Symposium

20

Jahrestag des epi
Anniversary of the epi
Anniversaire de l'epi

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Editorial

This special edition of epi Information is given solely to the papers presented during the very successful symposium held on 4th October 1997 in honour of the 20th Anniversary of the epi. The symposium, held in Strasbourg, lasted a full day and featured contributions from some distinguished epi members on a wide range of topics of interest to the profession as a whole.

Thanks should be given to the organizers of the symposium and the contributors to the symposium, all of whom put a great deal of time and effort into making the event such a success.

Jon Gowshall · Thierry Schuffenecker · Edith Vinazzer
Welcome Address
by Arthur Huygens, President of the epi

Monsieur le Président du Conseil d'Administration de l'Organisation européenne des brevets,
Monsieur le Président de l'Office européen des brevets,
Messes et Messieurs les Invités, représentants des Organisations internationales, nationales et régionales et des Organisations soeurs dans le domaine de la Propriété Intellectuelle,
Chers orateurs, modérateurs et autres personnes qui ont contribué au programme du Symposium,
Chers membres de l'epi, Messes, Messieurs,

C'est pour moi un grand honneur et un privilège de vous souhaiter la bienvenue à ce Symposium de l'epi, ici à Strasbourg. Nombreux sont ceux qui, particulièrement en France, considèrent Strasbourg comme le centre de l'Europe. Ceci est certainement vrai pour nous aujourd'hui.

Si nous avons choisi la ville de Strasbourg pour y organiser ce Symposium, cela tient à deux raisons:
D'abord, parce que c'est à Strasbourg que la plupart des jeunes professionnels ont fait leurs premiers pas vers la carrière de mandataire en brevets européens. Les célèbres cours du CEIPI sont devenus un outil indispensable pour la formation des mandataires en brevets européens qui veulent passer l'examen de qualification. Comme nous voulons attirer aussi des jeunes à ce Symposium, nous avons essayé de les seduire en leur offrant une opportunité de rencontrer leurs collègues et amis, là où pour eux tout a commencé.

Et puis, tous ceux qui ont suivi les cours du CEIPI ont raconté à leur retour combien le cours était utile, fatiguant aussi certes, mais surtout ils n'ont pas manqué d'évoquer le charme de la ville. Nous avons pensé que c'était une excellente idée d'y faire venir les grands-parents et grand-mères de notre profession qui n'ont pas eu l'occasion ou devraient dire qui n'ont pas eu le privilège de passer l'examen européen de qualification. Etant conscients que ces grands-parents allaient bientôt devenir une espèce en voie de disparition, nous avons voulu leur donner la possibilité de visiter au moins une fois l'endroit où leurs enfants et petits-enfants ont fait leurs premiers pas vers le bonheur.

As we are here in Strasbourg, in France, very close to the German border, I hope the "francophones" and my German speaking friends will forgive me if I continue my opening speech in English, as a compromise. As you know, my mother tongue, Dutch, is not an official language of the European Patent Office ...... yet.

On 21st October 1977, the Administrative Council of the European Patent Organisation adopted a Regulation on the establishment of an Institute of Professional Representatives before the European Patent Office. Following the establishment of this Regulation, the inaugural meeting of the Council of the Institute was held on 8th April 1978 under the chairmanship of the first President of the European Patent Office, Mr. Bob van Benthem. This date of 8th April 1978 marks the actual start of the epi.

Ladies and gentlemen, it is a very great honour for me to welcome the founding father of the epi, Mr. Van Benthem, at this Symposium.

As I said, the first Council meeting was held on the 8th, and also the 9th April 1978. What I did not tell you was that the 8th April 1978 was on a Saturday. So the meeting was held on a Saturday, and a Sunday, at the Penta Hotel in Munich, next door to the temporary accommodation of the European Patent Office.

Even worse, the meeting started at 8.00 h in the morning! In the past 20 years, the world has undergone enormous progress in many fields, such as social and technological. Reduction of working hours belongs to the achievements of the Western welfare society of today. What has not been changed over the years is that people in our profession have to work on Saturday! I appreciate very much that so many of you came to Strasbourg and gave up part of their weekend, and in Germany their long weekend, to attend the Symposium and participate in the celebration of the 20th anniversary of the epi.

We are still working hard, even at the weekend as we did 20 years ago. The only social progress made over these years is that we are allowed to start half an hour later.

Twenty years of epi. What did we achieve and how will the future look?

At the first Symposium of the epi, in May 1988 on the occasion of its 10th anniversary, the then President Mr. Jan D’haeber gave an optimistic picture of the development of the Institute in its first 10 years. Citing Ovidius, he referred to this 10 years as the Golden Age, although he realised of course that one is used to looking back to the past with a positive mood and tends to forget the negative occurrences.

The first part of Mr. D’haeber’s speech 10 years ago had the title "European Patent Attorney, a new profession?". He indicated that it was probably too early to answer this question in an affirmative way, for a number of reasons: 10 years was too short a period to make a judgment, most of the practitioners had to deal considerably with national affairs and probably would never be a 100% European Patent Attorney. But the most important reason was the fact that very few people had passed the European Qualifying Examination.

Now, 10 years later, this picture has of course been drastically changed. With 5,700 epi members and a still increasing number of European patent applications, for 1997 approximately 90,000, it seems clear that Mr. D’haeber’s question can now be answered with a firm "yes".
Nevertheless, there are still threats, in that the workload of epi members is not evenly divided. We all know that the bulk of the work is concentrated in two main geographical areas and that this problem cannot be easily solved.

Another problem is that the results of the qualifying examination in some countries indicate a very low passing rate which may result in a decrease of members in these countries, keeping in mind the gradual retirement of the so-called grandfathers.

Mr. D'hæmer gave also an interesting forecast of how the epi would look like in about 10 years. That is today, I quote:

"The epi could be an organisation with approximately the same number of members including Danish, Norwegian, Finnish and Irish as well as Portuguese colleagues and a lot of young people that have replaced the big gaps already existing now and becoming bigger and bigger in the near future. There will be a steady flow of new European Patent Attorneys who pass the European Qualifying Examination and will no longer be bothered by national examinations as a superfluous burden and there will be enough experienced colleagues volunteering to be examiners for the European Qualifying Examination or tutors in the preparation courses for it. In the Council there will perhaps no longer be national delegations and certainly no more divided delegations. The term of office will be three or four years so that Council members have plenty of time to concentrate on their real job and forget for a while to be elected again. It could also be that the President or the Secretary General of this Institute has a full time job because he is so busy attending international negotiations and organising training courses.

Perhaps, at the occasion of the 25th anniversary of the epi, there will be a proper General Meeting where a representative number of all the members participate and are engaged in a debate on the future of the epi in the next 25 years."

It appears that 10 years is quite a long time to make predictions. New developments tend often to be much slower than expected. Therefore, you won't catch me hazarding a prophecy for the next 10 years.

The geographical expansion of the EPC from 7 countries in 1978 (Belgium, France, Germany, Great Britain, Italy, Luxembourg and the Netherlands) to 18 countries in 1997 resulted in an increase of new epi members from those countries and, accordingly, in an increase of the size of the Council, the Board and the various Committees of the epi. Various attempts have been made to reduce the size of the Council and the Committees in order to keep them manageable, also in view of further geographical expansion in the years to come.

Last year, the Council eventually accepted a proposal to reduce its own size, and to prolong the term of office from 2 to 3 years, which was then decided by the Administrative Council. Thus, from 1999 the size of Council will be reduced from 91 to 71 members. The size of the Board will remain unchanged, that is 21 members. The size of the Committees is still a point of concern. Some of the Committees are quite popular, but Committee meetings are expensive because of the travel costs. The situation is closely monitored.

Among the most important Committees are the European Patent Practice Committee (EPFC), the Professional Qualification Committee (PQC) and the Committee on Biotechnological Inventions.

The EPFC is the flag of the epi and has, under the excellent chairmanship of Dr. Felix Jenny from the very beginning till May of this year and now under the chairmanship of Mr. Axel Casalonga, made numerous contributions for improving the Implementing Regulations of the EPC and streamlining practice before the European Patent Office. Yesterday, Mr. Casalonga gave his first presentation in the Council of the proposed reply to the Green Paper, which was prepared by the EPPC.

The PQC, now under the chairmanship of Mr. Francesco Macchetta, is working in good collaboration with the EPO on all aspects of the qualifying examination, such as assisting in organising preparatory courses for the examination.

The Biotech Committee, under the chairmanship of Mr. Bo Hammer Jensen, is discussing hot items such as the EU draft Directive on biotechnological inventions and exchanges views with the EPO.

In summary, I believe we can be proud of a good and efficient internal organisation of our Institute which has been built up in the past 20 years.

Despite the excellent and streamlined organisation we are aware that, on a national level, the work of the epi as a professional organisation is relatively unknown as compared with the national professional organisations in the member states.

The majority of the 5,700 ordinary members of the Institute know of the epi because they have to pay the annual subscription fee and they receive the periodical epi information four times a year which they do or, I am afraid, don’t read, and that is it.

Most of our members are also a member of a national professional organisation which they are much more familiar with, because it is more close by. In many countries they get regular information from their national institute, visit annual meetings, meetings on special topics, sometimes social events, etc. These ordinary members are somewhat in the dark as to how the epi is working. This strikes me, the more so because the bulk of the patent work handled by these persons is European patent work rather than work on the national level.

It is my firm opinion that for the people who are handling predominantly European patent work, the epi should be the professional organisation. At present, the epi has about 150 members who are actively involved in the work of the Institute. This number is much too small for an organisation of 5,700 people.
So, the epi has to work on its profile and we, the Council and the Board, are aware of this. In the past few years a start has been made both to inform the public of the epi so that the epi becomes more known, and to reach the users and potential users of the patent system, to give them a guidance on what patents are, how they may be obtained and what you can do with them, and to make them aware that professional help is important.

This has resulted in two recent publications, a leaflet in the three official languages providing concise information on the epi itself and a booklet entitled “Patents in Europe” in various languages. I am sure you will have found a copy of this booklet in the documentation materials handed to you this morning.

But there is more.

In June of this year, we set up a working group with the task of generating ideas and making recommendations to the Board on how the organisation of the epi on a national level can be improved and how the epi can be made more attractive for its ordinary and in particular young members.

Recommendations were given in a very interesting report and it was decided to proceed for the time being with the following items:

- we will edit an epi Newsletter, next to our quarterly periodical epi information, on our home page of the Internet and also perhaps in paper form;
- we will set up an epi students body which should be run by its members;
- I will start discussions with the national patent organisations to investigate the possibilities for a closer collaboration (e.g. by using their national infrastructure);
- we will provide more information to our members. I already mentioned the Newsletter, but we are also thinking of organising regional meetings or Symposia at regular intervals. It is my sincere wish that this second epi Symposium is not only to celebrate its 20th anniversary, but that it also marks the start of a new policy in which providing information to our members, future members and others who are involved in the industrial property field gets a more prominent role in the activities of the epi;
- we will set up, in addition to our existing education programme, a continuing education programme covering areas which are not covered directly or in any depth by the examinations. epi members are highly qualified and in a very competitive environment. It is therefore absolutely essential that we maintain high standards. With this in mind, we will vigorously seek representation rights for our members before any pan-European Court.

These are some thoughts of the future of the epi. There is a lot of work to do, but I am confident that the epi, as the only pan-European organisation of highly qualified professional representatives in European patent matters will further develop to the benefit of its membership.

Finally, I want to touch briefly upon the relationship between the European Patent Organisation and the epi.

In his first address to the epi Council as President of the European Patent Office, in May 1997, Mr. Kober highlighted a number of problems which may be of vital importance for the future of the European Patent System, and which have to be solved satisfactorily if patenting is to be made more attractive in Europe in the next decade.

Mr. Kober emphasized that we, the EPO and the epi, have to solve these problems. We are very pleased to hear that we, the epi, are the clients, partners and ambassadors of the EPO and that our opinion and our support in the decision-making process in the EPO and the Administrative Council is very important.

From our side I can add that the epi is very happy with its observer status in the Administrative Council and the Committee on Patent Law, which gives us an opportunity to give constructive contributions to the possible solutions of the various problems.

I will not repeat here all items raised by Mr. Kober in his speech in May. One item was not raised simply because it was not yet issued and that is the Green Paper of the European Commission, in which a number of questions is raised which are fundamental to the further development of the European Patent System.

Yesterday, the Council spent several hours discussing and deciding on the draft comments prepared by EPPC. We are quite satisfied with the outcome and I hope and believe that the Office will also be satisfied with our comments to a large extent. There will of course be opportunities to exchange views between our organisations in the near future.

Also the excellent co-operation in examination and disciplinary matters between the EPO and the epi is to be mentioned.

This 20th anniversary is of course also a reunion of colleagues who have been actively involved in the building of the epi. I am therefore very pleased that three past Presidents of the epi were found willing to return to the front one time for this Symposium. Mr. Jan D’haerem will be the moderator at the morning session, Mr. David Votier will lead the afternoon session and my immediate predecessor, Madame le Président Elisabeth Thouret-Lemaître will make some closing remarks.

I hope you will enjoy the Symposium and have interesting lectures and lively discussions.

May I now give the floor to the President of the EPO, Mr. Kober.

Thank you.
Address from the EPO President

I. Kober

Monsieur le Président, Mesdames, Messieurs,

Je suis très heureux que vous m’ayez donné l’occasion d’être aujourd’hui parmi vous et c’est un honneur pour moi que d’ouvrir ce symposium avec M. Huygens, le Président de l’epi.

Nous fêtons aujourd’hui le 20e anniversaire d’un membre important de la famille du brevet européen, l’Institut des mandataires agréés près l’Office européen des brevets. L’epi. L’Office européen des brevets et l’epi ont tous les deux été créés par la Convention sur le brevet européen.

Dans toutes les familles, on prête une attention toute particulière, si j’ose dire, au petit frère ou à la petite sœur et c’est ainsi que j’ai aujourd’hui l’honneur de présenter au Président de l’epi et à tous ses membres mes félicitations les plus chaleureuses et cordiales pour tout ce que l’epi a pu réaliser dans le passé.

Il y a vingt ans, la création de l’Institut constituait une étape importante dans l’histoire des professions libérales en Europe, puisque le nouvel Institut a réuni au sein d’un organisme unique et indépendant les professionnels en matière de brevets, provenant, à l’époque, de huit États européens dont chacun avait sa propre tradition.

Les objectifs de l’epi - comme nous les connaissons tous - sont les suivants :

1) collaborer avec l’Organisation européenne des brevets pour les questions en rapport avec la profession,
2) contribuer à la diffusion du travail de ses membres,
3) veiller au respect des règles de conduite professionnelles et
4) établir toutes les liaisons utiles avec l’OE et d’autres organismes pour les questions touchant à la propriété industrielle.

Je reviendrai sur les domaines dans lesquels une coopération entre l’OE et les membres de l’Institut revêt une importance particulière et dans lesquels seule une approche commune nous permettra de relever les défis qui nous sont posés.

Nous avons commencé ensemble il y a vingt ans, et nous assistons aujourd’hui au grand succès du système européen des brevets. Une part importante du mérite en revient aux membres de l’Institut. A l’Office européen des brevets, nous considérons les nombreux conseils en brevets européens répartis sur les 18 États contractants, comme M. Huygens vient de citer, comme nos partenaires et ambassadeurs pour la promotion du système européen des brevets.

Ces sont nos efforts conjoints qui nous ont permis d’améliorer et de rationaliser continuellement la procédure de délivrance des brevets européens, notamment grâce aux précieux conseils fournis par le SACÉPO, qui est le forum de discussion et d’échange régulier d’opinions entre le Président de l’OE, les conseils en brevets européens et l’industrie.

Au cours des dernières vingt années, de nombreuses solutions satisfaisantes ont pu être trouvées aux problèmes communs, après des discussions approfondies dans le cadre de nombreux groupes de travail ou par des contacts personnels dans les cas particuliers.

De nombreux conseils en brevets européens ont bénéficié consacrément leur précieux temps et leur énergie à représenter la profession en tant que membres officiels du jury d’examen et des commissions d’examen pour l’examen européen de qualification, ainsi qu’à participer aux travaux de la commission de discipline et de la chambre de recours statuant en matière disciplinaire. Leur engagement constitue un grand atout dans la réalisation de l’idée européenne.

Dans le but d’améliorer les conditions de dépôt des brevets, plusieurs membres de l’Institut ont testé, soutenu, puis utilisé les dernières technologies introduites dans le système des brevets européens, l’exemple le plus récent étant l’introduction du dépôt électronique dans le cadre d’EASY.

Un autre de nos résultats communs est la disponibilité du répertoire des mandataires agréés près l’Office européen des brevets sur la page d’accueil de l’OE sur Internet et sur le CD-ROM (CD-ROM ESPACE LEGAL) depuis le mois de mars de cette année.

Il est souvent difficile de prédire les développements futurs, mais je suis personnellement convaincu que de grands défis nous attendent. Certains d’entre eux entraîneront des changements radicaux qui exigeront de nous une réaction bien réfléchie. Les sujets en question sont partiellement traités par le Livre vert de la Commission sur le brevet communautaire et le système des brevets en Europe, publié en juin de cette année.

Il revient à la Commission et aux États membres de l’UE, d’un côté, et à l’epi, de l’autre, de décider si, et le cas échéant dans quelle mesure, la législation des États membres de l’UE pourra rendre obligatoire le recours à un mandataire agréé pour la prestation de services spécifiques.

La question de savoir si les législateurs nationaux et les professionnels pourront accepter l’examen européen de qualification comme qualification professionnelle adéquate et suffisante pour la représentation des demandeurs devant les Offices nationaux est un domaine dans lequel l’Office européen des brevets ne sera pas engagé en première ligne des discussions. Il est cependant évident que l’examen européen de qualification pourrait être changé dans un sens ou dans l’autre, si cela était jugé nécessaire pour lui conférer les mêmes effets juridiques dans l’ensemble des États contractants.

Le sujet de la première séance d’aujourd’hui porte en fait sur l’éducation et la formation des conseillers en brevets
européens. Je suis sûr que cet aspect sera également évoqué dans ce contexte.

Il existe d’autres questions que l’Organisation européenne des brevets et les mandataires agréés européens continueront de régler entre eux. L’un de ces points est le coût des brevets en Europe. Le premier pas vers une réduction des coûts à payer par les demandeurs a été fait l’année dernière et cette réforme est entrée en vigueur le 1er juillet de cette année. La période de trois mois qui s’est écoulée depuis et qui inclut les mois d’été, est trop courte pour donner une image claire des effets de la réduction des taxes sur le comportement des demandeurs de brevets. Les chiffres les plus récents incitent cependant à l’optimisme.

Les coûts d’un brevet européen se composent des taxes de procédure, des frais de représentation et de traduction, ainsi que des taxes annuelles pour le maintien en vigueur du brevet. Les coûts totaux pour une protection dans les huit pays les plus fréquemment désignés s’élèvent actuellement à quelque 60 000 DEM, si le brevet est maintenu pendant dix ans.

Avec une part de 18 %, les taxes de l’Office européen des brevets représentent moins d’un cinquième de ces coûts. Un autre cinquième concerne la préparation du fascicule de brevet et la représentation juridique au cours de la procédure de délivrance.

A l’exception du Luxembourg et de Monaco, tous les États contractants exigent une traduction du fascicule du brevet européen, si le brevet n’est pas rédigé dans leur langue nationale. Ceci entraîne des coûts substantiels après la délivrance pour la préparation et le dépôt des traductions. Pour un brevet européen rédigé en allemand, anglais ou français, qui entrera en vigueur dans les huit pays les plus souvent désignés, six traductions doivent être produites pour un coût de 22 500 DEM par brevet. 40 % de l’ensemble des coûts d’un brevet européen moyen sont par conséquent attribuables aux traductions.

La durée de vie moyenne d’un brevet européen étant de 12 ans, une somme totale de quelque 16 000 DEM doit finalement être payée pour les taxes annuelles, afin de maintenir la protection par brevet dans ces huit États. L’Office européen des brevets ne perçoit cependant que 50 % de ces taxes, le solde étant retenu par les Offices nationaux.

La question de la traduction et le problème des coûts qui en résulte a déjà fait l’objet de discussions intenses dans un certain nombre de forums européens. La discussion constitue certes un facteur éminent d’un bon processus décisionnel, et elle est absolument indispensable.

Cependant, à quoi bon discuter un sujet en permanence, si l’on oublie en même temps qu’il est urgent de prendre une décision ? Ceci est également vrai alors même que le sujet, comme il a souvent été souligné, est complexe et de nature politique.

J’ai donc particulièrement apprécié le fait que, lors de la réunion du Conseil d’administration de décembre dernier, l’ancien président de l’EPI, Mme Thouret-Lemaître, n’ait pas seulement appelé de ses vœux des propositions concrètes, mais qu’elle ait également souligné que l’Insti-
Training and Education in Europe

J. Gowshall (GB)

Zusammenfassung / Summary / Résumé


Education and training in Europe has been to date unfocussed and fragmented. It appears to be primarily run by the National Institutes and the National groups of students themselves. Europe-wide variations in experience in taking National examinations, combined with the Europe-wide variations in actual prosecution experience has led to a lack of consistency across Europe in the passing of the European Qualifying Examination. Whilst some measures are in place across Europe for assisting students to prepare for and pass the examinations, such as courses, tutorials and student membership of the epi, there is further scope for collaboration between the epi and students to work together to assist all students to take and pass the European Qualifying Examination.

L’éducation et l’apprentissage en Europe n’ont jusqu’à présent fait l’objet que de mesures parcellaires, essentiellement sous l’impulsion des instituts nationaux et des groupes nationaux d’étudiants eux-mêmes. La différence au niveau des examens nationaux ainsi qu’au niveau de la perception de la procédure européenne ont contribué à accentuer le défaut de cohérence au sein de l’Europe sur la question de l’examen européen de qualification. Bien que des mesures aient été prises pour assister les candidats dans leur préparation à l’examen - les cours, les séances de travaux pratiques (tutorats), et le statut de l’ “étudiant de l’épi”, il persiste cependant un besoin de collaboration plus soutenue entre l’épi et les étudiants de manière à leur faciliter l’accès à l’examen européen de qualification.

The Past

The Patent profession is a small but highly specialised one. Practitioners must be skilled not only in technical aspects but also in legal aspects. It is this rare combination of technical and legal ability that makes a Patent practitioner so sought after.

Traditionally, across the world, the training of a Patent practitioner is split into two fields. The first, the technical field, takes place before the practitioner enters the profession, usually at University. It is at University that the aspiring Patent attorney will learn science in his or her chosen field to a degree at which, whilst they might not be able to practice a groundbreaking science themselves, they are certainly able to understand it when explained by another in their field.

The training in the relevant Patent laws and their practicalities comes with experience of the job of a Patent attorney and is, therefore, traditionally carried out after entering the Patent profession. It is, therefore, not generally the concern of Patent attorneys to train prospective attorneys in their technical field. It is, however, the responsibility of Patent attorneys, both individually and collectively, to train prospective Patent attorneys both to carry out their profession and to pass their qualifying examinations.

