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
Schriftleitung

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Verlag · Publishing House · Maison d’édition

Carl Heymanns Verlag KG
Luxemburger Straße 449
D-50939 Köln
Tel. (0221) 94 373-0
Fax (0221) 94 373-901
e mail: service@heymanns.com
http://www.heymanns.com

grafik + druck, München

Anzeigen · Advertisements · Publicité

Druck Printing Imprimeur

ISBN 3-452-23867-9
ISSN 1434-8853
© Copyright epi 1998

Vierteljahreszeitschrift
Abonnementpreis im Mitgliedsbeitrag enthalten, für Nichtmitglieder DM 70,00 p. a. (zuzüglich Versandkosten)

Quarterly Journal
Subscription fee included in membership fee, for non-members DM 70,00 p. a. (plus mailing expenses)

Publication trimestrielle
Prix d’abonnement inclus dans la cotisation, pour non-membres DM 70,00 p. a. (frais d’envoi en sus)
# Table of Contents

### Editorial

126

### Council Meeting

127
Entwurf der Beschlußliste
129
130
Draft List of Decisions
132
Rapport de la 45ème réunion du Conseil, La Haye, 12-13 octobre 1998
133
Projet de Liste de Décisions
135
President's report
136
Treasurer's report
138

### Committee Reports

Report of the Committee on EPO Finances, by J.U. Neukom
138
Report of the EPPO Committee, by A. Casalonga
139
Report of the Finance Committee, by B. Feldmann
142
Report of the Harmonisation Committee on the Standing Committee on the Law of Patents, by J.D. Brown
143
Report of the Professional Qualification Committee, by F. Macchetta
144
Report on Utility Models proposals, by P. Shortt
145

### Reports and Submissions

A Grace Period for Patents, by A. Huygens
148
Regional Professional Bodies - the epi experience, by A. Huygens
150
Amicus Curiae Brief to the Enlarged Board of Appeal, filed by epi
153

### Articles

Le Décal de Grâce, par J.J. Martin
160

US Patent Law Post Markman/Hilton-Davis, A Gaze into a fractured Crytal Ball, by J. Dulin
161

### Letters to the editor

The novelty Test of Article 123(2) and Article 54(3) EPC, by Roy Marsh
165
Response to Jon Orchard's letter "Are Patent Attorneys Needed?", by M. G. Harman
167

### Notes from the Editorial Board

epi Home Page, 4th editorial Board member
167
News Section epi Home page
168

### European Qualifying Examination

Results of the European Qualifying Examination 1998
169
Student page
170
epi studentship and application form
170

### Discipline

Case CD 6/97
173
Case CD 1/98
174

### Information from the Secretariat

Training programme Queen Mary & Westfield College
176
EPO Travelling Exhibition
176
Deadline 1/1999
176
epi Membership / epi subscription
177
epi Membership chart as of 4 November 1998
184
Searchable Patent Attorneys' database on the EPO's website
185
IPR Helpdesk
185
Binders for epi Information
186
epi Committees
187
epi Board
U3
Editorial

Once again, the results of the European Qualifying Examination (published elsewhere in this edition of epi Information) are said to be disappointing. Once again, questions are being asked as to the reasons for the number of failures.

Part of the apparent problem may be statistical. If it is accepted that there is a “core” group of individuals who are unlikely to pass this year or for the next two or three and it is accepted that a similar core is contained within the first sitting group each year, then each year the number of failures will multiply with the addition of a further “core” of long-term-failures. As more and more of such long-term failures take the exam each year, the overall percentage of passes decreases. It is interesting to note that, whilst there were more candidates taking the examination this year, the number of individuals passing the examination is almost identical to last year (239 last year, 234 this year).

What is of possibly more importance, is the responsibility that all qualified epi members bear to the students.

It is surely incumbent upon all of us that students are made aware of the options available to them in terms of preparation for the examination. There are many ways of preparing for the examination, including the epi tutorials (details of which were in epi information 3/98 and are found on the website), courses such as the CEIPI course and tutorials run by national Institutes.

Probably the worst way of preparing for the examinations is to take the actual examinations themselves! It seems, however, that this is one way that candidates try and prepare themselves for the examinations — by taking the examinations when they are not ready. This unfortunately, means that the candidates usually fail which, is psychologically not good, and, further, is the one means of preparing for the examinations in which the candidates do not discover exactly where they went wrong. They are, therefore, not able to correct their flaws.

All epi members should consider to what extent they are fulfilling their responsibility of ensuring that students are properly trained and prepared as far as is possible. This could include ensuring that students were aware of the epi student membership scheme, ensuring that students were aware of the various tutorials that they could join, and encouraging them to do so, as well passing on experience and advice. It could also include ensuring that students do not attempt to sit the examination until they are fully prepared and have a reasonable chance of passing the papers for which they have enrolled.

The European Qualifying Examination is not an easy examination to pass requiring hard work and dedication. It would seem to be the responsibility of all epi members to ensure that the burden on candidates is not increased unduly.

Jon Gowshall · Thierry Schuffenecker · Edith Vinazzer
Bericht über die 45. Ratssitzung in Den Haag
12./13. Oktober 1998

Wieder einmal gelang es bei dieser Ratssitzung, der 45., die in Den Haag stattfand, die Geselligkeit und Herzlichkeit mit einer Menge harter Arbeit und Fortschritten auf vielen Gebieten zu verbinden. Die Sitzung fand im EPA statt, das, wie immer, großzügiger Gastgeber war.


Der Präsident unterbricht anschließend seinen Bericht, der in dieser epi Information abgedruckt ist.


Diese Partnerschaft müsse sich weiteren Herausforderungen stellen. Diese Herausforderungen beträfen u.a. die Globalisierung und die wachsende Anzahl von Anmeldungen beim EPA, viele mit obligatorischen Fristen. Die Beibehaltung der Arbeitsleistung bei gleichzeitiger Beibehaltung der niedrigen Kosten seien weitere Herausforderungen für das EPA.

Das EPA beabsichtigte, die gegenwärtigen Recherchenrückstände bis zum Ende des Jahres 2000 abzubauen, voraussichtlich, die Anmeldezahlen explodieren nicht weiter. Er wies darauf hin, daß das europäische System ursprünglich für 30.000 Anmeldungen vorgesehen war, gegenwärtig jedoch 120.000 Abmeldungen bearbeitet würden.

Neue interessante Wege öffneten sich, mit der Möglichkeit eines neuen "Schnellspursystems" und Vorschlägen, das System der Ausdehnung auf mehr Länder anzuwenden. Vor allem aber sei sich das EPA bewußt, daß es schnelle Arbeit leisten müsste, um seine Dienstleistungen ebenso schnell wie das US-Patentamt anbieten zu können.


Anschließend wies Herr Michel darauf hin, daß das EPA der Meinung sei, daß das BEST-Programm sei für die Voraussetzungen des gegenwärtigen Recherchenrückstandes unbedingt erforderlich, da es den Prüfern die notwendige Flexibilität verleihe, die Recherchen und die Prüfung durchzuführen. Rein menschlich gesehen, kann die on-line Recherche von jemandem nicht jeden Tag den ganzen Tag lang durchgeführt werden und deshalb würde das BEST-Programm ermöglichen, eine größere Anzahl von Recherchen durchzuführen, weil die Last der Recherchenarbeit auf andere Prüfer verteilt werden könne. Man sei der Meinung, daß auch die erforderliche Tätigkeit besser durch erfahrene Prüfer bewertet werden könne. Herr Michel wies darauf hin, daß selbst dann, wenn das EPU so geändert würde, daß die volle Umsetzung des BEST-Programms erfolge, nicht mehr als 35% aller Anmeldungen unter dem BEST-Programm bearbeitet würden.

und es deshalb die Zahl der kommenden Recherchen im Auge behalten könne.

Die nächste Frage befaßte sich damit, daß der Rat informiert worden war, daß die Recherchekosten DEM 3.300 pro Recherche betragen und Herr Michel wurde um Information darüber gebeten, wie sich diese Kosten zusammensetzen. Herr Michel sagte, daß die Personalkosten DEM 2.000 betragen, die Kosten für die Dokumentation DEM 700, die Computerkosten DEM 300 und die overheads DEM 300.


Daraufhin beendete Herr Michel seine Ansprache unter langanhaltendem Applaus.


Zunächst berichtete der Vorsitzende des Ausschusses für die berufliche Qualifikation. Wie immer in den Herbst-Ratssitzungen, befassen sich die Diskussionen, die diesem Bericht folgten, hauptsächlich mit den ersten Reaktionen auf die Prüfungsergebnisse, die gerade veröffentlicht worden waren. Während einige Diskussionen die sehr schlechten Prüfungsergebnisse betrafen, drehten sich andere um die Berichte, daß die Prüfungsergebnisse schon im Internet veröffentlicht wurden, bevor die Kandidaten schriftlich informiert worden waren. Obwohl darauf hingewiesen wurde, daß sie schon vorab im Internet veröffentlicht werden würden, lag das Datum der Veröffentlichung sogar vor dem ursprünglich festgelegten Datum. Der Rat war der Meinung, daß es am besten wäre, die Prüfungskandidaten zuerst über ihre Ergebnisse zu informieren und in Zukunft nicht von angekündigten Veröffentlichungsdaten abzuweichen.

Es wurde auch darüber diskutiert, wie neu zugelassene epi-Mitglieder dazu ermutigt werden könnten, sich als epi-Tutoren und Prüfer für die europäische Eignungsprüfung zur Verfügung zu stellen. Es gab auch einige Diskussionen zu den Vorschlägen des Ausschusses für berufliche Qualifikation zur weiterführenden beruflichen Ausbildung, sowie zur europäischen Akademie, die vom EPA ins Leben gerufen wurde.

Die folgenden Berichte des Harmonisierungsausschusses und des Finanzausschusses waren kurz und prägnant.

Nach dem Mittagessen wurde die Ratssitzung erneut für eine Vorführung von Herrn Lépée, EPA, unterbrochen, der zeigte, wie eine Recherche von den europäischen Recherchenprüfern durchgeführt wird. Der Dauervortrag wurde von einem mit einem Computer verbundenen Projektor unterstützt, so daß eine on-line Recherche demonstriert werden konnte. Es wurde klar, daß viele technische Fähigkeiten benötigt werden, um eine Recherche durchzuführen, besonders zur Auswahl der Parameter. Interessanterweise scheint sehr großes Allgemeinwissen nötig zu sein, um sicherzustellen, daß die für die Recherche benötigten Begriffe nicht technische Begriffe enthalten, die, obwohl sie den gesuchten Begriffen ähnlich sind, aus einem völlig anderen technischen Gebiet stammen.

Nachdem Herr Lépée seine Demonstration unter großem Applaus beendet hatte, beantwortete er noch einige Fragen bevor die Ratssitzung wieder aufgenommen wurde.

Als nächstes berichtete der EPPC-Ausschuß. Dieser Bericht war wie immer detailliert und äußerst interessant und behandelte verschiedene wichtige Themen zum europäischen Patentgesetz.


Die Schriftleitung berichtete anschließend über eine geplante Ausgabe der epi information zu einem bestimmten Themenbereich und gab Empfehlungen für die Weiterführung der Neustrukturierung der Website. Kurze Berichte des EASY-Ausschusses, des Diszipli-
narausschusses, des Geschäftsordnungsausschusses sowie des Ausschusses für Biotechnologie folgten.

Dann befaßten sich die Ratsmitglieder mit den vorgeschlagenen Änderungen des europäischen Patentüberblicks. Die Vorschläge für die Antwort des epi auf die verschiedenen Änderungen wurden vom EPPC vorgebracht und im großen und ganzen ohne Kommentar angenommen. Eine Ausnahme war die lebhafte Diskussion darüber, ob der Artikel 84 EPC als Einspruchsgrund anerkannt werden sollte, was nach einer Abstimmung beschlossen wurde, sowie die formelle Eingliederung des epi in die Europäische Patentorganisation.


Anschließend wurde ein Bericht über die vorgeschlagene Änderung der Standesregeln, nach der Beurteilung durch die EU, unterbreitet. Der Rat wurde darüber informiert, daß die EU im November oder Dezember einen abschließenden Beschuß veröffentlichen werde. Es wurde bestätigt, daß der Vorstand ermächtigt sei, die geänderten und verbesserten Standesregeln sofort nach der Veröffentlichung des Beschlusses, mit sofortiger Wirkung in Kraft treten zu lassen.

Der Generalsekretär gab einen Überblick über die bevorstehende epi-VPP Fachtagung in Ulm und betonte die Notwendigkeit einer baldigen Anmeldung. Der Präsident berichtete dann über die Fortschritte, die seine Vorschläge zur Zukunft des epi gemacht hatten, insbesondere über die Kontakte zu nationalen und internationalen Verbänden. Es wurde darüber abgestimmt, ob frühere Präsidenten das Recht haben sollten, zu den Ratsitzungen eingeladen zu werden. Dieser Vorschlag wurde vom Rat mit der Bemerkung zurückgewiesen, daß der Präsident das Recht habe, jedermann zu den Ratsitzungen einzuladen, und daß die Einladung früherer Präsidenten deshalb nicht zur Regel werden soll.

In einer kurzen Abstimmung wurde der Vorschlag der schwedischen Bezeichnung für "European Patent Attorney" gebilligt und die Daten und Orte für die beiden nächsten Ratsitzungen festgelegt.

Schließlich wurde der Rat über die Daten und Veranstaltungsorte der EPA-Wanderausstellung informiert. Der Präsident erklärte die Sitzung, die letzte dieses Rates, für beendet.

Eine Liste der Beschlüsse, die auf dieser Ratsitzung gefaßt wurden, ist nachstehend abgedruckt.

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Entwurf der Ratsbeschlüsse, 45. Ratssitzung in Den Haag
12./13. Oktober 1998

1. Der Entwurf des Haushaltsplans für das Jahr 1999 wurde mit der Änderung gebilligt, DM 10.000 von Punkt 5.6 "Werbemaßnahmen" nach Punkt 5.7 "Internet" zu verschieben.

2. Der Rat beschloß, den Mitgliedsbeitrag für 1999 bei DM 300 zu belassen.

3. Der Rat stimmte mit einer klaren Mehrheit gegen die Veröffentlichung der Prüfungsergebnisse im Internet, bevor die Kandidaten persönlich und schriftlich benachrichtigt wurden.

4. Der Rat stimmte mit einer klaren Mehrheit gegen die gleichzeitige Veröffentlichung zusätzlicher Informationen oder anderer relevanter Ergebnisse mit den Prüfungsergebnissen.

5. Der Rat billigte den Vorschlag, die Herren J.D. Combeau und P. Weinhold als Mitglieder der Prüfungskommission wiederzuerkennen.

6. Der Rat beschloß, die Einschreibenbevollmächtigung für jene Studenten auf DM 70 zu reduzieren, die ihre Studentenmitgliedschaft für das 5. oder jedes darauffolgende Jahr verlängern möchten.

7. Der Rat beschloß, daß sich das epi bei der Einführung des Euro dem EPA anschließen wird, wo der Euro ab 1. März 1999 die DEM als Richtwährung ablösken wird.

8. Der Rat billigte folgende Empfehlung: "Beginnend mit dem Haushaltsjahr 1999 sollten die Ausgaben für "Delegierte und andere" soweit irgend möglich, nicht mehr unter Punkt 1.4 sondern statt dessen unter jenen Punkten aufgeführt werden, mit denen sie in Zusammenhang stehen.

9. Der Rat sprach sich dafür aus, daß die Erfindungshöhe von Gebrauchsmustern jener europäischer Patente entsprechen sollte.

10. Der Rat stimmte für die Möglichkeit, das Gebrauchsmuster von einer Patentanmeldung abzweigen zu können.


13. Der Rat sprach sich mit einer klaren Mehrheit für den doppelten Schutz aus (Artikel 22).

Änderungen, die durch Abstimmung beschlossen wurden.

15. Der Rat beschloß eine externe Firma mit der Neu-
strukturierung der epi-Website zu beauftragen und
billigte die damit verbundenen Kosten.

16. Der Rat sprach sich für die Einführung der Artikel 84
EPÚ, 100 und 138 als Einspruchsgründe aus.

17. Frühere Präsidenten werden nicht als Regel zu
Ratssitzungen eingeladen.

18. Der Rat billigte den Begriff “Europatentombud”
as schwedische Bezeichnung für “European Patent
Attorney”.

Report of the 45th Council Meeting in The Hague
12/13 October 1998

Once again this Council meeting, the 45th, held in the
Hague, managed to combine the convivial and cordial
with a great deal of hard work and progress on many
fronts. The meeting was held in the EPO who were, as
ever, generous hosts.

The meeting opened with the President, Arthur
Huygens, welcoming all to the Hague. The scrutineers
were appointed, the agenda adopted and the minutes of
the 44th Council Meeting in Helsinki were approved. No
new matters arose from those minutes.

The President then turned to a new, regular, item on
the agenda, which was decisions and measures which
had been taken by the Board since the last Council
Meeting. The topics included the subject of appointment
of Board members from new EPC countries in the middle
of the term of the Board, the grace period hearing in
Brussels of 5th October, 1998 hosted by the European
Union, the publication or otherwise of Committee
reports in epi Information and on the website, a proposal
for a further symposium on reduction of Patent costs and
the suggestion by the Chartered Institute of Patent
Agents that the list of candidates for epi Council elections
should be accompanied by a brief biography of the
candidate, if the national organisation think appropriate.

The President then introduced his report, which is
printed elsewhere in epi information.

The meeting was then briefly adjourned to welcome
Mr. Jacques Michel, Vice President of DG1. Mr. Michel
welcomed the Council members to the Hague. He said
that it was apposite that he should be addressing Council
on the 25th anniversary of the signing of the European
Patent Convention. The Convention had been a complete
success and he said that this was not only down to
the actions of the EPO but also attributable to the actions
of epi and its members.

Further challenges were facing this partnership. Such
challenges included globalisation and the increasing
number of applications at the EPO, many of them
associated with compulsory deadlines. Maintaining
the quality of work done by the EPO whilst keeping the costs
down, were further, associated, challenges.

The EPO is looking to dispose of its current backlog of
searches by the end of the year 2000, assuming that
there will be no further explosion in the number of
filings. He pointed out that the European system was
originally designed to cope with 30,000 applications, but
now deals with 120,000.

There were other interesting avenues opening, with
the possibility of the consideration of a new fast-track
system and proposals to expand the extension system to
more countries. Above all, the EPO was aware that its
work must be quick in order to provide an equivalent
speed of service to that provided by the U.S. Patent
Office.

Electronic tools are being used more and more and the
paperless search was close. In the previous days, of paper
searches, search Examiners used to consult up to 12,000
documents. Now, using electronic means, an average of
some 300 are consulted in each search – the rest of the
documents are viewed and dismissed on-line. This
increase in speed and efficiency has been accompanied
with the ability to cover broader areas than with the
older-style paper searches. Mr. Michel made reference to
a demonstration of searching that was to take place in
the afternoon.

Mr. Michel then went on to advise that, in the opinion
of the EPO, the BEST program was essential for removal
of the current backlog by giving the appropriate flexibility
of Examiners to conduct the searches and examination.
In purely human terms, on-line searching cannot
be carried out all day, everyday, by any one individual
and therefore the BEST program would allow more searches
to take place, by spreading the searching load amongst
other examiners. It was believed that this would also
allow inventive step issues to be better searched, by the
use of experienced examiners. Mr. Michel said that even
if the EPC be amended to allow full implementation of
the BEST programme, still no more than 35% of all
Applications will be dealt with under the BEST pro-
gramme.

Mr. Michel concluded his talk and answered several
questions from the audience. It had been noted that
there was a proposed decrease in the search fee, to be
considered by the Administrative Council. The question
was whether this would increase the backlog. Mr. Michel
said that this would be difficult to answer. At least with
any such reduction not being effected until 1st July, 1999
at the earliest, the EPO would have time to prepare for
any such increase such as, for example, appointing more Examiners to the BEST programme. Indeed, the biggest problem that the EPO has had with regard to searching backlog was the increase in the number of US-derived PCT Applications which designated the EPO as International Searching Authority. However, this situation was not uncontrollable primarily because, with the designation taking place upon filing, the EPO were aware up to a year in advance, of its need to conduct the search and, therefore, it could keep an eye on the number of searches coming up.

The next comment was that the Council had been advised that a search cost DEM 3,300 and Mr Michel was requested to advise as to how this cost was split. Mr Michel said that the man power cost DEM 2,000, document costs were DEM 700, computer costs were DEM 300 and DEM 300 were overheads.

President A. Huygens questioned whether it was intended to change the agreement on searches with WIPO, in view of the backlog caused by the US-derived PCT Applications designating the EPO as International Searching Authority. He stressed that a further increase of US-derived PCT Applications is undesirable as long as there is no reciprocity with the USPTO, since this may lead to a further involvement of US patent attorneys in EPO work through PCT Chapter II. Mr Michel said that there was no plan at present to change that agreement.

Mr Michel then finished his talk to sustained applause.

The Secretary General s report was then presented. Subsequently the Treasurer reported that the finances appeared to be in order and recommended that subscription levels be maintained at their current level. The draft budget was approved and Council moved onto the reports from the committees which, for this Council meeting had been moved up the agenda, to allow committee chairmen a little more time than usual.

