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Information

Institut der beim Europäischen Patentamt
zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés près
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Editorial

The Editorial Board is now settling into its role and we are looking to make some changes to the means and style of the communication between the *epi* and its members, its student members, and those outside the profession. With this in mind, several initiatives have been taken, as will be clear from reading this issue of *epi* Information.

Following recommendation by the Board and Council, we are setting up a news section of the *epi* home page in an attempt to speed up the provision of news both to our members and to those outside the profession.

With regard to *epi* Information itself, we are putting aside some space for the students of *epi*. This is intended to allow the students to communicate on those topics of importance to them and, at the same time, to encourage co-operation between the students. In time it is hoped that this will lead to a formal student body co-ordinating relevant activities and communication across Europe.

Finally, as something of an experiment, we are looking to „theme“ certain future editions of *epi* Information. The first theme on which we are inviting contributions is the European Qualifying Examination. The intention is to stimulate members and student members into pro-

viding contributions rather than awaiting the random flash of inspiration that causes the writing and submission of a piece for *epi* Information.

You will also see that the layout and style of *epi* Information is looking to change slightly. The layout has changed from three to two columns in an attempt to make the text more readable. Furthermore, we have introduced photographs in the present edition, because we believe that such illustrations make a journal more interesting and easy to read. In future, we would welcome all styles of contribution of all levels of seriousness, an aim which we hope will be met, at least in part, by increasing provision of contributions from student members.

Of course, all these changes are being made using the assumptions that they are what the membership wish. It is difficult for us to make decisions and choices without knowing how the members feel about the paths we take. Accordingly, all feedback, negative or positive, on the changes we are making will be welcome, as would any suggestions for future initiatives to be taken with regard to *epi* Information and related communications from *epi*.

Jon Gowshall · Thierry Schuffenecker · Edith Vinazzer

Beschlusliste

42. Ratssitzung in München

12./13. Mai 1997

1. Die Empfehlung des Einspruchsausschusses, Herrn JÖNSSONS Einspruch gegen die deutschen Wahlergebnisse abzuweisen, wurde gebilligt.
2. Es wird ein ad hoc-Ausschuß gegründet, der sich zum Zwecke der Vereinfachung der Wahlregeln mit den Kommentaren des Wahlausschusses befaßt.
3. Die Empfehlung, die Größe des Vorstandes während der Amtszeit 1997–1999 nicht zu verändern, wurde gebilligt.
4. Folgende Mitglieder wurden in den Vorstand gewählt:

Präsident:	Herr Arthur HUYGENS (NL)
Vizepräsidenten:	Herr Leo RYCKEBOER (BE)
	Herr Walter HOLZER (AT)
Generalsekretär:	Herr Rüdiger ZELLENTIN (DE)
Stellvert. Generalsekretär:	Herr Joao PEREIRA DA CRUZ (PT)
Schatzmeister:	Herr Knud Erik VINGTOFT (DK)
Stellvert. Schatzmeister:	Herr Peter KELLY (IE)

Weitere Mitglieder:

 - Herr John L. BETON (GB)
 - Herr Geoffrey COLLINS (MC)
 - Herr Luis-Alfonso DURAN MOYA (ES)
 - Frau Pia HJELT (FI)
 - Herr Felix A. JENNY (CH)
 - Herr Jean-Jacques JOLY (FR)
 - Herr Paul LEITZ (LU)
 - Herr Sylvain Jacques LE VAGUERSE (FR)
 - Herr Francesco MACCHETTA (IT)
 - Herr Theophilos MARGELLOS (GR)
 - Herr Christopher Paul MERCER (GB)
 - Herr Ake NORDEN (SE)
 - Herr Hermann PEUCKERT (DE)
 - Herr Roland WILDI (FL)
5. Die Herren A. BRAUN und D. BEHRENS wurden als interne Rechnungsprüfer, sowie Frau J. KADEN und Herr M. MAIKOWSKI als stellvertretende interne Rechnungsprüfer gewählt.
6. Der Rat billigte die Wahl der vorgeschlagenen Mitglieder in die verschiedenen Ausschüsse.
7. Der Rat billigte die Vergrößerung der EASY-Arbeitsgruppe von vier auf sechs Mitglieder.
8. Der Rat billigte die Auflösung des Ausschusses zur Nutzung des Patentschutzes in Europa (UPPE).
9. Der Rat billigte die Auflösung des Ausschusses für die Zusammenarbeit mit dem US-Patent- und Markenamt, etc. (USPTO).
10. Der Rat billigte den Verbleib folgender Mitglieder des Disziplinarrates, die nicht zur Wiederwahl stehen, bis zum Abschluß der anhängigen Fälle im Ausschuß: F. CHARPAIL (FR), R. LHUILLIER (FR), R. PIDGEON (GB), N. WADDLETON (GB) und D. OEKONOMIDIS (GR).
11. Der Rat beschloß, daß ein ad hoc-Ausschuß "Europäische Kommission/ Beschwerde", bestehend aus Frau E. THOURET-LEMAITRE, L.-A. DURAN, T. SMULDERS und J.D. BROWN, die Arbeit mit der Europäischen Kommission weiterführen solle.
12. Der Rat beschloß, in der nächsten Ausgabe 2/1997 der epi Information eine Notiz zum gegenwärtigen Stand der Dinge bezüglich der epi-Standesregeln zu veröffentlichen. Die Mitglieder des ad hoc-Ausschusses werden einen Entwurf vorbereiten und ihn vor der Veröffentlichung Maître Collin unterbreiten.
13. Der Entwurf zur Änderung der Artikel 6.2 und 6.3 der Geschäftsordnung, der verlangt, daß die Ratsmitglieder ihrem Rückerstattungsformular eine Kopie ihres Flugscheines beifügen müssen, wurde vom Rat gebilligt.
14. Die Jahresrechnung für 1996 wurde gebilligt und der Schatzmeister entlastet.
15. Der Vorstand wurde entlastet.
16. Das geänderte Budget für 1997 wurde gebilligt.
17. Der Rat billigte die Ernennung folgender Mitglieder als Mitglieder der Schriftleitung: Herr J. GOWSHALL, Frau E. VINAZZER, und Herr T. SCHUFFENECKER.
18. Der Rat billigte die Beibehaltung des Ausschusses für EPA-Gebühren als aktiven Ausschuß.
19. Der Rat beschloß, ein Schreiben mit der Bitte an den EPA-Präsidenten zu senden, das Ergebnis einer eventuellen Studie über die Vor- und Nachteile des BEST Programms bekanntzugeben. Der Rat beschloß, einen Brief bezüglich sofortiger Akteneinsicht bei Teilanmeldungen an den EPA-Präsidenten zu richten.
20. Der Rat beschloß, das epi-Studentenprogramm weiterzuführen.
21. Der Rat billigte die Benutzung des Titels "eurooppatenttiasiamies" als finnisches Äquivalent des Titels "European Patent Attorney".

List of Decisions 42nd Council meeting Munich, 12/13 May 1997

1. The recommendation of the Objections Committee to dismiss Mr. JÖNSSON'S objection to the election in Germany was approved.
2. An ad hoc Committee will be set up to take into consideration the comments of the Election Committee in view of simplifying the Election Rules.
3. The recommendation not to change the size of the Board for the 1997–1999 Council term was approved.
4. The following members were elected to the Board:

President:	Mr. Arthur HUYGENS (NL)
Vice-Presidents:	Mr. Leo RYCKEBOER (BE)
	Mr. Walter HOLZER (AT)
Secretary General:	Mr. Rüdiger ZELLENTIN (DE)
Deputy Secretary General:	Mr. Joao PEREIRA DA CRUZ (PT)
Treasurer:	Mr. Knud Erik VINGTOFT (DK)
Deputy Treasurer:	Mr. Peter KELLY (IE)

Further members are:

 - Mr. John L. BETON (GB)
 - Mr. Geoffrey COLLINS (MC)
 - Mr. Luis-Alfonso DURAN MOYA (ES)
 - Mrs. Pia HJELT (FI)
 - Mr. Felix A. JENNY (CH)
 - Mr. Jean-Jacques JOLY (FR)
 - Mr. Paul LEITZ (LU)
 - Mr. Sylvain Jacques LE VAGUERESE (FR)
 - Mr. Francesco MACCHETTA (IT)
 - Mr. Theophilos MARGELLOS (GR)
 - Mr. Christopher Paul MERCER (GB)
 - Mr. Ake NORDEN (SE)
 - Mr. Hermann PEUCKERT (DE)
 - Mr. Roland WILDI (FL)
5. Messrs. A. BRAUN and D. BEHRENS were elected internal Auditors and Mrs. Jutta KADEN and Mr. Michael MAIKOWSKI Deputy internal Auditors.
6. Council approved the appointment of the proposed members to the various Committees.
7. Council approved the extension of the EASY Working Group from four to six members.
8. Council approved that the Committee on Utilisation of Patent Protection in Europe (UPPE) should be dissolved.
9. Council approved that the Committee for the Liaison with US Patent and Trademark Office and others (USPTO) should be dissolved.
10. Council approved that the following Members of the Disciplinary Committee who do not stand for reelection, Messrs. F. Charpail (FR), R. Lhuillier (FR), R. Pidgeon (GB), N. Waddleton (GB) and D. Oekonomidis (GR) remain in the Committee until the pending cases which they are examining are finalized.
11. Council approved that an ad hoc Committee "European Commission/complaint" consisting of Mrs. E. THOURET-LEMAITRE, L.-A. DURAN, T. SMULDERS and J.D. BROWN should continue the work with the European Commission.
12. Council approved that a note informing about the present status of the epi Code of Conduct should be published in the next issue 2/1997 of epi Information. The members of the ad hoc Committee will prepare a draft and submit it to Me Collin before publication.
13. The draft amendment to the By-Laws articles 6.2. and 6.3 which requests that Council members attach a copy of their air fare ticket to their claim for reimbursement was approved by Council.
14. The 1996 accounts were approved and the Treasurer was discharged from liability.
15. The Board was discharged from liability.
16. The revised Budget for 1997 was approved.
17. Council approved the appointment of the following Members as members of the new Editorial Board: Mr. J. GOWSHALL, Mrs. E. VINAZZER and Mr. T. SCHUFFENECKER.
18. Council approved that the Committee on EPO Finances should be maintained as an active body.
19. Council approved sending a letter to the EPO President, asking him to provide the results of any study on the advantages and disadvantages of the BEST procedure.
Council approved sending a letter to the EPO President on the immediate File Inspections of Divisional Applications.
20. Council approved that the epi Studentship scheme should be continued.
21. Council approved that the title "eurooppatenttia-siamies" should be used as the Finnish equivalent of the title "European Patent Attorney".

Liste des Décisions

42ème réunion du Conseil

Munich, 12/13 mai 1997

1. La recommandation de la Commission d'Objections de rejeter l'objection de M. JÖNSSON à l'élection des candidats allemands est approuvée.
2. Une Commission ad hoc sera mise en place pour étudier les observations de la Commission Electorale dans le but de simplifier les Règles pour les élections.
3. La recommandation de ne pas changer la taille du Bureau pour la période du Conseil 1997-1999 est approuvée.
4. Les membres suivants sont élus au Bureau:

Président:	M. Arthur HUYGENS (NL)
Vice-Présidents:	M. Leo RYCKEBOER (BE)
	HOLZER (AT)
Secrétaire Général:	M. Rüdiger ZELLENTIN (DE)
Secrétaire Général	
Adjoint:	M. Joao PEREIRA DA CRUZ (PT)
Trésorier:	M. Knud Erik VINGTOFT (DK)
Trésorier Adjoint:	M. Peter KELLY (IE)

Autres membres:

 - M. John L. BETON (GB)
 - M. Geoffrey COLLINS (MC)
 - M. Luis-Alfonso DURAN MOYA (ES)
 - Mme Pia HJELT (FI)
 - M. Felix A. JENNY (CH)
 - M. Jean-Jacques JOLY (FR)
 - M. Paul LEITZ (LU)
 - M. Sylvain Jacques LE VAGUERESE (FR)
 - M. Francesco MACCHETTA (IT)
 - M. Theophilos MARGELLOS (GR)
 - M. Christopher Paul MERCER (GB)
 - M. Ake NORDEN (SE)
 - M. Hermann PEUCKERT (DE)
 - M. Roland WILDI (FL)
5. MM. A. BRAUN et D. BEHRENS sont élus Commissaires aux comptes internes, Mme Jutta KADEN et M. Michael MAIKOWSKI Commissaires aux comptes internes Adjoints.
6. Le Conseil approuve l'élection des membres proposés pour les diverses Commissions.
7. Le Conseil approuve l'extension du Groupe de Travail EASY, de quatre à six membres.
8. Le Conseil approuve la dissolution de la Commission sur l'Utilisation de la Protection par brevet en Europe (UPPE).
9. Le Conseil approuve la dissolution de la Commission USPTO (Liaison with US Patent and Trademark Office and others).
10. Le Conseil approuve que les membres suivants de la Commission de Discipline qui ne se représentent pas à l'élection, MM. F. Charpail (FR), R. Lhuillier (FR), R. Pidgeon (GB), N. Waddleton (GB) and D. Oekonomidis (GR) soient maintenus dans leurs fonctions jusqu'à ce que les cas en cours qu'ils examinent soient clos.
11. Le Conseil approuve qu'une Commission ad hoc "Commission Européenne/plainte", composée de Mme E. THOURET-LEMAITRE et de MM. L.-A. DURAN, T. SMULDERS et J.D. BROWN, continue de traiter avec la Commission Européenne.
12. Le Conseil approuve qu'une note informant sur le statut actuel du Code de Conduite Professionnel de l'epi soit publiée dans le prochain numéro de epi Information 2/1997. Les membres de la Commission ad hoc prépareront un projet de texte qui sera soumis à Me Collin avant d'être publié.
13. La proposition de modification des articles 6.2. and 6.3 du Règlement Intérieur demandant que les membres du Conseil joignent une copie de leur billet d'avion à leur demande de remboursement de frais est approuvée par le Conseil.
14. Les comptes pour l'année 1996 sont approuvés et le quitus est donné au Trésorier.
15. Le quitus est donné au Bureau sortant.
16. Le Budget révisé pour 1997 est approuvé.
17. Le Conseil approuve l'élection des membres suivants comme membres du Comité de Rédaction: M. J. GOWSHALL, Mme E. VINAZZER et M. T. SCHUFFENECKER.
18. Le Conseil approuve que la Commission concernant les Finances de l'OEB soit maintenue active.
19. Le Conseil approuve qu'une lettre soit envoyée au Président de l'OEB pour lui demander de présenter les résultats d'une enquête sur les avantages et les inconvénients du projet BEST. Le Conseil approuve aussi l'envoi d'une lettre au Président de l'OEB concernant l'examen immédiat des dossiers de demandes divisionnaires.
20. Le Conseil approuve que le projet "Etudiants de l'epi" soit prolongé.
21. Le Conseil approuve l'utilisation du titre "eurooppatenttiasiamies" comme équivalent en finlandais du titre "Mandataire en brevets européens".

President's Report 43rd Council Meeting, Strasbourg 3 October 1997

A. V. Huygens (NL)

1. After the Council meeting in Munich on 12 and 13 May 1997, the Officers of the Board, i.e. the two Vice-Presidents, the Secretary General, the Treasurer and myself had a short meeting with the EPO President. After the presentation of the new Board, we discussed current issues, in particular BEST, and informed the President of our position.
2. On 26 May 1997 I convened a meeting of the Officers of the Board. The purpose of this meeting was to familiarise the new Officers in more detail with the current activities of the *epi* and to set up some new activities without delay. A report of the meeting was noted by the Board at its meeting in Helsinki on 6 September 1997.
3. As a consequence of the Officers meeting I set up a temporary Working Group of five people from different countries with a different professional background with the task to generate ideas and make 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. A report of the Working Group was discussed by the Board. This matter will be dealt with separately.
4. In May an invitation was received from Mr. Messerli on behalf of the Boards of Appeal to resume the series of meetings of the Boards with representatives of the *epi*, UNICE and IFIA which was interrupted last year. After consultation with Mr. Casalonga and Mr. Hammer Jensen, Chairmen of the EPPC and the Biotech Committee, respectively, I formed a delegation of 7 *epi* members for the next meeting on 10 November 1997.
5. I was pleased to attend, on behalf of the *epi*, the Administrative Council meeting held in Helsinki from 10–13 June 1997. A report of that meeting is attached.
6. I attended the 27th SACEPO meeting on 26–27 June 1997, together with most of the 18 elected *epi* delegates. I also attended the summer reception given by Mr. Kober at the Pschorrhöfe Building.
7. On 15 July 1997 Mr. Barendregt (NL) and I had a meeting with Mr. Michel at the EPO in Rijswijk to discuss the outline of a possible *epi* Council meeting in October 1998.
8. I was invited in July by Mr. Messerli to comment on the plan of the Disciplinary Board of Appeal to make its decisions available to the public in a broader extent than at present. After consultation with Mr. Ottevangers, Chairman of the Disciplinary Committee, I supported this initiative and made some additional recommendations.
9. I was further invited in July by the Disciplinary Board of Appeal to give my observations on the interpretation of the 1994 Regulation on the European Qualification Examination in a pending case relating to the compensation system. The observations were filed in the EPO in the first half of September, after thorough consultation with Mr. Macchetta, Chairman of the PQC, and Mrs. Thouret-Lemaître.
10. In August I received an invitation for a Round Table of UNION on "Patenting of Computer Software" in Munich on 9–10 December 1997. I will take care that the *epi* is represented by one or two specialists at this meeting.
11. In September I received an invitation to attend the Second International Symposium on Reduction of Patent Costs in Paris on 22–23 October 1997, which will be cohosted by AIPLA, FICPI and ICC. I will represent the *epi* together with Vice-President Ryckeboer.
12. I was pleased to attend the FICPI World Congress which was held in Copenhagen from 7–12 September 1997, as an invited guest.
13. On behalf of the *epi* Mr. David (FR) and I attended each a part of the PCT Union Assembly which was held in Geneva from 17–20 September 1997. A report of that meeting is attached to the Supplemental EPPC Report to the Council.
14. On 19 September 1997 I had a meeting in Paris with Mrs. Thouret-Lemaître, Mr. Joly and Mrs. Mallet (ICS Conseils) to finalise the preparations for the *epi* Symposium in Strasbourg.
15. Since the last Council meeting I have dealt with numerous enquiries and correspondence from members and outside bodies. Much attention was further paid to the Symposium in Strasbourg, the new *epi* brochure, future Council meetings, the Green Paper, and, above all, the future of the *epi* as such.

epi President's address on the occasion of the 20th anniversary of the European Patent Office Munich, 7 October 1997

A. V. Huygens (NL)

Professor Schmidt-Jortzig,
Professor Monti,
Dr. Bogsch,
Mr. Kober, President of the European Patent Office,
Distinguished Guests,
Ladies and Gentlemen,

I would like to thank you for allowing me, as President of the Institute of Professional Representatives before the European Patent Office, *epi*, to say a few words on the occasion of the 20th anniversary of the European Patent Office. I regard this as a great honour and distinction and was pleased to accept your invitation.

First of all, on behalf of the *epi*, I would like to congratulate the European Patent Office most warmly on its 20th anniversary.

Last Saturday, the 4th October 1997, we celebrated the 20th anniversary of our Institute with a Symposium in Strasbourg and a Gala Dinner. I believe the Symposium was very successful and so was the dinner which was attended by about 360 persons. That celebration might be considered as an "hors d'oeuvre" of the present celebration.

Mr. Kober, you indicated in Strasbourg that the EPO and the *epi* were both created by the European Patent Convention. You compared the *epi* with the little brother or sister who gets some extra attention from the rest of the family. I must admit that we are very happy with this attention, albeit that we are not a spoiled child and the difference in age from our "big brother" is only a few months.

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 marks the actual start of the *epi*. It was a great honour for us that the founding father of the *epi*, Mr. Van Benthem, accepted our invitation and attended our celebration in Strasbourg, as he is now here.

At the first *epi* Council meeting in April 1978, the late Mr. Boedi Chavannes was elected as the first President of the *epi*. It was of course a coincidence that both Mr. Van Benthem and Mr. Chavannes, and also the present President of the *epi*, were Dutch. May be therefore it was not a coincidence that Dutch has not become an official language of the European Patent Office yet.

The collaboration between the European Patent Organisation and the *epi* is embedded in the Founding Regu-

lations of the Institute. In the relevant part of these Regulations it is stated that the Institute shall collaborate with the European Patent Organisation on matters relating to the profession of registered representatives, in particular on disciplinary matters and on the European qualifying examination. The Institute shall further liaise as appropriate with the European Patent Organisation and other bodies on all matters relating to Industrial Property.

I am proud to say that these provisions are fully met. There is close collaboration between the Professional Qualification Committee of the *epi* and the Office on the qualifying examination. By the way, this examination is also taken by a substantial number of Examiners of the Office. Further, *epi* members take part in the Disciplinary Board and the Disciplinary Board of Appeal. The European Patent Practice Committee (EPPC) 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 Office. There has been set up an EPO/EPPC Liaison Committee. Further, there is a highly appreciated annual meeting between the Vice President of DG3 and chairmen of the Boards of Appeal and interested circles, among which are representatives of the *epi*. The *epi* Committee on Biotechnology Inventions is working closely together with the Office and exchanges views on hot items such as the EU draft Directive on biotechnological inventions.

In summary, I believe we can be satisfied with the good and efficient organisation of our Institute and the excellent cooperation with the EPO, which has been built up in the past 20 years.

This does not mean that we can sit back and wait, full of satisfaction. Of course, there are also problems and threats for us, and we have to solve them, partly alone and partly in collaboration with the EPO.

One of the major threats to our profession is 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. This problem will continue to exist with further geographical expansion in the years to come.

On several occasions Mr. Kober has pointed out that the members of the *epi* are the clients, partners and ambassadors of the Office, who have contributed to the success of the patent system in Europe. The success of the EPO is also our success.

I share Mr. Kober's view that we, that is the EPO and the *epi*, have to solve a number of problems which are of vital importance to the future of the European patent

system and which will have to be solved satisfactorily if patenting is to be made more attractive in Europe in the next decade.

The *epi* represents European patent attorneys who are working both in industry and in the free profession. This is often a great advantage and it is important that this situation be maintained. It is clear that their interests and the interests of their clients are not always the same. That is why it is the established policy of the *epi* to be neutral in matters which may divide the two main groups in our profession.

On the other hand, the *epi* has to be realistic and cannot close its eyes to major problems, such as the cost of patenting. That is also the reason why the *epi* is very happy with its observer status in both 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.

Finally, I would like to repeat here what I said a few days ago at our Symposium in Strasbourg. As a new point in its policy, the *epi* will put more emphasis on improving its national awareness and improving the attractiveness to our 5.700 members in the 18 members states. We have recently edited a leaflet in the three languages to inform the public of the *epi* so that the *epi* becomes more known, and we have edited a booklet entitled "Patents in Europe" in various languages, pro-

viding an introduction to the patent system for users and potential users. We give guidance to the public on what patents are, how they may be obtained and what you can do with them, and we make the public aware that professional help is important.

We will also set up, in addition to our existing training 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 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.

The *epi* will also make efforts, as the only pan-European organisation of highly qualified professional representatives in European patent matters, to have the *epi* formally recognised as a body to be consulted by the EU Commission on all matters relating to Intellectual Property.

I believe I have indicated that the little boy of the family has grown up to a powerful adult which certainly may develop further.

I wish the EPO a prosperous future and I am sure that the *epi* will contribute to this in good collaboration.

Thank you.

Report of the Committee of Experts on the Patent Law Treaty on 23rd to 27th June, 1997 in Geneva

J. D. Brown (GB)

The fourth session of the Committee of Experts on the Patent Law Treaty took place in the WIPO building in Geneva on 23rd to 27th June, 1997. The usual States, members of WIPO and/or the Paris Union were represented. There were also representatives of intergovernmental organisations, present in an observer capacity. A number of non-governmental organisations also participated. The *epi* was represented by Dr F.A. Jenny, Chairman of the Harmonisation Committee, and J.D. Brown, Secretary of the Harmonisation Committee. The meeting was chaired by Mr. Murray (Australian Commissioner of Patents).

The Committee discussed the whole of the DRAFT PATENT LAW TREATY AND DRAFT REGULATIONS, as prepared by the International Bureau, 23rd, April, 1997.

I. General Declarations

In their opening statements, many delegations expressed their support for the general aims of the Draft Treaty, but many delegations felt that the Draft Treaty was too much of a mixture of National procedures, rather than harmonisation.

II. Detailed Discussion

The International Bureau opened their remarks by saying "The PCT provisions will always prevail". The International Bureau noted that there are some inconsistencies between PCT and PLT, especially with regard to national phases of PCT applications and suggested solving the problems in the PCT regulations.

During the detailed discussion, the Chairman repeatedly had to remind delegations that the aim of *EPLOT* was harmonisation, not the lowest denominator, whilst aiming to reduce costs and simplify procedures.

Article 4 (previously Article 2) – Filing Date

It was agreed that initial filings can be in any language and claims and/or an abstract are not required for the application to be accorded a filing date. Furthermore, the so-called telex filing was re-instated (the International Bureau having argued for the deletion because "it was unnecessary in view of PCT"). Your reporter argued for re-instatement, especially for the benefit of S.M.E.'s who often only want overseas protection in one or two countries (not making a PCT application viable) and invariably making the decision to file at the very last minute. At the suggestion of the Australian

delegation, the International Bureau are considering broadening the provisions for "telex filing", to include the filing of non-convention (but nevertheless corresponding) applications. The term for filing any translation is a minimum of four months.

Your reporter also persuaded the International Bureau, with the support of a number of delegations, to include in the next DRAFT TREATY AND DRAFT REGULATIONS a provision that a priority document can, in appropriate circumstances, be used to correct a deficiency (such as a missing page of text or drawing) in an application.

Article 5 (previously Article 3 – Application)

The provisions allow a Patent Office to decide for itself if it will accept electronic filing, and, if so, under what conditions. There was great resistance from a number of delegations to a Patent Office being allowed to accept only electronic filing.

Article 12 (previously Article 9) – Request for correction

Any party to PLT may require that a declaration that the mistake was made in good faith and/or that the request for correction was made without intentional delay.

