. The only reference to patents is "Charted Patent", which indicates that the persons complained against are only holding themselves out as chartered patent agents/attorneys, i.e. British agents/attorneys.

CD 7/94. There is a box advertisement under "Patent agents" on page XYX of the XYX Yellow Pages. There is the wording "Patents... worldwide", but there is no reference to European patents.

CD 8/94. There are box advertisements: under "Patent agents" on page XXY of the XYX Yellow Pages; under "Patent agents" on a page with no visible number of the XYY Yellow Pages; and under "Patent agents" on page XXX of the YYY Yellow Pages.

All the box advertisements refer to "intellectual property rights and litigation internationally". The first two box advertisements also indicate that the advertisers are "Chartered Patent Attorneys". There is no reference to
Reasons for the decision

The matter of advertisement by Members of the Institute is ruled by Article 1 of the Regulation on discipline for Professional Representatives.

The general principles of professional conduct are laid down in the Code of Conduct of the Institute. The Code of Conduct, as last updated on 5/11/85, reflects the latest view of the Council on these general principles (cfr. article 1(b) of the Code of Conduct). Article 2 of the Code of Conduct defines the general principles of professional conduct on the issue of advertisement.

However, from discussions with members of the Institute of different nationality, from different origin or with different background, it is clear that there is no uniform interpretation as to what extent the recommendations of article 2 of the Code of Conduct also relate to members when they advertise their national activity without explicitly referring to their membership of the Institute.

Particular reference is made in this respect to decisions CD 4/91 (published in EPI Information 3/93 p. 170) and CD 1/92 (published in EPI Information 4/93 p. 326), which reprimand advertisements involving specific reference to the title “European Patent Attorney”, but leave open the question whether advertisements by members of the Institute in which no specific reference is made to the title “European Patent Attorney”, would be considered proper practice.

Under these latter circumstances the Chamber feels it should not issue a negative decision on a conduct which indeed some of the members of the Institute seem to disapprove but others currently seem to consider normal practice.

Decision

In view of the above facts and reasons the Chamber decides in conformity with Article 4, and 6(2)a of the Regulation on Discipline, to dismiss the matter of the complaints of Mr. XYZ, and to recommend that the Institute issue further guidelines and recommendations on the matter of advertising by national professionals who are also representatives before the European Patent Office.

Under Article 20 of the Additional Rules of Procedure of the Disciplinary Committee of the EPI, the Chamber recommends to the President of the Council of the Institute to publish the Decision, in whole or in part, without revealing the identity of the professional representatives concerned and the complainant, unless they consent to be named.

Under Article 21 of the Regulation on Discipline and article 19(1) of the Additional Rules of Procedure, the complainant is to be informed of the result of the proceedings by being sent a copy of the decision.

The Chairman of the Chamber N. Waddleton
Date: 25 July 1995

European Patents. "Chartered Patent Attorneys" indicates that the persons complained against are only holding themselves out as British agents/attorneys.

CD 9/94. There is a box advertisement under “Patent agents” on page XXXX of the YXY Yellow Pages. The only reference to patents is in the wording “Chartered Patent Agents”. There is no reference to European patents.

CD 10/94. There is a box advertisement under “Patent agents” on page XXXY of the YXY Yellow Pages. There is a general reference to “patents, trade marks, design, copyright”. There is no reference to European patents.

CD 11/94. There is a box advertisement under “Patent agents” on page XXXX of the YXY Yellow Pages. The advertisement refers to “Registered Patent and Trade Mark Agents”, which the Chamber understands to be British registered patent and trade mark agents. There is no reference to European patents.

CD 12/94. There is a box advertisement under “Patent agents” on page XXXX of the YXY Yellow Pages. The advertisement has the wording “Patents Trade Marks Copyright”. There is no other reference to patents. There is no reference to European patents.
Report of the EASY Working Group

D. Speiser (DE)

EASY is the name of a project of the EPO for introducing an Electronic Application SYstem, and the EASY working group of the EPI was requested by our Council to accompany the work of the EPO on their EASY project, to gather own practical experience with the EASY-software, to convey such experience to the European Patent Office and to be an addressee for the members of the EPI on questions relating to said project.

The present opinion of the working group can be summarized as follows:

EASY is far from being easy. But this is a very normal situation at the beginning of any new development in particular when considering the difficulties stemming from multinational participation and ambitious goals as well as relatively short time so far spent on the project.

Members of the EPI working group together with their staff have started their work by acquainting themselves with a first beta-version of the EASY software. Our tests have shown - as was to be expected at this early stage - that the beta-version is still far from being user friendly. It is in fact not yet suited for use in ordinary patent departments and in private practice because a lot of assistance is required by either the EPO developers and/or the internal resources a patent department might have.

This being so - even after the recent release of a second beta-version - we have not yet had a chance to go much beyond unsuccessful as well as successful attempts to prepare and file European applications using the EASY software.

Questions regarding security and errors and the possibility of linking existing internal databases used in the patent departments and in the offices of private practitioners with the EASY software still remain to be asked and answered.

Report of EPPC Meeting of 14th June 1995

R.J. Burt (GB)

Constitution of the EPPC

The EPPC elected the following as its officers, members of subcommittees and delegates to other committees:

President:
Mr F.A. Jenny (CH).

Vice President:
Mr A.V. Huygens (NL).

Secretary/rapporteur:
Mr R.J. Burt (GB).

Deputy Secretary/rapporteur:
Mr I.R. Muir (GB).

Sub-Committee for Technical Documentation:
Mr P. Claey (BE), Mr W. Hoogstraten (NL), Ms H. Kutzenberger (DE).

Sub-Committee for Legal Documentation:
Mr E. Freyinger (LU), Mr W. Nichols (BE), Mr G. Widmann (AT).

Sub-Committee for CPC matters:
Mr E. Armijo (ES), Mr A. Casalonga (FR), Mr A. Huygens (NL), Mr F. Jenny (CH).

Sub-Committee for Trilateral Harmonisation:
Mr F. Jenny (CH), Mr G. Schmitt-Nilsson (DE), Mr Z. Schöld (SE).

Liaison Committee:
Mr. Burt (GB), Mr A. Casalonga (FR), Mr A. Huygens (NL), Mr F. Jenny (CH).

Delegates to the SACEPO Sub-Committee on Examination Guidelines:
Mr A. Casalonga (FR), Mr W. Hoogstraten (NL), Mr F. Jenny (CH), Mr I. Muir (GB), Mr G. Schmitt-Nilsson (DE).

EPI Delegation to Committee on Patent Law of the EPO:
President and Vice-President of the EPPC.

EPPC Delegates to the EURORATAB Meetings:
President of the EPPC, if necessary replaced or accompanied by another member of the EPPC.


This committee is now a Standing Committee of the Administrative Council of the EPO in which the EPI has observer status. The committee considers detailed legal points on behalf of the Administrative Council and at its meeting in April 1995 it discussed inter alia the situation regarding the Patent Law Treaty, some amendments to Rule 28 and to Article 97 EPC (possibility of shortening, on applicant’s request, the 5-month time limit of Article 97 (5)). The committee furthermore agreed that Article 133(2) EPC is compatible with the TRIPS/GATT Agreements. Another topic on the agenda concerned the requirement for translations of the specification and claims of the European patent. At the request of the EPO the committee gave some thought to the idea of the translation of an abstract of the patent application as an alternative to translation of the whole patent document. The committee came to no conclusion on this topic which will continue to be an important item of discussion.
Restitutio in Integrum

Members of the EPPC have prepared a comprehensive review of the Board of Appeal case law relating to the duty of care in Restitutio in Integrum cases. It is evident that in early cases on Restitutio in Integrum a strict and rigid approach was by the Boards of Appeal, whereas they now apply the "principle of proportionality" (see for example J 22/92) and take a more flexible approach. The EPI is asked to reinforce to the EPO the pressure under which attorneys work and the EPO should be encouraged to continue with its more flexible approach. The Boards of Appeal have given one clear message - an isolated mistake in an otherwise satisfactory system is an acceptable reason for restitution; however, it is incumbent of the representative to prove he has a satisfactory system.

There has been a proposal put forward to replace the present system by a restitution system solely based on payment of a large fee, and should amendment of the EPC be undertaken, this proposal will be considered.

The possibility of making Restitutio in Integrum easier inevitably results in the question of protection of third parties. Article 122 EPC at present provides safeguards for third parties, in particular the Article 122(6) EPC protection for intervening rights. The one year time limit in Article 122 EPC also gives very important protection and representatives of a third party must always accept the risk of a request for restitution within one year of expiry of a time limit. A further safeguard is that the EPO will publish that a request for restitution has been filed as soon as possible after receiving such a request.

Possible amendments to the Patent Cooperation Treaty

There has been a call for the removal of the secrecy of the International Preliminary Examination particularly for those PCT applications where the EPO acts as IPEA. There is concern that on entering the regional phase of an international application, the EPO pass the application from itself as IPEA to itself as patent granting authority, and simply issue a Rule 51(4) EPC communication informing the applicant of the text in which it intends to grant the patent. A third party consequently has no access to the substantive arguments put forward by the applicant in response to objections from the examiner and is only permitted to see the rather uninformative IPEA report. The prosecution information, which can be very useful in interpreting the patent, is not available. It will therefore be proposed to the EPI Council to urge the EPO to ask WIPO in the regional phase for copies of the complete PCT files and to place at least the written opinions and the responses thereto in the European files. If this should turn out not to be possible the EPO should be urged to instruct EPO Examiners who handle the regional phase of an international application to give a written opinion indicating why the patent is allowable, in effect repeating the reasoning from the IPEA.

A proposal to seek to have the residence and/or nationality requirements for filing PCT applications abolished or relaxed was deferred to a later date.

The proposal for some form of Restitutio in Integrum in the international phase of the PCT patent application was not pursued in favour of relying on the use of Article 25 PCT pursuant to which all decisions of WIPO can be reviewed by national or regional offices.

Patentability of Computer-related Inventions

An update of the present position was presented by the subcommittee on computer-related inventions. The subcommittee have been asked to prepare a proposal for new Guidelines for the Examination of software inventions to be submitted to the EPO for discussion.

Payment of Fees

The problem with the payment of fees into an EPO bank account is that, if the bank loses the cheque the attorney has to deal with the bank to sort out the problem; it would be better if the EPO dealt with the bank because, as account holder, the EPO are in a stronger position. A further proposal is that the date of payment into an EPO bank account should be taken as the date of receipt of the payment. There was concern that there could be abuse by some banks by them making receipts which are post-dated for the benefit of an unscrupulous applicant or representative; however, the procedure is only proposed for banks with which the EPO has chosen to have accounts, and if these banks abused the procedure they could lose the EPO as client. This topic be discussed at the next meeting with the Liaison Committee.

Date of posting in an EPC Contracting State should be taken as date of receipt

A proposal was put forward that the date of posting of mail to the EPO from an EPC Contracting State be taken as the date of receipt of the item of mail by the EPO; this is already the case for mail sent to the national Patent Office in Switzerland and some other countries, and is being considered by the UK Patent Office. A disadvantage of the present system of relying on the date of receipt by the EPO is that representatives remote from the EPO are suffering a time penalty because of the postal system. There was some concern about abuse of a system relying on the date of posting; however, if registered mail had to be used the level of abuse should be minimal. One alternative suggested was that all communications to the EPO could be filed with the representative's local Patent Office for transmission to the EPO; this proposal was not pursued because it would require amendment of the Convention. Following the discussions it was decided that the topic as a whole would not be pursued.
The European qualifying examination (EQE) exam technique and tactics

M. Herzog

I first started writing this paper at the request of friends planning to sit the EQE and wanting to benefit from the experience of earlier candidates. The paper was first published by the “Patentanwaltskammer” (Chamber of German Patent Agents) hearing of it from Professor Dress of CEIP. Now “epi” (Institute of Professional Representatives before the European Patent Office) asked me to make these ideas and tips available to candidates of all countries of the EPC on the basis of the present English language translation of the originally German text. This I am very happy to do.

I. Introduction

As part of my own preparation for the EQE, I attended two CEIP seminars in Strasbourg. During the Paper D seminar, a five-minute excursus by one of the tutors - Mr Rosenich from Liechtenstein - profoundly influenced my subsequent approach.

Mr Rosenich impressed upon us that for any EQE candidate time is of the essence; it is therefore worth thinking beforehand about how to save it. Mr Rosenich for example had used the about 10 minutes between the distribution of Paper D and the actual start of the exam to remove the EPC contents pages and stick them together to form a vertical list which he then no longer had to leaf through in order to locate the relevant provisions. He reckoned that this saved him up to 15 minutes - about 5% of the time available!

Precise figures may be open to argument, but he certainly convinced my seminar group of one thing: assuming a candidate has mastered the subject-matter, he can considerably increase his chances of success by systematic and logical exam technique and tactics.

All this may seem obvious. But Mr Rosenich - and I take this opportunity to thank him - showed me that no tip can be too simple, and the simplest is often the most valuable.

The present paper does not claim to be exhaustive. On the contrary: every candidate should adjust and supplement these tactics to meet his own needs. It is also self-evident that all the technique and tactics in the world cannot save a candidate who does not "know his stuff". But that is not what this paper is about.

The approach outlined below is based on the way marks were awarded in electricity/physics in 1994, but should be easily adaptable to future EQEs as well as to the needs of those taking the chemistry paper.

II. General

What is the point of the EQE for candidates? Again, this may seem obvious, but the whole point is simply to pass it. The exam papers are not actually that difficult in themselves, but there is just not enough time to give a comprehensive answer to every question. Try to do so and you have virtually failed already. In this respect, the exam has little direct bearing on working as a patent agent. In patent practice, you have to give full answers to clients' questions - unless you want to find yourself confronted with liability suits all the time. Whereas in the EQE you need to concentrate instead on optimising the number of marks you can score in the time allowed.