The Professional Qualifications Committee reported first. As ever in the Autumn Council meeting, the discussions following the report of the Professional Qualifications Committee were dominated by a discussion of the initial reactions to the examination results which had just been issued. Whilst there was some discussion as to the very poor pass rate, much of the discussion focused around reports that the examination results had been published on the Internet some time before they were posted to the candidates. Whilst there had been a warning that they would be published on the Internet in advance, the date of publication was even earlier than that originally publicised. Council agreed that it would be best if candidates were informed first of their results and if there were, in future no deviation from announced publication dates.

The discussions also revolved around how to encourage recently qualified members of epi to become epi tutors and examiners for the EQE. There was also some discussion on the continuing professional education proposals of the PQC as well as the European Academy which has been started by the EPO.

Subsequent reports of the the Harmonisation Committee and the Finance Committee were brief and to the point.

After lunch, the Council meeting was, once again, adjourned whilst Mr Lepée of the EPO gave a demonstration of how European search examiners carried out a search. The demonstration was accompanied by overhead slides and a projector linked to a computer so that the on-line searching could be demonstrated. It was clear that a great deal of skill goes into conducting a search, in particular in knowing the parameters to choose. Interestingly, it seems that a relatively broad base of knowledge is required in order to ensure that the search terms do not include technical terms which, although similar to the term being searched, are from a completely different technical field.

After Mr Lepée had finished his demonstration to great applause he answered one or two questions and the council meeting resumed.

The next committee to report was the EPPC. As ever, this report was detailed and extremely interesting, covering several important topics relating to European law.

The discussion ranged particularly over fee levels, how to deal with "megapatents" (PCT Applications with as many as 500 claims), USPTO PCT searches and the European utility model proposals. With regard to the utility models, it was decided that the same requirement of inventive ability should be applied to any new utility model as is currently applied to a European patent. It was agreed that "branching off" was required and that, with regard to computer programs, there should be no deviation from Article 52(4) EPC.

The EPPC report spanned the break between the two days of the Council meeting. On the evening of the first day Council members attended a reception, held by the Minister of Economic Affairs of the Netherlands and the Mayor and Aldermen of the Hague at the Mauritshuis, and a dinner, hosted by the Netherlands AIIPPI Group and the Netherlands Institute of Patent Agents.

Following the remainder of the EPPC report the next day, the EPO Finances Committee reported briefly on proposed fee reductions to be presented to the Administrative Council and a brief overview of EPO finances including the extremely large surplus accumulating during the last financial year. Regret was expressed at the apparent ways that the EPO was returning such surplus to the National Patent Offices.

The Editorial Board then reported on a proposed forthcoming themed edition and recommendations as to how to progress re-structuring of the website. Brief reports were also received from the EASY Committee, the Disciplinary Committee, the By-laws Committee and the Biotechnology Committee.

The meeting then moved on to the proposed revisions to the European Patent Convention. The proposals for the epi response to the various revisions had been tabled by EPPC and, in general, they passed without comments. Exceptions to this were a lively discussion on whether Article 84 EPC should be made a Grounds of Opposition which, following a vote, was agreed should happen and
formal incorporation of epi into the European Patent Organisation.

The President then reviewed the forthcoming elections to the Council and an interim report on the size of epi committees was presented by the Vice President, Mr. Holzer. A nascent scheme for keeping the size of epi committees under control whilst encouraging younger members of epi to participate was presented to Council. Council approved the further investigation of this scheme.

A report was then received on the proposed amendment to the Code of Conduct following consideration by the EU. Council was advised that a final decision on this point should issue from the EU in November or December 1998 and it was confirmed that the Board had the power, as soon as the Decision was handed down, to put the revised and improved Code of Conduct into force with immediate effect.

The Secretary General gave an overview of the forthcoming epi-VPP seminar in Ulm, stressing the need for early enrolment. The President then reported progress on his proposals for the future of epi, notably contacts with national and international associations. A vote was taken as to whether past Presidents should be invited, as of right, to Council meetings. This last proposal was rejected by Council who made the point that the President had the power to invite any person to a Council meeting and, therefore, such invitation should not be made in mandatory right.

A brief vote was then taken approving the proposal for a Swedish language title equivalent to “European Patent Attorney” and the dates and places of the next two Council meetings were agreed.

Finally, the dates and venues of the EPO travelling exhibition were announced to Council. The President declared the meeting, being the last meeting of this Council, closed.

A list of Decisions taken at this Council meeting is published hereafter.

Draft List of Decisions, 45th Council meeting in The Hague
12/13 October 1998

1. The draft budget for 1999 was approved with the amendment that DM 10,000 should be shifted from 5.6 “Promotional activities” to 5.7 “Internet”
2. Council decided to maintain the subscription fee for 1999 at 300 DM.
3. Council voted by a clear majority against a publication of the examination results on the Internet before candidates are informed personally in writing.
4. Council voted by a clear majority against the publication, with the examination results, of any additional information or any other related results.
5. Council approved the proposal to reappoint Messrs. J.D. Combeau and P. Weinhold, as members of the Examination Board.
6. Council approved to reduce the enrolment fee to 70 DM for students wishing to continue their studentship for the fifth or any subsequent year.
7. Council approved that epi should follow the EPO in the adoption of the Euro which will become the reference currency in place of DEM as of 1 March 1999.
8. Council gave its approval to the following recommendation: “Starting with the 1999 Budget, as much as is reasonably possible of the expenditure on “Delegates & Others” should be omitted from item 1.4 by adding instead to other items with which connections exist.”
10. Council voted in favour of the requirement of branching off a utility model from a patent application.
11. Council considered that as long as Article 52 EPC is not amended, Article 3 “Protectable Inventions” and Art. 4 “Exclusions from patentability” of the Draft Directive for the Protection of Inventions by Utility Model, should conform with Article 52 EPC.
15. Council agreed to place the project for a re-structure of the epi website to an external firm and approved the costs involved with it.
16. Council voted in favour of the introduction of Article 84 EPC, Art. 100 and 138, as ground for opposition.
17. Past Presidents will not be invited to Council meetings, as a Rule.
Rapport de la 45ème réunion du Conseil à La Haye
12/13 octobre 1998

Le Conseil de l’épi, réuni à La Haye pour sa 45ème réunion, a combiné comme d’habitude une atmosphère conviviale avec une séance de travail intensif. La réunion s’est tenue à l’OEB dont l’hospitalité a été très appréciée.

Le Président, Arthur Huynghens, ouvre la séance et souhaite la bienvenue à tous les participants. Après la nomination des scrutateurs et l’adoption de l’ordre du jour, les minutes de la 44ème réunion du Conseil à Helsinki sont approuvées. Ces minutes ne soulèvent aucune nouvelle question.

Le Président commence par un nouveau point à l’ordre du jour qui traite des décisions et des mesures prises par le Bureau depuis la dernière réunion du Conseil. Les sujets comprennent la nomination des membres de la Chambre de recours en matière disciplinaire, l’audition organisée par l’Union Européenne sur le délai de grâce à Bruxelles, le 5 octobre 1998, la publication des rapports de commissions dans epi information et sur le site Internet de l’épi, une proposition de participation à un nouveau Symposium sur la réduction des coûts des brevets ainsi que la suggestion faite par le “Chartered Patent Institute” de joindre un court CV, pour chaque candidat, à la liste des candidats aux élections du Conseil de l’épi, dans la mesure où les organisations nationales le jugent opportun.

Le Président présente ensuite son rapport, lequel est publié dans ce numéro de epi information.


Ce partenariat est confronté à de nouveaux défis tels que la globalisation, le nombre croissant de demandes à l’OEB dont beaucoup d’entre elles comportent des dates limites fixes. Assurer la qualité du travail réalisé par l’OEB tout en réduisant les coûts constitue un autre objectif commun.

L’OEB tente de combler le retard actuel dans les recherches d’ici la fin de l’an 2000 du moins si une nouvelle explosion du nombre de dépôts n’intervient pas. M. Michel souligne que le système européen était conçu à l’origine pour traiter 30.000 demandes, et qu’il en traite aujourd’hui 120.000.

La possibilité d’utilisation d’un nouveau système rapide ainsi que des propositions en vue de développer le système d’extension à d’autres pays sont envisagées. L’OEB est avant tout conscient qu’il doit travailler vite et qu’il doit être aussi rapide que l’Office américain des brevets dans ses prestations de services. Les outils électroniques sont de plus en plus fréquemment utilisés et on n’est plus loin d’une recherche entièrement automatisée. Les examinateurs consultent autrefois jusqu’à 12.000 documents. Avec les moyens actuels, chaque recherche nécessite en moyenne la consultation de 300 documents – le reste des documents étant visionné et sélectionné en ligne. A cette amélioration en vitesse et en efficacité s’ajoute la possibilité de couvrir des domaines plus larges que ne le permet la recherche traditionnelle sur papier. M. Michel évoque une démonstration de recherche qui doit avoir lieu dans l’après-midi.

M. Michel mentionne ensuite que, du point de vue de l’OEB, le programme BEST est essentiel pour rattraper le retard actuel car il donne aux examinateurs une plus grande flexibilité pour conduire les recherches et l’examen. On ne peut évidemment pas exiger qu’une personne fasse de la recherche en ligne chaque jour, toute la journée. Le programme BEST devrait permettre de réaliser davantage de recherches grâce à une répartition du travail entre les examinateurs. On pense aussi qu’il devrait permettre à des examinateurs expérimentés d’améliorer la recherche pour les questions relatives à l’activité inventive. M. Michel ajoute que même si la CBE doit être modifiée pour permettre l’utilisation complète du programme BEST, ce dernier ne devrait pas couvrir plus de 35 % des demandes.

M. Michel conclut son intervention en répondant à quelques questions posées par les participants. Le Conseil a noté que le Conseil d’Administration envisage d’abaisser les taxes de recherche. La question est de savoir si le retard existant risque de s’en trouver accru. M. Michel répond qu’il est difficile de répondre à cette question. Si la baisse envisagée n’intervient pas avant le 1er juillet 1999, l’OEB aura le temps de prendre des dispositions en nommant par exemple davantage d’examineurs pour travailler avec le programme BEST. En fait, le plus gros problème que l’OEB ait rencontré en ce qui concerne le retard dans la recherche a été l’accroissement du nombre de demandes PCT, en provenance des USA, qui désignaient l’OEB comme administration chargée de la recherche internationale. Toutefois, l’OEB a pu garder le contrôle de la situation, en grande partie parce que la désignation se faisait au moment du dépôt de la demande. L’OEB pouvait ainsi évaluer ses besoins une année à l’avance pour conduire la recherche et, de ce fait être en mesure de contrôler le nombre de recherches requises.

Le Conseil ayant été informé que les coûts de recherche s’élèvent à 3.300 DEM, la deuxième question posée vise à connaître la répartition de ces coûts. M. Michel répond que les coûts de personnel s’élèvent à 2.000 DEM, les frais de documentation à 700 DEM, les coûts d’ordinateur à 300 DEM et 300 DEM sont calculés pour le matériel de projection.

Le Président A. Huynghens demande s’il est prévu de modifier l’accord passé avec l’OMPI sur les recherches,
en vue du retard causé par les demandes PCT, en provenance des USA, qui désignent l'OEB comme administration chargée de la recherche internationale. Il souligne qu'il n'est pas souhaitable que ces demandes PCT, en provenance des USA, continuèrent d'augmenter, aussi longtemps que la réciprocité n'a pas été établie avec l'USPTO, d'autant plus que cela risque de conduire à une plus grande implication des conseils en brevets américains dans le travail de l'OEB, au travers du Chapitre II PCT. M. Michel répond qu'il n'existe aucun projet à l'heure actuelle visant à modifier cet accord.

A la fin de son intervention, M. Michel est très applaudi par les membres du Conseil.

Le Secrétaire Général puis le Trésorier présentent leur rapport. Ce dernier présente les comptes qui sont positifs. Le Trésorier recommande de maintenir le montant actuel de la cotisation annuelle. Le projet de budget est approuvé et le Conseil considère alors les rapports de commissions dont l'ordre a été avancé à l'ordre du jour de cette réunion du Conseil afin de pouvoir accorder aux présidents de commissions un peu plus de temps de parole que d'habitude.

La Commission de qualification professionnelle (PQC) présente son rapport en premier. Comme toujours à la réunion d'automne du Conseil, la discussion qui suit le rapport de PQC porte principalement sur les dernières réactions résultant de la publication des résultats de l'examen. Le très faible taux de succès soulève des remarques mais le point le plus discuté est certainement la publication des résultats sur Internet avant que les candidats n'aient été informés de leurs résultats, personnellement, par courrier. Il avait été certes annoncé que les résultats seraient publiés à l'avance sur Internet mais ils ont été rendus publics avant la date annoncée initialement. Le Conseil est d'avis qu'il serait préférable que les candidats soient informés de leurs résultats d'abord par courrier, et qu'il faudrait veiller à ce que la date de publication annoncée soit respectée. La question de savoir comment encourager les nouveaux membres de l'épi à devenir tuteurs et examinateurs pour l'Examen européen de qualification, les propositions de PQC relatives au programme de formation continue de même que le projet d'une Académie Européenne, récemment créé par l'OEB, sont autant de sujets qui donnent lieu à des discussions animées.


Après le déjeuner, la réunion est de nouveau suspendue pour donner le temps à M. Lépée de l'OEB de faire une démonstration sur la manière dont les examinateurs conduisent une recherche à un niveau européen. La démonstration est accompagnée de diapositives et d'un projecteur connecté à l'ordinateur pour permettre une démonstration en ligne. Il apparaît évident que cette recherche nécessite une grande compétence, en particulier dans le choix des paramètres. Il est aussi intéressant de noter qu'une base de connaissances relativement étendue est nécessaire pour assurer que les termes de recherche n'incluent pas des termes techniques qui, bien que similaires au terme recherché, relèvent d'un domaine technique complètement différent.

M. Lépée est très applaudi. Il répond à quelques questions avant que la réunion ne poursuive.

La Commission d'EPPC présente ensuite son rapport. Comme toujours, ce rapport détaillé, extrêmement intéressant, couvre plusieurs sujets importants relatifs au droit européen.

Les thèmes abordés sont en particulier les seuils de taxes, la manière de traiter les "mégabrevets" (dernières PCT comptant jusqu'à 500 revendications), les recherches PCT de l'USPTO et les propositions pour un modèle d'utilité européen. Le Conseil approuve que le même critère d'activité inventive du brevet européen soit utilisé pour les modèles d'utilité. Il approuve également que le "branching off" soit exigé, et que l'article 52(4) soit respecté en ce qui concerne les programmes d'ordinateur.

La fin du rapport de l'EPPC est ajoutée au lendemain. Le soir du premier jour de réunion les membres du Conseil sont invités à une réception donnée par le Ministre de l'Économie des Pays-Bas ainsi que par le Maire et les conseillers municipaux de La Haye, au Mauritshuis. Le dîner est offert par le groupe néerlandais de l'AIPPI et par l'Institut des Conseils en Brevets des Pays-Bas.

Le lendemain, à la suite du rapport de l'EPPC, la Commission des Finances de l'OEB fait un rapport succinct sur les propositions de réduction de taxes qui doivent être présentées au Conseil d'Administration. Elle donne un bref aperçu des finances de l'OEB et mentionne l'énorme excédent accumulé au cours du dernier exercice. Le Conseil déplore que cet excédent soit reversé de manière évidente aux offices nationaux.

Puis le Comité de Rédaction annonce qu'une prochaine édition sera de nouveau centrée sur un thème particulier. Il fait part au Conseil des recommandations faites quant au développement et à la restructuration du site Internet de l'épi. De courts rapports sont présentés par la Commission EASY, la Commission de Discipline, la Commission de Règlement intérieur et la Commission sur les Inventions en Biotechnologie.

Le Conseil aborde ensuite les propositions de révision de la Convention sur le brevet européen. La position adoptée par l'épi face aux différents projets de révision a été soumise par l'EPPC et en général adoptée sans commentaires. Toutefois la question de savoir si l'article 84 CBE doit servir de motif d'opposition soulève une discussion animée. Le Conseil se prononce pour et approuve également l'incorporation officielle de l'épi dans l'Organisation européenne des brevets.

Le Président communique brièvement les dates des prochaines élections au Conseil. Un rapport préliminaire sur l'effectif des commissions est présenté par le Vice-Président, M. Holzer. Ce dernier présente une ébauche de projet visant à limiter l'élargissement des commissions tout en stimulant la participation de nouveaux membres de l'épi. Le Conseil est d'accord pour donner suite à ce projet.

Un rapport relatif à la proposition d'amendement du Code de conduite est présenté, après que cette dernière

Le Secrétaire Général rappelle le programme du prochain séminaire epi-VPP à Ulm et recommande de s’inscrire le plus rapidement possible. Le Président fait ensuite un brief rapport sur ses activités entreprises dans le cadre du futur de l’epi, notamment ses contacts avec les associations nationales et internationales. Le Conseil est invité à voter sur la question de savoir si les anciens Présidents doivent être invités, en règle générale, aux réunions du Conseil. Cette dernière proposition est rejetée par le Conseil qui souligne que le Président peut décider des personnes à inviter à une réunion de Conseil et que, par conséquent, une telle invitation ne doit pas être rendue obligatoire.


Les dates de l’exposition itinérante de l’OEB sont annoncées. Le Président déclare la séance close, celle-ci étant la dernière réunion de ce Conseil.

Une liste des décisions prises à cette réunion de Conseil est publiée ci-après.

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Projet de Liste des Décisions, 45ème réunion du Conseil à La Haye
12/13 octobre 1998

1. Le budget provisoire pour 1999 est approuvé avec un amendement, à savoir que 10.000 DM devront passer de 5.6 "Activités promotionnelles" à 5.7 "Internet".
2. Le Conseil décide de maintenir le montant de la cotisation à 300 DM pour 1999.
3. Le Conseil approuve à une forte majorité que les candidats soient informés personnellement et par écrit de leurs résultats à l’examen de qualification avant la publication de ceux-ci sur Internet.
4. Le Conseil se prononce à un une forte majorité contre la publication, avec les résultats d’examen, de toute information supplémentaire ou d’autres résultats annexes.
5. Le Conseil approuve la renommation de MM. J. D. Combeau et P. Weinhold, en tant que membres du Jury d’examen.
8. Le Conseil approuve la recommandation suivante: "A compter du Budget 1999, les dépenses classées sous 1.4 "Délégués et autres" devront autant que possible, être réparties sous d’autres postes avec lesquels elles ont un rapport".
10. Le Conseil vote en faveur d’une disposition permettant de passer d’un brevet à un modèle d’utilité.
11. Le Conseil considère que, aussi longtemps que l’Article 52 EPC n’est pas modifié, l’Article 3 “Inventions brevetables” et l’Article 4 “Exclusions de la brevetabilité” du Projet de Directive pour la Protection des Inventions par Modèle d’Utilité doivent se conformer à l’Article 52 CBE.
12. Seule la demande du rapport de recherche (Article 16) devrait être exigée pour engager une procédure.
13. Le Conseil se prononce à une forte majorité en faveur de la Double Protection (Article 22).
15. Le Conseil approuve que le projet de restructuration du site Internet de l’épi soit confié à un sous-traitant externe, ainsi que les frais en résultant.
17. Le Conseil écarte une disposition visant à conférer le droit aux anciens présidents d’assister systématiquement aux réunions du Conseil.

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President’s Report
covering the period from May – October 1998

A. V. Huygens (NL)

1. I was pleased to attend the 37th AIPPI Congress which was held in Rio de Janeiro from 24 to 29 May 1998, as an invited guest. Among the many contacts with representatives of organisations and individuals, I would like to mention a breakfast meeting that Vice President Walter Holzer (who represented the Austrian Association of Patent Attorneys) and I had with FICPI President John Orange and FICPI representative Terry Johnson, to discuss common fields of interest and possible collaboration between our organisations.

2. On 28 and 29 May 1998, the 7th meeting of the European Round Table on Patents (Eurotab) took place in Lisbon. Mr. Zaid Schöld represented the epi. His report is contained as Annex 2 to EPPC Report No. 42.

3. Vice President Walter Holzer and I attended the Administrative Council meeting in Munich on 16-17 June 1998. A short report is attached. We took the opportunity to have lunch with Mrs. Dybdahl of the EPO to discuss matters in the field of training and education.

4. Since the Administrative Council meeting had already finished in the evening of 17 June, I took the opportunity to attend part of the EPPC meeting on 18 June, where I gave an immediate report on the discussions which took place in the AC. I was also present at an instant discussion between Mr Schatz and the members of EPPC on the recent EPO proposal to reduce the search fees and to cease the designation fees.

5. I was pleased to receive an invitation from the Netherlands Industrial Property Office to attend the opening by Mr. Kober of the EPO Travelling Exhibition in Amsterdam on 23 June 1998. The Exhibition was attended very well.

6. On 24 June 1998, I had lunch with Mr. Kober and Mr. Michel in The Hague.

7. I attended the 28th SACEPO meeting in Munich on 25-26 June 1998, together with most of the 18 elected epi delegates. I also attended the summer reception given by Mr. Kober at the Pschorröhöfle Building.