Unsurprisingly, because of the qualification restrictions allowing a person to act before many National Patent Offices, as well as before the European Patent Office, education and training are extremely important.
for the continued health of the European Patent profession. Without sufficient education and training to allow new young attorneys to pass the qualifying examinations, the number of attorneys qualified to practice before the European Patent Office will fall and the profession will ultimately die, replaced by more pragmatic practitioners recruited by industry as a necessity, the bulk of the rest of the work possibly being taken by lawyers who do not need to qualify to act before the European Patent Office. Not only does this pose a potential threat to the profession itself but to the quality of work being carried out for clients due to the lack of maintained standard of practitioner.

Regrettably, for a profession that is supposedly pan-European, and has been for 20 years, there is still a wide variance in the number of candidates taking the exams and the percentage actually passing those exams. Even more worrying for the profession in certain countries which are party to the European Patent Convention is the lack of success in the exams of candidates from those countries. Whilst candidates in a few countries, most notably the United Kingdom and Germany, seem to have the ability to pass the European Qualifying Examination with some ease, this is tending to concentrate the number of qualified attorneys in those few countries in which candidates appear to possess those qualities. This is arguably a threat to the profession across Europe, if not from a practical point of view then almost certainly from a political point of view.

The reasons for the gap between the number of candidates actually taking the exam and those passing the examination appear varied. At present, it seems that the disquiet expressed in some quarters as to the standard of candidates taking the examination, seems to be related to the experience of the candidates and their readiness to take the examinations. This appears to be a more or less Europe-wide phenomenon. The other major factor in the ability of a candidate to pass the exams is the training that he or she receives and this appears to vary considerably between various countries.

What is required to take the examination? The first requirement is proof of the technical training, which training is discussed above. Such proof generally requires a University degree certificate or equivalent qualification. In general, Honours degrees in science subjects are classified as a "list A qualification" whereas non Honours degrees and certain other qualifications are designated a "list B qualification".

The second requirement for a person to qualify as a European Patent Attorney is the length of training that they must have undergone. For an individual with a list A qualification, they must have undergone at least three years attested training by a qualified European Patent attorney and declaratory evidence of such training is required to allow the candidate to take the exam. A list B candidate, on the other hand, must undergo six years training by such an attorney. This causes a problem occasionally. For example, as stated earlier, Honours degrees are list A degrees whilst non-Honours degrees are list B degrees. Unfortunately, ScottishUniversities, on principle, do not award Honours degrees although the actual training given by such a Scottish degree is no different from that of an English degree. This has, however, led to the difficult situation that some Scottish candidates find themselves accredited with only List B degrees despite having the same level of technical knowledge as those having List A degrees. In general, however, the technical qualifications are scrutinised carefully by the European Patent Office with the help of the European Patent Institute and an assessment is made on an individual basis in cases in which complaints have been received.

The third qualification a person requires to become a European Patent Attorney is the passing of a European Qualifying Examination. This examination, held in March or April each year, consists of four papers. The papers are the drafting paper, the amendment paper, the opposition paper and the legal paper. The candidate must pass all four papers, although not necessarily at the same time and this, in combination with the technical qualification and relevant length of experience which allowed them to take the exam in the first place, will qualify them as a European Patent Attorney and allow for entry into the European Patent Office Register and simultaneous membership of European Patent Institute. The only exception to the requirement of the technical qualification and relevant length of experience to allow a candidate to take the exam is for European Patent Office Examiners who may defer some of their experience until after they had taken and passed the examination.

The drafting paper provides a candidate with a letter from a client, outlining an invention and the known prior art, and asks the client to draft the majority of an Application. The amendment paper, taken in the afternoon of the same day as the drafting paper, provides a candidate with an application (although no longer drawn up to the same invention as they had in the morning), and provides a typical Communication from the European Patent Office relating to the examination of the Application, as well as some newly cited prior art. The Applicant is requested to draft a response to the Communication. The drafting paper tests the candidate's basic drafting skills whilst the amendment paper tests the candidate's adversarial ability against the European Patent Office as well as their knowledge of European Patent Office examination procedures.

The opposition paper provides the candidate with a Patent-in-suit, instructions from a client and several pieces of prior art, at least one of which is not in the official language in which the examination is written. The candidate must draft a notice of opposition to the European Patent. The opposition paper tests the candidate's linguistic and analytical powers, although there is also a large legal element in each opposition paper.

Finally, the legal paper sets a series of short questions in the first half and one long question in the second half all of which deal with legal problems. This paper is intended to test the candidate's knowledge of the European Patent Convention and associated law as
well as, particularly in the second half, their ability to analyse, organise and answer complex legal problems.

Whilst the European Qualifying Examination is, by its very nature, artificial, the intention of the examination and the foregoing experience period is to prepare the candidates to allow them to act for clients not only theoretically but, far more importantly, practically.

So, given that the examination and qualification requirements for becoming a European Patent attorney are the same across all countries, what is the explanation for the wide variance in apparent ability of candidates from different countries to pass the examination? It seems that the root causes are two-fold: experience and specific training.

Turning first to experience, this is clearly down to the workload of the individual attorney training the candidate. In many countries, European Patent work, at least with regard to prosecution and opposition, is scarce. Therefore, despite the best intentions of the training attorney, there is insufficient work to provide to a candidate to allow them to gain the experience necessary to pass the examinations. This is, of course, something of a self-defeating circle. The less candidates passing the examination the less attorneys there are in the country and the less attractive the country is to Applicants, at least from outside that country to use their European attorneys.

A second area in which a discrepancy arises between countries is in the training. This can be put down to the historical approaches in the various countries to training for their national qualifications, the roots of which go back much further than the 20 years that the European Qualifying Examination has been in existence. Whilst a look at each individual country and its qualification and training requirements would be not only redundant but also exceptionally tedious, I do not propose to examine this at present. For an in-depth view of the training requirements in each of the countries, albeit a little out of date, reference may be made to epi Information number 1/1992 and the relevant article.

Whilst that article concentrates on the qualifications required to become a National Patent Attorney rather than the training available, it is immediately clear that there is an extremely wide variation between the various countries as to qualifications required. For example, at least in 1992, the National bodies required no qualification by examination in Switzerland, Greece, Spain or Sweden. Of the qualification requirements by examination in the other countries, these vary greatly with regard to the number of papers taken and whether or not the papers are solely written or also oral. Many countries have an oral tradition, for example, Italy, in which only one written paper exists. In Denmark three papers existed but these were merely to obtain access to the unofficial list of Patent Attorneys, no official list existing. In contrast, in Germany, two written examinations were required to be taken as well as an oral examination and a period of training in the German Patent Office. Possibly the most stringent territory is the United Kingdom in which a candidate is still required to pass four technical and four legal papers.

Partly due to the wide variation of qualification requirements across Europe and partly just because of different national attitudes, training across Europe also varies greatly. There is little formal training in many countries and, in others, what there is is purely for the oral examinations and fairly unfocussed. At the other end of the spectrum is the United Kingdom which has a vast array of different training available to candidates. Such training includes two lecture series for the two-tier examination system, all organised by the students themselves. The students also organise tutorials in which a qualified tutor takes a small group of tutees through answers that they have prepared to a given paper. There are short, weekend, courses to allow candidates to revise for examinations as well as the longer Queen Mary & Westfield College course which is a part-time diploma course, passing of which allows a candidate to bypass taking the intermediate set of examinations. By way of these mechanisms students are encouraged and, if they consider it necessary, they organise other ancillary training for themselves.

One other factor has been mentioned, with regard to the variation across Europe with the taking and passing of examinations, and that is the language in which the examinations are held. There is little doubt that it is more difficult for a candidate whose native tongue is, for example, Italian, Spanish or Greek to cope with a paper that is written in English, French or German. However, the European Patent Office have consistently taken the view that a European Patent Office attorney must be able to operate in one of the three official languages otherwise they will possibly not represent their client properly. This is certainly true when one considers the necessity to participate in and react quickly to events during Oral Proceedings, which will inevitably be held in one of the three languages. Accordingly, whilst I personally have some sympathy for those candidates who have more difficulty because the exams are not held in their own languages, I understand the approach of the European Patent Office, that those candidates have chosen to enter a profession which is conducted in a language which is not their own and they should be prepared, therefore, for the necessity of using another language.

So what measures currently exist for training candidates across Europe?

There are five measures currently available to all candidates, in all of which the epi and/or the EPO have some involvement. The first, and possibly best known is the CEIPI course. This, in fact, is two courses. The first is a series of courses which give basic patent law training. The second, and probably better known, course is the two week long course, some two months prior to the examinations, which involves intensive group sessions analysing the previous year's examination and the group's own responses to the examination questions. The tutors on these courses are people experienced in the examinations who are, therefore, able to give prac-
tical advice as to how to approach the examination itself.

The second available measure for training is the epi tutorials. The European Patent Institute runs several tutorial groups across Europe. Such tutorial groups involve the candidates answering a set of papers from a previous year, usually the preceding year and forwarding these to the tutor. The tutor will then mark the papers and he/she and the candidates will agree to meet at a specific destination to spend time going through the papers and the candidates’ answers, in order to give the candidate practical advice as to how the examination might best be approached. The possibility of taking two tutorials a year is one that has been under investigation for some time.

The third, and possibly the most esoteric, practical training for the European Patent Office exams is the possibility of working at the European Patent Office as a "stagiare". This is generally open only to candidates from the less well represented countries in the European Patent Organisation. It involves working at the European Patent Office for a number of months and learning, at first hand, how the office works and becoming familiar with the laws and practices of the Offices at first hand.

Whilst there is no doubt as to the extreme value of such a scheme to an individual candidate, because of the very few candidates who are accepted, this is not a viable option for the majority of those wishing to become European Patent Attorneys.

The fourth area open across Europe to assist in training for the examinations is student membership of the epi. Such membership is currently in its infancy and involves signing for four years student membership for a single fee. This entitles the student to all issues of epi Information, as well as a bundle of documentation intended to assist students in their training for the examinations. Such documents include a recommended reading list, a list of available training facilities and a timetable of jobs recommended during various stages of training to provide good experience for the European Qualifying Examinations.

The final option, soon to be available to candidates training for the examinations, is intended to address any lack of experience rather than specific training for the examinations. This is a recently proposed scheme operating jointly between the epi and the European Patent Office to provide trainers with model European files. Such files are real European files, involving issues of interest, which have been rendered anonymous. The intention is that the trainer, who has insufficient European work to give proper experience to their candidate, will make use of these model files by releasing the documentation to the candidate in a steady stream, much as the candidate would receive in real life. This will create a real life case, although one not received from a particular Applicant. It is up to the trainer exactly how to use the materials provided although there is a guideline, at the beginning of the case, to indicate to the trainer exactly what issues of interest are dealt with in particular by the case. It is the intention, ultimately, to provide model Oppositions to allow the training of more than one candidate.

One of the points of particular interest when considering education in Europe is considering who in particular should be responsible for the training of the candidates. There are several possible trainers including the European Patent Office, employers, National Institutes, the epi and the students themselves.

The EPO should not be encouraged to involve themselves in the training of attorneys. This is for several reasons. Firstly, the EPO is generally considered to be "on the other side " from Patent attorneys and as such is viewed with suspicion by many Patent attorneys. Furthermore, it is vitally important for a healthy profession and Patenting system for the two sides, whilst retaining mutual respect and co-operation, not to be beholden to each other. There will always be the suspicion that, if the European Patent Office takes some responsibility for training attorneys, such training might be directed towards the European Patent Office’s needs rather than the needs of the attorneys and their clients. Whilst I believe that any such suspicion is almost certain to be unfounded, it would be best not to raise such suspicions in the first place and, for this reason, I do not believe that it is the place of the European Patent Office to train professional representatives.

Employers and national Institutes are, in a way, equivalent. Both are able to give individual assistance, although in a relatively limited fashion. In terms of the profession as a whole, neither can be considered to be sufficiently reliable in having a general intention to direct candidates towards passing the European Qualifying Examination. National Institutes are, understandably, particularly concerned with national problems although many are also involved with Europe. In the United Kingdom, for example, the national Institute provides European tutorials and lectures to assist candidates in approaching the European examinations.

Employers are, of course, expected to give support to their individual trainees and, in many cases, this is so. Such support is not just important but essential. The employers may assist the candidate by advising them of the best training courses, paying for commercial courses as necessary, such as the two commercial courses in the United Kingdom, arranging for attendance at the CEIPI course and the European tutorials as well as, of course, giving specific in-house training and allowing the candidate access to developmental materials.

However, regrettably, training cannot be left in the hands of individual employers for several reasons. Firstly, of course, not all employers are as aware of the possibilities for training as they might be. Many others, although having the best intentions, do not have the work or experience available to train the individual attorneys. More regrettably, it is rumoured that in some areas of employment the employers actively do not wish their candidates to take their examination on the grounds that qualification would render their employees not only better paid and thereby more expensive to
the employer but, also, more attractive to competitors. For such employers, an unqualified but experienced employee is the ideal employee.

It, therefore, appears to us that the bulk of the responsibility for training the students should fall both on the epi and on the students themselves. Whilst, of course, the responsibility on the students themselves has always been present, this is often in an unfocussed and individual way. Ultimately, the major responsibility is that of the students because they are the individuals who will benefit most from passing the examinations. However, the European Patent Institute, in the interest of the profession as a whole, should give as much sup-
port and encouragement to the students as possible, however. To date, whilst many measures have been taken by the European Patent Institute to assist students in their training, much of what has been done has been vaguely paternalistic and has certainly been for the students rather than with the students. As such, the students themselves are not encouraged to help themselves nor are they greatly assisted so to do. It seems to us that the potential of the epi working in tandem with the students has not yet been explored in any great measure and would seem to be the way forward in improving training throughout Europe.

Education and Training of European Patent Attorneys (EPAs) at the European and National Levels

F. Macchetta (IT)

Zusammenfassung / Summary / Résumé


Professional representation in proceedings established under the EPC requires training at different levels and with a multiplicity of tasks and objectives. At entry level two different forms of training appear to be necessary: training for learning the various aspects of the profession (on the job training) and training for passing the European Qualifying Examination. During the professional life following passing the examination, or entry under Art. 163(7) EPC, continuing education is required to keep abreast with the continuous evolution in this field of Industrial Property. The measures that epi has been taking and those that are under consideration are briefly presented to open a debate on these themes of general and common interest.

La représentation professionnelle dans les procédures instituées par la CBE exige une formation à différents niveaux et en vue de divers tâches et objectifs. A l'entrée, deux formes d'apprentissage apparaissent nécessaires: l'apprentissage des divers aspects de la profession, et la formation en vue de l'examen européen de qualification. Après la réussite à l'examen européen de qualification, ou l'insertion dans la profession en application de l'article 163(7) de la CBE, la formation professionnelle continue s'impose encore en vue de la nécessaire adaptation à l'évolution constante du droit de la propriété industrielle. Les mesures prises par l'epi à cette fin, et d'autres, sont brièvement présentées en vue d'un débat d'intérêt général.

Introduction

Professional representation in matters established under the EPC is established by the Convention itself (Art. 134 EPC), that allows however natural and legal persons having residence or principal place of business in a Contracting State to act per se (Art. 133(2)EPC).

The creation of the Institute of professional representatives is also authorized by the Convention itself (Art. 134(8)(b)EPC).

Professional representation under the EPC is therefore one of the essential elements for the correct and efficient working of the complex and articulated system established by this Convention.

Notably, the EPC does not make any difference among professional representatives employed in industry or engaged in private practice.

The essential features of this professional job and its remarkable interdisciplinarity has been already illustrated by Jon Goshall and I want just to make reference to it, without repeating it here.

It follows plainly from all the above that it is essential for the healthy functioning of the whole system that a
Training for entering the profession

As already indicated by Jon Gowshall, entering the profession, in addition to a University level scientific education, requires a minimum period of training in the professional activity (3 years) and passing an examination (the so-called European Qualifying Examination or “EQE”).

It is to be noticed that the minimum period of training and passing the EQE are two distinct requirements that serve two different purposes, in my view, and that, as reported below in more details, require implementing distinct training strategies.

The purpose of the professional training, I believe, is mainly that of giving the perspective EPA a sufficient experience in a broad range of professional activities in order to be ready to serve its clients’ interests in a relatively autonomous and responsible way, while the main purpose of the EQE is that of indirectly verifying the candidate’s ability to satisfactorily master some essential professional tasks and certify it, to the clients’ and public benefit. As with any examination, this is done in a necessarily artificial setting, that it is however devised, by the EQE Examining Committees under the direction of the EQE Board, so as to give a reliable indication of the candidate’s professional skills and capabilities.

I see the duty of the epi in respect of the EQE itself to be active, mainly through the efforts of its members in the EQE Committees and Board and in the epi-PQC, in assuring that the examination remains as close as possible to real professional life and serves its purpose of certifying that those who are successful have shown possessing the basic professional skills that are necessary to properly serve the clients’ interests in the area relating to the European Patent Convention.

As mentioned above, training for the EQE is, at least in my view, logically and practically distinct from training for the “normal” professional activity, with this latter having far more importance for the future activities of the perspective EPA.

At variance with training for the professional activity, training for the EQE is to be based in fact mainly on the examination papers of the previous years and the acquiring of a systematic and methodological approach to successfully answer the examination questions and perform the other examination tasks within the allotted time.

In addition to the many institutions and private organizations that offer preparation courses to the EQE, epi has been offering its tutorial program (as illustrated by Jon Gowshall) since the early 80.

This year, this program has been expanded with the addition of an Autumn session mainly for those wishing to review the papers of the current year in which they were not successful (see OJ EPO 9/97, page 442 and epi-Information, 1/97, 27-28) and prepare for the next sitting. Next year, the epi should be able to satisfy demands for weekend seminars, to be held preferably in September, aimed at completing the background preparation to the EQE.

On the professional training side, it must be remembered that training of new entrants is not only the task of the individual EPAs in charge of training new colleagues, but it is also a duty of the epi as a whole.

Training on the job is by far the most important way to learn this profession, at least in my view and experience; and we must always keep it in mind and underline its importance. While it is not substituted by any “academic” type of teaching, it may well be supplemented and reinforced by it. As indicated by Jon Gowshall, epi members are actively working within the framework of CEPI in a biennial basic course on the EPC that is held in several centers in Europe.

epi PQC is also trying to establish a system of training by case study, aimed in particular at supplementing the training of the candidates in those geographical areas where there happen to be less “European” patent work and therefore less on the job training opportunities. Also in this case, I’ll try not to repeat Jon’s presentation, but I leave for the discussion to further explore this area, while I invite everybody to consider volunteering for preparing a model case and to inform a PQC member or myself accordingly.

It is commonly accepted that a balanced geographical distribution of the patent profession is an important element to serve the need of the local innovative industry better and to promote the widespread awareness of the patent system, in addition to being an element enhancing a distributed professional competence and competition.

epi has been working in this direction since its beginning and the focusing of its additional training initiatives toward it is expected to contribute to maintaining a healthy and efficient European patent profession well beyond the turn of the century.

Another initiative that is still in its infancy, with its less than 200 enrollments in its 3rd year of existence, is the epi studentship. Without repeating, I would like to
remark its high potential in term of exchange of experience and information and common organization of training activities that epi, and its PQC in paricular, will have to assist in developing. It is expected that in the near future it undergoes a rapid evolution based on a more active role of the students' themselves in organizing their demands for activities finalized at their professional training. A whole new perspective is available for the students, and not only for them, by the availability of the epi home page on Internet and the use of electronic communications as a means for information and dialogue that virtually overcomes any distance problem.

Continuing professional education

Continuing professional education is a need for any activity, and the patent profession is no exception to it. On the contrary, by being a profession in a highly interdisciplinary area, at the cross-road of national and international systems, and in continuous evolution, continuing education is really germane to it and represents no news to any member of the epi, who have been practicing it not just as a "virtue", but also as a necessity.

What new then?

I think the new challenge for epi is to think of it as one of the tasks to be performed as a unitary body, and not just individually or by national or other groups of interests.

I would like therefore to indicate some of its possible features, just for the sake of discussion and with the aim of contributing to a common definition.

A first feature is in my view that of being European. After its first 20 years as a European professional order, epi is uniquely experienced and qualified to opening new grounds in this direction. We are aware of being probably the only working professional order at European level, with a high degree of integration and completely harmonized entry rules and mutual recognition. We are thus well equipped for developing it further on a common European basis.

A second feature is that of promoting a common and high professional standard, that is just one of the vital aspects for any professional activity that cares for its future.

A consequent feature is that of being geographically balanced in the sense of promoting an offer for continuing education throughout Europe with an attention to those areas where the growth of our profession seems to have more difficulties or a slower pace.

A key feature, in my view, is also that of being experience driven and not mainly "academic", to build on the vast practical experience that we have in our professional activity, with its unique interdisciplinary blend of technical, "legal", and economic aspects, that, I believe, makes our professional contribution to technical innovation so important and, probably, not yet fully understood at Institutional and, sometimes, even at industrial level.

I imagine the role of epi in this area of its continuing education to be that of promoter and driving force; not necessarily that of direct provider, but only experience will tell.

Further study and proposals are being prepared by epi PQC and I hope we can see this subject adequately developed in the near future.

New challenges and opportunities.

I believe that one of the most important challenges and opportunities that we have in these days is to promote the understanding of the essential contribution that professional representation may offer to the operability of a possibly new European Union patent system as well as an improved European patent system with a common, integrated and harmonized system for judging the infringement and validity of European Patents, that includes the possibility for epi members to represent their clients before any Institution or Court that is being charged with the competency or jurisdiction in patent matters.

While we are convinced to already have the necessary experience and skills for this latter task, because of the ability to represent our clients before e.g. the EPO Opposition Divisions and Boards of Appeal, it might well be one of the themes for our continuing education activities.

In Summary:

New entrants:
- emphasize:
  - training and on the job experience
  - geographically balanced training opportunities
- de-emphasize:
  - EQE pass rate, as such

Continuing professional education:
- sustain developing a high and common standard for our pan-European profession
- promote geographically balanced opportunities
- increase the visibility and reputation of epi in the Intellectual Property world and the general public.

New opportunities:
- contribute to the debate on a common patent system for the EU as well as an improved European Patent system with a common, integrated and harmonized system for judging infringement and validity
- obtain recognition of the epi professional representation role before any Institution or Court that is being established under these systems.
Die Patentschutzfragen für Software ergeben die Frage der Verfügbarkeit der Quelltexte. Dies betrifft sowohl die kommerzielle Nutzung als auch die Forschung. Für Forschungszwecke sind Quelltexte oft unverzichtbar. Es gibt jedoch Probleme mit der Schutzrechtsverletzung, da es häufig nicht klar ist, ob und wie der Schutz verletzt wird.

Das Patentrechtillignial die Softwareerfindung, die durch Inhalte und Funktionen gesteuert werden, um eine bestimmte Aufgabe zu erfüllen. Die Schutzrechte können dadurch eingeschränkt werden, wenn die Software als Produkt oder Dienstleistung vermarktet wird.

Die Schutzrechtsfrage ist eine komplexe Angelegenheit, die sowohl aus technischer als auch rechtlicher Perspektive betrachtet werden muss. Die Lösung liegt in einer klaren Regelung des Schutzrechts und in der Implementierung von Technologien, die das Schutzrechtsverletzungen minimieren.

Die Softwareerfindung sollte nicht unbedingt geschützt werden, um die Wettbewerbssituation zu verbessern. Vielmehr sollten die Schutzrechte darauf ausgerichtet werden, das Innovationsanspruch der Software zu fördern. Die Softwareerfindung sollte jedoch auch nicht komplett geschützt werden, um die Verfügbarkeit für Forschungszwecke zu sichern.