Article 13 (previously Article 12) Extension of a Time Limit set by the Patent Office

Where the request for an extension is made after the expiry of the time limit, such an extension shall be granted provided that the request is made, and the necessary requirements are fulfilled, within the time limit prescribed in the Regulations. A declaration may be required to the effect that the non-compliance was unintentional

(NOT "in spite of all due care required by the circumstances").

Article 14 (new) – Extension of a Time Limit set by National Legislation or Regional Treaty

Restitutio in integrum is to be subject to the "unintentional" test, rather than the "in spite of all due care required by the circumstances" test. This Article is not to apply to a time limit for an action before a board of appeal, where the extension would go beyond the grace period for maintenance fees prescribed under Article 5 bis (1) of the Paris Convention, Article 15 of PLT, for lodging an opposition and for filing a request for search or examination.

Article 15 (previously Article 13) – Belated Claiming of Priority

Where an application could have claimed priority but, when filed, did not do so, any contracting Party may require the filing of a declaration that the delay in claiming priority was not intentional for the priority claim to be added. Where an application has a filing date which is later than, but within two months from, the date on which the priority period expired, the priority right can be restored, if the application was not received by the office within the priority period unintentionally (the requirement is NOT "in spite of all due care").

III. Future Work

The fifth session of the Committee of Experts is scheduled for 15th to 19th December, 1997.

epi Comments on the Green Paper on the Community Patent and the Patent System in Europe

I. Introduction

1. The Institute of Professional Representatives before the European Patent Office (*epi*) is the statutory professional association within the European Patent Organisation and is an international public law corporation. All persons listed with the European Patent Office as professional representatives – i.e. European Patent Attorneys – are members of *epi*. This Institute is comprised of European Patent Attorneys from the free profession and from industry and currently there are approximately 5,700 members from the 18 EPC member states.
2. *epi* fully agrees with the statement in the Green Paper according to which „*innovation is vital for the viability and success of a modern economy*“ and further that „*it is vital to protect the fruits of innovation*“.
3. *epi* considers that the main advantages of a system for protecting innovation should be the following:

- efficient protection;
- efficient enforcement and particularly, a positive approach towards protection of inventions;
- reasonable costs;
- reasonable speed to obtain a protection and also to enforce the protection obtained;
- availability to all types of applicants (single inventors, SME's, large companies, multinationals, etc.)

II. The Patent system and the Single Market

4. *epi* considers that one way of improving the present European patent system is to provide a better harmonisation of assessments by Courts with regard to validity and infringement of European patents so as to avoid contradictory judgements and to harmonise the approach to patentability within the European countries.
5. The proposal of the Commission to institute a Community regulation has indeed the advantage of per-

mitting a quicker decision of the Contracting States. However, under a Community regulation it is impossible to provide for new courts.

In contrast, a new Convention between the EC Member States can provide for new courts (as desired by *epi*), but ratification by all Member States in the foreseeable future is likely to be more difficult. Furthermore, automatic accession by new EC Member States would not be possible, but an international Convention would have the advantage of more easily including EPC Member States which are outside of the Community, such as Switzerland.

Finally, a Convention permits more easily, as exemplified by the Luxembourg Agreement of 1989, the creation of a Common Appeal Court highly specialised in patent matters and capable of issuing final decisions on facts and law at the appeal level. Such a solution would avoid the need to provide for a final appeal from a Court of First Instance to the European Court of Justice on points of law. This would speed up the issuance of a final decision as well as providing effective harmonisation of interpretation of the patent law in Europe by a single body.

In view of the above dilemma, *epi* recommends to study a possible improvement of the present patent system by way of an international Convention between the EC and the European Patent Organisation, supplemented by a Community regulation to transform the law established by the association agreement into law binding within the EC. Such a new Convention could in fact be simply an adjustment of the present European Patent Convention, and thus be in line with the present European patent system which has been widely accepted and which works satisfactorily.

6. *epi* favours a flexible patent organisation in Europe giving the choice between the three following routes to protection:

- national patents filed and granted locally by national Patent Offices and enforced before national Courts with decisions having normally effect only in the relevant country.
- European patents granted by the EPO, having in the various designated European countries the same effect as a national patent.

epi believes that the successful European patent system could be further improved if the validity and enforcement of European patents be centrally decided. This could be achieved by supplementing the European Patent Convention with a new Protocol on Litigation ("EPAC") drafted along the general lines indicated hereinafter.

– Community patents with a unitary character covering the entire EU with validity and enforcement centrally decided by a Community Court as provided in the Protocol on Litigation of the 1989 Agreement relating to Community patents.

7. *In conclusion*, *epi* favours a patent system in Europe affording good protection and permitting efficient enforcement at reasonable speed and cost. In order to improve the present situation, central decisions on validity and central enforcement for the already

existing European patent should be introduced, preferably along the lines of the proposed new EPAC Protocol on Litigation, referred to hereinafter in paragraph 30 and the Annex. Furthermore, a Community patent system should be established with a centralised court organisation.

epi, recognising the advantages of a Community regulation, particularly to simplify future enlargements of the EU, would favour such a regulation, but only if it appears that the Treaty establishing the European Community does not forbid the creation of new Courts. Otherwise, *epi* is of the opinion that an international Convention is preferable.

III. The Community Patent

Section 3.1 – The need for a unitary patent system

8. *epi* favours the introduction of a Community patent system, valid and enforceable throughout the European Union.

However, *epi* considers it essential to maintain in parallel the national and European patent systems which have the advantage of much greater flexibility.

For that reason, the possibility provided in the 1989 Luxembourg Agreement for conversion immediately after grant of the Community patent into a European patent should be retained.

9. The European patent system as it already exists should, however, be completed by the establishment of a common appeal Court having jurisdiction to hear appeals on validity and infringement of European patents.

Section 3.2 – The Luxembourg Convention

10. *epi* recognises that the obligation of translating the Community patent shortly after grant into the languages of all the Member States as provided in Article 30 of the Community Patent Convention is certainly one of the reasons why the Agreement of 1989 has been widely criticised.

11. Concerning the judicial organisation set in place in this Agreement, however, *epi* is satisfied with the introduction of an independent Common Appeal Court deciding in appeal on all validity and infringement questions.

12. *epi* considers that the possibility of central revocation given to a Community Patent Court of first instance constitutes an acceptable risk of legal uncertainty in view of the possibilities offered by Article 6 of the Brussels Convention to file an infringement action at the Court of the domicile of any defendant and also in view of the strong harmonisation effect of the Common Appeal Court.

Section 3.3 – The problem of the cost of translations

13. Many organisations and interested circles have expressed their opinions on this question in relation to the European patent system; some point out that the possible benefits of translations do not justify

the costs, while others point out that a patent right can only exist in a country if it is registered in that country in one of its official languages or that it can only be enforced if it is available in one of the official languages of the relevant country.

epi being an Institute of European Patent Attorneys representing a wide variety of enterprises of different nature cannot take a position on the translation issue since these enterprises have opposite views on this question.

Section 3.4 – Judicial organisation

14. *epi* is of the opinion that questions of validity and scope of protection of the European patent and of its infringement are so linked that an efficient and reasonably quick decision on those questions is best made by a single body at the same time.

epi shares the view according to which a decision on infringement should take into consideration the validity of the patent at the same time. Such a judicial system existing in certain Member States appears therefore preferable for a future Community or European centralised judicial organisation for patent matters.

15. *epi* wishes to retain the possibility for a defendant to file a counterclaim for revocation during the course of an infringement action. *epi* would also favour the possibility for the plaintiff, in the same infringement action, to file a request for limitation of the European patent before the Court hearing the infringement question.

Section 3.5 – Fees

16. *epi* considers that not only the European Patent Office must operate in financial balance, as is required by Art. 40(1) EPC, but that this should also apply to the national Patent Offices of the EPC Member States. It is considered highly undesirable that a surplus of money is destined for the general fund of the Member States. Any surplus should be used to reduce fees or to increase the efficiency of the Patent Offices in processing patent applications. However, *epi* also recognises the importance and competence of the national Patent Offices in granting national patents, together with their additional task in regard of providing information.
17. A future financial arrangement concerning the renewal fees for Community patents should therefore take those two points into consideration so that the level of renewal fees for a future Community patent be maintained reasonable, balancing the effective costs of the new procedures and of the necessary patent documentation with the geographical extension of the protection.
18. A partial renewal of a Community patent ("à la carte" Community patent) does not appear satisfactory. *epi* considers preferable to maintain the choice possibility as between the European patent and the Community patent.

Section 3.6 – Links between the Community patent and the European patent

19. *epi* is of the opinion that the flexibility provided in the 1989 Community Patent Convention is highly desirable and should in any case be maintained, enabling the applicant or the proprietor to choose a European patent instead of a Community patent up to the acceptance of the application by the Examining Division or shortly after grant.

Section 3.7 – Prior use

20. *epi* proposes to harmonise the extent and character of prior use within the EC or, more preferably, the EPC countries.

Reference is made in this connection to *epi*'s position paper of May 1991 which was inter alia forwarded to the Community Patents Interim Committee and the Administrative Council of the European Patent Organisation.

IV. Further Harmonisation at Community Level

Section 4.2 – The patentability of computer programs and software related inventions

21. *epi* is of the opinion that the provisions of Article 27 of the TRIP's should be followed for the patentability of software related inventions.

Generally speaking *epi* considers that, subject to the other provisions of the EPC, European patents should be granted for inventions in all fields of technology provided they are new, involve an inventive step and are susceptible to industrial application.

epi therefore recommends to consider the entire deletion of Art. 52(2) and (3) EPC and amendment of Art. 52(1) EPC to the wording of Article 27 TRIP's. In any case, the term „computer programs“ should be deleted from Article 52(2) EPC.

Section 4.3 – Employees' inventions

22. *epi* is of the opinion that harmonisation of the national laws on employees' inventions is not at present necessary. However, *epi* would favour flexible and easy to apply provisions for governing employees' inventions.

Section 4.4 – Representation and professional qualification

23. *epi* recommends that the need for highly qualified professionals to deal with patent matters in Europe be recognised in any future patent organisation. *epi* considers that the maintenance of a strong and efficient profession is a requirement for efficient procedures to obtain and enforce patents in Europe.
24. *epi* also considers that patent matters require technically skilled European Patent Attorneys who are also trained in the relevant legal issues, not only for the grant of the patent protection but also at all subsequent stages and particularly during enforcement procedures. Therefore, *epi* is of the opinion

that European Patent Attorneys are best qualified to represent patent proprietors and third parties in patent matters before all instances including judicial authorities.

25. *epi* is also of the opinion that a sufficient distribution of European Patent Attorneys should be maintained throughout the European Union and the Contracting States of the European Patent Convention in order to help local industries and individual inventors as well as foreign industries outside of the European countries to solve their patent problems in the best possible way.
26. As far as representation before national Patent Offices is concerned, *epi* is of the opinion that the implementation of the EC Directive No. 89-48 of December 21, 1988 on the mutual recognition of professional qualification within the EU should be pursued.

Section 4.5 – Additional measures

27. *epi* does not consider it appropriate to introduce at the Community level financial provisions in favour of certain categories of enterprises the exact definition of which is always difficult to make. Such measures, if deemed useful, should be introduced at a national level.
28. *epi* does also not favour introduction of a legal cost insurance system at the Community level. Such an organisation should be left to private initiative.

Annex to *epi* Comments on the EC Green Paper

Draft Protocol on the Settlement of Litigation concerning the Infringement and Validity of European Patents (EPAC Protocol on Litigation)

Note of Presentation

Introduction

1. At the present time, it is possible to protect inventions in Europe either through national patents or through a European patent which, after grant, has the same effect as national patents in the designated States. National patents have only a territorial effect. Their validity and usually also their infringement is decided on a national basis by national Courts.
While the European patent as granted is normally the same for all designated States (with exceptions in case of prior rights), decisions on its validity and – usually – infringement are also made by national Courts with limited national effect.
2. The Brussels Convention of September 27, 1968, has recently been applied to patent matters in some circumstances and particularly for provisional measures by the Courts of certain countries. The ques-

V. The European Patent

29. *epi* is of the opinion that the current structure of the European Patent Organisation should not be changed and considers that the procedures set up at the European Patent Office for granting European patents work satisfactorily. However, the lack of harmonisation of national decisions relating to infringement and validity of the granted European patents, as well as the limited effect of decisions as to validity to the territory of each country, show that the settlement of disputes on infringement and validity of European patents should be improved.
30. *epi* is studying a draft Protocol on the settlement of litigation concerning the infringement and validity of European patents along the lines of the Protocol on Litigation of the 1989 Agreement relating to Community patents, but with certain amendments and improvements. The general outline of the present status of this draft Protocol ("EPAC Protocol on Litigation") is contained in the Annex to the present paper.

Munich, 7 November 1997

tion of the validity of the patent remains however outside of the Brussels Convention and it has been questioned whether the Brussels Convention is readily applicable in all circumstances to questions of substantive infringement when the validity of the patent is put in issue in the same action.

3. The present situation appears therefore unsatisfactory. There seems to be an urgent need for an harmonisation in the settlement of disputes relating to infringement and validity of patents in Europe.
4. The Agreement relating to Community patents done at Luxembourg on December 15, 1989 which includes the Community Patent Convention would have the advantage of solving those difficulties. However, the unitary character of the Community patent and the resulting lack of flexibility has led to the possibility for the applicant of choosing between the European patent system and the Community patent system for protecting an invention in Europe. The flexibility thus obtained is certainly an advantage for the users of the patent system and

will be maintained for an indefinite time.

Furthermore, the Community patent system for various reasons is still not in force.

5. It therefore appears necessary to organise as soon as possible new possibilities for settling the disputes on infringement and validity of European patents.
6. The questions of infringement and validity of European patents in all the Contracting States should be harmonised. The general outline of the Community Patent Convention could be taken up. As a matter of fact, it appears advisable on the one hand to speed up the infringement and validity procedures and on the other hand to maintain the highest possible quality of the decisions by giving jurisdiction to national first instance Courts both for validity and infringement questions and to a new Common Appeal Court.
It appears thus possible to obtain a balanced system between known and existing national Courts in the first instance and a highly qualified and specialised centralised second instance Court judging in last resort on law and facts.
7. Questions of the validity of the European patent as well as any request for limitation can be best handled by the EPO when no simultaneous infringement question arises. However, in order to harmonise centrally the judgement of patentability, it appears necessary that appeals from first instance EPO decisions be heard by the Common Appeal Court.
8. When however a Court is handling an infringement action, it would be preferable that all questions of validity including any request for limitation of the European Patent be heard by the Court and decided in the same decision as the infringement question.
9. The Protocol should preferably be separated from the European Patent Convention so that ratification by only some EPC Member States remains possible. Contrary to the Community patent system, countries outside of the European Union such as Switzerland could fully participate in this harmonisation process.

Content of the draft Protocol

10. The institution of a common system of law in the Contracting States must be provided, which does not rule out the possibility that the entry into force of this new Protocol may be deferred for various EPC Member States. Furthermore, provisions need to be made for the establishment of Revocation Divisions at the European Patent Office and a Common Appeal Court.
The effects of a European patent and a European patent application should be stated. Direct and indirect acts of infringement must be defined so that the definition of acts of infringement is harmonised throughout the Contracting States, which is not the case at present.
The prior use right should be harmonised throughout Europe, preferably along the lines of the propo-

sal made by *epi* which was adopted by the *epi* Council in May 1991.

11. Provisions on validity should be stated, relating in particular to a limitation procedure and a revocation procedure. National Offices should be informed in the event that a European patent is maintained in force after amendment, and possibilities of translation of the text should be left open, depending on the provisions adopted by the Contracting States, as is the case with Article 65 EPC.
The grounds for revocation should be as already laid down in Article 138 EPC, but with the addition of revocation because existence of a prior national right, this provision being left to the discretion of national Courts in the European Patent Convention. Appeals from decisions of the Revocation Divisions should lie exclusively with the Common Appeal Court.
12. European Patent Courts of first and second instance should be defined in each Contracting State and be as few in number as possible.
13. Provisions relating to international jurisdiction must also be indicated. In this regard, conditions similar to those of the Brussels Convention should apply to proceedings under the new Protocol. The normal jurisdiction would therefore be attributed to the Court of the Contracting State in which the defendant is domiciled. This would in practice almost always be the case in view of the provisions of Article 6 of the Brussels Convention relating to co-defendants who can be judged before the Court of the domicile of one of them.
A further jurisdiction could also be attributed to the Court of the Contracting State in which the infringement was committed. But in this case, the decision would apply only in the territory of that Contracting State.
14. Territorial jurisdiction of the European Patent Courts should not be confined to acts of infringement committed within the territory of the Contracting State in which the Court is located but extend on the contrary to the territory of all Contracting States, except in the rare case where the jurisdiction would be based solely on the place of the infringement. Consequently, with regard to the validity of the European patent and to its infringement, the decision would normally extend to all the Contracting States.
15. The European Patent Courts should have jurisdiction for infringement actions, actions for declaration of non-infringement, counterclaims for revocation and also requests for limitation which may be made by the patentee during the course of an infringement action.
16. Requesting revocation simultaneously with an action for declaration of non-infringement should be allowed which is presently not the case before national Courts.
17. All questions relating to infringement and validity of the European patent should be considered and judged by the same Court at the same instance. The judicial organisation envisaged is thus similar

on this point to customary practice in, e.g. France, the United Kingdom and Spain, and differs from the practice in Germany and those other European countries in which the validity of a patent is judged by an administrative authority whereas infringement is decided by a judicial authority.

It appears desirable that these two questions which are strongly linked be judged by the same Court and at the same instance.

18. As to proceedings at second instance, the Common Appeal Court must have sole jurisdiction to rule on appeal against decisions of the Revocation Divisions and also on matters that are the subject of an appeal to a European Patent Court of second instance, whether they relate to the effects of the European patent or to its validity. The European Patent Court of second instance will thus stay the proceedings and refer them to the Common Appeal Court whenever such a question comes before it.
19. The Common Appeal Court then gives judgement in fact and in law. It thus appears that this body would be capable of examining all the technical and legal facts relating to the validity of a European patent and its infringement. The existence of this single appeal body would certainly make it possible to obtain effectively harmonised case law in European patent matters.
20. Third instance appeals to national Courts should be strictly limited only to matters that are not within the exclusive jurisdiction of the Common Appeal Court. Thus one could feel confident that the parties will, within a reasonable period, know the final decision regarding the infringement and validity of the European patent. This compromise solution, which does away with the third appeal instance even on points of law in connection with the essential aspects of the validity and infringement of a patent, has likewise been adopted in the Protocol on Litigation of the 1989 Agreement relating to Community patents.
21. Rules for governing the stay of proceedings in related actions must also be provided. Those rules should tend to ensure that infringement and validity be normally discussed and decided simultaneously by the Courts, with the following consequences:
 - a) If a request for limitation or an application for revocation is in issue before the EPO at the time of an infringement action where the validity of the patent is brought before a European Patent Court, the proceedings before the EPO should be stayed, except in particular circumstances, for example if the proceedings before the EPO are almost terminated.
 - b) If no request for limitation and no counterclaim for revocation have been filed before the Court, the Court should stay the proceedings, thus leaving in practice the freedom to the parties to have the questions of validity decided by the EPO or by the Court.
 - c) When an infringement action is pending before a European Patent Court, it should not be possible for the same party already involved in an infringement action to request a limitation or to file an application for revocation at the EPO. Those questions relating to the validity of the patent should only be put in issue before the Court already handling the infringement question by way of a counterclaim for revocation or a request for limitation.
22. Penalties in the event of infringement should be imposed by the European Patent Court according to the national laws of the various Contracting States.
23. The European Patent Court which has jurisdiction on the merits should also have jurisdiction to order provisional and precautionary measures which are applicable within the territory of all Contracting States in which the European Patent has effect. This would therefore be a clear provision excluding the present possible doubts about the applicability of Article 24 of the Brussels Convention to patent matters.
24. As far as representation of the parties before the Common Appeal Court is concerned, provisions should be made, in view of the highly specialised and technical questions involved in patent matters, for representation by a European Patent Attorney or by a lawyer entitled to practice before a Court of a Contracting State, assisted by a European Patent Attorney. This applies of course when the Court hears an appeal from a decision of a Revocation Division or an appeal from a first instance European Patent Court.

epi 20th anniversary overview

E. Thouret-Lemaître (FR)

Ich nehme die nachfolgenden Fotos zum Anlaß, nochmals den Höhepunkt, das Symposium, in Erinnerung zu bringen, das uns für die informativsten und angenehmsten Stunden vereint hat.

Gleichzeitig möchte ich den Sprechern nochmals meinen herzlichsten Dank aussprechen und – als frühere Präsidentin des *epi* – dem *epi* ein langes Leben in Harmonie mit den anderen Pfeilern des Patentsystems wie dem EPA, der Europäischen Kommission, den nationalen Ämtern und den Richtern.

The pictures which follow give me the occasion to recall once again the Symposium which provided a most instructive and pleasant day for all of us.

I take this opportunity, as Past President of the *epi*, to thank again all speakers and to wish the *epi* a long life, in harmony with the other participants in the patent system like the EPO, the European Commission, the national offices, judges and magistrates.

Les quelques photos qui suivent me permettent d'évoquer une fois encore le temps fort que fut le Symposium, et qui nous a réunis tous pour un moment des plus instructifs et des plus agréables.

Je profite de ces photos pour renouveler mes remerciements aux orateurs et former le vœu – en tant que Past président de l'*epi* – d'une longue vie à l'*epi*, en harmonie avec les autres acteurs du système des brevets comme l'OEB, la Commission Européenne, les offices nationaux, les juges et les magistrats.





Fotos: Claire Mouget-Goniot

epi Code of Conduct

J. D. Brown (GB)

For the information of members, your reporter advises that, following a meeting with J.F. Pons, Deputy Director General, DG-IV, a further revised French version of the *epi* Code of Conduct was prepared. At the *epi* Council Meeting on 3rd October, 1997 in Strasbourg, a revised French version of the *epi* Code of Conduct was approved, with the *epi* Board being given the power to approve the final English and German version of the

epi Code of Conduct. The *epi* Board will decide and announce when the amended *epi* Code of Conduct shall come into force.

The *epi* Council also resolved that the amended *epi* Code of Conduct is not to be published, in any language, until the Notification Procedure before the EU Commission has been finally resolved.

Student Page

Calling all Students ...

Some years' ago, the *epi* set up its student membership scheme and many students have joined. To date, the benefits of the scheme have flowed from the *epi* to the student, primarily by virtue of the information sent to the students by the *epi* following their joining the scheme. The *epi* acknowledge that, to date, students have had no single forum in which to air their views and to communicate not only with one another but with the *epi* membership. It is for this reason that a student page is being set up in *epi* Information and we would encourage all students to provide any contribution that they feel fit.

The student page is intended to reflect the views and concerns of the student members and not of the *epi* as a whole. Members wishing to contribute should not feel restricted in their choice of subject matter nor in the level of intellectual content that they feel might be required. Any points of view or pieces of information, however trivial, are welcome, be it an amusing Patent specification, a report of a social meeting of a National Institute, information with regard to new training opportunities, advice as to how to take the exam or obtain experience, or just a humorous letter or article. All contributions will be welcome.

It should be noted that, whilst the page is primarily intended for students, it is not restricted to students, and others wishing to provide information that they may feel of use (for example, giving hints on how to approach the European Qualifying Examination) should not feel excluded from contributing.

Please send all contributions, preferably but not necessarily accompanied with a diskette containing the contribution in WordPerfect format to:

Editorial Board (Student Page)

epi

P.O. Box 260112

D-80058 MÜNCHEN

Of equal importance, it is the intention of the Editorial Board and the Professional Qualification Committee to, in time, allow both the student page and the student membership to coordinate and organise itself. As a preliminary to this, we would greatly appreciate volunteers from the student membership to run the student page, taking contributions, organising members and providing initiatives. If there are any volunteers for such a task, please contact the Editorial Board, c/o *epi*, as above.

Portfolio-Analyse als Instrument unternehmerischer Patentpolitik

S. Hofinger¹ (AT)

1. Einleitung

Auch Patentpolitik² ist als eine Form wirtschaftlich-rechtlicher Unternehmenspolitik mit dem zentralen Problem jedes wirtschaftlichen Handelns konfrontiert: dem optimalen Einsatz knapper Ressourcen. Das Verteilungsproblem stellt sich dabei konkret gesehen auf zwei Ebenen. Einerseits gilt es, die Sinnhaftigkeit von Investitionen in Patentschutz insgesamt zu beurteilen. Andererseits brauchen die verantwortlichen Entscheidungsträger klare Anhaltspunkte für die Aufteilung des Patentbudgets, um sicherzustellen, daß patentpolitische Entscheidungen nicht aus dem Bauch getroffen werden, sondern nach wissenschaftlich fundierten Investitionsrichtlinien.

Im Zuge der vorliegenden Arbeit wird der Versuch unternommen, durch Abwandlung und Anpassung der in zahlreichen Bereichen strategischer Unternehmensplanung bewährten Portfolio-Analyse eine Methodik zu entwickeln, die eine systematische Beurteilung patentpolitischer Fragestellungen erlaubt.

2. Portfolio-Analyse als Instrument patentpolitischer Entscheidungsfindung

Der Portfolio-Ansatz, ursprünglich eine Planungsmethode zur Optimierung der Investitionen an der Aktienbörse, hat seit seiner Begründung durch Markowitz³ zahlreiche Anwendungsgebiete gefunden und sich als Methode zur Problemidentifikation und -lösung vielfältig bewährt. Die Portfolio-Analyse ist in erster Linie dazu geeignet, in Form eines sogenannten „Ist-Portfolios“ die momentane Ausgangssituation unternehmenspolitischer Entscheidungen aufzuzeigen. Aufgrund des relativ hohen Aggregationsniveaus eignet sich die Portfolio-Analyse besser als Instrument zur Beurteilung längerfristiger, grundsätzlicher unternehmenspolitischer Entscheidungen, denn als Hilfsmittel zur Klärung detaillierter Einzelfragen. Für den konkreten Einsatz im Zusammenhang mit aktiver Patentpolitik bedeutet dies, daß beispielsweise folgende Problemstellungen zielführend behandelt werden können:

Werden von unserem Unternehmen Patente in ausreichendem Umfang als Wettbewerbsinstrument genützt?