Experience shows that for a given question your mark-scoring effectiveness declines exponentially the longer you spend on your answer. Thus, suppose that in time T you have already scored 50% of the total marks available. Spend time T again on the same question, and the best you can hope for is another 25% of the marks. Your mark-scoring effectiveness has halved.

The biggest mistake you can make in any exam paper is to get stuck in one particular question, devoting more time to it than is justified by the total marks it carries. Instead, you must divide up your time on the basis of the marks available.

This means that when devising your "battle plan" for the individual papers you must ask yourself:

- How do I divide up the time available?
- How can I save time?

Below is a "battle plan" which has helped me (and friends) to pass the EQE at the first attempt. But before we look at it in detail, first a few introductory remarks:

You have to practise your "battle plan", and in the process adapt it to your own individual needs. One particularly useful training exercise is to take past papers from previous EQEs. Be sure to do this under realistic exam conditions, so you get used to the enormous time pressure you will encounter in the actual exam. My own group, when going through the exercises afterwards, also looked critically at the "battle plan" and tried to improve it.

A propus groups: I strongly recommend preparing for the exam in groups rather than on your own. Ideally the group should comprise three or four people, including one person who has already sat the exam and can give the "first-timers" the benefit of that valuable experience.

You should also use the exercises to train yourself to write legibly even under time pressure. The most brilliant answer is not up to much if the markers can't read it, just as the best "battle plan" is no good if you don't actually keep to it during the exam.

Lastly, a few more points applicable to all the EQE papers:

- Don't get stuck too much in perfectly formulating the answers; I have always reckoned that the markers appreciate the time pressure, and ignore questions of style if they can see you understand the principles. Markers whose mother tongue is not English (or whatever
The marks available do no justify spending too much time wondering whether to put a feature in a dependent claim. The same applies to drafting your dependent claims; often you can simply take over formulations used in the client's letter.

Subject-matter you identify as patentable independently of the characterising portion of Claim 1 should definitely go into dependent claims. Don't forget to mention these claims explicitly in your notes to the markers.

A look at recent past papers A and B shows that your formulation of the problem solved by the invention can often be based very closely on the client's letter.

When drafting the introduction to the description, always use short forms such as "The invention concerns a device in accordance with the pre-characterising portion of Claim 1", "This problem is solved by means of a device with the features of Claim 1", and so on.

You can also cut out extracts from the client's letter and glue them into your answer paper. Make sure however that you use consistent terminology. To save having to write too much (and rendering these extracts illegible in the process), it is a good idea to insert short "adapter clauses" (eg: claim terminology = "information-bearing card"; description terminology = "chip card"; adapter clause = "Information-bearing cards are explained below using the example of chip cards"). If your description extracts from the client's letter refer to the drawings, don't forget to delete the reference numbers.

Similarly, your discussion of the nearest prior art and the advantages offered by the invention can usually be put together from the client's letter.

On the dependent claims, you should at least include the standard clause that these contain "advantageous and preferred embodiments of the device in accordance with the invention". If you have time, it is worth commenting separately on those dependent claims directed to independently patentable subject-matter.

IV. Paper B (reply to examining division communication)

1. Marks available:
   24 marks claims (presumably most for the main claim)
   24 marks argumentation

48 marks in total

To pass Paper B you have to score 24 marks.

2. Time allocation
   The time available is 3½ hours.
   Suggested allocation:
   
<table>
<thead>
<tr>
<th>Activity</th>
<th>Time (minutes)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Studying the papers</td>
<td>40</td>
</tr>
<tr>
<td>Claims</td>
<td>90</td>
</tr>
<tr>
<td>Argumentation</td>
<td>80</td>
</tr>
</tbody>
</table>

3. Comments
   Paper A (new application) and B (reply to examining division communication) are about the same technical subject-matter and are written on the same day. So you might think it a good idea to go through Paper A with other candidates during the break, and discuss ways of restricting the claims. But bear in mind that the break is only 90 minutes long, and together the two papers require 7½ hours of the utmost concentration. I think it is therefore better to relax over a light meal followed by a stroll in the fresh air.

   As you wait to be re-admitted into the examination room, run through in your mind the prior art from Paper A - it usually also comes up in Paper B. I reckon this saves you between 5 and 10 minutes of examination time.

   When you read the Part B papers - which are often a kind of model solution to Part A - it rarely happens that you find your own solution, i.e. your own Claim 1 from the morning. If so, don't react like a rabbit paralysed by car headlights. All is not necessarily lost, so force yourself to keep going. Every minute wasted thinking about how you must have messed up Paper A is a minute lost for marking in Paper B - precisely what no EQE candidate can ever afford. Whether you really did mess up Paper A you won't know anyway until you get the final results.
The EPO examining division communication is usually so formulated that there are several possible ways of restricting the invention claimed. The option you decide to pursue is the key to whether you pass or fail. It is therefore very tempting to spend a lot of time making up your mind. But I think one yardstick can save you a lot of time and help you make the right decision: stick as closely as you can to what your client wants. You can infer the client’s intention from the problem the invention is trying to solve (even if you have messed up Paper A). With a solution involving no (or only minimal) changes to the problem to be solved you stand a good chance of being on the right track, whereas one which means completely reformulating the problem is almost certainly wrong.

V. Paper C (opposition)

1. Marks available:
   40 marks use of information
   30 marks legal aspects
   30 marks argumentation

   100 marks in total

To pass Paper C you have to score 50 marks.

2. Time allocation
   The time available is 5 hours. Suggested allocation:

   Structure 120 minutes
   Formulation 120 minutes
   Legal questions 60 minutes

3. Comments
   The most difficult task in Paper C is to filter out, from all the prior art, the information which can be used to attack the patent - bearing in mind the relative priority of its individual claims (including any alternatives and dependencies) and, on that basis, which prior-art documents can be cited against them.

   How to go about this is best learnt by doing past papers and talking to people who have already taken the examination.

   Obviously, which information you can use and which you can’t depends on the wording of the patent you are opposing. To study the prior-art documents effectively, you need to grasp the gist of the claims as quickly as possible, so you don’t have to keep switching backwards and forwards between the contested patent and the prior art, and only need to consult the precise wording of the claims at critical points. You should also collate the information in such a way that you can use it effectively for your argumentation later on.

   To gather this information rapidly, effectively and clearly, my seminar group devised a step-by-step approach (see point 4 below) and an information sheet (see Annex), both of which have proved useful in tackling Paper C.

   When drafting your notice of opposition and your notes, use the documents’ Annex numbering, citing their full titles all the time is very time-consuming. To be on the safe side, when you list all the citations at the beginning of the notice of opposition you can add comments on the lines of “DE-A-12 34 567 (hereinafter abbreviated to A4)”.

4. Approach
   Step 1:
   Draw a straight line representing time, and pre-sort roughly the patent data on one side and the prior-art data on the other. Then enter the documents in order of publication date in the top line of the information sheet (see Annex), always leaving some space so you can add eg prior art discussed in description introductions and containing relevant information.

   Step 2:
   Read the client’s letter, highlighting the priority details of the patent in suit and the legal issues raised by your client.

   Step 3:
   Read the patent, highlighting (eg in different colours) passages of differing priority.

   Step 4:
   Use this information to work out the priority status of the individual claims - bearing in mind any alternatives and dependencies they may contain. Also watch out for hidden independent claims (eg where Claim 1 refers to glass as the material used, but Claim X depending on Claim 1 recites “that instead of glass a transparent plastic is used”).

   Step 5:
   The quickest way of absorbing the wording of the claims can vary considerably from one candidate to another. A fairly reliable one in my opinion is to jot down the features in the left-hand column of the information sheet. This is time well spent because there is then much less need to leaf through the documents afterwards.

   Step 6:
   Read the prior art through very carefully, filling in the information sheet as you go. Cast an eye also over the documents excluded by publication date; they might nonetheless include references to prepublished documents containing relevant information.

   Step 7:
   Now convert your completed information sheet into your notice of opposition (Step 7b). Since it is easy to get stuck in here and run out of time later for the legal questions, answer these first (Step 7a) to get the marks in the bag. This also gives you a better perspective on the arguments you have marshalled, so when you write the notice of opposition you can see better how conclusive they are. In your argumentation, always use the problem-solution approach.

VI. Paper D (legal paper)

1. Marks available:
   50 marks Part I: questions
   50 marks Part II: legal opinion

   100 marks in total

To pass Paper D you have to score 55.5 marks.

2. Time allocation
   The time available is 4½ hours. Suggested allocation:
Part I:
Questions
135 minutes (ie about 13.5 minutes for each of ten questions)

Part II:
Structure: 65 minutes
Writing: 70 minutes

3. Comments
With Paper D it is particularly important that you keep to your timetable. First, it is the only one where you have to score more than 50% to pass. Second, examination nerves are worse early on, and Paper D is the first paper you sit.

Be sure to start by answering the legal questions. Experience shows that candidates who write the legal opinion first often go into too much detail and don't leave themselves enough time for the legal questions. Another advantage is that these questions can be answered in any order, and are therefore a very good way of calming those examination nerves.

So: read the first question. If you haven't got an answer straight away, don't waste time but move straight on to the next. (Initial nervousness can often stop you answering even the simplest questions. But every second you waste by panicking is a second lost for scoring marks. So move on straight away.) If you can't answer the second question at once, go straight to the next. In my own case, it wasn't until the fourth question that I actually got going. When I went through a second time - less nervous by this stage - the first three proved not so difficult after all.

If you find yourself running out of time towards the end of the 135 minutes set aside for the legal questions, then at least try and jot down the relevant articles and rules, together with a few linking keywords. You are expected to write your answers out properly, but if you at least get the legal provisions right you may pick up the odd mark here and there. Make sure you at least have a stab at all the questions at any rate.

The same is true for the legal opinion: here again it is better to "scratch the surface" of all the problems than to deal at length with one but not cover any of the others.

(See please also the information sheet next page.)

EPI Tutorial fee reduction for EPI Students

At its last meeting in Edinburgh on 8/9 May 1995 the EPI Council decided that EPI Students will benefit from a reduction in Tutorial fees: For all papers the fee will be lowered from 450 DM to 300 DM and for two papers from 350 DM to 200 DM.

Students of the EPI

Rules

1. Each applicant to be registered as a student of the EPI must complete an application form to be obtained from the EPI Secretariat.

2. The application form must be counter-signed by a sponsor, in the person of either a European Patent Attorney on the list or a person acting as a representative under the provisions of Article 133-EPC, who is responsible for the training of the applicant at the date of application.

3. The completed application form must be accompanied by a payment of DEM 300, which will be effective to the end of December of the fourth year after the date of application.

4. If a registered student wishes to continue his/her studenthip for the fifth or any subsequent year, he/she has to submit another application form in respect of each such year. Such continuation application forms have to be accompanied by a payment of DEM 150 and to be counter-signed by the same or another sponsor.

5. During the currency of the studentship, the EPI undertakes to supply each student with:
   a) his/her own copy of "EPI Information" as published;
   b) a list, to be updated annually, of students registered as at 1 March of each year;
   c) a list of reference books and articles, etc., such as the "Guidelines for Examination", and information about the training and tutorial facilities for the student's country or region.

6. The completed original and continuation application forms have to be vetted by a designated member of the Professional Qualification Committee (PQC), who has to refer any queries to the chairman of the Professional Qualification Committee.

7. A registered student may resign at any time by writing to the EPI Secretariat to that effect. There will be no refund of any subscription in respect of the remaining period of his/her registered studentship. His/her subscription to "EPI Information" will be cancelled by the EPI Secretariat when convenient to it.

8. Applications for becoming an EPI Student will be accepted until 31 December 1997 unless Council extends this deadline at the instigation of PQC.

How to register see page 100 + 101
ANNEX: INFORMATION SHEET (copy in A3 format for exam)

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Indicate in this column whether feature present (+) or feature not present (-) or equivalent feature present (e).

In this column indicate reference (i.e., page and line).
Application to be registered as a Student of the EPI

To be returned to: EPI Secretariat
Postfach 26 01 12
D-80058 MÜNCHEN
Tel: .49 89 201 7080
Fax: .49 89 202 1548

Please write in capital letters:

This is a □ first application □ continuation application

Surname: .................................................................

Forename(s): ..............................................................

Address: ............................................................
(for correspondence)

Professional ..........................................................

Address (if different) ..................................................

Telephone No. ..............................................................

Fax No. .................................................................

Working languages: ..................................................

Training period (months) .............................................

I hereby apply for registration and agree, if my application is accepted to abide by the governing studentship rules of the EPI.

Candidate’s signature: ..........................................

Date: ..........................................................

I am aware that my application only becomes effective when the EPI account

Postbank München
No. 703-802
BLZ (Bank Sorting Code) 700 100 80

has been credited with 300 DM for the first application (for the first four year period) or 150 DM for each additional year.
I, ........................................................................................................................................
of ........................................................................................................................................

☐ being a European Patent Attorney on the list,

☐ or a person authorised under Article 133-3 EPC,

hereby sponsor:

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for studentship of the EPI, and confirm that I have responsibility for his/her professional training leading to entry on
the list by examination.

If the sponsor’s professional address is different from that of the applicant, please indicate below the reason for this,
indicating in particular how the responsibility for training is being met.

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Sponsor’s signature: ..................................................................................................................