Die strategische Bedeutung der Softwareerfindung für die Wirtschaft und die Gesellschaft wird immer größer. Deshalb ist es wichtig, dass die Schutzrechtsfragen für Softwareerfindungen klargestellt werden, um ein möglichst fairen und transparenten Wettbewerb zu gewährleisten.

In der Praxis bedeutet dies eine klare Definition der Schutzrechtsbereiche, die auf technische Innovationen konzentriert sind und nicht auf kommerzielle Nutzungsmodelle. Es ist jedoch auch wichtig, dass die Forschung auf dem Gebiet der Softwareerfindungen nicht eingeschränkt wird, um die wissenschaftliche und technologische Fortschritt zu fördern.
de réalisation dérivés ou comportant des équivalents (qui ne seraient pas considérés comme des atteintes au droit d'auteur), les perfectionnements apportés au concept de base, bref tout ce qui rentre dans le cadre du concept inventif réalisé par l'auteur du fait de son effort en recherche-développement.

II. La réception par le droit européen de l'invention dans la création logicielle. Après avoir rapidement évoqué l'état du droit européen du brevet, la question de son évolution est envisagée afin de rechercher de quelle manière les règles et les concepts du droit européen pourraient recevoir ces nouvelles valeurs économiques. En s'appuyant sur des considérations épistémologiques, l'auteur avance l'idée suivant laquelle ces règles et concepts applicables en la matière - et notamment celui d'effet technique ou de contribution technique, portent en eux le germe d'une adaptabilité réelle qui pourrait utilement servir à la réception par le droit des nouvelles valeurs issues du génie logiciel.

Nul ne contestera le développement spectaculaire de l'industrie informatique et en particulier des logiciels. Tout comme les premiers colons qui débarquèrent en Virginie à la fin du XVIème siècle, nous assistons, à l'aube du troisième millénaire, à la conquête par l'énergie humaine de terres nouvelles, au rythme de l'activité de recherche dans l'industrie du logiciel. Et le droit, qui a vocation à régir les activités de l'homme, ne saurait se désintéresser des nouvelles valeurs économiques dérivées de cette pratique. Dans nos sociétés de marché, la réception de nouvelles valeurs économiques que le droit juge conforme à l'intérêt social passe par l'attribution d'une exclusivité, d'un monopole, comme celui que confère le brevet d'invention.

Cependant l'appropriation du logiciel par voie de brevet soulève des objections et suscite des questions. D'où proviennent-elles?

Les difficultés sont-elles purement d'ordre technique? Certains pourraient être tentés de le croire et considérer que l'instrument juridique que constitue le brevet n'est pas approprié à cette sorte de création industrielle car cette dernière, mêlant l'utile et le beau, le fonctionnel et l'esthétique, suscite la concurrence des autres lois de propriété intellectuelle: loi sur les dessins et modèles, loi sur le droit d'auteur... A ces premières difficultés s'y ajoutent d'autres, relatives à la recherche documentaire, lesquelles sont vraisemblablement à l'origine de la hâte avec laquelle on a pu-être exclu les programmes d'ordinateur de la brevabilité. S'y ajoutent encore les difficultés de technique rédactionnelle pour ces nouveaux objets juridiques qui requièrent pour leur parfaite réservation des jeux de revendications multiformes, souvent de catégories différentes - procédé, appareil, utilisation, support destiné à porter le programme... etc... - pour en rendre compte tous les aspects et notamment leur fabuleuse transmissibilité physique, à l'image d'une disquette que l'on glisse dans la poche?

Des difficultés d'ordre idéologique s'ajoutent à celles d'ordre technique. La création logicielle est relativement récente et a entrouvert un espace, un domaine d'expressivité que certains programmeurs n'hésitent pas à ranger au nombre des libertés fondamentales, des libertés publique où chacun doit pouvoir disposer de sa liberté d'aller et venir. L'association américaine "the league for programming freedom" prône cette idée et entend faire barrage au concept de brevet de software. Dans un domaine pas très éloigné, celui d'Internet, on retrouve une inspiration semblable chez certains qui voulaient pouvoir disposer à leur guise du Web et de son contenu, et le soustraire à l'application stricte des monopoles comme ceux du droit d'auteur?

Le génie logiciel et grand Réseau devraient-ils constituer de nouveaux espaces de liberté devant être préservés au bénéfice des générations futures de programmeurs et d'internautes, à l'image de la terre ou de la lune consacrées comme patrimoines communs de l'humanité?

La réponse ne peut être que négative car rien ne distingue fondamentalement les créations logicielles des autres créations technologiques qui ont marqué l'évolution de l'humanité. N'a-t-on pas d'ailleurs souligné l'interchangeabilité des machines « hardware » et « software », montrant que tout ce qui peut être réalisé avec une machine « software » peut être obtenu à partir d'une machine entièrement câblée. Le sentiment de liberté qui est ressenti aujourd'hui si fortement par les utilisateurs de programmes informatiques n'est-il pas fondamentalement le même que celui que connurent les générations antérieures, lors de l'avènement de l'invention de la lampe électrique, du téléphone ou de la machine à vapeur. Toutes ces créations ont contribué à libérer l'homme de sa condition matérielle, et lui ont entrouvert de nouveaux et formidables espaces de liberté.

L'observation essentielle, et c'est celle qui fera l'objet de notre première partie, est que la création logicielle constitue l'âme de la technique informatique, sans laquelle les matériels demeuraient des armoires mortes. Elle porte au plus profond de sa substance, cette aptitude, cette capacité à être appréhendée par ce droit qui s'occupe essentiellement des techniques industrielles, à savoir le droit des brevets. Nous examinerons dans une seconde partie de quelle manière le droit européen des brevets reçoit et pourrait recevoir ces nouvelles valeurs économiques dérivées de l'industrie du logiciel.

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1 Cf. les revendications de type « Beauregard » et les discussions qu'elles soulèvent.

2 Cf. les efforts de groupes de pression comme « Electronic Frontier Foundation » (EFF) qui milita aux États-Unis pour la liberté d'expression dans le Web. Mme Esther Dyson, sa vice-présidente, s'exprima ainsi « La propriété intellectuelle, ancienne dans une économie fondée sur le « Not » et risquant de se dévaluer, horripille la majorité des propriétaires et des créateurs... Planète Internet. Sept-Oct. 1995, p. 38

I. Le concept inventif dans la création logicielle.

La création logicielle porte substance à être traitée par le droit des brevets, car sa valeur économique ne saurait se réduire aux seules formes concrètes de réalisation choisies par l’inventeur-programmeur (A). Il faut alors attribuer à cette valeur économique le bénéfice de l’application du droit des brevets (B).

A. Distinction de la valeur économique et des formes de réalisation.

La valeur économique ne se réduit ni à l’inventé (1), ni à l’objet du droit d’auteur (2). Cette double observation nous conduira au concept inventif sur lequel est basé le logiciel.

1. La valeur économique ne saurait être confondue avec l’inventé, c’est-à-dire avec les formes concrètes de réalisation. La valeur économique demande pour sa réalisation un complexe de matériels et de programmes un « mix d’éléments techniques et non techniques », pour reprendre une formule des chambres de recours. Elle ne saurait cependant se réduire, dirons-nous se limiter, à ce « mix » particulier (type d’ordinateur sur lequel le programme a été conçu ou est appelé à fonctionner, ensemble des autres programmes nécessaires à son fonctionnement, langage de programmation particulier employé etc...) Elle s’étend au-delà de la combinaison particulière des éléments hardware et software qui a été concrètement envisagée par l’inventeur. Cette première observation, déjà bien connue, ne nécessite pas de développements complémentaires.

Si elle ne se confond pas avec la forme concrète de l’inventé, la valeur économique ne se confond pas non plus avec l’objet déjà reçu par le droit d’auteur, et auquel on reconnaît pourtant déjà une certaine forme d’abstraction.

2. La valeur économique ne saurait se confondre avec l’objet du droit d’auteur. Les lois sur le droit d’auteur s’appliquent aux logiciels sans pour autant définir ces derniers. Le droit, bien que posant le principe fondamental de l’attribution d’une protection aux seules formes exprimées, n’exclut pas que l’objet de la protection puisse présenter une part certaine d’abstraction puisque la jurisprudence tend à y incorporer des objets tels que enchaînements particulier de modules, routines fonctionnelles, fonctionnalités essentielles du programme....

Cela est il suffisant pour assurer une protection efficace des droits légitimes de l’inventeur-programmeur? Certainement pas, car nonobstant la protection déjà accordée aux abstractions mentionnées précédemment, nombreuses sont les atteintes essentielles et non sanctionnées que peut subir la valeur économique du logiciel, faute, pour le droit d’auteur, et son application par les tribunaux, d’englober le concept inventif à la base du logiciel.

B. Identification de la valeur économique au concept inventif.

La valeur économique doit pouvoir incorporer, dans notre logique de praticiens, d’autres modes de réalisation, de perfectionnements, bref, toutes les solutions techniques que le logiciel original mettait déjà en oeuvre. Nous disons qu’il y a là un second objet qui est distinct de celui protégé par le droit d’auteur, et qui porte sur le concept inventif.

Ne serait-il pas anormal de persister dans l’idée que les inventions de programmation ne peuvent bénéficier d’une protection s’attachant à leur concept inventif (sous réserve bien entendu des critères habituels de brevabilité), alors que toutes les autres peuvent en bénéficier?


II. La réception par le droit des brevets du concept inventif dans la création logicielle.

Il n’est pas inutile de rappeler les principes de base (A), puis d’évoquer les développements potentiels que l’on pourrait en attendre. (B).

A. Principes de solution.

L’article 52(2) exclut expressément la qualification d’invention pour les programmes d’ordinateurs. L’alinéa 3 précise cependant que cette exclusion ne joue que dans la mesure où la revendication porte sur un programme en tant que tel. La position des Chambres de Recours s’exprime dans un certain nombre de décisions, au rang desquelles se trouvent bien évidemment les décisions bien connues VICOM, Koch & Sterzel, et bien sûr IBM.4

Ces décisions ont mis en évidence le critère mis en avant par les chambres, et qui porte sur la contribution technique à l’état de l’art que le concept inventif est susceptible d’apporter. Sur la base de cet apport jurisprudentiel, les autorités de la DG2 ont élaboré une approche intellectuelle qui est résumée dans les directives afin d’examiner, au cas par cas, la contribution faite par une création logicielle à l’état de l’art. La simplicité apparaît de cette approche a conduit certains à considérer suivant en cela une formule de M. le Vice-Président Wal-

lace - que "l'invention technique est comme un chameau qui est plus facile à reconnaître qu'à définir".

Si l'on évoque par exemple la décision VICOM, l'invention porte sur un procédé de traitement de signal de télévision et la revendication première définit ce procédé en empruntant largement au formalisme mathématique. En revanche, il était précisé que ce processus qui était défini par l'instrument mathématique s'appliquait à une image, laquelle se trouvait codée sous la forme d'un signal électrique. Et c'est la réalité de ce signal électrique, de cette entité physique, qui fut retenue par la Chambre comme décisive pour qualifier le procédé en cause d'invention:

"Si l'on utilise une méthode mathématique dans un procédé technique, ce procédé s'applique à une entité physique (qui peut être un objet matériel mais également une image mémorisée sous forme de signal électrique) par quelque moyen technique mettant en œuvre la méthode et il en résulte une modification de cette entité." 5

B. Evolution

Cette position est-elle satisfaisante? Sans doute pas complètement pour certains qui trouvent le critère trop restrictif. Il est d'ailleurs probable que les Chambres de recours s'interrogent elles-mêmes sur cette question de savoir jusqu'où on peut aller dans la brevetabilité du logiciel.

Il paraît certain que la voie du brevet n'est pas convenable pour réserver un logiciel contenant une collection de photographies, ni d'ailleurs un livre d'images. Le croire reviendrait à breveter un livre en raison de son contenu uniquement, ce qui n'est ni utile, ni opportun puisqu'il existe déjà la protection par le droit d'auteur pour réserver le contenu d'un livre, qu'il soit informatique ou pas. Par contre, la structure du livre, la composition du papier peut être brevetée. Il doit pouvoir en être de même pour tous les rouages, les ressorts qui en constituent les mécanismes internes de la forme électronique du livre moderne. Les chambres de recours seront elles prêtes à accueillir ces inventions? Nous pensons que cela n'est pas impossible car le critère qui est retenu jusqu'à là, l'effet technique, porte en lui les germes pour adapter le droit à ces nouvelles valeurs économiques.

On a vu en effet que la validité d'un brevet découle de la réalité, ou ce peu de substance que l'on attribue à une notion aussi imperceptible pour l'homme (lorsqu'il est dénué d'instrument approprié) que peut l'être un signal électrique servant à coder une image. Sans vouloir réduire par trop l'importance de la réalité physique de cette entité, qui à une époque pas si lointaine était considérée comme immatérielle, cette observation nous permet d'évoquer cette idée fondamentale suivant laquelle l'appréciation des choses évolue constamment et que les concepts, même ceux issus de la recherche scientifique, ne sont jamais figés et gravés dans la pierre. Bachèlard a médité le nouvel esprit scientifique et, dans le domaine scientifique comme dans bien d'autres, il y a une évolution constante des idées et de la perception par l'homme des choses qui forment son environnement. L'apparition de nouveaux instruments de mesure ne contribue-t-elle pas à forger de nouvelles réalités au même titre que l'oscilloscope a révélé la matérialité du signal de télévision? Il en découle une marge de manœuvre considérable pour adapter le droit et ses concepts au besoin social du moment. Ainsi, Auguste Comte excluait la minéralogie et la chimie des entités concrètes car étant, à ses yeux, trop abstraites. Il est certain qu'un tel jugement de valeur, exprimé à notre époque, aurait pour effet d'anéantir l'ensemble des brevets de la recherche chimique, pharmaceutique, mais également les semi-conducteurs et sans doute bien d'autres. Auparavant, le fluide électrique était considéré comme sans substance et cette opinion aurait aujourd'hui pour conséquence la nullité de la plupart des brevets qui sont issus de la recherche électronique ainsi que des télécommunications.

Ces observations montrent à quel point le caractère physique que l'on attribue à une entité ou son corollaire le caractère technique - dépend finalement de la culture d'une société à un instant donné et exprime l'état de la perception par cette société de son environnement. Appliquée dans le droit des brevets, cette évolution ou plutôt cette évolutivité apparaît bien évidemment comme une marge de manœuvre considérable pour adapter le droit et ses règles aux besoins sociaux du moment, et recevoir les valeurs économiques nouvelles qui sont issues de l'activité humaine. Les concepts portent par conséquent en eux les germes d'une adaptabilité réelle. Après tout, n'a-t-on pas appelé machine la perspective à réduire les trois dimensions aux données d'un plan 6 et Descartes n'enseignait-il pas de ramener toute science à la mécanique? Combien d'applications graphiques, dans le milieu médical mais également dans l'automobile, ne pourrait-on appeler ainsi "machines"?

Les Chambres de recours nous semblent faire preuve de pragmatisme dans l'appréciation des concepts mis en œuvre dans les demandes de brevet. Elles ont en effet déjà considéré que dès lors qu'un ordinateur, même non modifié sur le plan de sa constitution, fonctionne d'une manière différente, en raison de l'introduction d'un logiciel nouveau, il y a nouvel effet technique entraînant la qualification positive d'invention.

De la même manière, dans la décision T769/92, elles ont retenu l'existence d'une contribution technique pour un logiciel de gestion effectuant un traitement différentiel et indépendant de plusieurs tâches, même si ces tâches sont relatives à de la gestion financière ou d'inventaire.7

La même adaptabilité semble apparaître auprès des autorités de délivrance qui se montrent favorables à l'assimilation des nouvelles réalités du génie logiciel à des choses aussi traditionnelles que peuvent l'être un

5 T208/84, JO OEB, n° 1, 1987, p. 14

6 M. Focillon, dans La vie des formes, Paris, Alcan, 1939 dénommait ainsi la perspective: "Nous à Florence la collaboration des géomètres, des architectes et des peintres, inventant ou plutôt mettant au point la machine à réduire les trois dimensions aux données d'un plan, en calculant leurs rapports avec la précision des mathématiques".

7 Décision T769/92, 31 mai 1994, JO OEB 1995, p.525
Non-Patentable Inventions: Consequences on R&D in Europe and Competitiveness of European Firms

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Zusammenfassung / Summary / Rémumé

Patentgesetze sind in einer Hinsicht eigenartig, sie geben keine Definition darüber, was eine Erfindung ist: Ganz im Gegenteil, die meisten Patentgesetze enthalten Bestimmungen darüber, was keine Erfindung ist. Im Gegensatz zu der Situation in den USA geben europäische Patentgesetze darüber hinaus an, welche "Erfindungen" nicht patentfähig sind.

Die Hintergründe für diese Situation liegen im allgemeinen in moralischen und sozialen Bereichen. Diese Hintergründe werden diskutiert und es wird untersucht, welche positiven und auch negativen Auswirkungen gesetzliche Ausschlüsse von Erfindungen auf Forschung und Entwicklung und auf die Wettbewerbsfähigkeit europäischer Firmen haben. Darüber hinaus werden Empfehlungen für die Behandlung dieses Themas durch Anmelder und Patentämter gegeben.

Patent laws are peculiar in that they do not contain a definition of what constitutes an invention. On the contrary most patent laws comprise definitions of what are not deemed to be inventions. In contrast to the situation in the USA, the European patent laws furthermore define that certain inventions are not patentable.

The reasons for this situation are generally based upon moral and social grounds. These will be discussed and it will be investigated what positive and negative effects such exclusions may have on R&D and competitiveness in European companies giving recommendations.

as to how these issues should be handled by applicants and patent offices.

Les lois sur les brevets ne définissent pas le concept d'invention. Au contraire, la plupart posent des définitions de ce qui n'est pas considéré comme des inventions. Par contraste avec ce qui se passe aux États-Unis, les lois européennes sur les brevets excluent de la brevetabilité certaines inventions.

Des fondements tant moraux que sociaux peuvent expliquer cette situation. Sont discutés les effets de telles exclusions, positifs et négatifs, sur la R&D et la compétitivité des entreprises européennes ainsi que la manière dont les demandeurs et les offices de brevets devraient appréhender cette question.

What Are Inventions

Inventions are generally speaking solutions to problems. Inventions are made by many people every day in the normal course of life, when we encounter a problem to which we do not know an immediate solution. Most inventions are never registered in any way, but only stored in the mind of the inventor for use a later time, if a similar problem occurs in his life, and often a new or modified solution will be used in such a case.

In the development of the European culture the concept of monopolies was introduced in order to promote the development of specific trades or manufacture. It was believed that if a person or a group of persons were given the monopoly of e.g. performing trade with the far east or the production of porcelain, then the holder of the monopoly would be willing to invest the
large sums necessary for setting up the expeditions thereto, or build a factory.

Such investments were costly and risky, and therefore the investors needed the assurance of a handsome profit.

This concept developed into the system of intellectual, industrial or immaterial property rights we have today. As the name says, these rights are related to intangible products, the products of the mind. We have copyrights for the artistic expression, design rights for the shapes of products, and we have patent rights for technical solutions to specific problems. These rights provide the creator, inventor - or those financing the activity - with the right to prohibit others from using these creations of the mind commercially.

For some reasons certain limitations were made in these rights whereby discoveries and natural laws were deemed not to be inventions, but something inherent in nature, and thus not eligible for protection under these laws.

Also, it was decided to limit the granted patent rights to a number of years. Up to quite recently this number was counted from the grant of the patent, but today practically all countries provide patent protection for twenty years from the filing of a patent application.

**How Do Inventions Occur**

According to my experience there are two ways inventions are made, namely "purposely" and "serendipity".

A purposively made invention is one where the inventor has identified a problem and works on solving that problem. An example is the harvesting of apples. Some of the apples are too high up in the tree to be reached from the ground. The problem is: How do I get hold of these apples?

This problem has over the years provided many solutions, a number of which has even been patented, and therefore one solution for the person confronted with the problem would be to go to the store and ask what products they have in stock. Products produced on the basis of the solutions provided by other people.

The serendipity invention is the one that comes to the inventor - something happens - and the creative person identifies a use of that incident.

One famous example is the discovery of penicillin - an experiment that failed while working on solving another problem, but where Mr. Fleming was capable of drawing a correct conclusion from his observation to the benefit of countless of millions of people over the years.

**Patentable and Non-Patentable Inventions: 1st Part**

Should it then be possible for all of us to go to the patent office and have a patent for the inventions we make. Such a situation would not be practical and the criteria for patentability were quickly introduced, namely that the invention should be novel, non-obvious or provide an inventive step, and capable of being used in industry (in the USA it only has to be useful).

On top of that the so-called enablement feature was introduced, according to which the invention must be disclosed in a manner whereby the skilled person (in the art to which the invention pertains) can reproduce the invention.

So, everything should be fine. We have an invention and a system by which a patent can be granted, if the invention is novel, etc. But - no - society has decided that patents should not just be granted on the basis of a technical evaluation. Social values must be considered.

In the USA, where the legal system is the "common law" system, such evaluations can be made by the courts in the course of time. Especially, the patentability criterion "useful" has been used to that end (cf. Lowell v. Lewis 15 Fed. Cas. 1018, 1019 (C.C.D. Mass. 1817), and Bedford v. Hunt 3 Fed. Cas. 37 (C.C.D. Mass. 1817)).

However, in most other countries the law must define how to take that into consideration, and in those instances I know, this has been done by the introduction of exclusions from patentability.

Prof. Mario Franzosi has developed an approach to analysing patentability (EIPR 5 (1997) 251254), wherein he tries to demonstrate that a patentable invention comprises a technical and a social phase. He furthermore uses a number of concepts, an active element, F (force), a passive element, O (object), the technical result (TR), human needs (N), and social result (SR). These concepts are in his theory related by a number of equations, the first one defining the technical phase:

\[ F + O = TR \]  \hspace{1cm} (1)

stating that when a force acts on an object a technical result is provided - a patentable invention. According to the theory the TR can be identified through the fact that the material world has been modified by the creation of a novel product or process etc.

The second equation defines the social phase:

\[ TR + N = SR \]  \hspace{1cm} (2)

stating that if a technical result is applied to human need or a demand therefore, then a social result occurs.

According to the theory the two phases are connected, since the end of the first is the beginning of the second.

A special situation may occur if there is no technical result:

\[ F + O = TR = SR (3) \] or \[ TR + N = SR (if SR = TR) \]  \hspace{1cm} (4)

stating that when the technical result is equal to the social result

\[ SR = TR \]

then no patentable invention is present.
Anyone trained in mathematics can see that this system of equations is not coherent.

Prof. Franzosi also defines two types of consumption/utilisation, the productive and the enjoyment consumption. In the first instance he stipulates there is a modification of Nature, whereas this does not occur in the second instance.

In the article Prof. Franzosi uses these concepts to advocate that the granting of a patent should be completely independent of the social phase of the invention, and he also draws certain other conclusions about the patentability of - or rather the lack of patentability - certain inventions which in his view lack the technical phase, such as 2nd medical use claims, etc.

I profoundly disagree with Prof. Franzosi in these conclusions.

He uses the formulas to support the concept that the so-called Swiss-type claims should not be allowable, thereby in a sense to exclude a second novel use of a known product.