Sollten Patente bei der Budgeterstellung für Forschung und Entwicklung stärker berücksichtigt werden?

Ist die breite Streuung unserer Patente auf die gesamte Produktpalette des Unternehmens gerechtfertigt oder sollte vielmehr eine Konzentration auf bestimmte ausgewählte Produkte vorgenommen werden?

Welche Merkmale kennzeichnen diese Produkte, für die sich der Einsatz aktiver Patentpolitik als Wettbewerbsinstrument in besonderem Maße eignet?

Verknüpft man die empirischen Erkenntnisse einer umfangreichen, kürzlich erschienen Studie über aktive Patentpolitik⁴ sowie jene einiger früherer Studien⁵ mit dem formalen Hilfsmittel der Portfolio-Analyse, können daraus Antworten für obige Fragen abgeleitet werden.

3. Entscheidungsprozeß

Wendet man die Portfolio-Methodik als Hilfsmittel zur Problemlösung im Zusammenhang mit aktiver Patentpolitik an, so ergibt sich aus den grundlegenden Prozeßschritten bereits eine Systematik, durch die die Entscheidungsfindung maßgeblich erleichtert wird. Die nachfolgende Gliederung folgt dabei Hammer⁶, der folgende Vorgehensweise vorschlägt:

- Segmentierung
- Bestimmung der Unternehmens- und Umweltdimension
- Erstellung eines Ist-Portfolios
- Ableitung einer strategischen Stoßrichtung

3.1 Segmentierung

Primärer Schritt und Grundvoraussetzung bei der Anwendung der Portfolio-Methodik im Rahmen strategischer patentpolitischer Entscheidungen ist die Gliederung des Unternehmens in patentpolitisch relevante Einheiten. Im Zuge der bereits erwähnten empirischen Studie wurde dabei erstmals der Versuch unternommen, durch produkt- statt unternehmensorientiertes Vorgehen Muster und Gesetzmäßigkeiten von Patentaktivität zu erfassen und zu verstehen. Der Erfolg dieser grundlegenden Änderung der Betrachtungsweise läßt sich wie folgt erklären:

Patente beschränken sich in ihrer Wirkung jeweils nur auf einen „Teil“ eines Unternehmens, nämlich ein bestimmtes Produkt, auf dessen Verbesserung oder spezielle Ausführungsform sich ein bestimmtes Patent bezieht. Dies hat zur Folge, daß für die Frage, ob eine Erfindung zum Patent angemeldet werden soll, nicht Kennzahlen des gesamten Unternehmens relevant sind, sondern produktspezifische Kennzahlen.

1 Dipl.-Ing. Dr. rer. soc. oec. Stephan Hofinger ist Patentanwaltsanwärter in Innsbruck (Anschrift: Patentanwälte Torggler & Hofinger, Wilhelm-Greil-Str. 16, Postfach 556, A-6021 Innsbruck, Austria).

2 Der Begriff Patentpolitik soll im folgenden jene Form von Patentaktivität bezeichnen, die konsequent und regelmäßig über längere Zeiträume erfolgt. Einmalige, mehr oder weniger zufällige Aktionen fallen nicht unter diese Bezeichnung.

3 Markowitz, H., Portfolio Selection, The Journal of Finance, Vol. 7, 1952.

4 Hofinger, S., Ökonomische Determinanten aktiver Patentpolitik – Eine empirische Untersuchung ausgewählter Unternehmen in Österreich, ÖBI 1996, 111–117.

5 Scherer, F. M., Firm Size, Market Structure, Opportunity and the Output of Patented Inventions, AER (55), 1965, 1097–1125; Scherer, F. M., The Propensity to Patent, International Journal of Industrial Organisation 1, 1983, 107–128; Griliches, Z., [u. a.], Who Does R & D, and Who Patents? NBER-Report, 1984; Audretsch, D. B. /Acs, Z. J., Patents Innovative Activity, Eastern Economic Journal (Vol. 15/4), 1989, 373–376; Zimmermann, K. F. / Schwalbach, J., Determinanten der Patentaktivität, Ifo-Studien 1–4, 1991, 201–227.

6 Hammer, R., Unternehmensplanung, 5. Aufl., Oldenbourg Verlag, München, 1992.

Auch als Wettbewerbsinstrument trifft der Patentschutz genau jene Konkurrenten, die das gleiche Produkt herstellen und denen durch den Patentschutz eine bestimmte Ausführungsform oder Verbesserung, die im Herstellungsprozeß oder aus der Sicht des Konsumenten überlegen ist, versperrt ist. Zusätzlich trifft er noch jenen Unbekannten, der in Zukunft dieses Produkt herstellen möchte. Der Patentschutz unterscheidet sich damit von anderen Wettbewerbsinstrumenten wie Preis, Absatzwege oder Werbung, bei denen ein wesentlich breiterer Markt relevant ist.

Ausgehend von obigen Überlegungen scheint es auch bei der Anwendung der Portfolio-Analyse auf den patentpolitischen Entscheidungsfindungsprozeß sinnvoll, eine Segmentierung nach Produkten vorzunehmen. Die hohe Aussagekraft der Ergebnisse rechtfertigt dabei in jedem Fall die mit einer produktbezogenen Analyse verbundene Definitions- und Abgrenzungsproblematik.

Nach der im Verfahrensschritt der Segmentierung vorgenommenen Zergliederung des Unternehmens folgt eine isolierte Beurteilung der patentpolitisch relevanten Produkte, die die Grundlage einer letztlich vorzunehmenden Zusammenschau und Gesamtdarstellung bildet.

3.2 Bestimmung der Umwelt- und Unternehmensdimension

Allen Portfolio-Anwendungen ist eine Abfolge von Verdichtung zweier Haupteinflußbereiche mit anschließender ganzheitlicher Visualisierung in einem Koordinatensystem gemeinsam. Die Haupteinflußbereiche tragen im vorliegenden Fall die Bezeichnungen „Markt- und technologiedefinierter Patentwert“ (Umweltdimension) und „Unternehmens- und innovationsdefinierter Patentwert“ (Unternehmensdimension), wobei jeweils ein Bündel von passenden Bewertungskriterien, die nachfolgend ausführlich besprochen werden, zu einer Kenngröße verarbeitet wird. Bewertet werden jene Produkte, die im Prozeßschritt der Segmentierung als patentrelevante Einheiten identifiziert wurden. Die an die Beurteilung anschließende Darstellung aller Produkte in einer 9-Felder Matrix bietet folgende Vorteile:

- Sie erlaubt einerseits eine ganzheitliche Betrachtung der Produkte des Unternehmens in bezug auf patentpolitische Fragen, sowie eine Aussage über die wirtschaftliche Sinnhaftigkeit von Patentinvestitionen insgesamt.
- Andererseits ermöglicht sie einen Vergleich der einzelnen Produkte bezüglich des gegenwärtigen (und auch zukünftigen) Erfolgspotentials von Investitionen in produktspezifischen Patentschutz.

3.2.1 Bewertungsfaktoren und Berechnung der Kenngröße „Markt- und technologiedefinierter Patentwert“

In der kumulierten Kenngröße „Markt- und technologiedefinierter Patentwert“ sind jene patentpolitisch relevanten Faktoren zusammengefaßt, die unabhängig

von einem spezifischen Unternehmen durch den Markt oder die Technologie bestimmt sind. Die einzelnen Faktoren werden dabei getrennt voneinander betrachtet und gehen gewichtet in den Summenwert ein, der auf der Ordinate des Koordinatensystems der 9-Felder Matrix aufgetragen wird.

Der Einfluß des ersten Faktors der Berechnungstabelle (Abb. 1), der Marktsituation, wird aufgrund wettbewerblicher Überlegungen verständlich. Das Patentwesen ist genau dann ein wirksames Instrument zum Schutz von Erfindungen, wenn es möglich ist, Verletzer zu verfolgen. Eine Verfolgung ist jedoch nur dann sinnvoll durchführbar, wenn die Zahl der Anbieter des Produktes, für dessen Verbesserungen oder spezielle Ausführungsformen Patente angemeldet werden, gering ist. Mit dieser Bedingung ist gesichert, daß der Patentinhaber rasch von Nachahmungen erfährt, der Nachahmer leicht (namentlich) feststellbar ist und die Beeinträchtigung durch einen einzelnen Nachahmer so groß ist, daß der Aufwand eines Patentverletzungsprozesses gerechtfertigt und wirtschaftlich sinnvoll ist. Aufgrund dieser empirisch bestätigten Überlegungen wurde die Marktsituation bzw. die Anzahl der Marktteilnehmer als erster Bewertungsfaktor aufgenommen. Je geringer die Zahl der Anbieter eines Produktes, desto höher die entsprechende Bewertung. So sollte eine Monopolstellung mit 100 bewertet werden, patentpolitisch günstige oligopolistische Marktsituationen mit 2–10 bedeutsamen Marktteilnehmern mit 70–95, wogegen einem völlig zersplitterten Markt mit mehr als 100 Teilnehmern nur etwa 20 Punkte zugeordnet werden.

Weiters muß im Zusammenhang mit dem markt- und technologiedefinierten Patentwert berücksichtigt werden, ob Patente für das jeweilige Produkt ein wirksames einsetzbares Wettbewerbsinstrument darstellen, oder ob andere Instrumente ein höheres Erfolgspotential aufweisen. Vorgeschlagen wird deshalb eine Reihung jener Wettbewerbsinstrumente, die von Levin⁷ und Träger⁸ als konkurrierend erkannt wurden:

- Patente
- Preisstellung
- Werbung
- Zeitvorsprung / Lerneffekte
- Lieferbereitschaft / Service

Werden Patente auf Platz 1 gereiht, folgt daraus eine Bewertung mit 100 Punkten. Die nachfolgenden Plätze ergeben jeweils eine um 20 Punkte reduzierte Bewertung, sodaß für den 5. und letzten Platz nur mehr 20 Punkte vergeben werden.

Weiters konnte gezeigt werden, daß die Patentaktivität der Konkurrenz wesentlichen Einfluß auf die Notwendigkeit eigener aktiver Patentpolitik hat. Je dichter die Konkurrenz ihr Patentnetz spannt, desto wichtiger ist es für ein Unternehmen, durch eigene Anmeldungen Nischen und Produktvarianten freizuhalten. Eine genaue Beobachtung der Patentaktivität der direkten Wettbe-

7 Levin, R. [u. a.], Survey Research on R & D Appropriability and Technological Opportunity, Part I: Appropriability, Yale University, 1984.

8 Träger, U., Zum Patent- und Lizenzverhalten der deutschen Investitionsgüterindustrie, GRURInt. 1982, 604–609.

werber – ratsame begleitende Maßnahme jeder Form von Forschungs- und Innovationstätigkeit – dürfte auch bei diesem Faktor eine passende Punktevergabe ermöglichen.

Schließlich wird der unternehmensunabhängige Patentwert noch durch die mögliche Überlegenheit alternativer Schutzmechanismen, wie beispielsweise Geheimhaltung, beeinflusst. Verfahren werden laut übereinstimmender Ergebnisse verschiedener Studien nur dann angemeldet, wenn das angewendete Verfahren am Produkt erkennbar ist. Da die Produktionshallen der Konkurrenz in den seltensten Fällen zugänglich sind, muß das Produkt Spuren des Herstellungs- oder Bearbeitungsverfahrens aufweisen, die eindeutigen Hinweis auf eine mögliche Patentverletzung geben können. Geht das angewendete Verfahren aus dem Produkt nicht hervor, wird von den Unternehmen Geheimhaltung vorgezogen. Somit werden bei verfahrensbezogenen Produktinnovationen häufig nur wenig Punkte vergeben werden (in der Größenordnung von 10–50), und reine Produktinnovationen bei diesem Bewertungsfaktor deutlich besser abschneiden.

Die beispielhaft angeführte Gewichtung ist ein erster Vorschlag, die verschiedenen Faktoren unter Berücksichtigung ihres unterschiedlichen Einflusses in den Summenwert „Markt- und technologiedefinierter Patentwert“ eingehen zu lassen. Es handelt sich um einen aus ersten Anwendungen abgeleiteten, subjektiv geprägten Vorschlag, der im Zuge weiterer Erprobung der hier vorgeschlagenen Methode sicherlich Abwandlungen erfahren wird.

nierten Patentwert jene Faktoren vereint, die unternehmensintern für die wirtschaftliche Bedeutung aktiver Patentpolitik relevant sind. (Abb. 2)

Die Zahl der möglichen Patentanmeldungen hängt selbstverständlich von der Zahl der an einem Produkt vorgenommenen Verbesserungen und Innovationen ab. Stellt ein Produkt einen elementaren Eckpfeiler für den Erfolg eines Unternehmens dar, werden große Bemühungen unternommen werden, dieses Produkt zu verbessern und den aktuellen Erfordernissen anzupassen. Die Qualität der Erfindungen kann von zwei Seiten betrachtet werden:

- Kundennutzen: Dieser umfaßt funktionale Verbesserungen, Erhöhung von Bedienungskomfort und Sicherheit, Erhöhung der optischen Attraktivität, neue Anwendungsgebiete u.ä.
- Herstellernutzen: Dieser umfaßt eine Reihe von Faktoren, die sich meist in geringeren Herstellungskosten niederschlagen: effizientere Produktion, Material- und Energieeinsparung, geringere Ausschußquoten u.ä.

Neben den „objektiven“ Vorteilen, die bei der Punktevergabe zu berücksichtigen sind, sollte einbezogen werden, inwieweit durch entsprechende Maßnahmen wie beispielsweise Werbung diese Vorteile auch nutzbringend vermarktet werden können.

Eine als eigener Faktor ausgegliederte Qualität der Erfindungen und Innovationen liegt in ihrer Distanz zu nicht (mehr) schutzfähigen oder fremdgeschützten Lösungen. Auch hier setzt die richtige Bewertung eine

Markt- u. technologiedefinierter Patentwert	Bewertung 0 - 100	Gewichtung (Summe = 1)	Produkt/ Ergebnis
Marktsituation (Anzahl der Marktteilnehmer)	zB 80	0,25	20
Wettbewerbsinstrumente	70	0,30	21
Patentaktivität der Konkurrenz	100	0,20	20
Alternative Schutzmechanismen	90	0,25	23
			84

Abb. 1: Berechnungstabelle zur Ermittlung des markt- und technologiedefinierten Patentwertes

3.2.2 Bewertungsfaktoren und Berechnung der Kenngröße „unternehmens- und innovationsdefinierter Patentwert“

Im Gegensatz zum markt- und technologiedefinierten Patentwert sind im unternehmens- und innovationsdefinierten

genaue Kenntnis der gesamten Schutzrechtssituation des jeweiligen Produktes voraus.

Die unternehmensinterne Verteilung des Patentbudgets muß zudem den Stellenwert des Produktes bezüglich seines Anteils am Gesamtumsatz berücksichtigen. Die unternehmerische Patentpolitik wird sich dabei in

Unternehmens- und innovationsdefinierter Patentwert	Bewertung 0 - 100	Gewichtung (Summe = 1)	Produkt/ Ergebnis
Qualität der Erfindungen (Kunden- oder Herstellernutzen)	zB 60	0,40	24
Distanz zu nicht schutzfähigen / fremdgeschützten Lösungen	40	0,15	6
Stellung des Produktes im Gesamtumsatz des Unternehmens	20	0,45	9
			39

Abb. 2: Berechnungstabelle zur Ermittlung des unternehmens- und innovationsdefinierten Patentwertes

erster Linie auf die Hauptumsatzträger konzentrieren. Für die Bewertung scheint es in diesem Fall günstig, vom umsatzstärksten Produkt auszugehen und diesem 100 Punkte einzutragen. Die nachfolgenden Produkte werden in Abhängigkeit ihres Umsatzverhältnisses zum erstplatzierten Produkt bewertet. Werden mit dem Hauptprodukt beispielsweise 50 Millionen Umsatz erzielt und mit dem nächstkommenden lediglich 30, so resultiert daraus die Zuweisung von 60 Punkten an das umsatzschwächere Produkt.

Für die Gewichtung gelten auch hier die Anmerkungen des vorigen Abschnitts.

3.3 Erstellung eines Ist-Portfolios

Bei der Erstellung des Ist-Portfolios werden nunmehr sämtliche, einzeln bewertete Produkte des Unternehmens innerhalb der 9-Felder Matrix positioniert. Die Eintragung erfolgt in Form von Kreisen, wobei die Größe der Kreise vorteilhafterweise die Zahl bestehenden Patente bzw. Anmeldungen widerspiegelt. Durch diesen Vorgang wird zweierlei erreicht: Einerseits erlaubt die Matrixdarstellung eine ganzheitliche Betrachtungsweise und andererseits wird erreicht, daß die Stärken und Schwächen der einzelnen Produkte im gegenseitigen Vergleich sichtbar werden. Ein mögliches Ist-Portfolio eines diversifizierten Unternehmens (Produkte A bis F) könnte dabei beispielsweise so aussehen:

3.4 Ableitung einer strategischen Stossrichtung

Unabhängig von der jeweiligen Ausprägung und Gestalt des Ist-Portfolios sind durch die Gliederung der Darstellungsmatrix in Felder bereits voneinander abgegrenzte Bereiche vorgegeben, für die unterschiedliche Strategien sinnvoll erscheinen. Diese in der Literatur allgemein als

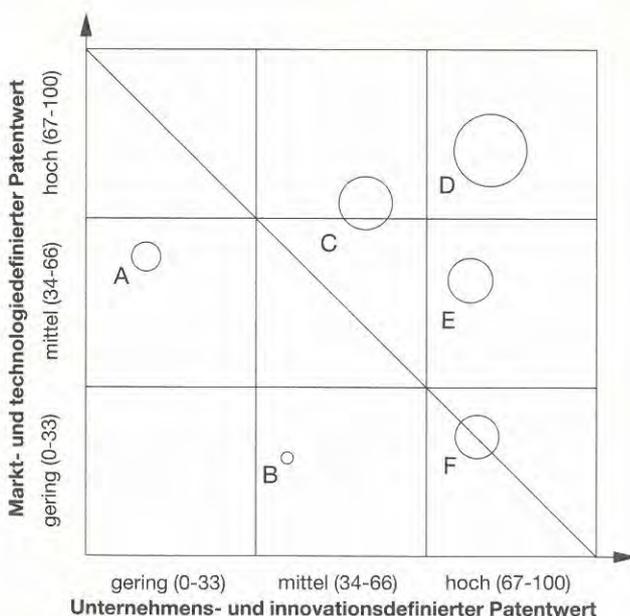


Abb. 3: Mögliches Ist-Portfolio eines diversifizierten Unternehmens

Normstrategien bezeichneten Stoßrichtungen einer positiven, zukünftigen Entwicklung können für den vorliegenden Anwendungsfall wie folgt definiert werden:

- Investitionsstrategien
- Non- bzw. Desinvestitionsstrategien

Grundsätzlich ist zu sagen, daß sich Investitionen im Patentbereich in zwei zeitlich aufeinanderfolgenden Stufen abspielen. Die erste Stufe betrifft die Kosten für Anmeldungen, die sich – grob gesprochen – als Produkt der Zahl der Anmeldungen und der Zahl der Länder, für die ein Schutz angestrebt wird, abschätzen lassen. Das Investitionsrisiko ist im Anmeldestadium besonders

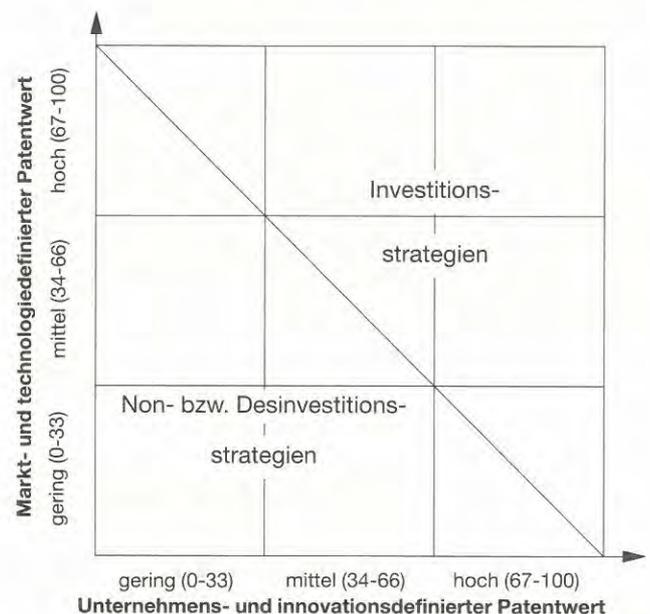


Abb. 4: 9-Felder Matrix mit zugeordneten Normstrategien

hoch, da der endgültig erzielbare Schutzzumfang der Patente noch nicht klar absehbar ist. Zudem befinden sich die betroffenen Produkte oft noch in der Markteinführungsphase, sodaß auch von dieser Seite noch keine sicheren Prognosen möglich sind. Anders gelagert ist die Investitionsentscheidung bei der zweiten Stufe, auf der für oder gegen die weitere Aufrechterhaltung (Zahlung von Jahresgebühren) von bestehenden Patenten entschieden wird. In diesem Fall kann wesentlich genauer abgeschätzt werden, ob sich weitere Investitionen aufgrund der gegebenen Wettbewerbssituation sowie der Produktentwicklung (Lebenszyklus) lohnen. Insbesondere ist es oftmals möglich, den Patentschutz in territorialer Hinsicht auf die Produktionsstandorte der Konkurrenz zu beschränken.

Investitionsstrategien finden für jene Produkte Anwendung, die oberhalb der Trenndiagonale gelegen sind. Die Summe der Charakteristika dieser Produkte, die letztlich zu einer Positionierung oberhalb der Trenndiagonalen führt, stellt sicher, daß Investitionen in Patentschutz wirtschaftlich sinnvoll sind. Investitionsstrategien einer aktiven Patentpolitik sind äußerst vielfältig:

- Durchführung zahlreicher Anmeldungen (auch für geringfügige Innovationen)
- Breite Absicherung in territorialer Hinsicht
- Lange Aufrechterhaltung bestehender Patente

Demgegenüber stehen die Non- bzw. Desinvestitionsstrategien für jene Produkte unterhalb der Trenndiagonalen. Ziel ist es in diesem Bereich, keine oder nur geringfügige Kosten für Patentschutz entstehen zu lassen bzw. bestehende finanzielle Bindungen zu minimieren. Konkret bedeutet dies beispielsweise:

- Umlenkung von Investitionen auf andere Wettbewerbsinstrumente
- Anmeldungen nur in besonderen Ausnahmefällen, die aufgrund des relativ hohen Aggregationsniveaus bei der Produktanalyse mittels der Portfolio-Analyse untergehen
- Einschränkung des bestehenden Patentschutzes bezüglich Laufzeit und territorialer Erstreckung

Besondere Beachtung verlangen jene Produkte, die in der Portfolio-Matrix entlang der Trenndiagonale zu liegen kommen. Da es sich dabei sowohl um zukünftige Hoffnungsträger als auch absteigende Produkte handeln kann, muß jeder Einzelfall gesondert im Detail analysiert werden.

4. Zusammenfassung

Intuition ist eine wesentliche Komponente erfolgreicher Unternehmensführung. Dies gilt jedoch nur dann, wenn die Entscheidungsfindung parallel dazu auch auf einer systematischen, wissenschaftlich fundierten Ebene stattfindet. In diesem Sinn soll die in dieser Arbeit entwickelte patentbezogene Portfolio-Analyse als Instrument verstanden werden, das trotz Begeisterung über Neuentwicklungen des eigenen Unternehmens und oftmals undifferenzierten Lockrufen der Patentämter eine solide Entscheidungsbasis für patentpolitische Grundsatzfragen bietet.

Mit der Anpassung der Portfolio-Analyse auf Problem- und Fragestellungen unternehmerischer Patentpolitik wurde Neuland betreten. Die Ausführungen sind somit in erster Linie als Diskussionsentwurf zu verstehen, und nicht als exakte, unverrückbare Rechenanweisung. Erst eine umfangreiche Praxis sowie weiterführende Studien werden zeigen, welche Modifikationen und spezielle Ausgestaltungen des Ansatzes nötig sind, um einem möglichst breiten Spektrum an Anwendungsfällen gerecht zu werden.

Cost Reductions in the European Patent System

S. Davies (UK)

1. Introduction

There has recently been considerable debate about the relatively high cost of obtaining patent protection in Europe. Much of the discussion has focused on whether the current need to file national translations of European patents should be dropped or at least modified. The main argument in favour of such a change is that the present translation requirements constitute a significant financial burden for patentees. Proponents of the status quo however maintain that translations help to disseminate technical information, and that since a patent has an important legal effect, it should be available in the local language. There does not appear to be an easy resolution of this question, which rises inevitably from the diverse languages of the EPC member states.

However, it is important to consider other opportunities for reducing costs. It is the purpose of this article to show that there is significant scope for a much greater harmonisation and centralisation of the grant and post-grant procedures in Europe, especially with regard to the procedural aspects of filing translations and payment of renewal fees.

2. The Present Mess

The current financial burden to European industry arising from the grant and post-grant phases is extremely high.

Indeed, one British inventor, James Dyson, designer of a revolutionary new vacuum cleaner, has filed a case at the European Court of Human Rights, arguing against the imposition of patent renewal fees. Whilst Dyson's legal position may be rather unconvincing, this case does highlight the importance of removing all unnecessary expense from the European patent system.

