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Editorial

J. Gowshall . J. Kaden . E. Liesegang . T. Schuffenecker

The *epi* Council were informed at the 50th Council Meeting in Madrid (reported elsewhere in *epi* Information) that another two countries have expressed the intention to accede to the European Patent Convention in 2002. The addition of these two countries, Lithuania and Latvia, to the eight countries already intending to accede to the EPC in 2002 (Czech Republic, Poland, Hungary, Slovakia, Slovenia, Estonia, Romania and Bulgaria) means that, if all countries accede as intended, next year will see the number of countries in the European Patent Organisation increasing by 50%. There is no doubt that this huge increase in the number of parties involved in the organisation will bring some practical problems. For example, the European Patent Office will face a difficult task in maintaining the delicate balance between ensuring that the staff of the EPO contains appropriate national representation and, at the same time, maintaining the quality of service for which the European Patent Office aims.

Nonetheless, there will be many positive factors involved in the accession of these countries to the EPC. The convenience for clients of obtaining Patent protection in such a large number of countries using a single system cannot be underestimated and may well encourage even more work flowing into the offices of European Patent attorneys. Equally important is the increased influence that will be wielded by both the European Patent Office and the *epi* given the respective size of the organisations. In international terms, both the European Patent Office and the *epi* can be argued to be the most influential bodies in these rarefied and specialised fields.

Most of all, undoubtedly the inclusion of these countries will produce and encourage change both in the law and working practices. It is such change which provides us all with the fresh challenges which make this job so rewarding and, as such, the countries should be welcomed with open arms, as we are sure they will be.

Bericht über die 50. Ratssitzung in Madrid 7.-8. Mai 2001

Die 50. Ratssitzung des *epi* in Madrid war interessant und lebendig. Der Rat diskutierte ausführlich über verschiedene wichtige Punkte.

Präsident Walter Holzer eröffnete die Sitzung am 7. Mai 2001 um 9 h. Bevor er zum offiziellen Teil überging, informierte er den Rat, dass Herr André Braun Sr. aus der Schweiz, der erste Präsident des Finanzausschusses, vor kurzem verstorben ist. Der Rat hielt eine Schweigeminute zu Herrn Brauns Gedenken.

Sodann hieß der Präsident die offizielle Abordnung der Türkei zu ihrer ersten *epi* Ratssitzung willkommen.

Die Stimmzähler wurden bestimmt, die Tagesordnung wurde angenommen und das Protokoll sowie die Beschluss- und Maßnahmenliste der 49. Ratssitzung wurden angenommen. Der Präsident erläuterte dann die Beschlüsse über Maßnahmen, die der Vorstand seit der letzten Ratssitzung gefasst hat. Dies schloss eine kurze Diskussion über die Größe und Struktur von Ausschüssen ein sowie eine Aufforderung an den Ausschuss für Berufliche Qualifikation, nationale Berufsstrukturen von Europäischen Patentanwälten in den Mitgliedsländern zu untersuchen und Gruppen herauszufinden, die mit den Prüfungen Schwierigkeiten haben.

Der Präsident hielt seinen Bericht, einschließlich der Aufforderung, die Namen von Rednern, die für *epi* Präsentationen zur Verfügung stehen, dem Vorstand bekanntzugeben. Der Präsident erwähnte auch die Möglichkeit von künftigen Kontakten mit anderen Einrichtungen und im Rat entstand eine Diskussion, welche Zusammenarbeit z. B. mit akademischen Einrichtungen möglich seien. Der Präsident erwähnte, dass das EPA eine neue Wanderausstellung plant, die sich an Parlamentarier in jedem der Vertragsstaaten richtet. Schließlich gab der Präsident dem Rat eine aktuelle Berichterstattung über die innerhalb des Europäischen Patentamtes aufgetretenen Schwierigkeiten in den Beziehungen zwischen Belegschaft und Management. Es wurde beschlossen, dass das *epi* die Ereignisse beobachten wird. Eine Zusammenfassung des Berichtes des Präsidenten erscheint an anderer Stelle in dieser Ausgabe.

Dann stellte der Generalsekretär seinen Bericht vor. Es wurde beschlossen, dass vom *epi* in elektronischer Form herausgegebene Dokumente in Zukunft in PDF-Format sein werden.

Dann kamen die Finanzen an die Reihe, wobei der Bericht des Schatzmeisters und der Jahresabschluss 2000 unter Berücksichtigung des Berichtes der internen Kassenprüfer besprochen und gebilligt wurden und der Entwurf für den Haushalt des kommenden Jahres gebilligt wurden. Dies alles erfolgte ohne große Diskussionen.

Die Aufmerksamkeit des Rates richtete sich dann auf die Standesrichtlinien und die Entscheidung des Europäischen Gerichtshofes. Nach einer Diskussion über den Nutzen eines Einspruchs gegen die Entscheidung wurde

beschlossen, dass kein Einspruch erhoben werden soll. Weitere längere Diskussionen darüber, wie die Standesrichtlinien im Licht der Entscheidung geändert werden sollten, wurden auf den nächsten Morgen verschoben, wenn der Geschäftsordnungsausschuss und der Ausschuss für Standesregeln dem Rat einen Vorschlag zur Begutachtung vorlegen würden.

Der Präsident eröffnete sodann eine Debatte über die Revision des Europäischen Patentübereinkommens, gab einen kurzen Überblick über die bis dato vorliegenden Hauptänderungen und lenkte die Aufmerksamkeit auf mögliche künftige Revisionen. Es scheint klar zu sein, dass es mindestens zwei weitere mögliche Änderungen des Europäischen Patentübereinkommens geben wird. Die zweite wird der „zweite Korb“ sein, der jene Punkte beinhaltet, die als zu komplex oder zu widersprüchlich angesehen werden, um in der vorhergehenden Änderungsrunde des Übereinkommens berücksichtigt zu werden. Davor kommt jedoch eine nochmalige Änderung des Übereinkommens in Betracht, um eine Einarbeitung der Gemeinschaftspatentrichtlinie zu ermöglichen. Man war sich einig, dass der „zweite Korb“ mindestens noch fünf bis 6 Jahre brauchen wird, möglicherweise länger, wenn im Hinblick auf die Gemeinschaftspatentrichtlinie zwischenzeitlich eine Revision notwendig sein sollte. Weiterhin ist voraussehbar, dass die Ausführungsbestimmungen nicht vor Ablauf von eineinhalb Jahren in Kraft treten würden, und der EPPC wurde damit beauftragt, den Durchführungsbestimmungen so früh wie möglich seine Aufmerksamkeit zu schenken.

Das „Anwalt-Klient-Privileg“ wurde zur gemeinsamen Angelegenheit von EPPC, Ausschuss für Standesregeln und Geschäftsordnungsausschuss erklärt, mit dem Ziel einer möglichen Änderung der Durchführungsbestimmungen, der Standesregeln und der Gründungsregeln.

Unter den Anregungen bzgl. des möglichen Inhalts des zweiten Korbs war ein Hinweis, dass die Schonfrist nicht angestrebt werden sollte. Das Problem des „file wrapper estoppel“, der zweiten medizinischen Indikation und Geschäftsmethoden wurden kurz diskutiert.

Dann richtete sich die Aufmerksamkeit des Rates auf eine Angelegenheit von praktischer Bedeutung und zwar auf den derzeitigen Prüfungsrückstand beim EPA. Dies führte zu einer eingehenden Diskussion darüber, wie das EPA den Rückstand aufzuholen gedenkt. Der Rat billigte, das EPA dazu anzuhalten, die PCT-Belastung abzubauen, da die Internationale Prüfung als eine Hauptursache für die Verzögerung bei der Prüfung von Europäischen Patenten angesehen wurde. Die aufgeschobene Prüfung und die Möglichkeit des Delegierens der Prüfung an andere Ämter wurden ebenfalls diskutiert.

Der Tag endete mit den Berichten des Disziplinar Ausschusses und des Ausschusses für Berufliche Qualifi-

kation, deren wichtigste Teile an anderer Stelle in dieser Ausgabe abgedruckt sind.

Dann erklärte der Präsident die Sitzung für den Tag als beendet.

Die Sitzung wurde am 8. Mai 2001 um 9 h wiedereröffnet. Bevor die Berichte der verschiedenen Ausschüsse fortgesetzt wurden, kam der Präsident auf die Diskussionen vom Vortag bzgl. einer möglichen Änderung der Standesrichtlinien zurück.. Die Ausschüsse für Standesregeln und für die Geschäftsordnung legten einen Vorschlag zur Änderung von Art. 2 vor, der nach einiger Diskussion angenommen wurde.

Die Ratssitzung wandte sich den Ausschussberichten zu. Der Rat billigte einen Vorschlag der Schriftleitung, dass einzelne Ausschussmitglieder als Verbindungsglieder zur Schriftleitung vorgeschlagen werden sollten. Der EPPC-Bericht, wie immer sehr lang und ausführlich, umfasste eine Anzahl wichtiger Punkte. Größere Diskussionen drehten sich u. a. um Beschlagnahmeprozesse und vorgeschlagene PCT-Änderungen.

Der Rat bestätigte, dass der EASY-Ausschuss seine Arbeit fortsetzen soll, insbesondere im Hinblick auf die vom Europäischen Patentamt gemachten Vorschläge für die Online-Anmeldung.

Schließlich legte der Ausschuss für EPA-Finzen einen Bericht über die Möglichkeiten zur Verwendung der EPA-Einkünfte zum Abbau des Prüfungsrückstandes beim Europäischen Patentamt vor.

Die Berichte des Harmonisierungsausschusses, des Finanzausschusses, des Biotechnologie-Ausschusses und des Geschäftsordnungsausschusses wurden vorgelegt. Die meisten dieser Berichte sind an anderer Stelle in dieser Ausgabe veröffentlicht.

Vize-Präsident Francesco Macchetta berichtete als Beobachter der Arbeitsgruppe für Streitregelung. Es folgte eine Diskussion über die Vorschläge zur Vertre-

tung bei jedem Europäischen Streitgerichtshof und über Strategien, die der *epi*-Rat verfolgen könnte, um in dieser Hinsicht für die Europäischen Patentanwälte größtmögliche Rechte zu erreichen.

Dann berichtete der Präsident über den vorgeschlagenen Beitritt neuer Länder zum Europäischen Patentübereinkommen im Jahr 2002. Litauen und Lettland haben ebenfalls ihre Absicht verkündet, zu dieser Zeit dem Europäischen Patentübereinkommen beizutreten, womit insgesamt 10 Länder beabsichtigen, innerhalb eines Jahres das Übereinkommen zu unterzeichnen. Das EPA hat sich mit allen diesen Ländern in Verbindung gesetzt und hält Seminare ab, um ihnen die Möglichkeit einer Vorbereitung auf den Beitritt zu geben. Der Präsident bestätigte, dass auch das *epi* an den Seminaren teilnimmt. Die nationalen Patentämter werden ebenfalls über die Großvaterklausel und ihre Handhabung unterrichtet. Es wurde hervorgehoben, dass, indem alle zehn Länder ihre Absicht zum Beitritt zum EPÜ im Jahr 2002 bekundet haben, die nationale Gesetzgebung in jedem dieser Länder geändert werden müsse, um beizutreten. Es bestehe daher die Möglichkeit, dass nicht alle Länder zur beabsichtigten Zeit in der Lage sein würden, der Europäischen Patentorganisation beizutreten.

Die Sitzung schloss mit Formsachen wie die Wahl eines neuen Vorstandsmitglieds für Finnland, die Wahl eines Vorstandsmitglieds für die Türkei und die Wahl eines Wahlausschusses für die Wahlen zum Rat 2002. Die Termine für die nächsten Vorstands- und Ratssitzungen wurden festgelegt. Eine kurze Diskussion über eine mögliche Aktualisierung der *epi*-Broschüre und Mittel für ihre Veröffentlichung folgte. Dann beendete der Präsident die Sitzung um 13 h und dankte den spanischen Gastgebern für ihre großzügige und liebenswürdige Gastfreundschaft.

Entwurf der Ratsbeschlüsse, 50. Ratssitzung in Madrid 7./8. Mai 2001

1. Der Rat hat beschlossen, dass der EASY-Ausschuss dem Generalsekretär bei der Lösung technischer Probleme beim Versand von e-mails behilflich sein soll.
2. Der Jahresabschluss 2000 wurde gebilligt und dem Schatzmeister Entlastung erteilt.
3. Der Rat erteilte dem Vorstand und den Angestellten Entlastung.
4. Der Rat billigte den überarbeiteten *epi*-Haushalt 2001.
5. Der Rat hat beschlossen, gegen die Entscheidung des Gerichtshofes, Erster Instanz, im Standesrichtlinien-Prozess keinen Einspruch einzulegen (45 Stimmen dagegen, 7 dafür, 7 Enthaltungen).
6. Der Rat hat beschlossen, dass das *epi* das Gerichtsverfahren weiterführen soll, wenn die Europäische Kommission Einspruch einlegt (63 Stimmen dafür, 1 dagegen, 8 Enthaltungen).
7. Der Rat hat beschlossen, die Paragraphen von Art. 2 der Standesregeln neu zu nummerieren (55 Stimmen dafür, 14 dagegen, 4 Enthaltungen).
8. Der Rat hat beschlossen, dass der Vorsitzende des EPPC zusammen mit den Vorsitzenden des Ausschusses für Standesregeln und des Geschäftsführungsausschusses sich mit der Frage des „Anwalt-Klient-Privilegs“ befassen und einen Vorschlag für die nächste Ratssitzung erarbeiten soll.
9. Der Rat billigte mit großer Mehrheit, dass der Präsident des *epi* an das EPA schreiben soll, um

- die Besorgnis des *epi* über die Prüfungssituation auszudrücken und darauf zu dringen, dass das EPA sich bemüht, die Überlastung abzubauen, die durch die Anzahl der PCT-Anmeldungen entstanden ist.
10. Der Rat billigte die Teilnahme von CEIPI-Studenten am *epi*-Weiterbildungsseminar in Copenhagen am 28. Mai 2001 im Rahmen des CPE.
 11. Der Rat billigte, dass jeder *epi*-Ausschuss ein Mitglied für die Zusammenarbeit mit der Schriftleitung ernennt.
 12. Der Rat billigte einen Brief an das EPA, um die Beseitigung des Verbotes der Doppelpatentierung und die Löschung der diesbezüglichen Paragraphen aus den Richtlinien zu beantragen.
 13. Der Rat billigte, dass ein Positionspapier des *epi* über die „Harmonisierung der Beweiserhebung in gerichtlichen Verletzungsverfahren von europäischen Patenten und Gemeinschaftspatenten“ an die Arbeitsgruppe „Streitregelung“ geschickt wird.
 14. Der Rat billigte mit großer Mehrheit, dass das Positionspapier des *epi* zum Vorschlag des Rates für eine Verordnung zum Gemeinschaftspatent an die Europäische Kommission geschickt wird.
 15. Der Rat billigte, dass eine Resolution des *epi* bezüglich der Harmonisierung des elektronischen Anmeldens an WIPO geschickt wird.
 16. Der Rat hat beschlossen, dass der derzeitige EASY-Ausschuss seine Arbeit fortsetzen und in „Ausschuss für Online-Kommunikation (OCC)“ umbenannt werden soll.
 17. Herr J. BOTELLA REYNA (ES) und Herr J.P. DESOLNEUX (FR), stellvertretende Mitglieder des Harmonisierungsausschusses, wurden zu ordentlichen Mitgliedern dieses Ausschusses ernannt.
 18. Der Rat billigte, dass der Finanzausschuss des *epi* nach Wegen suchen soll, um die Belastung durch die Mehrarbeit aufgrund der Neueintragungen aus neuen Ländern in die Liste zu verringern sowie die Richtlinien für die Wiederaufnahme in die Liste aufgrund der Mitgliedschaft in früheren Jahren zu überarbeiten. Es wurde außerdem beschlossen, dass der Vorstand der Frage der Wiedereintrittsrechte gemäß der Revision des EPÜ nachgehen soll.
 19. Der Rat billigte, dass Rückerstattungsbeträge mit der Umstellung auf Euro mit Wirkung ab 1. Januar 2002 wie folgt erhöht werden: gelegentliche Ausgaben auf 35 Euro, Essen pro Arbeitstag auf 35 Euro und Hotelkosten auf 125 Euro pro Nacht.
 20. Der Rat hat beschlossen, dass dem EPA ein Brief mit den Vorschlägen des *epi* zur Reduzierung der PCT-Arbeitsbelastung und zur Erhöhung der Effizienz geschickt werden soll.
 21. Der Rat billigte einstimmig, dem Verwaltungsrat die Streichung von Art. 7 (5) der Gründungsregeln des *epi* vorzuschlagen.
 22. Der Rat billigte einstimmig, dass die Regeln für die Wahl des Rates von „1. Oktober“ auf „15. September“ geändert werden sollen, und alle weiteren Termine entsprechend zu ändern.
 23. Der Rat billigte einstimmig die Streichung von Art. 15 der Regeln für die Wahlen zum Rat (Zusatzwahl) sowie die Streichung des letzten Satzes von Art. 2.4 der Geschäftsordnung „Wenn nach der Beschlussfassung ... neu gewählter Vorstand“.
 24. Der Rat wählte Herrn Pekka VALKONEN zum neuen Vorstandsmitglied für Finnland und Frau Selda ARKAN zum Vorstandsmitglied für die Türkei. Der Rat wählte Herrn H. BREITER (CH), Herrn A. PARKES (IE) und Herrn J.J. VAN KAN (NL) zu Mitgliedern des Wahlausschusses für die Wahl zum Rat 2002.
 25. Der Rat billigte die Vorschläge, die Ratssitzung im Herbst 2002 zusammen mit der Feier zum 25. Jubiläum des *epi* in Großbritannien, die Ratssitzung im Frühjahr 2003 in Belgien und die Ratssitzung im Herbst 2003 in Frankreich abzuhalten.

Report of the 50th Council Meeting in Madrid 7-8 May 2001

The fiftieth *epi* Council Meeting in Madrid was an interesting and lively one. Several topics of importance were discussed at length by the Council.

The President, Walter Holzer, opened the meeting at 9.00 a.m. on 7 May 2001. Before commencing the official business, he informed the Council of the recent death of André Braun Sr. from Switzerland, 1st President of the Finance Committee. The Council stood for a minute silence in Mr. Braun's memory.

The President then welcomed the official Turkish delegation to their first *epi* Council Meeting.