9. On 21 July 1998, I had a meeting in Barcelona with Mr. Marcelino Curell Suñol, President of Agosorpi, Mr. Victor Gil Vega, President of the Spanish Association of Patent and Trademark Agents, and Mr. Luis Alfonso Durán, epi Board member for Spain, to discuss current developments and possibilities for further collaborations between our organisations.

10. On 12 August 1998, I convened a meeting of the Officers of the Board in Munich. The purpose of the meeting was discussing the organisation and current activities of the Institute, setting out lines for the future, and preparing the Board meeting in Florence on 5 September 1998.

11. On 1 September 1998, Vice President Leo Ryckebosch and I had a meeting in Brussels with the UNICE President, Mr. Jacobs, the new UNICE Secretary General, Mr. Hudig, and other representatives of UNICE.

12. I wrote a letter of condolence to Mr. Kamil Idris, Director General of WIPO, in connection with the death of two WIPO Directors, Dr. Ludwig Bäumer and Mr. Joachim Bilger, at the crash of Swissair Flight 111 on 2 September 1998.

13. On 11 September 1998, I attended the extraordinary SACEPO meeting in Munich which was mainly devoted to the revision of the EPC. For further details, see EPPC Report No. 42 and item 14 of the agenda.


15. I was pleased to receive an invitation from the Chartered Institute for the CIPA Congress 1998 on “Regionalisation of Intellectual Property”, which was held in London on 24-25 September 1998. I gave a speech on “Regional Professional Bodies – the epi experience”. I attended also the Annual Dinner of the Chartered Institute on 25 September 1998, as a guest of CIPA.

16. I was pleased to receive an invitation from the German Federal Minister of Justice, Professor Schmidt-Jortzig, to attend a ceremony in Bonn on 30 September 1998 of investing Dr. Manfred Rau, immediate past President of the “Patentanwaltskammer”, with a decoration (“Verdienstkreuz 1. Klasse”). After the ceremony, I attended a festive lunch organised by the Patentanwaltskammer and gave a short speech.

17. On 5 October 1998, I attended with Mr. Casalonga the hearing and the discussion on a Grace Period for Patents, organised by the European Commission, and presented epi’s view on this matter.

18. Since the Helsinki Council meeting I have again dealt with many personal enquiries and correspondence from members and outside bodies. I assisted my Dutch colleagues who organised the epi Council meeting in The Hague and paid much attention to
my contacts with the EPO on a variety of subjects. I should also like to thank my fellow officers, Vice Presidents Leo Ryckebosch and Walter Holzer, Secretary General Rüdiger Zellentin, Treasurer Knud Erik Vingtoft, the epi Board, the Committees and the Secretariat for their hard working, together and in good atmosphere, to our mutual benefit and, of course, that of the epi.

Annex to President’s Report


1. The EPO President’s report had been presented. In the first 5 months of 1998 the number of applications was 17% higher than in 1997, with Euro-PCIs now being 58% of the filings. The total number of applications expected for 1998 is 112,000 to 120,000, which is higher than expected. There are also more technical appeals than expected for 1998, but less than in 1997.

2. The EPO requires a 5% increase in productivity and consultants have been employed to help achieve this.

3. The backlog in searches and substantive examinations is growing, with 20,000 searches in the backlog; the backlog is not spread evenly and is very high in telecom and computer technology.

4. The EPO will have a new recruitment program and 140 to 200 new examiners will be hired; the recruitment has been approved by the Administrative Council. The increase in numbers of examiners is needed for the increase in applications and also because of the age profile of examiners.

5. The EPO financial situation is better than expected with a surplus of DM 46 million so far this year.

6. The European Biotechnology Directive will be published soon in the Official Journal of the European Community and will then be in force; the EPO will check whether it will be in conformity with the EPC but believes no amendment of the EPC will be required.

7. The report of the Chairman of the Committee on Patent Law prompted no reaction at all from the Administrative Council; the lack of comment on the language problems was as expected. The Spanish delegation has made it clear that the package solution is of the table as far as Spain is concerned. Mr. Kober stressed that the package solution had not been rejected by the AC, although at present there was no majority in favour. It is important in his view to continue to seek a solution to the translation question, especially in view of the projected expansion eastwards.

8. The BASF case before the European Court could take several years and the European Commission will not wait for the decision before taking action on the Community Patent.

9. Mr. Waterschoot (DG XV European Commission) reported to the AC that two studies were being carried out, one on representation, and another on grace periods. I have expressed serious concern about the upcoming discussion on the grace period which will only help the Americans to sit back and do nothing to change their first to invent system.

10. The extension of the EPC to Eastern European countries was discussed and it was reported that eight countries (Czech Republic, Poland, Hungary, Slovakia, Slovenia, Estonia, Romania, and Bulgaria) eagerly await an invitation to join. Finland and Austria particularly favour the countries joining the EPC. The EPO has negotiated with the 8 countries but there are concerns with language problems, etc. I have asked whether it was intended to reach a solution on the translation question before or after expansion of the Organisation. A further problem is that there will be dilution of the Administrative Council; the present member states will discuss the problem in the Heads of Delegation meeting (e.g. is one country one vote acceptable). The joining of the 8 countries will likely be on the agenda of an Intergovernmental Conference which was initiated by the French Government but which has recently been postponed till March 1999.

11. I had submitted a letter to the AC on possible amendments to the EPC. Some of the proposals have been taken up, others mainly relating to representation have not yet. See also item 14 of the agenda.

12. The EPO provided some further information on the age structure of professional representatives. I had indicated in writing that these data was incomplete, partly owing to data protection provisions, and therefore unsuitable for a thorough analysis. We will attempt to gather more data and make some assumptions in order to predict future developments. I expressed epi's willingness to cooperate with an initiative from the EPO on training.

13. A provisional proposal for reducing the search fees and ceiling the designation fees gave rise to a lengthy debate. I took the position that any reduction of fees is of course welcomed. As far as the lowering of search fees is concerned, it is to be feared that, once being in force, the EPO has to deal with many more search requests in future. Therefore, this proposal can only be agreed to if the quality of the searches can be maintained and no further backlog will be created.

14. For the remaining points I would like to refer to OJ EPO 8/1998, 391-400.
Treasurer’s Report to epi Council

Knud E. Vingtoft (DK)

Accounts January – June 1998

The booked actual expenses for the first six months of the year 1998 are well below half of the expenses budgeted. Furthermore, the booked income for the first half of the year is only app. 1.5 thousand DEM below the income budgeted for the whole year. At the present time, no expenses substantially exceeding those budgeted are foreseen. Therefore, no amendment of the budget for 1998 is proposed.

Deletion of Members under Rule 102(1)

In August this year requests for deletion of 115 members were sent to the EPO. The total of the outstanding subscriptions from these members amounts to 40,250 DEM. Last year, deletion of 105 members representing 33,020 DEM in unpaid subscriptions was requested.

Proposed Subscription Fee for 1999

It is proposed to maintain the subscription fee unchanged for the year 1999.

Report of the Committee on EPO Finances (Summary)

J. U. Neukom (GB)

1. Of central interest is the EPO’s paper of May 1998 entitled “Further Improvements to the Coherence of the Fee Structure – Reduction of Fees”. Emphasising financial aspects, the proposals in this paper are:

A. The European search fee should be reduced from DEM 1700 to 1200 (30% reduction) and the international search fee from DEM 2200 to 1700 (23% reduction).

B. For a national application, but only if the national office concerned introduces the necessary provisions, the applicant should have the possibility, at the fee of DEM 1200, (a) to obtain an EPO search (an international-type search) within the priority year and (b) to have a search fee refund if a subsequent European or Euro-PCT application is filed.

C. The payment to EPO by ex-IIB member states (BE, FR, NL, LU) of virtually full cost, currently about DEM 3300 per case, for EPO searches on their national applications should be changed such that, where a subsequent European or Euro-PCT application is filed, a refund is made to the national office concerned of the difference between the cost price and the fee which would have been applicable had there not been a search already done.

Proposal A

2. The search fee reductions demonstrate once again the EPO’s embarras de richesses. Already, there is the prospect that this year’s operating surplus will yet again exceed DEM 100m., enough to cover the estimated cost of the proposed reductions more than two times over!

Proposal B

3. Lengthy debate on this proposal is possible, notably on whether a pre-European search done in a decentralised fashion by a national office using EPOQUE-BNS might not be treated as equal to an EPO search and therefore qualify for the search fee refund.

4. Another consideration concerns the EPO standard search which can be requested directly by anybody at any time for the payment of a fee: The person who has obtained such a search is in exactly the same position as someone following the proposal B route and prima facie should qualify for a fee refund large enough to put him in the same position financially.

Proposal C

5. A principal reservation arises from the loss of income to the EPO:
   - Effectively this loss would be a gift to the national offices, therefore yet another handout increasing the stream of EPO money going out through the backdoor to national offices; addition to the items identified in our last report (2/1998 page 56) would roughly double the total annual outflow.
   - The gift would of course be reduced in proportion to however much the national offices concerned were to reduce their national fees but, by virtue of—
the current national fees being only one half, or less, of the cost price at present paid to EPO (a statement made in the EPO paper), and the refund from the EPO to the national offices being roughly the same if not more, the national fee would have to be reduced to zero in order to neutralise the gift, a step which would run counter to the object of equalising opportunities of access to EPC for applicants of all contracting states.

- Effectively the gift is an EPO subsidy in substitution for national subsidy but, being limited to the ex-EEB states, might it not be seen as discriminatory so that other states will seek in due course to have some of their search subsidies borne by EPO?

6. The loss of income to the EPO might be regarded as "small beer" – only about 12% of the present total annual operating budget – but there are better uses to which it could be put than being paid to national offices. For example, it could reduce the maintenance fees payable to EPO by 10%, a logical step when late search reports, for which EPO is to blame, are causing a greater maintenance fee burden on applicants.

**Brief Conclusions**

7. The Committee’s vote is strongly in favour of proposal A; on proposal C it is against, and on proposal B an abstention is appropriate (subject to the observation in para. 4).

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**Report of the EPPC meeting of 18th June, 1998**

A. Casalonga (FR)

1. Consideration was given by the EPPC to document SACEPO 2/98 – Points for a revision of the EPC.


- **Adapt to BEST project, Articles 16 to 18.**
  The proposal to amend the Protocol on Centralisation was considered acceptable but with retention of the reference to the Hague and Munich in the Convention because this would ensure that the EPO would not move away from these locations at some time in the future.

- **Maximum age limit, Article 23(1).**
  This provision introduced an age limit of 65 for members of Boards of Appeal; it was considered that this age limit should be in the Rules rather than fixed in the EPC.

- **Independence of the members of the Boards, Article 23(3).**
  The EPPC held a vote to determine whether there was support for a general article saying that the EPO is bound by TRIPS and the Convention on Human Rights; the majority of delegates were against the proposal.

II. Substantive Patent Law.

- **Treatment of computer programs, Article 52(2).**
  The Committee on Patent Law has suggested using the Article 27(1) TRIPS wording in Article 52 EPC. This is also the agreed EPPC position.

- **Bring Article 53(a) into line with TRIPS.**
  The proposal to amend Article 53(a) to refer only to exploitation rather than publication and exploitation is acceptable.

- **Self collision, Article 54.**
  The problem only applies for applications filed in the period between the end of the Convention year and the date of publication of the earlier application. A vote was held and the majority were against provisions on self collision because they were deemed too complicated and could lead to legal uncertainty.


- **Time limit for filing a request for examination, Articles 33 and 95.**
  The majority were against the proposal to give the EPO greater flexibility in determining the time limit for filing the request for examination because of the risk of introducing deferred examination.

- **Applications filed by persons not entitled, Article 61(1).**
  It was agreed that all three of the EPO proposals be taken together, thus making pendency a requirement for a new filing, and introducing a time limit and protection of third party rights similar to those in Articles 122(2) and (6).

- **Introduction of new matter in divisionals, Article 76(1).**
  All delegates were against the introduction of European CIPs.
- **Claiming of priority rights, Article 87(1).**
  A vote was held and the majority of delegates were in favour of the EPO proposal to extend Article 87(1) to include WTO countries in addition to Paris Convention countries.

- **Filing of priority documents, Article 88(1).**
  There was concern that there were difficulties for third parties if translations of priority documents were not available, particularly as rapid access to the translation is often needed. There could be problems in litigation if translations of priority documents were not available. There was also the concern about what would happen if the priority document had been destroyed as part of a Patent Office's document retention policy. A vote was held and the majority of delegates favoured keeping the current provisions in the Convention but with an amendment to allow electronic transmission of priority documents.

- **Grounds for opposition and revocation, Articles 100 and 138.**
  There are different interpretations of the word “support” as used in Article 84; in the EPO “support” means copy, whereas in the UK it means: “is the claim reasonable in the light of the disclosure?” Currently the only attack on an over-broad claim is using Article 83. It was felt that Article 84 would allow a better attack on over-broad claims than Article 83, and would also be useful as a ground of opposition because of the need for claims to be clear and concise. A vote was held and the majority of delegates were in favour of Article 84 as currently worded as a ground of opposition. A further proposal to delete Article 84 was not considered acceptable.

- **Examination by the EPO of its own motion, Article 114.**
  New Rule 71a EPC concerning preparation for oral proceedings is not applicable to the Boards of Appeal, hence the EPO proposal to introduce similar provisions specifically for the Boards of Appeal. The EPPC already discussed the possibility of changing the Rules of procedure for the Boards of Appeal during its previous meeting of 12 March 1998. The Council approved already the proposal of DG3 that a mandatory communication be sent from the Boards to the parties together with the summons to the oral proceedings.

- **Oral proceedings, Article 116.**
  The EPPC considered that oral proceedings should always be available and discretion should not be given to the EPO to refuse to grant oral proceedings.

- **Taking of oral evidence under oath, Article 117.**
  There may be occasions when an Opposition Division may want to interrogate a witness. The Committee on Patent Law have said that German laws on perjury apply to statements made by witnesses in the EPO. A vote was taken and the majority of delegates were in favour of the EPO proposal to introduce a provision to enable the EPO to take oral evidence under oath.

- **Time limits, Article 120.**
  See later discussion with reference to document SACEPO 14/98.

- **Further processing and restitution, Articles 121 and 122.**
  The EPPC favours the “payment of a fine” solution for dealing with missed time limits. In effect, further processing pursuant to Article 121 would apply to all time limits except the priority year.

- **Amendments, Article 123.**
  The proposal is only for repairing mistakes made during prosecution where an inadmissible disclaimer was added during prosecution which could not be removed in opposition. A vote was held and a majority wanted Article 123 as proposed by the EPO, i.e. the “footnote solution”, but cautioned that there was a need for great care with the wording of this to ensure it does not cause problems.

- **Protest procedure under the PCT, Articles 154(3) and 155(3).**
  The EPPC considers that an applicant should be able to go to a Board of Appeal for an independent tribunal review of decisions of the EPO as an ISA or IPEA.

- **Stay of proceedings.**
  The EPPC could agree to the proposal for stay of proceedings in cases that might be affected by a referral of a case to the Enlarged Board of Appeal, as long as all parties to the particular proceedings being stayed were in agreement.

### IV. General.

- **Deregulation.**
  The proposal to deregulate as many provisions of the EPC and Implementing Regulations as possible was not considered acceptable because too undefined.

- **Transfer of EPC requirements to the Implementing Regulations.**
  The EPPC considered that important provisions should be kept in the EPC Articles and only unimportant items could be moved to the Implementing Regulations.

### V. Housekeeping Amendments.

- **Eliminate divergencies between the three versions of the EPC.**
  This proposal is acceptable but will be difficult to do successfully.

- **Transitional provisions, deletion of Articles 159-163 and 167.**
  Article 160(2) allows national judges to join the Boards of Appeal and this Article should be kept to
allow this. At present some of the Board of Appeal members are appointed under Article 160(2). It was considered that Articles 163(6) and (7) should be retained.

2. **The impact of Rule 23a** on national law was discussed. That National Laws need amendment to take into account Rule 23a EPC was agreed.

3. **EPO fee policy: Further improvements to the coherence of the fee structure – reduction of fees.**

Those questions were discussed with Mr Schatz of the EPO present to explain the fee reductions proposed. The EPO believes it has sufficient surplus funds to enable fee reductions, in part based on the prediction that renewal fee income will double in the next ten years.

The EPO hears that industry wants further reduction of initial fees including the search fee. The EPO proposes to reduce the EPC search fee by 30% and the PCT search fee by less (23%). If a Contracting State subcontracts its searches to the EPO, these will be carried out for 1200 DM; it will be up to the individual Contracting States to decide whether they will provide the searches themselves or use the EPO service.

The EPO has calculated the drop out rate at 25% and this is an acceptable number not entering the European phase; the only way the search can be carried out at the costs proposed is that 75% of the applications will continue in the European phase and the shortfall in funds can be made up from subsequent fees.

It was admitted that backlogs will rise next year but that the EPO will recruit more examiners which will help in the longer term but will make things even worse in the short term. The volume of international-type searches will be 10,000 and in effect the search is only being done one year earlier; only 25% will be additional searches.

Delegates were also told that the EPO is considering a ceiling on the amount of designation fees. No EPPC delegates were against the proposal to reduce the search fee provided quality was maintained; they also want other fee reductions as well.

4. **Treatment of PCT “mega applications.”**

The problem caused by such PCT applications is possibly due to there being no claims fees for PCT applications. A suggestion was made for a search fee from the EPO of 1200 DM basic fee, and 100 DM for every claim above 10.

5. **Implementation of PHOENIX.**

A majority of the EPPC wanted electronic documents kept for longer periods than the EPO presently keeps its paper files. It was suggested that the EPO be reminded about SPCs and problems if SPCs are litigated after expiry of the period of protection. A retention period of 5 or 10 years after expiry of final protection (SPC) was deemed acceptable.

6. **Decentralisation of the EPO.**

A small majority of the EPPC were against decentralisation of EPO functions as proposed in this document by FICPI. The main reason for maintaining centralisation was the need to keep the standard of search and examination harmonised and it was therefore felt it must be kept within the EPO. The counter argument was that if the EPO wants to reduce its backlogs by using other patent offices to help them it should be allowed to do so.

7. **Sub-Committee for Legal Documentation.**

It was reported that the EPO home page no longer has hyper links to organisations such as firms of patent attorneys. It was agreed that, if an EPI member wanted his web site address made available to the public, this could be included in his entry in the list of EPI members.

A "wish list" of documents to be available on the EPO home page has been started and suggestions for inclusion should be sent to the EPI for consideration at the next meeting of the PDC-impact committee.

8. **Question 67: EPO acting as IPEA (and ISA) for US-PCT applications.**

JP and US PCT applicants may designate the EPO as ISA and IPEA. In September 1992, the Council decided to ask the EPO to take steps that the USPTO accord reciprocity to European PCT applicants.

In epi Information 3/1993, page 227, Mr. C. Jones from Great-Britain denied any interest of European applicants in having reciprocity at the USPTO. An epi member recently reported that his European clients would like to file a European application directly with the EPO and get an EPO search, and would like to file a PCT application to get a USPTO search on the PCT application thereby having both searches during the international phase.

The EPPC therefore studied again the matter and found the following:

Pursuant to Article 11(3) of the agreement between WIPO and the USPTO on the USPTO acting as ISA and IPEA, the USPTO is free to add to the States and languages indicated in Annex A of that agreement.

Article 16(2,3b) PCT provides that each receiving Office shall, in accordance with the provisions of the applicable agreement between WIPO and the ISAs, specify the ISA or ISAs competent for the searching of PCT applications filed with such Office.

Article 32(3) PCT on IPEAs declares that Art. 16(3) PCT is applicable, mutatis mutandis. From the above it follows that if it were desired that it becomes possible that the USPTO acts as ISA / IPEA for PCT applications filed by European applicants, the first thing to do is get the USPTO prepared to act as such.
The next thing to do is to get the European receiving offices prepared to specify the USPTO as an alternative ISA. It seems however that politically, as of now this would be problematic. The EPO searches are perceived as being of higher quality than the USPTO searches. However, as in the framework of the tri-lateral cooperation (EP, JP, US) there are talks about a full mutual recognition of the search results, it might very well become acceptable to appoint the USPTO as ISA / IPEA for European applicants as soon as the USPTO searches are fully recognized by the EPO as a result of these trilateral discussions.

Following the discussion at the Council meeting of May 1998 where it appeared that the Council was divided particularly as to the level of inventive step the utility model should have, the EPPC discussed again the question and prepared different proposals for further discussion by Council.
According to the first proposal, the same level and same definition of inventive activity as for patents is provided. No exclusion from protectability is provided. According to the second proposal, a lower level of inventive activity is provided but with a similar definition based on the concept of obviousness as for patents. A list of exclusions from protectability is included.
According to the third proposal, a different definition of protectability is provided, leading to a lower level than for patents. The same list of exclusions for the second draft is included.

Report of the Finance Committee (extract)

B. Feldmann (DE)

This report covers some of the matters considered at the Committee’s last meeting 15/16 September 1998.

Subscriptions
Continuance of a membership subscription of DEM 300 for next year, 1999, is supported. An appropriate time for making any adjustments will be when provision for payment in Euros is introduced.

Single EU currency
The correct policy is believed to be that epi should follow the EPO in the adoption of the Euro. It is understood that the EPO will not be introducing provision for fee payments in Euros until next March. Therefore, developments can be awaited for the present.