The complexity of the legal requirements of the different member states for the grant and post-grant phases is revealed by a study of the EPO publication „National Law relating to the EPC¹“. The filing of European patent translations for example is subject to a wide range of national regulations, as demonstrated by the following list:

(a) in nearly all countries a translation must be filed within 3 months from grant, but within 6 months from grant in Ireland;

(b) in most countries a fee is required for filing a translation, but not in Belgium or Switzerland; in Germany and Greece there is a fixed fee per patent, whereas in Denmark and Sweden the fee varies according to the number of pages of a translation; furthermore, the fee for filing a translation varies from country to country, must be paid in national currency, and is

¹ NB I take the responsibility if my interpretation of the information in this booklet as set out below is incorrect!

changed (normally increased) from time to time; in most countries the time limit for filing the fee is the same as for filing a translation, but for France the fee must be paid at the same time as the translation is filed;

(c) in Finland and Italy a translation must be certified by the patentee or representative; in Greece a translation must be certified by a legal practitioner or suitable governmental authority; in the Netherlands a translation must be certified by a Dutch patent attorney; in Sweden a translation must be certified by the translator;

(d) Spain requires foreigners to have a translation prepared by a patent attorney or interpreter with proper accreditation; Portugal requires foreigners to have a translation prepared by a national professional representative;

(e) Italy, Portugal, Spain, and the United Kingdom require a specific form (particular to each country) to accompany the filing of a translation;

(f) Austria, Belgium, and Denmark require one copy of a translation; Germany and Greece require two copies of a translation; Spain requires three copies of a translation;

(g) most countries require a copy of the drawings, even if the drawings do not contain any textual matter, although in Italy this is only recommended, and does not seem to be required in Switzerland or France; Greece requires two copies of the drawings;

(h) the Netherlands (uniquely it appears) requires that each page of a translation includes the European publication number of the patent.

The situation is just as complicated regarding the appointment of a local representative in each country: for Austria, Belgium, Spain and Sweden, an appropriate national professional or legal representative must be appointed upon grant - for Sweden such a representative does not have to file the translations, whereas they do for Belgium; for Greece, any natural person resident in Greece can be appointed as a representative upon grant; for Finland, Germany, France and Italy no national representative need be appointed, although for Italy an internal address for service must be given.

Similarly, as regards the procedures for payment of renewal fees, there is again a wide disparity in the legal requirements of the different member states, as shown by the following examples:

(a) all countries charge annual renewal fees, but the fees vary from country to country, must be paid in national currency, and are changed (normally increased) from time to time; Austria has different fees according to whether the patent was granted before or after 1 July 1996; Switzerland offers a reduction for advance payment of renewal fees for the next N years (where N equals 3 or 5 depending on the age of the patent);

(b) in all countries the renewal fees increase according to the age of the patent, but the rate of increase is highly variable; comparing for example the ratio of the renewal fees for the eleventh year to the third year, this ranges from 2.4:1 for Finland to 9.8:1 for Spain; the

ratio of the renewal fees for the twentieth year to the fifth year shows even greater disparity, ranging from 4.2:1 for Denmark to 22.0:1 for Germany; note also that in most countries the renewal fees increase according to the number of years since filing, but in the Netherlands the fees increase according to the number of years since grant;

(c) most countries charge renewal fees from the third year from filing, but the Netherlands and the United Kingdom only charge renewal fees from the fifth year from filing;

(d) in most countries the due date for the renewal fee is the last day of the month in which the date of filing occurred, but in Portugal and the United Kingdom the due date is the actual anniversary of the filing date;

(e) Belgium and Spain allow a 1 month period from the due date for the payment of renewal fees without surcharge; Germany allows two months; and Switzerland allows three months; but for the remaining countries payment on or before the due date is presumably required; some countries however restrict how early a renewal fee can be paid, for example the United Kingdom does not permit payment more than three months before the due date; Ireland does not permit payment more than four months early; and Finland and Portugal do not permit payment more than six months early;

(f) Ireland requires the renewal payment to be accompanied by a prescribed form, but this does not appear to be the case in other countries;

(g) all countries allow an extended six month period from the due date for late payment of renewal fees with possible surcharge - this at least is standardised by Article 5bis of the Paris Convention; however, for Belgium and Switzerland, the period for late renewal without surcharge mentioned in „(e)“ above is deducted from the six month period to determine the remaining period for late renewal with surcharge, whereas for Spain the six month period for late renewal with surcharge is additional to the one month period mentioned in „(e)“ above (indeed, in Spain there are even further possibilities for late renewal with surcharge, beyond this six month grace period);

(h) in Italy, Luxembourg, the Netherlands, and Switzerland, the surcharge for late renewal is a fixed sum; in some other countries it is a fixed percentage (20% in Austria and Denmark, 10% in Germany, and 50% in Portugal) of the renewal fee; in Belgium and France, the surcharge varies with renewal year; whilst in Ireland, Spain and the United Kingdom, the surcharge varies according to how late the renewal payment is;

(i) a reminder or some other indication of non-payment is sent in Austria, Denmark, Finland, Greece, Ireland, the Netherlands, Portugal, Sweden, Switzerland and the United Kingdom, but not for Belgium, Italy or Luxembourg; such reminders may be sent abroad for the United Kingdom, but not for Austria, Denmark, Finland, and Greece; such reminders appear to be discretionary in Greece and Finland; the timing of the reminder is approximately 1 month after the due date in

Austria and Sweden, 2-4 weeks after the due date in Denmark, one month before the expiry of the period of grace for Finland and Greece, approximately 10 weeks before the expiry of the period of grace in Switzerland, and within six weeks of the due date for Ireland and the United Kingdom; the Netherlands sends reminders every month during the grace period;

(j) the appointment of a national professional representative is required for the payment of fees in Portugal and Spain, and for the communication of a reminder of non-payment of renewal fees in Austria and Sweden, but not for most other countries.

3. Proposed Solution

There is no justification for the myriad of inconsistencies and discrepancies outlined above, which probably arise simply from historical accident. Such complications impose significant expense on patentees, whilst providing quite negligible benefit to the public, and the situation will deteriorate still further as additional countries sign up to the EPC. It would therefore be highly expedient to focus cost reduction and harmonisation efforts on these grant and post-grant procedures. In particular, it is proposed that the following procedures should be adopted for filing translations and for the payment of renewal fees:

A) Procedure for filing translations

(i) The applicant indicates to the EPO those states in which the grant is to be effective (default all), and possibly makes a single fee payment to the EPO (which may be dependent on the number of indicated states). Of course, this process could be simply integrated into the current grant procedure, for example included with the payments under Rule 51(6) EPC, or even subsumed into the existing designation and grant fees.

(ii) The applicant files all translations necessary for the indicated states directly with the EPO by a preset time limit. There is a single set of format requirements for the translations and drawings. All certification and other analogous requirements for the translation should preferably be abolished, since these produce minimal (probably no) benefit²; at most one might consider some European accreditation or registration scheme for competent translators, whereby any translation prepared by such a translator would be considered acceptable.

(iii) The EPO then advises the national offices of each granted patent pertinent to their country, and supplies a copy of the relevant translation, plus share of fees (as appropriate). This communication could typically be done periodically (eg on a monthly basis, for all the

patents processed in the relevant period), and preferably using electronic transmission means.

B) For paying renewal fees

(i) The EPO sends the patentee an annual reminder of the renewal fee due for a patent, including a list of countries in which the patent is valid - again, the renewal fee might be dependent on the number of countries involved.

(ii) The patentee makes a single payment to the EPO for the renewal fee. The patentee may of course opt to only renew the patent in selected countries.

(iii) The EPO informs the national offices of the renewal status of the patent, and transfers to them an appropriate share of the renewal fee. Again this could be done electronically and on a periodic basis.

Note that removing most of the burden of renewal fee work from the national offices would justify alteration of the distribution key in favour of the EPO. This in turn could be used to finance general fee reductions by the EPO.

4. Discussion

Obviously the above proposals are presented in outline only, and need to be fleshed out in much greater detail, but this should not be unduly difficult. Such measures could probably be introduced without any revision of the EPC itself (especially if the centralised filing of translations and payment of renewal fees was made discretionary for the applicant).

A key aspect of the proposals is to allow a single European authorised representative to be responsible for routine grant and post-grant procedures, obviating the need to automatically appoint a different national professional representative for each designated state. I believe that this is desirable both in principle, as a facet of the Single Market, and also more importantly from a practical point of view, since it will substantially reduce costs for the patentee. Indeed the savings from the proposals over the lifetime of a patent are likely to be comparable with (and perhaps significantly greater than) any saving from not having to file translations. Admittedly national representatives will still be required for non-routine patent procedures, such as infringement suits, revocation proceedings, and so on, but such procedures only arise for a small minority of patents.

Of course, it must be recognised that many countries do already allow the direct payment of renewal fees without recourse to a national professional representative. However, few patentees are able to benefit from this situation, given the lack of a common legal framework for such payments as high-lighted above, and due to the need for payments in national currencies. This is particularly the case given the potentially very serious consequences should a renewal be missed. In addition, specialised patent renewal firms can also be used, such as Computer Patent Annuities (see <http://www.cpajersey.com/welcome.htm>), to simplify matters for a paten-

² There is admittedly a certain coherence in the approach of the Netherlands which treats the EPO text as authentic, and therefore might view certification as a desirable legal safeguard; the approach followed by most other EPO states is to treat the translation as authentic where narrower than the EPO text - this may be more appropriate if certification is abolished.

tee. However, such organisations effectively represent yet another level of complexity en route from the patentee to the national patent offices, and this must have adverse cost implications which would be avoided if, as proposed, the patentee could make a single direct payment to the EPO.

The centralised filing of renewal fees (and possibly translations) described above would of course be a natural part of any Community Patent. However, despite the recent Green Paper from the Commission, it remains unclear whether a Community Patent will be implemented, and if so, on what timescale. Certainly, this can be no excuse for failing to optimise the present European patent system. On the contrary, the Green Paper represents an ideal catalyst for the harmonisation described in this paper, which might be achieved very effectively by a suitable Community regulation.

5. Conclusion

To summarise therefore, the grant and post-grant phases of a European patent are currently subject to a complex and highly inconsistent set of national regulations. There is no underlying justification for this situation, which greatly increases the costs of acquiring and maintaining patent protection in Europe. Harmonisation and centralisation of this activity, such as proposed above for the filing of translations and the payment of renewal fees, have the potential to save European industry a very significant amount of money.

(PS Since writing the original version of this paper, I have learnt that the centralised filing of translations has also been suggested by the EPO to the Administrative Council as one possible measure to reduce costs, although I do not know the outcome of these discussions).

Survey on the Appropriate Demand for Future European Patent Translations

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Abstract

To create clarity as to which patent translations inventors in Europe actually need – and are prepared to pay for – a survey has been carried out among 3504 applicants for European patents. An overwhelming majority (78%) of the 756 responding applicants wants that no translation of the granted European patent is required except for litigation purposes. An enhanced abstract in English should be published together with the patent application. Even the individual inventors and SMEs opted for abolishing of the requirement for translation of the granted European patent with an overwhelming majority of 80%.

Introduction

"Promoting innovation through patents" is the motto of the "Green Paper on the Community patent and the patent system in Europe", presented by the European Commission on 24 June 1997. The Commission has recognized that "innovation is vital for the viability and success of a modern economy" and that "patents play a central role among the different instruments available for protecting innovation". The patent system in Europe has a serious disadvantage compared with those of the U.S. and Japan – high costs. One major cause of the high costs is the translation requirement of the current law.

Patents promote innovation in two respects. First, the prospect of patent protection motivates invention; and,

secondly, third-party patents motivate potential inventors (the term inventor as used herein encompasses their employers as well) to search for even better solutions. In general, inventors construct their inventive solutions on the basis of the knowledge of inventions made by others. To acquire this knowledge, inventors read, for example, published patent applications and patents or abstracts thereof in their field, in some instances in foreign languages or in the form of translations. Inventors are therefore well able to judge which patent translations they need. In my view it is only right that the requirement of patent translations be decided on the basis of the needs of the inventors, since they are the ones who have to pay for the patent translations and it is the inventors who create innovation. Those, however, who only wish to design around the inventions of others should not be put in a better position vis-à-vis patent translations than the inventors.

The high translation costs, which deter many inventors, are in my view based on a fundamental misunderstanding on the part of the politicians who are responsible for the law as it stands. Counselling by interest groups, the politicians probably thought that inventors wanted European patents to be translated into the language of every designated Member State of the European Patent Convention (EPC) – and were ready to pay for the privilege. The advantage of some of the inventors, as readers of patents of others, of being able to study these patents in their own language means a disproportionately high cost penalty for inventors in the "home country" of Europe. This cost penalty leads

to a considerable disadvantage compared with U.S. and Japanese inventors – who do not have to pay for translations to enjoy patent protection in their home country – and a considerable obstacle to innovation in Europe.

To create clarity as to which patent translations inventors in Europe actually need – and are prepared to pay for – a survey has been carried out among about 3,500 applicants for European patents.

The questionnaire

The questionnaire used in the survey (see Annex) was designed with the emphasis on it being easy to answer; only one box had to be marked. The questionnaire offered 6 choices with regard to the amount of translation required, namely the status quo and 5 alternatives. The first 4 alternatives successively add “translation features”. The fifth alternative is the so-called “package solution” proposed by the European Patent Office (EPO). The respondent was invited to decide among the choices he or she was presented with as to which was the right compromise in his or her view between low translation costs on the one hand and adequate information about third-party patent applications and patents on the other.

The *first alternative* involves English, French or German as language of the proceedings and claims at grant in English, French and German; no further translations are required, except for litigation purposes. The first alternative thus corresponds to the possibility envisaged in Art. 65 EPC that no EPC Member State prescribes a translation of the granted patent. Today, almost all EPC Member States prescribe a translation of the granted patent. This translation requirement has been in force for the United Kingdom since 1 September 1987, and for Germany since 1 June, 1992 (but as yet has not been invoked by Luxembourg and Monaco). To my knowledge, there were no complaints in the period from the opening of the EPO in 1978 to 1987 in the United Kingdom and to 1992 in Germany when there were no, respectively, English and German translations of European patents. The readers of European patents in the United Kingdom and in Germany were evidently content with the granted *claims* being published in English, French and German.

The *second alternative* adds to the features of the first alternative an enhanced abstract in English. The enhanced abstract is published together with the patent *application* or as soon as possible thereafter. At present, an abstract prepared by the applicant in the language of the proceedings is published together with the patent application. The variable quality of existing abstracts has been the frequent target of criticism. The EPO therefore suggested an enhanced abstract for information and documentation purposes. It would probably be best – especially from the point of view of minimizing the costs – for the EPO to arrange to have a specialist abstract service, for example Derwent, prepare abstracts of high and uniform quality as an information product completely detached from the granting procedure. Der-

went has in any case been successfully preparing such abstracts for subscribers for many years. If the EPO agrees confidentiality with the abstract service until the corresponding patent applications are published, the abstract service should be able to prepare the abstracts in sufficient time for them to be published together with the patent applications. Such proposals have already been discussed in the EPO.

In order that PCT applications which designate Europe (Euro-PCT) may be published together with the enhanced abstract, the intention is to come to a similar agreement between the abstract service, the WIPO and the EPO; if the costs for preparing the enhanced abstract of Euro-PCT applications cannot be fully financed from PCT fees, the EPO would have to take over all or some of the financing, even though some of the Euro-PCT applications are never European-phased. Should such an agreement with WIPO not come about, the enhanced abstract would only be published about 33 months after the priority date in the case of Euro-PCT applications pursuant to chapter II.

The second alternative could be of interest to those who are able to read English and wish to acquire early information about European patent applications without availing themselves of Derwent's existing services.

The *third alternative* adds three features to the second alternative. First, that the enhanced abstract also be published in French and German. Secondly, that the patent application – if the language of the proceedings is not already English – be published in a full English translation at the same time as the enhanced abstract. The third feature of “translation on demand” will be explained below.

This feature was included out of consideration for those readers of patents who are unable to read English. Any legal person headquartered or resident in an EPC Member State in which English is not an official language may, after grant of a European patent, ask the proprietor of the patent to supply a full translation of the patent into an official language of the same EPC Member State, the proprietor being free to choose the language. If, for example, a Swiss company requests a translation, the patentee need supply the translation into French, German or Italian only if the language of proceedings was English. If the requester does not receive the translation within a set period, for example within 6 weeks, from the receipt of the request, then the requester is entitled to use the invention protected by the patent without consent of the patentee in the State in which the requester is headquartered or resident. The requester is then in a similar position to that of a prior user. The right to consent-free use is only transferable with the entire operation. Since it can be a nuisance for the patentee to send translations to requesters in due time, it is provided that the patentee sends translations of the patent to the EPO. The EPO publishes such translations as quickly as possible, for example on CD-ROM. After publication, translations can be requested from the patentee only from those EPC Member States in which none of the languages of the EPO-published translations (including English) is an official language.

The fourth alternative adds translations of the granted claims into an official language of each of the designated States where protection is desired. The translations are submitted to the EPO and are published together with the patent in the language of the proceedings. Any potentially affected competitor can then read the claims in an official language of his State and consider whether he would be infringing. Only if the claims are unclear, does he have to use the description to interpret the claims (Art. 69 EPC and Protocol on the Interpretation of Art. 69). In such a case, he can arrange for a translation himself, or request it from the patentee, or seek learned counsel from a patent attorney conversant in the three official languages of the EPO. The published English translation of the patent application can be of assistance to the patent attorney. Only the text in the language of the proceedings is the authentic text (Art. 70 (1) EPC).

The *fifth alternative* is the so-called "package solution" proposed by the EPO. It does not build on alternatives 1 to 4. It possesses neither the feature of full translation of the patent application into English nor the feature of translation on demand. The fifth alternative involves an enhanced abstract of the patent application and its translation into an official language of each designated State. At grant, translations of the claims into an official language of each of the designated States where protection is desired has to be filed with the EPO. Other translations are required only for litigation purposes. Compared with the status quo, the package solution offers early multilingual information in the enhanced abstract and, at grant, reduces the need for translation to the claims.

The *sixth choice* in the questionnaire is the status quo: translation of the granted claims from the language of the proceedings into the two other official languages and full translation of the patent at grant into an official language of each of the designated States where protection is desired. The full translations are filed with the national patent offices.

The letter accompanying the questionnaire informed the reader of the prospect that the European Union will have initially 5 and later a further 10 new Member States. A calculation sheet attached to the questionnaire assumes 16 or 25 languages in the case of 20 or 30 Member States, respectively. The calculations took account of the translation costs only. If, as in the status quo, the translations have to be supplied to the national patent offices, there will be appreciable further costs for patent attorneys and national fees. The calculation sheet is primarily intended to allow a comparison of the cost elements of the alternatives in relative terms.

Details of the practical aspects of the survey and of the analysis

The questionnaire was sent out to all patent applicants headquartered or resident in an EPC Member State whose patent applications had a first European publication date within a certain period, namely from 1 April to 30 June 1997, according to ESPACE Bulletin Vol. 1997/

004. In the case of Euro-PCT applications, the international publication date (printed on the WIPO-PCT pamphlet) is not identical with the first European publication date; the latter comes after commencement of the regional phase.

In those cases in which a patent application was filed by joint applicants, the questionnaire was sent only to the first applicant named as headquartered or resident in an EPC Member State.

This produced a total of 3,565 applicants responsible for 7,673 patent applications.

To minimize any language problems, these 3,565 applicants were written to in the 6 languages which, according to the qualifying patent applications and patent applicants, are the most frequent: English for applicants in Denmark (68), Finland (82), Greece (3), Ireland (22), Portugal (2), Spain (72) and the United Kingdom (467); French for applicants in Belgium (25), France (539), Luxembourg (13), Monaco (1) and Switzerland (47); German for applicants in Austria (86), Germany (1,192), Liechtenstein (13) and Switzerland (165); Italian for applicants in Italy (360) and in Switzerland (8); Dutch for applicants in Belgium (41) and in the Netherlands (191); and Swedish for applicants in Sweden (168). The English version of the letter is reproduced in the Annex.

The English and German versions were posted in the period from 1 to 4 September 1997, asking for the questionnaire to be returned by 29 September 1997. The English version for Spain, however, was sent only on 10 September 1997, requesting the return by 2 October 1997. The other versions were dispatched in the period from 9 to 12 September with return dates of 2 October 1997 for Belgium (Dutch version), the Netherlands and Sweden and 6 October 1997 for Belgium (French version), France, Italy, Luxembourg, Monaco and Switzerland (French and Italian versions).

61 of the 3,565 letters were returned as undeliverable. Applicants (and similarly their applications) with undeliverable addresses are hereinafter treated as though they had never been contacted, i.e. they do not belong to the 3504 "surveyed applicants" (with 7606 applications). The questionnaire and accompanying letter had asked expressly that only one of the choices be marked. Therefore, those 5 questionnaires in which no box or more than one box was marked were ignored for the purposes of analysis; photocopied questionnaires filled in by companies which had not been contacted for participation in the survey – companies, for example, affiliated to applicants which were contacted – were likewise disregarded; these questionnaires are not included among the "analysable questionnaires". Thus, only those questionnaires were considered which came from applicants who had in fact been contacted for the survey.

The choice marked in the "analysable questionnaires" was matched to each qualifying application of the "surveyed applicant". In this way it was possible to analyse both with respect to applications and with respect to applicants. To calculate the percentage rate of return for analyses based on applications (tables marked "A"), the number of relevant applications was taken

as base. To calculate the percentage return rate in the case of analyses relating to applicants (tables marked "B"), on the other hand, the number of relevant "surveyed applicants" was taken as base. The percentage figures as shown are rounded off or up; however, when they are added, only the sum is rounded off or up; thus, adding the corresponding percentage figures as shown does not necessarily amount to 100 (%).

No questionnaires were returned from Greece, Luxembourg, Monaco and Portugal.

The following Table 1 shows the figures of surveyed applications and applicants and the figures of considered applications and applicants and the respective return rates.

Table 1 Surveyed applications and applicants

States	undeliverable letters	Applications (A)			Applicants (B)		
		surveyed	considered	Return rate	surveyed	considered	Return rate
Austria	1	113	28	24,8%	85	21	24,7%
Belgium	1	156	81	51,9%	65	19	29,2%
Denmark	1	106	18	17,0%	67	13	19,4%
Finland	0	192	16	8,3%	82	14	17,1%
France	15	1222	123	10,1%	524	54	10,3%
Germany	24	3001	1421	47,4%	1168	370	31,7%
Greece	0	3	0	0,0%	3	0	0,0%
Ireland	0	25	1	4,0%	22	1	4,5%
Italy	3	556	103	18,5%	357	44	12,3%
Liechtenstein	0	28	3	10,7%	13	3	23,1%
Luxembourg	0	17	0	0,0%	13	0	0,0%
Monaco	0	1	0	0,0%	1	0	0,0%
Netherlands	6	481	212	44,1%	185	42	22,7%
Portugal	0	2	0	0,0%	2	0	0,0%
Spain	1	76	5	6,6%	71	5	7,0%
Sweden	1	333	66	19,8%	167	37	22,2%
Switzerland	4	480	203	42,3%	216	59	27,3%
United Kingdom	4	814	180	22,1%	463	74	16,0%

Results of the survey

The most important re_sults can be read off Tables 2 A and 2 B and the graphs A and B.