The scrutineers were appointed, the agenda was adopted and the minutes and list of decisions and

actions made at the forty-ninth Council Meeting were approved. The President then reviewed the decisions to measures which have been taken by the Board since the previous Council Meeting. These included a brief discussion of Committee sizes and structure as well as an invitation for the Professional Qualifications Committee to investigate the national training structures of European patent attorneys in the member countries and to identify groups having difficulty with recruiting and exams.

The President provided his report, including requesting that names of speakers, willing to make presentations on behalf of *epi*, be put to the Board. The President also

mentioned the possibility of future liaisons with other bodies and there was some discussion in Council as to what liaisons might be possible, for example with academic institutions. The President mentioned the EPO plans for a new travelling exhibition directed towards Parliamentarians in each of the contracting states. Finally, the President gave Council an update as to the difficulties experienced within the European Patent Office in respect of staff-management relations. It was agreed that *epi* would observe events. A summary of the President's report appears elsewhere in this issue.

The Secretary General then presented his report. It was decided that future documents issued by *epi* in electronic form would be in PDF format.

Matters then turned to finance, including considering and approving the Treasurer's Report and 2000 accounts, considering the internal auditors' report and approving the draft budget for the following year. This all took place without any great discussion.

The attention of the Council turned to the Code of Conduct and the decision by the European Court of Justice. After discussing the merits of filing an appeal against the Decision, it was decided that no appeal would be filed. Further lengthy discussions as to how the Code of Conduct should be amended in the light of the Decision were left until the next morning, at which point the By-Laws Committee and Professional Conduct Committee would provide a proposal for Council to consider.

The President then introduced a debate on the revision of the European Patent Convention, including a brief overview of the major amendments to date, as well as leading the consideration of potential future revisions. It seems clear that there will be at least two further potential amendments of the European Patent Convention. The second of these will be the „second basket“ which contains those topics deemed too complex or controversial for consideration in the previous round of amendments to the Convention. Before that, however, it was envisaged that the convention would have to be amended again in order to enable implementation of the Community Patent Regulation. It was felt that the „second basket“ was at least five to six years away, may be longer if an interim revision were required in the light of the Community Patent Regulation. It was further likely that the Implementing Regulations would take at least a year and a half to put into force and the EPPC were charged with giving the Implementing Regulations their earliest consideration.

The matter of attorney/client privilege was passed to a combination of the EPPC, the Professional Conduct Committee and the By-Laws Committee, with a view to potential amendment of the Implementing Regulations, the Code of Conduct and the Founding Regulation.

Among the suggestions relating to the potential content of the second basket, were an indication that grace period should not be sought. The issues of file wrapper estoppel, second medical use and business methods were briefly discussed.

Council's attention then turned to a matter of practical significance, that of the current examination backlog at the European Patent Office. This led to intense conversation as to ways the European Patent Office might wish to reduce the backlog. The Council agreed to urge the European Patent Office to remove the PCT burden because International Examination was seen to be a major cause of delays in the examination of European Patents. Deferred examination and the possibility of subcontracting examination to other Offices was also discussed.

The day finished with reports of the Disciplinary Committee and the Professional Qualifications Committee the relevant portions of which are reprinted elsewhere in this issue.

The President then closed the meeting for the day.

The meeting resumed at 9.00 a.m. on 8 May 2001. Before continuing with the reports of the various Committees, the President returned to the previous day's discussions relating to potential amendment of the Code of Conduct. The Professional Conduct Committee and By-Laws Committee produced a proposal for an amended Article 2 which, after some debate, was approved.

The Council Meeting returned to the Committee Reports. The Council approved a proposal by the Editorial Board that individual members of Committees should be proposed as liaison members with the Editorial Board. The EPPC Report, as lengthy and detailed as ever, covered a number of important issues. Major discussions centered around, among others, seizure procedures and proposed PCT changes.

Council confirmed that the EASY Committee should continue its work, particularly with regard to the proposals for on-line filing being made by the European Patent Office.

Finally, the EPO Finances Committee provided a report regarding potential ways of using EPO Finances to reduce the examination backlog at the European Patent Office.

Reports were also received from the Harmonisation Committee, the Finance Committee, the Biotechnology Committee and the By-Laws Committee. The majority of these reports are published elsewhere in this issue.

The Vice President, Francesco Macchetta, reported as an observer on the Working Party on Litigation. Discussion followed as to the proposals for representation before any European Litigation Court and strategies that could be taken by *epi* Council in order to maximise the rights of European Patent Attorneys in such a respect.

The President then reported on the proposed accession of new countries to the European Patent Convention in 2002. Lithuania and Latvia have also expressed an intention to accede to the European Patent Convention at that time, giving a total of ten countries intending to sign to the Convention in a year's time. The European Patent Office are contacting all the countries and giving seminars to enable them to prepare for accession. The President confirmed that *epi* is participating in the seminars. National Patent Offices will also be instructed on

the grandfather clause and its operation. The point was made that, whilst all ten countries had expressed their intention to accede to the EPC in 2002, national legislation in each country would have to be changed for that country to accede. There was, therefore, the possibility that not all the countries would be in a position to join the European Patent Organisation at the stated intended time.

The meeting concluded with formal matters including the election of a new Board Member for Finland, the election of a Board Member for Turkey and the election of the Electoral Committee for the 2002 Elections Council. The dates of the next Board and Council Meetings were agreed. A brief discussion of the potential updating of the *epi* brochure and means for its publication were discussed. The President then closed the meeting at 1.00 p.m., offering thanks to the Spanish hosts, whose hospitality had been so generous and gracious.

Draft List of Decisions, 50th Council Meeting, Madrid 7-8 May 2001

1. Council approved the EASY Committee assisting the Secretary General in solving the technical problems for e-mail distribution.
2. The year 2000 accounts were approved and the Treasurer was discharged from liability.
3. Council discharged the Board and the officers from liability.
4. Council approved the revised *epi* budget for 2001.
5. Council decided not to appeal the decision of the Court of Justice of First Instance in the Code of Conduct procedure (vote: 45 against appeal, 7 in favour, and 7 abstentions).
6. Council decided that *epi* should continue the Court proceedings if the European Commission appeals (vote: 63 in favour, 1 against and 8 abstentions).
7. Council decided to amend Art. 2 of the Code of Conduct by renumbering the paragraphs (vote: 55 votes in favour, 14 against and 4 abstentions).
8. Council decided that the Chairman of EPPC, together with the Chairmen of the Code of Conduct Committee and of the By-Laws Committee should look into the attorney-client privilege question and come up with a proposal for the next Council meeting.
9. Council approved, by a large majority, of the *epi* President writing to the EPO to express *epi*'s concern about the examination situation and to urge the EPO to make efforts to reduce the burden created by the number of PCT applications.
10. Council approved the participation of CEIPI students in the forthcoming *epi* Seminar organised in Copenhagen on 28 May 2001 in the frame of the CPE.
11. Council approved the appointment of a specific member in each *epi* Committee, to liaise with the Editorial Board.
12. Council approved sending a letter to the EPO to ask for removal of the prohibition of double patenting and deletion of the relevant paragraphs of the Guidelines.
13. Council approved sending an *epi* position paper on „Harmonisation of evidence taken in Court actions for European and community patent infringement“ to the Working Party on Litigation.
14. Council approved sending the *epi* position paper on the Proposal for a Council Regulation on the Community Patent to the European Commission, by a large majority.
15. Council approved sending an *epi* Resolution on Harmonisation in Electronic Filing to WIPO.
16. Council decided that the present EASY Committee should continue its work and be renamed „Online Communications Committee (OCC)“.
17. Mr. J. BOTELLA REYNA (ES) and Mr. J.P.DESOLNEUX (FR), substitute members of the Harmonisation Committee, were upgraded to full members of that Committee.
18. Council approved the *epi* Finance Committee looking into ways to lessen the burden of dealing with entrants on the List from new countries and to review the policy for re-entrants on the List concerning subscriptions due for previous years. It was further decided that the Board should pursue the question of re-entry rights under the EPC revision.
19. Council approved an increase in reimbursement rates with the conversion to Euro, effective January 1, 2002 as follows: Incidental expenses be increased to Euro 35, meals per working day to Euro 35, and hotel costs/night to Euro 125.
20. Council decided that a letter should be sent to the EPO, putting forward *epi*'s proposals to reduce the PCT workload and to increase efficiency.
21. Council unanimously approved a proposal to the Administrative Council to delete Article 7(5) of the Regulation on the establishment of the *epi*.
22. Council unanimously approved that the Rules for Election of Council should be changed from October 1st to 15th September, and to amend all other dates accordingly.

23. Council unanimously approved deletion of Art. 15 of the Rules for Election of Council (supplemental election), as well as deletion of the last sentence of Art. 2.4 of the By-Laws „If after the vote ... newly elected Board“.
24. Council elected Mr. Pekka VALKONEN new Board member for Finland, and Mrs. Selda ARKAN Board member for Turkey.

Council elected Mr. H. BREITER (CH), Mr. A. PARKES (IE) and Mr. J.J. VAN KAN (NL) members of the Electoral Committee for the 2002 election to Council.

25. Council approved the proposals to hold the 2002 autumn Council meeting in Great Britain, together with the celebration of the 25th *epi* anniversary, the 2003 spring Council meeting in Belgium, and the 2003 autumn Council meeting in France.

Compte rendu de la 50ème réunion du Conseil à Madrid 7-8 mai 2001

La 50ème réunion du Conseil à Madrid a été intéressante et intensive. De nombreuses questions importantes ont pu être longuement discutées par le Conseil.

Le Président Walter Holzer ouvre la séance le 7 mai 2001 à 9 heures. Il informe le Conseil du décès de notre confrère suisse André Braun Sr., 1er président de la Commission des Finances. Le Conseil observe une minute de silence en sa mémoire.

Le Président souhaite ensuite la bienvenue à la délégation turque, laquelle vit sa première participation officielle à une réunion du Conseil de l'*epi*.

On adopte l'ordre du jour et l'on nomme les scrutateurs. Le compte rendu de la 49ème réunion du Conseil est ensuite approuvé, de même que la liste des décisions et actions de cette 49ème session. Le Président présente ensuite un exposé des décisions et mesures prises par le Bureau depuis la dernière réunion du Conseil. La structure des commissions ainsi que le nombre de membres au sein de chacune d'elles sont brièvement discutés. La Commission de Qualification Professionnelle est invitée à examiner les structures de formation au plan national dans les pays membres afin d'identifier les groupes présentant des difficultés particulières en matière de formation professionnelle.

Le Président présente ensuite son rapport. Il propose de remettre aux membres du Bureau les noms de personnes disposées à faire des exposés et conférences, au nom de l'*epi*. Le Président mentionne ensuite la possibilité d'établir des contacts avec d'autres organisations, par exemple les institutions universitaires. Le Président évoque le projet de l'OEB consistant à organiser une deuxième exposition itinérante dont l'organisation pourrait être remise aux parlementaires des différents pays membres. A la fin de son exposé, le Président évoque l'évolution de la situation à l'OEB en ce qui concerne les relations entre la direction et le personnel. Le Conseil donne son approbation au principe que l'*epi* demeure simple observateur des faits. Un résumé du rapport du Président est publié dans cette édition.

Le Secrétaire Général présente ensuite son rapport. Il est décidé que les documents produits par l'*epi* seraient désormais envoyés en format PDF.

Le rapport du Trésorier ainsi que les comptes pour l'exercice 2000 sont approuvés. Faisant suite à la présentation du rapport des commissaires aux comptes, le projet de budget 2001 est également approuvé.

La question du Code de conduite et de la décision rendue par le Tribunal de 1ère Instance des Communautés Européennes est ensuite évoquée. La possibilité d'interjeter appel fait l'objet d'une vive discussion, suite à laquelle le Conseil décide de ne pas faire appel. Des amendements au Code de conduite sont ensuite longuement discutés. La Commission du Règlement Intérieur et la Commission de Conduite Professionnelle sont alors chargées de soumettre une proposition au Conseil pour le lendemain matin.

Le Président aborde ensuite la question de la révision de la Convention sur le brevet européen. Il donne un bref aperçu des principaux amendements qui ont été adoptés et présente les points qui sont à l'étude pour d'autres révisions éventuelles. Il semble clair qu'il y aura au moins deux autres révisions éventuelles de la Convention sur le brevet européen, la seconde constituant la „deuxième corbeille“ dans laquelle sont rassemblés les sujets jugés trop complexes ou trop controversés pour être mis à l'étude lors de la première session. Dans l'attente, la CBE devrait faire l'objet d'un nouvel amendement dans le but de permettre la mise en place du Brevet communautaire. Le processus de révision „deuxième corbeille“ pourrait durer jusqu'à cinq ou six ans, peut-être même plus longtemps si une révision intérimaire s'avérait nécessaire dans le cadre de la réglementation du Brevet communautaire. Les dispositions d'exécution ne seront vraisemblablement pas mises en vigueur avant un an et demi. L'EPPC est chargé de les examiner le plus tôt possible.

Le Conseil décide que les Commissions „Pratique du brevet européen“, „Règlement Intérieur“ et „Conduite Professionnelle“ examinent la question du principe de confidentialité et de privilège en vue d'un éventuel amendement des dispositions d'exécution ainsi que du Code de conduite et du règlement relatif à la création de l'*epi*.

Parmi les suggestions relatives à la „deuxième corbeille“, il est suggéré de ne pas proposer la période de

grâce. Les questions du „wrapper estopel“, de la seconde indication médicale et des méthodes de business sont évoquées brièvement.

L'attention du Conseil se porte ensuite sur une question présentant une grande importance sur le plan pratique, à savoir le retard dans les examens à l'Office européen des brevets. Une discussion animée s'engage sur les moyens que l'OEB pourraient employer pour réduire ce retard. Le Conseil approuve que l'*epi* demande à l'OEB d'éliminer la charge de travail liée aux demandes PCT puisque l'examen international semble être la cause principale des retards constatés dans l'examen des brevets européens. L'examen différé et la possibilité de s'adresser à d'autres offices pour la sous-traitance sont aussi discutés.

La première journée de réunion se termine avec la présentation du rapport de la Commission de discipline et celui de la Commission de Qualification Professionnelle. Ce dernier est publié dans ce numéro de *epi* Information.

Le Président ferme la session du jour.

La réunion reprend le 8 mai 2001 à 9 heures. Le Président revient tout d'abord sur les discussions de la veille concernant une éventuelle modification du Code de conduite. La Commission du Code de Conduite Professionnelle et la Commission du Règlement Intérieur soumettent une proposition d'amendement de l'article 2, qui, après quelques discussions, est approuvée.

La parole est ensuite donnée aux Présidents de commissions pour la présentation de leur rapport. Le Conseil approuve la proposition faite par le Comité de Rédaction de désigner une personne au sein de chaque commission pour assurer la coordination avec le Comité de Rédaction. Le rapport de la Commission „Pratique du brevet européen“ (EPPC) toujours très complet et détaillé couvre de nombreuses questions importantes. Le Conseil discute entre autres les procédures de saisie-contrefaçon et les changements proposés pour le PCT.

Le Conseil approuve que la Commission „Système de demandes électroniques“ (EASY) poursuive son travail, principalement en ce qui concerne les propositions de dépôt en ligne faites par l'Office européen des brevets.

La Commission des Finances de l'OEB présente son rapport qui propose différentes possibilités d'utiliser les

finances de l'OEB pour réduire le retard dans les examens à l'OEB.

Les rapports de la Commission d'Harmonisation, de la Commission des Finances, de la Commission de Biotechnologie et de la Commission du Règlement Intérieur se succèdent. La plupart de ces rapports sont publiés dans cette édition.

Le Vice-Président, Francesco Macchetta, présente son rapport sur la dernière session du Groupe de travail „Contentieux“ à laquelle il assistait en tant qu'observateur. Une discussion s'ensuit sur les propositions de représentation devant un Tribunal pour litiges européen et sur les stratégies que l'*epi* pourrait développer en vue d'étendre au maximum les droits des conseils en brevets européens.

Le Président donne des informations sur les nouveaux pays candidats à l'adhésion à la Convention sur le brevet européen en 2002. La Lituanie et la Lettonie ont également fait part de leur intention d'adhérer à la Convention sur le brevet européen à cette date. Cela signifie que dix pays au total signeraient la Convention dans un an. L'Office européen des brevets multiplie les contacts avec ces pays et y organise des séminaires pour les préparer à leur accession. Le Président confirme que l'*epi* participe à ces séminaires. Les offices des brevets nationaux seront également informés de l'existence de la disposition dite „grand-father“ et de son régime. L'attention du Conseil est portée sur le fait que dix pays ont annoncé leur intention d'adhérer à la CBE en 2002, mais que leurs législations nationales respectives devront être changées pour permettre à ces pays d'adhérer. Il est probable que tous les pays ne seront pas en mesure d'accéder à l'Organisation européenne des brevets à la date envisagée.

La réunion se termine avec l'élection d'un nouveau membre du Bureau pour la Finlande, d'un membre du Bureau pour la Turquie, et de la Commission Electorale pour les élections du Conseil en 2002. Les dates des prochaines réunions du Bureau et du Conseil sont acceptées. La mise à jour de la brochure *epi* et les moyens de publication de celle-ci sont brièvement discutés. A 13 heures, le Président déclare la séance close et exprime ses remerciements aux organisateurs espagnols pour leur chaleureuse et généreuse hospitalité.

Projet de liste des Décisions, 50ème réunion du Conseil, Madrid 7-8 mai 2001

1. Le Conseil approuve que la Commission „Système de demandes électroniques“ (EASY) apporte son soutien au Secrétaire Général pour résoudre les problèmes techniques liés à l'envoi des courriers électroniques.
2. Les comptes pour l'exercice 2000 sont approuvés et quitus est donné au Trésorier.
3. Le Conseil donne le quitus au Bureau et aux „Officers“.
4. Le Conseil approuve le budget de l'*epi* révisé pour l'année 2001.
5. Le Conseil décide de ne pas interjeter appel de la décision du Tribunal de Première Instance rendue dans la procédure du Code de Conduite (45 votes contre l'appel, 7 pour et 7 abstentions).