Budget structure
The item which appears as 1.4?Delegates & Others? in our budgets continues to cause concern: In our last report (39/98) we pointed out that in 1997 this item covered a mixed bag of at least 15 different missions to places scattered around Europe, most involving more than one person.
The missions against this item in the first half of 1998 – already as many as 13 – are no less mixed. Therefore the view of the Committee as stated in our last report (39/98) is repeated, i.e.

"this item is now becoming disorderly. Much of what is now being included could be associated more logically with other items, especially for showing better from where has come the authority, or the request for authority, to undertake the mission. For example, the missions for purposes connected with patent law could be placed with EPPC, or with SACEPO (item 1.6) if convened by SACEPO, those undertaken by the President / Vice President (in these capacities) could be placed against item 2 ‘President (+ Vice President)’, and in a case like the EASY Seminar the placing should be with the Committee/Working Group concerned."

There was also set out in our last report (39/98) a RECOMMENDATION reading as follows:

starting with the 1999 Budget, as much as is reasonably possible of the expenditure on "Delegates & Others" should be omitted from item 1.4 by adding instead to other items with which connections exist.

Council is invited to give formal approval to this RECOMMENDATION (a step which was not taken at the last meeting). The belief of the Committee is also repeated that, unless a practice of this nature is adopted, the lines of responsibility will become more and more confused.
Before commencing detailed study of the latest draft of the Patent Law Treaty ("PLT"), the Standing Committee adopted the "General Rules of Procedure" of WIPO. This apparently formal matter, in fact, greatly facilitated the Chairman's wish for the Standing Committee to resolve issues as far as possible and to decide which issues should be left to the Diplomatic Conference.

In the meetings of the Committee of Experts on the Patent Law Treaty, the forerunner of the Standing Committee on the Law of Patents ("SCP"), topics were discussed at length in one meeting and then discussed at length in another. This was frustrating for WIPO and many delegations and, without some changes, a Diplomatic Conference would not have been called until well into the next millennium. The adoption by SCP of the General Rules of Procedure brought into play Rule 23 which reads: –

“When a proposal has been adopted or rejected, it may not be reconsidered unless the assembly so decides by a two-thirds majority.”

Without saying what he was doing, the Chairman of the First Session of SCP (Mr. Alan Trocik of Canada) proposed that clauses in the draft PLT be “adopted” if this was acceptable to the delegations. The important point here is that, not only will this procedure cut down unnecessary talking, it really concentrates the minds of the delegations! This procedure will also clearly identify the “political” matters that will need to be resolved by the Diplomatic Conference, as well as identifying the “difficult” or controversial matters.

It is hoped that the date for the Diplomatic Conference on PLT will be set at one of the meetings of SCP in 1999. The Diplomatic Conference could be held as early as 2000.

It is not the purpose of this report to detail all the changes made by SCP to the previous draft of PLT, but rather to report generally on the process made so far at the First Session of SCP (to be continued from 16th to 20th November, 1998).

Most of Article 1 (Abbreviated Expressions) has been adopted (some items being referred to the International Bureau ("IB") for further study). A new item referred to the IB was the definition of inventorship.

Article 2 (applicability of the Treaty) was adopted with some modifications.

Article 3 (National Security) was referred to the IB for further study.

Article 4 (Filing Date) was the subject of extensive debate. However, importantly, Item 2(b) was adopted in modified form, the effect of which is that the description can be filed in any language. Items 5 (Missing Drawings), 6 (Use of Contents of earlier Applications) and 8 (Divisional Applications) “to correct unintentional omissions” were referred to the IB for further study. Draft Rule 4 was generally referred to the IB for further study.

Article 5 (Application); Item 1 was adopted, as was Item 2 (a) after modification. The rest of the Article was referred to the IB/Reserved for further discussion or the discussion was deferred.

Article 13 (Extension of Time Limit Fixed by the Office); Item 1 (Request) and Item 2 (Exceptions) were adopted, but a new Item 2 (b) (i) (Special cases) was referred to the IB for further study. Discussion of Items 3, 4 and 5 was deferred but Item 6 (Observations) was adopted.

Article 14 (Further Processing or Revival of Application) and Article 15 (Restoration of Rights); Items 1, 2 and 9 of each were referred to the IB for further study and discussion of Items 3 to 8 of each was deferred.

Article 16 (Addition and Restoration of Priority Claim); Item 1 was adopted as was Item 2 (a) (Delayed filing of Subsequent Application). Item 2 (b) (forbidding granting of any extension to the two-month period referred to in Item 2 (a)) was deleted. Item 3 was adopted with modification, Items 4 to 8 were deferred and Item 9 was referred to the IB for further study. Draft Rule 16 was adopted, except that Item 3 was referred to the IB for further study.

The SCP agreed to consider the Model International Forms at the next meeting.

It is proposed to issue a more detailed report after the second part of the First Session of SCP, to be held from 16th to 20th November, 1998.
Report of the Professional Qualification Committee

F. Macchetta (IT)

1. European Qualifying Examination (EQE)

1.1 EQE Rules' changes
The change anticipated in the last Council meeting has been published in EPO OI 7/98, pages 364-368. As anticipated, it implements a simplified grading and compensation system.

1.2 Next EQE
Next EQE will be held on 24-26 March 1999, with enrolments up to 13 November 1998 (see OJ EPO 7/98, 369-374).

1.3 1998 EQE results
To be available at the beginning of October.

1.4 1998 EQE papers
The translation errors in paper D, in particular, were discussed with EQE Board (28.04.98) and careful control and evaluation of the related papers have been conducted. Future tightening of the quality control has also been assured and implemented.

Council is invited to note the contents of the above paragraphs.

1.5 EQE in the future
At the last meeting, PQC set up a WG to evaluate EQE statistics and form a preliminary view on some of the ideas and proposals that are contained in epi-Information 2/98. Preliminary, however, the established practice of minimizing changes to the EQE, avoid making piecemeal modifications and announce the necessary changes sufficiently in advance for candidates and trainers to adjust their preparation to the new rules has been confirmed.

Council is invited to note and approve the content of this paragraph.

1.6 Reappointment of epi-members as members of EQE Board
The term of office of two epi-members of EQE Board, Messrs. J.D. Combeau and P. Weinhold, is going to expire this year. It is recommended to reappoint them for the next term of office.

Council is invited to approve reappointing the epi members of the EQE Board whose term of office is going to expire this year.

2. epi-Students

2.1 There are currently 240 Students from 13 countries, distributed as follows:
AT: 1; BE: 5; CH: 12; DE: 24; DK: 20; ES: 1; FI: 3; FR: 13; GB: 102; IE: 5; IT: 7; NL: 25; SE: 22.
[In 1997, in the same period, there were 173 Students]

2.2 Students' Rule changes
It is proposed to reduce the fee for registering for the 5th and subsequent year (Art. 4 of epi Students' Rules) to 70 DM.

Council is invited to approve the reduction of the fee for registering as a Student (Art. 4 epi Students' rules) to 70 DM.

3. Tutorials

3.1 Summer session
44 candidates enrolled for the Summer tutorial (25 of which are Students) involving 19 tutors in 5 countries (BE, DE, FR, GB, IT).
[In 1997, 63 candidates enrolled for the summer tutorial, trained by 17 tutors]

3.2 Autumn session
An autumn session is available, in particular for candidates that want to repeat the papers they did not pass in the 1998 EQE. The term for enrolment is 30 October 1998 and additional information can be found in epi-Information 1/98 and on epi-homepage (http://www.epatentepi.com).

Council is invited to note the above and promote the EQE candidates' awareness of this training possibility.

4. Members of EQE Committees and epi-Tutors

Mem bers of EQE Committees and epi-Tutors are still urgently needed.

epi-Members having passed the EQE themselves in the last few years and possibly active in on-the-job training activities are in particular invited to volunteer for this essential professional service and request additional information through epi-Secretariat.

Council is invited to note the above, actively promote the awareness of this need and encourage members, particularly those having passed the EQE themselves and being possibly active in on-the-job training, to volunteer for this service.

5. Material to be in epi-homepage

PQC, in cooperation with epi-Information Editorial Board, will work at making available relevant material and information through epi-homepage.

In the last meeting, the following has been proposed to be made available:
- Tutorial program and enrolment form (already available)
- Students' rules and enrolment form
- List of PQC members
- Articles on advising candidates preparation for the EQC, that were published mainly in epi-Information
- Links to associations' and Institutions' EQE training programs.

Council is invited to note and approve the content of the above paragraph.
EU Draft Directive on Utility Models

P. Shortt (IE)

The epi submitted comments on the EU Green Paper on Utility Models, see epi information 1/1996, 6. Subsequently, the epi was represented at the public hearing which took place in September, 1996.

A draft EU Directive approximating the legal arrangements for the protection of inventions by utility model was then published on 5 January, 1998.

The draft was studied by the EPPC and was considered by the epi Council at its meetings in Helsinki (May 1998) and The Hague (October 1998).

Following these discussions, the epi has proposed detailed comments on the draft Directive, for submission to the EU Commission.

In order to keep epi members fully informed of the epi position on utility models, it has been decided to publish the commentary in full, which now follows:

October, 1998

Comments of the epi on the Draft Directive for the Protection of Inventions by Utility Model


General Remarks

As pointed out by the European Commission the existing national utility model systems within the European Community are of a quite different nature. It has also been shown that some of the national systems are much more attractive to the local industry than others. Therefore, it is important to ensure that the proposed harmonised legislation will contain the stipulations which have proven to be decisive or important for the usefulness and attractiveness of a utility model system.

The epi is of the opinion that in order to have maximum attractiveness to the innovative industry the envisaged harmonised European utility model legislation should comprise provisions which

- require an inventive step rather than technical progress,
- allow coexistence of a patent application and a utility model registration for the same invention,
- allow that a utility model application may be derived from a pending patent application by “branching off” at any time (within the maximum term of a utility model registration) and even within a short period of time after a possible rejection or abandonment of the patent application,
- allow registration of a utility model without search and substantive examination,
- allow search and possibly also substantive examination on request from the proprietor, and

- do not exclude patentable subject matter from utility model protection,
- require that at least a search report be procured by the proprietor of the utility model registration before enforcing the right obtained by the utility model registration.

Almost all of the above stipulations are found in the German utility model legislation, and the German system has proven to be one of the more attractive in Europe. Utility Model systems have been introduced in Austria, Denmark, Finland, and Ireland in recent years.

Branching off

The law of some Member States e.g., Germany provide for “branching-off”, namely that a utility model application may be filed for subject-matter of an earlier national patent application or of a European or PCT patent application having effect in the Member State concerned. The utility model application enjoys the filing date and also any priority date of the earlier patent application. The utility model may be filed up to the expiration of two months from the end of the month in which a final decision on the patent application is made.

It has been noted that the proposed utility model directive does not allow a utility model application to be derived from a pending patent application by branching off. Based on experience by members in countries having a utility model system allowing “branching off”, the epi is of the opinion it is extremely useful to have a stipulation for “branching off”, included in the Directive because such stipulation would allow an important interaction between the patent and utility model systems.

Lack of provision for “branching off” would mean a substantial increase in costs for an applicant who wants to obtain the best possible protection in Europe. In addition to a European patent application the patent applicant would as a safeguard have to file a utility model application in each and every European country in order to allow him for example

- to take legal action against an alleged infringer while the European patent application is still pending, or
- to obtain a utility model protection in case the patent application is rejected due to lack of inventive step as required for patenting.

In most cases the utility model registrations would prove to be superfluous and the money spent would be wasted. However, in some more rare cases they might prove to be vital for enforcing or obtaining a right. Therefore, a stipulation for branching off is very important to a patent applicant so that he may file national utility model applications covering the same invention as the patent application when and only when it proves necessary.
General wording of the Draft Directive
Where it is appropriate to do so the wording of the European Patent Convention should be adopted, as otherwise there is a possibility of confusion arising.

Comments on the various Articles of the Proposal

Articles 1 and 2 – Action at Community Level
It is noted that it is not now proposed to introduce a single Community right; the Directive proposes to harmonise national laws, in particular the basic rules governing inter alia protectable matter, requirements for protectability, and the extent and duration of protection. This approach accords with the views of epi, which is not in favour of a Community system of utility model protection.

Article 3 – Protectable Inventions and

Article 4 – Exclusions from patentability
The epi considers that all inventions susceptible of industrial application, within the terms of Article 52 EPC should be protectable by utility model. However, it is noted by the epi that certain industries, in particular the chemical, pharmaceutical and electronic industries, may wish to exclude certain categories of inventions, and their views must be taken into consideration.

Article 3 of the draft directive is substantially similar to Article 52 EPC except that "programs for computers" are not listed as inventions which are not protectable.

Article 4 contains a list of exclusions from protectability which includes computer programs, inventions relating to biological material, and chemical or pharmaceutical substances or processes.

The reasoning given by the Commission for excluding these categories is not convincing, and the same argument could be used to justify excluding certain other technical fields.

It should also be noted that some Member States already provide utility model protection for these excluded categories. It might therefore be more appropriate if the Directive provided that Member States may at their option exclude some or all of these categories from protection.

It is noted that three-dimensional form is not a requirement for protectability, and this accords with the views of the epi.

Article 5 – Novelty
Universal novelty is required, and this accords with the views expressed by the epi. However, the term "date of filing" must include the priority date as in Article 89 EPC (see comments under Articles 17 & 18). Paragraph 3 should be amended to provide that not only the content of a previously filed utility model application, but also the content of a patent application of earlier priority date filed in the same country, should be comprised in the state of the art for novelty purposes.

Article 6 – Inventive Step
Article 6 of the draft Directive provides that an invention involves an inventive step for the purpose of a utility model if it exhibits either:
1. Particular effectiveness in terms of, for example, ease of application or use; or
2. a practical or industrial advantage.

The epi considers the above definition to be unsatisfactory because it is unclear, and more particularly because it defines a level of technical progress rather than inventive step. The epi considers that a requirement of technical progress only is unacceptable to industry and would be detrimental to SMEs.

The epi is of the view that the level of inventive step required should be the same as that for patents, and consistent with that required under Article 56 EPC. The epi considers that the level of inventive step required under Article 56 EPC is already sufficiently low, and any lower requirement would lead to the grant of a large number of utility models in Europe for minor modifications or improvements not justifying protection. This could seriously hamper European industry and would be detrimental to free competition.

In a situation where the level of inventive step is the same as for patents, all categories of invention should be protectable by a utility model.

Further, the epi is of the view that the requirement in Article 6 that in the utility model application the applicant must indicate clearly and convincingly that the invention meets the requirements of a) and b), is too onerous on applicants and is likely, in many cases, to be unworkable in practice. Quite often the applicant does not know the closest prior art when the application is filed. Therefore, it should be possible to show at a later stage, for example when a search has been made, that the requirements for inventive step are fulfilled.

Article 7 – Industrial Application
The epi considers that there should be industrial application similar to that of Article 57 EPC, and we note that this is provided for in the draft Directive.

It is noted that the wording of the exclusion of surgical or therapeutic treatment procedures in Article 7.2 of the Directive differs from Art 52(4) EPC.

Chapter III – Utility Model Application

Articles 8 – 12
The epi is of the view that the application procedure should substantially follow Articles 72 and 80 to 85 EPC and we note that this is what is done in Articles 8 to 14 of the draft Directive with some small changes of wording.

It is assumed that physical requirements such as page sizes, line numbering, margins etc. will be included in implementing Rules or Regulations.
Article 13

The epi notes that Article 13 is not restricted to any specific number of claims, but the number of claims is limited to that which is strictly necessary having regard to the nature of the invention. The epi is against this limitation, and notes that there is no effective sanction if the limit is not observed.

The epi strongly recommends deletion of the second paragraph of this article. Applicant must have the right to decide how the claims should be drafted and how many claims are necessary to properly protect the invention. The proposed provision will most likely give rise to disputes between applicants and the competent authority about the "strictly necessary" number of claims.

According to the “Examination of the Provisions” this requirement “makes it possible to limit the extent of the protection so as to compensate for the lack of any preliminary examination”. This argument is not convincing because the scope of protection is determined by the independent claim or claims and not by the number of dependent claims. Furthermore, in a revocation procedure according to Article 24 in the proposed directive a too broad independent claim could presumable be restricted either by combining the independent claim and one or more dependent claims or by inserting restricting statements found in the description into the independent claim. Therefore, the proposed restriction of the number of claims would encourage the applicant to “park” unallowable dependent claims in the description.

Finally, despite the proposed stipulation the applicant can include as many claims as he wants because according to the proposed Article 15 the competent authority shall not examine whether the requirements of Article 13 are fulfilled.

Article 15 – Examination as to Formal Requirements

Examination is restricted to formalities. However, the requirements of Article 7, industrial applicability, is excluded from the formality examination. The epi considers that while there should be no substantive examination extending to novelty and inventive step, there should be a check that the invention complies with the requirement of industrial applicability.

Furthermore, according to the first paragraph of Article 15 the competent authority "shall check whether it contains a description and an abstract". This statement seems to be superfluous because according to the same paragraph the competent authority "shall examine whether the application satisfies the formal requirement of Articles 8 and 10". Article 8 prescribes that the application shall contain i.a. a description of the invention and an abstract.

Article 16 – Search Report

This provides for an optional search report at the request of the applicant only.

The epi is in favour of an optional search report, but considers that it could be at the request of a third party as well as the applicant.

Article 16(4) provides that Member States may require the provision of a search report before infringement proceedings are brought.

The epi is in favour of a situation where all Member States are required to provide for the filing of a search report by the proprietor of the utility model in the event of infringement proceedings being brought.

However, epi would prefer if the proprietor could initiate the infringement proceedings after requesting the search report provided that the Court stays the proceedings until the search report is filed.

Articles 17 and 18 – Priority

Article 17 provides for external priority rights, whereas Article 18 provides for internal priority.

The priority provisions as currently worded are unsatisfactory.

Firstly, the “date of filing” in Article 5 (Novelty) must include the priority date (as in Article 89 EPC).

Secondly, Article 17 appears to limit external priority to EU Member States. This is unacceptable and would be contrary to the Paris Convention. There must be a right to claim priority from a patent or utility model application filed in any Paris Convention country.

This objection could be overcome by rewording Article 17 to accord more closely with Article 87 EPC.

In relation to Article 18 this is limited to internal priority from a patent application. There must be provision to claim internal priority also from a utility model application. Also, the patent application referred to in this article could cover more than one invention. Therefore, the last sentence in the first paragraph should not refer to priority already claimed “for the patent application”, but for “said same invention disclosed in the patent application”.

A revised text is attached as Annex 1.

Article 19 – Duration of Protection

The epi, is in favour of a maximum term of 10 years renewable in steps of one year.

While the draft Directive provides for a maximum duration of ten years, the period of renewal is not annual. Instead, the utility model has an initial term of six years renewable by two further periods of two years. Renewal must be requested six months before the previous expiry date.

This does not appear satisfactory and may be contrary to Article 5bis of the Paris Convention.

It is noted that there is no specific provision for payment of a renewal fee.

Article 20 – Rights Conferred

Article 20 is based on Articles 28, 30 and 31 of TRIPS.

The epi considers that provision must be included in the Directive for a right of third parties based on prior use
and right of personal possession. It appears that paragraph 5 of Article 20 would enable Member States to include such provisions, but they are not mandatory.

The epi also notes that compulsory licences should be the same as for patents and should be compatible with TRIPS. Paragraph 6 allows for this, but again it is not mandatory on Member States to include compulsory licence provisions.

**Article 21 – Community Exhaustion of Rights**

This provides for exhaustion of rights after the product has been put on the market in the Community by the owner or with his consent. The epi is in favour of exhaustion of rights provisions, in accordance with existing Rules of Community law, being included.

**Article 22 – Dual Protection**

This allows the same invention to be the subject matter of a patent and utility model, but Member States may provide that the utility model is deemed ineffective when the patent is granted.

This is consistent with the views expressed by epi. The epi suggests an additional provision, that where Member States allow both rights to co-exist successive infringement proceedings cannot be instituted under both sets of rights.

**Article 24 – Revocation**

The grounds for revocation are based on Article 56 EPC.

**Other Points – Date of Publication**

a) The epi considers that it is important that the Directive provides that the date of publication of a utility model should be the same in all Member States. It is suggested that the utility model be published on grant or after 18 months from the earliest priority date, whichever is the earlier.

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**ANNEX I**

**Article 17**

Priority Right

1. Any person who has duly filed an application for a utility model or patent in or for a State being party to the Paris Convention for the Protection of Industrial Property, or his successor in title, shall enjoy, for the purpose of filing a utility model application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

2. Any filing that is equivalent to a regular national filing under the domestic law of the State where it was made, or under bilateral or multilateral agreements, shall be recognised as giving rise to a right of priority.

3. By regular national filing is meant any filing that is sufficient to establish the date on which the application was filed in the State concerned, whatever may be the outcome of the application.

**Article 18**

Internal priority

1. Any person who has duly filed a patent application or utility model application in or for a Member State shall enjoy, for the purpose of filing a utility model application on or for the same Member State in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application. The provisions of Art. 17(1), (2) and (3) shall apply *mutatis mutandis*.