Table 2A: Alternatives chosen grouped according to State
 applications surveyed: **7606** applications considered: **2460**

States	Alternatives										Status quo		Return Rate
	1		2		3		4		5				
Austria	9	32%	16	57%	3	11%	0	0%	0	0%	0	0%	24,8%
Belgium	66	81%	12	15%	2	2%	0	0%	1	1%	0	0%	51,9%
Denmark	2	11%	9	50%	6	33%	0	0%	1	6%	0	0%	17,0%
Finland	3	19%	5	31%	5	31%	1	6%	0	0%	2	13%	8,3%
France	44	36%	31	25%	21	17%	22	18%	4	3%	1	1%	10,1%
Germany	773	54%	495	35%	99	7%	3	0%	51	4%	0	0%	47,4%
Greece	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0,0%
Ireland	0	0%	1	100%	0	0%	0	0%	0	0%	0	0%	4,0%
Italy	24	23%	19	18%	22	21%	36	35%	2	2%	0	0%	18,5%
Liechtenstein	0	0%	2	67%	1	33%	0	0%	0	0%	0	0%	10,7%
Luxembourg	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0,0%
Monaco	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0,0%
Netherlands	168	79%	22	10%	9	4%	0	0%	5	2%	8	4%	44,1%
Portugal	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0,0%
Spain	0	0%	3	60%	1	20%	0	0%	0	0%	1	20%	6,6%
Sweden	25	38%	29	44%	7	11%	0	0%	5	8%	0	0%	19,8%
Switzerland	128	63%	33	16%	11	5%	0	0%	31	15%	0	0%	42,3%
United Kingdom	87	48%	67	37%	20	11%	1	1%	5	3%	0	0%	22,1%
Total	1329	54%	744	30%	207	8%	63	3%	105	4%	12	0%	32,3%

Graph A: Alternatives chosen based on applications

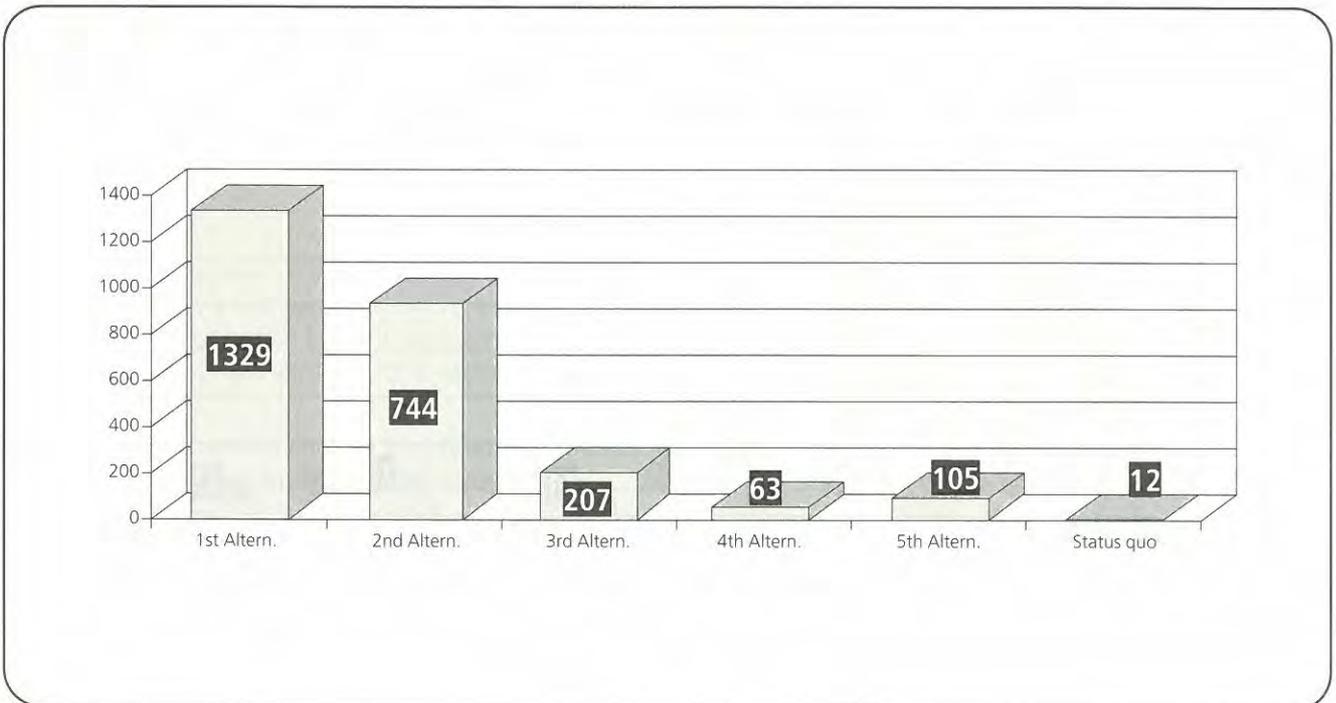


Table 2B: Alternatives chosen grouped according to State
 applicants surveyed: **3504** applicants considered: **756**

States	Alternatives										Status quo	Return Rate	
	1		2		3		4		5				
Austria	7	33%	11	52%	3	14%	0	0%	0	0%	0	0%	24,7%
Belgium	11	58%	5	26%	2	11%	0	0%	1	5%	0	0%	29,2%
Denmark	2	15%	7	54%	3	23%	0	0%	1	8%	0	0%	19,4%
Finland	3	21%	3	21%	5	36%	1	7%	0	0%	2	14%	17,1%
France	14	26%	20	37%	14	26%	3	6%	2	4%	1	2%	10,3%
Germany	159	43%	154	42%	41	11%	2	1%	14	4%	0	0%	31,7%
Greece	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0,0%
Ireland	0	0%	1	100%	0	0%	0	0%	0	0%	0	0%	4,5%
Italy	12	27%	15	34%	11	25%	4	9%	2	5%	0	0%	12,3%
Liechtenstein	0	0%	2	67%	1	33%	0	0%	0	0%	0	0%	23,1%
Luxembourg	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0,0%
Monaco	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0,0%
Netherlands	10	24%	16	38%	6	14%	0	0%	2	5%	8	19%	22,7%
Portugal	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0,0%
Spain	0	0%	3	60%	1	20%	0	0%	0	0%	1	20%	7,0%
Sweden	13	35%	16	43%	7	19%	0	0%	1	3%	0	0%	22,2%
Switzerland	27	46%	21	36%	8	14%	0	0%	3	5%	0	0%	27,3%
United Kingdom	27	36%	34	46%	10	14%	1	1%	2	3%	0	0%	16,0%

Graph B: Alternatives chosen based on applicants

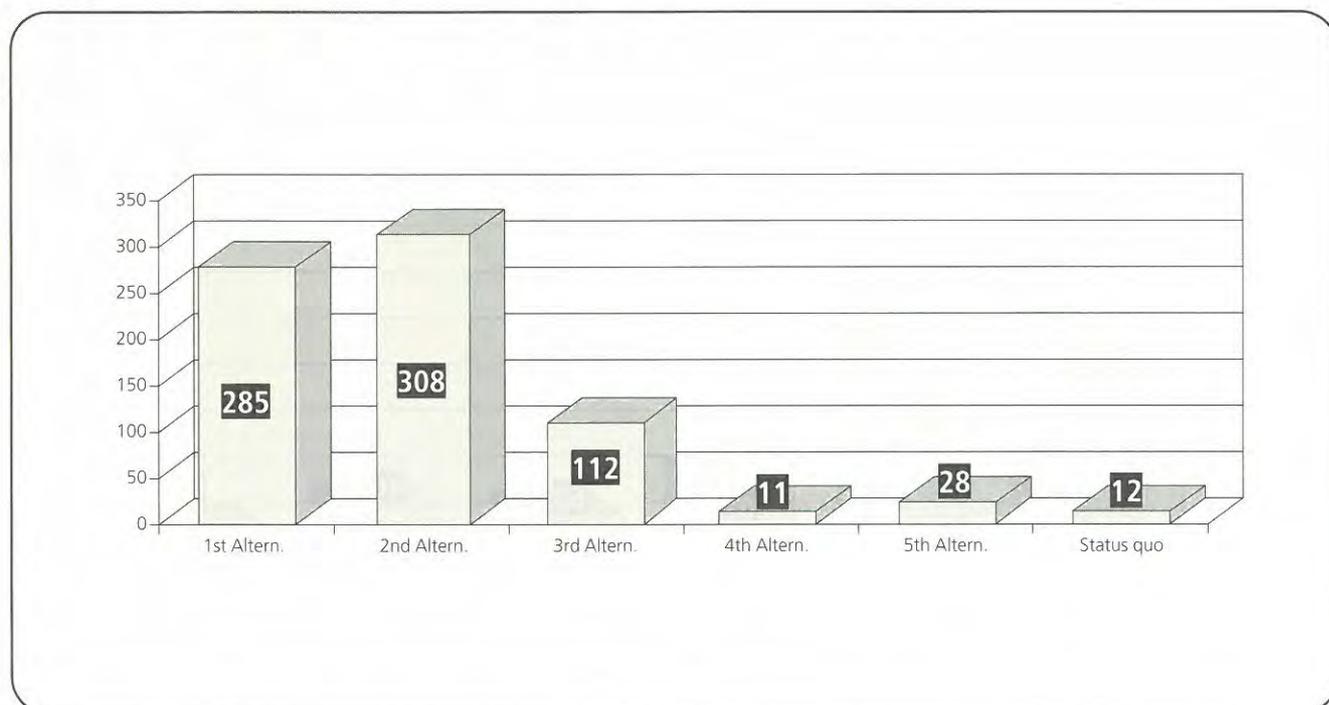


Table 3 shows differences between industries. The qualifying applications were divided into three groups in accordance with the International Patent Classification (IPC):

- chemical: section C including A61K
- electrical: section H
- remainder: all other technical fields

Table 3: Alternatives chosen grouped according to technical field
applications surveyed: 7606 applications considered: 2460

Technical field	Alternatives										Status quo		Return Rate
	1		2		3		4		5				
chemical	277	47%	232	40%	24	4%	4	1%	46	8%	1	0%	37,9%
electrical	331	71%	71	15%	28	6%	26	6%	8	2%	0	0%	40,2%
remainder	721	51%	441	31%	155	11%	33	2%	51	4%	11	1%	28,7%

Tables 4 A and 4 B suggest differences according to how many applications by an applicant had a first European publication date in the second quarter of 1997.

Table 4A: Alternatives chosen grouped according to applicants' number of applications
applications surveyed: 7606 applications considered: 2460

Groups	Alternatives										Status quo		Return Rate
	1		2		3		4		5				
1	174	36%	213	44%	77	16%	7	1%	12	2%	2	0%	18,3%
2 to 5	215	40%	209	38%	79	15%	5	1%	33	6%	2	0%	30,7%
6 to 10	171	63%	65	24%	20	7%	0	0%	7	3%	8	3%	33,8%
more than 10	769	66%	257	22%	32	3%	61	5%	53	5%	0	0%	49,9%

Table 4B: Alternatives chosen by applicants grouped according to their number of applications
applications surveyed: 3504 applicants considered: 756

Groups	Alternatives										Status quo		Return Rate
	1		2		3		4		5				
1	174	36%	213	44%	77	16%	7	1%	12	2%	2	0%	18,3%
2 to 5	73	38%	76	39%	30	15%	2	1%	12	6%	1	1%	29,3%
6 to 10	22	61%	9	25%	3	8%	0	0%	1	3%	1	3%	34,0%
more than 10	16	48%	10	30%	2	6%	2	6%	3	9%	0	0%	39,3%

Table 5 shows the alternatives chosen by the individual inventors, i.e. those applicants whose names consist of a surname followed by a first name (according to ESPACE Bulletin) without any indication of a firm like a company, corporation, society or institution. Each of the individual inventors considered in this survey has only one surveyed application, except one individual inventor with 2 applications and two individual inventors with 7 applications each.

Table 5: Alternatives chosen by individual inventors
individual inventors surveyed: 675 individual inventors considered: 86

1	Alternatives										Status quo		Return Rate
	2		3		4		5						
44	51%	30	35%	9	10%	1	1%	2	2%	0	0%	12,7%	

Table 6 shows figures for alternatives 1 and 2 from Tables 2A and 2B for those States from which fewer applications originate.

Table 6: Options of alternatives 1 and 2 in States from which fewer applications originate

States	Based on applications (A)						Based on applicants (B)					
	1		2		1+2		1		2		1+2	
Austria	9	32%	16	57%	25	89%	7	33%	11	52%	18	86%
Belgium	66	81%	12	15%	78	96%	11	58%	5	26%	16	84%
Denmark	2	11%	9	50%	11	61%	2	15%	7	54%	9	69%
Finland	3	19%	5	31%	8	50%	3	21%	3	21%	6	43%
Greece	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%
Ireland	0	0%	1	100%	1	100%	0	0%	1	100%	1	100%
Liechtenstein	0	0%	2	67%	2	67%	0	0%	2	67%	2	67%
Luxembourg	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%
Monaco	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%
Portugal	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%
Spain	0	0%	3	60%	3	60%	0	0%	3	60%	3	60%
Total	80	53%	48	32%	128	84%	23	30%	32	42%	55	72%

Discussion of results

The surveyed patent applicants have decided with an overwhelming majority in favour of alternatives 1 and 2. The sum totals of the responses in favour of the two alternatives were:

- 84% based on applications
- 78% based on applicants
- 87% based on chemical applications
- 87% based on electrical applications
- 82% based on the remaining applications
- 80% based on the group "1 qualifying application per applicant" (A)
- 80% based on the group "applicant with 1 qualifying application" (B)
- 78% based on the group "2 to 5 qualifying applications per applicant" (A)
- 77% based on the group "applicant with 2 to 5 qualifying applications" (B)
- 87% based on the group "6 to 10 qualifying applications per applicant" (A)
- 86% based on the group "applicant with 6 to 10 qualifying applications" (B)
- 88% based on the group "more than 10 qualifying applications per applicant" (A)
- 79% based on the group "applicant with more than 10 qualifying applications" (B)
- 86% based on individual inventors
- 84% based on applications from States from which fewer applications originate (A)
- 72% based on applicants in States from which fewer applications originate (B)

The foregoing sum totals do not reveal any serious differences. More particularly, even the applicants with only 1 qualifying application (very likely the individual inventors

and the SMEs) opted for alternatives 1 and 2 with an overwhelming majority (80%). Specifically, 86% of the individual inventors decided for alternatives 1 and 2. Similarly, even the applicants in the group of States, from which fewer applications originate (Austria, Belgium, Denmark, Finland, Greece, Ireland, Liechtenstein, Luxembourg, Monaco, Portugal and Spain), opted for alternatives 1 and 2 with an overwhelming majority of 72% (or 84% based on applications). This percentage is meaningful for the group of States; the returns from a few of those States were so low that these few percentages of individual States would not be meaningful.

As mentioned above, the additional feature of the second alternative compared with the first alternative is the enhanced abstract in the English language, which is likely to be cheaply available from Derwent, for example, especially if Derwent is allowed to publish the enhanced abstract in the Derwent information services at the same time as the EPO. The costs could probably be met by the EPO without existing fees having to be increased. Under the second alternative, the extraordinary cut in the cost of patents will mean that the number of European patent applications will increase to such an extent that the EPO can achieve considerable economies of scale. Those who prefer the first alternative to the second – and thus did not attach any importance to the enhanced abstract – probably have sufficiently good foreign-language skills so as to be able to cope with the patent applications published in one of the three official languages, English, French or German, or they are subscribers to the English-language Derwent services and are prepared to accept a delay of some weeks before being informed about newly published patent applications. If

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Table 7: Languages chosen grouped to Stated applications surveyed 7607

State	Language of filing										Language of publication																											
	Da		De		En		Es		Fi		Fr		Gr		It		NI		Sv		nonoffic.		De		En		Fr		Chg. into En									
	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%	0	%		
AT	0	0%	107	95%	6	5%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	107	95%	6	5%	0	0%	0	0%	0	0%	0	0%		
BE	0	0%	8	5%	92	59%	0	0%	0	0%	34	22%	0	0%	0	0%	4	3%	18	12%	0	0%	0	0%	8	5%	113	72%	35	22%	21	14%	21	14%	21	14%		
CH	0	0%	303	63%	115	24%	0	0%	0	0%	55	11%	0	0%	0	0%	5	1%	0	0%	0	0%	2	0%	303	63%	122	25%	55	11%	7	1%	7	1%	7	1%		
DE	0	0%	2915	97%	82	3%	0	0%	0	0%	3	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	2915	97%	83	3%	3	0%	3	0%	1	0%	1	0%		
DK	34	32%	2	2%	70	66%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	2	2%	104	98%	0	0%	0	0%	34	32%	34	32%		
ES	0	0%	1	1%	5	7%	64	84%	0	0%	0	0%	3	4%	0	0%	0	0%	0	0%	0	0%	1	1%	65	86%	1	1%	70	92%	5	7%	65	86%	65	86%		
FI	0	0%	0	0%	107	56%	0	0%	84	44%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	1	1%	85	44%	0	0%	192	100%	0	0%	0	0%	85	44%		
FR	0	0%	24	2%	72	6%	0	0%	0	0%	1124	92%	0	0%	0	0%	2	0%	0	0%	0	0%	0	0%	24	2%	74	6%	1124	92%	2	0%	2	0%	2	0%		
GB	0	0%	6	1%	808	99%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	6	1%	808	99%	0	0%	0	0%	0	0%	0	0%		
GR	0	0%	0	0%	1	33%	0	0%	0	0%	0	0%	2	67%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	3	100%	0	0%	2	67%	2	67%		
IE	0	0%	1	4%	24	96%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	1	4%	24	96%	0	0%	0	0%	0	0%	0	0%		
IT	0	0%	20	4%	262	47%	1	0%	0	0%	0	0%	7	1%	0	0%	266	48%	0	0%	0	0%	0	0%	267	48%	24	4%	525	94%	7	1%	263	48%	263	48%		
LI	0	0%	22	79%	6	21%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	22	79%	6	21%	0	0%	0	0%	0	0%	0	0%		
LU	0	0%	2	12%	11	65%	0	0%	0	0%	4	24%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	2	12%	11	65%	4	24%	4	24%	4	24%	4	24%		
MC	0	0%	0	0%	0	0%	0	0%	0	0%	1	100%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%
NL	0	0%	18	4%	377	78%	0	0%	0	0%	5	1%	0	0%	0	0%	0	0%	81	17%	0	0%	0	0%	18	4%	458	95%	5	1%	81	17%	81	17%	81	17%		
PT	0	0%	1	50%	1	50%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	1	50%	1	50%	0	0%	0	0%	0	0%	0	0%		
SE	1	0%	5	2%	197	59%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	0	0%	130	39%	131	39%	6	2%	327	98%	0	0%	0	0%	130	39%	130	39%		
TOTAL	35	0%	3435	45%	2236	29%	65	1%	84	1%	1236	16%	2	0%	277	4%	99	1%	99	1%	134	2%	696	9%	3440	45%	2927	38%	1239	16%	691	9%	691	9%				

The codes of languages and abbreviations have the following meanings:

Da=Danish, De=German, En=English, ES=Spanish, Fi=Finnish, Fr=French, Gr=Greek, It=Italian, NI=Dutch, Sv=Svedish nonoffic.=applications in other languages than the 3 EPO-official languages

Chg. into En=applications filed in nonofficial languages with a change of languages into English as publication language

the second alternative is realized and the Derwent services provide information some weeks earlier than hitherto, this will probably also satisfy those who chose the first alternative, since there is hardly a significant difference in costs between the two alternatives.

The third alternative, chosen by a small proportion (only 8% based on applications or 15% based on applicants) has three features, as stated, without it being clear how much importance each respondent attaches to each of the three features.

Many commentaries received with the questionnaires pointed out the problematical nature of translation-on-demand. There is an expectation that this feature will lead to frequent abuse. One possibility of abuse could be made impossible by the rule that all affiliated companies are treated as one requester of a translation. If a company has requested a translation, then an affiliated company must not request a translation of the same patent, not even into another language. Other possible abuses will surely be impossible to prevent. It could become very costly for an inventor to draw attention to his or her patent at exhibitions or in periodicals, since he or she is likely to be overwhelmed by requests for translations. It may be impossible to file translations with the EPO in good time because of lack of time or lack of money. A translation will frequently also be requested from the patentee because it is free of charge, unlike a copy of the patent specification. Yet it appears to be impracticable that the requester should pay something to the patentee for the translation. Finally, the prior user position with the restriction to one EU Member State may not be compatible with EU rules governing the free movement of goods. All these reasons and especially the vote of the applicants argue against the feature of translation-on-demand.

If one wanted to take on board one wish of the minority of respondents who opted for the third alternative, this should be, in my view, the feature of the English translation of the application. Many comments received said that, in Europe, English is the most frequently understood language in the field of patents and that most inventors know English, if only to be able to keep up to date through technical periodicals, which are usually in English. Many expressed the wish that, at least in the case of Community patent applications, the language of the proceedings is exclusively English. To my mind, those applicants in whose State English is not an official language should qualify for a fee reduction (similarly to Rule 6 paragraph 3 of the Implementing Regulations to the EPC) when they file the application in English. The preference for English has nothing to do with any disregard for the other two official languages of the EPO, but is the acknowledgement of an incontestable reality, as reflected, for example, in the 41% vote for the second alternative featuring the enhanced abstract in English. The very many subscribers to the English-language Derwent information services are likewise impressive evidence that English is understood very well in the field of patents in Europe. Very many of those opting for the first alternative (38%) are likely to be subscribers to Derwent information services.

The EPO has commendably searched for solutions to reduce translation costs. For example, the proposed "package solution" was reported at length to the Standing Advisory Committee before the European Patent Office (SACEPO) on 2 November 1995. It has been pointed out that the translations of granted patents hitherto filed with the national patent offices are consulted very rarely in some States.

The first president of the EPO and past president of the Dutch Patent Office, Dr. *J.B. van Benthem*, had in essence this to say about the language issue in 1992 (*Mitteilungen der deutschen Patentanwälte* 1993, 151 to 156, especially 153/154): The three official languages of the EPO are fully sufficient for the needs of the patent Community, i.e. all those who are concerned with patents. This is because this patent Community, in the wake of a patent-aware world of industry and commerce, has long been international and hence good at languages. In the first years of the European patent system, the patent Community in some Contracting States coped well with the fact that there was no prescription that European patent specifications had to be translated into the language of a particular country. There were few problems and protests in this respect. The reasons for the prescription of translation have only little to do with the needs of the users of the European patent system, but everything with national political and other interests. The national translation requirements lead to a doubling of the costs for obtaining a European patent. Consequently, however, the national interests of the Contracting States have won out over the interests of the European patent system to such an extent that this system now finds itself in a precarious position. This is because it has now become too expensive for a large proportion of the SMEs, with the consequence that they are denied access to the central European patent-granting process. And all that for interests which may have their justification in the cultural and perhaps also in the political sphere, but no longer in the economic sphere, where the chief criterion should be the practical needs of industry. By importing the political-cultural language problem into the European patent system, the Contracting States have pushed a problem into the field of industry where it does not belong. They have gone far beyond the goal of preserving national cultural identity. That this should endanger the European patent system in particular is, in the opinion of *van Benthem*, a matter which touches directly upon the question of European integration in the Community.

Eugen Stohr (a lawyer in the international legal affairs directorate of the EPO) writes in essence in similar terms in *Mitteilungen der deutschen Patentanwälte* 1993, 156 to 161, especially 158/159: The practice of the Contracting States of demanding a translation of the granted patent under Art. 65 EPC could become the Achilles' heel of the European patent system. SMEs find themselves in the curious position that it is especially the translation requirements introduced by the Contracting States while citing the interests of SMEs which, today, are an increasing obstacle to their use of the European patent system from the aspect of costs. Since only a van-

ishingly small proportion of all European patents become the subject of infringement proceedings, this cannot at any rate justify the requirements of a general filing of a translation of the European patent specification. Since the translation of the European patent specification plays at most a minor role in the determination of the relevant state of the art, it is questionable whether the need to build up appropriate national documentations or data bases is sufficient to justify the costs which the European patent applicant faces.

Similarly, the present president of the EPO, *Ingo Kober*, is said by the *Sddeutsche Zeitung* of 2.7.1997 (quoted in *Neue Juristische Wochenschrift* 1997, No. 39, page XLIV) to have warned that an expansion of the EU into Central and Eastern Europe calls the present patent system into question. This is because, he is quoted as saying, the associated inevitable increase in the number of languages has the consequence that the costs for patents in Europe are going to shoot up. Even now, according to *Kober*, translations into six languages account for 37% (DM 22,500) of the total costs of almost DM 60,000 for a European patent. The arithmetic arising out of an expansion of EU membership is very simple: Should the Union one day have thirty Member States, the patent costs would increase to two and a half times the present value – DM 150,000 or so, that is – and a colossal DM 100,000 would be accounted for by translations alone. *Kober* stated that such a “cost explosion” is beyond the financial escape of many SMEs – so that these companies can no longer afford a patent application. (These figures take into account not just the pure translation costs, but also professional and official fees for filing with the national patent offices.)

The voices reported here show that, in the EPO and its environs, the need has been recognized to reduce existing translation requirements. The direction is clear, but not yet the exact goal.

The package solution was offered as the fifth alternative in the questionnaire, but was chosen only rarely (4%). Evidently, the cost-benefit ratio of the features of the package solution appears to be too unfavourable. Although the package solution affords significant cost savings compared with the status quo, it is clear from the responses to the survey that almost all applicants (96%) do not want the package solution if other alternatives are available.

78% of applicants want much less translation than hitherto, namely only the features of the first and second alternatives. It is time the politicians recognised this fact and stopped following other interest groups who try to argue that more translation is good for the patent system because they gain economic benefits from more translation. All of us and the politicians, too, want to promote innovation in Europe. Let us thus lift an unnecessary burden from the shoulders of inventors and free them from translations which they do not need and do not want to pay for.

This survey is very meaningful. The respondents were not selected. Rather, the questionnaire was sent to every applicant headquartered or resident in an EPC state with an application having a first European publication date in

the second quarter of 1997. This ensures that the EPC states are represented in proportion to their actual filing activity. The total return rate of 32,3% based on applications and 21,6% based on applicants is considerable, if it is taken into account that at least an hour's effort is required to read the accompanying letter carefully and to make a choice. The results are highly significant. They unmistakably represent the opinion of the innovators – who need an economical patent system.

Many patent attorneys rightly see their main function in providing legal advice to their clients and not in being translators. Many also take the view that the translation requirement should be reduced in order that their clients may afford patent protection more frequently. However, there are some patent attorneys who want to keep as much translation as possible. Frequently, they put forward other reasons, such as legal certainty and protection of the public; sometimes, they also admit their own economic interest. As to legal certainty, it has to be pointed out again that only patent experts are able to interpret the scope of protection conferred by patents and that – if the claims are not clear – it is solely the language of the proceedings which is the authentic language for interpreting the claims of European patents. The legal function of patent attorneys is thus not restricted by less translation. Because of the likely increase in the number of patents, which are then less costly, the demand for legal advice will in fact increase. As to the protection of the public, it has to be said that patents are read primarily by (potential) inventors who are evidently well satisfied with the features of the first and second alternatives. As mentioned in the introduction, those who merely want to design around the inventions of others should not be put in a better position vis-à-vis patent translations than the inventors. After all, it is innovation which is to be promoted in Europe.

Individual patent attorneys in States with few applicants argue they need a lot of translation for economic reasons, because otherwise they would no longer be able to offer legal advice. The giving of legal advice requires experience. This experience cannot be gained through translating. If a patentee wishes to take action against an infringer of his patent, he will try to institute proceedings in that State and before that court and with those attorneys with the most experience. It does not fit in with the promotion of innovation in Europe to burden applicants with costs in order that patent attorneys be kept afloat with translation work. Applicants will be able to enforce their rights without such patent attorneys.

In some countries, such as France, constitutional arguments are put forward against the abolition of general translations of the entire patent or only of the claims (see, for example, J.J. Martin in *epi Information* 1/1997, 33 to 35, “La langue de la République est le français”, Art. 2 of the French constitution). If these arguments were truly plausible, it would be necessary to amend the constitution so that patents would not have to be translated until needed to enforce rights. It has to be in the interests of all parliamentarians to promote innovation in Europe, which includes little translation. It should not be possible in Europe for a few States to

prevent the freeing of inventors from unnecessary burdens by citing constitutional concerns. At any rate, the survey results show that French applicants – in voting predominantly (63%) for the first and second alternatives – do not see any constitutional problems.

The applications surveyed in this survey show an interesting choice of languages, especially with regard to the language of filing according to Article 14 (2) EPC (other than an official language of the EPO) and with regard to the language of publication, see Table 7 in the Annex.

Although French and/or German are official languages in some States, a considerable part of the applications of applicants of these States were filed in English:

Austria	5%
Belgium	59%
France	6%
Germany	3%
Liechtenstein	21%
Luxembourg	65%
Switzerland	24%

Almost all applications which were filed in a language other than English, French or German, have English as the language of publication. Thus, although the applicants of these applications in nonofficial languages could choose French or German as language of publication, they decided for English in 99% of all cases.

These facts, too, show the attraction of English for European applicants.

The present survey with its choice of alternatives was mainly designed to ensure that the wishes of patent applicants in respect of patent translations be better reflected in the EPC. The Green Paper, however, deals not only with possible amendments to the EPC, but also with a new law concerning Community patents. As already mentioned, many applicants expressed their wish (by telephone or in written comments) that the language of the proceedings of Community patent applications be exclusively English (however, the applicant is allowed to file his application in any official language of the EU Member States, provided he files an English translation within a prescribed term, e.g. similar as in Rule 6 (1) of the Implementing Regulations to the EPC). This feature is referred to below as "single language". One principal reason for a single language is that it is politically easier to agree on a single language than on several languages. In addition, the patent costs should be as low as possible. The results of this survey do not contradict the wish for the "single language". To fill

out the questionnaire, one had to opt for one of six choices. Those who chose the first or second alternative, for example, by that choice say only that they favoured these alternatives over the other choices. However, it is perfectly possible that many – even the majority, perhaps – of the voters for the first two alternatives are in favour of the "single language" in a Community patent system. The extent of the desire for a "single language" could be ascertained in a further survey.