6. Le Conseil décide de ne pas poursuivre la procédure du Code de Conduite si la Commission européenne ne fait pas appel (63 votes pour, 1 contre et 8 abstentions).
7. Le Conseil décide de renuméroter les paragraphes de l'article 2 du Code de Conduite (55 votes pour, 14 contre et 4 abstentions).
8. Le Conseil décide que le Président de l'EPPC et les Présidents de la Commission du Règlement Intérieur et de la Commission de Conduite Professionnelle examinent la question du privilège et de la confidentialité des échanges entre le client et son mandataire et soumettent une proposition à la prochaine réunion du Conseil.
9. Le Conseil approuve à une forte majorité que le Président de l'*epi* adresse un courrier à l'OEB pour faire part de la préoccupation générale des membres de l'*epi* en ce qui concerne la situation de l'examen et pour demander que des mesures soient prises par l'OEB pour réduire le retard dû à l'accumulation des demandes PCT.
10. Le Conseil approuve le principe d'une participation des étudiants du CEIPI au séminaire organisé le 28 mai 2001 à Copenhague, dans le cadre de la formation professionnelle continue.
11. Le Conseil approuve qu'une personne soit désignée au sein de chaque commission de l'*epi* pour assurer la coordination avec le Comité de Rédaction.
12. Le Conseil approuve l'envoi d'un courrier à l'OEB pour demander que soit levé le principe d'exclusion du double brevet et que soient supprimées les dispositions correspondantes dans les Directives à l'intention des examinateurs de l'OEB.
13. Le Conseil approuve l'envoi d'une prise de position de l'*epi* sur la question de l'harmonisation des moyens de preuve produits dans les affaires de contrefaçon de brevets européens ou communautaires au Groupe de Travail „Contentieux“.
14. Le Conseil approuve à une forte majorité l'envoi à la Commission européenne d'une prise de position de l'**epi** sur la Proposition pour une Réglementation du Brevet Communautaire.
15. Le Conseil approuve l'envoi d'une résolution de l'**epi** sur la question de l'Harmonisation des dépôts de demande par voie électronique.
16. Le Conseil décide que l'actuelle Commission „Système de demandes électroniques“ (EASY) poursuive ses activités sous la nouvelle dénomination de „Commission des Communications en ligne“ (OCC).
17. M. J. BOTELLA REYNA (ES) et M. J.P. DESOLNEUX (FR), membres suppléants de la Commission d'Harmonisation sont nommés membres titulaires de cette Commission.
18. Le Conseil approuve que la Commission des Finances examine de quelle manière on pourrait réduire la charge de travail occasionnée par les demandes d'inscription sur la Liste des mandataires émanant de nouveaux pays, et examine également la politique à suivre en ce qui concerne la réinscription sur la Liste des mandataires de membres qui n'ont pas acquitté leur cotisation au cours des années antérieures. De plus, il est décidé que le Bureau s'attache à la question des droits de réinscription dans le cadre de la révision de la CBE.
19. Le Conseil approuve qu'avec le passage à l'Euro les tarifs de remboursement de frais soient augmentés, à partir du 1er janvier 2002, comme suit: frais divers :35 Euro, repas par journée de travail: 35 Euro, frais d'hôtel par nuit: 125 Euro.
20. Le Conseil décide qu'un courrier soit adressé à l'OEB, faisant part des propositions de l'*epi* en vue de réduire la charge de travail provoquée par l'accumulation des demandes PCT, et d'augmenter l'efficacité.
21. Le Conseil approuve à l'unanimité le principe de proposer au Conseil d'Administration la suppression de l'Article 7(5) du Règlement relatif à la création de l'*epi*.
22. Le Conseil approuve à l'unanimité de changer, dans les règles pour les élections au Conseil, la date du 1er octobre à celle du 15 septembre, et de modifier les autres dates en conséquence.
23. Le Conseil approuve à l'unanimité la suppression de l'article 15 (élection complémentaire) des règles pour les élections au Conseil, de même que la suppression de la dernière phrase de l'article 2.4 du Règlement Intérieur „Si après adoption ... Bureau nouvellement élu“.
24. M. Pekka VALKONEN est élu membre du Bureau pour la Finlande et Mme Selda ARKAN est élue membre du Bureau pour la Turquie. M. H. BREITER (CH), M. A. PARKES (IE) et M. J.J. VAN KAN (NL) sont élus membres de la Commission Electorale pour les élections du Conseil en 2002.
25. Le Conseil approuve la proposition de la Grande Bretagne d'organiser la réunion du Conseil en automne 2002, qui sera accompagnée de la célébration du 25ème anniversaire de l'*epi*. Les réunions suivantes se tiendront en Belgique au printemps 2003, et en France à l'automne 2003.

President's Report (Summary)

The President referred to the general continued efforts of the *epi* to intensify collaboration with educational institutions, like CEIPI, the EPO European Academy and RIP, as well as participation in various types of seminars and symposia.

The President reported on activities between October 2000 and April 2001, commencing with the opening the EPO-*epi*-PAK Symposium concerning „Oral Proceedings“ in the EPO on October 26, 2000. The Symposium turned out to be very successful, both in terms of the number and the response of participants. Delegates from the new countries were also present. The contents of the Symposium was published in *epi*-Information No. 4/2000. The Symposium was followed by a conference with the accession countries' delegates in the *epi* Secretariat.

At the CIPA Annual Congress in November 2000 the President was invited to speak about „The Profession's Representation“ in the context of a workshop entitled „European IP Institute“. He in particular dealt with new *epi* activities, such as concerning the attorney/client privilege, the Code of Conduct and the representation before courts. Also in November he attended the oral hearing before the Court of First Instance in the appeal procedure against the Commission Decision on the Code of Conduct. The President then reported on the EPC Revision Conference in Munich, in which Vice Presidents Le Vaguerèse and Macchetta as well as himself participated as observers on behalf of *epi*. A report was published in the *epi* Information No. 1/2001. Upon an invitation from the International Academy of the EPO he also tutored a class of students from non-European countries on the structure and the working of the *epi* and the role of European patent attorneys in EPO proceedings.

Secretary General Zellentin and the President participated as observers in the Administrative Council Meeting in December 2000. Topics of interest were inter alia the legal framework for electronic filing, a presentation of the Grace Period by Prof. Straus, and efficiency gains in EPO procedures through the Broad Consultation Process. The President further took part in the ordinary CEIPI Board Meeting, in which points of discussion were the new statutes of the CEIPI/EPs, the activities of the international section and the preparation of a CEIPI Seminar in 2001, in which the *epi* would participate.

In January 2001 he intervened on behalf of *epi* in a Seminar organised by the International Academy of the EPO, the Turkish Patent Office and the Turkish Professional Association (PEM). He spoke about „The role

of European Patent Attorneys and the Institute of Professional Representatives before the EPO (*epi*)„. The problems concerning the „grandfather clause“ and the particular situation of the profession in Turkey were discussed. Also in January he followed an invitation from the Bulgarian industry's Alliance for Industrial Property in pharmacy, chemistry and biology to a conference organised by the Ministry of Justice with all professional organisations as well as other interested circles. The upcoming accession of Bulgaria to the EPC/*epi* and in particular the role the Patent Office has to play according to the EPC were predominant topics.

A meeting of the Presidency of the EPO with the *epi* officers and the Chairman of the PQC, Onn, took place in February 2001. Topics discussed inter alia were: the situation created by rising numbers of PCT applications and the consequences for the examination in the EPO, the functioning of BEST, the accession of the new countries to the EPC, the follow-up of the EPC Revision process, the collaboration of the PQC with the EPO, and miscellaneous topics such as the duration of the examination proceedings. At the AIPLA-ICC Conference in Paris on „Patent Systems for the new Millennium“, the President was given the task of rendering a „Critique“ on the Revision of the EPC, as presented by Vice President Schatz.

The Administrative Council Meeting in March was attended by Vice President Le Vaguerèse and Secretary General Zellentin. The Agenda inter alia comprised the follow-up to the Revision of the EPC. A separate meeting with the patent office representatives from the accession countries was held after the Council Meeting.

The meetings of the Working Party on Litigation and its expert group were attended alternately by Vice President Macchetta, the Chairman of the EPPC, Casalonga, and the President in the course of April 2001. These meetings centered on the structure and the rules of procedure of the envisaged European patent court system. Also in April the CEIPI Seminar chaired by the President of the EPO, Mr. Kober, was held in Strasbourg. The Seminar was organised by the CEIPI with the collaboration of the EPO and the *epi*. Theme of the very well attended Seminar was the „Revision of the European Patent Convention“. Vice President Le Vaguerèse, the Chairman of the EPPC, Casalonga, and the President presented papers. Finally, at the 3rd CNIPA Forum in Paris the President chaired one of the conference sections „Update on the current status of the projects for European Patent Courts (EPLP-court/Community IP Court)“.

Treasurer's Report

P. Kelly (IE)

The auditors – both external and internal – have now completed the audit work and the accounts for the year 2000 have been finalised. The accounts show a surplus income over expenditure of DM 62328.

The Budget 2000 projected a deficit of DM 162500 while the actual outcome for 2000 proved significantly more positive, namely a surplus of DM 62328. This represents a variation of DM 224828 between budget and actual. The major items to be noted are, namely: –

1. Savings were achieved on meetings (DM 156307); EU Letter (DM 47420); Rent (DM 23373) and Secretariat costs (DM 41821).
2. Increased spending over budget arose in relation to unpaid subscriptions written off (DM 40430); President/Vice Presidents' expenses (DM 10932) and purchase of furniture for the Secretariat (DM 14436).

I should comment on the savings achieved by noting that the variation on rent was achieved by deducting from the rent in the accounts the VAT which was included in the budget amount for rent. The accumulated costs savings at the Secretariat are due to the management of the Secretary General and in part to the increased use of e-mail. On the expenditure side, the decision of Council in Rhodes to write off all unpaid subscriptions in the current year means that we are writing off two (2) years 1999/2000 in the year 2000 accounts.

The balance sheet of the 2000 Accounts shows that on 31/12/00 the investment portfolio at DM 2,338,507 and cash at bank at DM 563,925.

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epi Balance Statement on 31st December 2000

		Assets			previous year (thousand)
		DM	DM	DM	DM
A.	Fixed assets				
	I. Tangible assets		1,—		—
	Office machines and equipment				
	II. Financial assets		<u>2.338.506,23</u>	2.338.507,23	1.847
	Securities portfolio				
B.	Receivables				
	I. Membership subscription and others				
	1. Membership subscriptions				44
	2. Others	<u>106.955,74</u>	106.955,74		115
	II. Bank & Cash (incl. money deposits)		<u>563.925,39</u>	670.881,13	1.042
				<u>3.009.388,36</u>	<u>3.048</u>
		Liabilities			previous year (thousand)
		DM	DM	DM	DM
A.	Net assets				
	as of 01.01.2000			2.673.755,24	2.584
	results for the year			62.328,69	90
				<u>2.736.083,93</u>	<u>2.674</u>
	as of 31.12.2000				
B.	Debts				
	I. Provisions		39.200,—		55
	II. Liabilities				
	1. Deliveries and services	40.779,12			88
	2. Others	<u>193.325,31</u>			231
			<u>234.104,43</u>	273.304,43	319
				<u>3.009.388,36</u>	<u>3.048</u>

Expenses and Income for the period from 1 January to 31 December 2000

<i>epi</i> Expenses and Income 2000						
	Budget 1999	Actual 1999	Budget 2000	Actual 2000	Shortfall in receipts Surplus of expenditure 2000	Surplus of receipts Shortfall in expenditure 2000
	TDM	DM	DM			
I. Receipts/Income						
1. from Members						
a. Subscriptions	1.710.000, –	1.774.181,16	1.830.000, –	1.815.650, –	./.	14.350, –
b. Abandonment of unpaid subscriptions	./.	43.602, –	./.	33.989,50	./.	40.145,85
2. Interests	110.000, –	107.043,56	115.000, –	120.861,28	–, –	5.861,28
3. Others	41.000, –	83.497,84	42.000, –	65.938,02	–, –	23.938,02
	<u>1.817.398, –</u>	<u>1.930.733,06</u>	<u>1.943.500, –</u>	<u>1.918.803,45</u>	./.	54.495,85
II. Expenses						
1. Meetings						
Council	330.000, –	380.494,56	380.000, –	316.203,01	–, –	63.796,99
Board	70.000, –	63.438,12	70.000, –	68.604,37	–, –	1.395,63
Committees	270.400, –	203.574,25	270.000, –	243.431,08	–, –	26.568,92
Delegates & Others	158.000, –	123.792,54	150.000, –	85.454,09	–, –	64.545,91
2. Special performances						
<i>epi</i> Information	100.000, –	98.048,41	90.000, –	93.232,52	3.232,52	–, –
By-Laws & non-foreseeable	9.000, –	–, –	6.000, –	–, –	–, –	6.000, –
ECC-Letter	60.000, –	54.206,28	100.000, –	52.579,59	–, –	47.420,41
Promotional activities (incl. <i>epi</i> -Brochure)	50.000, –	43.221,80	40.000, –	34.393,98	–, –	5.606,02
3. President (+ Vice President)	25.000, –	34.459,51	50.000, –	60.931,83	10.931,83	–, –
4. Treasurer and Treasury						
Treasurer and Deputy	13.000, –	11.489, –	13.000, –	8.429, –	–, –	4.571, –
Bookkeeping / Audit	26.500, –	22.199,08	25.000, –	20.169,77	–, –	4.830,23
Bank charges	22.000, –	16.152, –	18.000, –	15.885,32	–, –	2.114,68
5. Secretariat						
Expenditure on personnel	440.000, –	415.352,89	502.000, –	494.658,71	–, –	7.341,29
Expenditure on materials						
Rent	132.000, –	128.210,60	182.000, –	158.626,55	–, –	23.373,45
Moving expenses	227.000, –	103.449,12	–, –	–, –	–, –	–, –
Phone, Fax, e-mail	12.000, –	12.375,30	14.000, –	11.051,63	–, –	2.948,37
Postage	55.000, –	50.336,01	50.000, –	45.335,19	–, –	4.664,81
Copy, print	30.000, –	25.625,07	30.000, –	31.179,98	1.179,98	–, –
Office supplies/Representation	12.000, –	17.162,59	23.000, –	23.097,99	97,99	–, –
Maintenance/Repair	10.000, –	14.775, –	6.000, –	3.821,01	–, –	2.178,99
Insurances	1.500, –	557,90	3.000, –	582,20	–, –	2.417,80
Secretary General and Deputy	5.000, –	1.165,49	5.000, –	1.361,70	–, –	3.638,30
Travel personnel	7.000, –	544,91	3.000, –	648,53	–, –	2.351,47
Training	3.000, –	383,96	5.000, –	232, –	–, –	4.768, –
Acquisitions						
Office machines incl. Soft-/Hardware	20.000, –	13.515,83	6.000, –	11.843,40	5.843,40	–, –
Office equipment	3.000, –	–, –	60.000, –	74.436,31	14.436,31	–, –
6. Extraordinary expenses	–, –	6.557,50	5.000, –	285, –	–, –	4.715, –
	<u>2.091.400, –</u>	<u>1.841.060,72</u>	<u>2.106.000, –</u>	<u>1.856.474,76</u>	<u>35.722,03</u>	<u>285.247,27</u>
III. Surplus of receipts/expenses	./.	<u>89.672,34</u>	./.	<u>62.328,69</u>	<u>Surplus:</u>	<u>224.828,69</u>

Report of the Committee on Biotechnological Inventions

B. Hammer Jensen (DK)

I. Introduction

Since the last Council meeting in Rhodes in October 2000, the Committee has held one meeting on 14 March 2001. Communications have also been exchanged by the use of e-mail.

II. Substantive Questions

1. QUESTION 1 – EU Directive on the legal protection of biotechnological inventions:

The status of the implementation process has been monitored quite extensively. The present situation has unfortunately not changed substantially since the last report, namely that Denmark, Finland, Eire and the UK have implemented the directive in their national legislation and countries like Greece, Portugal, Spain, and Luxembourg are expected to implement during the present parliamentary season. In Sweden it is expected to be passed in the next parliamentary season without major problems, while in the countries France, Belgium, Holland and Germany problems are present and expected to remain in the implementation process. Members of the committee report at intervals on the

progress of the implementation process in their respective member states. In the ECJ case of the Netherlands against the directive, pleadings were held in February, the opinion of the General Advocate is expected by the end of the year and a decision by the beginning of 2002.

2. EPO Practice in respect of Rule 23:

This issue was discussed by the members, but it was found that no directions can not yet be seen in how this will influence the prosecution. One rumour was that applications for ESTs were rejected hoping for the applicant to appeal, but apparently no applicants have yet appealed such rejections.

3. Miscellaneous:

The members exchanged information on various issues in biotechnology, including the activities in respect of protecting traditional knowledge 5th Conference of the Parties (COP 5) in Nairobi in May 2000 made no actual decisions in respect of IPR. COP 5 requested that WIPO would investigate certain aspects, especially the protection of traditional knowledge and report their deliberations to the COP 6 to be held in a couple of years.

Report of the EASY Committee for the period between November 2000 and May 2001

D.K. Speiser (DE)

In its last report (epi-information 4/2000, p. 132) the Committee had informed the members about the testing of the EASY-software that was under the way at that time and that the EPO had promised that the EASY Committee would be given by the EPO all information needed to make an informed opinion on the result of the test phase.

This information was provided by the EPO at the occasion of a joint meeting between the pilot users, the EASY Committee of the *epi* and the involved members of the EPO. The meeting took place in The Hague on 23 November 2000 and the members of the EASY Committee came to the conclusion at the end of the meeting that the online filing software was sufficiently practical and secure to allow it to go public. However, since the Committee became aware of a remaining problem the Committee decided to immedi-

ately inform the epi members on the generally positive situation and the remaining problem by displaying an urgent message on the epi Homepage as follows:

„URGENT INFORMATION FOR THE MEMBERS OF THE EPI“

The members of the EASY Committee of the *epi* having participated in the preparation and filing of dummy patent applications using the epline Online Filing (OLF) System and having participated in the evaluation of the test results have satisfied themselves that online filing is sufficiently practical and secure to proceed to filing real European patent applications.

Following the publication on the EPO web site of the Legal Framework regarding online filing the first real European patent application will be filed online on 8

December 2000. Subsequently, everybody may apply to use the system for his or her filings.

Members intending to use the system must be careful in checking all stages of the preparation and filing steps, in particular the preparation of the text and drawings of the application because the conversion of word processor files and files of drawing programs into the prescribed PDF format may cause problems. No such problems occurred when scanning paper versions of the text and drawings using a scanner that provides a PDF output. Therefore, it is recommended for the time being that members use scanners to generate the needed PDF files. It is nevertheless essential to review the PDF files prior to submitting the application to the EPO as carefully as traditionally filed paper documents because the PDF files constitute the only legally binding authentic patent application; the possibility of a review is provided for in the online filing software.