To this end he uses the situation of formula 3 or 4

As stated above I find that the system of equations developed is basically wrong. If we look at how an invention most often occurs, then you cannot really separate the technical and the social phase. We should therefore add equations (1) and (2) to give

\[ F + O + N = TR + SR \quad (5) \]

since according to my experience inventions are most often made as a response to a need (in my example the need to reach the apples).

Furthermore the most valuable result of an invention is its ability to fulfill a need. We all know that most inventions are never brought into practical use because they do not fulfill a need. Sometimes they are made before a demand exists in society, and sometimes when the demand no longer exists, and again sometimes the solution provided are simply not sufficiently effective or safe to use. To become a success an invention has to be made at the right point in time.

If we look at equation (5) for the case where \( TR = 0 \) it becomes

\[ F + O + N = SR \quad (6) \]

This equation states that a social result is obtained from the existence of a need that gives rise to a force acting on an object. Something that I would equal to inventive activity, since the social result - the most important one - is achieved.

Should it not be rewarded to find that the use of Aspirin is beneficial in the treatment of AIDS just because it has been used to alleviate pain for many years?

**Inventions Excluded from Patentability**

The European Patent Convention states in Article 52(1) what is considered patentable inventions, and in Article 52(2) particularly what is not regarded as inventions within that meaning. The subparagraphs are:

(a) discoveries, scientific theories, and mathematical methods;
(b) aesthetic creations;
(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
(d) presentations of information.

Article 52(3) EPC softens this a little by stating that this shall be construed narrowly in that it is only to the extent that the invention relates to these subject-matters as such that they are excluded from patentability.

These paragraphs are generally in line with the patent laws in most other countries. Also, according to prof. Franzosi's theory, such subject matter does not provide a technical result (they may have a social result) and therefore are not patentable inventions.

This does not mean that there exists a general agreement as to the wisdom of these exclusions. Most people involved agree that creators of subject matter covered by subparagraphs (a) and (b) are well served for protection by the laws governing copyright and designs, which are normally applied in these instances.

In contrast hereto the creators of programs for computers and presentations of information (databases) argue that the protection afforded under these laws is too weak, and that they are severely in need of a stronger, broader type of protection, such as patent protection that covers not only the specific embodiment, but the rationale in the program or database.

I shall not here go into details in respect of these issues, but leave this for my colleague Thierry Schuffenecker to deal with that.

Then in Article 52(4) EPC it is stated that methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph 1. Again it is softened by the remaining part stating that this does not apply to products, especially substances and compositions, for use in any of these methods.

In this instance we certainly deal with inventions, both according to general ideas, and according to the above mentioned theory. However, the makers of the law has decided that such inventions cannot be patented because they by definition have been found to lack industrial utility.

Then Article 53 of the European Patent Convention defines certain specific exceptions to patentability, namely in article 53(a) inventions the publication or exploitation of which would be contrary to "ordre public" or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is pro-
hindered by law or regulation in some or all of the Contracting States.

Article 53(b) EPC excludes plant or animal varieties or essentially biological processes for the production plants or animals; this provision does not apply to microbiological processes or the products thereof.

Again it is not the normal criteria for patentability that differentiates these inventions, but a decision by the makers of the Convention.

In the TRIPS agreement under the GATT agreement administered by WTO, article 27 defines a number of types of inventions the member states may exclude from patentability. The EPC exclusions according to both Article 52 and 53 are fully supported by TRIPS.

Many practitioners have argued that especially Art. 53(a) EPC should be deleted from the patent law - Patent Office examiners and patent attorneys are not trained in ethics and morals, and today society has other laws and regulations that are better suited to deal with such problems. The granting of a patent should be a purely technical issue investigating novelty, inventiveness and utility.

I also profoundly disagree with such a view. Patents do not exist in a moral vacuum. Patents and monopolies have always been used to promote innovation, technical progress and industry, and it is the responsibility of the lawmakers to ensure that the technology progresses in a manner that is not counter to the interests of the society at large.

Before discussing this in more detail and promoting certain ideas to solve some of the problems in the present situation I would like to investigate the background for these exceptions in more detail.

History and Rationale Behind Art. 52(4) EPC

In the history of patenting in Europe a number of exclusions have been seen over time, many of these have disappeared. For example has it only been possible to obtain patents for foods in Denmark since 1988. Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body have been excluded from the patent laws of many European countries since the introduction of patent law.

The reason for the exclusion is that the existence of patents in this area was seen as an obstacle against the free conduct of business of doctors and physicians, and thereby a possible threat against the public health.

History and Rationale Behind Art. 53(a) EPC

Most European patent laws comprised for many years provisions that would exclude the patenting of inventions the exploitation of which would be illegal in some manner. These provisions were found to be extremely difficult to apply in the patent offices, since it entailed that the examining division should always be up to date with all laws and regulations controlling a certain technology in order to decide on this issue.

Furthermore, such laws are susceptible to changes, sometimes with very short notices. This would eventually lead to paradoxical situations where a pioneer invention was not patented because a prohibition on exploiting the technological field in question was in force at the time of decision, whereas later inventions of smaller impact would be patentable because the prohibition was lifted (maybe even because of the successful application of the first invention in other parts of the world).

History and Rationale Behind Art. 53(b) EPC

The exclusion of plant and animal varieties as such in Art. 53(b) EPC, 1st sentence, originates apparently from the double protection ban in the 1960 version of the UPOV Convention. The exact reasons are obscure and very difficult to trace in the preparatory works of the Munich and Strasbourg texts.

However, it is reasonable to believe that the draftsmen felt that such an exclusion would provide for adequate assurance that the patent law would not create any problems for those countries that were or would be members of UPOV. At least I can see no other reason for such an exclusion. The rationale behind the exclusion in the UPOV text was that plant varieties should be protectable under that legal instrument and that they did not belong in the patent law, since the requirement of repeatability (enablement) could in those days not be fulfilled. In that connection a reference to the "Rote Taube" case in Germany is relevant.

In the "Rote Taube" case (1969) the German Federal Supreme Court found that the pigeon in principle was patentable, but that the specification did not enable the skilled person to carry out the invention. However, I believe it still to be relevant in respect of the patenting of both plant and animal varieties to cite from that decision:

"We are concerned with the question whether biological phenomena and forces can be treated the same way as those of a technological nature. In this connection it is again of little importance what the legislator in 1877 considered to be 'technology', but rather how the biological phenomena and forces are to be understood and classified in the present state of sciences... A teaching to methodically utilise controllable natural forces to achieve a causal, perceivable result could be considered patentable, provided that teaching meets the general prerequisites of industrial application, novelty etc."

The court clearly realised that, if the biological phenomena could be utilised in a controllable manner, they should be patentable.

At the time of the making of the 1960 UPOV text no-one could possibly conceive the development we have seen in the field of biotechnology regarding controlling these natural forces in a predictable and repro-
ducible manner. This was also realised in the most recent UPOV text by removing the double protection ban. Unfortunately, the European Union has not taken the opportunity to remove it from the EU regulation 2100/94 on Plant Breeders Rights.

Although it is not stated explicitly (as in Art. 52(3) EPC), I believe it is clear from the text that the exclusion only should cover plant and animal varieties as such, since the second part of the first sentence states that also essentially biological processes for the production of plants or animals are excluded. In my view it is not a coincidence that the text makes a discrimination between the product protection for varieties and the process protection for essentially biological processes for the production of plants or animals.

The further inclusion of animal varieties in the exclusion can only be guessed at, but it is my firm belief that this was done because it was believed that a convention similar to the UPOV Convention should in the future be introduced for the protection of animal breeds, something that has not happened yet.

The second sentence of Art. 53(b) EPC provides an exclusion to an exclusion in stating that this provision does not apply to microbiological processes or the products thereof. The EPC does not have any definition of what constitutes neither an essentially biological process nor a microbiological process. This fact has provided for some confusion in the application of this provision.

Patentable and Non-Patentable Inventions: 2nd Part

The exclusion of discoveries etc. in Art. 52(1)(a) and (b) EPC are generally accepted for as long as these are applied narrowly in the sense that only "pure" discoveries are excluded.

Recently the concept of discovery has been the subject of intense discussion in connection with the EU Commission’s proposal for a directive on the protection of biotechnological inventions. Opponents to the proposal has attempted to characterise all inventions relating to natural products as discoveries, an argument that has had some success among politicians and the public in general.

However, the proposal as now amended after the first reading in the EU parliament still provides for patent protection of natural products as we have known it for years.

Also the exclusion in Art. 52(4) EPC has a solid foundation in Europe and are acceptable.

Concerning Art. 53 EPC I believe that severe problems have been seen already, and I fear that further problems lie ahead of us. While I disagree with the view that patents should be dealt with in a purely technical manner, I do agree with the view advocated by some commentators that patent office examiners, and even the European Patent Office Boards of Appeal are not competent to decide on issues such as "ordre public", ethical questions and morality. These are issues so important that they should be dealt with in the courts.

However, as the laws are worded today it is the duty of the patent office examiners and board members to deal with it. Firstly in the examination and opposition procedures, and secondly in appeal cases, where opponents may use Art. 53(a) EPC to revoke a patent.

One way by which this may be avoided would be to replace the present provisions with provisions whereby a patent may not be enforceable if its exploitation would be against ordre public or morality. This solution, on the other hand would make it possible to obtain such a patent - something which I do not believe would be acceptable to society.

Another solution would be to provide for the possibility of making further appeals from the EPO to the courts.

Article 53(a) EPC has often been cited by the opponents to the above mentioned proposed directive, especially that it would be immoral to patent any life forms at all, and in particular against the patenting of biological material of human origin. A view that has also had quite some success in the general public. The view coincides with a certain hostility in the population against the biotech industry, especially genetically engineered food and animals. People are frightened at the prospect of what these technologies may lead to.

The EPO Boards of Appeal have been considering the issue in a number of cases, and in my view they have reached the correct conclusions, but the manner by which they have dealt with the issue raises a lot of concern in me.

The Boards have correctly felt that they should deal with all the objections raised, but in the process they have not felt it necessary to call on independent experts to provide evidence, but only listened to the experts provided by the parties. Especially the deliberations of the Boards over the arguments presented by the opponents that the patented technologies should be dangerous to the environment (arguing that this should be against ordre public) have been very superficially dealt with. They should either have rejected the arguments on the basis of the fact that society allows the experiments leading to the inventions, and the exploitation of the technology therefore cannot be considered to violate ordre public or they should have investigated the issue in detail.

The opponents use such fears in the population in a very shrewd manner riding on a trend in the European (or Western) societies to let feelings and sentiments govern our actions. To show this I only have to point to incidents such as the Brent Spar problem (providing the worst solution to a problem) and the Princess of Wales tragedy (massively exaggerated reaction to the tragic death of a media person). These tendencies are dangerous because they are being used by certain groups to influence political decisions to be taken not on the basis of rational insight and knowledge, but purely on feelings and fears.
I must admit that the manner in which evidence is taken by the Boards of Appeal raises fears in me that the Boards could be seriously influenced by such tendencies.

Article 53(b) has - with success been used against the patenting of plants. In the famous PGS decision (T 356/93) the EPO Board of Appeal decided against claims on genetically engineered plants based upon the argument that the claims encompassed plant varieties (which are excluded).

The President of the EPO tried to solve the problem created by this decision by referring it to the Enlarged Board of Appeal, but the Enlarged Board of Appeal did not want to make a decision and rejected the referral on formal grounds (I call it the ostrich method).

Because of the PGS decision we have today a paradoxical situation. Regulation 2100/94 was drafted in a manner predicting the existence of patents covering plants, but not to cover plant varieties as such. Also, the proposed directive provides for the patenting of plants, but not plant varieties. Furthermore, it is - at least to me - clear that the present wording of the EPC does not prohibit patents on plants. But - because of one Board of Appeal - the practice of the EPO at the present is NOT to grant such patents.

This situation has lead to subsequent appeals from rejections of cases claiming plants, the outcome of which has to be seen.

Furthermore it will be interesting to learn the decision from the same Board of Appeal in the Onco-mouse case, which is still pending.

This brings about a further shortcoming of the present system of EPO Boards of Appeal, where the compositions of the boards are unchanged until a member leaves the EPO, and where in many technical fields the same board deals with all cases.

Consequences on R&D in Europe and Competitiveness of European Firms

The exclusions in article 52 EPC do in my view not entail any problems for the R&D in Europe for as long as the patentability of natural products are not a priori excluded by defining them as discoveries.

On the other hand I find that Article 53 EPC is a problem as it is today applied by the Boards of Appeal of the EPO. If the tendency to reject patents for plants, and maybe even for animals is continued a disconcerting situation will occur for that part of the European industry involved in developing transgenic plants. With no availability of patents to protect against the derivatisation or development of new plant varieties on the basis of whatever varieties they would market themselves, the only solution would be to develop only infertile hybrid seeds and try to depend to the largest possible degree on trade secrets.

This would harm both the European R&D and our competitiveness in this field. A brief example may show this.

In Denmark a public research institution is now working on the development of transgenic rye plants. No-one has yet produced such a rye plant because the known promoters do not function in rye, and also the regeneration of a plant has posed very serious problems. This institution now has hopes to succeed, but only in two old out dated varieties. The institution will probably try to patent their technology, but the development of modern transgenic varieties will take a long time and cost a large sum of money, and will not be done by that institution - they plan to license the technology to someone.

However, who will license this technology in when the most important rye market, namely Europe, may lie open to piracy by lack patent protection?

It has been argued by someone that the patenting of plants (and animals) would pose problems for the European farmers as potential infringers of patents (as long as no provision exist like the farmers privilege in Regulation no. 2100/94 on Community Plant Variety Rights).

Also, it has been argued that patent on plants and animals would amount to a discrimination against breeders of traditionally produced plants and animals.

This is simply not correct.

Why is it that farmers and breeders should have special rights in respect of intellectual property rights?

Tradition and the powerful influence of the agricultural organisations representing farmers apparently is the most important reason. However, from discussions with these organisations and many farmers I have got the impression that they are now inclined to adapt business practices corresponding to those that are accepted by everybody else.

Furthermore, we can see from the recent vote in the EU parliament that this has been recognised by most political parties.

If patents for plants and animals is a discrimination of plant breeders, then patents are generally discrimination of competitors, but that is what it is all about. A patent provides the patentee with the possibility to prohibit others from utilising the invention commercially.

It must also be pointed out that Regulation no. 2100/94 on Community Plant Variety Rights in its Article 92 provides a prohibition on cumulative rights by which any variety protected under that Regulation would become "free" of any patent that might have covered it, but such an existing patent right would provide the patentee with rights in respect of so-called derived varieties that could help him prohibit the commercial exploitation of such a derived variety (not in respect of the development of the derived variety) for as long as the derived variety has retained the properties that formed the basis for granting the patent.

This means that as long as the farmer uses a protected variety, then he has no problem in respect of farmers privilege or for the breeder with the derivatisation of new varieties until such time as steps are taken to commercialise - that is until an application for a plant variety
right is filed, at which time it will be necessary to approach the patentee.

Patents in this area would thus not entail any major difference in the lives of most farmers and breeders within the EU.

Unfortunately I do not know about the situation in Switzerland and Liechtenstein.

We have not yet seen any example of the application of Art. 53(a) EPC where the final conclusion could be questioned, but seeing how the Article is actually applied leaves me uncertain if it would not someday be applied in a manner which I would find wrong.

Would this influence European R&D?

I do not believe this, for as long as the situation remains as it is today, but if the Boards of Appeal decided against the patentability of an invention based upon Art. 53(a) EPC providing a more specific guidance, this situation may change.

Conclusion

In conclusion it must be said that the exclusions in Art. 52 EPC and 53(a) EPC have not till now been used in a manner that has any substantial influence on neither the R&D in Europe nor the Competitiveness of European Firms.

While I believe this will remain the case in respect of article 52 EPC, I have sensed a tendency in the Boards of Appeal of the EPO that does not please me in any way, and I do not feel absolutely comfortable with the way the boards function in respect of taking evidence and fact finding in their procedure.

We have seen this in respect of the application of Article 53(b) EPC both the 1st and 2nd sentence, where the Board apparently has taken a position which is contrary to what some independent experts in this field has stated.

It would therefore be reasonable now to revise especially Article 53 EPC in order to bring it into harmony with what we today see as the emerging result of the painstaking process of bringing the Commission's proposal for a directive on the protection of biotechnological inventions through the EU decision making process, namely that plants and animals are patentable, and that the exclusion in Article 53(b) EPC must be construed so narrowly to exclude only patents for plant and animal varieties as such. Just like Article 52(3) EPC explicitly provides this for the exclusions under Article 52(2) EPC.

Die Bewertung der erfinderischen Tätigkeit in 20 Jahren europäischer Praxis
Die Lösung eines Problems?

R. Teschemacher (DE)

Zusammenfassung · Summary · Résumé


Article 56, first sentence, sets out the requirements for inventive step. It does not however set out any method for checking whether these requirements are satisfied. In practice, the EPO and its Boards of Appeal adopt the problem and solution approach. In using this method, the following points are to be observed: The closest prior art must be realistically determined, that is to say it must be determined in accordance with actual technical development. If necessary, several representable starting points must be considered simultaneously. No elements of the solution must be incorporated in the problem. Since no technical advance is prescribed, it may consist of the further solution of an already
Die gesetzliche Grundlage


Gesetz wurde Artikel 56 Satz 1 EPU mit dem folgenden Text in den drei Amtssprachen:

Eine Erfindung gilt als auf einer erfinderischen Tätigkeit beruhend, wenn sie sich für den Fachmann nicht in naheliegender Weise aus dem Stand der Technik ergibt.

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

Une invention est considérée comme impliquant une activité inventive si, pour un homme du métier, elle ne découle pas d’une manière évidente de l’état de la technique.


Die Leichtigkeit, mit der das Erfordernis der erfinderischen Tätigkeit im EPU etabliert werden konnte, mag zunächst verwundern angesichts der verschiedenen Traditionen, die zuvor im nationalen Recht der Vertragsstaaten anzutreffen waren. Die erfinderische Tätigkeit lag aber im Trend der europäischen Rechtsentwicklung,

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2 Pagenberg, a.a.O., Seite 147.
3 Plager, a.a.O.
4 Pagenberg, a.a.O.
5 Pagenberg, a.a.O.
6 Bossung, a.a.O., Seite 223, 226.
7 Bossung, a.a.O., Seite 147.
8 In der Praxis zum FR-PatG von 1968, Pagenberg, a.a.O., Seite 228, m. weiten Nachw.
die parallel ihren Niederschlag auch im nationalen Recht fand.


**Vorarbeiten zur Eröffnung des EPA**

Der erste Schritt zur Umsetzung der gesetzlichen Grundlage in die Praxis des zukünftigen Amtes wurde mit den Richtlinien für die Prüfung im EPA unternommen, die von der Arbeitsgruppe III des Interimsausschusses unter Einbeziehung der interessierten Kreise verfaßt wurden. Sie enthielten in C-IV ein Kapitel über erforderliche Tätigkeit, in dem der Prüfer insbesondere vor einer ex-post Betrachtung gewarnt wurde mit dem Hinweis, daß die bei der Recherche ermittelten Dokumente in Kenntnis der Erfindung gefunden worden seien. Die Richtlinien wurden veröffentlicht, um den zukünftigen Benutzern Gelegenheit zu geben, sich auf die kommende Amtspraxis einzustellen.


**Die Entwicklung des problem and solution approach**

In einem Vortrag vor dem Queen Mary College Anfang 1983 stellte Mr. Cadman, der Vorsitzende der damals einzigen Chemischen Beschwerdekammer den "problem and solution approach" vor, der in der Rechtsprechung "seiner" Kammer, entwickelt worden war. Da aus dieser Methode gelegentlich Anlaß zu Kritik und zu Mißverständnissen entstanden ist, will ich mich hiermit näher befassen.

Nach der Praxis der Prüfungs- und Einspruchsabteilungen, die der Rechtsprechung der Beschwerdekammern folgt, findet die Prüfung nach folgendem Grundschema statt:

1. Identifizierung des nächsten Stands der Technik
2. Ermittlung der Aufgabe durch Vergleich der Wirkungen der beanspruchten Erfindung mit denen des nächsten Stands der Technik

In allen diesen Schritten können Probleme auftreten:

**ad 1) Was die Identifizierung des nächsten Stands der Technik angeht, so ist zu berücksichtigen, daß technische Entwicklungen im allgemeinen nicht abstrakt um ihrer selbst willen angestrebt werden. Vielmehr werden Erfindungen mit bestimmten Zielvorstellungen gemacht. Der nächste Stand der Technik ist der Ausgangspunkt, von dem der Fachmann am leichtesten zu der Erfindung

8 Siehe hierzu näher Beier, Zur historischen Entwicklung des Erfordernisses der Erfindungshöhe, GRUR 1985, 606.
12 Bericht im IIC 351 (1978).
gelangt wäre, oder wie es in T 254/86 heißt, das "erfolgsversprechendste Sprungbrett" zur Erfindung. 17

Das impliziert, daß die Zielrichtung der Erfindung bei der Wahl des nächsten Stand der Technik zu berücksichtigen ist. Der nächste Stand der Technik ist daher in aller Regel eher effektbezogen als strukturbezogen. 18 Das bedeutet auch, daß der für die Neuheit relevanteste Stand der Technik nicht zugleich auch der nächste Stand der Technik für die erfinderische Tätigkeit sein muß. Die nächstliegende Entgegenhaltung kann also nicht einfach durch das Abzählen gemeinsamer Merkmale ermittelt werden. Vielmehr ist auch ein strukturfernerer Stand der Technik heranzuziehen, wenn er dem Anwendungsgebiet der beanspruchten Erfindung näher liegt. Nur diese Betrachtungsweise führt zu einer realistischen, d.h. der Denkweise des Fachmanns entsprechenden Wahl.