Date: ......................................................................................................................................
VESPA
Verband der beim Europäischen Patentamt eingetragenen freiberuflichen schweizerischen Patentanwälte

VIPS
Verband der Industrie-Patentanwälte in der Schweiz

organisieren auch in diesem Jahr wieder ein Prüfungstraining für die

VORBEREITUNG AUF DIE EUROPÄISCHE EIGNUNGSPRÜFUNG 1996

- Anhand von früheren Prüfungsaufgaben werden die Teile A - D der Eignungsprüfung geübt.
- Der Kurs versteht sich als letzte Kontrolle vor der Eignungsprüfung und als Ergänzung zu eigentlichen Ausbildungskursen
- Die Lehrfunktion des Kurses beschränkt sich demgemäss auf das Durcharbeiten konkret gestellter Prüfungsaufgaben und die Instruktion der Prüfungstechnik durch erfahrene und beim EPA zugelassene Vertreter
- Die Aufgaben werden nach Wunsch auf deutsch, englisch oder französisch gestellt und können auch in der entsprechenden Sprache bearbeitet werden.
- Der Kurs ist auf zwei zeitlich getrennten Modulen aufgebaut, die einzeln gebucht werden können
- Die Teile A und B sind nur gemeinsam wählbar
- Die Teile A/B, C und/oder D können frei gewählt werden
- Kosten pro Modul:
  - Teil A/B: Sfr. 250.--
  - Teil C: Sfr. 150.--
  - Teil D: Sfr. 150.--
  - alle Teile: Sfr. 450.--

Modul 1

- (Modul 1 wurde bereits durchgeführt)

Modul 2

- **Anmeldeschluss:** **neu** 15. September 1995

Auskunft / Anmeldung beim Kursleiter:
ANDRE BRAUN, Patentanwalt VSP, Murtengasse 5, CH-4051 Basel,
Telefon: +41/61/2720771, Fax: +41/61/2720163
The Powers of the EPO Boards of Appeal in Determining the Admissibility or Inadmissibility of Appeals

B. Cronin (GB)

This paper analyzes the role of the EPO Boards of Appeal in determining the admissibility or inadmissibility of appeals, particularly in cases where the status of the decision under appeal is in question. It also discusses a possible remedy to the present lack of legal safeguards at the end of EPO appeal proceedings, by a proposed addendum to the Rule relating to the rejection of inadmissible appeals.

Powers of the Boards

Under Article 21 and Article 106 sub-paragraph (1) of the EPC, the Boards of Appeal are responsible for the examination of appeals from the decisions of the Receiving Section, Examining Divisions, Opposition Divisions and of the Legal Division.

The powers within the competence of the Boards of Appeal as defined in the Convention can be summarized as follows:

- Rule 65 provides the power to reject an inadmissible appeal;
- Article 110 sub-paragraph (1) provides the power to examine an admissible appeal; and
- Article 111 sub-paragraph (1), first sentence provides the power to decide on an examined appeal.

Moreover, Article 111 sub-paragraph (1), second sentence provides that the Boards may exercise any power within the competence of the department which was responsible for the decision appealed.

Rule 65 stipulates that the Board of Appeal shall reject an appeal as inadmissible if the basic conditions for constituting the appeal are not complied with by the relevant time limit. The rejection of inadmissible appeals is an exclusive power of the Boards, and is non-discretionary.

If an appeal does not comply with the requirements for admissibility, the Board must therefore dismiss it and is not empowered to examine the matter further.

One of the important prerequisites for admissibility is that appeals lie only from decisions of the first instance departments listed in Article 106 sub-paragraph (1). Consequently, before a Board examines and decides on an appeal, the existence of an appealable decision has to be ascertained. This is particularly important if an appeal is filed against a "decision" which questionably is an appealable one.

The Boards' Power to Revoke Opposed Patents

It has previously been suggested that decisions of the EPO Boards of Appeal to revoke opposed European patents should be subject to appeal.

Revocation by the Board can only take place after the Board has set aside the Opposition Division’s decision to maintain an opposed patent. This closes the appeal proceedings and re-opens the opposition proceedings, whereupon the Board may exercise the power of the Opposition Division to revoke the patent.

When a Board of Appeal then revokes the patent, it is exercising a power which is within the sole competence of the Opposition Division and the decision terminates the opposition proceedings, which is the responsibility of the Opposition Division. This therefore ought to be considered to be a decision of the Opposition Division taken by the Board under its power of substitution.

Arguments can thus be provided in support of the admissibility of an appeal against a revocation decision taken by a Board of Appeal, but these arguments need to be put to the test by subjecting the question to the Boards.

How, then, would an appeal against such a decision be handled by the Boards of Appeal?

Admissibility / Inadmissibility of an Appeal against a Decision to Revoke taken by a Board

Suppose an appeal, formally admissible in all respects, is filed against a decision taken by a Board of Appeal to revoke an opposed patent. The appeal asserts that the decision, though taken by the Board, is in fact a decision of the Opposition Division, therefore open to appeal.

The sole question as to the admissibility or inadmissibility of such appeal is whether or not the decision under appeal constitutes an appealable decision of the Opposition Division within the meaning of Article 106 sub-paragraph (1).

Rule 65 provides the Board of Appeal with exclusive jurisdiction to reject appeals as inadmissible for non-compliance with Article 106, and it seems self evident that the matter would be resolved by the Board’s discretion.

If the appealed decision is found by the Board to be a decision of the Opposition Division, the appeal is admissible. If not, the appeal must be rejected as inadmissible.

The Office administration does not view the matter this way, but considers that "there is no room for any further appeal and consequently no room for another decision, not even on the admissibility of a further appeal, otherwise the execution of the decision could be deferred ad infinitum".

Based on this appraisal, such an appeal was sent back for lack of basis in the Convention, without its admissibility / inadmissibility being con-

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1 See "The Power of the EPO Boards of Appeal to Revoke European Patents: is the EPO's Practice Compatible with the TRIPS Agreement?", EPI Information 3/1994, Page 102.
sidered by a properly constituted Board of Appeal.

The administrative branch of the Office has thus by-passed the Boards of Appeal and prevented the Boards from exercising their power firstly to determine whether or not such an appeal is admissible, and secondly to reject the appeal if it does not comply with Article 106 sub-paragraph (1).

In so doing, the Office administration has de facto assumed the power of the Boards to reject an inadmissible appeal by deeming such appeal non-existent, while denying any procedural right to the party concerned by refusing to recognize the existence of any procedure.

This creates an impasse, since if the administration short-circuits appeals of this nature their admissibility or inadmissibility will never be determined by the Boards.

An Attempted Solution via the Legal Division

To resolve this impasse an attempt has been made to obtain a decision from the Legal Division to amend an entry in the Register of European Patents for a revoked patent, so as to reflect the existence of procedures challenging the finality of the revocation decision.

It was hoped that this could lead to recognition of the existence of these procedures and the fact that they remained pending before the Board of Appeal, awaiting its decision. But the Office declined to cooperate and, by a letter from the Vice-President of DG5, refused to recognize the competence of the Legal Division to take a decision in the matter, i.e. in relation to an entry in the Register for a revoked patent.

From the requester’s standpoint, this letter had the effect of a decision from the Legal Division refusing its requests, and an appeal was filed. This appeal was duly entrusted to the Legal Board which considered the arguments presented in support of admissibility, but concluded in decision J02/93 (headnote published in OJ 4/95) that the appeal was inadmissible.

In its reasoning, the Board stated that the Legal Division has sole responsibility as regards decisions in respect of entries in the Register of European Patents and that the letter of the Vice-President cannot be regarded as a decision, does not emanate from the Legal Division, and is not appealable.

In other words, the Office administration cannot take decisions in place of the responsible department and, by implication, has no right to prevent an administratively-dependent department from taking a decision within that department’s responsibility.

From the appellant’s standpoint, the most important result was that, in rejecting the appeal as inadmissible, the Board stated that the request for a decision filed before the Legal Division was still pending. This reveals two important aspects of the Board’s power in rejecting an inadmissible appeal.

Firstly, in holding that the letter under appeal did not constitute a decision, the Board recognized that the absence of a decision meant that the request for a decision was still pending.

Secondly, in the pronouncement of the rejection, the Board was able to attest the existence of the request for a decision before the Legal Division.

Thus, the administration’s refusal to recognize the competence of the Legal Division to take a decision on the matter was overruled and, as a result, the requester was able to demand a written decision on its requests. Following this, the Legal Division issued a decision in which it maintained its stance that it is not competent to take a decision on the requests. This incongruous decision is now the subject of pending appeal J03/95.

The Office is obviously not prepared to accept that the departments charged with procedure have any power to deal with matters after a European patent has been revoked by a Board of Appeal, which the Office takes to mean that all procedures are closed and no new procedures can be initiated.

But the filing of an appeal - be it admissible or inadmissible - is one amongst several procedures provided by the Convention that can be initiated after revocation, and the appeal procedure - starting with a determination of admissibility or inadmissibility - can only be dealt with by the competent department, the Board of Appeal.

Suggested Addendum to Rule 65

The reluctance of the Office to allow proper consideration of the admissibility of any appeal against a revocation decision taken by a Board of Appeal could perhaps be removed by regulating the procedure under Rule 65 by which the Boards exercise their power to reject such appeals as inadmissible.

The proposal set out below takes account of the fact that the Boards of Appeal are empowered to reject inadmissible appeals and are further empowered, in examining the admissibility of an appeal, to determine whether the impugned decision does in fact constitute a decision and, if so, whether the decision is an appealable one. Moreover, if the Board finds that there is no appealable decision, in rejecting the appeal it has the power to pronounce whether proceedings before the previous instance have been closed by a decision or are still pending.

Based on this, Rule 65 could for example be completed by an addendum which would regulate the handling of appeals against decisions of the Boards, by recognizing the power of the Boards to reject such appeals as inadmissible after a judicial review to determine whether or not the decision was taken in conformity with the Convention.

A possible wording for a new sub-paragraph (3) of Rule 65 could for instance read along the following lines:

(3) The Board of Appeal shall reject as inadmissible any appeal against a decision which is within the responsibility of the Receiving Section, an Examining Division, an Opposition Division or the Legal Division but was
taken by a Board of Appeal exercising the power of that first instance department.

(a) If the statement under Rule 64(b) of such appeal indicates that amendment or cancellation of the decision is required because the decision was taken in breach of a provision of this Convention, and the written statement under Article 106 identifies and substantiates the alleged breach, the Board shall subject the decision under appeal to a judicial review and, in rejecting the appeal as inadmissible, shall declare its finding that:

(i) the decision under appeal was taken in accordance with the provisions of this Convention; or

(ii) the decision under appeal was taken in breach of one or more provisions of this Convention and is void.

If the decision under appeal is void, the Board of Appeal shall remit the case to the Board of Appeal which issued the void decision for further prosecution according to Article 111(1) second sentence.

(b) In rejecting the appeal as inadmissible, the Board of Appeal shall state that the rejection is final and that no department of the Office is empowered to review the rejection or consider the admissibility or the inadmissibility of any appeal against the rejection.

* * * *

The suggested Rule change would mean that the Board has the power to make a legal review of the decision under appeal, but only to the extent necessary to determine the reasons for inadmissibility, thus codifying the Board’s power.

The possibility in sub-paragraph (a), for the Board to investigate whether the decision under appeal is void because of a breach in the Convention, means that the Board can reject the appeal as inadmissible due to the inexistence of the void decision, enabling the previous procedure to be resumed.

Under Article 23(3), in their decisions the members of the Boards are bound to comply with the provisions of the Convention and it follows that the Boards derive no power to take decisions which contravene the Convention. Consequently, all decisions of the Boards bear the hallmark of being entirely in compliance with the Convention and, for this reason, review and cancellation of decisions taken by a Board can only be envisaged in exceptional circumstances.

In the proposal it is contemplated that a review can be made only if it is alleged that the decision was taken in breach of a provision of the Convention, and that a decision can be declared void only where such breach is established.

If a decision is found to be void it will be remitted to the Board which issued it. That Board could then issue a fresh decision, or remit the case to the department of first instance if it sees fit.

Paragraph (b) is a statement of the self-evident, which will eliminate any concern that reckless parties could file appeal after appeal, without end. This paragraph would be a deterrent to such behaviour, and would provide justification for the Office administration to be able to brickwall any further “appeals” without having to refer the matter to a Board of Appeal. This statement should also make it clear that the bar to further procedure applies solely to the case in dispute and cannot be interpreted to justify a refusal by a department of the Office to take a decision in another case.

**Comments**

The above proposal is based on a “regulated inadmissibility” of appeals of the type under consideration in effect by deeming them to be inadmissible. Of course, it would equally be possible to regulate the admissibility of such appeals, if it were agreed that when the Board takes a decision exercising the power of a first instance department, this should be regarded as an appealable first instance decision.

As illustrated above, the proposal applies to appeals against revocation decisions by the Boards of Appeal, but it is applicable equally to appeals by opponents and, in rare situations, to ex parte proceedings.

The suggested procedure lends itself to a fairly streamlined application by the Boards, since practically the only issue under consideration in the judicial review will be alleged breaches of the Convention.

It must be rare for the Boards to breach the Convention in their decisions, and it should not be too difficult for the reviewing Board to discriminate between cases where there has been a breach (usually flagrant) and those where there is none (usually quite clear).

The procedure should not unduly delay the execution of a valid decision. Furthermore, a safeguard is included to avoid any possibility of repetitive appeals going on ad infinitum.

The suggested procedure will not add a “third instance” to the proceedings, nor will it add significantly to costs. In fact, it could simplify the procedure in certain cases where the Board of Appeal, having set aside the decision of the first instance department, is ready and willing to decide the matter. In such cases, knowing that any adversely affected party has a limited possibility for a judicial review, the reasons for remitting the case to the first instance department would be less compelling.

Under Article 24 sub-paragraph (1), the judicial review would have to be made by a newly constituted Board, hence totally independent of the preceding Board, and the availability of such independent final review should remove users’ misgivings about the lack of legal safeguards at the end of EPO appeal procedures.