The Committee further recommends that potentially interested users of the online filing system arrange with the EPO through the epoline Customer Services the filing of one or a few dummy applications before starting to file real applications; in this way the user can acquaint himself or herself with the software and the procedures and if he or she requests from the EPO to be provided with paper copies of the dummy PDF documents filed, one can actually see what was received by the EPO. In this way confidence in the system can be obtained.

Detailed information is available from the epoline Customer Services and members intending to make use of the system should call them at +31 70 340 4500. Also, they will have to make a cost / benefit analysis of online filing versus traditional paper filing since the EPO unlike the Japanese Patent Office will not offer a reduced filing fee or other incentive for the users of the online filing system. Such analysis can be made using the experience gathered by filing dummy applications electronically."

28 November 2000

Dieter K. Speiser
Chairman of the EASY Committee
of the *epi*

At the occasion of the joint meeting with the EPO the Chairman of the Committee was asked by the EPO to take part in the first online filing of a European patent application, and this event subsequently took place on 8 December 2000 resulting in European patent application EP 00000001.8. Everything was fine during the preparation and submission of this first European application and the filing receipt containing the serial number and the filing date was forwarded by the EPO online within one or two minutes from having submitted the application electronically.

The EASY Committee subsequently prepared a letter to the President of the EPO suggesting that the EPO gives an incentive to those epi members and other users of the epoline system who actually use online filing rather than

the traditional paper work. In this letter it was pointed out that the forerunner of the epoline system, namely the EPO project in the name of DATIMTEX which had been launched in the eighties became an almost total failure. According to many voices from members of the epi the reason for the failure was that there had been no incentive for the users of the system to compensate for some extra efforts needed at that time to comply with the DATIMTEX requirements. We informed the EPO President that in contrast thereto the Japanese online filing system despite the need for substantial hardware and software investments by the users became an immediate success from about 1989 because of a substantial reduction of the filing fee for users of the online system. Still, the President of the EPO declined the proposal of the epi obviously being under the impression that there was no need for an incentive.

In this context it might be of interest to learn that the German Patent and Trademark Office will offer the users of its forthcoming online filing system a reduced filing fee.

According to information recently received from the EPO 125 European patent applications have been filed online since 8 December 2000 and 250 users have registered with the intention to file their applications online.

Looking into the future the EPO intends to allow online filing as of June 2001 of its form 1200, which is used to open the regional phase of a PCT application before the European Patent Office. In the second half of the current year version 1.10 of the online filing software of the EPO will be launched. This version unlike the current version can be used in a LAN and allows multi role processing so that drafting, signing and submitting an online application can be done by separate persons in our offices, whereas presently online filing can be done only using a standalone PC.

According to the EPO, the problems encountered occasionally with the conversion of word processor files into the prescribed PDF format originated from the use of the Acrobat Writer software that had been provided by the EPO together with the online filing software. Meanwhile, the EPO informed us that by replacing the Acrobat Writer[®] software by the Acrobat Distiller[®] software and using its option „embed all fonts“ the earlier encountered problems are avoided.

On the other hand, the Committee was informed by an applicant, frequently using epoline online filing, that according to his experience also Acrobat Distiller[®] („AD“) is not always safe for converting a Word file to PDF format, if the „AD“ is not used in conjunction with a proper PostScript[®] printer driver software, an option mandatorily required by later Acrobat installation programs. Moreover, there seems to be for the applicant no way to check whether „all fonts are in fact embedded“ in the electronic data, before the actual transmission to the EPO. As an additional measure it is recommended to select the „Cancel Job“ option in case of failed embedding font. This and the aforementioned option is available in a configuration file „EASY.Joboptions“, included

in the software distribution by the EPO and to be used by the „AD“. Still, for the time being a visual check by the applicant on the hardcopy as printed and returned by the EPO remains to be necessary, if the PDF files are generated from a word processor.

Thus, it presently appears that the recommendation contained in the above cited „URGENT INFORMATION FOR MEMBERS OF THE EPI“ has become redundant only as long as the users convert their word processor files into the needed PDF-Format using the Acrobat Distiller® software and use it in conjunction with a proper PostScript® printer driver software.

As a matter of caution, the Committee proposed to the EPO to again invite pilot users to run online filing tests using the Acrobat Distiller® software for the production of the prescribed PDF files. The EPO meanwhile agreed to contact the current users on short notice to test their present software installations using dummy applications. Hopefully, this will also help to increase the presently slow reaction times of the EPO regarding problems submitted by the online users.

The Committee was informed by the EPO that as of May or June 2001 it will again become possible for all potential users of the online filing system to acquaint themselves with the online filing software by filing dummy applications using a special Internet access. Details can be obtained from the epline Customer Service.

During the period under review the *epi* Committee started to look into the details of the so-called MIPEX project which is a project of some national Patent Offices in Europe headed by the UK PTO for the development of an online filing system separate from the system provided by the EPO. The Committee fears that the implementation of different software systems for use with the various Patent Offices will be detrimental to the intentions both of the respective Patent Offices and its users. Accordingly, our President, with a letter dated 11 December 2000, invited the *epi* Board Members to check with their local Patent Offices whether or not they participate in the setting up of an online filing system under the MIPEX project rather than using national versions of the EPO software which are obtainable from the EPO. While the Committee is unaware of responses to said letter, it can be reported that the German PTO, being a member of the MIPEX project and following our initiative, apparently began to note the problems that are to be expected when forcing the users to use different kinds of software packages for their online filings. The German PTO indicated that its software possibly could be designed in a way allowing the filing both of national and European patent applications. Talks commenced between the German PTO and the EPO in an attempt to arrive at an acceptable solution of the problem.

Meanwhile the Finnish Patent Office officially opened its online access for the filing of national Finnish applica-

tions using the national version of the online filing software (EASY) of the EPO. The first online patent application in Finland was filed by Kolster Oy AB where our Committee member Antero Virkkala works.

The UK Patent Office has been in discussions with the EPO and is preparing to install an epline server in order to act as a Receiving Office for EP applications from the UK; the security requirements in the UK preclude UK resident applicants from filing directly with the EPO unless security clearance has been obtained.

Having accompanied the efforts of the European Patent Office towards the launching of the online filing software and having participated in the evaluation of the results of the related tests, at least the major part of the task of the EASY Committee appears to have been fulfilled. Therefore, the Committee wants to raise the question whether it should continue to accompany the development of online communications and keep the members informed. If Council concludes that the Committee should continue to be active, it is proposed by the Committee to adapt its name to Online Communications Committee (OCC). Otherwise, Council should decide that the EASY Committee be dissolved.

Council is invited to decide whether or not the present EASY Committee is to continue or terminate its work.

Further to the decision taken at the last Council Meeting in Madrid on 7-8 May 2001, the following *epi* Resolution was sent to the EPO and WIPO:

***epi* Resolution on the Harmonisation in Electronic Filing**

The *epi*, as the organisation of all professional representatives before the EPO, with members from both industry and the free profession,
in consideration of the FICPI Resolution passed at the FICPI Executive Committee meeting in Seville on February 4 to 9 2001,
in consideration of the need for widespread adoption by the users in order to ensure viability of the on-line filing systems of the respective patent offices,
and in consideration of the difficulties of running multiple diverse systems in representatives' offices,
urges WIPO, the EPO, and all patent offices of the contracting states to the EPC to harmonise electronic access and filing modalities by providing a common standard for electronic filing and, in particular, a common user interface suitable for filing PCT applications, EPC applications, and national patent applications, as well as trade mark, utility model applications, and design applications.

Report of EPO Finances Committee

J. Boff (GB)

Financial position of EPO

The EPO ended the year with an operating surplus of approximately DEM 283m as compared with a budgeted surplus of DEM 88m. This surplus is due both to an increase in demand, and lower than budgeted recruitment of examiners.

Workload, Human Resources, and Performance of EPO

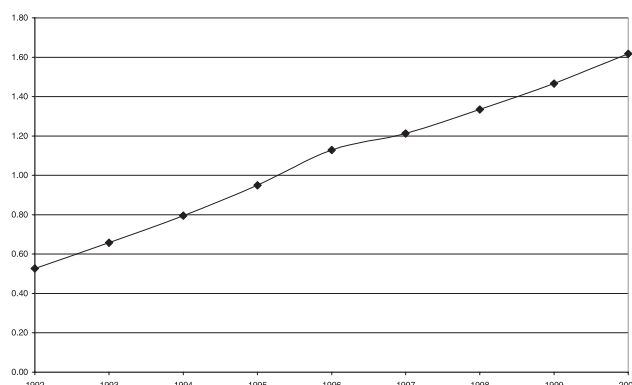
Workload

The number of PCT applications filed in 2000 was 23% higher than in 1999 (WIPO Statistics). This means a consequent increase in PCT workload for the EPO both at the search and examination stages.

The ratio of Euro-PCT to direct EPC filings continues to increase with no sign of slow-down.

1990	1991	1992	1993	1994	1995	1996	1997	1998	1999	2000
0.35	0.48	0.53	0.66	0.79	0.95	1.13	1.21	1.33	1.47	1.62

Ratio of Euro-PCT filed to direct EU filings



Given the continuing improvements to the attractiveness of the PCT, and the prolonged delays in directly filed European applications this trend looks set to continue. This increase in PCT work is a problem.

Human Resources

Staff recruitment has been slower than budgeted. During 2000 the EPO had budgeted to recruit a further 90 DG1 Examiners, and 250 DG2 Examiners. Taking into account a deficit in numbers recruited in 1999, and the need to replace retiring Examiners, in total the EPO needed to recruit 142 DG1 examiners and 317 DG2 Examiners. In the event 109 DG1 Examiners and 115 DG2 Examiners were recruited.

This difficulty in recruitment has had, and will have, a major effect on EPO performance. The following Table shows the 1999 and 2000 figures

	1999 Budget Plan	Unfilled from 1999	% below Budget	2000 Budget Plan	Unfilled at end of 2000 (estimated)	% below Budget	2001 Budget Plan	Growth in budgeted numbers 1999 to 2001
DG1 Search examiners	1192	42	3.5%	1282	33	2.6%	1380	15.8%
DG2 Examiners	1258	128	10.2%	1508	202	13.4%	1758	39.7%

This shows that not only is the recruitment behind Budget, but also the growth in numbers implied by the Budget would be a strain on any organisation to manage. An increase of nearly 40% in Examiner number implies a huge training commitment, which has had a consequent effect on the performance of existing Examiners.

Performance

During 2000:–

- the search stock increased from 8.3 months to 8.7 months (in 1996 it was 6.6 months)
- the examination and opposition stock increased from 27 months to 28.4 months
- the number of patents published decreased from 35359 in 1999 to 27523 in 2000

All of this is symptomatic of structural problems within the EPO. Given the problems in recruitment, and the increased use of PCT, it is hardly surprising that the EPO is failing to meet the demand for its services.

Ways of improving the situation

Broad Consultation Process

The EPO has undertaken a Broad Consultation Process to look for ways of improving the performance of the EPO (CA/95/00). It would appear to make sense for epi to make positive proposals that would improve matters rather than await action from the EPO. Accordingly the following points relating to financial matters are raised for discussion.

Given the nature of the problem, the suggestions raised fall under the headings:–

- Reducing the PCT workload
- Increasing the efficiency of the direct EP route
- Reducing Euro-PCT workload

Reducing the PCT workload

Reducing Demand

One of the main problems for the EPO is the precedence that PCT applications take, with their fixed time limits for search and examination. This problem is compounded however by the EPO taking more than its fair share of the PCT searches and examinations. The following Table shows:–

- the number of PCT applications filed in 2000 by applicants from EPC countries, USA, and Japan;
- the number of applications for which the EPO, USA, and Japan acted as Search Authority; and
- the number of applications for which the EPO, USA, and Japan acted as Examination Authority.

	Filed	ISA	IPEA
EPC	34050	55414	37427
USA	38171	17386	16389
Japan	9402	8850	4401

It is readily apparent that the EPO does far more work as ISA and IPEA than the number of filings by EPC applicants would merit (and this does not take into account that many applications filed by EPC applicants would be searched in Austria, Spain, or Sweden).

It is also apparent that the USA does not pull its weight.

If the workload could be spread more evenly among ISAs and IPEAs then some of the EPO's problems would be relieved.

In particular, if the USA could be persuaded to do more International Preliminary Examinations then the EPO's workload would be considerably relieved. It has been estimated by the EPO that for every 1000 PCT dossiers the EPO loses examining capacity for 415 EPC dossiers. If the EPO ceased acting as an International Preliminary Examination Authority for US applicants then it could

release resources sufficient to do at least 5000 EP examinations a year. This would have a financial aspect in the reduction in fees for International Preliminary Examination (and probably search fees) from the USA, but this would be partially offset by the consequent charging of full examination fees on entry into the European Regional Phase.

Improving the PCT specification

Examination of US-originating patent specifications also is a problem due to the tendency for such applications to have large numbers of claims. In the Regional Phase this is dealt with (to a limited extent) by the use of claims fees. No such incentive towards a concise specification exists under the PCT except for a very low fee per page over 30. The EPO could make the International Search and International Preliminary Examination fees dependent upon the complexity of the application by making them dependent upon the number of claims/pages. If, for example, the fee for International Preliminary Examination for an application with 30 claims was twice that for an application with 10 claims economy of claiming would be encouraged.

Adopting BEST approach to PCT procedure

At present PCT applications are searched and then, if the Demand is filed, examined. A financial incentive in the form of a discount on the IPE fee could be offered if the applicant files the Demand at the time of filing the application and agrees to receive a combined Search Report and Written Opinion. If the EPO consider that BEST saves resources for EP applications then the same approach should save resources for PCT applications also.

Increase efficiency of direct EP route

The EPO are clearly headed towards use of BEST. This is clearly a waste of effort for the many cases where the Search Report shows sufficient prior art to deter the applicant from proceeding further. A more logical approach would be to use the alleged efficiencies of bringing search and examination together for those cases where the applicant wishes it, and keeping them separate where there is a high risk of wasted work.

The EPO intend to use BEST on all European first filings. Some European first filings are intended solely as priority basis for a later PCT application. If the EPO wish to use BEST then it could invite applicants on European first filings to indicate whether the application is intended as a priority filing only. If such an indication were given, then the EPO would be saved wasted BEST work and so a discount on the Search fee could be given.

In a similar attempt to improve efficiency, a discount on the Examination fee could be given if the Examination fee is paid with the Search fee and the applicant agrees to receive a combined Search and Examination Report. This would shorten the time to issuance of the first Examination Report.

Reducing Euro-PCT Workload

At present a Euro-PCT application that is examined at the EPO as IPEA is examined twice – once at the International Stage and once at the Regional Phase. This inevitably results in inefficiency due to the delay between the International and Regional Phase examination. A discount in the Examination Fee could be offered if the applicant enters the European Regional Phase and pays the Examination Fee at the time of filing the Demand, and agrees to receive a Written Opinion and EP Office Action at the same time. Although subsequent examination need not proceed at the same pace this would save some EPO resources and give the opportunity for a quick grant procedure.

Financial incentives

Several of the above proposals fall within the general concept of offering fee savings as incentives to reducing EPO effort. This overcomes reservations about offering broad fee reductions (which might increase demand unduly).

By giving real financial incentives to those making the EPO's job easier, the production of the EPO could be increased and there would be some channelling back to co-operative applicants of the persistent surpluses of the EPO.

Those applicants who had specific reasons not to make the EPO's job easier would be able to do so at a cost.

This approach also reduces the risk that the EPO might impose undesirable fee structures or patterns of working on all applicants, merely because they have problems with some applicants.

Report of the European Patent Practice Committee (EPPC)

A. Casalonga (FR)

I. Double Patenting

The EPC does not deal with copending European patent applications of the same date. However, if an applicant files two applications with the same date, containing claims directed to the same invention or slightly overlapping, the Examiner requests an amendment of one of the application following the guidelines (see guidelines part C, chapter IV, 6.4).

In some cases, for example in the chemical field, an applicant could need to cover two aspects of an invention by slightly overlapping claims filed in two different applications on the same day.

In a recent decision of a board of appeal (T 587/98-3.5.2) the Board confirmed that there was no legal basis for the guidelines and accepted to maintain both applications without amendments.

The EPPC felt that an applicant should be free to pursue two applications filed on the same day with overlapping claims. The EPO should be urged to amend the guidelines in that direction following the recent case law.

II. Name Standardization in Patent Documentation

Already a number of years ago, PDG Impact took the initiative to try to come to some standardisation in the names of applicants used in the different patent databases, particularly those of the EPO and Derwent. At the time, the EPO and Derwent agreed with PDG Impact that there is indeed a serious problem. Many applicants have multiply names in the databases, some of them even

50-100. Derwent standardises names, but Patent Offices have no freedom because they have to accept the name as indicated on filing.

In a number of cases the bigger concerns use for their applications different legal entities, often on purpose and with good reason. Nothing wrong can be seen in this practice.

In many other cases however, there is no good reason and different names are rather used by accident or mistake.

In the PDG Impact Meeting of 29-30 March 2001 it was decided that a start will be made by the EPO sending lists of applicant names of the many legal entities within a number of big European companies that are PDG members. These members have promised to try to standardise. From a test it appeared that a lot of required „standardisation“ is in fact removal of errors. For example, for a computer

„E I DuPont“, „E.I. DuPont“ and „Dupont“ are all different. The applicants are now asked to indicate the correct spelling of their names. Besides that, the concerns will consider if the use of different legal entities within the concern is only be mere accident or does serve a purpose. In the first case, streamlining is possible.

III. Question 158 – Possible harmonization of evidence taken in court actions for European and community patent infringement

Following the decision taken at the *epi* Council meeting in Rhodes, the EPPC continued the discussion on this

question. A position paper has been drafted and approved by the *epi* Council of Madrid.

1. Introduction

The procedures for obtaining evidence before or during patent infringement actions vary from country to country in Europe.

In the United Kingdom once an action has started the Court will give directions about the standard or specific disclosure of documents. In recent years, changes to the Court procedures have however somewhat curtailed the more extensive discovery procedure of earlier years.

In some countries like France, Belgium, Italy and the United Kingdom it is possible to collect evidences, before engaging in a patent infringement action, by means of a seizure procedure which is an *ex parte* procedure authorized by the Court and open to the plaintiff. Such a procedure gives the possibility to the plaintiff of sending independent persons, without prior notice, even into the facilities of the alleged infringer, in order to collect evidence of infringing acts.