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**A Grace Period for Patents?**

Arthur Huygens, President of the epi

**Introduction**

On 5 October 1998, the European Commission held a hearing in Brussels on this topic in the framework of its study to the usefulness of a grace period, especially to SMEs and non-industrial research workers. The hearing was attended by more than 40 organisations who gave a variety of views.

Some years ago, the epi developed a position on the possible introduction of a grace period. The position was clearly against such an introduction, essentially because it would result in increasing legal uncertainty and reduce the chances to come to a world-wide, harmonised first-to-file system in the foreseeable future. At the same time it was recognised that efforts should be continued to educate those users who are not familiar with the patent system.

This position was reconfirmed by the EPPC and the epi Board prior to the hearing in Brussels and subsequently
endorsed by the *epi* Council at its meeting in The Hague on 12-13 October 1998.

A slightly abridged version of the speech which I gave in Brussels follows below.

**Position of the *epi* presented at the hearing in Brussels**

"Mr. Chairman,

*epi* is the statutory association of professional representatives before the European Patent Office and has almost 6000 members from the 19 Member States of the EPC. It represents both patent attorneys working in industry and in private practice. As such European patent attorneys are first line intermediates and consultants linking the Innovators to the Administrations in Europe, which are responsible for granting patents.

*epi* is opposed to the introduction of a grace period under the present circumstances, mainly because of the increasing legal uncertainty and the bargaining position towards the USA. *epi* fully shares the views of UNICE and CEFIC, as they have been expressed this morning by Mr. Beton (GB), Mr. Ramon (BE), Mr. Yorke (CH), Mr. Dänner (DE), and others.

Creating a grace period in the patent systems in Europe will cause a lot of problems which will go far beyond the benefits which might be brought by the introduction of a grace period. In other words, the remedy is worse than the disease.

We have heard this morning a number of drawbacks: postponing investment decisions, who possesses what and when, loss of rights abroad where there is no grace period, etc., the key word being legal uncertainty. Legal uncertainty in return of what?

It is true that a grace period might be a useful safety net in exceptional cases, where an early unintentional publication would immediately kill the possibilities for obtaining patent protection (loss of rights). However, it is to be feared that complications will arise when these exceptions are made a rule.

At present, not only the big industry in Europe with their own patent departments, but also SMEs, universities and individual inventors are aware or at least should know that one has to file first before disclosing their inventions to others. This is simply a matter of education and there is a continuing task of providing information on patents for both the patent profession and the Patent Offices, including technology transfer centers, etc. About a year ago *epi* has issued a brochure entitled "An introduction to Patents in Europe" in several languages, in which it is stressed that patent protection should be sought before disclosing an invention to others. This brochure has become a best seller and it meets the purpose. And there are more such publications.

Once the SMEs and individual inventors have reached the stage of consulting a patent attorney first, the problem is over. Every patent attorney will of course advise his clients to file first and, it is my view, the costs for a first filing are relatively low (on average in the order of between 5,000 and 10,000 DM) and certainly not prohibitive. In my view, lack of financial resources is not a good reason for introducing a grace period.

Of course, I realise that despite all information provided there are cases where inventors do not want to listen or for other reasons publish their work or show their products first and then come to a patent attorney. Although I have no clear figures, I believe these are rather isolated cases and, with all due respect, it is just bad luck. They will never do it again. It is a matter of continuously providing information to certain target groups such as SMEs, universities and single inventors to create awareness of the patent system. As I said before, this is a task for the professional bodies, and others. And like any part of the law, ignorance of patent law is not excusable.

No grace period has been available in Europe for the last 20 years after harmonisation of patent laws in line with the Strasbourg Convention and EPC. I support the view that introduction of a grace period in Europe would severely affect the legal certainty on which the European system is based. One should not create a new system based on exceptions which, moreover, can and should be avoided by disseminating good information on the patent system.

If, however, a grace period would be introduced, this does not solve the basic problem of obtaining patent protection in a timely way. No, it may even worsen the situation, since it would stimulate ignorance of the system. It may even encourage publishing, with all consequences involved. In such a situation, the groups concerned keep only one thing in mind and that is that they may now publish before contacting a patent attorney. It is to be feared that they may again come too late. Is there any guarantee that they will observe tomorrow a time limit after publication, if they are not able or willing to observe a time limit today prior to a publication?

Therefore, I believe the basic problem will not be solved by the introduction of a grace period and, in return, we get extra complications and legal uncertainty. The introduction of a grace period in Europe alone would further increase confusion in global patent activities, which is contrary to the general harmonisation policy successfully promoted by the Commission. Instead of a grace period other solutions may be conceivable as a safety net, such as taking advantage of the minimum requirements as provided in Art. 80 EPC, where even no filing fee is required.

Introduction of a global grace period under a global well-harmonised first-to-file patent system would be acceptable as a compromise solution, although the same basic objections against a grace period as such will remain to exist.

I wanted to restrict myself to these aspects in the limited time available.

Thank you, Mr. Chairman."
Regional Professional Bodies – the epi experience

Arthur Huygens, President of the epi


Ladies and Gentlemen,

I am very pleased and honoured to address you today and to share some thoughts with you on the future of the epi. Looking through the list of participants, I noted that the vast majority of those who are coming from an EPC Member State are members of epi. So, I should like to get some comment from the members, and of course also from other people, as to whether you can agree with these ideas. If you agree, please tell me and convey it to others as well. If you disagree, please only inform me, preferably in writing.

I should also like to congratulate the Chartered Institute on choosing the interesting theme of regionalisation of Industrial Property for this Congress. Not only is it interesting, it forces institutions and individuals to reflect on the many aspects involved and, as far as the speakers are concerned, to put their ideas on paper.

A friend of mine, a Dutch lawyer who is outside the Industrial Property field, once gave the following picture of patent attorneys:

“If two patent attorneys meet, there is great chance that they know each other and that they share membership of at least a couple of organisations. If they do not know each other, they create a new organisation.”

It is true that there is a plurality of organisations in the Industrial Property field, national, regional, and global, and that one can spend a lifetime to attend all sorts of symposia, conferences, meetings – you name it – organised by these organisations.

There are also people who are in the possession of whole collections of hats, which they wear at such events to voice opinions on behalf of the organisations that they represent. Sometimes, they wear more than one hat at the same time.

Where does the epi stand in this pluriform society? The epi now is only 21 years young. Some of the old, well-established organisations may consider this newcomer as an unashamed gate-crasher, that does not add anything to what the others already had done before.

This of course is not true; the epi has become a well-established organisation with its own place in the Industrial Property society. I thank the organisers for giving me 5 minutes more, as compared to my colleagues, to briefly explain the task and role of the epi before looking into the future.

What is epi?

Despite the fact that there are many epi-members in the audience, I believe I have to pay some attention to this question. I am sure many of you will not be familiar with the answer.

The Institute of Professional Representatives (epi) was founded on 21 October 1977 by the Administrative Council of the European Patent Organisation, in accordance with Article 134(8) EPC. Thus, this (now) fresh adult is the statutory professional association within the European Patent Organisation.

Both the European Patent Office and the European Patent Institute are based on the European Patent Convention. There is one big difference between the Office and the epi: the epi is autonomous, whereas the Office is governed by the Administrative Council, i.e. the Presidents of the national Patent Offices. In other words, Mr. Kober has 19 bosses..... You've got it, there is no parallel between epi and the national patent attorneys associations. Tibor and I are just good friends; he is not my boss.

Like the Chartered Institute, the Netherlands Institute and various other patent attorney associations in the EPC Member States (IE, ES, PT, GR), epi is a unitary organisation, i.e. the European Patent Convention makes no distinction between patent attorneys in private practice and those employed in the patent departments of industrial enterprises.

The objects of the Institute

The four objects of the epi as laid down in its Founding Regulations are:
- to collaborate with the European Patent Organisation on matters relating to the patent profession and, in particular, on disciplinary matters and on the European qualifying examination;
- to aid in the dissemination of knowledge relevant to the work of epi members;
- to promote compliance by epi members of a code of professional conduct;
- to liaise, as appropriate, with the European Patent Organisation, and other bodies, on matters as they relate to industrial property.

I would like to add a fifth object, which is based on a resolution of the Administrative Council in 1984: “the epi forms an institution integrated into the framework of the European patent grant procedure”. This means that the European Patent Organisation and European patent attorneys are part of an overall system and jointly bound to use their endeavours (as the preamble of the European Patent Convention puts it) “to strengthen co-operation between the States of Europe in respect of the protection of inventions.”

You see, from these objects in the Founding Regulations and the resolution of the Administrative Council, that the epi and the European Patent Organisation are bound to each other. There are many links between the two organisations – official ones (e.g. epi members are appointed to the Examination Board, the Disciplinary Board and the Disciplinary Board of Appeal, which are
mixed bodies with the EPO; and to SACEPO), and unofficial ones (e.g. the Liaison Committee between the EPO and EPPC).

One of its important achievements is that epi has obtained observer status in the Administrative Council and the Committee on Patent Law. The process took us several years before the Administrative Council reluctantly agreed. As far as I am aware, epi is the only organisation from the so-called interested circles with observer status, the difference with other organisations being that epi is part of the European Organisation, whereas others are not. You may know that the Administrative Council is extremely reluctant to admit other bodies as observers, mainly because of the precedence that it might create for third parties.

Membership

All persons listed at the European Patent Office as professional representatives (i.e. European patent attorneys) are members of epi. In other words, the membership of epi is mandatory.

At the beginning of 1998, the epi had almost 6,000 members from 19 Member States. Of these, 35.3% came from Germany, 23.1% from the UK and 9.6% from France. This amounts to a total of 68% of our membership stemming from only three countries.

There is, therefore, a very marked regional imbalance which shows up even more if one looks at the applications filed through professional representatives, which account for approx. 85% of all European patent applications filed. I do not have the exact figures, but I believe that about 70-75% are filed by European patent attorneys from Germany or the UK.

The concentration of professional activities in two main geographical areas, London and Munich, and consequently the uneven division of work among the profession in other Member States is the biggest problem that we have to face. To be honest, I do not see a solution to that problem and nor does the European Patent Office.

It would be acceptable, in my opinion, if the number of patent attorneys in certain countries was reduced as a result of free market mechanism. If there is no work, there are no patent attorneys needed and jobs will be lost. However, this should never result in a complete disappearance of the profession in certain (peripheral) countries.

There is also the tendency that the number of candidates in these countries who wish to qualify by the examination is decreasing. The question has been raised why young people should spend considerable time and effort in preparing themselves for the European qualifying examination, if there is no work and there are no jobs. Even worse, many of these people have a legal background and may act before the European Patent Office under the exception of Article 134(7) EPC. It is clear that is not good for the profession as such and for the high standards that we wish to maintain.

In summary, I am well aware of the big problem of the regional imbalance but I have no solution.

For those of you who are from outside Europe, I should add that the problem will not be solved by the modern communication tools presented by the USPTO and JPO in their futuristic outlook, as suggested by Mr. Lehman some weeks ago in San Francisco when he gave a similar presentation as we heard yesterday from Mr. Todd Dickerson. The problem is not just the geographical spread, but also cultural differences and a language barrier.

European patent attorneys

To complete the picture of representation before the European Patent Office, I should add, that besides professional representatives (i.e. the epi members) and legal practitioners according to Article 134(7) EPC, employees of applicants from the contracting states and patent attorneys from outside Europe, in particular the USA (for PCT II demands) may also act before the European Patent Office. In 1996, US patent attorneys represented about 1,700 such PCT II demands before the EPO. It is true that this number is relatively small, but I believe it should not be increased, in the absence of any form of reciprocity with the Americans.

In summary, more than 90% of the patent applications filed in the EPO pass through the hands of European patent attorneys. Nevertheless, there are other possibilities for filing a patent application at the EPO, so that there is certainly no monopoly position of our profession, not even de facto monopoly. This is the position taken by the epi and which was recently repeated once again in its defence against an investigation by the Commission.

The bodies

The epi is governed by a Council which is elected by its members every two years. The present size of the Council is 93 members from the 19 Member States.

The geographical expansion of the EPC from 7 countries in 1978 (Belgium, France, Germany, Great Britain, Italy, Luxembourg and the Netherlands) to 19 countries today resulted in an increase of new epi members from those countries and, accordingly, an increase of the size of the Council, the Board and the various Committees of the epi. Various attempts have been made to reduce the size of the Council and the Committees, in order to keep them manageable, and also in view of further geographical expansion in the years to come (8 countries have applied for adherence to the EPC: Poland, Czech Republic, Slovakia, Hungary, Slovenia, Estonia, Bulgaria, Romania).

In November 1996, the Council eventually accepted a proposal to reduce its own size, and to prolong the term of office from 2 to 3 years. This was then passed by the Administrative Council. Thus, from 1999 the size of Council will be reduced from 93 to 74 members. The size of the Board will remain unchanged, that is 22 members (i.e. including Cyprus).
Activities

The work of epi is mainly the function of specially elected Committees, which regularly report to the Council. There are about 10 active Committees, of which the European Patent Practice Committee (EPPC), the Professional Qualification Committee (PQC) and the Committee on Biotechnological Inventions are the most outspoken. These Committees, and the Committee on EPO Finances, have regular contacts with representatives of the EPO. EPPC, for example, has made numerous contributions to improve and streamline procedures before the EPO.

The size of the Committees is still a point of concern. Some of the Committees are quite popular and their sizes are close to their saturation point. It is clear that Committee meetings are also expensive because of the travel costs. The situation is still under investigation.

In summary, I believe we can be satisfied that all objects of the Institute, as laid down in the Founding Regulations, are fully complied with. In the past 20 years a good and efficient organisation has been built up, which can cope with a further expansion of EPC countries and we have excellent cooperation with the EPO at various levels.

When I prepared my speech, I suddenly realised that, as compared with the Chartered Institute at least one important Committee is still missing and that is the Social Committee! I will invite an experienced social British epi member to advise me how we can set up such a Committee.

Reverting now to a more serious item, I have become aware that, despite its excellent and streamlined organisation, on a national level the work of the epi as a professional organisation was relatively unknown compared with the national professional organisations in the member states.

The majority of the almost 6,000 ordinary members of the Institute know of the epi because they have to pay the annual subscription fee and because they receive the periodical epi Information four times a year which they do (or, I am afraid, don't) read, and that is it.

Most of our members are also a member of a national professional organisation which they are much more familiar with, because it is closer. To cite Paul Hartnack, people contact their corner shop association, not the epi. In many countries they get regular information from their national institute, visit annual meetings, meetings on special topics, sometimes social events, etc. These ordinary members are somewhat in the dark as to how the epi works. This strikes me, the more so because the bulk of the patent work handled by many of these persons is European patent work rather than work on the national level.

It is my firm opinion that, for the people who are handling predominantly European patent work, the epi should be the professional organisation. At present, the epi has about 150 members who are actively involved in the work of the Institute. This number is much too small for an organisation of almost 6,000 people.

When I took the chair, in May of last year, I mentioned several items which, in my opinion, were challenges for the new Board in the next two years and the years to come.

One of the items was that we had to improve the profile and impact of the epi within the current Contracting States and to attract more active members. The epi should be made known to young practitioners and to the broader public which forms our potential clients. Therefore, it was essential, in my opinion, inter alia to initiate contacts with national professional organisations and to develop regular activities on a national or regional level.

A few months later I started a round of consultations with the Presidents of national patent attorneys associations to investigate if, and to what extent, collaboration between these national organisations and the epi would be possible.

One of the first Presidents whom I met was Robert Beckham, your immediate past President. We had a very open and useful discussion on such items as education, continuing education, disseminating information, current issues in the Administrative Council, jointly organising events, and logistic support. I am sure this will have a follow-up. I have also been in other countries (Germany, France, Ireland, Netherlands, Spain, Switzerland), where I had the same experience of willingness to cooperate. A first Symposium, jointly organised by epi and the German patent association VPP, will be held in Ulm in November 1998.

Very high on my priority list is education.

Of course there is serious concern in all countries about the low pass rate of the European qualifying examination, combined with the fact that, in most of the present Member States, the "grandfathers" have retired or will retire in the next ten years. Incidentally, this point was raised in one of the Administrative Council meetings by Mr. Hartnack, who invited the EPO – in collaboration with the epi – to provide statistical data on the age structure of the epi members. Of course, this data does not solve the problem of the low passing rate, but it may be helpful in estimating, more accurately, how many people need to be recruited to fill the gap.

Numerous discussions have been held between the EPO and PQC on the reasons for the low pass rate (except for UK candidates) and possible remedies. It was agreed that the high standard which was established throughout the years should be maintained. Significant improvement was made in 1994 when the module system was introduced. Nevertheless, the pass rate remains low, especially among the so-called resettlers, and the number of candidates is further increasing which also means more work for the tutors and markers. This problem has now attracted the personal attention of Mr. Kober. Another, less controversial point is the simplification of the grades from 7 to 4 possibilities.

A continuing education programme for European patent attorneys is being set up, in view of the pressure on monopolies and deregulation. Our profession has to sell itself by offering quality. It appears that, in several
countries, this subject is high on the agenda and initiatives have been undertaken to start such a programme. The Professional Qualification Committee of epi have set up a “continuing education” committee and I am awaiting their first report. Without intervening in their conclusions and recommendations, it seems quite clear that such a programme, or at least an important part thereof, can only be set up at a regional level and not centrally.

I will explain this. The most important goal that epi wants to achieve is obtaining representation rights before any pan-European court. We realise that this will be very difficult, since we have to convince the lawyers and, no doubt, they will consider this not in their interest. Do not forget that also courts (obviously), law makers and many policy makers have a legal background, so they will have sympathy for the lobby of the lawyers. Therefore, the least that we should do is to pay special attention to the legal aspects of education. Patent attorneys in Europe mostly have a university degree in a technical science and not in law, in contrast to, for example, US patent attorneys.

In addition, it appears that the legal education or the legal background of the patent profession varies from country to country. Therefore, it seems appropriate to start at least this part of a continuing education programme on a national or regional level. This could well fit in with the ideas of national associations, since they also wish to obtain representation rights before their national courts.

I have already mentioned the topic of disseminating information in the discussions with the national associations. We should keep in mind that, to a very large extent, we share the same members, roughly more than 90%. Therefore, the idea is that it could be beneficial to jointly organise meetings, lectures, events, etc., which, for the epi, are then “regional” or “national” meetings.

For the epi, this seems a much more attractive way to reach its members than organising big symposia at a central place somewhere in Europe on a frequent basis. So far, we had only two symposia in the 21 years of our existence and that is not enough. It appears to be difficult to attract many members and there is much choice in attending competing symposia.

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

Thank you.

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**Amicus Curiae Brief to the Enlarged Board of Appeal filed by epi**

By its decision in the PGS case (T356/93), a Technical Board of Appeal effectively ruled that it is not possible to patent genetically engineered plants. This seemed to be in conflict with the onco-mouse case (T19/90) and so a question was referred to the Enlarged Board by the President of the EPO. epi filed an amicus curiae brief. However, the Enlarged Board refused to consider the question. In an attempt to have T356/93 overturned, a test case has proceeded from the Examining Division to the same Technical Board. This Board has now referred four questions to the Enlarged Board. epi has now filed a further amicus curiae brief with the Enlarged Board. The brief is set out below. The brief is intended to persuade the Enlarged Board that all exclusions from patentability in the EPC must be construed narrowly and that genetically engineered plants are patentable.

1. Introduction

1.1. This Brief contains a general review of the structure of the EPC, including comments on the way in which exclusions and exceptions are to be interpreted, and a section of comments on the points raised by the referring Appeal Board in the Annex it issued shortly prior to Oral Proceedings on the case which gave rise to the reference. There is then a section indicating how epi believes that the questions should be answered.

1.2. In considering the questions posed by the Appeal Board, it must be borne in mind that a claim of the type:

   “A plant which has been transformed by genetic engineering techniques so that it contains gene X in a form which can be stably transmitted to progeny.”

is under consideration. Such a plant is referred to hereinafter as “a transgenic plant”.

1.3. epi would in particular ask the Enlarged Board to bear in mind that Article 53 (b) EPC contains two exclusions and one exception to the exclusions. It is a well accepted principle of interpretation of legal instruments that exclusions are to be construed narrowly and that exceptions to exclusions are to be construed broadly. In this respect, the Enlarged
Board is referred to G5/83, T49/83, T385/86 and T320/87 in the biotechnology area and T208/84, T26/86, T6/83 and T158/88 in other technical areas. These decisions all indicate that exclusions must be construed narrowly. It is submitted that these points should be borne in mind when deciding what should be the answers to the questions.

2. Structure of the EPC and Article 53 EPC

2.1. It is believed that it is worthwhile to look at the structure of the EPC as regards the definitions of what is and what is not patentable. In this respect, the EPC starts with Article 52 (1). This states that:

"European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step." (emphasis added)

It is submitted that this is the general principle under which the EPO must operate. Thus, patents must be granted in all technical fields, except if otherwise provided.

2.2. The legislators also decided that there should be exclusions to the areas in which patents are to be granted. These are set out after the general principle. This clearly shows that the general principle should be applied except in specific cases. Thus, everything is allowed unless it is specifically forbidden. This also makes it clear that the general principle is broad and the exclusions are narrow.