In short, the proposed procedure offers several further advantages:

- It will bring the EPC clearly into compliance with TRIPS Article 32,

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2 Where a Board, after setting aside the Examining Division’s refusal, decides to grant a patent e.g. in a limited version, and the applicant is adversely affected.
because a judicial review will be available for all revocation decisions.

- It should meet user's expectations as regards reduction of the possibility of an abrupt and irreparable loss of rights at the end of the procedure, caused by a legally defective decision.

- It should remove or reduce criticism of the EPC on the ground that it provides less opportunity for legal review than that available via national procedures.

### Summary

The Boards of Appeal are empowered to reject inadmissible appeals, but current Office practice prevents the Boards from determining the admissibility or inadmissibility of an appeal from a decision taken by a Board of Appeal exercising power within the competence of the first instance department.

It should be possible, for example by an addendum to Rule 65, to set out a procedure to be followed by the Boards in rejecting such appeals as inadmissible, including a judicial review by which decisions taken in breach of the Convention can be declared void.

The proposed rule change would bring the EPC into compliance with TRIPS by providing judicial review for revocation decisions taken by the Boards, remove users' misgivings about the lack of legal safeguards at the end of procedures before the EPO, and contribute to procedural efficiency in the handling of appeals.

### EPI Answer to the Request for Observations by the Enlarged Board of Appeal in case G 2/94

The EPI submitted the following observations as answer to the request for observations by the Enlarged Board of Appeal in case G2/94. The request is based on referrals by boards of appeal as published in the Official Journal 4/95 p. 171, and as cited partly below, following the EPI answer.

#### EPI Answer:

I. In its decision J 11/94 the Legal Board of Appeal 3.1.1 has established that there exist two different views on the question who is entitled to present (part of) the case of a party in oral proceedings. In Decision T80/84 it was decided that the oral presentation of a case, or part thereof, by an unqualified and unauthorised person, is not to be permitted. In Decision T598/91 a different position was taken, to the effect that an assistant or technical expert is to be allowed to plead, albeit under the supervision and responsibility of a qualified and authorised representative, employee or person. This different view was mainly based on the consideration that "pleading" and "representation" are different concepts.

II. Decision T80/84 is a straightforward and clear one, but seems to be inflexible, since it does not permit oral elucidations by technical experts accompanying the representative on possibly unforeseen technical questions, being raised during oral proceedings.

According to Decision T843/91 (vide par. 9.3) the above decision (T80/84) is not contravened by allowing experts to give oral contributions under the control of the authorised representative, when the Board considers such presentation useful for the good understanding of the case to be decided upon. This reasoning is based on the provisions of Article 117 EPC, enabling the Board to request information.

The rigid ruling of T80/84, made flexible in accordance with T843/91, is perfectly workable in practice and should at least be maintained.

III. The reasoning developed in Decision T598/91 seems to go much further than the line developed in T843/91. According to T598/91 a professional representative may appoint assistants and technical experts, at his own choice, in order to prepare part of the case to be presented before a Board and let them plead during the oral proceedings, albeit under the supervision and responsibility of the professional representative. The competence of these assistants and technical experts is "prima facie" assumed. The Board will normally give those people permission to plead and may withdraw such permission, where appropriate.

The oral intervention of an assistant or expert at the hearing should be in addition to the pleading by the supervising representative which means that the representative is at least present in person and presents at least a part of the case.

No restriction is made regarding the issue to be pleaded, which may be relevant technical and legal matters as well.

IV. The above reasoning is based on the view that "representation" does not necessarily imply an "exclusive" right of "pleading", which is considered to merely comprise the developing of arguments orally in court.

The example chosen by the Board to show the distinction between these two concepts (see T598/91 - Reason 2.4) is not convincing. It seems to be rather exceptional that a party, being a natural person, is present at an oral hearing, whereas the pleading is done by a representative, which does not, at that instance, "represent" a party, since the party is present in person and for that reason need not be represented.

Even in such a case the party, present at the hearing could very well be seen as being represented, the party being present in the quality of "auditor".

V. Another argument of the Board to distinguish between the concepts of
"pleading" and "representation" is based on Article 133 EPC stipulating that some applicants and patentees may authorize a "non-qualified" employee to represent them, whereas others - from outside the jurisdiction of the Member States - must hire a professional representative. Employees of such non-Member State parties should, in the opinion of the Board, have the same pleading possibilities.

VI. The reasoning under V could very well lead to an erosion of the functions of a professional representative, who, under a liberal free-for-all pleading system, could be put under pressure to limit his contribution to a more or less ornamental presence during oral proceedings, the "pleading" being mainly done by others. This is an undesirable consequence of liberalising the system of compulsory representation and extending the group of persons allowed to plead.

VII. It is the considered opinion of EPI that pleading during oral proceedings falls under and forms part of the concept of representation and that this should be maintained. This concept should not prevent non-representatives from addressing a Board during oral proceedings, under certain conditions, as now allowed under Art. 117 EPC.

This means that question 1 as formulated in Decision J 11/94 is to be answered in the affirmative.

Question 2a is in the view of EPI to be answered as follows:

a. The main part of the pleading during oral proceedings is to be undertaken by the professional representative, i.e. a professional representative according to Article 134(1); an employee according to Article 133(3), 1st sentence; or a legal practitioner according to Article 134(7).

b. Under his supervision and responsibility well defined questions of a technical nature may be elucidated by a technical expert, accompanying the said representative.

c. Legal issues should be pleaded exclusively by the said representative.

Question 2b seems to be answered at least partly by the answer 2a-c. It is understandable that a Board will be embarrassed by a confrontation with a former Board member, pleading for a party in the oral proceedings. In the view of EPI former Board members should refrain from pleading before a Board. Whether a ruling should be given in this respect should be left to the present Board. EPI prefers to refrain from submitting observations on this issue.

May 1995


(Amtlicher Text)

1. Steht es im Ermessen einer Beschwerdekammer, einer Person, die nicht nach Artikel 134 (1) und (7) EPU berechtigt ist, Beteiligte im Verfahren vor dem EPA zu vertreten, in einer mündlichen Verhandlung in Ergänzung des Vortrags des zugelassenen Vertreters Ausführungen zu gestatten?

2. Wird die Frage zu 1. bejaht:

a) Welche Kriterien sind bei der Ausübung des Ermessens zu berücksichtigen?

b) Gelten Besonderheiten für ehemalige Mitglieder der Beschwerdekammern?

Das Verfahren ist unter dem Aktenzeichen G 2/94 anhängig.

I. In decision J 11/94 dated 22 September and 17 November 1994, Legal Board of Appeal 3.1.1 referred the following point of law to the Enlarged Board of Appeal under Article 112(1) (a) EPC:

(Translation)

1. May a board of appeal exercise discretion in deciding whether or not a person not entitled under Article 134 (1) and (7) EPC to represent parties to proceedings before the EPO may make submissions during oral proceedings in addition to the pleadings by the professional representative?

2. If the answer to question 1 is "yes":

(a) What criteria must the board observe when exercising this discretion?

(b) Do special criteria apply to former board of appeal members?

The case is pending under Ref. No. G 2/94.

I. Conformément à l'article 112(1) a) CBE, la chambre de recours juridique 3.1.1 a soumis à la Grande Chambre de recours, par sa décision J 11/94 en date du 22 septembre et du 17 novembre 1994, la question de droit suivante :

(Traduction)

1. Une chambre de recours dispose-t-elle d'un pouvoir d'appréciation pour autoriser une personne à présenter, dans le cadre d'une procédure orale devant l'OEB, des informations destinées à compléter l'exposé du mandataire agréé, même si cette personne ne peut assurer la représentation d'une partie à la procédure conformément à l'article 134(1) et (7) CBE ?

2. Dans l'affirmative :

a) Quels critères convient-il d'appliquer lors de l'exercice de ce pouvoir d'appréciation ?

b) Des conditions spéciales sont-elles applicables dans le cas des anciens membres d'une chambre de recours ?

L'affaire est en instance sous le numéro G 2/94.
Exclusive Jurisdiction under the Brussels And Lugano
Enforcement Conventions - A Hidden Poison Pill in the EPC

Hans Raible, DE

Abbreviations used:
A Article
BEC Brussels Enforcement Convention of 1968 (in its latest version of San Sebastián - Donostia), reprinted in European Patents Handbook (EPH), chapter 74.9
EBA Enlarged Board of Appeal of the EPO
ECJ European Court of Justice
EP European Patent
EPO European Patent Office
LEC Lugano Enforcement Convention, reprinted in EPH, chapter 74.10
For all practical purposes, the BEC and the LEC are identical and subject to the same internationally agreed rules of interpretation.

In EPI-Information 1993¹, the author described in detail why, according to the BEC, the EPO has no jurisdiction to continue opposition proceedings after an opponent has withdrawn his opposition, and why exclusive jurisdiction instantly passes to the national courts after the withdrawal of an opposition, leaving no room for further activities of the EPO.

The question remains what will become of EPs which were amended by the EPO after it had lost jurisdiction. It will be shown below that these EPs cannot be enforced before the national courts.

The higher demands of operating in an international setting

Patent people are accustomed to the national setting where nobody bothers a great deal about jurisdiction and every court is glad if another court, or the patent office concerned, does the necessary (and usually disagreeable) work. Therefore, the typical patent practitioner is like a contortionist and experienced at stretching the law.

The EPO is different - it operates in an international setting that is governed by extremely stringent European laws on jurisdiction. The EPs issued by the EPO are like cheques that have to be honoured by the national banks - their recognition and enforcement is the prerogative of the national courts, and at the present time, the courts of all Contracting States are bound by the same supranational, unified European law that is binding now for 360 million inhabitants in the whole of Western Europe.

When it comes to patent infringement, there is considerable latitude under supranational European law, and there are so-called "alternative jurisdictions" which are so unusual that the national courts are quite unwilling to apply them. The Cross-Border Injunctions issued by the Dutch courts under A.24 of the BEC/LEC are typical examples of this latitude which can become extremely risky to parties not conversant with these Conventions.

The following courts shall have exclusive jurisdiction, regardless of domicile:

4. in proceedings concerned with the registration or validity of patents, trade marks, designs or other similar rights required to be deposited or registered, the courts of the Contracting State in which the deposit or registration has been applied for, has taken place or is under the term of an international convention deemed to have taken place;²

5. in proceedings concerned with the enforcement of judgments, the courts of the Contracting States in which the judgment has been or is to be enforced.

Sont seuls compétents, sans considération de domicile:

4. en matière d’inscription ou de validité de brevets, marques, dessins et modèles, et autres droits analogues donnant lieu à dépôt ou à un enregistrement, les juridictions de l’État contractant sur le territoire duquel le dépôt ou l’enregistrement a été demandé, a été effectué ou est réputé avoir été effectué aux termes d’une convention internationale;

¹ EPI-Information 1993, 228-231
² A binding interpretation of this part of A.16 by the ECJ can be found in Duijsnste vs. Goderbauer of Nov. 15, 1983.
5. en matière d'exécution des décisions, les tribunaux de l'État contractant du lieu de l'exécution.

Since item 4 of A 16 would not have covered the jurisdiction of the EPO under the EPC, a clause was appended both to the BEC and to the LEC. This "appendix" reads3:

Without prejudice to the jurisdiction of the European Patent Office under the Convention on the grant of European patents, signed at Munich on 5 October 1973, the courts of each Contracting State shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any European patent granted for that State which is not a Community patent by virtue of the provisions of article 86 of the Convention for the European patent for the common market, signed at Luxembourg on 15 December 1975.

Sans préjudice de la compétence de l'Office européen des brevets selon la convention sur la délivrance de brevets européens, signée à Munich le 5 octobre 1973, les juridictions de chaque Etat contractant sont seules compétentes, sans considération de domicile, en matière d'inscription ou de validité d'un brevet européen délivré pour cet Etat et qui n'est pas un brevet communautaire en application des dispositions de l'article 86 de la convention relative au brevet européen pour le marché commun, signée à Luxembourg le 15 décembre 1975.

Even though a patent practitioner is accustomed to weird language, he/she will probably not understand this masterpiece of legal prose. At other places where "sans préjudice" is used in these Conventions, it is translated in more intelligible fashion. An example will clarify the meaning: "Without prejudice to the bending and breaking of light waves, nothing is bent and broken more often on earth than the law", meaning, in plain English: With the exception of light waves, nothing is broken more often than the law. This is legal shorthand, avoiding a great deal of amendments to both Conventions by incorporating (embedding would be a more appropriate term) the EPC into them, as far as jurisdiction is concerned, by the stroke of a pen, but at the cost of being unreadable4.

This means that, vice versa, the general rules on jurisdiction laid down in both Conventions are binding on the EPO. This view is not shared by the EPO.

A structural diagram

A diagram will make the relationships more clear.

The basic principle of both Conventions is that the courts at the defendant's domicile/seat have jurisdiction (A 2; A 53). If a citizen of Reykjavik, Iceland, will not pay the bill of a Greek company, and if there are no agreements on jurisdiction, the Greek company, under the LEC that binds the courts of both countries, will have to sue its debtor before the héraðsdómar at Reykjavik. This is meant to protect the defendant, and it obviously does. This basic principle of both Conventions is often quoted in its Latin form as "actor sequitur forum rei".

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3 This is in Protocol 1 to both Conventions, Article VD (BEC) resp. Article Vquiniquestes (LEC). This Article was added to the Protocol of the BEC in 1978 when the EU was enlarged by the accession of Denmark, Ireland, and the UK. Subsequently, this A VD also became part of the LEC, and therefore also is part of Swiss law and binding upon the Swiss courts, as well as those of Austria and Sweden.