In France and Italy, the seizure procedure is limited to the description of infringing products, machines or processes, with the possibility of photocopying documents and taking samples of alleged infringing goods. In the United Kingdom the *ex parte* procedure may involve the removal of documents and allegedly infringing goods and also can include injunctions to restrain infringement and/or the communication to third parties of the content of the injunction. In Belgium, the seizure procedure sometimes permits the seizure of the entire production of the alleged infringer.

Such types of seizure procedures are extremely effective tools in the hands of the plaintiff.

However, they are also criticised for not always sufficiently protecting the rights of the defendant, who obviously at the beginning of the patent infringement action is not yet condemned for infringement. Furthermore the patent can eventually be declared void.

The *epi* considers that a harmonised procedure for taking evidence of infringing acts would be a useful tool and should be introduced in the future jurisdictional organisation of patents in Europe, both for a future EPLP or Community patent regulation. After consideration of all presently existing procedures in the various European countries for obtaining and forwarding evidence of infringement before the Court, the *epi* now considers that it would be advisable to introduce in Europe a procedure somewhat similar to the seizure procedures presently existing in Belgium, France, Italy and the United Kingdom.

Such a procedure should be open to the plaintiff before engaging in a patent infringement action at a future Court dealing with European patents or with Community patents.

However, certain conditions and limitations should be provided for such a new European harmonised seizure procedure.

2. Conditions to obtain the authorization for seizure

The authorization to perform a seizure procedure should be requested before the Court, preferably before the Central Court of first Instance if such Court exists or before a regional Court of first Instance in the case where seizure is to be provided at the first instance level.

The patentee should of course show to the judge that he is owner of the patent, that the patent is in force and covers the countries where the Court has jurisdiction (in the member states of EPLP or the European Community).

If the future judicial organisation in Europe opens the possibility of engaging an infringement action on the basis of a pending European application, an authorization for seizure should also be possible with such a pending application.

The *epi* also considers that the plaintiff should provide the judge, together with the request for authorization of seizure, with sufficient basis for the presumption of existing infringement. This would help avoid an abuse of the procedure whereby a patentee simply tries to obtain information about a competitor's activities.

3. No prior notice

The *epi* considers that one of the most important features of such a seizure procedure is the *ex parte* character of the procedure.

The *epi* feels that surprise is an essential characteristic of the seizure procedure and an important means for collecting evidence about infringing acts.

Therefore, the *epi* favours the possibility of obtaining authorisation from the Judge for the performance of such a seizure, without prior notice to the alleged infringer, so as to guarantee the surprise.

4. Persons allowed to participate to the seizure operations

The seizure operation authorised by the Judge should be performed on behalf of the Court by an Official appointed by the Court.

However, it has to be accepted that the plaintiff must have the possibility to fully brief any Court official and any person possibly assisting such Court official during the seizure operation.

It would not be sufficient for the plaintiff to be simply authorised to describe in writing the documents and devices which need to be examined during the seizure operation.

Clearly, in such a surprise procedure, it is often impossible for the plaintiff to know exactly where and to what extent evidence of infringement will be available during the seizure operation.

The *epi* therefore considered the possibility of the European patent attorney of the plaintiff being authorised to assist the Court official during the seizure operation. This would permit the plaintiff to gain the most advantage from the procedure, the European patent attorney of the plaintiff being able to guide the Court official during the seizure operation so as to obtain the best possible evidence of infringement.

On the other hand, it must be recognised that this could in certain situations create an excessive imbalance in favour of the plaintiff.

However, the *epi* considers necessary that the Court official be an independent European patent attorney nominated by the Court or that such an independent European patent attorney be appointed by the court to assist the Court official during the seizure operation.

Such an independent European patent attorney, acting as a technically skilled person, fully knowledgeable in patent matters and independent of both parties, would guarantee a proper balance between the parties with respect to the seizure operation.

To enable the effective collection of all necessary evidence during the seizure operation, the independent European patent attorney nominated by the Court should be fully briefed and prepared by the plaintiff, its counsel and European patent attorneys, by means of suitable written and oral information.

5. *Extent of seized material*

The *epi* considers that seizure operations should permit the drafting of complete written reports of infringing acts observed during the seizure operations by the Court officials and their assistants.

Photocopies of documents, as well as effective seizure of original documents, should be permitted as a general rule so long as those documents clearly relate to any infringement.

The seizure operation should also permit the Court official to seize samples of infringing goods or parts of such goods.

The seizure procedures should not authorise the Court official to seize more than a limited number of samples. The seizure of entire machines or tools, used for manufacturing alleged infringing goods or being themselves allegedly infringing, should not be permitted. In such a case only a written description with photographs should be allowed.

It is important that the seizure operation should be strictly limited to the obtaining of evidence of an alleged infringement and that it should avoid any unnecessary disturbing actions that could prejudice the legitimate activities of the alleged infringer.

6. *Protection of confidential information*

Confidential information belonging to the alleged infringer should be protected. Abuses of the seizure procedure should be avoided.

On the other hand, it is clear that the very aim of the procedure necessitates that any relevant information can be seized during the seizure operation, with the alleged infringer not having the possibility of escaping this collecting of evidence on the grounds of confidentiality.

In order to obtain a balanced procedure, the *epi* considers that the confidential documents obtained during the seizure operation should be considered and suitably sorted under control of the judge before any authorisation is given for communication of these to the plaintiff.

Depending on the situation, the judge should also be able to limit communication of part or all of the confidential documents to be made only to the European patent attorneys and lawyers of the plaintiff, as well as in some cases to selected employees of the plaintiff.

The procedure should provide in this regard for various possibilities to be left open for decision by the Court.

7. *Complementary evidence*

The *epi* considers that the plaintiff should be able to obtain complementary or supplementary evidence of infringing acts on the basis of the evidence already obtained during the seizure procedure.

This could best be obtained by a specific request to the Court after the complaint has been filed.

The *epi* does not consider it advisable that such a complementary evidence request should be obtainable by a kind of discovery procedure, initiated after the complaint has been filed.

8. *Time limit for filing the complaint*

The *epi* considers that the plaintiff should be obliged by the law to file a complaint before the Court having jurisdiction within a certain time limit after the seizure operations have been performed.

This would help to avoid abuse of the procedure by the plaintiff performing a seizure operation with the sole aim of disturbing a competitor.

The Court having jurisdiction should be served with the complaint even before the question of communication of possible confidential information has been settled and relevant information communicated to the plaintiff or to the selected employees of the plaintiff and/or to the plaintiff's counsels and European patent attorneys as previously mentioned.

The duration of the time period between the seizure operation and the filing of the complaint should be short, for example one month.

9. *Prejudice suffered by the alleged infringer*

Nothing in the provisions organising such a seizure procedure should preclude the alleged infringer from requesting from the Court any due reparation of damages which the alleged infringer considers to have suffered through the seizure operation performed at the request of the plaintiff.

IV. **Question 160 – Community patent regulation draft**

The EPPC discussed the draft of the EU Commission and, without taking a position in principle on the proposal, prepared a position paper which, in the meantime, has been sent to the EPI Board and, after approval, sent the following *epi* position paper to the EU Commission.

I **GENERAL COMMENTS**

The proposal for a Council Regulation issued in August 2000 replaces the previous Agreement and Convention

on a community patent accepted in Luxembourg in 1989 and which never came into force. The proposed Regulation maintains however the main features of a community patent having a unitary character throughout the territory of the community as well as an autonomous character, the community patent being subjected only to the provisions of the Regulation and to the general principles of community law.

The *epi* takes note of the proposal according to which, by virtue of the community accession to the EPC and the possible designation of the community as the territory for which the community patent can be granted, the provisions of the EPC shall apply to applications for community patents and granted community patents. This has the clear advantage of maintaining the present satisfactory solution of a unique examination and granting procedure with a largely harmonised interpretation of patentability in Europe.

Freedom of choice

Given the present success of the European patent granted according to the EPC, the *epi* also welcomes the possibility for applicants to choose freely the most appropriate patent protection in Europe depending upon each situation. The *epi* therefore approves the possibility for an applicant having filed a European patent application and having designated all the countries of the Community to choose a community patent up to the date of grant by converting his application into an application for a community patent. In the same way, it is particularly appropriate that an applicant having initially designated the territory of the community may convert his application into an application for a European patent up to grant.

Organisation of the litigation procedure

The proposed Regulation considers the creation of a new intellectual property community court. The *epi* wishes to remind that following the inter governmental conference held in Paris in November 2000, a working party is presently studying a proposal for an optional protocol on litigation for the European patent (EPLP).

The *epi* considers that it would be particularly unwise to create different and separate jurisdiction for European patent and for community patents. Thoughts should therefore be given to an organisation which would permit for example after accession of the community to the EPC to have the same court system for the community patent and for the European patent at least for countries having accepted a future optional protocol on litigation for the European patent. This would clearly have the advantage of achieving a better harmonisation between the European patent system and the community patent system.

Furthermore, the *epi* favours the local presence envisaged at the level of the first instance of the EPLP. This issue is of importance for many applicants in several countries of the community and should be seriously considered also for the community patent.

Translation requirements

According to the proposed Regulation, the community patent is granted in one of the languages of the EPO. A translation of the claims in the two other official languages according to the EPC is the only required translation. However, according to articles 11 and 44, a translation is required for the claims of a published application to obtain a reasonable compensation or of the entire text of the granted patent to obtain damages. Provisions are contained in the draft Regulation for avoiding the necessity of those translations, if it can be proved by the applicant or the patentee that the assumed infringer would have understood the claims or the text of the community patent in the filed language. Provisions are also contained for the case of member States having several official languages.

The *epi* is not in the position of giving a general opinion on translation requirements for the community patent, the views of the *epi* members being split on the question of translations of patents in Europe. The *epi* nevertheless welcomes the statements contained in articles 11 and 44 of the proposed Regulation which take into account the possible consequences of the lack of translation on the extent of the civil responsibility of the parties.

The *epi* noted however that the wording of articles 11 and 44 are somewhat different and suggests that both wordings be harmonised in order to avoid any risk of discrepancy and difficulty of interpretation. In this regard, the *epi* considers the wording of article 44-3 more clear and preferable as compared to the wording of article 11-2.

As regards member States having more than one official languages, the *epi* considers that the provisions of the EPC particularly contained in article 65 EPC should be adopted, according to which translation into any one official language of such member State is sufficient unless the member State has stipulated a particular official language.

Representation before the community court

In view of the highly technical matters which will have to be considered by the community patent court, the *epi* finds advisable to introduce provisions in the Regulation according to which European Patent attorneys would be allowed to represent the parties before the future community court of intellectual property. Corresponding provisions could be introduced for example in the statutes of the court.

For the same reason the *epi* considers that the Chambers of the future community patent courts should comprise both technically qualified members and legally qualified members. Corresponding provisions could be introduced in the statute of the court if not in the Regulation itself.

II Comments on the main articles of the draft regulation

Article 2 – Community Patent

The *epi* approves the provisions according to which the community patent would be obtained by simply de-

signating the territory of the community in a European patent application. It could possibly be made clear that a designation of the community would also be possible in a PCT application. At least it should be possible to obtain a community patent through a PCT application designating at the filing date all the members States of the community.

It was noted that the proposal contained no provision relating to SPC (Supplementary protection certificates). It should be made clear that an SPC could be obtained on the basis of a community patent.

A possible amendment to the proposed article 2-2 could be that the EPC in general applies to the granted Community patent. Provisions such as *restitutio in integrum* according to article 122 EPC should clearly apply in case of lack of payment of an annual fee for a community patent.

The possibility of choice between a European patent and a community patent up to grant which is particularly welcomed by the *epi* should be confirmed in the Regulation itself for example in article 2.

Article 4-2 – Right to the Community Patent

The *epi* noted that the provisions contained in article 4 are a mere repetition of article 6 EPC with the danger of a conflict if one of the provision is amended in the future. The *epi* considers that this article could therefore possibly be cancelled.

Article 12 – Right based on the prior use of the Invention

The *epi* considers that the scope of the prior users rights are not defined with sufficient precision in the draft Regulation.

The *epi* thinks that the aim of the prior users right is to protect a person who in good faith has made investments for commercialising an invention before the priority date of a subsequent patent. However, the requirement for establishing a right of prior use should be strict in order to protect the justified interests of the patentee.

Accordingly, provisions should be introduced for defining which extensions of the prior activity are permitted and which should not be allowed. For example, importation should be extendable to use or sale but not to manufacture. Manufacture should be extendable to use and sale but not to importation from outside of the community. Mere prior preparation for sale should not be extendable to manufacture.

Article 13 – Process Patent: Burden of Proof

The *epi* would favour adopting the wording of article 34 Trips that any identical product when produced without the consent of the patent owner shall in the absence of proof to the contrary, be deemed to have been obtained by the patented process:

- a) if the product obtained by the patent process is new; or
- b) if there is a substantial likelihood that an identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

Article 14 – Dealing with the Community Patent as a National Patent

When the community patent is considered as an object of property, the proposal indicates several possibilities for the determination of jurisdiction, the *epi* considers that the applicable law should be determined only by the residence of the applicant or the residence of the patentee particularly if there has been an assignment between the filing date and the date at which the question arises.

The proposal of the draft Regulation according to which the law of the country of residence of the first representative is chosen in the case where the applicant or patentee has no residence or establishment within the community would create potential difficulties in practice. It could lead applicants to choose their representative only in view of the national law on property. It would also be questionable when the first representative is a citizen from a country outside of the community such as Switzerland.

The *epi* therefore suggests that German law would apply in such a situation.

Article 21 – Compulsory Licences

The grant of compulsory licences by the commission is considered inappropriate by the *epi*. In practice, granting a compulsory licence for example in the case of depending rights may necessitate a full study of the scope of protection of the patent involved. Only the community court for intellectual property seems to have the necessary expertise in such a situation.

The *epi* therefore suggests to change this provision by replacing the commission by the community court.

In paragraph 2 it is suggested to add utility models and certificates of utility.

In paragraph 1, it is suggested to indicate that the time period to be considered is the one which expires first.

Concerning paragraph 3, the *epi* considers that an authorisation of exploitation of a community patent should in principle give rise to royalties even in situations of urgency.

The *epi* therefore suggests to cancel this paragraph.

The *epi* would furthermore suggest that the wording of article 31 Trips be considered to amend the proposal in its articles 21 and 22.

Article 28 – Grounds for Invalidity

According to the proposed Regulation, the community patent is declared invalid if the subject matter of the patent is not new having regard to the content of a prior national patent. This means the complete nullity of the community patent on the basis of the national right existing in only one member State. The proposed Regulation also does not mention national utility models or certificates of utility.

In any case, the *epi* considers that such a consequence is far reaching and that conversion of the community patent in such a case into a European patent or national patents should be possible. Another possibility would be to maintain the effects of the community patent in the

other member States where the national right does not exist. The *epi* stresses in this regard that the community trademark system provides for possibilities of conversion in such a situation.

Article 30 – Actions and Claims relating to the Community Patent

The *epi* noted that according to the proposed draft the community patent may not be the subject of actions in respect of threatened infringement. It is difficult to understand why this specific possibility of action has been excluded. The *epi* would prefer to have those threat actions available.

Articles 31 and 32 – Invalidity Action / Counter Claim for invalidity

The *epi* feels that it could be made more clear that limitation of the community patent can be made during an invalidity procedure or in case of a counter claim for invalidity and that the community court shall examine said request of limitation during the course of the invalidity action or counter claim for invalidity.

Article 33 – Infringement action

The *epi* doubts that the beneficiary of a licence of right or compulsory licence should be allowed to bring an action for infringement even with authorisation of the proprietor of the patent.

Article 34 – Action for declaration of non-infringement

The *epi* is in favour of amending paragraph 2 of this article in order to permit to contest the validity of the community patent in an action for declaration of non-infringement.

Article 37 – Request for Limitation

The *epi* considers that the procedure for limitation proposed in this article is redundant with the central limitation procedure at the EPO which has now been provided in the revised EPC (articles 105(a)-c). The EPO limitation procedure appears to be simpler and quicker in view of the fact that patentability of the limited claims is not considered.

The *epi* takes for granted that Article 105(a)-c EPC applies to community patents notwithstanding the exclusive jurisdiction provided in Article 30-3 of the proposed regulation.

The *epi* therefore considers that the procedure for limitation proposed in Article 37 is superfluous in case of an *ex parte* request. The proposed procedure should be restricted to limitation requested before the community court during the course of an invalidity action already engaged or in the case of a counter claim of invalidity presented before the community court during the course of an infringement action.

Article 38 – Application for Ruling that the patent has lapsed

This provision does not seem really useful. It is suggested to replace the provision by a simple notification from the

EPO which could be provided in the Implementing Regulations.

Article 42 – Provisional or protective measures

In the absence of harmonised protective measures, it should be made clear that national law applies for taking evidence.

The *epi* is generally in favour of harmonised provisions for obtaining evidence and would suggest that the draft Regulation be supplemented by specific provisions in this regard. The procedures existing in certain countries (for example the *saisie-contrefaçon* in France) should be studied and possibly extended to the entire territory of the community together with suitable means for protecting the legitimate interests of third parties.

Article 44 – Actions or Claims for damages

The *epi* welcomes the indication in paragraph 2 that the court should take into account all relevant aspects for determining the appropriate damages. However, the mention of good or bad faith of the parties could in the opinion of the *epi* lead to difficulties of interpretation. The same can be said for the last sentence where it is said that the damages shall not be punitive.

The *epi* is in favour of cancelling this sentence and leaving the court make their own evaluation of the situation for determining the appropriate damages.

Article 45

The proposed provision could possibly be clarified to indicate that continuing infringement can be stopped even after five years and that defence on the basis of the prior user rights can be made at any time.

Article 54 – Prohibition of simultaneous protection

It should be made clear in section b of paragraph 1 that the opposition proceedings may be concluded with a decision to maintain the patent with or without amendment.

The *epi* also suggests that instead of mentioning both patents cover the same invention it should read claim the same invention.

V. Question 161 – Patenting combinatorial libraries

At the European Round-Table on Patent Practice in Lyon, May 25 and 26 2000, the EPO presented a paper relating to Patenting Combinatorial Libraries and Associated Technologies (EUROTAB 3/2000).

The EPPC made the following comments:

Part A. Substantive Examination

II. 1) Lack of clarity

If the description gives no definition of the term „library“ it has to be interpreted in its broadest scope, i.e. as encompassing both a mixture of compounds, an array of compounds as well as individual compounds.