Conclusions

The results of the survey suggest the following goals:

The EPC Member States cancel the requirement under Art. 65 EPC whereby granted patents have to be translated. The EPO ensures by agreement with a specialized commercial operator that an enhanced abstract is published in English together with the patent application. A corresponding agreement is sought with WIPO; the costs are borne partly, if necessary wholly, by the EPO.

If a certain amount of consideration is to be given to the minority view, the only possibility is in my view that of the additional translation of a patent application into English. In this context, the filing of the application in English is favoured by a lower fee when the applicant is headquartered or resident in a State in which English is not an official language.

Acknowledgements

The present survey was only possible as a result of the enthusiastic work of the following people: Ms Dagmar Wondrak did all the data processing, in particular the recording of the particulars of the applications, their applicants and their addresses and the preparation of a program to analyse the marked questionnaires and to create the tables. Ms Gerlinde Gemperli printed the various versions of the questionnaire and the accompanying information. She copied, folded and enveloped the many letters together with Ms Ingeborg Diletti and Ms Monika Sommer. Ms Monika Sommer prepared the letters in the Italian, Dutch and French versions, organized the folding, enveloping and despatch of these letters and analysed the returned questionnaires. Dr Herbert Rupp gave many data processing tips and valuable ideas for the design of the survey. I am very grateful to them all and to Byk Gulden for generous support.

Questionnaire

Marked by

Please mark one box only!

With a view to possibly amending the law, the above applicant for European and/or Euro-PCT patent applications is in favour of the marked alternative or the status quo.

The translation costs shown are calculated on the basis of an average European patent for 20 (in brackets, 30) States (DEM = German Marks).

1st alternative 4,560 DEM (4,560 DEM)

- ² Language of the proceedings in one of the three official languages, i.e. English, French or German. Claims at grant in all three official languages. No further translations necessary except for litigation purposes.

2nd alternative 4,810 DEM (4,810 DEM)

- ² In addition to the first alternative, publication, at the same time as publication of the patent application or as soon as possible thereafter, of an enhanced abstract in English.

3rd alternative 13,190 DEM (13,190 DEM)

- ² In addition to the second alternative, publication of an enhanced abstract in French and German as well and, at the same time, publication of a full translation of the patent application into English. Further additional „translation on request“ feature.

4th alternative 23,790 DEM (32,790 DEM)

- ² In addition to the third alternative, translation of the granted claims into an official language of each of the designated States where protection is desired. Supply of the translations to the European Patent Office.

5th alternative 22,060 DEM (34,210 DEM)

- ² The so-called "package solution" proposed by the European Patent Office: Translation of an enhanced abstract of the European patent application into an official language of each designated State. Translation of the claims at grant into an official language of each

Status quo 41,400 DEM (86,440 DEM)

- ² Translation of the granted claims into the three official languages and full translation of the patent at grant into an official language of each of the designated States where protection is desired. Supply of the full Translations to the national patent offices.

Dr. Suchy guarantees that the information contained in the returned questionnaire will remain confidential. The data will be used in anonymus form only.

Technical Board Decision T 958/94: A new perspective for process claims?

T. Beetz (NL)

Among the many decisions by Technical Boards, recent decision T 958/94 (published in OJEPO, 6/1997, pp. 229) stands out. Although the particular case relates to second medical indication claims, the decision reaches far beyond therapeutic fields.

From Enlarged Board decision G 5/83 on, a second or further indication of a known drug may be claimed by using the so-called Swiss format. In conformity herewith, in the present case a claim was worded as:

Use of a dextran derivative (...) to manufacture an agent for inhibiting the growth of tumor cells.

In view of Spain and Greece a second claim was filed, which was worded as:

Process for the manufacture of an agent for inhibiting the growth of tumor cells, characterised in the use of an essential constituent of said agent, of a dextran derivative (...).

This latter claim was refused by the Examining Division on the grounds that it was not in the second medical indication form as stipulated by the Enlarged Board. This decision was set aside by the Board of Appeal, whose main argument was based on the principle that there is no difference between claiming the use of a thing for a certain purpose and a process to achieve the same result using the same thing. Further, reference was made to Board of Appeal decision T 893/90, which was believed to confirm the present opinion. Although the principle of equivalence of process and use claims seems to be general (see also Guidelines C-III, 4.9), this author questions whether an equivalent process claim to the second medical use claim exists.

The process claim as given above seems to be a conventional claim directed to a process, wherein the essential technical feature is the use of a constituent (dextran derivative) in the preparation of an agent. However, because this process was already known for the manufacture of the same agent for another (first) medical use, this logical interpretation does not lead to a claim which is novel. The only reason why this claim can be considered to be novel is to be found in the part "an agent for inhibiting the growth of tumor cells." The addition "for inhibiting the growth of tumor cells" must therefore be construed as a real restriction. This seems to be in conflict with Guidelines C-III, 4.8, which reads "apparatus for carrying out the process must be construed as meaning merely apparatus suitable for carrying out the process." Thus, according to the Guidelines, an agent for inhibiting the growth of tumor cells must be construed as an agent *suitable* for inhibiting the growth of tumor cells.

It may be remarked that the same expression "an agent for inhibiting the growth of tumor cells" also occurs in the Swiss-type use claim. Clearly, this leads to an anomalous situation, wherein the second medical indication claim is an exception to this principle, as the result of decision G 5/83 which reads in point 21: "It is to be clearly understood the application of this special

approach to the derivation of novelty can *only* be applied to claims to the use of substances or compositions intended for use in a method referred to in Article 52(4) EPC." The Enlarged Board realized (points 19–20 of the decision) that the medicament itself, and thus also the method of producing said medicament, is not in any way different from the known medicament. The artificial way of drafting a use claim therefore is the exception. Board of Appeal decision T 893/90 confirms this Enlarged Board decision, in that it follows point 20, which stipulates that when the medicament itself is novel in the sense of having novel technical features, the ordinary requirements of Articles 54 (1) to (4) EPC are met. Such novel features are indeed present in case T 893/90, which medicament has ingredients present in amounts and in proportions just sufficient to arrest bleeding (see point 4.6). Thus, in this case, process claims were allowed under the normal requirements of novelty and inventive step.

In decision T 958/94 the Board of Appeals arrives at another outcome, which leads to an undesired situation. If this Board of Appeal believes that the "for use" or "for inhibiting" clause must be interpreted restrictively when medicaments are concerned, then a claim such as *Product for inhibiting the growth of tumor cells* must also be interpreted restrictively. Such an interpretation, however, is in conflict with Article 54(5) EPC, since that article stipulates that such a claim is only possible when the use for *any* method is not in the state of the art. .

Another problem with decision T 958/94 is the conflict with a major principle of the EPC, in that the requirements for novelty of medical products do not differ from those of other products. Take, for instance, a situation wherein a novel use as an additive is found for a compound X, which is known as such as an intermediate in a chemical reaction. In view of Enlarged Board decision G 6/88 a claim to the novel *use* of compound X is allowable. Applying decision T 958/94, also a claim would be allowable when drafted as:

Process for the preparation of known compound X for use as an additive, comprising the known steps (...).

Such a claim, however, is clearly not allowable because the claimed process lacks any novel feature.

The Board, therefore, is wrong in assuming novelty of the process claim, and is further wrong in assuming support for their view in earlier decision T 893/90. The problem is that the use claim as allowed under G 5/83 does not lend itself automatically to being redrafted in the process form, in view of the fact that the Enlarged Board unmistakably allowed the second medical **use** claim as an exception to the common rules of novelty. As a legal principle, exceptions must be interpreted narrowly.

Decision T 958/94 conflicts with Enlarged Board decision G 5/83, with the EPC, and with the feeling of many practitioners. It is hoped that Examining Divisions will not apply T 958/94, but will take their own responsibility toward the principles of the EPC.

Designation Fees – ripe for abolition?

P.W. Neville (GB)

The European Commission's "Green Paper on the Community Patent and the Patent System in Europe" has invited views on which EPO fees should be reduced.

In my opinion, one fee stands out as an anomalous and ready for abolition. This is the *Designation Fee*, already reduced in July 1997 from DM 350 to DM 150. That reduction suggests that the fee is not fundamentally essential for the EPO's finances. Of course, the EPO has to do some work for each country which is designated, but this would be simplified if, as I suggest, every EPC-member country were automatically and compulsorily designated in every European patent application. When the European patent application becomes granted, applicants would retain their present freedom to implement grant in all, or some, or even none, of the EPC-member countries.

Important advantages would flow from compulsory free-of-charge universal designation.

Patentability of an invention in any one European country under the EPC has always depended on whether any prior similar unpublished European patent application has designated that country (Article 54(4)). For this artificial reason, an invention may be patentable in some

but not other countries in Europe, even if the inventor had sought patent rights throughout Europe. This inconsistency would not arise if that earlier European patent application had designated all countries.

Since recently, payment of the Designation Fee can be deferred until *after* the European patent application is published. This leads to serious procedural problems under Article 54(4). In particular, an originally patentable invention can cease to be patentable by arbitrary acts undertaken by third parties *after* a patent application on that invention has been filed (namely, by deferred payment of a Designation Fee on an earlier-filed European patent application). This offends the principle that a patent application is judged according to the state of affairs prevailing on the application date, not according to the state of affairs at a later date. The present suggestion would prevent the problem, as any such earlier-filed European patent application would then have automatically designated all countries *ab initio*.

I therefore urge the profession to support the idea of compulsory free-of-charge designation of every EPC-member country, in all European patent applications.

For a renewal of the membership of *epi* Committees

F. Hagel (FR)

For a reader of *epi* Information, it is obvious that the work of the various committees is a major part of the activity of *epi*. The reports published in *epi* Information, while reflecting only partially the activity of the committees, offer a wealth of information and insights to European attorneys. I am thankful, and I am sure all members of *epi* feel the same, to the members of the committees, who on top of their professional duties volunteer their time and commitment for the benefit of our community.

For the very reason that the committees play a major role within *epi*, a discussion should be opened about the way their members are appointed. As a fairly senior attorney, I note a strikingly high stability in their membership as years go by. Stability may indeed be seen as a positive factor as good work requires the knowledge of past activity and the building up of personal relationships between members – which takes time. But *epi* should also set as an objective a certain rate of renewal

of the membership and the appointment of more junior colleagues to the committees. As the number of members in a committee is not extensible, this raises the issue of setting a time limit to membership. In the current state, it seems that once an attorney has been appointed to a committee, the term of his/her appointment is at his/her discretion (unless internal rules, of which I am not aware, are implemented within the various committees). Such a situation tends to freeze the membership of committees and to favour cooptation for the appointment of new members.

Our experience in professional associations is that a rule limiting the term of appointment is not only feasible but very effective. For instance, in France, ASPI (association of corporate IP professionals) and LES-France have implemented a limit of 6 years for Board members, resulting in a steady renewal of the Board. In the case of *epi* committees, a similar time limit might be considered.

Results of the European Qualifying Examination 1997

FIRST SITTING – Examination in full and modular sitting

Country	Cand. Total	PASSED				FAILED			
		Total	%	Exam.in full	modul sit. 2 mod.	Total	%	Exam.in full	modul. sit. 2 mod.
AT	8	4	50,0	4	0	4	50,0	4	0
BE	4	0	0,0	0	0	4	100,0	3	1
CH	6	1	16,7	0	1	5	83,3	3	2
DE	126	43	34,1	40	3	83	65,9	76	7
DK	13	3	23,1	2	1	10	76,9	7	3
ES	5	0	0,0	0	0	5	100,0	4	1
FR	38	12	31,6	10	2	26	68,4	18	8
GB	73	41	56,2	36	5	32	43,8	29	3
GR	2	0	0,0	0	0	2	100,0	1	1
IE	2	1	50,0	1	0	1	50,0	1	0
IT	28	2	7,1	1	1	26	92,9	15	11
NL	24	7	29,2	7	0	17	70,8	14	3
SE	11	1	9,1	1	0	10	90,9	8	2
CA	1	0	0,0	0	0	1	100,0	1	0
TOTAL	341	115	33,7	102	13	226	66,3	184	42

RESITTING – Examination in full
 Total number of candidates: 27
 Passed: 2 (7,4%)
 Failed: 25 (92,6%)

RESITTING – Examination in part
 Total number of candidates: 439
 Passed: 124 (28,2%)
 Failed: 315 (71,8%)

European Qualifying Examination

D. Jackson (GB)

These notes are intended to assist candidates in preparing for the EQE and to give guidance on how to answer the different papers.

It should be borne in mind, however, that notes such as these are no substitute for experience and knowledge. Candidates are advised always to read the Instructions for Candidates at the commencement of each paper to ensure there are no changes that may affect their answers.

The responsibility for any errors in these notes is mine, but I wish to thank all those colleagues, members of examination committees and candidates who have knowingly or unknowingly contributed, including in particular Tim Powell and Alice Findlay.

Any suggestions for improving these notes for future candidates would be welcomed.

PAPER A E/M (DRAFTING)

ALLOCATION OF MARKS AND GRADES

There are 48 marks in total for Paper A, generally awarded as follows:

Independent claim(s) 24 – 26

Dependent claims 14 – 15
 Description 7 – 10

Marks are translated into grades as follows:

Grade 7 – 0 – 11
 Grade 6 – 12 – 17
 Grade 5 – 18 – 23
 Grade 4 – 24 – 29
 Grade 3 – 30 – 35
 Grade 2 – 36 – 41
 Grade 1 – 42 – 48

DESCRIPTION

The general requirements for the description are:

Introduction
 (Background state of the art if needed)
 Description of most relevant document(s)
 Problem
 Solution (object)
 Basis for independent claim(s)
 (Advantages)

There is no need to provide either basis for, or a description of advantages of, dependent claims.

You must ensure any independent claim you have drafted is consistent with the solution described.

INDEPENDENT CLAIM(S)

It is not possible to provide a recipe for a suitable claim, but the Examination Committee generally favours a "means plus function" claim.

Consider the possibility of a method claim as well as an apparatus claim.

You must ensure that all embodiments described by the client fall within the scope of the independent claim(s). If any described embodiments are omitted, the claim will be heavily penalised (less than 50 percent of marks for this aspect will be awarded).

Any major unnecessary restrictions in the claim (while encompassing all described embodiments) will generally be penalised by about 4 marks. Minor unnecessary restrictions will be penalised less severely.

You must ensure that reference numerals are used in the claims and that a two-part form of claim clearly separating the invention from the prior art is used wherever possible.

It may be possible to broaden the client's proposals and this can lead to a small bonus where appropriate. In general, however, you should be cautious about broadening a client's disclosure because the client usually knows his own field.

When drafting your claim to avoid the prior art, always seek to incorporate positive restrictions and not negative restrictions. That is, state what is present, not what is absent. Always explain how the components of your claim interact. Do not include anything in the claim that is not essential.

Once an independent claim has been drafted, it should be considered from a number of different aspects:

- is the claim novel over each prior art document,
- is the claim limited unnecessarily in any respect (i.e. will potential infringers escape), and
- is the claim consistent with the client's wishes (i.e. does it cover all embodiments)?

Many candidates who obtain a Grade 4 pass score less than 50 percent of the marks available for the independent claim(s).

DEPENDENT CLAIMS

When drafting dependent claims, you need to consider correct dependencies. It is advisable to set up at least one good fall-back position and not to combine multiple features in a single claim.

In order to establish a satisfactory structure for your dependent claims, it is suggested you should first outline each proposed claim (with a single word or phrase). You can indicate progressive dependencies with indentation. In this way it is possible to identify features that are generic to all embodiments and which therefore are relevant to all claims and to identify features or sub-features that are relevant to each embodiment and which therefore require more restricted dependency.

Material for dependent claims can usually be recognised by suitable statements in the client's description such as "advantageously" or "preferably". It could be helpful when reading through the client's disclosure to mark such passages at an early stage.

Do not include an excessive number of dependent claims: too many can lose marks as can too few. Generally, the total number of claims should be in the region of 10 to 15.

PROPOSALS FOR SEPARATE APPLICATIONS

You are not expected to propose significant numbers of further applications and the Examination Committee is tending to deduct marks for unjustified further applications. You should therefore not look for separate inventions unnecessarily.

REFERENCES

epi Information	2/1989, page 56
	1/1995, page 10
	3/1995, page 95

PAPER B E/M (AMENDMENT)

ALLOCATION OF MARKS AND GRADES

There are 48 marks in total for Paper B, generally awarded as follows:

Claims	20–24
Argumentation	24–28

Marks are translated into grades as follows:

Grade 7	– 0–11
Grade 6	– 12–17
Grade 5	– 18–23
Grade 4	– 24–29
Grade 3	– 30–35
Grade 2	– 36–41
Grade 1	– 42–48

SUBJECT MATTER

You should note from 1998 the subject matter of Paper B may not be linked to the subject matter of Paper A.

GENERAL APPROACH

In order for this paper to pose a reasonable test of a candidate's ability, it is unlikely (but not impossible) that any suitable amendment will be found in the original dependent claims. Most probably, therefore, it will be necessary to review the description of the application to find a suitable amendment.

It is suggested, therefore, that one way of proceeding is first to identify in the description and dependent claims potential distinctions from the prior art references, ideally consistent with the client's instructions. Note all possible distinctions and then select the best.

This can be done, for example, by reading through the paper and highlighting relevant words such as "preferably", "advantageously", "improve", "desirable", "problem", "disadvantage". These and other similar words all give hints as to possible sources of amendment. Also identify any statements in the prior art that appear to lead away from statements in the application.

Having identified a solution, prepare amendments to the main claim. Do not restrict the claims unnecessarily and pay attention to the requirements of Art 123(2) EPC.

Bear in mind when drafting your new claim that the preamble should be consistent with the closest prior art document.

As with Paper A, once a new main claim has been drafted it should be considered from a number of aspects:

- is the claim novel over each prior art reference,
- can inventive step be supported with suitable arguments,
- is the claim limited in any unnecessary respect, and
- is the claim consistent with any instructions from the client?

With a satisfactory main claim, it should be possible to draft amended dependent claims.

Finally, prepare your response, but do not leave this too late because the arguments for inventive step carry most marks for this part of the paper and come at the end of the response. If necessary, cut down on the time allocated to the dependent claims and/or provide justification for claim 1 only in the response and return to these later if possible.

Ensure your arguments are consistent with your amendments to the main claim.

Remember to check the Communication from the EPO Examiner and ensure you respond to any specific matters (e.g. ex post facto analysis or Art 84 EPC) that require attention. Bear in mind the arguments presented in the Communication could be wrong.

INDEPENDENT CLAIM(S)

About 8 to 12 marks are usually allocated to the independent claim.

Any unnecessary restrictions will as a rule each lose about four marks for a major restriction and two marks for a minor restriction.

Generally, it is advisable to follow the recommendations in the client's instructions.

It is not unknown for some broadening of the main claim to be desirable, but if anything is omitted from the claim as filed, or if a functional generalisation is employed, this must be justified in the response under Art 123(2) EPC.

Contrary to the advice at EPI Information 3/1995, page 95, making the wrong choice for the amendment does not necessarily lead to failure of the paper. Whatever amendment is made to the main claim, it is essential to follow that amendment consistently throughout the paper.

Negative definitions in claims, e.g. "means for preventing .\8.\8.", are undesirable and should be avoided if possible.

DEPENDENT CLAIMS

About 12 marks are usually allocated to the dependent claims, but the number of marks can be significantly less.

The dependent claims are intended to provide fallback positions in the event your main claim should fail and this must be borne in mind when formulating the dependent claims. Ensure that the dependencies of claims are reasonable.

Usually, those dependent claims that are not made redundant by the amendments to the main claim should be retained, but this is not always the case. For example, dependent claims may be cancelled where the subject matter of the original dependent claims is known from the prior art or where significant features are omitted from the original dependent claims.

Where the dependent claims are retained, amendment of these to take account of the amendments to the main claim can give up to about 50 percent of the marks for the dependent claims, the remaining marks being allocated to features omitted from the original claims and which can be found in the description. To obtain good marks for the dependent claims it is therefore essential to introduce additional claims from the description.

Do not include an excessive number of dependent claims: too many can lose marks as can too few.

You are not required to draft arguments in support of the **patentability** of the dependent claims.

DIVISIONAL APPLICATIONS

You are not generally expected to make an issue of divisional applications, but there can be a few bonus marks available.

In any event, you are not expected to draft claims for any divisional application.

DESCRIPTION

There is no need to propose amendments to the description.

ARGUMENTATION

The majority of the marks for argumentation are for establishing inventive step. Clear, logical and convincing arguments are required in order to gain high marks. Remember to deal with any specific issues, such as lack of clarity, raised in the Communication.

Draft letter of response:

European Patent Office
D-80298 München
Germany

Dear Sirs

Patent Application No.
in the name of ...

With reference to the Communication received from the Examining Division, I enclose three copies of amended claims.

BASIS FOR AMENDMENTS

For each claim, state clearly what amendments have been made and from which parts of the application they have been derived (e.g. "Claim 1 has been amended by incorporating the feature(s) of original claim(s) .\8.\8." and/or "Claim 1 has been amended by incorporating the subject matter from page .., lines .. to .., of the description"). Repeat for all amended or new claims.

Depending on the nature of the amendments, you may need specifically to address the issue of Art 123(2) EPC. This is essential if you have broadened any aspect of a claim, employed a functional generalisation or where the amendments are of dubious admissibility. Art 123(2) EPC should also be considered where the passage providing the basis for an amendment contains additional features not incorporated into the claim and arguments should be provided as to why these features are not essential.

NOVELTY

Show that the subject matter of the amended independent claim(s) is novel with respect to the available prior art. That is, show for each independent claim that the claim contains at least one feature of distinction with respect to **each** of the prior art documents (including prior art acknowledged in the application or in any of the references). A claim may have different distinctive features for different documents.

INVENTIVE STEP

Show that the subject matter of the independent amended claim(s) involves an inventive step with respect to the available prior art.

In this respect, the Examination Committee favours the problem/solution approach which involves the following steps:

- (a) Establish which one of the prior art documents is considered to constitute the closest state of the art for the amended claim(s) and why (e.g. "Document III is considered to constitute the closest prior art because .\8.\8.>").
- (b) Derive the objective technical problem to which the invention is addressed, taking into account the effects achieved by the differences of the subject matter as claimed with respect to the closest prior art (note: ensure the technical problem derived is indeed solved by the invention as claimed). This involves returning to the application and con-

sidering the features of the amended claim as compared with the closest prior art. What problem is solved by the differences?

- (c) Consider whether there is anything in the prior art that would prompt the skilled person faced with this technical problem to modify or adapt the closest prior art to arrive at something falling within the scope of the claim (i.e. does the prior art lead the skilled person away from the invention, or does the prior art solve a different problem, etc.). Do this in a number of stages. First consider the most relevant prior art alone-why would the skilled person not be able to derive the subject matter of the amended claim from this reference (hopefully, a passage has been identified in the reference that leads away from the claimed invention). Next, consider each other item of prior art in turn (including prior art acknowledged in the application or in the references) and explain why a combination of these with the most relevant reference does not lead to the claimed invention.

There is a trend developing, in situations where the Examination Committee considers more than one prior art document could be considered to be the closest prior art, for the Examination Committee to expect arguments starting from more than one document.

There are no marks for requesting oral proceedings or interviews.

REFERENCES

epi Information 2/1989, page 56
 1/1995, page 10
 1/1996, page 29

PAPER C (OPPOSITION)

ALLOCATION OF MARKS AND GRADES

Marks are generally awarded as follows:

Use of information	40
Argumentation	40 (previously 35)
Legal aspects	20 (previously 25)

and are translated into grades as follows:

Grade 7	- 0-25
Grade 6	- 26-35
Grade 5	- 36-49
Grade 4	- 50-59
Grade 3	- 60-69
Grade 2	- 70-80
Grade 1	- over 80

FORMALITIES

You must be thoroughly familiar with the requirements for the Notice of Opposition. There are no marks for getting them right, but you will lose marks (up to four) if you

get them wrong or miss anything out. Use the Form 2300 provided. Requirements are:

- Name and address of opponent together with State of residence or principal place of business (Note: for an individual put family name before given names)
- Number of patent opposed and title of invention
- The extent (claims and countries) to which the patent is opposed and the grounds (excluding always Art 100(b) EPC)
- Name and address of representative. Sign the Notice/Form in the name of the representative.
- State somewhere that you are paying the fee.

State which language version of the patent you are opposing and which language version of each annex you are using.

PROCEDURE FOR TACKLING THE PAPER

There are many ways of tackling Paper C, but you need to be well organised to handle the considerable amount of information. Below is one suggestion.

Preliminary

For each claim make a note whether the claim is independent or, if not, the various dependencies available. Look for claims that are independent in a subtle way, such as a claim referring to a claim of a different category (Guidelines C-III, 3.7a) or claims that are both dependent and independent (e.g. .\8.\8. in particular as claimed in .\8.\8.). Also look for alternatives giving, in effect, two separate claims.

Draw up a chronological table for all the documents (or allegations of prior use). For documents published before the earliest priority of the opposed patent you only need the publication date, but for overlapping publications you also need to note priority date(s), application date and details of overlapping designations.

Check whether any of the annexes are in the same name, or have the same inventor(s), as the opposed patent because this may affect the priority claim.

Bear in mind that it is known to provide an annex which describes relevant prior art, but which cannot be used.

This table is fundamental to your answer. Remember a document must be available to the public (T381/87) and a date of posting is insufficient.

Table 1				
Annex 1	Annex 2	Annex 3	Annex X
Date 1 (oldest)				
Date 2				
Date 3				
.				
.				
.				
Date X (most recent)				

Next determine the priority date of each claim. You can establish the priority date of a claim in a number of ways.

One way is to break down each claim into a number of features 1a.\8.\8.x, 2a.\8.\8.x etc and identify where each feature can be found in the documents of the opposed patent (1st priority date, 2nd priority date, application as filed, possible subsequent amendment etc). Usually, however, it is not difficult to establish the priority date of each claim.