4 In other pieces of EU legislation, such as the CPC or the Community Trade Mark Regulation, such regulations are spelled out in clear and readable form. This appears indispensable with legislation of this degree of complexity but was not possible in 1978. It would be difficult even today.
The exclusive jurisdiction under A 16 BEC/LEC and under the EPC is an exception to this basic principle, and the ECJ constantly has decided that such exceptions to 'actor sequitur forum rei' have to be interpreted restrictively.

Originally, the Max-Planck-Institut at Munich had suggested that A 16 item 4 should be interpreted beyond its wording and in an extremely wide sense to include disputes with inventors, questions of entitlement, compulsory licences, etc. The ECJ did not follow this view and decided that A 16 item 4 means just what it says. This exclusive jurisdiction only refers to:

- a) the registering and grant procedure leading to a patent, design, TM etc.
- b) questions of validity of IP rights, such as opposition, revocation and amendment proceedings.

**Alternative jurisdiction**

If the national courts have no exclusive jurisdiction in cases concerning compulsory licences, it follows by exclusion that the normal rules concerning jurisdiction must apply, and this means that various courts may have jurisdiction. This is called alternative jurisdiction.

In an intra-EU setting, this means that basically A 2 BEC is applicable to cases concerning compulsory licences, i.e. the courts at the domicile/place of the patent owner have jurisdiction and may have to apply foreign law. E.g., a British company having a German patent under which a compulsory licence is demanded may insist on an English court deciding the matter as per A 2 BEC, and the English court will then have to apply the German law on compulsory licences. The parties may also agree on a German court (prorogatio fori, A 17 BEC), or the British company might agree to the jurisdiction of a German court by simply entering an appearance as per A 18 BEC (reprinted below). There are many alternatives, and the parties might also agree on a French court as per A 17 BEC, but the French court would probably dislike this and throw out the case. (Even this possibility is considered in A 17(1) BEC/LEC.)

This multiple choice situation is typical for cases of alternative jurisdiction but is excluded in cases of exclusive jurisdiction. Mixing up the two species is a frequent error and can lead to disastrous results.

Regarding the scope of "exclusive" jurisdiction, the ECJ also held that A 16 item 4 is subject to an identical, "autonomous" interpretation in all Contracting States, and that the interpretation laid down by the Court in Duijnstee vs. Goderbauer.

From this, it ought to be clear that not either the exclusive jurisdiction of the EPO under the EPC in matters of validity can be blown up, and is also subject to the same kind of "autonomous" interpretation, frequently referred to as "restrictive interpretation".

A good example is the patentee's opposing his own patent, in other words, amendment proceedings in disguise. Amendment proceedings are not provided for in the EPC, and therefore, the EPO has no jurisdiction for them, and the courts of the Contracting States have "exclusive" jurisdiction for any amendments outside of the scope of a valid opposition, as spelled out in A 16 item 4 BEC/LEC. Originally, the EBA had decided that the EPO has jurisdiction for such amendment proceedings (G1/84). The EBA then reversed itself to take account of the legal situation (G9/93).

There will always be disputes as to whether a particular question of law falls within the exclusive jurisdiction of the EPO or of the courts of the Contracting States. As in all legal questions, there is some latitude.

One argument says that the jurisdiction of the EPO is an exception to the exclusive jurisdiction given to the courts of the Contracting States, and that the EPO-jurisdiction will, therefore, have to be interpreted restrictively.

Another view, held by Pr. Poudret of the Univ. of Lausanne, is that A 16 item 4 should be interpreted restrictively in favour of giving the EPO as broad jurisdiction as possible.

These are largely academic questions - if the EBA produces good decisions that fit into the framework of the BEC and the LEC, nobody will take issue with them.

What is not possible, however, is that the EPO treats matters of exclusive jurisdiction as if they were matters of alternative jurisdiction, and this it has done in the past, disregarding the ius cogens Europaei laid down in both Conventions.

Thus, there is a very strict division of labour between the national courts and the EPO as far as validity of EPs is concernend: As long as jurisdiction can be derived from the EPC, it rests with the EPO. Since this is an exception to the general rule laid down in A 2, it has to be interpreted with restraint, in accordance with the case law of the ECJ. In all cases where the EPC, when interpreted with restraint, does not confer jurisdiction upon the EPO, only the national courts will have exclusive jurisdiction - within the limits laid down by the ECJ in Duijnstee vs. Goderbauer.

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5. GRUR Int. 1976, 465-477 and 510-520.
6. One might also argue that these are "administrative proceedings" not covered by either Convention, cf. Steenbeek in EPI-Information 1993, 111-113. This is a question of "classification" in the sense used in the conflict of laws. The question will not be easy to decide.
   "Le juge se déclare d'office incompétent si sa compétence n'est pas fondée aux termes de la Convention. Ceci est très bien et donne confiance au défendeur, qui peut ainsi éviter de se défendre uniquement pour contester la compétence du juge. Mais l'expérience nous met en présence d'une situation fréquente et fâcheuse lorsque le juge se trompe, en se déclarant compétent, même si sa compétence n'est pas fondée sur la Convention. Aussi prononce-t-il un jugement qui peut obtenir la force de la chose jugée."
   [The EPO makes no exception to this, cf. cases G9/91 and G10/91 discussed below.]
8. The opinion of Pr. Poudret is based on Recueil systématique du droit fédéral (suiss), RS 0.232.142.2.
Learning from the social sciences
There is a phenomenon called "capital symbolism" by its discoverer, Pierre Bourdieu of the Collège de France, meaning that every large institution has a tendency to add to its own glory. In the case of the EPO, this means that the EPC is interpreted broadly with regard to jurisdiction in order to add to the capital symbolism of the EPO. As Alberto de Elizaburu recently has pointed out so eloquently, this accumulation of capital symbolism by the EPO goes along with a reduction of the capital symbolism in the national patent offices and may lead to conflicts.

Examples for this tendency are new R. 57a and amended R. 87.
New R. 57a reads:
Amendment of the European patent
Without prejudice to Rule 87, the description, claims and drawings may be amended, provided that the amendments are occasioned by grounds for opposition specified in Article 100, even if the respective ground has not been invoked by the opponent.

As the title of the new Rule says, this tries to create a new jurisdiction for the EPO, namely the jurisdiction to amend an EP after grant, and outside the scope of an opposition which scope is determined by the opponent.

Director Ingwer Koch, Legal Affairs, EPO, the father of the new Rules, has given a very thorough explanation of the reasoning behind them. The authority relied on is not the EPC, but the Roman lawyer Ulpius with his dictum VOLENTI NON FIT INJURIA used by the EBA in G9/91 and G10/91. A dictum from Roman law appears to be rather frail basis for extending the jurisdiction of the EPO into fields not covered by the EPC.

It will be shown below that the use of Ulpius's dictum is expressly forbidden in matters of exclusive jurisdiction. Amendment proceedings are wholly outside of the scope of the EPC (as confirmed by the EBA in G9/93) and cannot be introduced by Rules approved by the Administrative Council of the EPO. Legislative action would be necessary, i.e. an amendment of the EPC that would have to be approved by the parliaments of all Contracting States.

It must be concluded that new R. 57a, and even more so amended R. 87, is based on a wrong premise, namely Ulpius's dictum, and parties using these new Rules are doing so at their own risk and peril. The risks are explained below.

There is no way of transferring exclusive jurisdiction from the national courts back to the EPO, e.g. by agreements of the parties (prorogation for) or by entering an appearance. This is expressly forbidden by Article 17, 18 and 19 of both Conventions.

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11 Domitius Ulpianus, 170 to 228, a Roman lawyer and politician. The dictum is taken from his commentary "Ad edictum". It was mainly used in rape cases: if the woman was willing (volens), no harm (inuria) was done to her.
12 Joseph Voyance, professor at IHEAP, Lausanne, in L'espace judiciaire européen, CEDICAC, Lausanne, 1992, p. 21/22:
"A côté des sois énumérés jusqu'ici, la Convention de Lugano institue encore une série de compétences qui sont exclusives (art. 16). Elles sont indépendantes de toute considération de domicile et n'admettent aucune prorogation. Ces compétences sont prévues dans quatre domaines:
...-
- en matière d'inscription ou de validité des brevets, marques, dessins et modèles et autres droits analogues."
13 Gerardo Broggini in op cit, p. 46: "La seule réserve faite par le texte concerne la juridiction exclusive prévue par l'article 16. Les foro de l'article 16 sont absolument impératifs et ne peuvent être modifiés ni par la prorogation volontaire (art. 17), ni par la comparution volontaire (art. 18)."

However, there is a backdoor: A party intervening in opposition proceedings may argue based on new grounds of opposition. This was decided, based on A 105 EPC, by the EBA in G1/94. This may be used for "legally sound amendment" of an EP if needed, but will become rather costly.
The pertinent parts of these Articles are reprinted below. A 17(3) is only given in its original French version since the English version contains a translation error that might mislead the reader.\(^\text{14}\)

**A 17(3)**

Les conventions attributives de juridiction ainsi que les stipulations similaires d'actes constitutifs de trust sont sans effet si elles sont contraires aux dispositions des articles 12 et 15 ou si les tribunaux à la compétence desquels elles dérogent sont exclusivement compétents en vertu de l'article 16.

**A 18**

Apart from jurisdiction derived from other provisions of this Convention, a court of a Contracting State before whom a defendant enters an appearance shall have jurisdiction. This rule does not apply where appearance was entered solely to contest the jurisdiction, or where another court has exclusive jurisdiction by virtue of article 16. (Emphasis added).

**A18**

Outre les cas où sa compétence résulte d'autres dispositions de la présente convention, le juge d'un Etat contractant devant lequel le défendeur comparait est compétent. Cette règle n'est pas applicable si la comparution a pour objet de contester la compétence ou s'il existe une autre juridiction exclusivement compétente en vertu de l'article 16.

**A 19**

Where a court of a Contracting State is seized of a claim which is principally concerned with a matter over which the courts of another Contracting State have exclusive jurisdiction by virtue of article 16, it shall declare of its own motion that it has no jurisdiction.

**A 19**

Le juge d'un Etat contractant saisi à titre principal d'un litige pour lequel une juridiction d'un autre Etat contractant est exclusivement compétente en vertu de l'article 16, se déclare d'office incompétent.

These articles are also binding upon the EPO, with the exception of patents issued for Slovenia, Latvia and Lithuania since these three countries, at present, are not a party to either Convention.

In G9/91 and G10/91, the EBA decided that the EPO can obtain jurisdiction in certain matters concerning validity by the patentee's entering an appearance, using Ulpian's dictum VOLENTI NON FIT INIURIA. This is in plain contravention of A 18 quoted above and therefore untenable. In matters of exclusive jurisdiction, the rules are iron-clad, and A 19 is an absolute bar to the EPO's dealing with anything for which the courts of a Contracting State have exclusive jurisdiction, such as amendment proceedings.\(^\text{15}\)

**Section 5 of Title II BEC/LEC says that in proceedings concerned with the validity of a Swiss patent (national or EP) the Swiss courts shall have exclusive jurisdiction.**

If, in a Cross Border Injunction, a Dutch court decides on the validity of a Swiss patent (as the Dutch courts do), this is in evident conflict with the exclusive jurisdiction of the Swiss courts and "shall not be recognized" by them except if decisions on the validity of Swiss patents are expressly provided for in the Dutch law on injunctions, cf. A 24 BEC/LEC.

**As A 28 stands, it also prohibits the recognition of any decision on the validity of granted EPs handed down by the EPO, i.e. the legal draftsmen of the "appendix" forgot to amend A 28 BEC/LEC. One will have to read the "without prejudice" into A 28, i.e. decisions of the EPO on the validity of EPs shall be recognized by the national courts, but only if the EPO had jurisdiction under the EPC - when interpreted with restraint.**

Thus, if the EPO revokes an EP in a judgment concerning a matter in which it had no jurisdiction, or no longer had jurisdiction, such a decision is like an uncovered cheque that has to be refused by the national banks, i.e. such a judgment shall not be recognized by the national courts, and the national parts of the EP will remain in force (provided the annuities are paid). This will not apply to Slovenia, Latvia and Lithuania for the reasons explained above, i.e. the Slovenian, Latvian and Lithuanian parts will lapse.

If the EPO amends an EP without having jurisdiction (Examples: The patentee opposes his own patent, cf. G1/84; an opposition is withdrawn, but the EPO continues the proceedings and limits the claims; the EPO deals with grounds for opposition not raised by the opponent during the opposition period), such judgments

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\(^{14}\) The English version of A 18 also contains a translation error ("solely"). In Elefant en Schuh GmbH vs. Pierre Jacqmain, of June 24, 1981, the ECJ decided that the French version of A 18 is binding.\(^{15}\)

Joseph Voyame in op. cit., p. 19: "Le tribunal saisi doit même, d'office, refuser d'entrer en matière si la juridiction d'un autre Etat contractant est compétente à titre exclusif en vertu de la Convention (art. 19)."
shall not be recognized, either, since they infringe upon the exclusive jurisdiction which the national courts would have had over the matter under A 16 LEC/BEC plus appendix. The amendments are invalid, but the unamended patent will become unenforceable as obviously lacking patentability - why would it have been amended otherwise?

A case where this partly works to the patentee's advantage is where an EP is upheld in unamended form since this will strengthen the patent, but it will not prevent a national action for revocation by the same party, giving the attacker a second chance which he would not have had in view of A 23 of both Conventions if the EPO had not acted ultra vires.

Incidentally, these problems show the very urgent need for legislative action to enable amendment proceedings before the EPO. In view of the large sums of money needed to obtain an EP, the applicants rightly expect a "full service" and the possibility of central repair of their EPs, but this will have to be done by a "properly licenced repairshop".

The European Patents Handbook (EPH), in chapter 30.4, expresses the view

"that article VD [viz: of Protocol 1] provides the EPO with exclusive jurisdiction during the period while opposition proceedings are, or could be, pending in the EPO; but it is thought that the article merely provides a concurrent jurisdiction for EPO oppositions which otherwise would have to be excluded ..."