Although interpretation of the scope of the claims has to be left to national courts, the description should nevertheless fulfil EPC, Art. 83 and 84 at grant. It is

the responsibility of the Examining Division of EPO to exclude the possibility of protection of individual compounds in a library type claim, unless this is explicitly claimed and the description contains sufficient disclosure for such individual compounds.

II. 2) Novelty

Novelty must be judged on a case by case basis. It should be possible to introduce a disclaimer.

A Markush type prior art can be considered to cover A or B or C etc but normally not a mixture of A and B and C, unless this is explicitly described. The mixture is not implicitly disclosed in the sense that a man skilled in the art, carrying out the teaching of description containing the Markush type claim would inevitably arrive at the library. He would not produce a mixture and he would not produce *all* compounds in an array (cf. Guidelines Part C, Chapter IV, 7.5).

On the other hand a library *must* contain *A and B and C* etc. This is valid for both mixtures of compounds as well as an array of compounds. The term „library“, if correctly defined in the description, should distinguish the compounds of the library from the compounds of an identical Markush type claim for novelty purposes (cf. Guidelines, Part C, Chapter IV, 7.6).

II. 3) Inventive step

- i) Applications for libraries must disclose a specific use or screening target. It would in principle not be enough only to e. g. define „use in lead generation“.
- ii) If a library solves the problem of obtaining candidates for a specific purpose, the library as such must be considered to solve the problem even if not all species of the library gives potentially active compounds. The library is a research tool as such and if this search tool solves the problem, inventiveness should be accepted.

There may also be properties specific to library design that in itself may support inventive step, for example, combination of structural diversity vs. number of individual members of the array.

If an application for a library – either it relates to a mixture or an array of compounds – also describes individual members or groups of members solving the

specific problem, independent claims directed to these members should be allowable in the same application. In such case necessary physical data or separation methods should be described. Again, a case by case study based on description and claims in combination with the problem-solution theory must be carried out.

II. 4) Sufficiency of disclosure and support

This must be decided on a case by case basis. The description has to fulfil EPC, Art. 83 and 84.

Part B. Search Strategy

Search strategy must also be decided case by case depending on description and claims. Search strategy can of course not only be based on convenience of EPO's business process.

If it is known that one of the compounds covered by the claims of a library has been used for the same purpose as contemplated by the library, this must put serious doubts on inventive step. It does not make any difference if the library as claimed relates to a mixture or an array of compounds. In the same manner it does not matter if prior art relates to combinatorial chemistry or not. It would nevertheless seem to be obvious to create a library containing the prior art compound for the same purpose.

As a consequence of this, the search must cover the individual compounds of a library.

There are also other reasons for that the search must cover the individual compounds of a library, in particular

- i) the applicant may be claiming individual compounds;
- ii) the applicant may amend the claims to specifically claim preferred compounds during prosecution [better to do the search at the beginning];
- iii) processes for making the prior art compound may be relevant for the creation of the library;
- iv) only by doing the search can the EPO decide whether a document is A, Y or X in the search category.

Unity of an invention shall not be denied if an application relating to a library also contains independent claims relating to individual members of the library.

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Report of the Finance Committee

B. Feldmann (DE)

1. This report draws attention to two of the matters considered by the Committee at its latest meeting on 27/28 March 2001.

New country problems

2. Under this heading, in our report to the last Council meeting, we put forward the recommendation that Council selects an existing Committee, or sets up and *ad hoc* working group, to undertake the task of exploring ways, to lessen the burden of dealing with entrants on the List from new countries who fail at the outset to pay their subscriptions and to review the policy for re-entrants on the List concerning subscriptions due for previous years.
3. There is now a related, and potentially more important, issue to be considered: In the revision of EPC agreed at the recent Diplomatic Conference, the so-called „Grandfather clause“ has been modified (the modified form is in Article 134, replacing the present Article 163). Omitted in the modified form is para. (7) of the present Article 163 in which „grandfathers“ are guaranteed a right of re-entry. The understanding is that the substance of para. (7), together with present Rule 102(3), will re-appear in new rules for the revised EPC and the Proceedings of the Diplomatic Conference will confirm this. However, in the meantime, neither have the Proceedings yet been published nor has any drafting of the new rules yet been seen. Consequently there must be some uncertainty about whether grandfather re-entry is without doubt to be preserved.

4. This uncertainty suggests, at least for the time being, that caution is necessary in advising that grandfather entrants need not pay their first subscription, and instead delete themselves voluntarily from the List, because later re-entry will always be possible (see, for example, the end of para. 2 on page 170 of epi Info. 4/2000).
5. If Council wishes, the Finance Committee is willing – although probably not fully within its terms of reference – to pursue not only the task mentioned in para. 2 above but also the wider question of re-entry rights under the EPC revision. This would be done in consultation, as necessary, with others, such as the Treasurer, Secretary General and the EPPC Chairman.

Reimbursement rates

6. These rates have remained unchanged for nearly 5 years, the last alteration having been in November 1996. A good opportunity for making the next adjustment will be the conversion to Euro for 1 January 2002. Expressed in Euro, the present rates are approximately € 28 for incidental expenses, € 33 for meals, and € 112 for hotel.
7. After extensive discussion, the Committee believes that a fair adjustment (to take effect on the date just mentioned) would be an increase of these figures, in the order given, to € 35, € 35 and € 125, a higher percentage increase being applicable to the incidental expenses rate which is thought to have fallen further behind actual cost than the other rates. The adoption by Council of such increases is recommended.

Report of the Harmonisation Committee

F. Leyder (BE)

A. Fourth meeting of the Standing Committee on the Law of Patents (SCP/4)

1. The Diplomatic Conference for the Adoption of the Patent Law Treaty (PLT) took place in Geneva from 11th May to 2nd June 2000, and adopted the PLT on 1st June 2000.
2. At its fourth session in November 2000, the SCP considered the desirability and feasibility of further harmonising patent law. Klas Norin represented the

epi during the discussions. The Member States were invited to provide guidance to WIPO on how to proceed with further substantive harmonisation. The SCP members agreed that the harmonisation of the different patent systems was a pre-requisite to reducing the costs of obtaining international patent protection.

3. The SCP members agreed to focus discussions during the next two sessions (which will be held in May and November 2001) on six basic principles that

- determine whether a given invention qualifies for patent protection, namely:
- the definitions of prior art,
 - novelty,
 - inventive step (non-obviousness),
 - industrial applicability (utility),
 - sufficiency of disclosure, and
 - the structure and interpretation of claims.
4. During the discussions, the US delegation made a statement that it could consider the issue for „first-to-file“ vs. „first-to-invent“ in the near future, but indicated that harmonisation could be attained without addressing the critical issues of this question.
 5. It was further agreed that the SCP would review at the meeting in November 2001 whether additional issues as „first-to-file“ vs. „first-to-invent“, 18-month publication of applications or post-grant opposition should be included.
 6. All delegations expressed their views on Document SCP/4/2. The International Bureau will submit first drafts of provisions for a draft Treaty and Regulations concerning substantive patent law harmonisation to the fifth session of the SCP in May 2001. It was decided that these provisions should be drafted with no special territorial restrictions.
 7. Noteworthy is a statement by the US delegation that it was willing to consider the deletion of the best mode requirement from its national law. According to our delegate, it also agreed that the best mode requirement had gone out of proportion in practice, and it indicated that it might be willing to adhere to the PCT standard of unity of invention.
 8. Disclosure of information on the Internet (and its impact on patentability) was then discussed on the basis of document SCP/4/5. It was agreed that the International Bureau would circulate a questionnaire on current practices in internet-related issues, in particular with regard to publications on the Internet, and including questions regarding the infringement of patents on the Internet.
 9. All documents relating to SCP/4 are available on the WIPO internet site via the link http://www.wipo.int/eng/document/scp_ce/index_4.htm.

B. Fifth meeting of the Standing Committee on the Law of Patents (SCP/5)

10. SCP/5 will take place in Geneva from 14th to 19th May 2001
11. The documents prepared by the International Bureau for SCP/5 are available on the WIPO internet site via the link http://www.wipo.int/eng/document/scp_ce/index_5.htm. They comprise:
 - a draft Substantive Patent Law Treaty (SPLT);
 - draft Regulations and Practice Guidelines under the draft SPLT; and
 - results of the questionnaire concerning disclosure of information on the Internet and other issues relating to the Internet.
12. John Brown and Klas Norin have been nominated by the President to represent the *epi*. The Harmonisation Committee has to advise the *epi* delegates at the SCP meetings, and it will accordingly meet in Madrid, immediately after the end of the Council meeting.

Report of the Professional Qualifications Committee (PQC)

T. Onn (SE)

1. Students of the *epi*

There are now 258 *epi* students from 14 countries.

2. *epi* Tutorials

82 candidates (from BE, CH, DE, DK, ES, FI, FR, GB, IT, NL and SE) participated in the autumn Tutorials 2000. The Tutorials involved 29 tutors from BE, CH, DE, DK, FR, GB and SE.

The 2001/2002 Tutorials will start by the end of June 2001. There will be a summer Tutorials covering the 2000/2001 papers and the last date for enrolment is 8 June 2001. There will also be an autumn Tutorials covering the year 2001 papers. Last date for enrolment to the autumn term is 12 October 2001.

We have started a study of the possibilities to improve the Tutorials and as first step questionnaires have been distributed to the tutors and tutees participating in last year's Tutorials. After evaluation of all responses adequate changes in the Tutorials programme will be made.

Discussions have been held with CEIPI on how to deepen our collaboration. We are going to further coordinate the *epi* and CEIPI Tutorials in order to avoid unnecessary overlapping (in content as well as in time) of our respective programmes.

3. Tutors' meeting

On 14 November 2000 the annual Tutors' meeting was held. In order to extend the collaboration with CEIPI Mr.

Stauder and two CEIPI tutors were invited. Six chairmen/secretaries from Examination committees I, II and III had accepted our invitation and so had 20 *epi* tutors.

The meeting started with a presentation of the EQE statistics for 2000. The Examination Committee members informed about the complaints of the candidates to the Examination Board. There is only a small number of complaints and most of the concern trivial matters.

Each paper was discussed with the emphasis on the marking of the papers. It is important for the tutors to have some knowledge about this and the openness in the discussions was very stimulating. Feedback from the candidates regarding the different papers of the 2000 EQE was also given to the Examination Committee members.

The Committee member also gave their view on some areas where the shortcomings of the candidates should be improved. They concluded that it is not a matter of lowering the level for passing but rather to improve the training of the candidates.

To our great satisfaction the draft of the Examiner's Report was received already by the end of September, thus in very good time before the meeting.

The Council is invited to take note of the content of these three first items.

4. Continuing Professional Education (CPE)

The first CPE-seminar will take place next month with a seminar in Copenhagen on 28 May and the topic will be Oral proceedings at the EPO. Mr. Daniel Thomas of DG 2 will chair the seminar, which will be held as mock Oral proceedings in Opposition. We have started the preparation for repeating this seminar in Milan in October this year.

As to the future administration of the CPE seminars we have come to an agreement with CEIPI that they will be responsible for the lecturers and *epi* will take the responsibility for the practical arrangements (booking the venues, sending out the invitations, receiving the registrations and the registration fees).

Future topics that have been suggested for CPE seminars are „Interpretation and replies to Communications from the Office“, „Case law of the EPO Board of Appeals“ and „EPC/PCT update“.

An additional task within the CPE is the training of European Patent Attorneys to admit us to represent our clients before the new courts that are being created within the framework of the Community Patent and the European Patent systems.

Further it is our intention to set up links to existing national CPEs in the member countries from the *epi* website. This will facilitate for *epi* members to find information on current CPE-seminars.

Council is asked to approve the proposal of developing CPE along the lines depicted above.

5. EQE statistics

More than 200 of the candidates sitting last years EQE have answered our questionnaire. The questionnaire comprised about 30 questions so it will take some time for our working group to analyse all the answers. A first, preliminary report from our working group on statistics is enclosed.

We have asked the Examination Board for a better availability of the EPO statistical material of the EQE. We are pleased to have received a positive response and have been promised to get more material from them.

In order to get a broader statistical material to work with we are preparing a revised questionnaire to the candidates who sat the 2001 EQE. The Examination Board has kindly promised to distribute a copy of this questionnaire with an accompanying letter. This will be distributed together with a letter from EPO informing the candidates where and how to find the results of the EQE on the EPO website.

6. Joint working group *epi*/EPO/CEIPI

Mr. Kober has agreed to a joint *epi*/EPO/CEIPI working group for i.a. an analysis of the EQE statistics. Further tasks for this working group will be to prepare guidelines to the candidates and proposals on how to improve training.

The working group has been established and comprises Ms. Dybdahl and Mr. Hugg from EPO, Mr. Stauder from CEIPI and Mrs. Leissler-Gerstl and Mr. Onn from *epi*. The group had its first meeting on 25 April 2001 at the EPO.

The additional statistics that the Examination Board had promised to give us will be received by mid-June. In order to make progress additional EPO statistics will under confidentiality be given to the group. There was also a discussion about the answers to our questionnaire and a consensus about the necessity of further questionnaires to future candidates.

7. EQE 2001

Of the more than 1200 candidates that had enrolled 1164 came to sit the examination, which took place on 28-30 March 2001. The number of first sitters was 567, which is an increase with over 40% as compared with previous years, whereas the number of resitters was about the same.

9 November 2001 is the last date to enrol for the EQE 2002.

8. Joint meeting PQC/Examination Board

The PQC members and the tutors received a friendly welcome by Mr. Vivian and the other members of the Examination Board. The outcome of our questionnaire project was presented to the Board and it was emphasized that the outcome must be considered with great caution and can only be regarded as a mere indication.

PQC expressed its gratitude for the help from EPO in distributing the questionnaires to the candidates. Mr. Vivian promised to continue this cooperation and to support PQC in any questions in this regard.

One of the *epi* tutors Mr. Jackson presented detailed comments on the 2001 EQE that he had received from his tutees. There was some discussion concerning the significant difference between fitness for practice and fitness for examination, which is often underestimated. It was reported that some candidates felt that the additional time given for some papers now seems to yield more and longer questions. Thus the original idea of giving the candidates more time to answer the questions has been „compensated“ with a larger number of questions.

Another question that was discussed was whether there should be a „fixed“ allocation of questions on EPC and on PCT? It was commonly agreed to relinquish this idea. A main complaint of the candidates and tutors is the lack of transparency of the marking system. After a lengthy discussion it was agreed that the transparency had improved throughout the last few years. This is the result of the more open discussions between members of the Examination committees and the tutors on the annual Tutors' meetings. However, all agreed upon the need of further improving the transparency. The Examination Board promised to try to indicate in the Examiners' report, by way of examples, what would have been a false approach to a paper.

The Council is invited to take note of the content of these four last items.

epi looks for tutors

Der *epi*-Ausschuss für berufliche Qualifikation sucht Tutoren für die *epi*-Tutorien zur Vorbereitung auf die Europäische Eignungsprüfung.

Alle *epi*-Mitglieder, die zur Mitarbeit bereit sind, werden gebeten, sich an das *epi*-Sekretariat zu wenden.

The *epi* Professional Qualifications Committee is looking for tutors for the *epi* tutorials preparing for the European Qualifying Examination.

All *epi* members willing to collaborate are requested to contact the *epi* Secretariat.

La Commission de Qualification Professionnelle de l'*epi* recherche des tuteurs pour le tutorat de l'*epi* préparant à l'examen de qualification.

Les membres de l'*epi* intéressés sont invités à se mettre en rapport avec le Secrétariat de l'*epi*.

epi Secretariat

Tal 29

D-80331 München

Tel: +49 89 201 70 80

Fax: +49 89 202 15 48

e-mail: info@patentepi.com

Redaktionsschluss für epi Information 3/2001

Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **14. August 2001**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

Deadline for *epi* Information 3/2001

Our deadline for the next issue of *epi* Information is **14 August 2001**. Documents for publication should have reached the Secretariat by this date.

Date limite pour *epi* Information 3/2001

La date limite de remise des documents pour le prochain numéro de *epi* Information est le **14 août 2001**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Code of Professional Conduct

The Court of First Instance of the European Communities on March 28, 2001 has taken a decision in the *epi's* application for annulment of the Commission Decision 1999/267/EC.
(For details see: www.curia.eu.int/jurisp/index.htm (Case T-144/99)).

The Court

1. Annuls Article 1 of Commission Decision 1999/267/EC of 7 April 1999 relating to a proceeding pursuant to Article 85 of the EC treaty (IV/36147 *epi* Code of Conduct) in so far as it concerns Article 2(b)(3) and Article 5(c) of the Code of Conduct of the Institute of Professional representatives before the European Patent Office;
 2. Dismisses the remainder of the application;
 3. Orders the parties to bear their own costs, including those incurred in the interlocutory procedure.
- As a result of the Decision of the Court of First Instance Arts. 2(b)(3) and Article 5(c) of the Code of Conduct are reinstated.

The Council of the *epi* in its ordinary meeting on May 8, 2001 decided that the Decision should not be appealed and that the paragraphs of Article 2 of the Code of Conduct will be renumbered.

The Code of Conduct as of May 8, 2001 has the following wording:

Richtlinien des Instituts der beim Europäischen Patentamt zugelassenen Vertreter für die Berufsausübung

Diese Richtlinien dienen zur Regelung des Verhaltens und anderer Tätigkeiten der Mitglieder insoweit, als diese Tätigkeiten sich auf das Übereinkommen über die Erteilung europäischer Patente (Europäisches Patentübereinkommen) unterzeichnet in München am 5. Oktober 1973, oder dessen etwaige abgeänderte Fassungen beziehen.

In diesen Richtlinien sind die folgenden Definitionen anwendbar:

„Institut“
bedeutet das Institut der beim Europäischen Patentamt zugelassenen Vertreter;

„Mitglied“
bedeutet ein Mitglied dieses Institutes;

„Übereinkommen“
bedeutet das Europäische Patentübereinkommen;

„Rat“
bedeutet der Rat des Institutes;

„Mandant“
bedeutet jede natürliche oder juristische Person, die von einem Mitglied eine Beratung entgegennimmt oder Dienste erbittet;

„Disziplinarorgane“
bedeutet die in Artikel 5 der Vorschriften in Disziplinarangelegenheiten aufgeführten Organe;

„Disziplinarrat“
bedeutet den in Artikel 5 der Vorschriften in Disziplinarangelegenheiten aufgeführten Rat.

1. Allgemeines

a) Die allgemeinen Anforderungen an Mitglieder des Institutes sind in den Vorschriften in Disziplinarangelegenheiten niedergelegt.