2.3. It is submitted that it is worthwhile to look at what the legislators were intending when they drafted the exclusions which follow Article 52 (1) EPC. All the exclusions to patentability were drafted with some sort of activity in mind. In the case of Article 52 (2) and (3), it is clear that the legislators had in mind to exclude from patenting anything resulting from purely mental acts or which did not have any technical features.

2.4. It is interesting to note that many of the activities covered by this part of the EPC may well give rise to other forms of protection. For instance, aesthetic creations, programs for computers and presentations of information can all be covered by copyright protection. However, the legislators did not see fit to mention this in the EPC. Thus, the fact that the legislators did not mention the UPOV convention does not mean that they did not have it in mind.

2.5. It is submitted that there are useful analogies between Articles 52 (2) and (3) EPC and Article 53 (b) EPC. The referring Appeal Board had concentrated on the case law relating to computer programs. This had led the Appeal Board to develop its line of reasoning as regards “combinations”. It is submitted, however, that any granted patent on a combination of a computer program with other features provides protection for the computer program as such under the provisions of “contributory” infringement. Thus, it is submitted that the Appeal Board’s view is not correct.

2.6. The Enlarged Board is also referred to Article 52 (2) (b) EPC. If an inventor devises an improved clay for modelling, it is absolutely plain that the clay’s main use will be for the production of models, which are aesthetic creations. A claim to a moulded article composed of the improved clay will encompass a large number of aesthetic creations as such. This has not prevented the granting of patents on such subject matter. This is analogous to the situation for genetically engineered plants. It is submitted that a generic claim encompassing an excluded embodiment is allowable, whether the exclusion is under Article 52 or Article 53 EPC.

2.7. Turning to Article 52 (4) EPC, it is submitted that the argument set forth in Section 7 of the referring Appeal Board’s Annex does not take into account the reason behind Article 52 (4) EPC. This sub-article was introduced into the EPC because it was very clearly perceived that patents should not be allowed to interfere with physicians in treating patients. This was unambiguously the intention of the legislators and has never been contested before the EPO. Thus, this exclusion relates to a clearly defined field of activity.

2.8. It is interesting to note that the exclusion in Article 52 (4) EPC was construed by the Enlarged Board very narrowly so that the exclusion only covered activities carried out by or under the supervision of physicians in treating or diagnosing a disease (see G05/83 in paragraph 22). The Enlarged Board specifically allowed claims which excluded these activities, even where the point of novelty in the claim was only the first or second medical use.

2.9. In first medical use claims, the terminology used is:

"Substance X for use in medicine."

According to normal interpretation of claims, such a claim covers substance X per se, whether or not suited for use in medicine. The Enlarged Board held, however, that in the particular circumstances of Article 52 (4) EPC, a “for use” recitation, which is normally regarded as being non-limiting, must be interpreted as a limitation which excludes coverage of substance X per se. Thus, the Enlarged Board clearly envisages that special interpretations of claims can be made in circumstances relating to exclusions from patentability.

2.10. Turning now to Article 53 (b) EPC, it can be seen that it contains two exclusions to patentability, which should be construed narrowly in conformity with the principles set forth above. In order to determine how narrowly they should be interpreted, it is necessary to look at the reasons for their introduction into the EPC.
2.11. As far as plant varieties are concerned, the reason for the introduction of Article 53 (b) EPC was the existence of the UPOV Convention. It should be borne in mind that the drafters of the EPC had in mind the original text of the UPOV Convention. As the Enlarged Board will be well aware, there is now a new text for the UPOV Convention. (This has only recently come into force. It was not in force at the time of the PGS Decision, nor at the time of the referring Decision.) In the new text, the ban on double protection has been removed and the definition of a plant variety has changed. In the PGS Decision, the Appeal Board referred to the new text. It is submitted that this was incorrect and that, when interpreting the EPC, the original text of the UPOV convention should be considered.

2.12. It is submitted that the intention of the drafters of the EPC was to put into effect the double-protection ban in the original text of the UPOV Convention by providing that it should not be possible to obtain patent protection for anything which could be covered by the UPOV Convention. The UPOV Convention was concerned with the protection of the products of conventional biological plant breeding procedures, such as crossing and back-crossing of plants, to produce new varieties. The only input from the plant breeder is the selection of the plants to be used in these procedures and, eventually, of the variety to be protected. The UPOV Convention is not concerned with technical processes which might be used to improve plants in general. It is certainly not concerned with the procedures of biotechnology which, at the time of writing of the original UPOV text, had not even been contemplated. It is thus submitted that the drafters of the UPOV Convention only had in mind the protection of biologically produced plant varieties.

2.13. It must also be noted that there are two exclusions in Article 53 (b) EPC. The first exclusion relates to products, that is to plant and animal varieties. The second exclusion relates to processes, that is to essentially biological processes for the production of plants and animals. This process exclusion does not refer to “varieties” at all. It is therefore submitted that the product exclusion must be narrower than the process exclusion.

2.14. The referring Appeal Board seems to be of the opinion that the legislators had in mind to exclude the patenting of all animals and all plants. If this was the case, why did the legislators not say this? Instead, they very clearly limited the product exclusion to plant and animal varieties. It is only the process exclusion which relates to all animals and plants with no limitation. Thus, the clear differences in the wordings of the two exclusions demands that a narrower interpretation be given to the product exclusion than to the process exclusion.

2.15. It is submitted that the intention of the legislators can be clearly seen from the wordings of the exclusions. Again, the exclusions were aimed at particular activities. As stated above, these were the activities of classical plant and animal breeders involving the use of conventional biological processes. One of the results of these activities, aimed at improvement of plants or animals, was the production of new plant or animal varieties. Clearly, the legislators aimed the first (product) exclusion at the improved products of these activities. It is therefore plain that the first exclusion was intended to exclude from patentability only those plant or animal varieties generated by conventional biological processes.

2.16. There are also breeding activities which do not result in the production of new varieties. These are breeding activities which result in plants or animals for sale. These are the activities of farmers. It was plainly the legislators’ intention that patent law should not interfere with the use by farmers of conventionally-produced breeding stock to produce products (plants or animals) for sale. However, it cannot be read into this that the legislator also intended to exclude from patentability breeding of transgenic plants or animals.

2.17. It is submitted that it would be inconsistent if the first half sentence were to exclude from protection all plant varieties, however they may have been produced, yet only to exclude essentially biological processes for their production. An interpretation of Article 53 (b) EPC which is internally consistent and which is consistent with the ambit of the original UPOV Convention would be that the product exclusion to patentability of Article 53 (b) EPC, first half sentence relates solely to biologically-produced plant varieties.

2.18. It is also to be noted that the protection afforded by the original UPOV Convention is very specific. It covers only a single, distinct, uniform and stable variety of plant. The UPOV Convention, in its original text, does not use the term “variety” as part of a taxonomic grouping. The UPOV Convention only refers to any taxonomic groupings in order to define areas in which protection may or may not be obtained. Certainly, neither the original nor the revised text of the UPOV Convention provides for the protection of any taxonomic grouping such as a species, genus, family or order.

2.19. It is submitted that the drafters of the EPC did not intend to create an area of technical endeavour in which it was possible to obtain neither patent nor plant variety protection. It is believed that there was no intention to exclude from patent protection taxonomic groupings of plants, but solely varieties as defined by the original text of the UPOV Convention. It is therefore submitted that the exclusion of the first half sentence of Article 53 (b) EPC was intended to be limited only to varieties.
as defined by the UPOV Convention and not to any larger grouping.

2.20. Even if it is accepted that a generic claim to a plant may encompass a plant variety protectable under the UPOV Convention, it is submitted that this should not mean that the generic claim is unallowable, as the exclusion in Article 53 (b) EPC relates only to plant varieties, not to plants as such.

2.21. It is to be pointed out that the scope of a claim is determined according to the provisions of Articles 64 (2), 69 (and the relevant Protocol) and 84 EPC. It is a consideration of these Articles which should be used to determine what is covered by a claim. Article 53 (b) EPC determines what is excluded from patentability, not what is within the scope of a claim. However, it follows that what is excluded from patentability cannot be within the scope of a claim.

2.22. It is therefore submitted that the exclusion in Article 53 (b) EPC, first half sentence should be construed narrowly so that specific claims to biologically-produced plant or animal varieties are not allowable but that specific claims to non-biologically produced plants or animal varieties and generic claims to higher groupings of plants or animals are allowable.

2.23. It should also be borne in mind that the legislators could only exclude from patentability things about which they were aware. This raises two possibilities. The first is that the legislators were aware of the possibility of producing transgenic plants. The legislators could then have decided to exclude these from patentability. However, if they had done so, the exclusion in Article 53 (b) EPC would have been worded differently. The second possibility is that the legislators had no idea that transgenic plants could be produced. In this case, the legislators could not have even tried to exclude them from patentability. (Since the EPC was drafted before 1973 and was based on the Strasbourg Convention of 1963, it is difficult to imagine that the legislators could have had transgenic plants in mind when drafting Article 53 (b) EPC.) In either case, the clear conclusion is that there is nothing in the EPC which excludes transgenic plants from patentability.

2.24. It must also be noted that Article 53 (b) EPC contains an exception to the exclusions. This states that the exclusions do not apply to:

"... microbiological processes or the products thereof."

It is submitted that this exception should be construed broadly. It is therefore necessary to determine what is covered by the term "microbiological processes" and what are "the products thereof".

2.25. At the time that the EPC was drafted, microbiology was the science which related to the organisation and internal workings of micro-organisms. Microbiology also dealt with investigations of how micro-organisms could be manipulated technically in order to alter their properties. For instance, the production of improved strains of yeast and of antibiotic-producing bacteria fell within the area of microbiology. Such processes might involve the use of mutagens for altering the genetic make-up of a micro-organism so as to improve its properties. These operations were all of a technical character in that they involved significant intervention by humans. They were also of a technical character in that the micro-organisms were frequently used in industrial processes.

2.26. Although the techniques of recombinant DNA technology were, at the time of drafting the EPC, in the very early stages of development, it is submitted that the processes used in such technology are covered by the term "microbiological processes". The processes of recombinant DNA technology are technical in that they involve significant intervention by humans and in that their products are used industrially.

2.27. The micro-organisms investigated and worked on by microbiologists included not only protists, such as bacteria, yeasts and fungi, but also isolated plant and animal cells. Thus, a microbiological process was one which was carried out on or using any unicellular material.

2.28. It is therefore submitted that a "microbiological process", as referred to in Article 53 (b) EPC, second half sentence, encompasses any process involving the manipulation, including manipulation by recombinant DNA technology, of a micro-organism, such as a protist, animal or plant cell.

2.29. As to what are the "products" of microbiological processes, it is believed that it is useful to contrast the wording of Article 53 (b) EPC with that of Article 64 EPC. In Article 64 (2) EPC it is submitted that the protection conferred by a process claim:

"... shall extend to the products directly obtained by such process." (emphasis added)

This is in contrast to the wording of Article 53 (b) EPC, second half sentence, which is not limited to the "direct" products of microbiological processes. It is well accepted that if, in the same context, two phrases are not identical, it is usually the case that they do not have the same meaning. It is submitted that the difference in wording between Articles 53 (b) and 64 (2) EPC, both of which relate to products of processes, means that the two phrases have different meanings. Thus, in Article 53 (b) EPC, the "products" extend beyond the "direct" products of the microbiological processes.

2.30. From the definition of "microbiological process" given above it will be apparent that any cell which has been produced using a classical microbiological procedure or by use of recombinant DNA
technology is a direct product of a microbiological process. It is submitted, however, that the “products” of that process must encompass not only such a cell but also the progeny of that cell. This would be in line with standard microbiological practice. For instance, if the microbiological process produced a bacterial cell which secretes a useful antibiotic and the cell is then grown up so that the antibiotic can be harvested, all the progeny of that cell would be regarded as being the products of the microbiological process because they all have the desired property. The fact that, after the microbiological process has been carried out, the natural reproductive ability of the cell is used to produce progeny does not affect this conclusion.

2.31. As regards plant cells, it is submitted that the same conclusion must apply. It may be that producing progeny from a plant is a more complex process as it may involve regenerating a plant from a cell (the direct product of the process). Nonetheless, the plant will have all the characteristics endowed by the operation of the microbiological process and can thus be seen to be inextricably connected to the original cell produced by the microbiological process. It is thus submitted that plants and seeds derived from a cell produced by a microbiological process are the products of a microbiological process, as defined in Article 53 (b) EPC, second half sentence.

2.32. It is interesting to note that the EPO already recognises that “microbiological” as used in the EPC relates to more than micro-organisms. Rule 28 EPC has been amended so that it relates to the deposit of “biological material” such as plant cells, seeds and animal cells, instead of to the deposit of micro-organisms. It is submitted that this supports the view that the term “microbiological” should be interpreted broadly.

2.33. If the legislators had intended the exception in the second part of Article 53 (b) EPC to be limited to the direct products of microbiological processes, then they clearly could have used exactly the same wording as is used in Article 64 (2) EPC. The fact that they did not shows that the legislators had a different intention. It is submitted that the intention of the legislators is clear. They regarded the use of microbiological techniques as being technical, not biological, in nature and therefore suitable for protection using the patent system. No doubt they also realised that microbiological processes required some element of biological processing, even if it was just growing up a culture. However, this did not prevent the legislators from indicating that the direct and indirect products of microbiological processes were to be protectable using the patent system.

2.34. In its earlier Decision on the RGS case (T356/93), the referring Appeal Board indicated very clearly that transgenic plant material, such as cells and seeds, are microbiological material. In order to make these, it is necessary to use microbiological processes. Thus, a transgenic plant cell or a transgenic plant seed is the direct product of a microbiological process. It therefore follows that any transgenic plant regenerated from the cell or seed is the indirect product of a microbiological process. This being the case, it is clear that the exception in Article 53 (b) EPC confirms that transgenic plants are not covered by the exclusions in the Article.

3. Article 53 (b) EPC as a Whole

3.1. Taking the two parts of Article 53 (b) EPC together, it is submitted that they paint a coherent picture. The first half sentence indicates that the subject of plant or animal breeder’s rights, as far as new varieties produced by conventional breeding techniques are concerned, are excluded from patent protection, but it does not exclude the protection of higher groupings of plants or animals by patenting. The second half sentence indicates that any product which was made using a microbiological process, i.e. using a technical process, whether or not biological steps were taken after the microbiological process was completed, is not excluded from patentability.

3.2. It is believed that this view is in line with the views taken by the Enlarged Board and the Boards of Appeal regarding the exclusions in Article 52 EPC. In respect of those exclusions, there has been a clear distinction made between technical subject matter and excluded subject matter. The clear line of all the various decisions is that if the invention involves a significant technical contribution, it is not excluded from patentability. It is submitted that the same should apply in the case of Article 53 (b) EPC and that the exclusion should only apply to plant or animal varieties which were produced with no essential technical intervention.

3.3. It is submitted that the above analysis of the structure of the EPC shows that the exclusions in Article 53 (b) EPC do not extend to transgenic plants.

4. Comments on the Annex Issued by the Referring Board Prior to Oral Proceedings on the Application

4.1. In its Annex, the Appeal Board had stated that, before a narrow interpretation can be taken, it is necessary to show that there is both a broad and a narrow interpretation. The Board then went on, effectively, to say that there is only one interpretation of Article 53 (b) EPC. This is clearly not the case. A number of different interpretations have been set forth by various parties, but the Appeal Board appears to have ignored these in favour of its own view. There seems to be no consideration of anyone else’s view. It is requested that the Enlarged
Board take into account the views of other parties, such as that put forward above. This shows that there are both broad and narrow interpretations of Article 53 (b) EPC.

4.2. In its Section 8.3, the referring Appeal Board quotes from Article 53 (b) EPC but does not appear to notice that the exclusions relate, on the one hand, to plant or animal varieties and, on the other, to biological processes for producing plants and animals without any reference to varieties. It is clear from this alone that there are two different areas of exclusion using two different wordings, yet the Appeal Board appears to have taken no notice of this clear difference.

4.3. It is submitted that the point made in paragraph 4.2 above is very relevant to the fallacies put forward by the Appeal Board in its Section 9. In particular, in its Section 9.1(b), the Appeal Board stated that:

“The coupling of “plants” and “animals” and the use of “varieties” point to a broad consideration of living organisms whose primary form of exploitation is by reproduction of the organisms themselves.”

However, this does not take into account that in the same sentence “plants” and “animals” are not coupled to “varieties”. This makes it clear that the legislators deliberately wished to differentiate “plant or animals varieties” as products from “plants or animals” as produced by biological processes. It is submitted that the Enlarged Board should take into account these two clearly different definitions.

4.4. If the legislators had intended to make a broad exclusion of patenting of plants and animals, why was the product exclusion directed to “plant or animal varieties”? It would have been much easier to draw the exclusion to “plants and animals” without any reference to varieties (as was done in the “process” exclusion).

4.5. In further looking at the intentions of the legislators, it must be borne in mind that the legislators did know of the existence of the 1961 UPOV Convention and the activities it covered. It is clear that the exclusions were designed to exclude these essentially biological activities only.

4.6. It is to be noted that, if the legislators had intended to exclude transgenic plants and animals from patentability, they must have been aware of the possibility of their production. If the Appeal Board is correct that the possibility of transgenic plants and animals had not occurred to the legislators, then the exclusions cannot possibly have covered them and can only have covered the known, essentially biological activities referred to above.

4.7. Of course, it may have been that the legislators were very far-sighted and had contemplated the production of transgenic plants and animals. In this case, they might have come to the conclusion that any patenting of plants or animals should have been prohibited, whether or not there was a technical contribution to their production. This could have been done very easily. All the legislators would have needed to do was to put in Article 53 (b) EPC a simple provision stating that:

“European patents shall not be granted in respect of ... plants or animals or processes for their production.”

The fact that the legislators did not use such a simple formulation clearly shows that there was no intention to produce a blanket ban on the patenting of plants or animals.

4.8. It is submitted that the alleged problems with enforcing a patent related to transgenic plants or animals are no different from those in other areas. There are many areas where patents are difficult to enforce. The fact that there may be difficult questions as regards exploitation and enforcement of patents on transgenic plants or animals is not a reason to exclude them from patentability.

4.9. The referring Appeal Board attempted to reduce the scope of the exception in Article 53 (b) EPC by supposing that “animal” may have been interpreted to cover micro-organisms. However, this seems highly unlikely. In English, an animal is something much larger than a micro-organism. A micro-organism would not correctly be referred to as an animal. It is believed that the same is true in French (animal) and German (Tier). Thus, it is not the case that the exception was designed to cater for a possible misinterpretation of the term “animal”.

4.10. Again, if the Appeal Board were correct, it appears that the legislators used terms which they knew were unclear and used a cumbersome method in an attempt to resolve the lack of clarity. Even at the time of drafting, there were many ways in which plants and animals could be clearly distinguished from micro-organisms and so there would have been easy ways to resolve the supposed lack of clarity. It is submitted, in fact, that the legislators believed that there was already a clear distinction between plants and animals on the one hand and micro-organisms on the other. Thus, it is submitted that the Appeal Board’s view is not correct.

4.11. A large amount of the argumentation set forth by the Appeal Board, such as considerations as to farmers, problems with enforcement and the relationship with the UPOV Convention, assumes that the legislators discussed these matters at great length and in some depth. If that had been the case, there is no doubt that there would have been some record of such discussions in the contemporary material. However, as the Appeal Board itself has pointed out, there is very little in the contemporary material. This clearly indicates that
the assumed deep consideration did not take place.

4.12. The Appeal Board seems to think that special consideration should be given to farmers. However, there is nothing anywhere in the EPC or in the contemporary material which provides any justification for this view. Therefore, farmers are to be treated like any other member of the public. If anything, farmers are more likely to be aware of intellectual property problems. They are used to dealing with large companies for most of the products they use. They are well aware that there are often restrictions on what they can use and how they can use it. It would therefore be no more difficult for farmers to deal with the use of transgenic plants and animals than it would be for them to deal with the use of a protected plant variety or a patented chemical product.

4.13. It is submitted that the only possibility to avoid discrimination is to grant patent protection for transgenic plants and animals. The contrary will discriminate against inventors and companies who invest their time, effort and resources into the production of improved plants and animals for the benefit of society. Not granting patents in this area deprives inventors and companies of the justified return on their investment.

4.14. No doubt, any problems with farmer’s privilege can be dealt with by further legislation, such as the EU Biotechnology Directive. However, whether or not this is needed does not detract from the fact that the EPC clearly provides for the patenting of transgenic plants and animals.

5. The Referred Questions

5.1. Question 1

5.1.1. It is clear that all the instances of the EPO must examine whether a claim meets the requirements of the EPC as regards patentability. Since Article 53 (b) EPC is a part of the EPC, in appropriate cases, all the instances of the EPO must consider whether a claim is allowable under its provisions.

5.1.2. As to how a claim should be interpreted for this purpose, it is difficult to provide an answer without knowing the wording of the claim. It may be that the referring Appeal Board is questioning whether a claim to a transgenic plant can be interpreted so that it automatically excludes coverage of any biologically produced plant variety having the same gene. If this is the question, it cannot be seen why such an interpretation should be excluded, in analogy with the interpretation of first medical use claims.

5.1.3. Thus, as the Enlarged Board has already held that a claim to “Substance X for use in medicine” does not cover Substance X per se, because of the effect of Article 52 (4) EPC, the Enlarged Board could hold that a claim to a transgenic plant does not cover a biologically-produced plant variety, because of the effect of Article 53 (b) EPC.