This view disapproves A 23 of both Conventions which deals specifically with exclusive jurisdiction and reads:

A 23
Where actions come within the exclusive jurisdiction of several courts, any court other than the court first seized shall decline jurisdiction in favour of that court.

A 23
Lorsque les demandes relèvent de la compétence exclusive de plusieurs juridictions, le dessaisissement a lieu en faveur de la juridiction première saisie.

The whole concept of "exclusive jurisdiction/compétence exclusive" as per both Conventions is entirely incompatible with the idea of "concurrent jurisdiction/compétence simultanée ou concurrentielle" - these are enantionomers, like fire and water. If a party "seizes" the EPO with opposition proceedings, or if it intervenes in such, it cannot have a second try in the national courts, and the national courts "shall decline jurisdiction" - "le dessaisissement a lieu".

This is an absolute bar to another action covering the same grounds for opposition/revocation, and not dependent upon an opposition still being pending in the EPO.

In all A 23 cases, a national court will have to examine first - as a preliminary question (question préalable; Vorfrage) - whether the EPO had acted intra vires or extra vires. If the EPO had no jurisdiction - such as in Rule 57a cases - A 23 BEC/LEC will not be a bar to a subsequent action for revocation, and the national court may proceed unfettered by A 23. Examining this intra/extra vires question will add a new dimension to 'European' revocation actions, costing the capital reality of the parties involved.

The purpose of A 21 to 23 BEC/LEC is to avoid conflicting decisions. It makes sense to give the last word to the EPO since nobody can have a better knowledge of European patent law than the EPO, its creator. But the EPO cannot claim the last word if it chose to operate outside the boundaries set by the EPC - to the detriment of patentees who will frequently have to put up with conflicting decisions which supranational European law would have avoided - if observed.

The question still remains whether A 23 BEC/LEC will only be binding between the same parties, or whether it acts in rem, i.e. forbids a new application.

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16 This view is shared by Stauder, EPO & CEIPI. - In a lecture given at Stuttgart, Dr. Stauder told the audience that his students could not understand why there should be concurrent jurisdiction between the EPO and the national courts. [Occasionally, it pays to listen to one's students.]

17 Gerardo Broggini in L'espace judiciaire européen, op cit, p. 50: "La règle de l'article 23 est plus simple, mais aussi presque sans application pratique. Nous ne connaissons aucun cas d'application". [The application of excluding revocation proceedings after an opposition or intervention in the EPO appears quite practical.]

18 Regarding the French view on this, the reader is referred to the excellent article of Axel Casalongo, Quelques remarques sur l'interprétation nationale du droit européen, in EP Information 1993, 186 - 191.

19 Broggini, op cit, p. 49: "Les règles des articles 21 à 23 s'efforcent d'éviter des décisions irreconciliables."

20 The idea of throwing out an action for revocation because of A 23 BEC/LEC will appear unthinkable to a national judge at the present time. The question will have to be referred to the ECI, and only when the ECI has decided will this idea gain acceptance. This may take decades in some Contracting States. The Paris courts, always eager to apply international conventions and treaties correctly, will probably be No. 1 again in Europe.

It appears dangerous, however - in view of professional liability - to express the 'EPH view' in a legal opinion. If the client cannot contest validity in the national courts after he has lost in opposition or intervention proceedings, he might be better off in not opposing the EP in question, or in not intervening in an opposition, and the alternative should be clear to him so that he will act en connaissance de cause.

The German experience (with A 6quinqueg of the Paris Convention) shows that it takes about one generation before the national courts begin applying an international convention. This is the disadvantage of "legal shorthand", i.e. of not incorporating such conventions - in longhand - into the applicable law.

21 Cf. A 96(3) of the Community Trade Mark Ordinance where a community trade mark court will only have to decline jurisdiction if the
national decision in a matter already decided by the EPO. E.g., if the EPO decided in opposition proceedings that a certain EP is valid in view of references A to D, A 23 BEC/LEC would also be a bar to a national court's deciding the matter anew between different parties, and possibly with a conflicting outcome.

The merits of exclusiveness

As to “exclusive” and “concurrent” jurisdiction, the reader is also referred to item 5 of A 16 BEC/LEC reprinted above which says that enforcement of a judgment is the exclusive prerogative of the courts in that Contracting State where enforcement becomes necessary.

This is the salvation in Dutch Cross-Border Injunctions. As is well known, the Dutch courts will issue injunctions under A 24 BEC/LEC that cover all countries of an EP, setting fines of e.g. 100,000 hfl per future act of infringement.

If such infringements do occur in NL, the Dutch courts can enforce their own injunctions since they do have exclusive jurisdiction at home, and they can therefore impose the 100,000 hfl fines. If the infringements do occur in CH, for example, enforcement of a Dutch injunction is the “exclusive” right and obligation of the Swiss courts, and the Dutch courts have absolutely no “concurrent jurisdiction” to collect a fine for acts done in CH (nor anywhere in the EU outside NL). If they would do that, they would break supranational European law, and certainly, our Dutch colleagues would prevent that.

Since a Dutch injunction first has to be “recognized” by the Swiss courts before it can be “enforced” by them, the Dutch injunction becomes pretty worthless outside of NL if the case law of the ECJ is applied properly by the Swiss courts (the LEC provides for this in its Protocol 2, Preamble and A 1), i.e. there will be no recognition and no enforcement in Switzerland (or any EU country except NL) under A 16 item 5 BEC/LEC. This largely takes the air out of Dutch Cross-Border Injunctions and shows the benefits of exclusiveness vis-à-vis competition.

In view of the liabilities involved, it appears wise to pay close attention to questions of exclusive jurisdiction. This is not national patent law where nobody cares a great deal and where there are no penalties if a forum non conveniens hands down a decision; this is supranational European law which carries a poison pill in it for those who do not abide by it, and this poison pill may be deadly to the patentee and leaves no leeway to the national judge who “shall not recognize” such judgments that are in conflict with the very rigid and inflexible Title II of the BEC/LEC.

Lessons regarding these Conventions formerly were part of the syllabus of CEIPI. These were abolished after the death of Dr. Dr. Singer (who was an eminent expert in matters of international law). Even though these matters are not part of the syllabus of the European Qualifying Examination, it appears advisable for tutors to reintroduce such lessons. As Gottfried Raiser, a leading barrister of the Stuttgart bar, has pointed out, it will not be possible to practice European patent, design or trade mark law in a responsible manner without having a good knowledge of these extremely difficult and complex - Conventions which might properly be called an attorney’s nightmare.

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Readers who are fluent in French are referred to a very useful booklet issued by CEDICAC, Lausanne, Switzerland, L’espace judiciaire européen. La Convention de Lugano du 16 septembre 1988, edited by Nicolas Gillard, ISBN 2-88197-020-6. This costs 350 FF and gives a good introduction to the Lugano Enforcement Convention which is substantially identical with the Brussels Enforcement Convention and subject to the same rules of interpretation laid down by the European Court of Justice. The booklet also contains a summary of the entire case law that is binding upon the courts when applying these Conventions.

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22 GRUR Int. 1995, 193-201.
23 This presupposes that the infringer has no domicile/seat in NL and takes the necessary legal steps before the Dutch courts. There are many pitfalls here, and if the infringer does the wrong things, the Swiss courts cannot help him and must recognize and enforce the Dutch korth-geding judgments. Ius vigilantibus scriptum. The risks of professional liability in such proceedings are enormous. For this reason, the EPO's decision to no longer teach these Conventions in the CEIPI lecture courses is to be regretted.
24 A 28 BEC/LEC
Chers Brevets

S. Le Vaguerèse (FR)

Et Yahvé dit : "Voici que tous font un seul peuple et parlent une seule langue. Maintenant, aucun dessein ne sera irréalisable pour eux. Allons, descendons et confondons leur langage pour qu’ils ne s’entendent plus les uns les autres".

Compte tenu de la qualité des intervenants, la vigueur des propos sur les questions de coût des brevets en Europe peut surprendre. Chacun tourne vers son voisin un index accusateur «La protection est trop coûteuse. Il faut que l’OEB baisse ses taxes» disent les uns. «Les agents sont trop chers, et il faut supprimer les traductions» répond l’OEB. L’utilisateur-payeur n’est pas indemne de critiques. «Vous devez faire pression pour que la part des annuités qui nous est reversée soit plus importante» ajoute l’OEB «ce qui nous permettrait de réduire nos taxes» ...

Bien entendu - si l’on peut dire - dans ce concert, ou cette cacophonie, tout le monde poursuit le même but, la promotion de l’utilisation du brevet, qui comme chacun sait doit apporter en ce monde bonheur et prospérité. Mais cet idéal d’harmonie et de grandeur peut-il résister aux intérêts particuliers de telle ou telle catégorie, d’autant que tous s’indignent de ce que leurs efforts passés, vrais ou supposés, seraient tenus pour peu de chose ?

«Regardez, dit l’OEB, depuis trois ans le montant des taxes n’a pas été relevé et nous avons considérablement amélioré notre productivité. Avec un effectif globalement en diminution, nous faisons plus qu’avant. Aller plus loin n’est pas possible car nous devons maintenir un niveau de rémunération qui est lié à notre statut d’organisation internationale».

«Réduire nos honoraires, disent les Conseils, il ne faut pas y songer, nous devons assurer la rémunération de personnels hautement qualifiés dont la contribution dans toutes les procédures est prépondérante. Par ailleurs, nous avons déjà beaucoup sacrifié dans la mise en place du système européen. Il n’est pas possible d’aller au-delà».

Les Offices nationaux ne sont pas en reste. Ils montrent la réduction de leurs effectifs et l’immensité de leur mission au service de tous et, plus encore, des «petits» dont il est postulé, de manière un peu rapide sans doute, que le marché national est à leur mesure.

Après tout, faut-il écouter ces utilisateurs qui protestent à propos du coût excessif des brevets européens ? Et d’abord, sont-ils bien à plaindre ? Tout n’a-t-il pas été fait pour leur donner satisfaction ? N’ont-ils pas :

- un système européen dont la qualité nous est envieé par les plus grands, USA et Japon ;
- un système qui a permis, dans une large mesure, de réduire leurs coûts ou d’accroître leur portefeuille par rapport à ce qu’il pouvait être du temps où ils ne disposaient que des protections nationales ;
- dans tous les cas, le libre choix entre le système européen et les systèmes nationaux.

Que demander de plus ?

Et pourtant... l’utilisateur continue de trouver la facture un peu lourde pour le bénéfice qu’il retire de ce service. Quelles raisons à cela, faut-il s’en inquiéter et quelles peuvent en être les conséquences ?

Plusieurs raisons peuvent expliquer cette préoccupation.

Les utilisateurs de brevets ne sont pas faits d’un autre bois que l’ensemble de leurs concitoyens. Ils ne s’enflammant pas plus facilement pour les institutions aussi glorieuses soient-elles. Ils cherchent à satisfaire au mieux les intérêts qu’ils sont chargés de défendre. Dans ce sens, ils doivent s’efforcer de trouver les outils qui répondent le mieux aux situations auxquelles ils sont confrontés. La protection des inventions et les moyens pour y parvenir ne peuvent échapper à cette recherche permanente. Les questions qui sont débattues à propos de ce problème de coût ne sont qu’une manifestation de cette nécessité. Si la protection, son étendue, son efficacité ne répondent pas aux besoins des utilisateurs ou si leur coût n’est plus en rapport avec le bénéfice conféré par cette protection, ils ne peuvent que manifester leur insatisfaction.

Cette évidence énoncée, la question ne fait que se déplacer. Pour quelles raisons les utilisateurs jugent le rapport coût/bénéfice disproportionné, alors même que le système européen est unanime reconnu pour procurer certaines économies par rapport à la même protection par les moyens nationaux dès qu’un nombre relativement petit de pays est retenu ?

On peut bien entendu considérer les deux éléments de ce rapport et dire que le "bénéfice" de la protection est insuffisamment garanti. C’est certainement un facteur important dans la genèse du mécontentement des utilisateurs. Toutes les enquêtes à ce sujet font état des difficultés de faire respecter ces droits chèrement acquis. Cette constatation ne fait pas défaut dans l’étude récemment publiée sous le titre EPO-Script. Pourtant si la protection n’est pas parfaite, il semble difficile d’affirmer que la situation ait évolué de manière négative par rapport à ce qu’elle était il y a une quinzaine d’années. La tendance générale reconnue est que les tribunaux ont renforcé sensiblement la position du brevet qui s’efforce de faire respecter ses droits,
et cela dans tous les pays connaissant un système de brevet de bonne tradition.

Si le coût de la protection a tendance à décroître et que le bénéfice s'accroît, tout va donc dans la bonne direction et, à priori, l'utilisateur ne devrait que se réjouir. Quelle est donc la raison de cette insatisfaction ?

Sans doute, le mouvement "managerial", de pression sur tous les fournisseurs de biens et de services, et très en vogue actuellement, peut aussi atteindre les responsables des portefeuilles des grandes entreprises. L'idée n'est peut-être pas étrangère à ce mouvement, pourtant son application pour se comprendre devrait se situer dans un environnement concurrentiel, et il n'y a pas d'alternative véritable aux modes proposés. Comme indiqué, les brevets nationaux sont plus coûteux dès que le nombre de désignations est égal ou supérieur à trois. Si les modes de protection offerts ne donnent pas satisfaction, le seul choix qui s'offre à l'utilisateur est le renoncement à la protection, ou la limitation de celle-ci.

La recherche d'une réduction à tout prix des budgets de fonctionnement, ne paraît pas non plus être la cause de cette préoccupation. Dans les années passées on a assisté chez les utilisateurs à une véritable frénésie de protection. Les chiffres enregistrés à l'OEB en sont une marque évidente. La même tendance se manifeste largement dans les portefeuilles des utilisateurs qui ont eu tendance à s'accroître sensiblement.