Code of Conduct of the Institute of Professional Representatives before the European Patent Office

This Code is to govern the conduct and other activities of the members insofar as such activities are related to the Convention on the Grant of European Patents (European Patent Convention) signed in Munich on 5 October 1973, as may be amended from time to time.

In this Code, the following definitions are applicable:

„Institute“
means the Institute of Professional Representatives before the European Patent Office;

„Member“
means a member of this Institute;

„Convention“
means the European Patent Convention;

„Council“
means the Council of the Institute;

„Client“
means any natural person or legal entity who takes advice or asks services of a Member;

„Disciplinary Bodies“
means those listed in Article 5 of the Disciplinary Regulation;

„Disciplinary Committee“
means the Committee listed in Article 5 of the Disciplinary Regulation.

1. General

a) The general requirements for members of the Institute are laid down in the Disciplinary Regulation.

Code de conduite professionnelle concernant les membres de l'Institut des mandataires agréés près l'Office européen des brevets

Ce Code a pour objet de régir la conduite et les autres activités des membres, pour autant que de telles activités ont un rapport avec la Convention sur la délivrance de Brevets Européens (Convention sur le Brevet Européen) signée à Munich le 5 octobre 1973, et telle qu'elle peut être révisée de temps en temps.

Dans ce Code, les définitions suivantes sont applicables:

„Institut“
signifie l'Institut des Mandataires Agréés près l'Office Européen des Brevets;

„Membre“
signifie un membre de cet Institut;

„Convention“
signifie la Convention sur le Brevet Européen;

„Conseil“
signifie le Conseil de l'Institut;

„Client“
signifie toute personne physique ou morale qui prend avis ou utilise les services d'un Membre;

„Instances disciplinaires“
signifie celles énumérées à l'article 5 du Règlement en matière de discipline;

„Commission de discipline“
signifie la Commission mentionnée à l'article 5 du Règlement en matière de discipline.

1. Généralités

a) Les obligations générales des membres de l'Institut sont fixées par le Règlement en matière de discipline.

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| <p>b) Die allgemeinen Grundsätze des beruflichen Verhaltens sind in diesen Richtlinien niedergelegt, die die gegenwärtigen Ansichten des Rates wiedergeben. Kein Mitglied wird durch diese Richtlinien von seiner Verantwortung entbunden, die in den Vorschriften in Disziplinarangelegenheiten in den Artikeln 1, 2 und 3 enthaltenen beruflichen Regeln zu befolgen.</p> | <p>b) The general principles of professional conduct are laid down in this Code, which reflects the present views of the Council. A member is not released by this Code from his own responsibility to comply with the Rules of Professional Conduct set out in the Disciplinary Regulation in Articles 1, 2 and 3.</p> | <p>b) Les principes généraux de conduite professionnelle sont fixés dans le présent Code, qui reflète les vues actuelles du Conseil. Ce Code ne dégage pas un membre de sa propre responsabilité de respecter les Règles de Conduite Professionnelle fixées dans le Règlement en matière de discipline, en ses articles 1, 2 et 3.</p> |
| <p>c) Die grundsätzliche Aufgabe eines Mitgliedes ist es, den an Patentangelegenheiten interessierten Personen als zuverlässiger Berater zu dienen. Er sollte als unabhängiger Berater dadurch wirken, daß er den Interessen seiner Mandanten vorurteilsfrei und ohne Berücksichtigung seiner persönlichen Gefühle oder Interessen dient.</p> | <p>c) The basic task of a member is to serve as a reliable adviser to persons interested in patent matters. He should act as an independent counsellor by serving the interests of his clients in an unbiased manner without regard to his personal feelings or interests.</p> | <p>c) Le devoir fondamental d'un membre est d'agir en donnant des avis dignes de confiance aux personnes s'intéressant aux questions des brevets. Il doit agir comme un conseiller indépendant en servant les intérêts de ses clients d'une façon impartiale, sans tenir compte de ses sentiments et intérêts personnels.</p> |
| <p>d) Ein Mitglied soll Maßnahmen treffen zur Sicherung der Interessen seiner Mandanten für den Fall, daß es an der Ausübung seines Berufs gehindert ist.</p> | <p>d) A member shall take measures to safeguard his client's interests in the event he would be prevented from exercising his profession.</p> | <p>d) Un membre prendra des mesures pour sauvegarder les intérêts de ses clients pour le cas où il serait empêché d'exercer ses fonctions.</p> |
| <p>e) Gute Kollegialität zwischen den Mitgliedern ist eine Notwendigkeit für die Wahrung des Ansehens des Berufsstandes und sollte ohne Rücksicht auf persönliche Gefühle geübt werden.</p> | <p>e) Good fellowship among members is a necessity for preserving the reputation of the profession and should be exercised irrespective of personal feelings.</p> | <p>e) Une bonne confraternité parmi les Membres est nécessaire pour préserver le renom de la profession et doit s'exercer indépendamment de sentiments personnels.</p> |
| <p>f) Jedes Mitglied soll diese Richtlinien kennen und kann sich nicht mit deren Unkenntnis entschuldigen.</p> | <p>f) Each member should know of the Code and cannot plead ignorance of it.</p> | <p>f) Chaque membre doit connaître ce Code et ne doit pas alléguer qu'il l'ignorait.</p> |
| <p>g) Ein Verstoß gegen diese Richtlinien kann nicht mit Instruktionen durch einen Mandanten gerechtfertigt werden.</p> | <p>g) A breach of this Code cannot be justified by referring to instructions from a client.</p> | <p>g) Une infraction au Code ne peut être justifiée par son auteur en se référant aux instructions d'un client.</p> |

2. Werbung

a) Werbung ist im allgemeinen erlaubt, soweit sie wahrheitsgemäß und sachlich ist, und mit wesentlichen Grundsätzen, insbesondere der Redlichkeit und der Achtung des Berufsgeheimnisses, in Übereinstimmung steht.

b) Von der erlaubten Werbung sind ausgenommen:

1) Angaben zur Person eines Mandanten, es sei denn, der Mandant willigt hierin ausdrücklich ein;

2) die Angabe des Namens anderer Berufsangehöriger, es sei denn, es besteht eine schriftliche Vereinbarung über die Zusammenarbeit zwischen dem Mitglied und diesem Berufsangehörigen;

3) das Anzeigen, Ankündigen oder Veröffentlichenden von Angeboten betreffend den Kauf, Verkauf oder die Vermittlung von gewerblichen Schutzrechten, es sei denn auf Instruktionen eines Mandanten.

3. Beziehungen zur Öffentlichkeit

a) Ein Mitglied soll den guten Ruf dieses Institutes, seiner Mitglieder und der Praxis der Vertretung vor dem Europäischen Patentamt hochhalten.

b) Ein Mitglied soll an Büroräumen, auf Drucksachen oder anderweitig keinerlei Angaben machen, die die Öffentlichkeit irreführen.

c) Ein Mitglied soll Dritten keine Provision für die Vermittlung von Arbeit geben, dies erstreckt sich jedoch nicht auf den teilweisen oder vollständigen

2. Advertisements

a) Advertising is generally permitted provided that it is true and objective and conforms with basic principles such as integrity and compliance with professional secrecy.

b) The following are exceptions to permitted advertising:

1) the identification of a client without the express authorisation of that client;

2) the mention of the name of another professional entity unless there is a written cooperation agreement between the member and that entity;

3) the advertisement, announcement or publishing of offers to buy, sell or negotiate industrial property rights, except upon the instructions of a client.

3. Relations with the Public

a) A member shall uphold the public reputation of the Institute, of its members and of the practice of representation before the European Patent Office.

b) A member shall not give any indication on office premises, stationery or otherwise which is misleading to the public.

c) A member shall not give any commission to others for the introduction of business, but this

2. Publicité

a) La publicité est généralement autorisée, pour autant qu'elle soit véridique, objective et conforme aux principes essentiels notamment la loyauté et le respect du secret professionnel.

b) Des exceptions à la publicité autorisée sont:

1) la mention de l'identité d'un client, sauf autorisation expresse dudit client;

2) la mention du nom d'une autre entité professionnelle à moins qu'il existe un accord de collaboration écrite entre le membre et cette entité;

3) la publicité, l'annonce ou la publication d'offres d'achat, vente ou négociation de droits de propriété industrielle, sauf sur instructions d'un client.

3. Rapports avec le public

a) Un membre doit maintenir le bon renom de l'Institut, de ses membres et de l'exercice de la représentation devant l'Office européen des brevets.

b) Sur les lieux de ses bureaux, sur son papier à lettres et autres articles de papeterie, ou autrement, un membre ne doit donner aucune indication qui puisse induire le public en erreur.

c) Un membre ne doit pas donner de commission à des tiers pour la transmission de travaux, mais cette clause ne s'étend pas à l'acquisition par-

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| <p>gen Erwerb einer anderen Patentvertretungspraxis.</p> <p>d) Ein Mitglied soll berufliche Tätigkeiten im Zusammenhang mit dem Europäischen Patentamt durch ein Nichtmitglied unter seinem Namen oder dem Namen eines Zusammenschlusses ohne angemessene Beaufsichtigung nicht gestatten.</p> <p>e) Soweit es die Ausübung seines Berufs betrifft, ist ein Mitglied für die Handlungen seiner Gehilfen, die Nichtmitglieder sind, verantwortlich.</p> | <p>does not extend to the acquisition in part or whole of another patent agency practice.</p> <p>d) A member shall not permit without adequate supervision professional activities related to the European Patent Office under his name or the name of his association by a person who is not a member.</p> <p>e) As far as the exercise of his profession is concerned, a member is responsible for the acts of non-member assistants.</p> | <p>tielle ou totale de la clientèle d'un autre cabinet de brevets.</p> <p>d) Un membre ne doit pas permettre, sans contrôle adéquat, à une personne qui n'est pas membre, d'exercer au nom de ce membre, ou au nom du groupement auquel il appartient, des activités professionnelles ayant un rapport avec l'Office Européen des brevets.</p> <p>e) En ce qui concerne l'exercice de sa profession, un membre est responsable des actes de ses collaborateurs non-membres.</p> |
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4. Beziehungen zu Mandanten

a) Ein Mitglied soll auf die ihm von seinen Mandanten anvertrauten Angelegenheiten jederzeit angemessene Mühe, Aufmerksamkeit und Sachkenntnis verwenden. Ein Mitglied soll die Mandanten über den Stand ihrer Angelegenheiten informiert halten.

b) Grundsätzlich ist ein Mitglied nicht verpflichtet, den Interessen eines Mandanten in Angelegenheiten zu dienen, die nicht mit beruflichen Angelegenheiten verbunden sind, die der Mandant dem Mitglied anvertraut hat.

c) Ein Mitglied darf von einem Mandanten Vorschüsse verlangen.

d) Zusätzlich zu den Anforderungen von Artikel 3 (2) der Vorschriften in Disziplinarangelegenheiten soll ein Mitglied einen Auftrag ablehnen, der im Widerstreit mit seinen eigenen Interessen steht. Wenn in solchen Fällen der Auftrag nicht aufgeschoben werden kann, ohne daß möglicherweise dem Mandanten Schaden entsteht, soll ein Mitglied den Auftrag annehmen und ausführen, soweit dies unmittelbar notwendig ist, um diesen möglichen Schaden zu verhindern, und danach die Angelegenheit niederlegen.

e) Ein Mitglied soll nicht ein finanzielles Interesse an irgendeinem gewerblichen Schutzrecht unter solchen Umständen erwerben, die zu einem Widerstreit zwischen Berufspflichten und Interesse führen. Er soll keine Honorare in Rechnung stellen, die unmittelbar vom Ergebnis der von ihm besorgten Dienste abhängen.

f) Zusätzlich zu Artikeln 2 und 3 der Vorschriften in Disziplinarangelegenheiten soll ein Mitglied keinerlei Handlungen gegen eine bestimmte Angelegenheit vornehmen, die von dem Mitglied oder von einer anderen Person in seinem Büro bearbeitet wird oder bearbeitet wurde, es sei denn, daß der Mandant in dieser Angelegenheit mit der Handlung einverstanden ist oder daß dieses Mitglied keine Kenntnis von dieser Angelegenheit hat und nicht mehr in der Lage ist, von dieser Angelegenheit Kenntnis zu nehmen. Es ist diesem Mitglied nicht gestattet, bei einer solchen Handlung Informationen zu verwenden, die erhalten wurden, als die Angelegenheit früher bearbeitet wurde, es sei denn, daß diese Information öffentlich ist.

g) Ein Mitglied wird automatisch von seiner Verschwiegenheitspflicht gemäß Artikel 2 der Vorschriften in Disziplinarangelegenheiten entbunden, wenn die geheimen Informationen öffentlich geworden sind.

4. Relations with Clients

a) A member shall at all times give adequate care and attention and apply the necessary expertise to work entrusted to him by clients. A Member shall keep clients informed of the status of their cases.

b) In principle, a Member does not need to serve the interests of a client in matters not connected with professional work entrusted to him by the client.

c) A member may demand advance payments from a client.

d) In addition to the requirements of Article 3(2) of the Disciplinary Regulation, a member shall decline an order which is in conflict with his own interests. In all such cases, if the order cannot be postponed without possible damage to the client, a member shall accept and perform the order so far as immediately necessary to avoid such possible damage: thereafter he shall resign from the case.

e) A Member must not acquire a financial interest in any industrial right in such circumstances as to give rise to a conflict between professional duty and interest. He must not charge an attorney fee directly related to the outcome of the services he provides.

f) Supplementary to Articles 2 and 3 of the Disciplinary Regulation, a member shall not take any action against a particular matter which is being handled or has been handled by the Member or another person in his office, unless the client in the matter agrees to this action or unless the Member has no cognizance of the matter and is no longer in a position to take cognizance of it. The Member is not permitted to make use in the action of information obtained during the time the matter was previously handled, unless the information is public.

g) A member is automatically released from his secrecy obligation according to Article 2 of the Disciplinary Regulation if the secret information becomes published.

4. Rapports avec les clients

a) Un membre doit, à tout moment, consacrer le soin et l'attention convenables à tout travail qui lui est confié par des clients, et faire preuve de la compétence nécessaire dans ce travail. Un membre doit tenir ses clients informés de l'état de leurs dossiers.

b) En principe, un membre n'est pas tenu de servir les intérêts d'un client dans des affaires sans relation avec le travail professionnel qui lui a été confié par un tel client.

c) Un membre a le droit de demander des provisions à un client.

d) En plus des exigences de l'Article 3(2) du Règlement en matière de discipline, un membre doit décliner un ordre qui entre en conflit avec ses intérêts propres. Dans tous les cas de ce genre, si l'ordre ne peut être différé sans dommage éventuel pour le client, le membre doit accepter et exécuter l'ordre dans la limite de ce qui est immédiatement nécessaire pour éviter un tel dommage éventuel; ensuite il se démettra du dossier.

e) Un membre ne doit pas acquérir d'intérêt financier dans un droit de propriété industrielle quelconque, dans des circonstances propres à donner naissance à un conflit entre ses obligations professionnelles et son intérêt. Il ne demandera pas d'honoraires en relation directe avec le résultat des services qu'il fournit.

f) En complément aux articles 2 et 3 du Règlement en matière de discipline, un membre ne doit engager aucune action contre une affaire particulière qui est en cours de traitement ou qui a été traitée par un tel membre ou par une autre personne de son bureau, à moins que le client concerné par cette affaire ne soit d'accord sur cette action ou à moins que ce membre n'ait pas connaissance de l'affaire en question, et ne soit plus en mesure d'en prendre connaissance. Le membre n'est pas autorisé à utiliser au cours de l'action des informations obtenues pendant la période où l'affaire avait été antérieurement traitée, à moins que ces informations ne soient publiques.

g) Un membre est automatiquement libéré de son obligation de secret selon l'article 2 du Règlement en matière de discipline, si les informations secrètes sont devenues publiques.

5. Beziehungen zu anderen Mitgliedern

a) Ein Mitglied hat gegenüber den anderen Mitgliedern gute Kollegialität zu wahren. Darunter versteht sich ein höflicher Umgang sowie die Tatsache, daß ein Mitglied sich über ein anderes Mitglied nicht in unhöflicher oder verletzender Weise äußern soll. Beschwerden gegenüber einem anderen Mitglied sind erst mit ihm persönlich, entweder direkt oder durch die Vermittlung eines dritten Mitglieds, zu erörtern, danach notwendigenfalls auf den durch dieses Institut vorgeschriebenen Wegen unter Einhaltung der Regeln in Disziplinarangelegenheiten vorzubringen.

b) Da ein vorrangiges Interesse des Institutes in der Aufrechterhaltung eines einheitlichen Berufsstandes liegt, soll kein Mitglied eine Diskriminierung zwischen Mitgliedern, insbesondere im Hinblick auf Sprache oder Nationalität, ausüben oder fördern.

c) Über eine Angelegenheit, von der ein Mitglied weiß oder vermutet, daß sie von einem anderen Mitglied bearbeitet wird oder bearbeitet worden ist, hat das Mitglied dem Mandanten gegenüber jede Meinungsäußerung in dieser Angelegenheit zu unterlassen, es sei denn, daß der Mandant wünscht, eine unabhängige Meinung zu erhalten oder seinen Vertreter zu wechseln. Das Mitglied darf das andere Mitglied nur dann informieren, wenn der Mandant zustimmt.

d) Wenn ein Mitglied von einem Mandanten einen Auftrag erhält, die Bearbeitung einer Angelegenheit von einem anderen Mitglied zu übernehmen, darf das beauftragte Mitglied diesen Auftrag annehmen, muß dann aber sicherstellen, daß das andere Mitglied davon Kenntnis erhält. Das andere Mitglied ist verpflichtet, alle für die Bearbeitung der Angelegenheit erforderlichen Schriftstücke ohne Verzögerung dem neuen Vertreter auszuleihen oder zu übergeben oder in Kopien zu angemessenem Kosten zur Verfügung zu stellen.

6. Beziehungen zum Europäischen Patentamt

Im Verkehr mit dem Europäischen Patentamt und seinen Bediensteten soll ein Mitglied höflich handeln und soll alles, was möglich ist, tun, um den guten Ruf dieses Institutes und seiner Mitglieder hochzuhalten.

7. Beziehungen zum Institut

a) Die Mitglieder haben das Institut über ihre Zustellschrift informiert zu halten, an die ihnen vom Institut Korrespondenz und andere Informationen zugesandt werden sollen. Jede Änderung dieser Anschrift muß dem Generalsekretär unverzüglich mitgeteilt werden.

b) Die Mitglieder haben den gemäß Artikel 6 der Vorschriften über die Errichtung des Institutes zu entrichtenden Jahresbeitrag entsprechenden vom Rat festgelegten und mitgeteilten Anordnungen zu zahlen.