Da es in der Praxis verschiedene Ansatzpunkte für technische Weiterentwicklungen geben kann, kann es auch verschiedene Entgegenhaltungen geben, die als nächster Stand der Technik in Betracht kommen. Sind mehrere Alternativen vertretbar und realistisch, dann sind sie auch parallel heranzuziehen. Führt etwa ein neues Herstellungsverfahren zugleich zu einer höheren Ausbeute und zu einem besseren Produkt, so kommt als Ausgangspunkt sowohl die Entgegenhaltung in Betracht, die für die Verbesserung der Ausbeute am relevantesten ist, als auch diejenige, die für die Produkt eigenschaften am nächsten liegt. Die mit einer Erfindung befaßten Instanzen haben sich nach dem Grundsatz des rechtlichen Gehors (Artikel 113 (1) EPU) auch in dieser Hinsicht mit dem Sachvortrag der Parteien auseinanderzusetzen. Tragen die Parteien substantiell vor, warum eine Entgegenhaltung als Ausgangspunkt in Betracht kommt, so kann sich eine Abteilung oder eine Kammer hierüber nicht hinwegsetzen ohne konkret zu begründen, warum ein anderer Ausgangspunkt bei realistischer Betrachtungsweise nähergelegen hat. Es liegt an den Beteiligten, in das Verfahren die Tatsachen einzubringen, auf deren Grundlage der nächste Stand der Technik realistisch, d.h. der technischen Entwicklung in der Praxis entsprechend, bestimmt werden kann. Das entscheidende Organ wird sich regelmäßig an den Stand der Technik halten, von dem in der Beschreibung ausgegangen ist, sofern dort die Würdigung des Stands der Technik vollständig und korrekt ist. Hat allerdings der Verfasser der Beschreibung wesentlichen Stand der Technik nicht gekannt, oder ist der Stand der Technik nicht objektiv gewürdigt, so ist näher zu prüfen, ob der vom Anmelder oder Patentinhaber gewählte Ausgangspunkt objektiv gerechtfertigt ist.

ad 2)

Zur Ermittlung der Aufgabe ist festzustellen, durch welche Unterschiede sich die beanspruchte Erfindung gegenüber diesem Ausgangspunkt abhebt. Wenn ein korrekt abgegrenzter zweiteiliger Hauptanspruch vorliegt (vgl. Regel 29 (1) EPU), werden dies die Merkmale sein, die im kennzeichnenden Teil des Anspruchs stehen. Die Aufgabe folgt daraus, welche Wirkungen durch den Einsatz der zusätzlichen Merkmale erreicht werden sollen. Dabei ist darauf zu achten, daß die Aufgabe frei von Elementen der Lösung der beanspruchten Erfindung bleibt, andernfalls kämme man zu einer ex-post Bewertung der Erfindung. 19

Das EPU verlangt nicht, daß die Erfindung einen technischen Fortschritt mit sich bringt. Die Aufgabe muß daher nicht notwendig in einer Verbesserung liegen. Vielmehr kann sie auch in einer weiteren Lösung einer im Stand der Technik bereits gelösten Aufgabe bestehen 20. In diesem Fall kann sich der Anmelder freilich nicht auf einen die erfinderische Tätigkeit begründenden Effekt gegenüber dem Stand der Technik berufen; die erfinderische Tätigkeit kann daher nur damit begründet werden, daß es nicht nahegelegen habe, den bekannten Effekt auf die nunmehr vorgeschlagene Weise zu erzielen.

Als nächstes ist festzustellen, ob die angegebene Aufgabe durch die angegebenen Mittel tatsächlich gelöst wird. Geltendgemachte, doch nicht hinreichend belegte Vorteile können bei der Ermittlung der technischen Aufgabe nicht berücksichtigt werden. Vorteile, die nicht ohne weiteres glaubhaft sind, sind durch Ver suchsergebnisse zu belegen.

Erweist sich, daß die angestrebten Vorteile mit den im Hauptspruch angegebenen Merkmalen nicht oder nicht im beanspruchten Umfang erzielt werden und damit die Aufgabe nicht gelöst wird, wird dies regelmäßig einen Einwand wegen fehlender erfinderischer Tätigkeit 22 nach sich ziehen. Der Anmelder oder Patentinhaber wird häufig versuchen, dem durch eine Beschränkung mit zusätzlichen Merkmalen Rechnung zu tragen, was nur im Rahmen der ursprünglichen Offenbarung zulässig ist. Dabei wird zu prüfen sein, ob sich die Aufgabe ändert, und ob die beschränkenden Merkmale zur Lösung der ursprünglichen oder einer in zu lässiger Weise geänderten Aufgabe 23 beitragen. Willkürliche Beschränkungen sind nicht geeignet, den Einwand fehlender erfinderischer Tätigkeit auszuräumen. Auf Fragestellungen in dieser Richtung muß der Anmelder oder Patentinhaber insbesondere dann vorbereitet sein, wenn er sich in der mündlichen Verhandlung beschänken will, da dann möglicherweise nur mehr Änderungen zugelassen werden, die ohne weiteres als gewährbar erscheinen. 24

20 T 209/1, ABl. EAA 1982, 217.
Für die abschließende Beurteilung, ob der Fachmann in der Lage war, vom nächsten Stand der Technik zur beanspruchten Lösung zu kommen, reicht es nach der ständigen Rechtsprechung nicht aus, daß der Fachmann zu dieser Lösung hätte kommen können, in dem Sinn, daß sie ihm unter einer Mehrzahl von Alternativen offenstand. Erforderlich ist vielmehr, daß der Fachmann gerade zu dieser Lösung gekommen wäre (could-should approach)25.

Regelmäßig geht es darum, ob der Fachmann Anlaß hatte, eine bekannte Lösung durch Merkmale aus weiteren Entgegennahmen oder aus dem allgemeinen Fachwissen zu ergänzen oder abzuwandeln. Dies wird dann angenommen, wenn der Fachmann mit hinreichender Aussicht auf Erfolg erwarten konnte, daß durch den Einsatz der weiteren Mittel der angestrebte Erfolg eintreten werde. In aller Regel ist dies nicht der Fall, wenn mit der Erfindung ein überraschender Erfolg erzielt wird. Da der Erfolg überraschend ist, war es definitionsgemäß nicht vorhersehbar und ist geeignet die erforderliche Tätigkeit zu begründen. Hiervon gibt es allerdings Ausnahmen:

(a) Der Vorteil ist nur in seinem Ausmaß überraschend Hätte der Fachmann durch den Einsatz eines Mittels z. B. eine Erhöhung der Ausbeute erwartet, fällt diese aber tatsächlich weit höher aus als vorhersehbar, so kann dies die erforderliche Tätigkeit nicht rechtfertigen, wenn das vorhersehbare Maß der Erhöhung der Ausbeute den Fachmann schon veranlaßt hätte, die beanspruchte Lösung zu wählen26.

(b) Ein überraschender Vorteil wird von einem zu erwarten den Vorteil begleitet. Wird etwa ein neu auf den Markt gekommenes Material für die Herstellung eines bekannten Erzeugnisses eingesetzt und konnte sich der Fachmann hiervon eine Verbesserung in den Produkteigenschaften erwartet, so können in überraschender Weise erzielte Verbesserungen im Ablauf des Herstellungsverfahrens die erforderliche Tätigkeit nicht stützen, wenn der Fachmann schon wegen der Produktverbesserungen diese Lösung gewählt hätte. Solche Fälle sind von der Rechtsprechung unter den Stichworten "one way street situation" oder "bonus effect" behandelt worden27.


Hierzu gehören beispielsweise Erwägungen unter folgenden Stichpunkten:
- Ausnutzung bekannter Materialien -Einsatz bekannter Alternativen
- Aggregation oder synergistischer Effekt
- Abweichen vom Trend der Entwicklung
- Pioniererfordernis
- Überwindung eines Vorurteils
- Glückliche Auswahl aus einer Vielzahl von Möglichkeiten
- Vereinfachung trotz Erhaltung aller anderen Vorteile

Diese Erwägungen sind relevant, bevor ein Ergebnis über das Vorliegen erforderlicher Tätigkeit festgestellt werden kann. Sie sind daher dazu da, zur Begründung des Urteils über die erforderliche Tätigkeit beizutragen, nicht um das auf andere Weise festgestellte Ergebnis im Zweifelsfall zu korrigieren.


Kritik

Der problem and solution approach ist nicht ohne Widerspruch geblieben. Gerade in den epi Informationen wurde an ihm Kritik geäußert.

Einfach zu einer rückschauendcn Betrachtungsweise führe, da der nächste Stand der Technik in Kenntnis der Erfindung

30 Damit sind nicht wirtschaftliche Vorteile gemeint, die sich aus technischen Merkmalen ergeben, wie die Verbilligung eines Produkts.
31 Damit sind nicht wirtschaftliche Vorteile gemeint, die sich aus technischen Merkmalen ergeben, wie die Verbilligung eines Produkts.


Wird die Aufgabe frei von Lösungsansätzen definiert, kann man auch nicht von einer Aufgabenerfahrung sprechen. Dieser Begriff kann nur dort Berechtigung haben, wo die Aufgabe Lösungsansätze enthält, was bei der Aufgabe, die sich der Erfinder subjektiv gestellt hat, häufig der Fall sein mag. Ist schon die subjektive Aufgabe des Erfinders nicht aus dem Stand der Technik herleitbar, so liegt erfinderische Tätigkeit vor, ohne daß es noch auf erfinderische Elemente in der konstruktiven Ausgestaltung ankämme.

Weiter wird behauptet, der problem and solution approach wäre nicht geeignet zur Beurteilung von Erfindungen, die auf Entdeckungen beruhen. Entdeckungen werden aber nicht um ihrer selbst willen geschützt (Artikel 52(2) a) EPÜ), sondern nur dann, wenn sie in einer konkreten technischen Anwendung nutzbar gemacht werden können. Wird etwa ein neues Element entdeckt, so können dessen vorteilhafte Eigenschaften in einem Produkt eine Patentierung rechtfertigen. Aufgabe und Lösung können wie bei jedem anderen neuen Produkt formuliert werden.


Der so definierte Beitrag wird in Bezug gesetzt zum relevantesten Stand der Technik. Nach dem universellen Neuheitsbegriff gilt die Fiktion, daß dem Fachmann alles zugänglich ist, was der Öffentlichkeit im maßgeblichen Zeitpunkt zugänglich war. Dieser Neuheitsbegriff verleitet dazu, ex-post technische Informationen in einen Zusammenhang zu setzen, der für den Fachmann ohne Kenntnis der Erfindung nicht erkennbar war. Mit der Wahl des nächsten Stands der Technik und der Definition der Aufgabe ohne Lösungsansätze als Ausgangpunkt wird dem Fachmann die Blickrichtung gegeben, die er ohne Kenntnis der Erfindung haben konnte. Nur Dokumente, die aus dieser Blickrichtung her relevant erscheinen, dürfen mit dem nächsten Stand der Technik kombiniert werden. Damit soll der problem and solution approach als Methode verhindern, daß aus dem im Zeitpunkt der Erfindung unübersichtlichen Stand der Technik

32 Siehe insbesondere White, EPR 1986, 237.
die Elemente zusammengepickt werden, deren Zusammenhang erst im Nachhinein als plausibel erscheint.

Schließlich kann auch nicht legitiemerweise eingewandt werden, der problem and solution approach sei schon deswegen unzulässig, weil das EPU keine Aufgabe als Element der Erfindung vorschreibe. Der Gesetzgeber des EPÜ hat davon abgesehen, den Begriff der Erfindung präzise zu definieren und befindet sich damit in Übereinstimmung mit den meisten Patentsystemen.


Dies wirft die Frage auf, ob der problem and solution approach die einzige zulässige Methode ist, mit der das Vorliegen erfinderischer Tätigkeit vor dem EPA zu prüfen ist.


43 Van Empel, The granting of European Patents, Leyden, 1975, Rd. 64.
44 Grundsätzlich Schachenmann, a.a.O. Fn. 15.
45 Dies kann nicht damit abgetan werden, die Vorschrift sei lediglich fakultativ. Hier geht es nicht um die Form der Darstellung, die nach Regel 27(2) EPU in der Tat fakultativ ist, sondern um deren Inhalt, der bindend ist, siehe Tschewe-macher, Münchener Gemeinschaftskommentar, Artikel 82, Rd. 40.
47 ABl. EPA 1996, 309, Gründe Nr. 2.4.4.
Central Limitation, Re-Examination Invalidation

E. Armijo (ES)

Zusammenfassung / Summary / Résumé

Von den vielen möglichen Lösungen für ein wirksames Streitverfahren und die Erhaltung von homogenen Rechten in Europa befaßt sich der gegenständliche Vortrag mit der zentralen Einschränkung, der zentralen "Re-examination" und zentralen Ungültigerklärung von Patentrechten.

In den verschiedensten Bereichen bestehen jedoch nicht nur ein großes Interesse an der Harmonisierung und der Zentralisierung möglicher Änderungen erteilter Patente und der Ungültigerklärung nationaler Patente, die aus europäischen Patenten entstanden sind, es wurden auch bereits Vorschläge ausgearbeitet, um diesen Zielen näher zu kommen. Die dieser Themenkreis betreffende aktuelle Situation kann unter vier verschiedenen Aspekten betrachtet werden:

- Der erste Aspekt ist die Betrachtung der gegenwärtigen Situation bezüglich: Einschränkung, Re-examination und Ungültigerklärung auf nationaler Ebene in verschiedenen europäischen Ländern.
- Der zweite Aspekt ist die Situation wie sie im Gemeinschaftsrecht bestehen und vorgesehen ist.
- Der dritte Aspekt betrifft die zentralen Einschränkungsmöglichkeiten beim Europäischen Patentamt.
- Der vierte Aspekt ist das neue Übereinkommen über die Beilegung von Patentstreitigkeiten betreffend die Verletzung und die Gültigkeit von Europäischen Patenten.

Under this large umbrella of solutions for effective action and maintenance of uniform rights at the European level, the subject of this topic deals with Central Limitation, Re-examination and Invalidation.

At the present time, in the different circles interested in patents, there is not only a widespread concern for the harmonization and centralization of post-grant amendments, or for the invalidation of national patents deriving from European Patents, but already proposals are in existence to achieve this end.

Accordingly, the actual situation regarding the subject, can be dealt with in four different aspects:

- The first aspect is the present situation with respect to these 3 topics: Limitation, Reexamination and Invalidation, at the national level in the different countries of Europe.
- The second aspect is the situation foreseen in the Community Patent Agreement for centralized limitation proceedings.
- The third aspect is the centralized limitation possibilities at the European Patent Office.
- The fourth aspect is the new Convention on the Settlement of Litigation concerning the Infringement and Validity of European Patents.

Les mesures d'harmonisation en matière de modifications - ou d'annulation - des brevets européens après la délivrance préoccupent largement tous les milieux intéressés en matière de brevets, et déjà des propositions à cet égard font leur apparition. La limitation, le réexamen et l'annulation des brevets après délivrance sont successivement considérées sous un quadruple aspect: dans les divers droits nationaux, dans le cadre du Brevet communautaire, mais également au regard de la pratique de l'OEB, et enfin en ce qui concerne le projet de la nouvelle Convention sur le règlement des Litiges concernant la Contrefaçon et la validité des Brevets Européens.

Present situation at national level of the Limitation, Re-examination and Invalidation Proceedings

1.1. In relation to the limitation proceedings

A great disharmony exists in the legislations of the different European countries, with reference to the possibilities for patent amendments after grant.

a) it must be stressed that the limiting rules for all these countries always include the common requirements of Article 123 of the European Patent Convention: matter cannot be added that would extend beyond the content of the application just as it was filed /the scope of the protection cannot be broadened by such amendments. This Article 123 of the EPC represents the first milestone laid in the field of centralization and harmonization of amendments to European patent applications during prosecution, or to European patents during the opposition stage.

The national legislations, which have been undergoing the process of being brought into harmony with the European Patent Convention since 1973 until the present time, have arrived at similar conditions in their wording.

Thus, for example: in Germany - Sections 21, 38 of the German Patent Law in Great Britain - Section 76 of the current Patents Act in Spain: Article 41 of the current Patent Law.

b) There are some European countries having, in their legislations, rules for carrying out procedures for amending patents, after grant, either voluntary on the petition of the patentee or in inter-parte proceedings at the discretion of the Courts or of the Patent Offices, on questioning the validity of the same.

These countries are: Germany, Great Britain, Ireland, Spain, Portugal, Switzerland, The Netherlands, Belgium, the Czech Republic, Denmark, France, Norway and Austria.
In those countries the following aspects may differ from one to the other.

The first aspect is the different balance of possibilities existing for patentees, on the one hand, and for third parties, in defence of their respective rights, on the other hand.

When involved is to voluntarily amend a patent, there are countries, such as the United Kingdom, Ireland, the Czech Republic, in which both one and the other are on an equal footing for intervening, owing to the possibility they have of opposing such amendment, there being countries, on the other hand, in which third parties are unable to intervene (Spain, Portugal, Germany, Holland, Switzerland, Belgium, Austria), unless having some acquired rights on dominion or exploitation of the patent, that is when they hold a licence for exploiting the same.

The second aspect to be stressed is that their legislations include the possibility of introducing amendments into patents, either partially or totally, whenever at the instance of the owners of those patents.

In all of those countries the possibility is provided of renouncing the patent in its totality, or the totality of one or more complete claims.

In certain countries it is left clear in their legislations that part of a claim can be renounced and/or part of several claims (e.g., the United Kingdom, Ireland, Germany, Switzerland, Austria, Denmark (through re-examination proceedings)).

In certain other countries (e.g., Spain, Portugal, Holland, Belgium, the Czech Republic) it is not, however, left clear in their legislations whether one can renounce part of a claim and/or part of several of the claims. In the majority of these countries this question is left pending the interpretation that may be given, either by the Patent Offices or by the Law Courts.

In all the cases amendments can end up being rejected by the Patent Offices. This will invariably occur if such amendments fail to comply with the basic requirement that the scope of the protection would not be broadened by such amendments.

c) There are, on the other hand, some other European countries having, in their legislations, very simple precepts, or even having no established precept whatsoever that would allow voluntary post-grant amendments to be made. These countries are: Italy, Sweden, Finland, Hungary, Norway, Luxembourg and Greece.

For these countries, the possibility only exists of amending the claims of a granted patent in revocation or annulment proceedings by a Court, when the invention does not meet the legal requirements of patentability. In some of them, if the nullity ground refers only to a part of the patent, the patent may be partially annulled, provided the patent without said part discloses a patentable invention.

1.2 In relation to the Re-examination proceedings

The possibility of applying for re-examination of a patent is provided for in only very few European countries.

Thus, for example, it is provided for in the United Kingdom at the instance of any third party before the Comptroller. In Germany also there is provision for it, but only at the instance of the patentee. There are very few cases on this point. In the Czech Republic this possibility also exists, although there is scant experience with it.

In Denmark this administrative process of re-examination was implemented in 1993.

This means that, after grant, not only the patentee, but also third parties, may file a request for re-examination of a national Danish patent or of the Danish part of a European patent.

A request for re-examination is filed with the Danish Patent Office and the decision by the Danish Patent Office may be appealed to the Administrative Appeal Board. The decision given by the Appeal Board may be appealed to a Court.

So it may happen that, if a European patent which has been opposed at the European level has survived and has been declared valid, the opponent may continue the battle by filing a request for re-examination of the Danish registration of the European patent.

In this manner an economically strong opponent would be able to tire out the patentee, especially because costs are not awarded to the losing party in the administrative reexamination procedure.

1.3 In relation to the Invalidation Proceedings

A lot has been written about the current disharmony that exists when, on the one hand, the patentability of the invention is judged by the Examination and Opposition Divisions, by the Boards of Appeals or by the Enlarged Board of Appeals of the European Patent Office and, on the other hand, when it is the different National Courts who judge the corresponding national patents derived from the same European Patent.

At the Round Table in Munich on 4 November 1994, organized by the Union of Practitioners in Industrial Property, numerous cases of conflicting decisions were mentioned, between EPO decisions and different National Court decisions concerning particular aspects of novelty, inventive step and of the requirement of sufficiency of disclosure.

Some clear cases of the divergence of patentability criteria between the mentioned instances were outlined for the case of Germany. There, up until May 1994, the German Courts had issued 57 Decisions regarding the validity of German patents deriving from European Patents. Of these 57 Decisions, in 4 cases the German Courts had pronounced in favour of the nullity of the German patents, having had in mind the same prior art pursuant to which the European parent patents had been granted. All of us know why it happened so,
namely because the German Courts continue to maintain the criterion of judging the patentability of the invention on the basis of a higher level of inventive step than that applied by the EPO Examining Division.

Even though the number of conflicting cases giving rise to the jurisprudence of the EPO Board of Appeals and EPO Enlarged Board of Appeals is much higher than that of the jurisprudence in existence in each country, respecting nullities related to national Patents derived from European Patents, various cases exist for comparing corresponding decisions relating to parallel cases.

In this regard, in the 16-19 October 1996 Open Forum in Barcelona - organized by FICPI - Guido Modiano presented an excellent paper on this point, setting forth some conflicting decisions that have arisen in the United Kingdom, Sweden, Switzerland, the Netherlands, Germany, Austria, France, Belgium, Italy and Spain.

By way of conclusion, it can be said that, even though the national Judges respect and consider persuasive the decisions taken by the EPO, at whatever level, nevertheless these national Judges do decide, taking into account their own criteria according to Law and the special circumstances of the case at the time of judging the patents. This is why these conflicting Decisions may occur.

2. Situation foreseen for the future Community Patents for centralized limitation proceedings

The Agreement relating to the Community Patent, signed by the Community States at Luxembourg on 15 December 1989, will allow making limitations to a granted Community Patent.

- Article 51 establishes: “At the request of the proprietor, a Community Patent may be limited in the form of an amendment to the claims, the description or the drawings”.
- Article 37 (1) establishes, moreover, that said limitation can be applied for with respect to individual States only in the case of conflict with prior national rights.
- This limitation cannot be raised at the EPO until the conclusion of the 9-month term from publication of the mention of grant; nor can it be raised as long as there are oppositions or appeals pending EPO resolution.
- Article 53 establishes that the EPO will examine the application for limitation, and that it will limit the Patent provided the grounds for revocation would not prejudice the maintenance of the Community Patent as limited (Art. 56/1 (a) to d). It can also reject such limitation application.
- Article 50/2 establishes that the limitation will not be retroactive. Once the Community Patent is limited, the EPO will re-publish it in the amended form, and the limitation will come into force on publication of its mention in the Community Patent Bulletin.

- General conclusion: Due to the fact that the entry into force of the CPC seems unlikely, any time in the foreseeable future, I am pessimistic about this centralized possibility for the users.

3. Centralized Limitation Possibilities at the European Patent Office

3.1. We have already spoken of Article 123 EPC, allowing the possibility of introducing limitations into the European application or European Patent, while still in course of prosecution before the European Patent Office. In this regard, I would recall that the EPO is very strict about permitting added disclosure to the first-filed Specification and, therefore, the practice with these limitations continues to be a “sensitive” issue. In effect, it happens sometimes that the Examining Divisions allows claims with improper amendments and afterwards these are found, in the opposition proceedings, to constitute added matter. Then the patent can be held invalid because there is no possibility of removing the limiting feature without broadening the claim.

3.2. Nevertheless, no rule whatsoever exists in the EPC that would allow limitation or reexamination of a European Patent, once granted and published.

- Up until 6 July 1994, the owners of European Patents who wished to limit the same, for example, on becoming aware of new prior art not considered during the examination, or on becoming aware of prior national rights and so wishing to narrow the scope of the claimed invention, used Art. 99 (1) EPC relative to opposition proceedings, opposing their own patents, on the basis that this Art. 99 (1) establishes that “any person” can file opposition to a granted European Patent.
- This was possible on the basis of decision G 1/94 (OJ EPO 1985, 299) by the Enlarged Board of Appeal, who interpreted said term “any person” in a broad sense, including therein the owner of the patent himself. Hence, there has been a period of time during which the owners of European Patents, within the 9-month period following publication of the notice of grant, have been able, throughout that route, to limit in a centralized way, or even achieve revocation of their European patents, for all of the designated States, with an ab-initio effect.
- Nevertheless, on 6 July 1994 a new decision (G 9/94) by the Enlarged Board of Appeal overturned the foregoing. According to that decision, European Patent owners cannot oppose their own patents, inasmuch as the correct interpretation of “any person”, within the context of Article 99 (1) must be that of any person other than the owner.
- The Enlarged Board of Appeal has interpreted in this decision that the term “any person” has to be considered not only on the basis of its literal meaning, but also within the context of the EPC as a whole and in the light of its object and purpose.
Thus, the self-opposition, permitting central limitation for patents, is no longer admissible, and the opposition proceeding has been left limited to a proceeding between two different parties.