Le brevet européen, et c'est là la raison probablement la plus directe de cette mécontentement, est paradoxalement victime de son succès. Les utilisateurs présents ou potentiels veulent mettre à profit toutes les ressources qu'offre le système. La frustration vient de ce que cet outil fantastique qu'est le brevet européen (et que serait aussi le brevet communautaire) a montré beaucoup d'avantages, d'où la montée en régime beaucoup plus rapide et intense que ce que prévoyaient les fondateurs du système. Dans le même temps, l'utilisateur atteint de boulisme de brevet européen, doit limiter son appartenance pour des raisons budgétaires. On comprend sa frustration et sa colère, même si celle-ci n'est pas parfaitement raisonnable.

Mais l'utilisateur est-il seulement le jouet de ses caprices ? Au-delà de la satisfaction pour un responsable du portefeuille de voir celui-ci croître et emballer, n'y-a-t-il pas quelques nécessités qui n'ont rien à voir avec un surinvestissement, dans ses œuvres, de l'ego du responsable des brevets ?

Le fait est, de manière raisonnable ou non, que lorsque le responsable du portefeuille recherche avec les interlocuteurs de sa direction, quelle ampleur doit être celle de la protection de l'invention la plus modeste, il est rarissime que la réponse soit du type "le canton de Saint-Flour ou de Brioude", ou même "la région s'étendant au nord d'une ligne Bayonne-Tourcoing". Quasiment systématiquement, la réponse est : "et pour ce qui concerne l'EUROPE - tous les pays présentant une économie raisonnablement développée et où peut s'exercer une certaine compétition avec nos concurrents". Le trait est volontairement forcée, mais la réalité pour beaucoup de sociétés, grandes et même moins grandes, est bien celle-là. Et ces sociétés, s'ils n'ont bien se donner la peine de lire les statistiques, sont à l'origine d'une écrasante majorité des demandes européennes. Rappelons ici, que cent entreprises françaises sont à l'origine des 2/3 des demandes européennes (lire à ce sujet Economie et statistiques n° 275-276, 1994, p. 61).

Autrement dit, l'économie de concurrence, dont le brevet est un instrument, ne peut se contenter d'une utilisation des brevets qui apparaît à l'heure actuelle, comme "trop" contingente pour les raisons de coût. Autrement dit encore, les progrès en terme de capacité de protection ne suivent pas l'évolution de l'espace économique européen tel que les entreprises en font l'expérience permanente. Il faut ajouter que rien ne permet d'imaginer un renversement de tendance à ce sujet.

Qu'on veuille bien se souvenir un instant que dans le Traité de Rome la Propriété Industrielle n'est abordée que comme une exception, tolérée sans doute parce qu'à l'époque des mesures alternatives pour la protection n'existaient pas. Le fondement communautaire reste, à l'intérieur du territoire de ce qui est maintenant l'Union européenne, la libre circulation des marchandises. Les développements récents ne font qu'accentuer le caractère anachronique de la territorialité restreinte des brevets à chacun des États. Le brevet européen, dans les projets initiaux, s'apparentait beaucoup plus à notre futur brevet communautaire. Seule la protection sur l'ensemble du territoire commun apparaissait compatible avec les règles du Traité de Rome. Le brevet européen actuel, résultat de compromis "réalistes", se comprenait comme une mesure de transition ayant pour but de permettre à l'institution "brevet" de survivre dans un environnement qui lui était profondément hostile, en attendant l'avènement du brevet communautaire.

Les succès du brevet européen ont fait oublier momentanément à certains cette réalité. Le brevet européen n'est pas un luxe que s'offriraient les entreprises en mal de prestige, mais une nécessité engendrée par l'économie communautaire. Toute pratique qui voudrait en disposer autrement ne manquerait pas à terme de se heurter aux autorités de l'Union. Le mécontentement présent des utilisateurs n'est que l'expression de l'impossibilité dans laquelle ils se trouvent à répondre entièrement à cette nécessité, en raison des coûts excessifs auxquels ils doivent faire face.

Arrivés à ce point de réflexion, la question se pose : "Existe-t-il des solutions adéquates susceptibles de satisfaire les utilisateurs comme les autres protagonistes ?" Conside- rons les attitudes et commentaires rapportés au début, on pourrait en douter. Il semble même que certains se voient vite résignés à voir la situation rester bloquée et même se dégrader. Ceux-la imaginent un retour plus ou moins significatif aux pratiques d'avant 1978 ! Leur philosophie est en substance : si le brevet européen est trop cher, qu'à cela ne tienne, il y a les brevets nationaux.

Cette attitude, cela va sans dire, est contraire aux nécessités qui viennent d'être rappelées.

Le mouvement d'humeur du "retour au national" paraît donc voué à l'échec. Il reste d'ailleurs jusqu'à pré-
sent dans des limites peu significatives. S’il devait s’amplifier, on pourrait redouter qu’il s’accompagne d’une désaffection pour l’ensemble des modèles de protection “brevet”.

Un indice de ce que l’alternative nationale n’est pas la solution, se trouve dans l’intérêt suscité par la mise en œuvre éventuelle d’une protection européenne des modèles d’utilité. L’intérêt pour ce modèle d’utilité européen ne réside certainement pas, pour l’inventeur, dans la reconnaissance que son œuvre n’attire pas la qualité requise pour faire l’objet d’un brevet. Il ne réside pas davantage dans le fait que la durée de protection serait moindre. Seul le coût modéré attaché à ce type de protection joint à l’étendue de celle-ci est significatif.

Si ce modèle d’utilité n’a pas été mieux défendu jusqu’à présent, c’est probablement qu’il est perçu - à tort ou à raison - comme un possible concurrent du brevet européen... et surtout aussi, des brevets nationaux. Quoiqu’il en soit, dans la mesure où le choix du modèle d’utilité ne serait qu’un pis-aller, faute de pouvoir accéder au brevet en raison de son coût, sa mise en place ne résoudrait évidemment pas la question de façon adéquate.

Que l’on ne se méprenne pas, le modèle d’utilité n’est évoqué ici que pour montrer la permanence et la force des demandes des utilisateurs pour une protection géographiquement étendue et à coût modéré. Il ne constitue en aucun cas la solution au problème du coût du brevet qui reste l’objectif fondamental. Le message des utilisateurs à ce propos ne semble pas trop difficile à déchiffrer. A-t-il été entendu ? Ce n’est pas certain.

Une évolution vers un coût moindre est-elle envisageable ? Les intérêts particuliers semblent s’y opposer. Une réduction des taxes, la suppression des traductions superflues et d’autres mesures parfaitement identifiées du même genre, qui pourraient réduire considérablement les coûts, sont toutes repoussées sans ménagement, certainement pour d’excellentes raisons, qui laissent toutefois l’utilisateur bien perplexé.

N’y aurait-il donc aucun espoir de voir la situation se débloquer ?

Pour tenter de répondre à cette question, un parallèle avec la situation au démarrage du brevet européen peut être utile.

Dans une certaine mesure, les questions qui se posent aujourd’hui ne sont pas différentes de celles qui existaient à cette époque. Les Conseils redoutaient une perte d’activité, les Offices nationaux aussi. Il a fallu une conjonction inhabituelle de volonté d’aboutir - serait-ce au prix de certains sacrifices d’intérêts nationaux ou catégoriels - pour que cette nécessité apparaisse avec celle du Marché Commun s’impose. La réussite n’apparait pas évidente à tous. Aux Célébrations du 10ème anniversaire de l’OEB, M. Philip COOPER, représentant la Grande-Bretagne, commençait son intervention en ces termes : « Ce qui frappe peut être le plus dans le système européen des brevets, c’est qu’il a vu le jour et qu’il fonctionne. »

Il faut rappeler, qu’à l’époque, l’adoption du système européen ne s’est pas faite sans peine, mais après beaucoup de retard, d’essais infructueux et de tergiversations. Si finalement les réserves, les réticences de toutes natures ont été écartées, c’est l’oeuvre de quelques “grands” experts de l’époque. A la tête de leur délégation, et en dépit des renoncements que cela impliquait pour leurs administrations nationales, ils ont “porté” cette entreprise ambitieuse, usant de tout leur pouvoir de persuasion et, autant que de besoin, en l’imposant aux plus réfractaires.


Néanmoins, si l’on n’est pas trop pessimiste, on constatera que dans l’agitation dominante du moment, certaines décisions vont dans le sens d’une intégration toujours mieux assumée des dispositions européennes qui, encore une fois, sont les seules qui répondent raisonnablement aux besoins des entreprises dont l’espace européen est le marché naturel. Il y a bien entendu la relance de dispositions comme celle visant l’instauration d’une instance “commune” pour décider de la validité des brevets européens (le cas échéant indépendamment de l’entrée en vigueur du brevet communautaire dont elle faisaient partie à l’origine). Il y a aussi, et surtout pour ce qui concerne les coûts, les PAYS-BAS qui viennent de renoncer pour l’essentiel à leur système national pour éviter un double emploi (générateur de surcoûts inévitables pour les utilisateurs) avec le système européen.

Les représentations nationales paraissent en effet les seules en mesure de conduire les changements nécessaires. Ce sont elles qui gèrent l’OEB. Ce sont elles aussi qui fixent les part des taxes de maintien en vigueur qui va à l’OEB et aux Offices nationaux (une mère qui pour l’INPI représente près de 40 % de ses revenus !). Ce sont elles encore qui par leur position sont les mieux placées pour promouvoir de nouvelles règles concernant les traductions. Ont-elles encore des ambitions pour leur enfant européen ?

En attendant, le foisonnement des prises de position que l’on constate, est peut-être le meilleur témoignage de la volonté de “retrouver un même langue (je ne dis pas une même langue)”, et alors “aucun déssein ne nous sera irréalisable”, pas même celui entamé il y a maintenant 17 ans.
Res Judicata effect of decisions in EPO opposition cases with regard to national revocation proceedings

L.J. Steenbeek (NL)

In EPI Information 2/1995, Mr P.A. Smith (GB) reacted to a stance1 I had taken in an article2 published in EPI Information 4/1994. I wrote: "If the opponent loses his opposition, the res judicata effect of the judicial proceedings before the Board of Appeal precludes that a subsequent national application for revocation is admissible." In the reaction, this assumption was believed to be mistaken, and some disadvantages were mentioned which would result if my statement were true.

In this counterreaction, I will show that under UK national law it is indeed very likely that the res judicata estoppel bars a later national application for revocation. I will also show that the same disadvantages as mentioned by Mr Smith may very well occur in situations which are perfectly in compliance with UK national law. But first I have to admit that this estoppel only applies as far as the opposition and the later application for revocation are based on the same grounds.

The relevant part of the UK law can be found in Section 72 of the Patents Act 1977, more specifically in subsection (5). Subsection (5) specifies in a negative manner that there is no estoppel from a decision of the comptroller with regard to a later counterclaim for revocation in infringement proceedings. This negative way of formulating the absence of an estoppel underlines that a res judicata estoppel is a general principle of common procedural law, which applies unless the UK Parliament has made an express statutory provision to the contrary. The basis for a res judicata estoppel is that it is in the public interest that there should be an end to litigation.

It follows from subsection (5) that a decision of the comptroller does estop a losing applicant for revocation from alleging invalidity in a later application for revocation filed (1) against the comptroller or (2) directly with the court other than in a counterclaim for revocation in infringement proceedings, see also subsection (6). Further, a decision of the court other than in appeal from a decision of the comptroller, i.e. on an application for revocation filed directly with the court, does estop a party from alleging invalidity in a later application for revocation filed (1) with the comptroller, (2) again directly with the court, and (3) in a counterclaim for revocation in infringement proceedings.

It appears that in subsection (5) of Section 72 of the UK Patents Act 1977, it has not been provided that an EPO decision in opposition proceedings shall not estop any party from alleging invalidity of the patent in UK national proceedings. It thus follows that in this respect, the UK Parliament has not made an exception to the common law res judicata estoppel, so that this estoppel can be invoked by the patentee without any restriction, i.e. even as a defense to a counterclaim for revocation in infringement proceedings.

Anyway, even if the EPO opposition proceedings were to be equated with the likely administrative revocation proceedings before the comptroller, the decision in the EPO opposition proceedings would still estop the former opponent from alleging invalidity in any proceedings other than in a counterclaim for revocation in infringement proceedings. So, a res judicata estoppel based on an earlier final decision in EPO opposition proceedings would at least apply in any applications for revocations filed with the comptroller or with the court other than in a counterclaim for revocation in infringement proceedings.

I will now show that the disadvantages mentioned in the reaction to my previous article can also occur in situations which are perfectly in compliance with UK national law. From the above discussion as to the boundaries of the exception to the general res judicata estoppel principle, it follows that when an application for revocation has been filed directly with the court, the losing party is estopped from alleging invalidity of the patent in a later counterclaim for revocation in infringement proceedings. This may occur when during the revocation proceedings the patentee does not file a counterclaim for a patent infringement injunction, for instance because at that time there was not yet any actionable infringement or threat of infringement, or because the patentee has commenced or intends to commence infringement proceedings in another European court by employing the relevant provisions of the Brussels and Lugano Conventions on jurisdiction and enforcement. So even now and even if all I wrote about a res judicata estoppel resulting from EPO opposition proceedings...
proceedings were not true, it may very well happen that infringement and validity of a patent valid for the UK are not considered in one and the same proceedings. Anyway, even if it were accepted that this is a serious disadvantage, it is no proof that a res judicata estoppel as discussed by me does not apply.