Table 2		
	1st priority	2nd priority
1a		
.		
.		
x		
2a		
.		
.		
x		
etc		

Remember a claim can have more than one priority date as a result of alternatives in the claim or as a result of dependencies on different claims.

Next analyse the prior art to identify which claim features are to be found in which annex. Breaking down each claim into different features can be helpful here too.

Be sure to use the annex numbers given in the paper: members of the Examination Committee have many scripts to mark and if they have to learn a new nomenclature for the references given, mistakes may arise.

Note down where the various claim integers can be found in each annex. It may be helpful to include a column to assist in identification of added matter, but do bear in mind this applies also to the description.

Remember also that the patent you are opposing may well acknowledge the existence of relevant prior art.

Table 3				
	Annex 2	Annex 3	Annex X Art 123(2)
1a	page x, line y			
	etc			
.				
.				
x				
2a				
.				
.				
x				
etc				

This means you should not need to read through an entire annex towards the end of the examination looking for a missing line reference that is critical to your argument.

If you are struggling for a translation, remember the examination paper and the opposed patent are provided in English, French and German and the annexes are each

provided in two languages. You can use the other versions of the paper, the opposed patent and the annexes as a dictionary.

Finally, prepare a list of legal points for the Examination Committee. This will include availability of the annexes as citations, incorrect designations, details of claim priorities, possible extension of subject matter and the numerous matters arising from the client's letter such as the scope of protection afforded by the patent, availability of references, corrections, the possible grounds of opposition, costs and prior use.

In addition, if you are not attacking a claim, or if you only have a weak attack, say so here and explain why. Notes need not be extensive, but do mention relevant articles, rules, decisions etc., and explain what they say and how they apply in this particular case. Do not rush this part because most marks can be picked up fairly simply.

Many legal points arise from the letter from your client. Indeed, every part of the client's letter is there for one reason or another. It is suggested that whenever candidates make use of information from the client's letter they underline the relevant part. If any part of the client's letter remains unused, it is most likely an argument has been missed and marks lost.

You should now be *at least* two hours into the exam and you have written very little of the answer. Do not panic.

STATEMENT OF GROUNDS-GENERAL COMMENTS

Marks are awarded for use of information (identification of appropriate references) and for argumentation (why they are relevant). Most candidates score more marks for use of information than they do for argumentation.

Attack claim 1 and any other independent claim in as many ways as possible: this includes multiple novelty attacks if available. For the dependent claims, time will limit you, but do try to attack each possible combination of claims.

Generally, more marks are allocated for the attacks on claim 1 than for those on other claims. About 10 to 12 marks are allocated to claim 1 for each of use of information and argumentation.

Remember that a dependent claim is not necessarily more restricted in scope than a claim to which it refers (bear in mind phrases such as "in particular" and "X replaced by Y").

Ensure your answer makes it clear you have recognised all the possible combinations.

For each attack, identify the annex(es) you are using and identify relevant passages from the annex(es) concerned. This should not be difficult if you have prepared Table 3.

On introducing each annex, discuss its availability in relation to Articles 54-56. By doing this, you make it clear to the Examination Committee that you have considered the status of each annex.

Say why the annex is relevant (same field) and if combining two annexes say why the skilled person would make such a combination. Be very careful to make the

distinction between novelty and obviousness and show you understand this.

Novelty (Article 54(2) and (3))

If an annex discloses $a + b$ and $a + c$, but not $a + b + c$, then a novelty attack against $a + b + c$ must fail.

Note, however, that if the information in an annex, when combined with the skilled person's general knowledge, discloses all features of a claim, then that claim lacks novelty. You can therefore use an annex under Article 54 if, for example, it discloses a compound and another annex gives a required characteristic of that compound (Guidelines C-IV, 7.1 and 7.2).

For an attack under Art 54(3) you must additionally check the overlap of designations, that the priority date was validly claimed and that the application has not been abandoned before publication.

Make it clear whether an attack is under Art 54(2) or 54(3).

There is nearly always a novelty attack to be made on claim 1 and often also on a dependent claim. For a dependent claim it may be only one claim combination and so do not forget that the other combinations will need to be attacked as lacking inventive step.

Inventive step

In general, you should not attack the same claim with the same annexes under lack of novelty and also under lack of inventive step. However, if you have doubts whether a particular feature is indeed present in an annex and you believe it is necessary to use the same annex for both forms of attack, then make it clear to the Examination Committee that there is room for argument that the feature is missing at the beginning of your attack for lack of inventive step.

If a document has previously been used for a novelty attack against an earlier claim under Art 54(2) and is subsequently to be used in an obviousness attack, then explain why (for example, feature X is not present in Annex B, but is present in Annex A and it would have been obvious to combine the documents because .\8.\8.). Indeed, always explain why the skilled person would have read any combination of documents together.

Bear in mind the possibility of attacking on the basis not only of Annex A + Annex B, but also Annex B + Annex A, although generally there are relatively few marks for identifying the second attack and the time may be better spent elsewhere.

Look carefully for disclosure of functional equivalents to a claimed feature.

Do look for all possible attacks on claim 1 since often an attack which is slightly weaker for claim 1 may form the basis for the most useful attack on the dependent claims.

The Examination Committee favours the problem and solution approach. Determine what the problem is, has it been recognised before, is the solution obvious once it has been recognised, do any of the annexes identify

the same problem? Consider also the "advantages" of the solution. It may be appropriate to attack these as illusory or known. If no advantage is given, attack on that basis. Use T37/82 if appropriate-features which do not contribute to the solution should not be taken into account in assessing inventive step.

Common general knowledge should be used with caution. However, do take time to consider whether a solution is one which is well known in a number of fields and can, therefore, be attacked on this basis.

Impermissible extension of subject matter

Ever since Art 100(c) EPC was added to the examination syllabus as a possible ground for opposition, extension of subject matter has always featured in Paper C.

Normally this is easily recognisable from the client's letter or an Official Letter with which you are provided.

Do bear in mind, however, that the fact that a feature was not in the priority documents does not necessarily mean that it was added during prosecution. It may have been there on filing and you should cover both possibilities.

Make sure that you know the relevant case law on extension of subject matter and that you do not attribute to a claim a date other than a priority date or the filing date.

Remember that Art 123(2) EPC applies to the patent as a whole. An attack under this ground can often be made in respect of subject matter in the description and this is separate from any attack on a claim.

Miscellaneous

Do not overstate your case. The Examination Committee is looking for attack, but reasoned attack. They want to see that you know what you are doing. If you do stretch a point explain this in a note. You must be *sure*, however, if you do not attack a claim.

Number your pages. You cannot be certain your script will stay together.

As you draft the Statement of Grounds, do add to your notes to the Examination Committee, but do not overdo it. These should be reserved for circumstances in which you have not made an attack which might possibly be made, if there is a claim which you have not attacked or an annex which you have not used, if you have attacked a claim in circumstances where there is real doubt as to success, or for explanation as to your course of action where this is not clear from your Statement of Grounds.

DRAFTING YOUR STATEMENT OF GROUNDS

First deal with any general points such as impermissible extension under Art 123(2). There is a general attack to be made whenever a claim has been amended to add subject matter during prosecution and/or the description has been amended, for example to provide a basis for the amended claim or in respect of an alleged correction. Suggested procedure for attacking a claim

Claim X

First state the dependency of the claim because this is fundamental to your argument. For example:

Claim X is dependent on claim 1 and, because of the phrase 'in particular', must also be regarded as an independent claim.

Next state the priority date of the claim. Remember a claim may have more than one priority date. For example:

Claim 3, when dependent on claim 2, has a priority date of DD MM 1995 because .\8.\8. and, when dependent on claim 1, has a priority date of DD MM 1994 because .\8.\8.

With an independent claim set out the field of the invention as stated in the claim e.g.:

Claim 1 relates to widgets which may be fitted to ...

Then move on to your most relevant prior art. As explained previously, when introducing each new item of prior art set out when it was published if arguing lack of novelty under Art 54(2) or lack of inventive step, and make the point that this is before the priority date of the claim.

If arguing lack of novelty under Art 54(3) point out the relevant application and/or priority dates and the Contracting States to which your argument applies.

You should then explain why the skilled person would consider this prior art as belonging to the same field as that of the claim of the disputed patent and why the skilled person would consider the prior art as being relevant to the alleged invention.

When arguing lack of novelty, you should then recite each feature of the claim in turn and show where this feature can be found in the prior art ensuring any differences in terminology and any difficult points, such as the properties of a compound, are dealt with.

When arguing lack of inventive step use the problem solution approach. First identify the features found in one of your prior art references as under novelty. Second, identify the differences between the closest prior art and the claim and establish the objective technical problem solved by these features. Finally, explain why the skilled person would have combined the two references to overcome the problem you have identified. Remember to argue your case.

REFERENCES

epi Information 2/1989, page 56
 3/1995, page 95

PAPER D (LEGAL)

ALLOCATION OF MARKS AND GRADES

Now that Paper D has been separated into two separate sessions, marks are generally awarded as follows:

Paper DI	45
Paper DII	55

and are translated into grades as follows:

Grade 7	- 0 - 35
Grade 6	- 35.5 - 45
Grade 5	- 45.5 - 55
Grade 4	- 55.5 - 65
Grade 3	- 65.5 - 75
Grade 2	- 75.5 - 85
Grade 1	- 85.5 - 100

GENERAL POINTS

You are permitted to take whatever reference material you wish into the examination, but there needs to be a compromise. There is no point taking with you material that you are not sufficiently familiar with and which will take too much time to use.

It is suggested by the Examination Committee that candidates take at least the following material into the examination:

- European Patent Convention
- Implementing Regulations to the EPC
- Protocol on Centralisation
- Protocol on Recognition
- Rules relating to Fees
- Notice of the President of the EPO concerning the arrangements for deposit accounts
- Patent Cooperation Treaty
- Regulations under the PCT
- Paris Convention
- List of contracting states to the EPC (including the Extension states) and PCT

Additional material that could prove useful includes:

- Relevant dates for contracting states to the EPC and PCT
- List of contracting states to the Paris Convention and relevant dates
- Guidelines for examination
- Decisions of the President of the EPO
- Notices published in the OJ EPO
- EPO Legal Advice
- Case Law of the Boards of Appeal of the EPO
- EPO Board of Appeal Case Law 1995
- EPO Board of Appeal Case Law 1996
- Recent decisions of the Boards of Appeal and the Enlarged Board of Appeal

Bear in mind that you are permitted to annotate and cross reference the material you take into the exam. This preparation is the key to passing Paper D.

You can prepare in two ways. One way is to annotate a copy of the EPC and the other way is to prepare a series of charts for various stages of applications filed under the EPC and PCT.

Annotation of the EPC starts with an official copy of the EPC: this has the advantage that it is published in three languages and you can paste information over the spare space and the two languages you do not need. You should identify for each article the relevant rules, case law, notices and presidential decisions and paste

these into the book. When you have finished this exercise, you should have a complete reference to the EPC. Provided you know the relevant article, you can then identify appropriate rules, case law and other material which you can, if necessary, employ to refer to a more detailed source. You may even wish to compile your own index to help you quickly identify the relevant article(s).

Charts can be used to summarise all the filing requirements under the EPC and PCT, listing all the documents, fees, time limits, relevant articles and rules, together with the consequences of failure to comply and possible remedies. Charts can also be useful for other stages, such as grant, opposition, appeal etc.

Both annotated copies and charts have the benefit that, in order to prepare them, you must study the relevant material in considerable depth, thus assisting your preparation for the examination.

A brief survey of the 1994 to 1997 Paper D shows that, with the exception of J4/86 in the 1997 paper, every Legal Board of Appeal decision and every Technical Board of Appeal decision referred to in the model answers prepared by the Examination Committee and which remains relevant is mentioned in the book "Case Law of the Boards of Appeal of the EPO". This is clearly an important source of material for the examination, but since it will eventually become out of date you must anticipate that the subsequent annual case law summaries will also be important.

Beyond this, in addition to the material suggested by the Examination Committee and the guidelines, the 1994 paper cited material (Notices, Legal Advice and President's Decisions) from 1989, 1991, 1992 and 1993 issues of the OJ EPO together with G1/91 published at OJ EPO 1992, 253. The 1995 paper cited additional material (Notices and President's Decisions) taken from 1992 and 1993 issues of the OJ EPO together with G1/92 published at OJ EPO 1993, 277 and (in passing) the Headnote of G3/93 published in OJ EPO 10/1994. The 1996 paper cited additional material taken from a 1995 issue of the OJ EPO. The 1997 paper cited Legal Advice 5/93.

Candidates should ensure their reference material is up-to-date. Changes in the EPC or case law which over-rules previous practice will inevitably find their way into the examination sooner or later.

PAPER DI

Always read the question very carefully and ensure you first understand the question being asked before writing your answer.

In view of the amount of information you can take into the examination, in this paper the Examination Committee is looking for citation of relevant articles and rules at least, and ideally also relevant case law and guidelines. In each answer you should give consideration to the following:

All statements must be justified otherwise, for example, it is often not possible to give credit

where a candidate understands a question, but has made a simple error in writing the answer.

The allocation of marks varies from question to question, but the legal basis for an answer (article, rule, case etc) can often account for some 25 to 30 percent of the marks for that question. It is therefore essential to give this information. Where a decision is involved, a summary of the decision will be sufficient if the case number is not known, but it is not adequate simply to state that there is a Board of Appeal decision because such a statement does not demonstrate any understanding.

Whenever deadlines or dates are involved, always check the dates on the calendar ensuring you look up the correct year. It is almost certain that one of the dates will fall within the provisions of Rule 85 EPC.

It is rarely helpful in the EQE to allocate a fixed time to any part of a paper, but Paper DI is an exception. Bearing in mind that the marks for each question vary (the marks for each question being indicated on the paper), it is suggested you allow 3 minutes for each mark.

Thus a question worth 5 marks should be answered in about 15 minutes. You should bear in mind though that this allows no contingency for any questions that are particularly difficult to answer.

There is no point reading all the questions through at the beginning of the examination. You are required to answer all the questions, so begin at Question 1 with the intention of answering it immediately. However, if you cannot answer a question, move quickly on to the next and return to any problem questions at the end.

PAPER DII

In this paper it is helpful to cite relevant articles and rules or other legal basis, but primarily the Examination Committee is looking for clear cogent advice.

Each piece of information given in the paper is there for a purpose, so endeavour to make a note whenever

you use any information so that you can tell what you have, and have not, used.

Do draw up a chronological table of events to help you establish when events took place and how they relate to other events.

As part of this paper, you are often asked to set out a list of time limits (or actions) and the fees involved. You can use your charts here to identify precisely what is required, and when. However, as a rule you should not merely give the minimum information, but you should additionally set out what can be done if any of the time limits are missed. In each case set out the legal basis for your answer.

A longstanding issue with the Examination Committee is that candidates do not understand priority rights-how they arise, who owns them and what is necessary to claim them to maximum benefit. You can be almost certain that priority date will be a significant issue in this paper.

Additionally, you can be almost certain that an understanding of novelty and grace periods in the United States will arise, possibly also with a consideration of Interference proceedings.

You should bear in mind that there are often alternative courses of action, for example filing PCT or EPC and US separately. Where there are alternatives, these should be set out and a recommendation made on the basis of practicality and cost as you would in your day-to-day practice.

The questions to be answered are clearly set out in the paper so do ensure you answer the questions asked in a logical and orderly manner.

The key to Paper DII is to deal separately with each of the topics set out in the paper and to look at the situation from the point of view of your client. You are giving the advice to your client and there is usually a way of giving positive advice.

REFERENCES

- | | |
|-----------------|------------------|
| epi Information | 2/1989, page 56 |
| | 3/1993, page 234 |
| | 3/1995, page 95 |
| | 1/1996, page 29 |

epi Home Page

News Section

As the importance of the European Patent Organisation and the European market as a single entity continues to grow, the importance of the European Profession as a whole grows with it. As the representatives for the profession, the *epi* believes that it should be in the forefront of the provision of relevant information relating to the European Patent system as well as the relevant areas of national law and procedures.

To date, however, the only means that the *epi* have of providing such information, not only to its own members but to those outside the European profession, is *epi* Information. Regrettably the logistics of providing such a document to such a large number of readers, so widely spread, results in the publication being unable to provide some information quickly enough for it to be relevant upon receipt.

For this reason, the Council have recommended the setting-up of a News section of the *epi* home page and it is hoped that such a section will be operating in February 1998. For such a system to work efficiently, however, the Editorial Board will, unsurprisingly, require news to place into the news section. We are requesting help from all members to provide us with any useful information they may have. The idea is to provide information quickly and unofficially. For this reason, we would greatly appreciate information that any member may have on a Decision by the European Patent Office, not, to date, published in the EPO Journal, any relevant national Decision or any other news of interest both to either *epi* members or to users of the European Patent system, e.g. suggested law changes or practice changes within the EPO. It is the intention of the *epi* to supplement such information with information obtained through its own offices such as, for example, decisions made in Administrative Council meetings as well as decisions taken by *epi* bodies themselves.

It would be greatly appreciated if the first **such information could reach the Editorial Board by the end of January 1998**, although it is stressed that this is to be a continuing service and that, therefore, any interesting information should be passed to the Editorial Board whenever a member receives it and thinks it might be of interest to other members.

With regard to the information itself, short summaries (ideally 50 to 150 words long) should be provided in one of the three official languages to:

Editorial Board (Home Page News)

epi

P.O. Box 260112

D-80058 MÜNCHEN

For a quick translation into HTML-format as "winword *.doc" file (6.0 or higher), "*.rtf" (rich text format) file or as plain ASCII-text file.

Your future co-operation is greatly appreciated. Keep watching the skies!!

epi Information 2/98

Themed Editions

The members of the *epi* all very busy with their own professional tasks. Therefore, it is greatly appreciated when any member takes the time and trouble to produce a letter or article for *epi* Information. It is acknowledged that providing such articles and letters is an additional burden on top of an already busy schedule. It, therefore, seems to the Editorial Board that it is inequitable that, in all cases, it is the authors of these pieces who are the ones who have to derive the inspiration behind the article.

In order to relieve this burden a little, we are experimenting with the possibility of themed editions of *epi* Information, in which the articles and letters revolve around a single topic. It is hoped that this will inspire more members to write articles and letters and will also stimulate debate in future editions.

Accordingly, the first edition for which such a theme has been chosen is *epi* Information 2/98 and the theme is:

The European Qualifying Examination.

We felt that this was a broad enough topic, falling within the experience of all members of *epi* in one way or another, to stimulate quite a number of our members. In particular, it is also a topic of ongoing debate, particularly amongst those who have to sit the examination!!

We would greatly appreciate articles and/or letters on this topic, from any perspective. For example we would appreciate the perspective of the student yet to take the exam, the student who has recently taken the exam, whether they have passed or failed, the tutor who tutors candidates, the more senior member of the profession whose responsibility it is to train candidates and, if we are very lucky, an examiner who has to read the answers! Not only do we believe that such articles be of great interest to many readers and stimulate debate but, equally, will be of extreme use to those readers who are able to view a topic from a perspective that they may not have been able to previously.

The deadline for provision of articles for *epi* Information 2/8 is **20th May, 1998**. Please forward any contributions to:

Editorial Board (*epi* Information 2/98)

epi

P.O. Box 260112

D-80058 MÜNCHEN

We thank you in anticipation of your contributions.

epi Excess Liability Insurance 1997/1998

On 1 October 1997 the *epi* Excess Liability Insurance scheme has gone into its ninth year of existence. It aims to give better insurance coverage at a reasonable price to *epi* members.

The indemnity of basic professional liability insurance schemes is often limited to DM 2 million. Therefore, the *epi* Excess Liability Insurance scheme indemnifies losses as far as they exceed DM 2 million/equivalent. Its limit of indemnity is a further 3 million per loss so that – together with basic insurance – a total loss of DM 5 million/equivalent is covered.

There is a collective indemnity limit to 30 million p.a. for all participating *epi* members which according to insurance calculations will hardly be reached. The premium for the *epi* Excess Liability Insurance scheme for the insurance year 1997/1998 amounts to DM 750,- plus insurance tax.

Persons wishing to join the *epi* insurance policy should directly contact the broker, Funk GmbH, for all policy matters, application forms etc., and payments. Please make your payments to the broker's account mentioned hereafter, free of bank charges, indicating the following reference "*epi* insurance 01 004742 5000" (this is the *epi* client number with the broker) as well as your name.

epi invites each member to carefully consider joining the *epi* Excess Liability Insurance scheme since clients' claims may easily reach the sum of DM 5 million. They may ruin your economic and professional situation if no adequate insurance cover is provided for. The *epi* Excess Liability Insurance scheme improves your insurance cover at a reasonable price and provides insurance cover for you as an *epi* member in all eighteen EPC contractual countries regardless of where you exercise your profession.

For further information on the *epi* Excess Liability Insurance please contact:

Funk International GmbH
Postfach 30 17 60
D-20306 Hamburg
Phone: ..49-40-359 14-2 24
Fax: ..49-40-359 14-4 23
Attn.: Mrs. Gunhild Peiniger

The bank connection of Funk International GmbH is:
Account No. 9 131 310 00
Bank Code 200 800 00
Dresdner Bank AG, Hamburg, Germany

Training Programme in preparation for the European Qualifying Examination 1998

Queen Mary and Westfield College
University of London

The 1998 Training Programme on the European Patent for students preparing for the European Qualifying Examination will be held from 26th–28th January 1998. Cost: £ 600 inclusive of documentation, refreshments and lunches.

As the course is usually over subscribed, applicants are advised to book early to avoid disappointment. Please note that there are only 30 places available for 26th–28th January. If there is sufficient demand, a second course may be offered from 27th–29th January. Offers will only be made on return of *completed application forms* on a first come, first served basis.

For further details please contact:

Intellectual Property Law Unit
Centre for Commercial Law Studies
Queen Mary and Westfield College
339 Mile End Road
GB-London E1 4NS

Tel: (0171) 975 5126
Fax: (0181) 981 1359
Email: S.C.Ng@qmw.ac.uk

Spring Exhibition of *epi* Artists Munich 9 to 27 March 1998

Last call to the *epi* Artists who have overlooked our note in *epi* Information 2/1997.

Some 15 people have already shown interest in our exhibition and have proposed a wide and interesting range of works of art. Further participants are welcome to join them.

Last deadline for registration:

23 January 1998

If you are interested, please inform the *epi* Secretariat:

epi Secretariat
P.O Box 260112
80058 München
Germany

Tel: +49 89 201 70 80

Fax: +49 89 202 15 48

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Postgraduate engineer (Ph.D, CEIPI) in the field of chemistry and biophysics, bilingual German/French, after several year's practice in Swiss and French law firms and a background in public R & D and Technology Transfer Organisations

seeks new opportunities

to collaborate with an intellectual property law firm.

Please write in confidence c/o epi Secretariat

Einbanddecken · Binders · Reliures

Please note that from 1997 on binders will include two years of *epi* Information. Therefore, the next possible

order will be at the end of 1998, for the years 1997 and 1998.

Redaktionsschluß für
epi Information
1/1998

Redaktionsschluß für die nächste *epi* Information ist der **13. Februar 1998**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

Deadline for
epi Information
1/1998

Our deadline for the next issue of *epi* Information is **13 February 1998**. Documents for publication should have reached the Secretariat by this date.

Date limite pour
epi Information
1/1998

La date limite de remise des documents pour le prochain numéro de *epi* Information est le **13 février 1998**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.



*Institut der beim Europäischen Patentamt
zugelassenen Vertreter*

*Institute of Professional Representatives
before the European Patent Office*

*Institut des mandataires agréés près
l'Office européen des brevets*

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2 January 1998

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Bei Zahlungseingang nach dem **30. April 1998** erhöht sich der Beitrag um **DM 50**.

Falls Ihr Beitragskonto schon einen Fehlbetrag aufweist, erhalten Sie ein zusätzliches Blatt. Bitte überweisen Sie dann auch den Fehlbetrag.

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Payments received after **30 April 1998** are subject to a surcharge of **50 DM**.

If your subscription account shows a deficit already, a separate sheet is attached. In this case please also transfer the outstanding amount.

Cette facture vous est envoyée pour votre déclaration d'impôts, même si vous avez déjà fait une demande de prélèvement automatique.

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Der Schatzmeister
Knud Erik Vingtoft

The Treasurer
Knud Erik Vingtoft

Le Trésorier
Knud Erik Vingtoft

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Retournez s.v.p. à:

epi-Sekretariat
Postfach 26 01 12

D-80058 München

Telefax 089 - 202 15 48**Einzugsermächtigung****Direct debiting mandate****Autorisation de prélèvement**

Eingangsfrist im
epi-Sekretariat:

Deadline for receipt by the
epi Secretariat:

Date limite de réception au
Secrétariat de l'epi:

15. Februar**15 February****15 février**

Bitte senden Sie diese Einzugsermächtigung oder eine Kopie hiervon **nur an das epi-Sekretariat**, nicht an das EPA.

Please, send this debiting mandate or a copy thereof **to the epi Secretariat only**, not to the EPO.

Veillez envoyer cette autorisation de prélèvement ou une copie de celle-ci **uniquement au Secrétariat de l'epi**, pas à l'OEB.

Bitte verwenden Sie **nur dieses Formular**, gegebenenfalls mit einem gesonderten Blatt für die Namen mehrerer epi-Mitglieder. **Verwenden Sie keine Einzugsermächtigungen des EPA.**

Please use only this form, if necessary with a separate sheet for the names of several epi members. **Do not use EPO mandate forms.**

Veillez n'utiliser que ce formulaire; ajoutez si nécessaire une feuille séparée pour les noms de plusieurs membres de l'epi. **N'utilisez pas les formulaires d'autorisation de prélèvement de l'OEB.**

Name/Vorname des **epi-Mitglieds**:
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Nom/prénom du **membre de l'epi**

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

Die Einzugsermächtigung gilt für **mehrere epi-Mitglieder**.
Falls "ja", bitte ein gesondertes Blatt mit den Namen und Mitgliedsnummern beifügen.