The consequence is that patentees have to rely on each national limitation proceeding, one by one, when they realize that they have a patent with a nonenforceable too large scope.

3.3. The possibility, allowing centrally limiting European Patents, or re-examining them, was discussed on the 11 and 12 September 1995, during the "hearing", held in Munich, by the EPO, the main purpose of which was to listen to the opinions of the users of the European Patent system.

The majority of the interested circles spoke in favour of introducing a centralized system for permitting modifications to the patent after grant, but limiting this possibility to the patentee. Nevertheless, no interested circle spoke in favour of implanting a reexamination procedure requested by third parties, inasmuch as this possibility would increase the uncertainty as to the validity of the patent, during its lifetime.

But, as the possibility of European Patents being re-examined by different National Offices exists and so this could lead to European Patents of different value, it was therefore considered that a central re-examination proceeding by the European Patent Office would be preferable instead.

As a consequence of the "Hearing" Conclusions, the Administrative Council of the European organization, at its 6 December 1995 meeting, petitioned its Committee on Patent Law to make a study of this issue, and to make the corresponding proposals in that respect.

3.4. The Patent Law Committee issued, on 23 September 1996, a paper (CA/PL11/96) which outlined the following principles for a European centralized limitation procedure:

- The desirable European limitation procedure should have a structure similar to the CPC limitation procedure.
- Limitation procedure will enable to narrow down the scope of a patent post-grant.
- Limitation procedure will be only at proprietor's request (so not accessible to third parties).
- Examination of patentability of the limited patent will be made by the EPO.
- Limitation will have ab-initio effect for all designated countries (in contrast to the CPC limitation procedure), so as to permit to eliminate the legal effects of a patent for the period prior to the limitation as well as to prevent revocation.
- The limitation procedure could be requested at any time, but not during the period within which an opposition could be filed, or while opposition proceedings were pending.

(This would prevent parallel cases relating to the validity and scope of a patent from arising at EPO level).

- The central limitation procedure would be effective in all the designated States of the European patent.
- Limitation separately considered for individual contracting States would be allowed, in the event of conflict with prior national rights in these States (This is the same possibility foreseen in Art. 37 (1) and 51 (1) of the CPC).
- (Now, prior national rights can be taken into account in the opposition proceedings with the result that a separate type of claims may be included in the patent for the State in question)
- National proceedings, in particular partial surrender limitation procedures or revocation proceedings, should not take precedence over the European limitation procedure.
- Nevertheless, opposition proceedings were to take precedence over any limitation procedure.
- The Committee on Patent Law concluded:
- For a central limitation procedure for European Patents to be introduced, the EPC would have to be revised.
- The regulations required could be added to the EPC as a separate part after the opposition procedure.
- The practical implementation of such a procedure could be assigned to the opposition divisions of the EPO.
- There is no particular urgency attached to the introduction of a central limitation procedure for European Patents.

3.5. The national representatives on the Patent Law Committee pointed out some difficulties facing this proposal, during their 23-25 October 1996 meeting.

- The introduction of a central limitation procedure would extend the EPO's competence in the post-patent phase beyond the opposition proceedings. Whether or not this is desirable should be a matter for the contracting states to decide.
- Whether a limitation procedure should be introduced with or without examination of the patentability of the residual patent is a question which should still be considered carefully. Some States are in favour of a quick procedure without re-examination of the subject matter, some others favour the re-examination. If it was finally decided not to examine the remaining part of the patent it could lead to obtaining a residual unpatentable patent with that limitation procedure. If it was decided to examine that limited patent, possible further search of prior art submitted by the patentee would perhaps be necessary.
- If the Community Patent would ever exist, and this European limitation proposal were to come into effect, two types of different limitation procedures would have to "co-exist", one for the Community Patent and another for the classic European Patent.
• The central European limitation procedure and the national limitation procedures would be in competition. It would be a matter for the national legislators to decide which one would prevail, in case of conflict.
• This situation nevertheless is not new. This situation now happens in cases where a European opposition proceeding and a national infringement or revocation proceeding are in competition.
• If the request for limitation is published and made available to the public, the possibility of permitting third parties to intervene in the proceedings makes observations or even opposing the limited patent would also have to be foreseen.
• All these possibilities may have, as result, a lengthy proceeding, perhaps contrary to the patentee's interest.

3.6. General conclusion: Since to implement this proposed limitation procedure a revision of the EPC would be necessary, and this can only occur in a new Diplomatic Conference, and the matter seems not to have a special urgency, I am also pessimistic about this possibility in the near future.


Owing to the difficulties already mentioned that seem to exist for entry into force of the Community Patent, the "Institut Français pour la Recherche en Propriété Industrielle", linked to the Paris Chamber of Commerce, has prepared a Draft of a "New International Convention on the Settlement of Litigation concerning the Infringement and Validity of European Patents".

Said Draft was sent to the European Commission in 1996, where it has been well received by IRDAC (the Industrial Research and Development Advisory Committee), besides being sent to the European Patent Office, for study and opinion. The latter has not yet studied this Draft, so it has still not been possible to send it to SACEPO for discussion. Later on it can be sent to the national representatives of the Contracting States for study and definitive implantation.

Said Draft has been studied by the EPPC several times.

The Draft is based both on the Protocol for the settlement of litigation concerning the infringement and validity of Community Patents and on the Protocol for the Common Appeal Court, forming part of the Community Patent Agreement signed in Luxembourg on 15 December 1989.

Due to the delay, mentioned above, of entry into force of the Community Patent Agreement and its two Protocols, the said Draft seeks to achieve in a similar manner harmonisation of the resolution of litigations relating to the Infringement and Validity of European Patents, besides introducing a centralised system for determining the validity of European Patents, or to limit these.

Hence, this Convention:
• DEFINES acts of patent infringement in a harmonised way.
• ESTABLISHES creation, in each one of the contracting countries, of "European Patent Courts" at national level which would be in charge, in first and second instance, of resolving the different European Patent infringement conflicts, as well as the possible invalidity of these European Patents.
• ESTABLISHES the possibility of deciding the validity of the European Patents, centrally likewise before the European Patent Office (by a Revocation Division).
• ESTABLISHES a common European Patent limitation procedure before the European Patent Office.
• ESTABLISHES the creation of a Common Appeal Court (EPAC), for infringement cases as well as for cases of invalidity of European Patents.
• ESTABLISHES that, in the actions before EPAC, it will be compulsory to be represented by a European Patent Attorney or by a lawyer assisted by a European Patent Attorney.
• ESTABLISHES rules of jurisdiction in the case of infringement, in line with those established by the Brussels Convention. The proceedings shall be brought in the Courts of the Contracting State in which the defendant is domiciled or in which he has an establishment. So, in the case of several defendants, forum shopping may be possible. Nevertheless, the proceedings may also be brought in the Courts of the Contracting State in which the act of infringement has been committed. Consequently, once this Convention comes into force:
• In European Patent infringement cases and in invalidity cases, the plaintiff will be able to proceed, in first and second instance, before his National European Patent Courts. The Courts of 2nd instance shall stay their proceedings in so far as requiring a judgement at the Common Appeal Court.
• The validity of a European Patent can be challenged centrally for all the contracting States before the EPO, or as a counterclaim before only one European Court.
• These European Patent Courts of each Contracting State will, therefore, follow the jurisprudence established by the EPAC.
• In invalidity cases, the plaintiff will likewise be able to proceed either before these National European Patent Courts, or else before the European Patent Office. In the last instance, he will likewise be able to proceed before the EPAC. The validity or invalidity will prevail for every country, whatever Court decides the issue.
• Execution of the decisions, and the decision on damages following on the EPAC decision, will again become the competence of the National Courts.
• The possibility shall continue to exist, of appealing to the highest Court of Justice in each contracting state. That is to say, the national regulation of acceding, in
third instance, to the highest Court shall continue for those matters upon which the EPAC does not have exclusive jurisdiction.

- The EPAC Convention has an intermediate approach between the centralized approach of the CPC (for validation and infringement) and the decentralized approach of the Brussels Convention.

### 5. General Conclusion:

As thus far outlined, hopefully, we are at different levels in the process of trying to obtain harmonized and/or centralized proceedings to deal with limitation, infringement or invalidity of European Patents. Time will tell the final results.

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**Exercising rights conferred by a European patent**

**Solutions for effective action and maintenance of uniform rights at the European level**

**Mechanism of decisions having cross border effect**

> JHPJ Willems (NL)

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Zusammenfassung / Summary / Résumé

Eine wirksame Verteidigung ist von großer Wichtigkeit für alle Arten von Rechten, aber insbesondere für Patentrechte.

Eine wirksame Verteidigung von Patentrechten sollte schnell, preiswert, sicher und von guter Qualität sein.

Grenzüberschreitende gerichtliche Verfügungen können hier eine große Rolle spielen, da sie relativ schnell und preisgünstig sind, die Sicherheit steigern und von guter Qualität sein können.

Grenzüberschreitende gerichtliche Verfügungen werden an Bedeutung gewinnen, da Patentpraktiker die Möglichkeiten internationaler Gerichtsbarkeit gemäß den Übereinkommen von Brüssel und Lugano entdeckt haben. Wenn ein nationales Gericht internationale Gerichtsbarkeit besitzt, dann hat es den betreffenden Fall zu untersuchen und kann dies nicht verweigern.

Grenzüberschreitende gerichtliche Verfügungen, die der verletzenden Partei eine Geldstrafe auferlegen, falls diese das Patent weiterhin verletzt, funktionieren wegen der Übereinkommen von Brüssel und Lugano. Falls die Geldbuße verfällt, kann sie durch Beschlagnahme der Waren des Verletzers in allen Mitgliedstaaten des Übereinkommens eingetroffen werden.

Wie auch immer, grenzüberschreitende Verfügungen könnten zu "forumshopping" führen. Falls dies als Nachteil betrachtet wird, besteht doch die Hoffnung, daß ein Beitrag hinsichtlich des wachsenden Druckes bezüglich der Schaffung eines europäischen Patentgerichtes und bezüglich der Harmonisierung des europäischen Patentgesetzes geleistet wird, nicht nur des materiellen Patentrechtes sondern auch des Prozeßrechtes.

Effective maintenance is importance for all kinds of rights but especially for patent.

Effective maintenance for patent rights should be fast, cheap certain and of good quality.

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Cross border injunctions can play an important role here because they are relatively fast and cheap, enhance certainty and can be of reasonable quality.

Cross border injunctions are going to stay because practitioners have discovered the possibilities of international jurisdiction under the Brussels and Lugano conventions. When a national judge has international jurisdiction he has to try the case and cannot refuse to do so.

Cross border injunctions, imposing a fine on the infringing party in case he should go on infringing the patent, do work because of those same Brussels and Lugano conventions. If the fine is forfeited it can be collected by seizing the goods of the infringer in all member-states to the conventions.

However: cross border injunctions could lead to forumshopping. If this is considered a disadvantage is to be hoped that it will contribute to the rising pressure towards the creation of a European Patents Court and towards the harmonisation of European patent law, not only material law but also procedural law.

Une maintenance efficace est du plus haut intérêt pour les droits de brevets. Celle-ci devrait être rapide, bon marché, certaine et de bonne qualité.

Les Euro-injonctions jouent un rôle décisif car elles s’ouvrent rapides, bon marché, de qualité raisonnable et accentuent la certitude. Elles sont appelées à se maintenir dans la mesure où la pratique a découvert les possibilités offertes aux juridictions internationales dans le cadre des Conventions de Bruxelles et de Lugano. Lorsqu’un juge national est saisi d’une question sur un plan international, celui-ci est contraint de rendre une décision et ne peut se soustraire à cette tâche. En raison des conventions ci-dessus, les Euro-injonctions opèrent efficacement lorsqu’elles imposent le paiement d’une amende à la partie contrefactrice en cas de poursuite de la contrefaçon. En cas de besoin, l’amende peut être...
payée par le biais de la saisie des produits contrefacteurs dans tous les États membres.

Elles pourraient cependant conduire à une pratique de "forum shopping". Si cette possibilité peut apparaître comme un inconvénient, celle-ci pourrait néanmoins accentuer le mouvement vers l'institution d'une cour en matière de brevets européens, ainsi que l'harmonisation des règles, tant matérielles que procédurales en matière de brevet européen.

CBI's are not easy to come to terms with, especially not for IP-lawyers, being raised with the idea of the territoriality of their subject-matter.

When I first had to deal with them, I suffered a kind of agoraphobia; an instinctive feeling that this could not be right.

In the course of the past years however I became convinced that they are to be welcomed, but should be welcomed everywhere to be really effective.

Nevertheless I hope I will not sound to you as a salesman, trying to sell you a vacuumcleaner that sucks up all problems. I realise very well that CBI's have also their disadvantages.

Nevertheless my message to you this afternoon is:

Although they have their shortcomings, cross-border injunctions (hereafter also: CBI) are there to stay as part of a system of effective maintenance of patent rights. Moreover: that is not to be regretted.

When we define a system of effective maintenance as being

i) fast (justice delayed is justice denied),
ii) affordable and
iii) giving the utmost certainty and
iv) quality,

the CBI covers 3 of the 4 requirements:

A CBI is faster than a lot of separate proceedings, it is also cheaper and it gives no risk of different decisions on the same subject matter in various countries.

A problem could be the quality: often a foreign law will have to be applied and it certainly is not easy for a national judge to apply foreign law. If that problem can be overcome or reduced we should welcome CBIs. In my opinion the problem can be solved.

But whether we welcome them or not: they are going to stay because the law - i.e. the Conventions of Brussels and Lugano - say so.

The importance of effective maintenance for patent rights

Effective maintenance in a judicial procedure is of course important in all fields of law. As a former professor of procedural law taught me:

being right without being set right is just pub-talk.

But for patents effective maintenance is even more important:

In the case of a patent judicial maintenance is the only way to exercise your right. It is the essence of your right.

If you own a house or a car, you can use your property and you need the judge only when some rogue tries to hinder you in using it. In the case of patent-rights however, your only right is the right to prevent someone from doing the thing you thought of first. If you cannot use that right effectively in court, that means diminishing directly the value of your patent. Of course I am aware of the fact that by far the larger part of patent disputes are settled out of court, but such a settlement is only possible if the alleged infringer knows he can be dragged to court in an effective way.

Effective maintenance

Has to be fast because of the short (economic) lifetime of a patent. Without the possibility of a relatively fast judicial reaction, the patent law is only a toothless monster.

Has to be as cheap as possible because it is about economics: expensive maintenance reduces the value of the patent and can even make it worthless: a patent for a paperclip in the USA would be worthless because it cannot be maintained. You cannot sell enough paperclips to reimburse you for the cost of litigation.

Maintenance must have the same result throughout Europe because otherwise the European market would become split up in sub-markets and that again would reduce the value of the patent as it would make decisions about investments troublesome.

Finally: if the quality of the decisions is not good, that will result in costly appeal-procedures and transform your patent to a sweepstake or lottery and you cannot base investment-decisions on the outcome of a lottery.

As the only risk of CBIs seems to be the (important aspect of) quality, and CBIs are here to stay, the only question seems to be: how to reduce that risk?

The risk of a lesser quality because of the difficulties of applying foreign law.

How great is the risk that foreign law has to be applied?

How can the risk of a lesser quality be minimised?

Regarding the applicable law, the main rule is stated very clearly in Cheshire and North's Private International Law, Butterworths (1992), pp. 74-75:

"One of the eternal truths of every system of private international law is that a distinction must be made between substance and procedure, between right and remedy. The substantive rights of the parties to an action may be governed by a foreign law, but all matters appertaining to procedure are governed exclusively by the law of forum".

In our Dutch practice that is rule is implemented thus that the question of whether or not there has been an infringement is to be decided according to the law
of the locus delicti. Also the question of what sanction can be given (injunction, damages, forfeiture of the infringing articles, naming of customers and a discovery of the numbers and prices sold, etc.) again has to be decided according to the law of the locus delicti.

As procedural questions, to be decided by national law, we consider the question in what form of procedure the matter can be brought before the court (kort geding or main proceedings) and the question how the sanction is to be effected (forfeiture of a fine, sending someone to prison).

So, in Holland anyway, it boils down to the question whether there is an infringement and to the question whether an injunction is possible. Personally I don’t think those questions should in general - be too difficult because

i) the substantive law on infringement and scope of protection has largely been harmonised and

ii) there is no reason why special problems of certain national laws (for instance art. 44-3 of the British Patent Act 1977) could not be explained to a foreign judge, if need be by a national barrister.

If a plaintiff is asking for special remedies (e.g. forfeiture of the infringing articles) I think the onus of proof (that that particular remedy can be obtained according to foreign law(s)) is on him. In my experience I get the impression however that, although all kinds of other sanctions are nearly always asked for, it does not really matter as long as the plaintiff gets his injunction.

Likewise the onus of proof of a certain defence being valid according to foreign law is on the defendant.

Why are/were these CBIs causing so much emotion?

Cross-border injunctions in patent cases have been given in the Netherlands during the past five or six years in patent cases since President Rechtbank the Hague 30 December 1991 BIE 1992, 80 Philips / hemogram.

The rationale of the Dutch Hoge Raad (our Supreme Court) in the landmark decision Interlas / Lincoln of 1989 was that it would have an undesirable effect on legal practice - if in a time of increasing international contacts - in cases of torts with an international character - like an infringement of intellectual property rights - the injured party would be compelled to go to court in every country concerned.

It took CBIs some time - to December 1991 - to spread to patent cases.

They initially caused some commotion but seem to be spreading nevertheless.

By the way, it is not clear why the Dutch are regarded as the inventors of the cross-border injunctions: they were neither new nor inventive. You all probably know of the Laker anti-suit injunctions, when British and American judges forbade parties to sue their adversaries on the other side of the Atlantic: that was cross-border pur sang.

If the Frenchman Pierre Lebrun hits his wife over the head in Strassbourg, nobody, I hope, will think it strange that a French judge would forbid him to do so. Nor would it seem too strange if this French judge forbade Monsieur Pierre Lebrun to hit his wife and decided that this injunction would also apply during the vacation M and Mme Lebrun are planning to take in Spain. Nevertheless: this is an injunction with cross-border effect.

Why, then, would it surprise us that a French judge would enjoin M Lebrun from infringing a patent of his colleague Lenoir, be it a French patent or a German patent?

One explanation could be that we as patent lawyers have been raised with the idea of territoriality of patent rights. But that is not so very special as we like to think: also the rights provided by the ownership of a house or a car are somewhat different from country to country. In Germany you can only derive your rights from the BGB and in France solely from the Code Civil. In some countries your car has to comply with higher or other technical standards than in other countries. In France (and in most other countries) you can not enjoy all the horse-powers of your racing monster because of speed limits, while in Germany you can use it to the full. Nevertheless: why should a French judge not enjoin a defendant from damaging that car, not only when it is in Strassbourg but also when it crosses the Rhine and is parked in Karlsruhe?

I have the impression many opponents to the idea of cross-border injunctions are not too much opposed to the idea of enjoining a national defendant to do something in another country.

In their view the real problems arise in the case of a judge of country X forbidding something to a defendant domiciled in country Y.

That, however, is really not a problem of cross-border effects but is a matter of jurisdiction.

For most member-states of the EPC the matter of jurisdiction is regulated by the Brussels Convention or by its sister, the Lugano Convention.

And that brings me back to my statement that CBIs are going to persist, in any case in some form or other. I am saying so because the Brussels Convention says so.

Why are CBIs going to stay?

It all boils down to jurisdiction: if a judge does not have jurisdiction he should, of course, not try the case, but on the other hand: if a judge does have jurisdiction over a defendant he should indeed, of course, try that case.

The main rule is that if a judge has jurisdiction he has also the power to decide the case. ( Lloyd J. in
This has also been held implicitly by the German Landgericht in Düsseldorf\(^5\) and by the British Patent Court (Laddie J)\(^6\).

The point of view is also possible that it concerns patents which are, after grant, independent from each other so decisions about them can never be conflicting.

This question whether the existence of a sole European (bundle)patent gives indeed sufficient connection to apply art. 6 of the Convention will however have ultimately to be decided by the European Court of Justice in Luxembourg. However, up till now no Court of Appeal has thought it fit to ask this Court of Justice for its opinion. Taking into account that the answer on a prejudicial question takes about two years, it seems that we will have to live with some uncertainty for the next few years.

A further exception on the main jurisdiction-rule of art. 2 is art. 5-3 Brussels Convention, which gives jurisdiction to the court of the place where the tort has been committed. The question is still pending before our Court of Appeal however whether this jurisdiction extends to cross-border decisions. Personally I think this special jurisdiction should be limited to the country where the infringement, that creates the jurisdiction, is taking place.

Finally there is art. 18 of the Brussels Convention, giving jurisdiction to the court before which the defendant appears, save when this appearance is solely to dispute the jurisdiction of the court. It does happen however that foreign defendants appear and do not question the jurisdiction!

One other case I would like to mention, in which the plaintiff started a kort geding procedure in Holland after having initiated main proceedings in the other countries concerned. Given the rationale of the decision of our Supreme Court - preventing that a plaintiff should be compelled to take proceedings in a number of different countries - it should not have been a surprise for the plaintiff when I held that the rules of fair play meant that he could not force the defendants to fight at home and abroad. Having chosen to go to court in every country concerned, he should in my view not be permitted to force the defendants to fight not only at home but also in a foreign court.

Why does it work?

By the way: this same Brussels Convention makes that the CBI works and is not only a piece of paper.

In Holland we do not know the concept of contempt of court and we are not sending people to prison for not obeying orders of a judge. Instead an injunction is accompanied by the order that the defendant, should he not obey, will be forfeiting a very heavy fine (to the plaintiff). If the plaintiff is of the opinion that the fine has been forfeited he can seize property of the defendant in the Netherlands. If the defendant does not have assets in the Netherlands but he does in other countries, the plaintiff asks the Dutch judge to determine

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2 High Court of Justice, Chancery division, 7 March 1997, no CH 1996 P 6040.
3 High Court of Justice, Chancery Division, 26 March 1997, no CH 1996 C. no 7837.
what amount has been forfeited and that decision can be executed in other countries that are party to the Brussels or Lugano conventions. The judge in that other country has to give his exequatur but the Conventions say that he may refuse that only if it is contrary to public order. Up till now I know of only one case in which a judge (a French judge) had to decide on that question, in which case no conflict with the French ordre public was found.

This was formerly often not fully understood: when the CBI's where rather new and were only given in Holland, I heard of foreign lawyers advising their clients to remove their assets from Holland.

You see why that is not a very useful advice: as long as someone has assets in any memberstate under the Brussels or Lugano Conventions, a CBI can be executed effectively against him. (A better way to prevent trouble seems to be not trespassing on the intellectual property of other companies.)

What about forum-shopping?

This is often mentioned as one other disadvantage of CBI's, in any case of the way they are applied up till now in Holland as a consequence of our construction of art. 6 of the Convention.

I am not yet sure whether this indeed is a disadvantage or whether it could be regarded as an advantage in disguise.

First: forum-shopping can be done by both parties so it is not a one-sided (dis)advantage.

When forum-shopping could only be done by the patentee, it is easy to see that that might lead to a too large scope of protection. The patentee will choose those jurisdictions that are supposed to be patentee-prone. The possible defendant however can start an action himself to get a declaration of non-infringement.

Second: it only matters as long as there are differences between the different jurisdictions. That could lead to greater harmonisation, because national judges are informed on the law in other countries and on decisions given elsewhere.