The reason why I discuss UK law in this counterreaction, is that the reaction came from a UK colleague. However, res judicata (or "autorité de chose jugée") estoppels are also part of general civil procedural law in continental Europe. It is, for example, an accepted part of DE law that a decision in a first national application for revocation which has become final, bars a subsequent second application for revocation filed by the same party on the same grounds. In this respect I would draw attention to Reason 2 of the Decision G 9/91 of the Enlarged Board of Appeal of the EPO: "As to the general scope of opposition under the EPC, it is of importance that it takes place only after grant of the European patent, i.e. at a point in time when the proprietor is enjoying in each designated Contracting State the same rights as would be conferred by a national patent in that State (Articles 64 and 99 EPC). Thus, the relief sought by the opponent is not, as in traditional pre-grant opposition, refusal of the patent application but revocation of the patent as granted (in its entirety or in part) with effect ex tunc in all designated Contracting States (Article 68 EPC). Furthermore, the grounds for opposition being limited to and essentially the same as the grounds for revocation under national law (Article 138 EPC), it appears that the concept of post-grant opposition under the EPC differs considerably from that of classical pre-grant opposition and in fact has several important features more in common with the concept of traditional revocation procedure (cf. Haertel in GRUR INT, April 1970, p. 90: "Das nachträgliche Einspruchverfahren kommt in seiner Wirkung einem europäischen Nichtigkeitsverfahren nahe"). In view of these arguments of the Enlarged Board of Appeal, I believe that the present national legal rules prohibiting a second national application for revocation filed by the same party and based on the same grounds as in a prior national application for revocation of which the decision has become final, should be interpreted as also estopping a former opponent from filing a national application for revocation after the decision in prior EPO opposition proceedings has become final. In my view, it is far too easily assumed that the mere fact that a European patent can be attacked both in opposition proceedings and in national revocation proceedings, means that this double possibility of attack can be used by the same party.

As consequently any unjustified leniency towards the patentee in opposition proceedings cannot be repaired in any later national revocation proceedings, I fully agree to another statement made by the Enlarged Board of Appeal in the same Decision G 9/91, viz.: "In any case, it seems to the Enlarged Board in its present composition that post-grant opposition proceedings under the EPC are in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment."

Former examiner’s reaction to the open letter of Mr. Funke to the President of the EPO

P.W. Grubb (GB)

I read with interest the open letter of Mr Funke to the President of the EPO published in the last issue of EPI information, in particular his attacks on the competence and integrity of the Examination Board and the Examination Committee responsible for Paper C. I can well imagine that the present members of these bodies feel unable or reluctant to enter into controversy with unsuccessful candidates. I, however, having served as a member of the relevant Examination Committee for six years, and having had no official connection with it since 1986, feel no such inhibitions. Indeed, I consider it both a duty and a pleasure to reply.

First of all, I sympathise with Mr Funke, as with all unsuccessful candidates. It is not pleasant to fail an examination, particularly so when the margin of failure is only a matter of a few marks. However, whether or not one agrees with Dr Braendli that the failure rate is too high, at whatever level the barrier is set there will inevitably be some who just fail to clear it.

There are however two basic attitudes to failure. One is to look forward and say "I must do better next time". The other, unhappily represented by Mr Funke, is to brood upon what is past and to say "I am too clever to fail" if I have not passed it is because the examiners are incompetent". The latter attitude is not only unhelpful to the candidate himself, but also wasteful of the time of others.

I do not wish to go into Mr Funke's answer, which he has now thrust upon us, in any great detail. However, since he has laid such great weight on the two points of the non-attack in AT, CH/LI and DE and the question of filing in Spanish, perhaps some comment is needed.

To the first point, I would simply say that in my opinion the better attorney is one who does what is sensible for his client rather than one who gets into a confused and illogical situation because he takes an ambi-

4 Schulte, Patentgesetz, 4. Auflage, page 594, No. 22.
Loss in the mail of EPO notifications: would an electronic mail box help?

L. Bosotti (IT)

Most European representatives have presumably passed through the unpleasant experience of discovering that a notification addressed to them by the EPO was not promptly delivered or in some instances never delivered to them, as for some reason the notification went astray in the mail.

Even if the probability of such an event is low in purely statistical terms, this may become a major source of concern for firms handling a fairly high number of European applications simultaneously. Typical consequences of a notification from the EPO not being timely delivered or not delivered at all are e.g. an Examiner's report being left without a response, the applicants' approval of the text proposed for grant failing to be given within the term set in the Rule 51(4) Communication or, in some extreme cases, the date of publication of the mention of grant of an application becoming known too late to the subject handling the application. In some instances, the situation can be easily remedied with the cooperation of the EPO. In other cases the applicant/representative is practically forced to apply for further processing under Art. 121 EPC as an alternative to appealing a decision based on which the application is deemed to be withdrawn. In some extreme cases the consequence may be the loss of rights in one or more contracting states. In any case, unnecessary and time-consuming activity is required both from the EPO and the representative.

In this era where information technology becomes more and more significant in carrying out our activities, both in the office and at home, it is somewhat strange that critical information such as information pertaining to examination before the European Patent Office is conveyed exclusively or almost exclusively by post.
Specifically, the question arises as to whether, while leaving the European Patent Convention and the respective implementing regulations totally unaffected, a sort of mail box service may be organized with the EPO enabling applicants and/or their representatives to make periodical enquiries concerning notifications sent to them by the EPO. This could be done using the methods and hardware currently used for data base searches, in order to monitor the status of the respective applications and check what communications have been mailed by the European Patent Office in respect of what applications.

One may argue that such a possibility already exists today, by questioning EPO data bases such as the EPIDOS Information Register.

However, it is self-evident that such a solution is impractical for firms possibly having to monitor the status of several hundred European applications being handled simultaneously. More to the point, the information so obtained is largely redundant as most of the data thus retrieved are already available with the files of the subject handling the application. Costs would also play a role, having regard to the connection time required for singling out within each file the specific items sought.

Perhaps a much simpler system would be helpful in solving the problem outlined in the foregoing.

Briefly stated, each applicant, representative or group of representatives should be given the possibility of being allotted an electronic mail box with the information system of the EPO. Any time the EPO issues a notification sent to a certain applicant, representative or group of representatives, a record would be generated with the respective electronic mail box simply indicating i) the number of the application concerned (possibly with additional information such as the applicant’s/representative’s file number and the name of the applicant), ii) the nature of the respective notification (e.g. Examiner’s report, Communication under Rule 51(4) EPC, Communication under Rule 51(6) EPC, etc. and iii) the respective date of issue.

Such records could be easily arranged in files each pertaining to the same kind of communications and maintained in the mail box for a given period of time (e.g. one-three months after the date of issue of the respective notification) and then deleted. The applicant/representative concerned, by periodically questioning the mail box could obtain - for instance as an on-line print-out - a list concerning all communications mailed to him or her during the previous months. This would enable a prompt check to be carried out with the files held by the applicant/representative, thus enabling notifications not delivered within a reasonable time to be spotted, possibly requesting mailing of a copy by the EPO.

Arranging such an electronic mail box system should not be particularly expensive for the EPO. Also, a nominal charge covering the respective cost could possibly be billed to representatives requesting such a service. No specific security measures would be required in order to manage such a system, at least insofar as information retrievable by other sources (i.e. the European Patent Bulletin or Register, the EPIDOS file or file inspection) is covered. Nonetheless, the service could be extended also to information not available to the public by using standard methods adopted for data base searches (i.e. passwords and the like).

A further extension of the service could also be conceived for representatives different from the representative or representatives handling the application before the EPO at least insofar the date of publication of the mention of grant (or the date of the decision to maintain the patent in force in amended form) is concerned. In that way representatives charged with the validation steps in a given contracting state could be given the possibility of enrolling in (and only in) such extended portion of the electronic mail box in order to obtain, with the same procedure described in the foregoing, a printout listing all applications handled by that representative for validation purposes for which the publication of the mention of grant has taken place during e.g. the previous months together with the respective publication dates.

Again, it is felt that such a service, in addition to being helpful to applicants and their representatives, would not add to but rather simplify the EPO activity by avoiding unnecessary appeals, requests for further processing or requests for restitution in integrum to be submitted in respect of events attributable only to improper operation of the postal service.

**EPI Excess Liability Insurance 1995/1996**

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Persons wishing to join the EPI insurance policy should directly contact the broker, Funk GmbH, for all policy matters, application forms etc., and payments. Please make your payments to the broker’s account mentioned hereafter, free of bank charges, indicating the following reference “EPI insurance 01 004742 5000” (this is the EPI client number with the broker) as well as your name.
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Date de Remise des Documents pour EPI Information 4/1995

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Selection 1995

Information direct from the source:
A comprehensive collection of the most important regulations adopted since 1977, arranged according to the articles and rules of the EPC and of the Rules relating to Fees
edited by the European Patent Office, Directorate-General 3 (Appeals), Legal Research and Administration

Durchführungsvorschriften zum Europäischen Patentübereinkommen
Auswahl 1995

Information aus erster Hand:
Eine umfangreiche Zusammenstellung der wichtigsten seit 1977 erlassenen Vorschriften, geordnet nach Artikeln und Regeln des EPÜ und der Gebührenordnung herausgegeben vom Europäischen Patentamt, Generaldirektion 3 (Beschwerde), Wissenschaftlicher Dienst und Verwaltung

Règles d'application de la Convention sur le brevet européen
 Sélection 1995

Information à la source :
Recueil des principales dispositions adoptées depuis 1977, classées par articles et par règles de la CBE et du règlement relatif au taxes
publiée par l’Office européen des brevets, Direction générale 3 (Recours), Recherche juridique et administration

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- decisions by the Administrative Council
- decisions and communications by the President of the EPO
- agreements between the EPO and national offices or WIPO.

There are also notices concerning important EPO forms. The collection thus contains texts which are important for the European grant procedure in the broader sense. It also features regulations concerning professional representatives before the EPO and the European examining qualification.

An essential source of information from day to day, the regulations selected for inclusion are reproduced in full. Some of the texts date from the EPO's early days and could otherwise be quite difficult to track down.

The collection therefore fills a gap in the system of publications and collections relating to European patent law.

The table of contents arranges the individual regulations according to the articles or rules for which they were adopted. Indexes in the three official languages make it easier to search for particular terms.

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- de décisions du Conseil d'administration
- de décisions et de communications du Président de l'OEB
- d'accords conclus entre l'OEB et les offices nationaux ou l'OMPI.

Le recueil fait également référence aux principaux formulaires de l'OEB.

Ce sont donc là des textes importants pour la procédure européenne de délivrance au sens large. L'on retrouvera par ailleurs dans le recueil des dispositions relatives aux mandataires agréés près l'OEB et à l'examen européen de qualification.

Les règles d'application contenues dans ce recueil figurent dans leur texte intégral. Elles seront fréquemment consultées pour le travail quotidien. Certaines des textes qui ont été publiées remontent aux débuts de l'Office et ne pourraient, si ce recueil n'existant pas, être retrouvées au prix d'efforts considérables.

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<tr>
<th>Disziplinarrat (EPI)</th>
<th>Disziplinarausschuß (EPA/EPI)</th>
<th>Standesregeln</th>
</tr>
</thead>
<tbody>
<tr>
<td>Disciplinary (EPI)</td>
<td>Disciplinary Board (EPO/EPI)</td>
<td>Professional Conduct</td>
</tr>
<tr>
<td>Discipline (EPI)</td>
<td>Conseil de Discipline (OEB/EPI)</td>
<td>Conduite Professionnelle</td>
</tr>
<tr>
<td></td>
<td>E-Mitglieder - EPI Members - Membres de l'EPI</td>
<td></td>
</tr>
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<td>W. Katschinka</td>
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</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Beschwerdekammer in Disziplinarangelegenheiten (EPA/EPI)</th>
<th>Chambre de recours en matière disciplinaire (OEB/EPI)</th>
</tr>
</thead>
<tbody>
<tr>
<td>E-Mitglieder - EPI Members - Membres de l'EPI</td>
<td></td>
</tr>
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<thead>
<tr>
<th>Berufliche Qualifikation · Professional Qualification Qualification Professionnelle</th>
</tr>
</thead>
<tbody>
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<td>Full Members</td>
</tr>
<tr>
<td>Stellvertreter Substitutes · Suppléants</td>
</tr>
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<tr>
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<th>R. Burt**</th>
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<td>R. Wildi</td>
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<td>LU</td>
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<td>NL</td>
<td>W. Hoogstraten</td>
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<td>P. R. Kristensen</td>
<td>NL</td>
<td>A. V. Huygens</td>
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<td>E. Armijo</td>
<td>PT</td>
<td>J. L. Arnaud</td>
</tr>
<tr>
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<td>M. Curell Suñol (Subst.)</td>
<td>SE</td>
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<td>A. Casalonga</td>
<td>SE</td>
<td>Z. Schöld</td>
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Herausgegeben aufgrund amtlicher Unterlagen des deutschen Patentamts

Inhaltsübersicht:

Abschnitt 1:
Nummernübersicht der Patente

Abschnitt 2:
Gruppenverzeichnis der Patente

Abschnitt 3:
Noch nicht gelöschte Patente

Abschnitt 4:
Anhang
Verzeichnis der im Jahre 1994 für nichtig und teilweise für nichtig erklärtten Patente.

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Von Dr. Gerhard Speckmann
Rechtsanwalt beim Oberlandesgericht Hamm
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1995. VIII, 201 Seiten.
Leinen DM 140,—/ÖS 1100,—/SF 140,—
ISBN 3-452-23297-2

Es haben bearbeitet:


Herausgegeben von
Friedrich Karl Beier, Kurt Haertel und Gerhard Schricker

1984/95. 1.–18. Lieferung, 2501 Seiten. Kartoniert
DM 1042,80,–/ÖS 8170,–/SFr 1043,–
ISBN 3-452-19412-4

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