This direct debiting mandate applies to **more than one epi member**.
If "yes", please list names and membership numbers on a separate sheet.

nein ja
 no yes
non oui

L'autorisation de prélèvement s'applique à **plusieurs membres de l'epi**.
Dans l'affirmative, prière de joindre au présent formulaire une feuille séparée portant le nom et le numéro de ces membres.

Name des **Kontoinhabers**:
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EPO account number:
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Datum · Date

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Signature du **titulaire du compte**

Einzugsermächtigung

Eingangsfrist im *epi*-Sekretariat: **15. Februar**

Das Institut der beim Europäischen Patentamt zugelassenen Vertreter (*epi*) wird hiermit ermächtigt, den *epi*-Jahresbeitrag für das unten angegebene *epi*-Mitglied in der jeweils gültigen Höhe von dem nachstehend genannten und beim Europäischen Patentamt (EPA) geführten laufenden Konto einzuziehen. Die Einzugsermächtigung gilt für den nächstfälligen und künftig fällige Beiträge bis auf schriftlichen Widerruf. Sie gilt ebenso für offene Beiträge vergangener Jahre. Der Einzug erfolgt auf der Grundlage der zwischen dem EPA und dem *epi* getroffenen Verwaltungsvereinbarung vom 5. April 1993 (ABl. EPA 1993, 367) und der Nr. 9 der Vorschriften über das laufende Konto (ABl. EPA 1993, 366).

Der Einzug des Beitrags erfolgt mit Wirkung vom 25. Februar des laufenden Jahres. Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen gehen dem Einzug des *epi*-Beitrags vor. Mehrere Beiträge, die vom selben Konto abgebucht werden sollen, faßt das *epi* zu einem Gesamtbetrag zusammen. Demgemäß erteilt das *epi* dem EPA einen Abbuchungsauftrag über den Gesamtbetrag. Reicht das Guthaben nach

Begleichung der vorrangigen EPA-Gebühren und Auslagen zur Ausführung des Abbuchungsauftrags des *epi* nicht aus oder trifft die vorliegende Einzugsermächtigung beim *epi* nach dem 15. Februar ein, kann der Abbuchungsauftrag nicht ausgeführt werden. Das *epi*-Mitglied wird über den fehlgeschlagenen Einzugsversuch informiert. Überweist es den Beitrag dann nicht bis spätestens 30. April (Kontoeingang) für das *epi* spendefrei im normalen Bankverkehr, erfolgt ein Einzugsversuch des erhöhten Jahresbeitrags am 25. Juni. Schlägt auch dieser Versuch fehl, muß der erhöhte Beitrag im normalen Bankverkehr beglichen werden.

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

Falls ein gesondertes Blatt mit den Namen mehrerer *epi*-Mitglieder beigefügt wird, braucht es nicht gesondert unterschrieben zu werden.

Direct debiting mandate

Deadline for receipt by the *epi* Secretariat: **15 February**

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

Subscriptions are debited with effect from 25 February of each year. All fees and costs payable to the EPO on the debiting date have priority over the *epi* subscription. The *epi* will combine several subscriptions to be debited from the same account into one overall sum, for which it will then issue the EPO with a debit order. If, after priority

payment of EPO fees and costs, the credit balance is not sufficient to carry out the *epi* debit order, or if the direct debiting mandate is received by the *epi* after 15 February, the debit order is not carried out. The *epi* member will be informed. Then, if the annual subscription has not been credited to the *epi* account through the standard banking procedure and at no expense to the *epi* by 30 April (reception on *epi*-account), an attempt will be made to debit the higher annual subscription on 25 June. Should this attempt also prove unsuccessful, the higher annual subscription must be paid to the *epi* through the standard banking procedure.

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

If a separate sheet with the names of several *epi* members is enclosed, it does not need a separate signature.

Autorisation de prélèvement

Date limite de réception au Secrétariat de l'*epi*: **15 février**

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

Le prélèvement de la cotisation prend effet le 25 février de l'année en cours. Le règlement de toutes les taxes et de tous les frais dûs à l'OEB à la date de débit a priorité sur le prélèvement de la cotisation annuelle à l'*epi*. L'*epi* regroupe en un seul montant plusieurs cotisations devant être débitées du même compte. A cette fin, l'*epi* donne à l'OEB un ordre de débit pour le montant

total. Si, après règlement prioritaire des taxes et des frais dûs à l'OEB, la provision du compte ne suffit pas pleinement pour exécuter l'ordre de débit de l'*epi* ou si la présente autorisation parvient à l'*epi* après le 15 février, l'ordre de débit ne peut être exécuté, et le membre en est informé. Si celui-ci ne vire pas le montant de la cotisation le 30 avril au plus tard (date d'inscription au compte de l'*epi*), par une opération bancaire normale et sans frais pour l'*epi*, il sera procédé, le 25 juin, au prélèvement du montant majoré de la cotisation annuelle. Au cas où ce prélèvement non plus ne peut être effectué, le montant majoré de la cotisation doit être acquitté par une opération bancaire normale.

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

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

Regeln für die Zahlung der *epi* Mitgliedsbeiträge

Beschluß des *epi* Rates auf seiner Sitzung in Kopenhagen am 11./12. Mai 1992

- 1) Der jährliche *epi* Mitgliedsbeitrag ist innerhalb von zwei Monaten nach Fälligkeit zu zahlen.
- 2) Für Mitglieder, die bereits zu Anfang eines Jahres in die Liste der zugelassenen Vertreter eingeschrieben sind, ist das Fälligkeitsdatum der 1. Januar.
- 3) Für Mitglieder, die erst im Verlauf eines Jahres in die Liste der zugelassenen Vertreter aufgenommen werden, ist das Fälligkeitsdatum der Tag der Eintragung in die Liste.
- 4) Der jährliche Mitgliedsbeitrag wird erlassen, wenn
 - der schriftliche Antrag des Mitgliedes auf Löschung von der Liste der zugelassenen Vertreter vor dem 1. April beim Europäischen Patentamt eingeht;
 - eine Person nach dem 30. September in die Liste der zugelassenen Vertreter aufgenommen wird.
- 5) In allen anderen Fällen muß der volle jährliche Mitgliedsbeitrag bezahlt werden. Ratenzahlungen, Stundungen oder Beitragsreduzierungen können nicht gewährt werden.
- 6) Zahlt ein Mitglied, das bereits zu Anfang des Jahres auf der Liste der zugelassenen Vertreter stand, seinen Beitrag nicht vor dem 1. Mai (Eingang auf dem *epi* Konto), erhöht sich sein Beitrag um DM 50.-. Gleiches gilt für Mitglieder, die erst im Verlauf des Jahres in die Liste der zugelassenen Vertreter aufgenommen worden sind, falls sie ihren Mitgliedsbeitrag nicht innerhalb von vier Monaten nachdem sie durch „*epi*-Information“ oder einen Brief über seine Höhe informiert worden sind, zahlen.
- 7) Zahlungen müssen mittels Banküberweisungen, in Deutsche Mark und frei von Bankspesen für *epi* erfolgen. Dabei sind der Name und die Mitgliedsnummer jedes einzelnen Mitglieds, für das die Zahlung erfolgt, anzugeben.
- 8) Wegen der beachtlichen Bankgebühren und darüber hinaus wegen des großen zusätzlichen Verwaltungsaufwand werden keine Schecks, Bankschecks, kein Bargeld oder ähnliches angenommen.
- 9) Der *epi* Rat beschließt Änderungen des Mitgliedsbeitrages vor Anfang des Folgejahres. Er informiert alle Mitglieder durch „*epi*-Information“ über den neuen Beitragsbetrag und die Zahlungsmodalitäten. Alle Mitglieder, von denen angenommen werden kann, daß sie die entsprechende „*epi*-Information“ erhalten haben, müssen Zahlungsvorkehrungen innerhalb der oben genannten Zeitspanne treffen, ohne daß eine zusätzliche Aufforderung hierzu erfolgt. Der Schatzmeister wird jedoch zu Beginn eines Jahres bzw. bei neuen Mitgliedern nach Eintragung in die Liste zusätzlich Rechnungen an alle Mitglieder verschicken. Verspätete Zahler, von denen angenommen werden kann, daß sie die oben genannte „*epi*-Information“ erhalten haben, können sich aber nicht darauf berufen, diese Rechnung nicht erhalten zu haben.

Rules Governing Payment of the *epi* Annual Membership Fee

Decision taken by the *epi* Council at its meeting in Copenhagen on 11/12 May 1992

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

Règles relatives au paiement de la cotisation annuelle *epi*

Décision prise par le Conseil de l'*epi* à la réunion de Copenhague les 11 et 12 mai 1992

- 1) Le paiement de la cotisation annuelle *epi* est dû dans les deux mois qui suivent la date d'exigibilité.
- 2) La date d'exigibilité pour les personnes inscrites sur la liste des mandataires agréés au début de l'année est le 1er janvier.
- 3) La date d'exigibilité pour les personnes admises sur la liste des mandataires agréés en cours d'année est la date d'admission sur cette liste.
- 4) N'est pas redevable de la cotisation de l'année en cours:
 - un membre qui demande par écrit à l'OEB sa radiation de la liste des mandataires agréés avant le 1er avril;
 - toute personne inscrite sur la liste des mandataires agréés après le 30 septembre.
- 5) La cotisation annuelle doit être payée dans son intégralité dans tous les autres cas. Aucun versement partiel, report d'échéance ou réduction du montant ne peut être accepté.
- 6) Toute personne inscrite sur la liste des mandataires agréés au 1er janvier et dont la cotisation n'est pas payée avant le 1er mai (date de réception sur le compte de l'*epi*) doit payer un supplément de 50.– DM. Ceci s'applique également à toutes les personnes inscrites sur la liste en cours d'année, dont la cotisation n'est pas réglée dans les quatre mois qui suivent la notification dans „*epi* Information“ ou par lettre.
- 7) Le paiement doit être fait par virement, en Deutsche Marks, sans frais bancaires pour l'*epi*. Le nom et le numéro d'affiliation de la/les personne(s) pour qui la cotisation est destinée doivent être indiqués clairement sur le virement.
- 8) Les chèques, les chèques bancaires, les règlements en espèces ou autres ne sont pas acceptés en raison des frais bancaires importants et de l'énorme supplément de travail que leur traitement nécessite.
- 9) Le Conseil de l'*epi* décide des modifications du montant de la cotisation annuelle avant le début de l'année. Tous les membres sont informés par „*epi* Information“ du nouveau montant de la cotisation et des conditions de paiement. Toute personne qui, en tant que membre, reçoit „*epi* Information“ devra s'assurer que sa cotisation est payée dans le délai imparti, ci-dessus mentionné, sans autre notification. Le Trésorier enverra toutefois aussi un appel de cotisation à tous les membres au début de l'année, de même qu'aux nouveaux membres après leur inscription. Toute personne recevant en tant que membre „*epi* Information“, mentionné plus haut, et n'ayant pas payé sa cotisation à temps ne pourra pas alléguer qu'elle n'a pas reçu l'appel de cotisation.

epi-Mitgliedschaft und Jahresbeitrag

1. Internationale Kammerorganisation

Das *epi* ist die Standesorganisation der beim Europäischen Patentamt zugelassenen Vertreter. Es besteht Pflichtmitgliedschaft. Das *epi* erfüllt ähnliche Aufgaben wie nationale Standesorganisationen, z.B. die deutsche Patentanwaltskammer. Seine Mitglieder sind sowohl Freiberufler als auch in der Industrie oder im staatlichen Bereich Tätige. Voraussetzung für die Mitgliedschaft ist u.a. der Erwerb eines natur- oder ingenieurwissenschaftlichen Hochschuldiploms bzw. gleichwertiger natur- oder ingenieurwissenschaftlicher Kenntnisse, eines mindestens dreijährigen patentrechtlichen Praktikums und das erfolgreiche Ablegen der Eignungsprüfung beim Europäischen Patentamt.

Das *epi* ist also die Kammerorganisation des Europäischen Patentamtes. Es ist eine Körperschaft internationalen öffentlichen Rechts.

2. Mitgliedschaft

Die Pflichtmitgliedschaft, die automatisch mit Eintrag in die Liste der zugelassenen Vertreter beim EPA begründet wird, beruht auf Artikel 5, die Verpflichtung zur Entrichtung des Jahresbeitrages auf Artikel 6 der Vorschriften über die Errichtung des Instituts, vgl. ABl. EPA 2/1978, S. 85 ff. Die Mitgliedschaft endet ebenso automatisch mit der Streichung aus der EPA-Liste.

Nach einer Streichung aus der Vertreterliste kann jederzeit ein Antrag auf Wiedereintragung in die Liste gestellt werden. Es dürfen jedoch keine gegenteiligen disziplinarischen Maßnahmen vorliegen. Eventuell in früheren Zeiten nicht entrichtete Mitgliedsbeiträge müssen zuvor nachentrichtet werden. Bei einer Wiedereintragung in die Vertreterliste braucht keine Eignungsprüfung abgelegt zu werden.

Beim *epi* gibt es nur Vollmitgliedschaft, keine ruhende Mitgliedschaft. Wer die Jahresgebühren für einige Zeit sparen will, muß sich vor dem 1. April des laufenden Jahres von der Liste der zugelassenen Vertreter beim EPA streichen lassen und gegebenenfalls später einen Antrag auf Wiedereintragung in die Liste stellen. Bitte richten Sie Ihren Antrag auf Streichung/Wiedereintragung an das EPA, Direktion 5.1.1.

3. Jahresbeitrag

Die Verpflichtung zur Entrichtung des *epi*-Jahresbeitrages entsteht mit Eintragung in die Liste der zugelassenen Vertreter.

Verschiedentlich ist der Wunsch nach Aus- oder Herabsetzung dieses Beitrages von z.Z. DM 300,- geäußert worden. Diese Frage hat mehrfach den *epi*-Rat und Vorstand beschäftigt. U.a. angesichts der vergleichsweise geringen Höhe des Beitrages wurde eine Aus- oder Herabsetzung abgelehnt. Damit gilt, daß der Mitgliedsbeitrag für das laufende Jahr nur entfällt, wenn

- a) die Streichung von der Vertreterliste vor dem 1. April erfolgt ist;
- b) der Eintrag in die Vertreterliste erst nach dem 30. September vorgenommen wurde.

Der Jahresbeitrag kann nicht gequotelt werden. Er ist in voller Höhe auch bei Eintragung in die Liste während des Kalenderjahres zu entrichten, es sei denn er entfällt ganz, wenn die oben unter a) und b) genannten Voraussetzungen vorliegen.

Bitte beachten Sie, daß der Vorstand und Rat des *epi* bei allen Entscheidungen zu beachten haben, daß es sich bei dem *epi* nicht um eine nationale Einrichtung handelt, sondern daß 18 Staaten am Patentübereinkommen beteiligt sind.

epi membership and membership subscription

1. Professional Association

epi is the professional association with compulsory membership of Professional Representatives before the European Patent Office (European Patent Attorneys). Its tasks are comparable to those of national professional associations such as the British Chartered Institute of Patent Agents. Its members come from the free profession as well as the industry and government sectors. Requirements for membership are a university level scientific or technical qualification or an equivalent level of scientific or technical knowledge, a full-time training period of at least three years, and passing the European Qualifying Examination.

epi is an international public law corporation.

2. Membership

All persons entered in the list of Professional Representatives, kept by the European Patent Office (EPO), automatically become a member of the *epi*, Art. 5 of the Regulation on the Establishment of an Institute of Professional Representatives before the European Patent Office, OJ EPO 2/1978, p. 85 et seq. Their obligation to pay the annual subscription to *epi* results from Art. 6, loc. cit. Membership automatically expires as soon as a member is deleted from the list of the EPO.

After having been deleted from the list, a member may at any time file an application for reinstatement. There must, however, be no contradicting disciplinary measures. Outstanding membership subscriptions have to

be paid before reinstatement. There is no need to pass the European Qualifying Examination again for being reinstated.

epi has only one membership status, no associate membership or the like. Persons who do not want to pay their annual subscription for one or more years need a deletion from the list of professional representatives before 1 April of the current year. They may apply for reinstatement later on. Application for reinstatement has to be sent to the EPO, Directorate 5.1.1.

3. Membership subscription

The obligation to pay the annual *epi* membership subscription starts with the registration on the list of Professional Representatives kept by the European Patent Office.

Occasionally, requests have been made for suspension or reduction of the membership subscription, currently amounting to 300 DM. The *epi* Council and Board have

considered this question many times and have decided that the membership subscription may neither be suspended nor reduced. One of the reasons for this decision is the already low amount of the membership subscription. It is waived if

- a) a member's written demand for deletion from the list of professional representatives arrives at the European Patent Office prior to 1 April;
- b) a person is registered on the list of professional representatives after 30 September.

The entire membership subscription, and not only a proportion, has to be paid even if a person is entered on the list in the course of the year, except if the above-mentioned conditions under a) and b) are fulfilled.

Please keep in mind that the *epi* Board and Council have to take into consideration that all decisions they take concern an international organization involving 18 Contracting States to the European Patent Convention and not only one single country.

Affiliation à l'*epi* et cotisation annuelle

1. Organisation internationale de l'Ordre des mandataires agréés près l'Office européen des brevets

L'*epi* remplit auprès de l'Office européen des brevets les mêmes fonctions que, au niveau national, le Barreau pour les avocats ou l'Ordre pour les médecins, avec cependant la particularité que non seulement les personnes appartenant à la profession libérale mais également celles qui exercent dans l'industrie ou dans le secteur public en sont membres. Peuvent faire partie de l'*epi* les personnes titulaires d'un diplôme scientifique ou technique de niveau universitaire ou bien ayant des connaissances scientifiques ou techniques de niveau équivalent, qui ont accompli un stage d'au moins trois ans dans le domaine du brevet et réussi l'examen européen de qualification de l'Office européen des brevets.

L'*epi* est donc l'Ordre des mandataires agréés près l'Office européen des brevets. C'est une association de droit public.

2. Affiliation

L'affiliation obligatoire qui est automatiquement suivie de l'inscription sur la Liste des mandataires agréés de l'OEB, repose sur l'Article 5 du Règlement relatif à la création de l'Institut, et l'obligation d'acquitter la cotisation annuelle sur l'Article 6, voir JO OEB 2/1978, p. 85 et suiv. L'affiliation à l'*epi* expire automatiquement avec la radiation de la liste de l'OEB.

Une personne qui s'est fait radier de la Liste des mandataires peut à tout moment se faire réinscrire, à condition qu'aucune mesure disciplinaire à son encontre ne l'interdise. Les cotisations éventuellement impayées doivent être réglées au préalable. Il n'est pas nécessaire de repasser l'examen de qualification pour se faire réinscrire sur la liste des mandataires.

Les membres de l'*epi* sont tous des membres actifs. Il n'est pas possible de suspendre l'affiliation. Si une personne désire ne pas payer de cotisation annuelle pendant quelque temps, elle doit demander sa radiation de la liste des mandataires de l'OEB avant le 1er avril de l'année en cours et refaire une demande d'inscription plus tard. La demande de radiation/réinscription doit être adressée à l'OEB, direction 5.1.1.

3. Cotisation annuelle

L'inscription sur la liste des mandataires entraîne automatiquement l'obligation d'acquitter la cotisation annuelle.

Une suspension du paiement de la cotisation ou une réduction de son montant, actuellement de 300 DM, n'est pas possible. Une éventuelle suspension ou réduction de la cotisation a souvent été considérée par le Conseil et le Bureau de l'*epi*. Cette possibilité a été rejetée en raison, entre autres, du montant relativement peu élevé de la cotisation. Une personne est toutefois dispensée d'acquitter la cotisation annuelle si

- a) elle se fait radier de la liste des mandataires avant le 1er avril;
- b) elle se fait réinscrire sur la liste des mandataires après le 30 septembre.

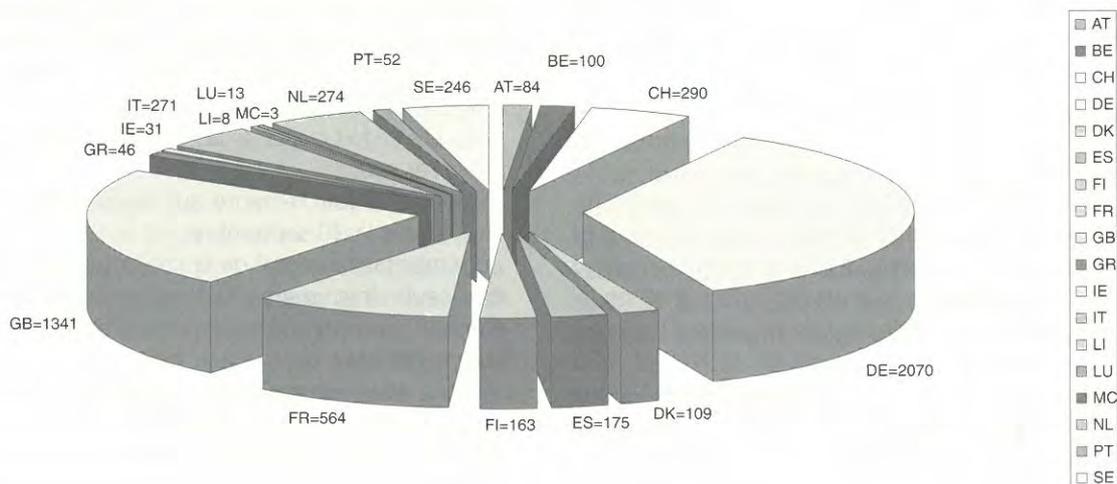
Le montant intégral de la cotisation doit être payé en une seule fois, même si l'inscription a lieu en cours d'année, exception faite des conditions citées ci-dessus aux points a) et b).

Nous vous rappelons que le Bureau et le Conseil de l'*epi* doivent, pour chaque décision, tenir compte du fait que l' est une organisation internationale constituée non pas d'un seul pays mais de 18 Etats Contractants de la Convention sur le brevet européen.

Liste der beim EPA zugelassenen Vertreter nach dem Stand vom 01. 11. 1997

Vertragsstaat	Zahl zug. Vertr.	% zug. Vertr.
AT	84	1,44
BE	100	1,71
CH	290	4,97
DE	2070	35,45
DK	109	1,87
ES	175	3,00
FI	163	2,79
FR	564	9,66
GB	1341	22,96
GR	46	0,79
IE	31	0,53
IT	271	4,64
LI	8	0,14
LU	13	0,22
MC	3	0,05
NL	274	4,69
PT	52	0,89
SE	246	4,21
Total	5840	100,00

Zahl der Zugelassenen Vertreter



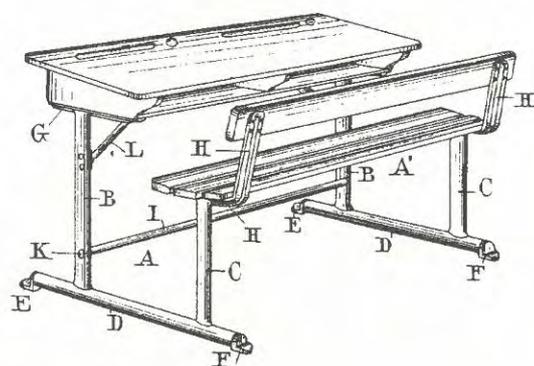


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Compendium



**Aufgaben der europäischen Eignungsprüfung
1990 - 1992, 1993, 1994, 1995, 1996 und 1997**

**Papers of the European qualifying examination
1990 - 1992, 1993, 1994, 1995, 1996 and 1997**

**Epreuves de l'examen européen de qualification
1990 - 1992, 1993, 1994, 1995, 1996 et 1997**



Compendium

Bestellung • Order • Commande

Gewünschte Anzahl / Number requested / Nombre souhaité

	Preis per Broschüre* Price per booklet* Prix par brochure*	A Chemie Chemistry Chimie	B Chemie Chemistry Chimie	A Elektrotechnik/Mechanik Electricity/Mechanics Electricité/mécanique	B Elektrotechnik/Mechanik Electricity/Mechanics Electricité/mécanique	C Einspruch Opposition Opposition	D Rechtskenntnisse Legal knowledge Connaissances juridiques
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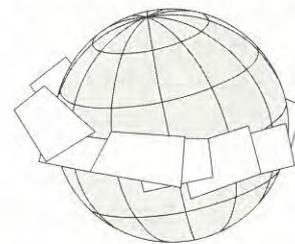
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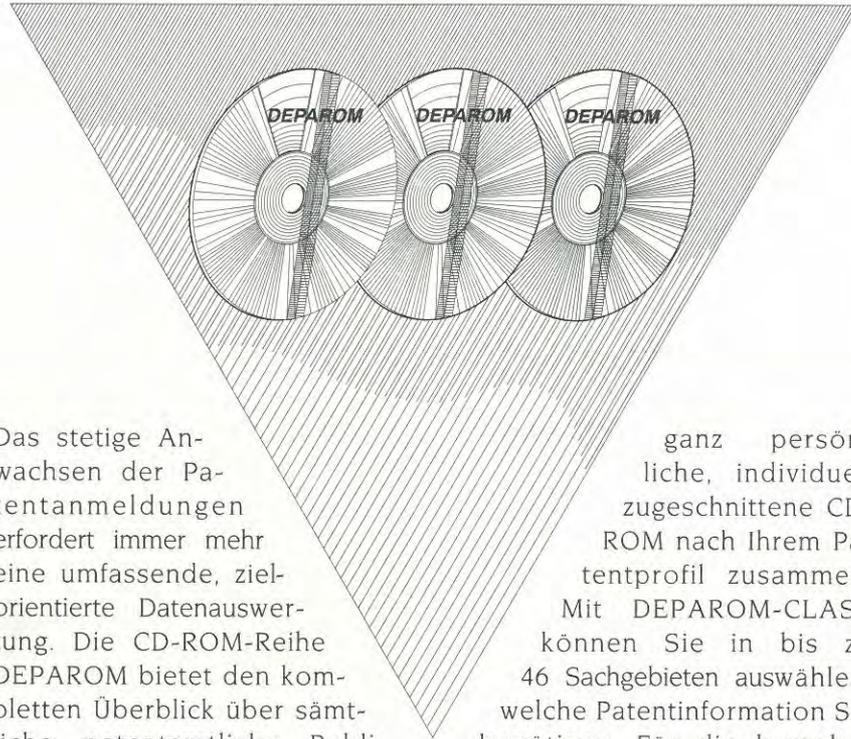
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