What we really need - and badly need - is of course a European Patents Court in some form or other.

Patent judges are of course all too aware of the fact that we should have as much unity in our patent law as possible. We are no longer living (any more) on islands. Nobody realises that more thoroughly than the islanders par excellence: the British. The English Patents Court for instance has held that the British view on the matter of the second medical indication is the better one. Nevertheless it has decided that unity demands the views of the EPO be followed.

However: only judges trying to keep abreast of one another's decisions is not enough. There should be a court that not only unifies but which can give direction to the development of European patent law as well.

What possibilities are open?

- COPAC could be one possibility, but will it ever come to life?
- Jacob J. has suggested to appoint experienced national judges as members of the EBA. I welcome that suggestion, but it is only for starters: the EBA cannot answer questions from the national judiciaries and has no dealings with matters of infringement.
- The Greenpaper of the European Commission suggests the creation of a new Revocation Division within the EPO that should decide exclusively on matters of nullity. Hearing what practitioners say about the time a decision from the existing divisions of the EPO takes and taking into account that an appeal from decisions of the Revocation Division will be possible on the Court of First Instance in Luxembourg and ultimately to the European Court of Justice, I fear that such a construction would lead to an ocean of stayed infringement procedures, all awaiting the outcome of the decision on validity and would be killing effective patent protection. (I wonder whether it is possible to devise a court which would be able to handle all nullity claims in Europe within a reasonable time).

- Prof. Brinkhof, vice-president of our Court of Appeal, has suggested a kind of ad-hoc court composed of judges from the national Supreme Courts, supplemented by one or more members of the Enlarged Board of Appeal, who convene only if a ruling is required on questions of interpretation and who can give binding answers to preliminary questions put to them by national judges.

I think personally that would be the most workable solution. If such a court would be attached to the European Court of Justice or the Court of First Instance in Luxembourg it could perhaps be realised without time consuming changes in treaties, of which we all know the usual pace. It could also be attached to the EPO and perhaps be integrated with the Enlarged Board. This would have the substantial advantage of eliminating the risk of conflicting decisions of the EBA and the European Patents Court but on the other hand the disadvantage of needing a separate treaty.

Such a solution can only work for a community-patent, that yet has to be created. (Since few people believe the CPC will ever come to life.) For the EPC-patents a European court will not be able to decide on the validity because of art. 16-4 of the Brussels Convention, giving exclusive jurisdiction on matters of validity.

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9 for Community patents
to the courts of the country where the patent is registered.

I often wonder however why parties do not consider the possibility of asking a binding decision of a panel of for instance three appellate judges from different countries supplemented by 2 technical members of a Board of Appeal of the EPO. Nothing prevents the parties to make a contract that they will abide by such a decision of such a panel on forfeiture of a penalty. If the validity of the patent is at stake such a contract could oblige the patentee to have his patent struck out in all designated countries if the panel came to the conclusion that it should be annulled.

Such a solution could be useful till we get at last a real European patent and a real European patents court.

Conclusion:

As I said before:

Although they do have their shortcomings, CBIs are here to stay as part of a system of effective maintenance of patent rights. And again: that is not to be regretted.

I would like to add: they are only part of such a maintenance system. What we very badly need is a European patents court that can unify European patent jurisprudence, preferably by rendering binding opinions on questions put to it by national judges.

I hope I have not wasted your time by talking to you for half an hour and coming to the same conclusion I mentioned at the beginning of my presentation.

However that may be: I welcome questions, being sure that there remain plenty of them.

The scope of protection of (European) patents and its possible future interpretation under the Protocol to Art 69 EPC

W. Holzer (AT)

Zusammenfassung / Summary / Résumé


In connection with the interpretation of the scope of protection of European patents by national courts within the field of tension established by the Protocol, namely fair protection for the patentee and a reasonable degree of certainty of third parties, a trend towards an increased consideration given to the interests of the public as to certainty of right is noticeable. In line with this, under the doctrine of equivalents only means will be consid- ered as equivalents which are deductible more or less readily from the wording of the claim for which the ap- plicant has the sole responsibility. The scope of protec- tion will normally not extend to individual features or to sub-combinations of features taken from the claim. Third parties must be able to rely on the fact that the subject matter of the invention protected is described fully in the claim. As a common European patent court is unli- kely in the near future, a small number of specialized courts of the first and second instance should be established in the member states handling infringements. Likewise, provisions should be included in national laws regarding equivalents and harmonizing interpretation principles, because experience has shown that the Protocol leaves open too many possibilities of interpretation.

Dans la question de l'interprétation de l'étendue de la protection des brevets européens par les juridictions nationales conformément aux principes qui sont posés par le Protocole, oscillant entre une juste protection pour le brevet et un degré raisonnable de sécurité juridique pour les tiers, on observe une tendance qui se dessine vers une accentuation de l'intérêt du public et de la sécuri- té juridique. Ainsi, pour l'application de la doctrine des équivalents, seuls seront considérés comme équivalents les moyens qui pourront se déduire plus ou moins facile- ment des revendications, dont la rédaction aura été sous la seule responsabilité du demandeur. L'étendue de la
1. The patent claims form the basis for the scope of protection

SOMEONE WHO HAS IDEAS BUT DOES NOT KNOW HOW TO EXPRESS THEM IS NO MORE ADVANCED THAN SOMEONE WHO HAS NONE (Percy)

The inventor, the applicant and/or their European patent attorney determine the wording of the patent claims at the filing date. The "art" of an attorney who turns the invention into claims, thereby endeavouring to create a certain scope of protection, usually consists in veiling the subject matter put forward by the inventor by describing it in general terms, mainly by using a single-idiom meta-language based on the word "means" (plus a functional adjective). The attorney acts under what we might term a blurred vision syndrome.

ATTORNEYS USE MEANINGFUL "MEANS" LANGUAGE DISGUISES THOUGHT (L. Wittgenstein)

Thus, any later interpretation mainly consists in unveiling the subject matter with a certain degree of abstraction.

"abstract". Separated from matter, practice, or particular examples, not concrete; ideal, not practical; abstruse; "abstraction", Process of stripping an idea of its concrete accompaniments; "abstruse", Hard to understand, profound, (The Concise Oxford Dictionary, 1926)

Art 84 EPC tells us what the claims ideally should be: "The patent claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description". Also ideally (T 2/80), the claims should be understood without the support of the specification.

Pursuant to Art 83 EPC "the European patent application must disclose the invention in a manner sufficiently clear for it to be carried out by a person skilled in the art."

Thus, Art 84 as well as Art 83 EPC not surprisingly refer to "clarity" as being of paramount importance for the patent protection system, which admittedly also has its "obscure" aspects. This requirement in an ideal world would automatically simplify the determination of the scope of protection.

WHAT CAN BE SAID AT ALL CAN BE SAID IN A CLEAR MANNER (Wittgenstein)

In a juridical sense a patent claim is commonly held to be a unilateral declaration of the applicant in the words and terms of his choice, chosen in consideration of known prior art to define a subject matter to be protected. The teaching of the claim although addressed to the interested public, must establish a link to the knowledge and abilities of the person skilled in the art.

THE APPLICANT NEED NOT BE SKILLED IN THE ART

2. The grant procedure

The filing date marks the point of no return for the content of the application, also as concerns stated equiva-
lents. The application which is published pursuant to Art 93 EPC after 18 months informs the public about the extent of protection, which is usually the maximum extent, based on the content of the application.

Art 69 (2) manipulates the scope of protection: "For the period up to grant of the European patent, the extent of the protection conferred by the European patent application shall be determined by the latest filed claims contained in the publication under Article 93. However, the European patent as granted or as amended in opposition proceedings shall determine retroactively the protection conferred by the European patent application, in so far as such protection is not thereby extended."

Upon publication a "careful and analytical reading of the whole content of the application, it was said in T187/91, would reveal what is essential to the invention in order to achieve its stated aims. This means that an interpretation of the claims on the basis of the content of the application is possible for the first time, which may be of interest for the competitor and any possible infringer.

ANYONE WHO DETERMINES THE SCOPE OF A CLAIM IS A POTENTIAL INFRINGER

Art 93 EPC can be seen in conjunction with Art 67 EPC, which enables the filing of claim translations for provisional protection, the scope of which may be the maximum possible scope.

As a great deal may happen in the examination proceeding concerning the scope of protection, we may ask: Must the scope of protection be addressed as such in the course of the examination of the patent application? What role does the examiner play in this context? Should the European Patent Office, as some scholars believe, be given greater responsibility as concerns establishing the scope of a claim?

Quite evidently, the examiners must occupy themselves foremost with the novelty of the claim teaching and with the inventive activity of the subject matter. The examiner must in other words deal with the difference remaining over prior art and with the terms defining such difference, while observing that the terms and their interrelation be clear and precise, and that the claim renders a complete teaching in relation to the underlying problem.

As the scope of protection demands interpretation at the end, the Guidelines for Examination already strive to give the problem a direction at the very beginning under the heading "Clarity and Interpretation of the patent claims", in instructing the examiner how to cope with the claim wording.

According to the Guidelines the individual words and terms shall have the meaning and the extent which they normally have in the technical field in question, unless the specification emphasizes a particular definition or meaning. Theoretically, any special meaning ideally should follow from the claim already (in the interest of the public), because only the claims are translated into the three official languages later on.

Regarding the scope of protection as such, the Guidelines mention that discrepancies between the claims and the description should be avoided if they, in view of Art 69 (1) might lead to a doubt about the scope. Likewise, general statements in the description aiming at expanding the scope of protection to "the essence of the invention" should be objected to. A further important aspect will be to determine the right category of the claims in view of the different scope of protection different categories accord. On the other hand, Art 69 EPC cannot be relied on as a substitute for an amendment which would be necessary to remedy a lack of clarity.

What normally happens in the examination proceeding is a limitation of the claims as initially filed and published, thereby narrowing the original maximum scope of the published claims.

However, there is also the problem of broadening of the claims which is perhaps more delicate. Pursuant to Art 123 (2) EPC the claims may only be broadened to the extent of what has been disclosed in the specification. Thus, new subject matter extending beyond the content of the application as filed may not be imported. This limitation is logical, because otherwise the content of the original specification would be novelty impairing with respect to what has been claimed in the broadened claims. A general principle is that a feature can be deleted from a claim as long as there is basis for a claim without that feature in the application as originally filed.

Again, according to the Guidelines for Examination, the applicant may include in the claims only such obvious modifications and equivalents as have been described in the application. It has been decided by the Boards of Appeal that a narrow term in a claim, which according to its literal meaning would not encompass an embodiment described in the specification (as originally filed) and clearly belonging to the invention, may be replaced by a broader term, unless the technical meaning of the narrow term in itself were able in the context of the description and drawings to establish the scope of protection. More importantly, the replacement of the only disclosed technical means by a broader term (which would result in the incorporation of non-disclosed equivalents into the content of the application) would not be allowed.

In general we can state that any later inclusion of equivalents in the specification and claims as originally filed is forbidden.

On the other hand, a rather liberal attitude prevails as concerns shifting of features from the preamble to the characterizing clause, as the scope of protection deriving from the totality of features apparently would not be affected.

Decision T 331/87 pertains to a "three-pronged test of essentiality" to determine whether a feature may be deleted from a claim or replaced without breaching Art 123 (2). The condition is that a person skilled in the art would directly and unambiguously recognize that
a) the feature was not explained as essential in the disclosure;
b) the feature is not indispensable for the function of the invention in the light of the underlying problem;
c) the replacement or removal requires no real modification of other features to compensate for the change.

Apart from the aforesaid problems which are more or less of a technical nature, the examiners need not reflect on possible problems of infringement and of equivalence, rather the examiner’s influence on the scope of protection is limited to the claim wording granted or suggested, and to the amount of abstract wording allowed. A wording suggested by the examiner, of course with the best of intentions, should however be carefully assessed. Many applicants and attorneys readily accept a suggested wording for patentability reasons without deliberating on the consequences. Sometimes a prolonged discussion with the examiner might result in a more abstract wording, beneficial for the scope of protection. After all, it is the applicant who must consent to the claims upon receipt of the Communication pursuant to Rule 51 (4) EPC, which marks the point of no return for the basis of the scope of protection as far as the applicant’s influence is concerned!

At the end of the examination proceedings the scope of protection will in many cases differ from the one of the claims as published. To add a national peculiarity: Pursuant to the Italian and the Austrian patent law and in accordance with Art 70 EPC, the scope of protection resulting from the claims as translated in the validation procedure would be decisive if the translation is “narrower” than the original claim version. This would enable a patentee to influence the scope even after grant!

In opposition proceedings the subject matter of the claims and their extent may change again, because new prior art might lead to a limitation of the claims. Again, Art 123 (2) EPC forbids any broadening due to an amendment of the claims, and there is no possibility to concurrently apply Arts 69 and 84 EPC.

The Boards of Appeal have stated (T 442/91) that in the opposition proceeding the Opposition Division must not concern itself with the scope of protection at all, because this was the task of national courts pertinent for patent infringement cases. The European patent apparently should not be provided with a “interpretation tag” at grant!

Summing up, remarks that the European Patent Office should assume a greater responsibility for the scope of invention in my view are exaggerated and pertain to the basis of the scope of protection only, namely the best possible wording of the claims. Not surprisingly, the Boards of Appeal have been quite restrained and have contributed little to the problem of determining the scope of protection. Rather, according to the rulings of the Boards of Appeal the objective content of the claims is to be ascertained in order to determine whether the invention is novel and inventive or in order to determine the subject matter of the patent. In this context, the specification and drawings may be used for interpretation purposes.

The Chamber moreover stated (T 1055/92) that the most important function of a patent claim is to fix the scope of protection desired for the invention; it would therefore not always be necessary that in a claim the technical features or steps be described in all details; a claim should state the essential features of the invention, in particular those features which distinguish the invention from closest prior art.

THE EUROPEAN PATENT OFFICE HAS LIMITED RESPONSIBILITY

As concerns any feedback of information on actual infringements to the European Patent Office on the other hand, one can ask what benefit the Examining Divisions or other bodies, such as the Boards of Appeal, would derive from such information for their task. Probably little, because infringing actions are not predictable and each claim due to its substance and interrelation of features will have its own separate causality incomparable with that of other claims. The yardstick for the amount of abstract wording of a claim to be granted should be prior art rather than its possible interpretation by national judges.

INFRINGEMENT IS NOT PREDICTABLE

3. The scope of protection is determined in a (possible) conflict

As Art 69 (1) EPC metaphorically speaks of the "extent" of the protection conferred by the European patent, but leaves a doubt about the scope in referring to the possibility of interpretation, it was given an Interpretation Protocol which is an integral part of the Convention:

"Art 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and the drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for the third parties." 

Historically speaking, the Protocol was considered a compromise between the formerly "restrictive" U.K. practice demanding that the claims set the precise boundaries of a monopoly by accepting any limitation introduced by the applicant, and the formerly "liberal" German practice sometimes relying on an expanded general inventive idea. The wording of the Protocol
therefore more or less acknowledged the formerly "neutral" Swiss practice, to set a middle ground between a literal and a liberal construction.

It is interesting to note that the German language, which is binding in itself, pursuant to Art 177 (1) EPC, requires "adequate" instead of "fair" protection and "sufficient certainty" instead of "a reasonable degree of certainty". Thus, no certainty even in the official languages!

Due to the lack of a supranational authority the scope of protection of the European patent will in the short run in the event of a conflict still be determined in the member states in the realm of national jurisdiction, pursuant to Art 64 (3) EPC. The national courts and the national judges deliberate according to the national laws, however, they cannot ignore the existence of Art 69 and the Protocol which constitutes a common legal framework on interpretation to be applied in all of the member states. As an example, in Germany and Austria the national laws have been amended to refer to an application of the Protocol (Sec 22a Austrian Patents Act, Sec 14 German Patents Act).

It may be of interest to recall a statement made in G 2/88 by the Enlarged Boards of Appeal: "There is a clear difference between the scope of protection and the right derived from a European patent. The scope of protection is determined by the contents of the claims, and therefore by their category and technical features. The right derived from a European patent on the other hand follows from the laws of the member states. In a general manner the scope of protection concerns what in view of the category and the technical features is protected, whereas the right from the patent concerns how the subject matter is protected". This approach, although legally remarkable, is of a theoretical nature in ignoring possible or actual infringement.

When will the scope of protection normally be addressed?

1) In inventive / innovative activity by the inventor and/or his attorney; 2) In situations of possible infringement, by the (possible) infringer and/or the patentee and/or their attorney; 3) In official proceedings at national patent offices on an application for a declaration of infringement / noninfringement (inter partes); 4) In national courts by judges and by experts appointed by courts; 5) In arbitration, mediation and other alternative dispute resolution mechanisms.

4. On Interpretation in case of (possible) infringement

From a political point of view the question is: What is more important, the interest of the public, that is of third parties to rely on certainty as regards the scope of protection, in order to be able to develop or work around the patent, (which by the way are different activities), or the interest of the patentee who desires a reward and who wishes to have as broad a scope of protection as possible?

If one regards the patent as a monopoly that restricts the freedom of the public, logically, the boundaries of a patent should be definite and relatively narrow. On the other hand, without adequate protection the patent system becomes void.

In this context recent court practice at least in some countries evidences a tendency towards an increased consideration given to the interest of the public as to certainty of right. This general somewhat "antimonopolistic" trend may be in line with general common market goals. The new court practice, on the other hand, might enable us to formalize some supranational principles or rules which could be included in national substantive laws in a harmonizing effort.

The features of the protected subject matter and of the assumed infringement or "When is a claim infringed?"

DETERMINING THE SCOPE OF PROTECTION REQUIRES INFRINGEMENT

We speak of infringement of the claim, not of the invention. Any assessment starts from the (possibly) infringing product, process etc., the claim being interpreted retrospectively.

REALITY IS COMPARED TO THE SENTENCE (Wittgenstein)

Normally a claim would be considered to be infringed if its "essential" technical features are found in the infringing subject matter in an identical manner or in the form of a variant with only minor or insignificant modifications or in a form in which some or all of the features are replaced by equivalent means or, to make it a bit more complicated, with one or more of the features deleted.

In "identical" infringement there would be no need to determine the scope of protection.

In practice, parties trying to avoid a patent would consider substituting or adding features. That is why the infringing subject matter usually presents itself in some form of make-up or disguise! As soon as the issue is raised by the patentee or the possible infringer, analysing the features and differentiating between essential and less essential features of the claims becomes an apparent necessity. It also has to be determined what role a feature plays in the context of a claim (we did not construct). When is a feature essential? In the end, if it has been essential for patentability reasons.

4.1 Interpretation principles in the light of jurisdiction

George de Talleyc notes:

ANY INTERPRETATION IS FALSIFICATION (Italian proverb)

Interpretation considerations, principles or rules which could probably be accepted in a general sense in the future, may be derived from hitherto jurisdiction in some
of the member states accepting the advice of the Protocol to proceed on middle ground ("via media" in the U.K.), such as Germany, the U.K., Austria, France, Switzerland... In a number of other member states, such as Italy, Belgium, Greece, the Netherlands... up to now apparently the middle ground has not yet been attained.

Very superficially we may note that the U.K. still pursues a somewhat restrained interpretation practice, thereby increasing the responsibility for the patentee, while for example France, Germany and Austria are relatively liberal, whereas Italy, Greece, Belgium and the Netherlands could be considered most liberal thereby putting more pressure on the infringer. This situation is not satisfactory as the inventor in different countries gets a different reward. However, once a block of countries tends towards middle ground, hopefully the other countries will have to follow sooner or later.

Some principles:
It is generally acknowledged, and has been at least a U.K. principle that in the interest of the patentee and thus of the patent system, it should as a rule not be possible to avoid the essential features of a claim by only minor modifications or additions resulting in a variant of the subject matter.

Since Art 69 already requires that the monopoly should follow from the claims, the entire claim has to be taken into account, with no difference made between the one-part or two-part claims. One could demand further that the claim wording should be taken as it is, because any rearrangement of features already results in pre-interpretation.

No objection can probably be raised to a rule accepting that the interpretation of claims shall be made according to the general principles of the interpretation of declarations of will, and the wording of the claims be interpreted in their logical sense. (In other words, common sense (!), which surprisingly is sometimes addressed in decisions, should be the basis of interpretation).

The main source for determining the scope of protection is the invention as patented, not as conceivably patented. Not what had been invented would be decisive, but only what had been claimed and granted. The motives which have led the applicant and/or his attorney to broaden or limit the claims would not be of interest.

Features will have to be rated and assessed, in particular as to essentiality, in the context of the claim.

Any interpretation of the claims should start from the underlying problem and shall be based on the knowledge of a person skilled in the art at the priority date.

Matter contained in the specification only, even if inventive, would not be protected. (Therefore, there is less possibility to interpret equivalents into the claim other than those directly following therefrom).

In case of doubt or discrepancies, however, the standard interpretation would be that the claim wording taken literally determines the scope of protection, which must nevertheless be interpreted.

Any limitations introduced in a claim deliberately by the applicant will have to be accepted as such.

THE CLAIM IS THE APPLICANT'S FAULT
A voice from America in this context: U.S. patent interpretation requires that a patentee cannot expand the scope of his patent coverage to cover matter which has been limited by an argument as being important, in securing allowance of the claims.

LIMITATIONS ARE IRREVERSIBLE
Working within the closed interpretation system of the Protocol, the terms as used in the claims shall be interpreted, if necessary, on the basis of the specification (as originally filed), the specification thus serving as a kind of "dictionary", in particular if the terms have been given a particular meaning in the specification, for example a list of terms and their meaning, as is often done in U.S. specifications (e.g. disclaimers). This in particular signifies the importance of the description.

WORDS AND TERMS HAVE A MEANING
As Austrian and other jurisdiction holds specifically: For the clarification of the technical terms as used in the claims only the specification and the drawings may be used, disregarding what in a particular technical field is designated by the term. Thus, the terms of the claims may also depart from common (technical) language if supported by the specification. Another aspect is equally important: As concerns technical terms which are self-evident to a person skilled in the art, the priority point of time is decisive.

4.2 The role of prior art
Ideally, one should be able to determine the scope of protection of a claim without consultation of prior art. This scope would be valid as long as the claim is not limited in a proceeding before a national court or patent office. The approach is based on the prerequisite that those who must obey the monopoly must be able to note its limits without time consuming assessment of prior art.

On the other hand, national courts when assessing a claim in an actual case, apart from the aim of the invention regularly do take into account prior art as stated in the specification, in order to determine whether the claim perhaps extends to something that in fact belongs to prior art, without thereby raising an invalidity issue. This course of action could be regarded as a form of re-examination, a notion naturally rejected by courts! Indeed, a claim may be worded precisely and nevertheless a closer look into prior art as acknowledged in the patent may result in an interpretation that reveals that the scope of protection be construed more narrowly than appears at first glance.

THE COURTS SOMETIMES DO NOT TAKE FOR GRANTED WHAT HAS BEEN GRANTED
4.3 Equivalents

At the beginning of this tricky topic there is an array of questions: How much more protection can an inventor/patentee expect over what he has actually written down in a claim? What is encompassed by a claim without being expressly stated? The answer will last but not least depend on the quality of the invention, ranging from pioneer inventions to minor improvements.

INVENTIONS HAVE A QUALITY

Is there a common doctrine of equivalents throughout Europe? The answer will probably be, NOT YET, if we look at proceedings in the U.K., for instance.