5.2. The Second Question

5.2.1. It appears that this question is based on the assumption that a claim to a transgenic plant cannot be interpreted so that it does not cover biologically-produced plant varieties. Even in this case, the Enlarged Board could hold that the prohibition of Article 53 (b) EPC does not apply to a broad claim. This would be consistent with the practice of allowing broad claims to moulded compositions, even though such claims embrace aesthetic creations. In such cases, the prohibition of Article 52 (2) (b) EPC is not applied to the broad claims.

5.3. The Third Question

5.3.1. It is believed that this question is misleading. The provisions of Article 64 (2) EPC relate to the rights conferred by a patent, which are not taken into consideration during examination of a patent application. However, the provisions are couched in particular wording. It is submitted that it is the wording of Article 64 (2) EPC that should be taken into account when considering the wording of Article 53 (b) EPC.

5.3.2. The point here is that the legislators clearly knew that processes had direct products and indirect products. In Article 64 (2) EPC, the legislators chose to use the term “direct”, thereby limiting the application of Article 64 (2) EPC to the direct products of a process. However, in Article 53 (b) EPC, the same legislators did not refer to “direct” products. Rather, they referred merely to products with no limitation. Since the legislators could have inserted “direct” into Article 53 (b) EPC, as shown by Article 64 (2) EPC, but did not, it must be taken that the exception in Article 53 (b) EPC is not limited to direct products. There is no justification for inferring “direct” into Article 53 (b) EPC.

5.3.3. Thus, the wording of Article 64 (2) EPC shows that the exception of Article 53 (b) EPC was intended by the legislators to extend to all products of microbiological processes, whether direct or indirect. Thus, transgenic plants, seeds and plant cells are patentable by virtue of the exception in Article 53 (b) EPC.

5.4. The Fourth Question

5.4.1. The fourth question seems to be “Does Article 53 (b) EPC preclude the patenting of transgenic plants?”. It is submitted that it does not. Transgenic plants, at whatever stage, are the products, direct or indirect, of a microbiological process. They are not biologically-produced plant varieties.

5.4.2. Thus, the answer to the fourth question is “Yes”.

6. Summary
6.1. For the above reasons, it is submitted that Article 53 (b) EPC does not preclude the patenting of transgenic plants. The main reason for this view is the belief that the exception in Article 53 (b) EPC clearly applies to transgenic plants for reasons associated with the answers to the third and fourth questions. Moreover, for reasons associated with the answers to the first and second questions, generic claims to transgenic plants could be interpreted so as not to cover biologically produced plant varieties or so as to avoid the exclusions of Article 53 (b) EPC.

Le Délai de Grâce

J.-J Martin (FR)

"Les lois sont des rapports nécessaires qui dérivent de la nature des choses" (Montesquieu)

Introduction
En matière de brevets, le "délai de grâce" s'entend généralement comme la période de temps précédant le dépôt d'un brevet d'invention pendant laquelle les divulgations émanant directement ou indirectement de l'inventeur lui-même ne sont pas opposables à la validité de son titre. Autrement dit, pendant ce délai de grâce, l'inventeur peut être exonéré des conséquences en principe fâcheuses (défaut de nouveauté, d'où nullité du brevet) de ses propres divulgations.

De tels systèmes existent d'une part aux USA et au Canada dans le cadre de systèmes accordant le brevet au premier inventeur et, d'autre part, selon des modalités en général restrictives, dans un certain nombre d'autres pays accordant le brevet au premier déposant (dont le Japon, l'Allemagne, le Brésil, l'Argentine, l'Espagne, la Chine, la Corée, la Russie, l'Ukraine).

2. Pourquoi un délai de grâce est-il demandé aujourd'hui par certains déposants français et européens?
Les raisons classiques sont bien connues et elles sont d'ordre pratique.

Citons les situations suivantes:
- l'inventeur doit parfois procéder à des essais de l'invention avant dépôt qui l'exposent nécessairement à un risque de divulgation;
- dans bien des cas, en particulier pour les inventions chimiques ou pharmaceutiques, les obligations même en matière de description suffisante l'obligent à procéder à des essais. Par exemple, en matière de médicaments, les exigences de la jurisprudence en matière de propriétés pharmacologiques et d'applica-

3. Les deux concepts en compétition.
A ce stade, il convient de bien comprendre que le délai de grâce trouve sa signification et sa portée selon le concept de base adopté : on l'a vu dans le système américain, l'invention est attribuée au premier inventeur, dans les autres systèmes au premier déposant.
Chacun de ces systèmes a sa cohérence propre.
Dans le système du premier inventeur, les instances administratives et judiciaires recherchent véritablement qui est le premier inventeur (système des interférences et des discoveries) pour lui attribuer le brevet.
Dans un tel système, il n'y a aucun inconvénient à ce que les divulgations de l'inventeur ou de ses ayant-droits soient exonérées puisque de toutes façons les droits de l'inventeur remonteront à sa création première ("first conception" suivie de "reduction to practice"), tout ce que les tiers ont pu faire ultérieurement étant sans incidence sur la validité du brevet ultérieur.

De la même façon, le système du premier déposant est cohérent. Dans ce système, on ne se soucie pas en général de rechercher l'origine des droits du déposant, et il est alors inévitable que tout ce qui a été publié avant le premier dépôt soit considéré comme destructeur de la nouveauté.

L'erreur fondamentale consisterait à méêlanger sans précaution les deux systèmes de philosophies si différentes pour arriver à un hybride invivable qui serait le système du premier déposant assorti d'un délai de grâce systématique à l'américaine.

Ce système cumulerait les inconvénients. En particulier, toutes les publications ou divulgations des tiers postérieures à la divulgation mais antérieures au premier dépôt seraient susceptibles de détruire la validité du brevet, alors même qu'on ne saurait pas si elles émanent ou non de l'inventeur lui-même. De là une insécurité totale pour le public.

Incidentement, on peut observer que certains promoteurs du délai de grâce poussent subreptice après vers le système américain, en oubliant de dire clairement que le bon fonctionnement d'un délai de grâce suppose un système d'attribution des droits au premier inventeur, avec les moyens administratifs et juridictionnels nécessaires.

Dans ces conditions, la seule solution envisageable est celle d'un modeste compromis dans le but de satisfaire certains chercheurs, mais sans les encourager à négliger la condition de principe de nouveauté au premier dépôt.

La proposition est la suivante :
1. Il faut donner aux chercheurs français et européens le moyen exceptionnel de réparer leurs divulgations intempestives.
2. Il ne doit pas s'agir d'un mécanisme de priorité renvoyant au système du premier inventeur, que nous n'avons pas les moyens administratifs et judiciaires de faire fonctionner.
3. Il semble qu'il soit suffisant de prévoir pour l'inventeur ou son ayant-droit une simple immunité contre sa propre divulgation dûment identifiée pour les tiers. Les divulgations exonérées pourraient d'ailleurs être limitées aux publications, voire à certaines publications scientifiques (c'est ce qu'on fait au Japon).
4. Le mécanisme doit évidemment être aussi général que possible. Il pourrait être discuté par la Conférence Intergouvernementale de réforme de la Convention de Munich. Mieux, il pourrait être discuté à l'O.M.C. ; les Européens ne doivent alors rien abandonner sans contrepartie.
5. Il s'agirait là d'un simple mécanisme de récupération des erreurs utilisable à titre exceptionnel.
6. Un délai d'immunité de six mois semble suffisant.
7. Dans la pratique administrative, on pourrait prévoir :
   - qu'une déclaration d'immunité soit faite pour être obligatoirement publiée avec le brevet dans les dix-huit mois de la divulgation ;
   - que pour chaque divulgation exonérée, l'administration perçoive une taxe suffisamment élevée pour que la mesure d'immunité reste une pratique exceptionnelle.

Ainsi serait envisageable un compromis utile et réaliste qui ne remettrait pas en cause le principe de l'attribution du brevet au premier déposant qui est la pierre angulaire de la protection par brevet en France et en Europe.

U.S. Patent Law Post Markman/Hilton-Davis
A Gaze into a fractured Crystal Ball

J. M. Dulin

Overview:
The reality of the historic aversion of many U.S. courts to patent cases, in combination with an overburdened judiciary and the movement into "case management" means that the U.S. court system will continue to experience pressure to look for subtle (and perhaps not so subtle) ways to reduce case loads. Accordingly, patent practitioners should be alert to look for and to expect a series of new rules, presumptions, "clarifications" or "simplifications" to develop over the next few years by U.S. Courts under a "policy" of reducing the costs and divertive effect of patent litigation on the litigants.

In light of that overview, set forth below as an attempt to alert practitioners, are a dozen projected trends, some multi-faceted, of the more significant directions in which U.S. courts are expected to proceed over the next 5 years or so in deciding patent-related issues, keeping in mind that the process will be neither continuous nor direct.1)
Trends:

1. Narrowing Claims.

It should be expected that the courts, predominantly the US Court of Appeals for the Federal Circuit (herein "CAFC") as it reviews district court cases, will continue the trend of narrowing claims. This has two implications. More patents will be held valid, but conversely, patents will less likely be infringed. The courts are expected to send very clear messages that they will be constraining claims more narrowly, and will not look kindly on plaintiffs' attempts to broaden them. The net effect is that plaintiffs will have to think twice about suing for infringement where the defendants' device lies outside a narrow interpretation of the claims.

2. DOE – Known Interchangeability Test.

An associated effort of the court will be to clarify the Doctrine of Equivalents. The combination of narrow claim interpretation and fewer equivalents (or clearer standards of functional equivalency) will be pushed as a way to reduce the costs of litigation, primarily through simplifying the issues facing the courts, sub nom fewer issues for litigants. Consistent with the court's interest in case management and not having to decide tough, "arcane" technical issues, the court will attempt to articulate a standard for the test of substantial equivalents. Look for at least one test articulated as: in order for the accused device to be a substantial equivalent, it must be known in a particular art to be interchangeable for the claimed purpose.

3. Role of Documentary Evidence in DOE – The "When" Tug of War.

This "known interchangeability" test for substantial equivalents under the Doctrine of Equivalents will be touted as an objective test. The courts will look to documentary information in patents, technical journal articles, text books and product spec sheets, at the time of filing the application and/or prior thereto as being the kind of evidence which must be submitted to prove known interchangeability.

Italicizing "at the time of filing" just above is to highlight that "known interchangeability" may become a floating concept to keep pace of technology. Thus, the date for interchangeability could well become tested be at the time of infringement. This issue brings into play the submarine patents problem. Defendants are expected to rely on a policy argument to push back the date of knowledge of interchangeability to the time of filing, while patentees wish to keep it moving forward with the crest of the technological wave. The resulting "Policy Tug of War" should be expected to give rise to no clear consistency in decisions. The parties will need to be creative in developing fact-intensive criteria for their case judge to consider. There may be legislative attempts to craft exceptions for established practices in industry.

4. MSJ – Judicial Relief Valve

To the extent the court can rely on such documentary evidence vis a vis interchangeability, the possibility opens for more Motions for Summary Judgement (MSJ) of non-equivalence on the part of defendants in cases where literal infringement is not charged. U.S. Courts are expected to jump at the chance to dispose of non-literal, Doctrine of Equivalents infringement cases, the vast majority of all suits. Courts will also adhere to the principle that if there is no infringement then it need not decide validity; case over!


Greater emphasis on narrowing claims through objective tests of "construction", will make prosecution history review far more important. Defendants and courts will embark on "Estoppel Hunts". This means there will be a greater emphasis on the art cited, not only during the prosecution but also art cited defensively in litigation to fill the gaps in the Examiner's cited art. Likewise, Plaintiff patentees will look to cluing art to show teachings of known interchangeability already of record in the art.


Plaintiffs are expected to more readily resort to Reexaminations to counter new art, and then argue strenuously for great deference to resultant PTO Reexamination patentability decisions. As for Defendants, In re Portola Packaging, 42 USPQ 2d 1295, is bad news in its holding that the statutory requirement for granting a Reexamination Request ("substantial new question of patentability") cannot be based on a combination of references considered during the original prosecution, even if: 1) that combination was not considered by the Examiner, and 2) claims are amended during Reexamination.

7. Markman and Hilton-Davis Hearings.

Not only will we have Markman hearings, but also Hilton-Davis hearings. If an element is missing, as a matter of law there is no infringement. More than ever, literal infringement cases, already only 10% or less of all cases, will be settled well prior to trial.

A. Blocking Doctrine.

Markman Hearings may turn out in some cases to be extended hearings on Motions in Limine (MIL), but brought in the name of Markman well before the usual MIL. The courts, via Markman hearings are expected to further expand the emerging Blocking Doctrine, under which courts are expected to articulate that as a matter of law if a structure or process is fully disclosed and enabled in the specification, but it is not recited in the claims, then it is dedicated to the public.

B. Doctrine of Disclaiming.

The corollary Doctrine of Disclaiming will become even stronger as a result of Hilton-Davis. That is, if the language of the claim excludes an element, the patentee is estopped from relying on the Doctrine of Equivalents. A defendant practicing the prior art clearly can not be an infringer under the Doctrine of Equivalents. That is expected to be expanded from no infringement by practicing the prior art, to no infringement by practicing an
obvious variation thereof (which will be called an equivalent in some decisions) as a matter of law.

C. Role of Obviousness in H-D.
Stated another way, if you are charged with infringement under the Doctrine of Equivalents (DOE), you will be able to argue that as a matter of law you cannot be an infringer if your structure, element or process is an obvious variation of the prior art. Accordingly, a major aspect of a DOE Hilton-Davis hearing will be obviousness.

Of course, if such "obviousness" issues are not raised in a Hilton motion by defendant’s counsel, the court won’t address it. Accordingly, litigation management will take on even greater emphasis, particularly in early planning to set up depositions geared toward Markman and Hilton-Davis “defenses” and counters to them.

D. § 112(2) “objective” test of claim Scope – Notice Fairness.
Courts are also expected to look less to § 112(6) (due to Hilton-Davis holding that use of the term “equivalents” in § 112(6) does not negate the DOE), and more to the requirement for distinctly claiming what applicant regards as his invention in § 112(2). Courts will be increasingly clear that everyone has a right to know what is and is not covered by the claims in suit. The courts will put more emphasis on the § 112(2) “requirement” of notice. The courts will move forward fashioning what will be termed an “objective” test parallel to the obviousness test: What would a reasonable patent attorney make of this claim? The reasonable patent attorney will be one that is informed by a technical person of ordinary skill in this art.

E. Counsel Opinions on Infringement / Non-Infringe-
ment.
The courts will want to look at counsel’s opinions on this issue. Thus, there will be even greater emphasis on the competency of counsel opinions, and infringement/non-infringement opinion counsel not being trial counsel. Conversely, there will be an even greater need for due diligence (Federal Rules of Civil Procedure, Rule 11) both in deciding whether to bring suit and in defense. Clearly, the courts will continue to look at the reasonableness of the opinion of counsel, in part in light of the qualifications of the attorney rendering the opinion, as well as a recitation of the thought processes in arriving at the opinion. Conversely, litigation counsel not only need to understand the technology and the logic of an infringement opinion, but also need to be able to evaluate the qualifications of proposed opinion counsel before opinion counsel is retained and work begun.

8. Role of the Jury.
We all expect fewer cases will be going to a jury. Juries will continue to have a role, albeit restricted, in connection with the facts. Court will have less patience for an unending parade of conflicting, equally qualified expert witnesses. Post Hilton-Davis, technical equivalents will be a fact for the jury if the claims pass the summary judgment threshold. Increasingly, this will be one of the few remaining areas for the jury. Whether there is equivalence as a matter of law (not equivalents as a technical matter) and no blocking will be decided by the courts on summary judgment. There will probably be more Special Interrogatories to juries and Special Jury Verdicts.

A. Deference to PTO on Patentability.
One area of serious concern is that the US Patent & Trademark Office (PTO) is a strong aider and abettor of this trend of the courts on the “matter of law” road to quick resolution of cases. This surfaces in the arguments of the PTO that the court should give great deference to PTO Examiners' patentability “determinations”. The Patent Office essentially is trying to raise an opinion-type “holding” into an unreviewable “finding”, with the implication that they are binding on the court via great “deference” to the PTO. In fact they are nothing more than opinions and the PTO is often not fully informed enough to know or ascertain the level of skill in the art. But then, what the PTO might do to improve in that area is for another article.

The place for a defendant to attack is where the Patent Office’s “finding” or “holding” (however it is termed) of patentability (opinion) is not supported by a sound recitation of facts and analysis. Counsel should urge the court to look more carefully at the underlying facts, the analysis and the logic of the opinion. The CAFC is expected to send back cases to the Board of Appeals where it feels that there is an inadequate fact finding by the Board. The court will say in essence: “We don’t know how you arrived at this decision of patentability (or not); we remand to the Board to clarify.” The Board merely “opining” that claims are obvious, without support, will not be persuasive on appeal.

B. Test for Review of PTO Decisions.
In this regard, the Patent Office does not view favorably the present test of “clearly erroneous” because it does not give sufficient deference to the PTO. The PTO would like the CAFC to adopt the test that the Board’s decision was “not arbitrary.” While the CAFC in In re Lueders (96-1391, Fed. Cir. 97) rejected that standard of review, the court in In re Zurko (96-1258, Fed. Cir. 97) invited the PTO to apply for an en banc review on the question of proper standard of review of PTO findings of fact. But failing to get the CAFC to adopt the incredibly expansive “arbitrariness” test, the PTO would be willing to settle for a “substantial evidence to support the decision” test, since this does give more deference to conclusion Board opinions. The PTO simply does not want to be second-guessed. The implication is that to the extent the PTO pushes court decisions away from the “clear error” test into either a “not arbitrary” or “substantial evidence to support the decision” test, defendants will be less able to challenge a patent. Thus, especially in patentability cases, the CAFC is expected to remand more cases where the Board has arrived at a decision without setting out a good road map of how it arrived at its decision with a sound
analysis and complete chain of support, factual and logical, from point A to point B, from prior art to obviousness.

9. PHE-Search for Surrendered Structure.
Prosecution History Estoppel (PHE) review will gain new importance. Prosecution experience will be a vital asset on trial teams. The courts will look to PHE on a par with claims interpretation and prior art. Courts are expected to view the prosecution history as a powerful interpretive guide for the scope of the claims. The prosecution will probably become decisive with respect to literal infringement or not, and whether there was surrendering of structure by the patentee to permit the alleged infringer to block a charge of infringement under the doctrine of equivalence.

10. Enabling Amendments vs Limiting Amendments.
In regard to growth in prosecution history presumptions, under extensions of Hilton-Davis, offering an amendment to the claim will be presumed to be solely for the purpose of overcoming prior art to obtain allowance (= patentability). The courts will undoubtedly look beyond self-serving statements in the amendment to see what really happened. Where there is a seemingly limiting (=narrowing) amendment to overcome the art or a rejection, the patentee will have to present clear and convincing evidence that the amendment, including the statements (representations) made in the amendment, were not for the purposes of overcoming the prior art, but rather were to make the claimed device operable (that is, merely satisfying the enablement requirement of § 112(1)). The enabling type of amendment will not be limiting, but will of course reflect on the claim scope under the Doctrine of Equivalents. Accordingly, experienced practitioners will look for both § 112 and § 102/103 rejections in the same Office Action, and will cast their amendments and responses to the rejections as if the issue were one of operability. Wanted: Patent prosecutors with litigation experience.

11. Structural Array to Support Broad Claims.
The time is now past that the broadest claim is a "means plus function" claim. The law is clear now that means plus function claims are sharply limited by the structure in the specification and its equivalents (equivalent structure as tested by known interchangeability). Accordingly, it will be increasingly important for patent practitioners to put an array of structures in the specification in order to get any claim breadth whatsoever. Breadth is going to be more technology dependant, less broad in chemical and biologic/pharmaceutical arts, and somewhat broader in mechanical arts. But the "broad" old days are gone, and mechanical arts practitioners will need to borrow some tricks from their chemical brethren.

Litigation experience will be very helpful in the patent application drafting and PTO prosecution process. Here’s an example, from an area vital to Silicon Valley – software. In Fonar vs GE, 41Q2d 1801, the Federal Circuit held that the best mode requirement of § 112 (1) was satisfied in a software case by disclosure of the functions of the software. Neither source code nor flow charts are required any longer! (This case is instructive on grant of Defendant’s Judgment as a Matter of Law Motion at the District Court and its reversal by the CAFC). Going a step farther is Robotic Vision v View Engineering, (96-1365, CAFC 1997) which held that the best mode requirement does not even require disclosure of the function of the software where it is apparent to one of ordinary skill in the art (OSIA) that software would be required (in this case a control program to move a sensor in X-Y directions), and OSIA could easily write such software.

Where litigation experience in application drafting, and its converse, prosecution experience in litigation come into play, are in the Fonar and Robotic Vision type cases. These cases are a trap for the unwary. To the extent less best mode disclosure is required, there may be more on sale and publication bars. That is, many software consultants create software via a developmental program. Once the customer lists the desired functionality (what the program is to accomplish) and gives the developer an initial down payment on the program that doesn’t yet exist, does the clock start to run? Under Fonar and Robotic Vision, yes! Often it takes over a year to complete the writing and debugging of the program, and filing of the application may come 9-11 months later. Voiola, a defense generated by the lessening of the best mode requirement. Indeed, in that there is some confusion amongst practitioners (and litigators) as between best mode and enablement, both in § 112 (1), a further trap is that the patent practitioner, in skimping on best mode disclosure by merely listing functions, may inadvertently create a defense of lack of enablement support.