What is regarded as an equivalent? To start with: The applicant / inventor discloses a technical teaching by its essential elements in the claims, thereby establishing a link to the abilities of a person skilled in the art (also to a potential infringer) to perform the teaching not only on the basis of the information given in the description, but also with certain other equivalent means at his disposal, in particular with means automatically available. Such means are called "notoriously exchangeable in the field" in Germany (translated from the beautiful German language term: "fachmännisch austauschbare Mittel").

The difficulty with any equivalents is that they are neither mentioned in the Protocol nor (as yet) in most national laws (except in Belgium). Equivalents are a means of jurisdiction, which has developed some changing principles in dealing with them. The questions concerning "real" equivalents arise as soon as an allegedly infringing embodiment deviates from the literal scope of a claim in more than minor or insignificant aspects. As it is considered a basic "right" of the public to work around a patent, the public should be aware of the fact that the claim possibly also has a certain "scope or array of equivalents". How can the public be aware of any equivalents? Unless equivalents are stated in the description, the interested public would normally require the help of a patent attorney or a Patent Office offering proceedings for a declaration of infringement / non-infringement.

As the patent business still is male dominated, a "disharmonious" LADY made us wonder about harmonization, as concerns a possible future European doctrine of equivalents.

AS CONCERNS JURISDICTION: THE EPLADY IS A TRAMP

The EPLADY cases and other recent cases demonstrate that the trend goes toward accepting equivalent means only which are deducible (more or less readily) from the claim wording. Such means first of all would function like the means they substitute, the term "function" in my view requires interpretation as to its meaning in the three official languages (does it also cover the mode of operation, the performance...?). Equivalent means would moreover produce the same effect and would follow for a person skilled in the art with an average knowledge and ability in the absence of any inventive effort from deliberations linked to the invention as circumscribed in the claim. The problem in the EPLADY cases apparently was that the knowledge and abilities of the person skilled in the art varied from country to country, which is not surprising for a virtual being!

THE ABILITIES OF THE PERSON SKILLED IN THE ART REQUIRE INTERPRETATION

Equivalent means may be of different quality and structure, which normally makes them difficult to assess. They will in practice have to be evaluated, also as to their range, by taking into account the problem and the purpose of the invention as well as prior art. The decisive question is how much "effort" the person skilled in the art must invest into ascertaining an equivalent, little effort meaning "obvious" equivalents.

The demand for "obviousness" of equivalents (depending on the "quality" of the invention) was addressed in an Austrian EPLADY case referring to "plain" equivalents ("glatte (!) Äquivalenz" in accordance with the old German practice), which should be obvious to or readily at the disposal of the person skilled in the art, without any deliberations necessary.

In France, which has a history of allowing a more functional wording of the main claim to give it a broad scope (apparently due to the fact that in France initially patent claims were not required) and where a rather liberal interpretation attitude seems to prevail at least among critics and commentators, equivalents taken into account apparently would also have to be "direct" or "simple" ones.

A EUROPEAN TREND TO MORE OBVIOUS EQUIVALENTS?

It has clearly emerged from the "new" jurisdiction, on the other hand, that "functional" equivalence alone is insufficient. Even if the scope of protection for the inclusion of functional equivalents extended beyond the wording of the claim, it was said in a decision, it would comprise only such (functional) equivalents which can be derived from the wording of the claim.

Deliberations on equivalents include the assessment of inferior infringing means.

INFRINGEMENT MEANS ARE NOT INFERIOR IF THEY BELONG TO PRIOR ART

At the other end of the spectrum is the inventive effort. The Austrian EPLADY teaches us that if the deviation of the alleged infringing embodiment from the patent results in a "bigger step" towards further development (of the technique in question) in comparison to the "step" made by the combination of (known) elements as patented, there is no equivalence.

EQUIVALENT MEANS MAY BE PATENTABLE

We may recall that the inventor would not have been allowed to add any equivalent means to the specification after filing; indeed he need not have tried if, as a simple example, a general expression, like "fluid pressure means" was allowed to remain in the claim vis a vis prior art, which would include "pressurized air
means" as equivalent means, whereas "mechanical springs" would be considered disclaimed.

4.4 The essentiality of features

In any case it will also have to be determined if the feature or claim element substituted by the equivalent was an essential feature. Whether an essential claim element may be substituted by an equivalent at all depends! It was stated in one of the EPLADY cases inter alia: if the patent merely protects a specific embodiment and not a solution of a problem comprising a number of embodiments, the other embodiments do not fall under the patent. This seems to be a sensible approach: If it turns out for example that the applicant has restricted his application for some reason or other, in particular for patentability reasons, to a single embodiment or specific feature, there will be no room for equivalents. Evidently, the scope of the invention as determined will be rather narrow.

Similarly, the CATNIC decision in the U.K. said if the feature to be substituted is an essential feature, any variant falls outside of the monopoly. In a simplified manner, the CATNIC test checks whether the substituting feature has a material effect on the invention, whether the lack of material effect is obvious, and whether it is obvious that the variant should not have been excluded from the scope of the claim (by a disclaimer in the description).

An other interesting question is, how much guidance the applicant gives or should give in the specification as to possible equivalents. Does it matter how many embodiments the inventor has described? (Are two sufficient, as one could assume from a French decision?) As one clearly cannot expect the inventor to foresee possible infringements as to their specific structure, the best guidance for attaining a certain scope still remains abstract or functional claim wording encompassing possible equivalents. It should suffice that the applicant discloses one concrete embodiment in the description if prior art at the application date permits a generalized claim wording still satisfying patentability requirements.

Therefore, the European Patent Office should continue to, whenever possible, be liberal as concerns peripheral claims and the use of general (functional) technical terms. Experience shows that less harm is done by a general term in the main claim, which will force the "public" to take a closer look or look for an interpreter (attorney), and which eventually will have to be interpreted, whereas more conflicts arise with " precise" structural language that finally must be assessed as to possible equivalents.

We are happy, by the way, to note that also in the United States the doctrine of equivalents was unequivocally affirmed by the U.S. Supreme Court in the recent HILTON DAVIS decision, in a manner which appears somewhat in line with current European practice, or should we rather say new European practice goes in the direction of U.S. practice?

When determining whether a particular device or product infringes a patent under the doctrine of equivalents, it was said, the element-by-element rule applies. If the alleged infringing device does not include a specific element required by the claims in an identical or equivalent manner, it does not fall within the scope of the claim. On the other hand, what follows from the decision is that if features (elements) have been put in the claim by amendments made during prosecution in relation to patentability, this excludes the application of the doctrine of equivalents. In other words, the court would determine why the feature had been put in the claim.

AS CONCERNS EQUIVALENTS: DOES EUROPE HARMONIZE WITH THE UNITED STATES?

4.5 Which is the decisive point of time for taking into account equivalents?

The priority date when the invention was set down or the date of publication of the patent application, when the public first becomes aware of the maximum extent of the subject matter, or any later date, when a conflict arises. Of course, the latter situation would be of benefit for the patentee, who could, theoretically speaking, perhaps rely on a growing scope of protection or at least a scope of protection that remains the same relative to technological development. This perspective, on the other hand, might conflict with the wish of the public for certainty about the right it must observe when developing alternatives. Another source of conflict would arise out of the fact that the later alternative ("equivalent") might result in an invention of its own, which might entail a problem not of infringement but of a depending invention. Clearly, the later "alternative" could not be regarded as an equivalent at the time of patenting.

One could therefore debate whether the latest point of time could practically be the date of publication of the patent, because at that point of time "les jeux sont faits" as concerns the scope of protection. This would be in line with jurisdiction, that the responsibility of the inventor for the wording of the claims would be shifted to the public domain should the inventor retroactively have the possibility to interpret a later possibly inventive intellectual achievement of third parties into the scope of his earlier patent, in order to profit from their intellectual effort.

4.6 The question of "incomplete" infringement

An other issue is the examination of "incomplete infringement" of claims either covering an aggregation or a combination of features.

A quote from the U.K. Courts of Appeal (1.5.97): "The word opaque used as an essential feature of the claim could not be construed as including a device
which was partly transparent. The alleged infringement being inferior to the patentee’s device in not meeting the expressed objects set out in the patent.

As concerns the lack of features, we may look in particular to German courts with their long history of intricate decisions.

Under the Protocol the courts have departed from former German jurisprudence also recognizing infringement if the infringing means did not comprise a feature of a chain or combination of features at all. Whether the scope of protection of a European Patent also pertains to such a "sub-combination" of features under the new court practice is a point of discussion. In one prominent decision ("Beheizbarer Atemschlauch", GRUR 1992), infringement was denied because the infringing embodiment lacked a feature, the particular importance of which was emphasized in the specification. In an other unpublished case infringement was denied because the accused infringing embodiment did not have a feature which had been considered by the examiner (and accepted by the applicant) as a basis for the patentability of a combination of features. The court said: “Omitting one or more features would expand the scope, contravening Art 123 EPC. The relevant combination of features (equivalents included) would have to be re-examined, however, the court said, it had no authority to assess patentability, in short, any interpretation would not cover the deletion of features (with a reference to R. König, "Mitteilungen der deutschen Patentanwälte", 1993).

Pursuant to the notorious German decision "Batteriekastenschur" (GRUR 1989) the scope of protection should be sufficiently predictable for "outsiders"; they should be safe from a surprise attack if the scope resulted only by deleting a feature (a claim apparently should not be a mine field!). It has to be borne in mind that if one takes the claim as the relevant source of protection, the disclosure contained in the description, but not claimed, could be used by third parties.

In general, the opinion seems to prevail among commentators and judges that under the Protocol the scope of protection would normally not extend to individual (essential) features or sub-combinations of essential features taken from a claim, except under very special circumstances, for instance if the feature omitted was clearly unnecessary. Therefore, since individual features and sub-combinations of features will as a rule not be protected, any matter to be protected individually will have to be included in (in)dependent claims. This enhances the importance of subclaims.

The practical problem sometimes is that even with the help of prior art as stated in the specification it is not clear why a certain feature has been put in the claim. In such a case it would have to be evidenced by the patentee that this had not been done for patentability reasons.

JURISDICTION BY "TESTS"?

Again, due to the lack of a centralized jurisdiction it has become "à la mode" for member countries as well as the EPO to develop test tools for coping with the problems related to the scope of protection. We note for example the "purposive construction test" and the "CATNIC test" in the U.K. (which according to John Bétan avoids the "doctrine of equivalents"), the "derivation test", the "three-pronged test of essentiality" as devised by the EPO, a test for assessing "sub-combinations" in Germany, etc. While such tools on the one hand purport new approaches and also contain common ideas, the problems basically have remained the same and so have some of the questions and results of the tests. The practice of developing tests, if continued, might take the wrong direction. It is surprising and may perhaps be attributed to the intellectual pressure developed in a closed system like the Protocol how inventive people skilled in the ART become to develop all sorts of "new means" of deliberation! In Germany, for example, equivalents apparently do not suffice any longer (after the old doctrine of deliberation was buried), they now seem to be accompanied by a system of "similarities"....

5. The non-relevance of Art 25 EPC

Art 25 EPC was devised with the idea of enabling the EPO to assist national courts with an expertise in national proceedings, apparently with the belief that such expert opinions could have a harmonizing effect. Art 25 does not mention the scope of protection, however, it deals with the subject matter the scope of protection results from, in referring to a technical opinion: “At the request of the competent national court trying an infringement or revocation action, the European Patent Office shall be obliged, against payment of an appropriate fee, to give a technical opinion concerning the European patent which is the subject of the action. The Examining Division shall be responsible for the issue of such opinions.”

The Guidelines for Art 25 state that the Examining Division is not supposed to inter alia address the scope of protection.

However, assuming we are confronted with an infringement action, what could the technical matter be that a national court would require an expert opinion on? Most probably concerning the technical terms as used in the claims, which naturally would influence the determination of the scope of the claims, even if it were only for explaining why a certain feature had been included in the claim. Of course, the legal question would still have to be answered by the court, however, the article published in 1987 by G. Kolle quite appropriately refers to the fact that in most cases technical and legal questions cannot be separated.

The responsibility resting with the Examination Division would not necessarily be detrimental to impartiality, but the role of an independent court expert advising a judge in my view is something entirely different. This may also be the reason why Art 25 EPC practically has been of no relevance since it was introduced after a long debate with interested circles. As noted before, as
a matter of principle the authority granting the patent should not also provide it with an interpretation if the latter depends on an infringement.

6. Arbitration and Mediation

Can the scope of protection be addressed in arbitration, mediation and other alternative dispute resolution proceedings at all and to which extent? The underlying question is what is arbitrable in the member states as concerns industrial property rights?

There seems to be agreement that what is not arbitrable is validity / invalidity of the European patent, because this is an issue of the public domain. It is on the other hand acknowledged that industrial property rights may be submitted to arbitration or mediation. In patent infringement matters settlements can be concluded. Therefore, in arbitration proceedings the infringement of claims could be dealt with. This will in most cases also involve determining the scope of protection of a patent.

Apart from the fact that such proceedings are secret, it should be borne in mind that the scope of the invention or of protection would be determined "inter partes". Thus, the parties to the arbitration proceedings could agree on a particular extent of protection, for instance the defendant renouncing to produce a certain embodiment.

**ARBITRATION IS SECRET**

The question of the scope of protection may for example also play a role in the framework of licence agreements containing an arbitration clause, when it has to be determined whether the articles produced by the licensee are to be submitted to the patent and thus to royalties, etc.

7. Towards a harmonized assessment of the scope of protection?

"However, the patent system must under no circumstances act as a further brake on the competitiveness of European industry: Ease of obtaining patents; legal certainty; appropriate geographic coverage: These are all essential criteria for the effective protection of innovation in Europe" (Green Paper, European Commission)

Even if the jurisdiction in some countries goes to the limits of the Protocol in its interpretation practice, the existence of the Protocol cannot be ignored in the member states, where in the future due to the Protocol the interests of the public will be given greater attention. In this context legal certainty or sufficient predictability means that third parties should in particular be able to rely on the fact that the invention is described fully by the features of the claims or that the applicant has put in all of the necessary features, respectively.

In balancing the needs of the public we might ask how the "right" of the public to "rely" on a claim wording is to be interpreted? A claim cannot simply be relied upon by browsing through it. The description will have to be consulted. Therefore, the requirement that the extent of the patent be sufficiently predictable should pertain to a person skilled in the art rather than to a layman. Indeed, it would appear contrary to the accepted practice in commerce and industry if an artificial product, such as a patent, is assessed without due caution, for instance without availing himself of the advice of someone (patent attorney) acquainted with the deliberations of a person skilled in the ART. Any party wishing to work around a patent to which their product or process comes close, in particular in a country where official proceedings for a declaration of infringement or non-infringement do not exist, should at least be required to assess whether the feature(s) it wishes to substitute are essential to the claim.

S.G.D.G.

As concerns the doctrine of equivalents, I have mentioned before that any such means must have a link to the claim wording. Therefore, equivalent means, even if based on an inventive activity, which are solely referred to in the specification would not be encompassed by the scope of the claim. Whilst diverse decisions concerning the doctrine of equivalents in Europe are intellectually stimulating, they are nevertheless frustrating for the parties. With a "harmonized" well functioning European doctrine of equivalents the needs of the public as well as of the applicant / patentee would be well served. The applicant then need not worry about packing all of the embodiments and variants conceivable possible into the specification, in addition to a "best mode" embodiment. This would have the beneficial effect that the specification could be shortened from the outset, bringing about well known cost advantages later! Also, advantages for the Patent Office examiners should not be overlooked. The applicant might likewise be induced to curtail the specification before grant, when it has become clear that certain embodiments would no longer be encompassed by the claims.

"In the absence of a common court, the emergence of different interpretations of European patent law by national courts is liable to undermine the value of the European patent." (Green Paper, European Commission)

The development of different, more or less rigid "tests" involving the scope of protection as well as the different "interpretation" practice and application of the Protocol in the member countries clearly demonstrates the complexity, or should we rather say ambiguity (not to say volatility) of the phenomenon in question, combined with an apparent need for some "common" interpretation authority or "harmonized" practice, respectively.

**HARMONIZED INTERPRETATION WOULD EXTEND THE SCOPE OF PROTECTION THROUGHOUT EUROPE**

Naturally, what crosses the mind first, but perhaps is somewhat unrealistic for the immediate future, would be the creation of a central European authority, some
Common Patent Court which could for example even be set up in the "vicinity" of the EPO, however as a separate body. In the short run, one could contemplate a more realistic scheme, such as the one devised under the Community Trademark System; a small number of specialized courts of first and second instance in the member states for dealing with infringement cases (such courts could perhaps in the future be turned into branches of a central court, which has also been suggested by the Commission). I might mention that such specialized courts already exist, for example in Austria, where all patent infringement actions are being tried by one Viennese court for the entirety of Austria. I do not ignore that invalidity counterclaims are regularly raised in defence, staying as a rule the court proceedings. In this regard one could advocate that the national courts (unless they already have jurisdiction to decide on the counterclaim) resort to a practice of "nullity or (partial) nullity of inter partes". I am aware that this approach may not be totally in line with certainty requirements. However, it would not be worse than contradicting national infringement / validity decisions. Relative invalidity would mean "no infringement" and partial invalidity a "limited scope of protection". We may recall that the patentee, although in different ways in the member states, could voluntarily apply for a limitation of the patent, if necessary. In connection with this, representation, or more realistically co-representation, by patent attorneys before all court instances must be demanded. In Austria a system functions very well in which the senators hearing infringement cases include one patent attorney as a lay judge advising the other judges in technical matters. Each party to the proceeding is moreover accompanied by its patent attorney who has the right to "assist" the attorney at law.

The diverse application of the Protocol, on the other hand, shows that a "wide ranging" rule, such as the Protocol, apparently does not suffice in matters requiring subjective interpretation, as it leaves open too many interpretation possibilities. In order to improve the present situation, at least a few basic provisions resulting from "common sense" national practice should be taken care of in the substantive laws of the member states as a first step. (Naturally, rules themselves do not take decisions).

In this respect the former draft stipulations of the WIPO Harmonization Treaty on Patent Law can be referred to, which in Art 21 dealt with the scope of protection and interpretation of claims, in a manner similar to Art 69 EPC. In addition it contained a theory of equivalents. Similar provisions plus a few of the afore discussed principles included in national laws would merely put down in writing what jurisdiction has established. Experience shows that jurisdiction in some countries will not change without amendment of the law. Any such provisions also might have a deterrent effect on possible infringers. Of course, this may not avoid an EPILADY EPIC but might be instrumental in shaping the minds of the hitherto "national persons skilled in the art" into a "Single European person skilled in the art". "Fragmentation" of jurisdiction could thereby be avoided!

EUROPE NEEDS A SUPERMAN SKILLED IN THE ART

As to other "harmonizing" measures, conferences of judges, dissemination of national decisions, EPI tutorial and "student" systems, EPO examiners taking the qualifying examination (!) and the like, definitely are of importance and already reality. I may refer in this regard to the extremely informative series run by "Mitteilungen der deutschen Patentanwälte" specifically on topics related to Art 69 and its Protocol. Given the relatively few European infringement cases, naturally any activity is of interest, for instance symposia such as the one held by the UNION on questions of diverse validity decisions. Due to the wide publicity of and attention given to the more prominent cases, one should be able to "rely" on national judges to take into account case-law of other countries, in particular if one considers the possibility of cross-border injunctions.

PUBLICITY IS THE VERY SOUL OF JUSTICE (Jeremy Bentham, as quoted by The Hon. Mr. Justice Jacob)

What would also be welcomed in the short run by practitioners would be a European Collection (library) or some sort of database of relevant decisions, which should be no problem in the age of Internet and CD-ROM. Obviously the Internet would be the appropriate tool, because the collection as well as retrieval of the required information would not present unsurmountable obstacles. This database could be fed by existing national (private and official) collections. We might even ask whether it could not be set up by the EPO?

A "FINALE" BORDERING HERESY

Given a desired increase in patent "production", the treatment of patents as a commodity, the belief that a steadily rising number of patents, even if for smaller improvements, will stimulate innovation and competitiveness, together with the notion of national courts stressing the need for certainty of right for third parties, it appears quite logical that the scope of protection of the average patent will be relatively "restricted" in the future.

We might thus arrive at a growing number of patents that merely satisfy the applicant's desire to obtain one and the European Patent Office's wish to grant one, which may be in line with the idea to also have "regard" for the competitor in a common market where any monopoly may be detrimental to the free circulation of goods and services. This is also evidenced by the new Community Trademark Regulation, where one notices numerous trademarks being published, the distinctivity and thus the scope of protection of which is rather small, but which on the other hand are no cause of alarm, because it already follows from the Regulation that such (descriptive) trade marks, because of their limited scope, may not restrict competitors. In short, we may witness an array of European intellectual property monopolies having little potential of conflict. Whether this truly promotes innovation and serves the system at
all is a matter of debate. Would progress not rather be 
stimulated by conflicts?

It is perhaps heresy to quote voices demanding that 
patents should not only be technical information vehi-
cles and should predominantly be granted for "real" 
inventions rather than also for minor improvements, 
which could be referred to utility model protection, and 
that the number of patents granted should correspond 
to the number required for preventing a standstill of 
innovative activity. This would naturally lead to the fur-
ther conclusion that the examination requirements, in 
particular concerning the inventive step, could be 
applied more strictly, thereby automatically expanding 
the scope of protection. European industry should be 
challenged by patents on "inventions of high quality" 
to increase its research and development efforts!

As these heretical suggestions will probably not be 
heeded to, we may restrain ourselves to modestly 
recommend that applicants and in particular their 
representatives should be better aware of the impor-
tance of the scope of protection in a possible conflict 
when drafting an application and making amendments 
during prosecution.

Thus, we are back to where we set out from, and 
we might put the full blame on ourselves in a final 
quote from a decision: "It is the responsibility of the 
applicant to carefully lay down in the features of the 
patent claims what he has requested protection for."

EPILOGUE: "Les mots, je les emploie nature. Je leur 
donne, ou plutôt je leur laisse, toute leur réalité dans la 
simplicité. Je n'aime employer que des mots simples qui 
emportent avec eux toute la réalité de la chose qu'ils 
signifient." (Pierre Reverdy)
Closing Address

E. Thouret-Lemaître

Deshalb fand es am Samstag statt und der Preis war so gewählt, daß er auch für die jungen Leute unseres Berufs attraktiv war.
Ich danke Ihnen für ihre Anwesenheit. Ich bin überzeugt, daß die Zukunft unseres Berufs europäisch ist.

I hope that the subjects presented today will permit us to prepare the future of our profession.

Our future as patent attorneys is linked to the future of the patent system. It is the reason why I am convinced that we must work in cooperation with all the instances in charge of patents, the EPO, the European Commission, the National Patent Offices and the judges.

As Luis Duran mentioned this morning, we are the intermediates between the Applicants and the authorities. We must therefore think first of the companies, small, medium and even large ones, which use patents for protecting their inventions and consequently for producing goods for the welfare of the humanity.

I wish the best to the epi for the future and invite you to join our President and the Board for the dinner which will take place in l’Hôtel des Monnaies in Molsheim.
Koch/Stauder

Vereinbarung über Gemeinschaftspatente

mit Gemeinschaftspatentübereinkommen, den ergänzenden Protokollen und den weiteren beigefügten Texten

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