Conclusion
It goes without saying that the Doctrine of Equivalents will continue to remain very confusing. Not surprisingly, many courts don’t handle the doctrine well. Almost literally, it is a Field of Dreams – Patentees find coverage, while infringers retort “In your Dreams!”. Practitioners should not expect courts to continue relying on the battle of experts to resolve DOE issues. Courts will be encouraged to go back in time to look at what was thought of at the time of drafting and filing the application, rather than creative experting at the time of litigation. Accordingly, the courts are expected to look more to the patent file and contemporaneous documents from the technical literature.

While courts are expected to attempt to make litigation more predictable, and accordingly less of it, this doesn’t mean that litigators should now go solely into licensing. But it follows that licensing will become even more important as a solution alternative to litigation. Patentees will need to do a far better job of up front due diligence, which may reveal that licensing the potential infringer is the better solution. This is particularly the case where the infringement is a DOE-type infringement which could well be disposed of on a Motion for Summary Judgement or Judgement as a Matter of Law.
due diligence needs to be focused on whether the patent in suit could survive a vigorous and early Markman/Hilton-Davis set of hearings. Strategic licensing, including “single use” and “necessary only to the trade” licensing will come in vogue.

In summary, the courts should be expected to continue moving forward to a 4-step case management-based process:
1) PTO says the invention is patentable, court defers;
2) Claim scope interpretation by the Court on Doctrine of Equivalence cases via one or more early “Hurdle Motions” (MSJ and the mandatory JMOL reply); greater emphasis on prosecution history estoppel (dedications and blockings) with the burden on the patentee, and all amendments being presumed to be made to overcome prior art, not for enablement/operability. De novo review by CAFC of Trial Judges’ rulings on claim interpretation (scope); claim scope interpretation by Judge, in spite of the Supreme Court in Hilton-Davis not reaching Judge versus Jury issue (noting there was ample precedence for CAFC finding DOE is a jury question). Another Hurdle Motion will be misjoinder/non-joinder of inventors, with the burden on the challengers by clear and convincing evidence;
3) Under Hilton-Davis, the court looks to documentary evidence on whether or not there is known interchangeability on an element by element basis (only as to different elements) in the accused structure. DOE not applied to claim as a whole. If DOE, infringement. If not, no infringement; and
4) Validity review, only if infringed. PTO deference and presumptions remain strong, but patent scope, continues to narrow. It will be interesting to revisit these trend predictions in about 5 years to see how well they turn out.

Jacques M. Dulin is a Specialist Counsel to Heller Ehrman White & McAuliffe at Palo Alto, California

The Novelty Test of Article 123(2) and Article 54(3) EPC

Roy Marsh (GB)

The article by B. Grennberg which appeared in issue 3/1998 is a fine basis for debating the question, what actually does a document disclose. The question is of course relevant to the EPC Articles which Mr. Grennberg mentions, notably Article 83, 54(3) and 123(2). The Judges of patents courts in Europe owe it to our clients, that is to say, European industry, to find a common view.

The position under German national law can perhaps be summarised by a sentence which appears on page 45 of the book by Stockmair entitled The Protection of Technical Innovations and Designs in Germany (VCH 1994). This reads:

Such “obvious” equivalents are considered to form part of the original disclosure according to German case law.

In the Bonzel case, which was litigated before the Opposition Division and Technical Board of Appeal in the EPO, the English High Court, and the German Federal Patents Court and Supreme Court. The EPO and the English Courts found that matter had been added during prosecution, but both instances in the German Court found that no new subject matter had been added. The English proceedings were of course adversarial, with both sides putting forward evidence from technical experts, and both of these experts being cross-examined at length, in open court, by the advocate for the other side. The English judge relied on the evidence from both experts in finding that subject matter had been added. In Germany, the Supreme Court appointed its own expert, and relied upon the evidence from that expert in its finding that no new subject matter had been added.

How could such a different result come about? Perhaps the answer lies in provisions of German national patent law, specifically Section 38 and 21 of the Patent Act. Section 38 recites:

Bis zum Beschlüß über die Erteilung des Patents sind Änderungen der in der Anmeldung enthaltenen Angaben, die den Gegenstand der Anmeldung nicht erweitern, zulässig.

Section 21 sets out the grounds of revocation, with the "added subject matter" ground at Section 21(1)(4). The Benkard commentary recites at page 685:

Jedoch fällt eine Erweiterung des Offenbarungsgehalts der Beschreibung oder der Zeichnungen die weder mit einer Änderung des Anspruchswortlauts verbunden ist noch zu einer erweiterten Auslegung der veränderten Ansprüche führt, nicht unter den Tatbestand der unzulässigen Erweiterung.

which I would translate into English as:

An extension of the disclosure of the description or drawings, which is neither associated with a change to the wording of the claim(s) nor results in an extended interpretation of the altered claims, is not, however, covered by those facts which constitute the inadmissible extension.
In line with this background, it is perhaps not altogether surprising that the German Supreme Court came to a different view from that of the EPO and the English courts.

At the moment, the cry is for more harmonisation. There could be no better route map than the development of EPO case law over the last twenty years. Finding a line to reconcile the differing views in Germany and England is a major achievement. Specifically, the EPO has done much to “demystify” the issue of inventive step, often the issue which stands closest to the heart of any patent dispute. The time is right now to debate differences on the issues of “novelty” and “new subject matter” (in other words, what exactly does a document disclose) so as to bring about the same progress in Europe that has already been achieved on the issue of inventive step. The strict line taken by the EPO on amendment has the merit that it prevents applicants from belatedly making an insufficient description sufficient, or belatedly installing the basis for a fall back position of scope narrower than the main claim. The combination of a strict line on Article 123, together with a realistic line on EPC Article 69, meets the twin objectives of certainty for third parties and fairness for patent proprietors.

Mr. Grennberg speaks about different burdens of proof. While I agree with him that the substantiation of a particular level of disclosure can be harder to accomplish in some situations than others, I would disagree with him that the burden of proof is different. It seems to me that the ordinary level of proof used in civil litigation, namely the “balance of probabilities” is always the correct test to apply. It is simply that getting beyond the balance point can be more burdensome in some fact situations than in others, so more evidence is needed then. For example, when the fact which one is trying to prove is one that is inherently very unlikely, then it might be hard to bring the issue to a 50/50 balance of probabilities. In the English case Leonard Chapman v. Ian McAnulty it was proved that dates on engineering drawings had been changed. The “balance of probability” test is the one which was applied, but the difficulty of getting to that balance was a serious one. For a discussion of the standard of proof which the EPO applies, I would recommend the Lunzer 1995 English edition of the Singer commentary on the EPC, at Article 117 on page 625.

Are Patent Attorneys Needed?
Response to John Orchard's letter

M.G. Harman (GB)


My experience is not so long as his, but I recall a colleague in the early sixties remarking that when a German examiner had been persuaded of patentability, he would write to us saying what he was prepared to grant, and we would have to write back and object if we did not accept his proposals. I also remember at least one case where our German Associates went to an interview with the Examiner and reported back that the Examiner was unhappy with our claim (which was in US style) and had drafted a new claim for us in Germanic style which he was prepared to accept.

In the UK, Examiners were traditionally reluctant to suggest amendments, because it would be potentially embarrassing if it turned out later that something suggested by them was unnecessarily narrow (even though there was Crown immunity from being sued), they acknowledged that their expertise lay in examining and criticising claims rather than in drafting them, and the ultimate responsibility lay with the attorney. They did however stretch matters in the case of private applicants who did not have professional representation.

Before 1977, however, British Official Letters were normally accompanied by one copy of the specification for amendment. Examiners marked minor points and queries (in both the description and the claims) in pencil, sometimes just with an underlining and a question mark, and did sometimes suggest possible amendments in that way. If we agreed with a suggestion, we would copy it in ink, if we did not, we would simply rub it out. This practice was dropped under the 1997 Act as it was deemed too informal.

Too much informality can lead to sloppiness and worse, but we are now unfortunately deprived of the useful lubrication which a degree of informality gives.
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# RESULTS OF THE EUROPEAN QUALIFYING EXAMINATION 1998

**FIRST SITTING - Examination in full and modular sitting**

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</tbody>
</table>

RESITTING - Examination in full
Total number of candidates: 38
Passed: 0; Failed: 38

RESITTING - Examination in part
Total number of candidates: 487
Passed: 99 (20,3%); Failed: 388 (79,7%)
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 co-ordinate 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, o/to epi, as above.

Students of the epi

The Professional Qualifications Committee (PQC) would like to remind readers of the benefits, to those wishing to get on the List by way of the European Qualifying Examination (EQE), of applying to become Students of the epi.

Applying to become a Student involves payment of an entry fee of DEM 250, which provides the benefits to the end of the fourth year from the application date (an application form is printed hereafter). Each registered Student will receive his/her own copy of epi Information, a list of registered Students, and a "Training Manual". This latter includes a list of recommended reading material, a list of training resources in EPC States, the relevant EQE rules and provisions, training guidelines, and edited case studies (not available yet). This fee is not intended to raise profits for the epi, but only to cover foreseen costs.

The basic motive behind setting up this type of association with the epi is to persuade and enable would-be European Patent Attorneys to take responsibility (on a self-help basis) for getting the training and exposure to the work of a patent professional that each needs not only to pass the EQE but to function as a fully-competent patent attorney. If you have any concern for the future of our profession, and know a would-be candidate for teh EQE, then please play your part by bringing this notice to his/her attention.
Application to be registered as a Student of the epi

To be returned to:  
epi Secretariat  
Postfach 26 01 12  
D-80058 München  
Tel: +49 89 201 7080  
Fax: +49 89 202 1548

Please write in capital letters:

This is a □ first application □ continuation application

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

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

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

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

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

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

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

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

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

Candidate's signature: .................................................. 

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

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

Postbank München  
No. 703-802  
BLZ (Bank Sorting Code) 700 100 80
has been credited with 250 DM for the first application (for the first four year period) or 70 DM for each additional year.

(Please note that epi Studentship fees cannot be debited from the deposit account held with the European Patent Office)

I, ........................................................................................................

of ........................................................................................................

☐ being a European Patent Attorney on the list,

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

hereby sponsor:

........................................................................................................

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

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

........................................................................................................

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Sponsor's signature: .................................................................

Date: ...........................................................................
Entscheidung des Disziplinarrates des Instituts der beim europäischen Patentamt zugelassenen Vertreter
Disziplinarfall CD 6/97

AAA, vertreten durch BBB, gegen WXY

Zusammensetzung der Kammer:
V. GIL-VEGA – Vorsitzender
J. WAXWEILER – Berichterstatter
A. PISSARRA DIAS
MACHADO – Mitglied
J.-P. KEDINGER – Stellvertretendes Mitglied

1. Entscheidung
Die Kammer beschließt das Verfahren in Sachen Disziplinarfall CD 6/97 gegen die Herren WXY einzustellen.

2. Sachverhalt


3. Gründe für die Entscheidung
Im Hinblick auf die allgemeinen Grundsätze von Gesetz und Recht, sieht sich die Kammer nicht in der Lage eine Entscheidung in einer früher vor eine andere juristische Körperschaft gebrachte, noch anhängige, aber nicht entschiedene Sache zu erlassen.

Aus diesem Grund wird das Verfahren eingestellt.

Auf Grund des Artikels 20 der ergänzenden Verfahrensordnung des Disziplinarrates des EPI, empfiehlt die Kammer dem Präsidenten des Rates des Institutes die Entscheidung, ganz oder in Auszügen zu veröffentlichen, jedoch ohne die Identität der betroffenen zugelassenen Vertreter und des Klägers, es sei denn, diese stimmen der Veröffentlichung ihrer Namen zu.

4. Mitteilung über die Möglichkeit der Beschwerde
Beschwerde gegen die Entscheidung kann von den betroffenen zugelassenen Vertretern, vom Präsidenten des Rates des Institutes und vom Präsidenten des Europäischen Patentamtes eingereicht werden.


der Vorsitzende der Kammer
V. Gil-Vega
Entscheidung des Disziplinarrates des Instituts der beim
europäischen Patentamt zugelassenen Vertreter
Disziplinarfall CD 1/98

(in Fortsetzung von CD 2/95 bzw. D 16/95)

XXX gegen YYY

Zusammensetzung der Kammer:
W. KATSCHINKA – Vorsitzender
G. LEHERTE – Berichterstatter
H. LINDGAARD – Mitglied
F. BARENDEGT – Stellvertretendes Mitglied

Die Verfahrenssprache ist Deutsch

1. Entscheidung


2. Sachverhalt und Anträge


Es könne daher nicht gesagt werden, dass der zugelassene Vertreter seinen Patentanwaltsberuf gewissenhaft und in einer Weise ausgeübt habe, die der Würde dieses Berufes entspreche (Art. 1(1) VDV). Ferner habe er sich auch nicht so verhalten, “dass das Vertrauen, das für die Ausübung des Berufes notwendig ist, nicht beeinträchtigt wird” (Art. 1(2) VDV).

Der zugelassene Vertreter, YYY, stellt keine Anträge.


Es könne daher nicht gesagt werden, dass der zugelassene Vertreter seinen Patentanwaltsberuf gewissenhaft und in einer Weise ausgeübt habe, die der Würde dieses Berufes entspreche (Art. 1(1) VDV). Ferner habe er sich auch nicht so verhalten, “dass das Vertrauen, das für die Ausübung des Berufes notwendig ist, nicht beeinträchtigt wird” (Art. 1(2) VDV).

Der zugelassene Vertreter, YYY, stellt keine Anträge.

4. Beschwerde

5. Rechtliche Beurteilung der Beschwerdekammer


Da Tätigkeiten eines zugelassenen Vertreters, die sich auf die nationale Phase beziehen, durch die Vorschriften des Artikels 1 VDV geregelt werden, erfüllen ein tatdelwertes Verhalten eines zugelassenen Vertreters im Zusammenhang mit diesen Tätigkeiten den Tatbestand einer Verletzung der allgemeinen Berufspflichten gemäß Artikel 1 VDV.

Im Hinblick auf die Beibehaltung zweier Entscheidungsinstanzen hat die Beschwerdekammer den Fall an den Disziplinarerrat zurückverwiesen. Unter Zugrundelegung obiger rechtlicher Beurteilung hat der Disziplinarerrat eine Ermittlung hinsichtlich der Tatsachenbehaupungen durchzuführen und zu entscheiden.

6. Entscheidungsgründe


7. Kostenentscheidung

Im Hinblick auf den nicht überdurchschnittlichen Aufwand an Zeit und Spesen nimmt die Kammer Abstand von der Festsetzung eines Kostenersatzes.

8. Rechtsmittelbelehrung


Vorsitzender der Kammer
W. KATSCHINKA
Queen Mary and Westfield College
University of London
Training Programme in preparation for
the European Qualifying Examination 1999
1st – 3rd February 1999


As the course is usually over subscribed, applicants are advised to book early to avoid disappointment. Please note that there are only 40 places available. Offers will only be made on return of completed application forms on a first come, first served basis.

For further details please contact:
Queen Mary Intellectual Property Research Institute
Centre for Commercial Law Studies
Queen Mary and Westfield College
Mile End Road
G8-London E1 4NS

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

EPO Travelling Exhibition

The following countries are hosting the EPO Travelling Exhibition in 1999:

Ireland: 06.01.99 – 10.01.99 (Dublin)
Great Britain: 02.02.99 – 20.02.99 (London) – official opening on 08.02.99
Belgium: 08.03.99 – 26.03.99 (Brussels)
Switzerland: 12.05.99 – 30.05.99 (Luzern)
Cyprus: June 1999 (provisionally from 22.06. to 04.07.99)

Redaktionsschluß für epi Information 1/1999

Wegen der Veröffentlichung der Wahlergebnisse wurde der Redaktionsschluß für die nächste Ausgabe der epi Information auf den 5. Februar 1999 vorverlegt. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

Deadline for epi Information 1/1999

Because of the necessary publication of the election results the deadline for the next issue of epi Information has been brought forward to 5 February 1999. Documents for publication should have reached the Secretariat by this date.

Date limite pour epi Information 1/1999

En raison de la publication des résultats d'élection, la date limite de remise des documents pour le prochain numéro de epi Information a été avancée au 5 février 1999. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.
Sie erhalten diese Rechnung zur Verwendung bei Ihrer Steuererklaerung, auch wenn Sie bereits eine Einzugsermachtigung erteilt haben.

Bitte nutzen Sie die Einzugsmoglichkeit vom laufenden EPA-Konto, s. Anlage.

Uberweisungen (keine Schecks bitte) sind zu tätigen
- in Deutsche Mark (DM)
- Bankgebühren zu Ihren Lasten

Auf dem Überweisungsträger bitte angeben:
- Ihren Namen
- Ihre Mitgliedsnummer (steht neben Ihrem Namen auf dem Adreßaufkleber).


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

Der Schatzmeister
Knud Erik Vingtoft

4 January 1999

RECHNUNG
epi-Beitrag 1999

INVOICE
epi Subscription 1999

FACTURE
Cotisation epi 1999

DM 300

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

Although you may already have issued a direct debiting mandate, you will receive this invoice for filing your tax declaration.

Please use the possibility for direct debiting from EPO deposit accounts, see encl.

Transfers (no cheques please!) are to be made
- in German Marks (DM)
- all bank charges payable by subscriber

Please note on your transfer order:
- your name
- your registration number (shown next to your name on the label above).

Payments received after 30 April 1999 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.

Nous recommandons le prélèvement sur le compte courant à l’OEB, v. annexe.

Le virement (pas de chéques s.v.p.!) doit être effectué
- en Marks allemands (DM)
- frais bancaires à votre charge

Indiquez s.v.p. sur votre ordre de virement:
- votre nom
- votre numéro d’affiliation (inscrit à côté de votre nom sur l’étiquette).

Tout paiement reçus après le 30 avril 1999 est majoré de 50 DM.

Si votre compte-cotisation accuse déjà un solde débiteur, vous trouverez une feuille en annexe. Dans ce cas veuillez aussi virer la somme manquante.

Der Schatzmeister
Knud Erik Vingtoft

The Treasurer
Knud Erik Vingtoft

Le Trésorier
Knud Erik Vingtoft

Secretariat: P.O. Box 260112 · D-80058 München · Erhardtstr. 27 · D-80331 München
Bitte einreichen an:  
epi-Sekretariat  
Postfach 26 01 12  
D-80058 München  

Please return to:  

Retournez s.v.p. à:  

Telefax 089 - 202 15 48

Einzugsermächtigung  
Eingangsfrist im  
epi-Sekretariat:  
15. Februar

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

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

Direct debiting mandate  
Deadline for receipt by the  
epi Secretariat:  
15 February

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

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

Autorisation de prélèvement  
Date limite de réception au  
Secrétariat de l’épi:  
15 février

Veuillez envoyer cette autorisation de prélèvement ou une copie de celle-ci uniquement au Secrétariat de l’épi, pas à l’OEB.

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

Name/Vorname des epi-Mitglieds:  
epi member’s surname/first name:  
Nom/prénom du membre de l’épi

epi-Mitgliedsnummer:  
epi membership number:  
Numéro d’affiliation à l’épi:

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.

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

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

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

Datum - Date  

Unterschrift des Kontoinhabers - Account holder’s signature  
Signature du titulaire du compte
Einzugsermächtigung

Eingangsfrist im epi-Sekretariat: 15. Februar


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 prélève, 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 dus à l’OEB à la date de débit a priorité sur le prélèvement de la cotisation annuelle à l’epi. L’epi regroupe en un seul montant plusieurs cotisations devant être débitées du même compte. À 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 dus à l’OEB, la provision du compte ne suffit pas pleinement pour exécuter l’ordre de débit de l’epi ou si la présente autorisation parvient à l’epi après le 15 février, l’ordre de débit ne peut être exécuté, et le membre en est informé. Si celui-ci ne vire pas le montant de la cotisation le 30 avril au plus tard (date d’inscription au compte 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 prélève 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. À 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 Lösung 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) Zahl ist 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 Verwaltungs aufwand werden keine Schecks, Bankchecks, 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
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. 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.
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:
   a. un membre qui demande par écrit à l'OEB sa radiation de la liste des mandataires agréés avant le 1er avril;
   b. 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 alléger qu’elle n’a pas reçu l’appel de cotisation.

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

2. Mitgliedschaft


3. Jahresbeitrag
Die Verpflichtung zur Einrichtung des epi-Jahresbeitrags entsteht mit Eintragung in die Liste der zugelassenen Vertreter.
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 gequokert 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 19 Staaten am Patentübereinkommen beteiligt sind.
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.

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2. Affiliation


L’affiliation à l’epi expire automatiquement avec la radiation de la liste de l’OEB.

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b) elle se fait réinscrire sur la liste des mandataires après le 30 septembre.
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List of professional representatives as of 4.11.1998
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<th>BUREAU</th>
</tr>
</thead>
<tbody>
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