Wenn ein Mitglied den Jahresbeitrag nicht entsprechend den Anordnungen zahlt, kann die Angelegenheit vom Schatzmeister dem Disziplinarrat vorgelegt werden.

5. Relationship with other Members

a) A member must observe good fellowship towards other members, and this includes courtesy and the fact that a member may not speak of another member in discourteous or offensive terms. Grievances in respect of another member should first be discussed in private with the other member, either directly or through a third member, and then if necessary through the official channels prescribed by the Institute and in the disciplinary Regulation.

b) Since a prime interest of the Institute is to maintain a unified profession, no member must exercise or promote discrimination between members, for example on grounds of language or nationality.

c) A Member shall avoid any exchange of views about a specific case, which he knows or suspects is or was being handled by another Member, with the client of the case, unless the client declares his wish to have an independent view or to change his representative. The Member may inform the other Member only if the client agrees.

d) Where a member is instructed by a client to take over the handling of a case from another member, the Member so instructed is free to accept such instruction but then shall ensure that the other member is informed. Such other member shall without delay, loan or transfer all documents necessary for the handling of the case or provide copies at reasonable expense to the new representative.

6. Relationship with the European Patent Office

In all dealings with the European Patent Office and its employees, a member shall act courteously, and shall do everything possible to uphold the good reputation of this Institute and its Members.

7. Relationship with the Institute

a) Members must keep the Institute informed of their address to which correspondence and other information from the Institute are to be sent. Changes of address must be notified to the Secretary-General without delay.

b) Members must pay, in accordance with arrangements laid down and notified by the Council, the annual subscription required by Article 6 of the Regulation on the establishment of the Institute.

If a member fails to pay the subscription as required by the arrangements, the matter may be referred by the Treasurer to the Disciplinary Committee.

5. Rapports avec les autres Membres

a) Un membre doit observer une bonne confraternité envers les autres, ce qui sous-entend la courtoisie et le fait qu'un membre ne doit pas parler d'un autre membre en termes discourtois ou blessants. Les griefs à l'égard d'un autre membre doivent d'abord être débattus en privé avec cet autre membre, soit directement, soit par l'intermédiaire d'un troisième membre, et ensuite si nécessaire, par intermédiaire des voies officielles prescrites par cet Institut et dans le règlement en matière de discipline.

b) Etant donné que l'un des principaux intérêts de l'Institut est de maintenir une profession unifiée, aucun membre n'exercera ou ne favorisera de discrimination entre les membres en raison notamment de sa langue et de sa nationalité.

c) Un Membre doit éviter tout échange de vues sur un cas spécifique qu'il sait, ou soupçonne, être ou avoir été traité par un autre Membre, avec le client d'un tel cas, à moins que le client ne fasse état de son désir d'obtenir un avis indépendant, ou de changer de mandataire. Le Membre peut informer l'autre Membre seulement si le client est d'accord.

d) Quand un membre reçoit d'un client des instructions aux fins de prendre en charge un cas provenant d'un autre membre, le membre qui reçoit les instructions est libre d'accepter ces instructions mais doit alors s'assurer que l'autre membre est informé. Cet autre membre est obligé, sans délai, de communiquer ou de transférer tous les documents nécessaires au traitement de ce cas ou en fournir des copies au nouveau mandataire, à un prix raisonnable.

6. Rapports avec l'Office européen des brevets

Dans tous les rapports avec l'Office européen des brevets et ses employés, un membre doit agir de façon courtoise, et faire tout son possible pour maintenir le renom de l'Institut et de ses membres.

7. Rapports avec l'Institut

a) Les membres sont tenus d'aviser l'Institut de l'adresse à laquelle toute correspondance ou communication de l'Institut doit leur être transmise. Tout changement d'adresse devra être notifié sans délai au Secrétaire Général.

b) La cotisation annuelle requise à l'article 6 du Règlement de création doit être payée par les membres, conformément aux dispositions fixées et notifiées par le Conseil.

Si un membre ne paie pas sa cotisation conformément auxdites dispositions, le Trésorier peut porter l'affaire devant la Commission de Discipline.

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| <p>c) Kein Mitglied darf ohne Genehmigung durch den Präsidenten des Institutes irgendwelche schriftlichen oder mündlichen Mitteilungen im Namen des Institutes abgeben.</p> <p>d) Ein Mitglied hat das Recht, durch den Generalsekretär um eine Meinungsäußerung zu ersuchen, ob irgendeine Handlung, die es vorschlägt oder billigt, aufgrund dieser Richtlinien zulässig ist. Diese Meinungsäußerung ist für die Disziplinarorgane nicht verbindlich.</p> <p>e) Unbeschadet der Bestimmungen in Artikel 5b sollten Verstöße gegen diese Richtlinien schriftlich dem Disziplinarrat zur Kenntnis gebracht werden.</p> | <p>c) No member may, unless authorised by the President of the Institute, make any written or oral communication on behalf of the Institute.</p> <p>d) A member has the right to seek through the Secretary-General an opinion on the permissibility, under this Code, of any act the member proposes to do or sanction. Such opinion shall not be binding on the Disciplinary Bodies.</p> <p>e) Except as provided in paragraph 5b), breaches of the Code should be brought to the notice of the Disciplinary Committee in writing.</p> | <p>c) A moins d'y être autorisé par le Président de l'Institut, aucun membre ne peut faire, au nom de l'Institut, une communication écrite ou orale, quelle qu'elle soit.</p> <p>d) Un membre a le droit de solliciter par l'intermédiaire du Secrétaire Général un avis sur le caractère licite, selon ce Code, de toute action que ce membre propose d'entreprendre ou de sanctionner. Un tel avis ne lie pas les instances disciplinaires.</p> <p>e) A l'exception de ce qui est prévu au paragraphe 5b ci-dessus, les infractions à ce Code doivent être portées par écrit à la connaissance de la Commission de discipline.</p> |
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Beschlossen vom Rat des Instituts am 13.11.1979, Brüssel;
ergänzt am 5.11.1985, München;
geändert am 7.05.1996, Dublin;
geändert am 3.10.1997, Straßburg;
geändert am 8.05.2001, Madrid.

Decided by the Council of the Institute on 13.11.1979, Brussels;
supplemented on 5.11.1985, Munich;
amended on 7.05.1996, Dublin;
amended on 3.10.1997, Strasbourg;
amended on 8.05.2001, Madrid.

Décidé par le Conseil de l'Institut le 13.11.1979, Bruxelles;
complété le 5.11.1985, Munich;
modifié le 7.05.1996, Dublin;
modifié le 3.10.1997, Strassbourg;
modifié le 8.05.2001, Madrid.

Décision de la Commission de Discipline de l'Institut des Mandataires Agréés près l'Office européen des brevets

XXX contre YYY
Cas disciplinaire CD 2/00

Langue: Français

Décision

La Chambre décide de rejeter la plainte déposée par XXX contre YYY.

Motifs de la décision

Cette affaire concerne les relations existant entre deux mandataires agréés qui sont membres de la même société, l'un étant le supérieur hiérarchique de l'autre.

La Commission de Discipline est d'avis qu'elle ne peut pas intervenir dans les relations existant entre un employé et sa hiérarchie.

En effet, le Code de Conduite Professionnelle concernant les membres de l'Institut des Mandataires Agréés près l'Office européen des brevets et le Règlement en matière de Discipline des Mandataires Agréés ne peut pas s'appliquer à une situation interne à une société.

En outre, un tel conflit interne n'est pas susceptible d'affecter „le renom de la profession“ [Code 1.e)] ou „de compromettre la confiance que l'on doit pouvoir accorder à la profession [Règlement article 1(2)]“.

En fait, le conflit entre XXX et son ancien supérieur hiérarchique YYY s'inscrit dans le contexte le plus général des relations d'un employé avec son ancienne société (employeur) et relève donc du Code National du Travail

Membres de la Chambre:

M. J. Waxweiler: Président
M. J.J. Kédinger: Rapporteur
M. V. Gil-Vega: Membre
M. G. Leherte: Membre Adjoint

et, par conséquent, est de la compétence des Prud'Hommes.

Publication de la décision

Conformément à l'article 20 du Règlement de Procédure Additonnelle de la Commission de Discipline des Mandataires Agréés près l'Office européen des brevets, la Chambre recommande au Président du Conseil de l'Institut de communiquer intégralement ou partiellement cette décision aux membres de l'Institut ou de publier cette décision sans toutefois révéler l'identité du mandataire agréé concerné et du plaignant, à moins qu'ils ne consentent à être nommés.

Conformément à l'article 21 du Règlement en matière de Discipline des Mandataires Agréés et de l'article 19(1) du Règlement de Procédure Additonnelle susmentionnés, le plaignant et le mandataire agréé seront informés du résultat de la procédure en leur adressant une copie de la décision.

23 avril 2001

Le Président de la Chambre
Jean Waxweiler

Electronic documents within the epi

With the development of the size and the role of our international organisation, particularly with the entry of new countries into the EPC system, it has become even more important for *epi* to ensure a quick and convenient distribution of information to its members.

Strenuous efforts have already been made to enhance the access to information in an effective and rapid manner, particularly with the increased use of electronic-mail and the development of the *epi* web site.

Additional efforts must still be made to improve the uniformity of the information made available. Such uniformity will be at least partially achieved by the generalisation of the provision of all electronic documents being particularly formatted in the standard ADOBE ACROBAT format (also known as the „pdf“ file).

As was announced by the General Secretary at the 50th Council meeting, the *epi* secretariat will use this type of electronic document more and more. Pdf documents have been shown to be insensitive to viruses and their use ensures uniformity in the presentation of the information, whatever the actual configuration of the computer of the *epi* member.

It could be useful for *epi* members to bear in mind that, although the ADOBE ACROBAT software is a commercial product, two different versions are currently provided

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The „writer“ software is provided under a commercial licence agreement by ADOBE, and allows the licensee to create his or her own pdf files. The *epi* secretariat is getting such a licence so as to convert the different documents which are received from the different sources of information of the *epi* (Committees, Board, *epi* members etc/u) and facilitate their subsequent transmission via the Internet network.

There is no doubt that this additional measure will, in addition to the existing issuance of *epi* information, help to promote the voice of the *epi* throughout the membership.

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Design Patent Protection in the United States

J. Hamilton, O. Poulin, P. Signore, and C. Ward¹ (USA)

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I. INTRODUCTION

It is well known that impressionists were attracted to and inspired by the industrial objects that appeared in their world during the second half of the 19th century. For example, Monet's and Caillebotte's representations of Argenteuil's local distillery with its smoking chimneys and of iron railroad bridges over the Seine, are now celebrated works of arts. These artists recognized the esthetic value of these constructions' shapes and geometries, these constructions whose *raison d'etre* was purely functional. About a century later, Andy Warhol and his pop art focused on the artistic values of objects such as soup cans, knives, guns, and money.

The field of Intellectual Property also recognizes the value of the appearance of functional objects. In the United States, this recognition is embodied in the design patent system. Unfortunately, too many patent practitioners, who are busy obtaining utility patent protection for their clients' useful inventions, forget about design patent protection and leave unprotected the valuable appearance of their clients' work. This article intends to review the U.S. design patent system. As will be seen, U.S. design patents and U.S. utility patents share many of the same laws. Section II addresses the basic requirements for obtaining a design patent. One important point to retain from that section is that, although ornamentality is a requirement, the functionality of an invention does not prohibit its protection by a design patent. Section III examines the various advantages associated with obtaining design patents. One central point from that section is that careful drafting of a design patent application can provide broad and strong protection.

¹ James Hamilton is a partner in the law firm of Oblon, Spivak, McClelland, Maier & Neustadt, P.C. and specializes in design patent protection and licensing agreements. Olivier Poulin has an LLM in intellectual property from the University of Strasbourg, France. Dr. Philippe Signore is a patent agent and Christopher Ward is an patent attorney in the electrical/mechanical practice group of Oblon, Spivak, McClelland, Maier & Neustadt, P.C.. The opinions expressed herein are solely those of the authors and do not represent those of Oblon, Spivak, McClelland, Maier & Neustadt, P.C..

II.REQUIREMENTS FOR DESIGN PATENTABILITY

The U.S. design patent statute, just like the U.S. utility patent statute, is found in Title 35 of the United States Code, and includes 35 USC 171-173. Specifically, 35 USC 171 states that:

Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for invention shall apply to patents for designs, except as otherwise provided.

The first part of section 171 imposes four requirements for design patentability: novelty, originality, ornamentality, and the subject matter must be an article of manufacture. The second part of section 171 implies that other requirements, which relate to utility patents, also apply. In particular, a design must be non-obvious. The following sub-sections discuss each of these five requirements. Other requirements for design patentability exist, for example compliance with 35 U.S.C. § 112, first and second paragraphs. These other requirements, which are related to the manner in which the design patent is applied for, rather than the design itself, are not addressed in this article but are discussed elsewhere.²

A. Article of Manufacture

According to section 171 the design to be patented must be „for an article of manufacture.“ An article of manufacture means a tangible object made by man. In other words, the patentable design must be embodied into, or applied to, a man-made tangible object. The patentable design cannot be a design or picture standing alone, i.e., in the abstract. Impressions, prints, or pictures applied to an article of manufacture, and the shape or configuration of an article of manufacture satisfy the article of

² Design Patents are discussed in detail in MPEP's Chapter 15.

manufacture requirement and are thus patentable as designs under 35 USC 171. As an interesting example, the court in *In re Hruby* held that a pattern of water for a water fountain was a design for an article of manufacture.³

Another interesting example of a patentable article of manufacture is a computer-generated icon shown on a computer screen. The icon itself is not patentable, but when claimed as an icon embodied on a computer screen, monitor, or other display panel, the combination of the icon and the display panel (or portion thereof) is patentable as a design under 35 USC 171.⁴

Importantly, 35 USC 171 does not limit design protection to a whole article of manufacture, but can be for a portion of an article of manufacture. This point was explained in *In re Zahn*, where the court held that the applicant could claim only the design for the shank portion of a drill bit without having to claim the entire drill bit.⁵ The *In re Zahn* court based its reasoning on the fact that 35 USC 171 applies to designs „for“ articles of manufactures and not „of“ articles of manufactures. As discussed further below in Section III-A, the possibility to claim only the design for a portion of an article of manufacture is useful to obtain a relatively broad protection.

B. Originality

Under 35 USC 171, a patentable design must be „original.“ The originality requirement bars issuance of a design patent for a design derived from any source or person other than the individuals named as inventors. The originality requirement excludes from patentability any simulation of known objects, persons, or naturally occurring forms. As professor Chisum explains:

The originality requirement protects the interest of the true inventor and the general public; it would be morally offensive to allow one to harvest what another has sown. The requirement bars a patent even if the true inventor does not complain or if the true inventor is not known, as for example, when a person discovers and imports for the first time into the United States a device in common use in a foreign country.⁶

On the other hand, a design can be original even if it is „the result of a reassembling or regrouping of familiar forms and decorations.“⁷ In a way, the originality requirement is related to the novelty and non-obviousness requirements since it is based on that which is already known, and thus on that which cannot be new.

C. Novelty

Under 35 USC 171, a patentable design must be „new.“ The second clause of 35 USC 171 also requires that the design patent satisfy the novelty and statutory bar provisions of 35 USC 102.⁸ The standard for evaluating the

novelty of a design is the „average observer test:“ the overall appearance of the design in the eyes of an average, or ordinary, observer must be different from the appearance of any other single prior design.⁹

There is therefore an important difference between the novelty of a design patent and that of a utility patent: the novelty of a design patent comes from the ornamentation of the claimed design while the novelty of a utility patent comes from the technical characteristics of the claimed invention. Therefore, an invention may be novel for design patentability purposes, yet lack novelty for utility patentability purposes, and vice versa. As a hypothetical example, an entirely pink soda can would be ornamentally different from a regular soda can, yet would lack structural novelty. A soda can made out of a room temperature superconductor would be structurally new over a known aluminum soda can, yet would lack novel ornamentation. Of course, a pink superconducting soda can would be novel and protectable by both a design patent and a utility patent.

D. Non-Obviousness

According to section 171, the provisions „relating to patents for inventions shall apply to patents for designs,“ which implies that a patentable design must be non-obvious under 35 USC 103. The courts have held that the proper standard to evaluate a design's non-obviousness under 35 USC 103 is whether „a designer of ordinary skill of the articles involved“ or other closely related object would have found the design as a whole obvious at the time the design was invented.¹⁰ The non-obviousness analysis for design patents therefore closely parallels the non-obviousness analysis for utility patents, which was outlined in the seminal Supreme Court case of *Graham v. John Deere Co.*,¹¹ except that the person of ordinary skill in the art is replaced by a designer of ordinary skill.

Another important aspect of design non-obviousness is that „the appearance of the design must be viewed as a whole, as shown by the drawing, or drawings, and compared with *something in existence* – not with something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature.“¹² A finding of obviousness requires „a reference to something in existence, the design characteristics of which are basically the same as the claimed design.“¹³ The emphasis is thus on the visual appearances of something in existence, not on design concepts. „When the patented design is a combination of selected elements in the prior art, a holding of obviousness requires that there be some teaching or suggestion whereby it would have been obvious to a

3 *In re Hruby*, 373 F.2d 997, 153 USPQ 61 (CCPA 1967).

4 See also MPEP § 1504.01(a) „Computer-Generated Icons.“

5 *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).

6 *Chisum on Patents*, Vol. 1, Section 2.01 (December 1999).

7 *American Fabrics Co. v. Richmond Lace Works*, 24 F.2d 365 (2nd Cir. 1928).

8 Note however that 35 USC 172 expressly alters Section 102(d)'s statutory bar by lowering the period to six months.

9 See *In re Bartlett*, 300 F.2d 942, 133 USPQ 204 (CCPA 1962 („The degree of difference required to establish novelty occurs when the average observer takes the new design for a different, and not a modified already-existing, design“).

10 See e.g. *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981); and *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982).

11 *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966).

12 *In re Jennings*, 182 F.2d 207, 86 USPQ 68, (CCPA 1950).

13 *In re Rosen* 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

designer of ordinary skill to make the particular selection and combination made by the patentee."¹⁴ The test for properly combining references in design cases, as distinguished from utility cases, is „not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that appearance of certain ornamental features in one would suggest the application of those features to the other."¹⁵

Finally, as for a utility-type non-obviousness analysis, evidence of secondary considerations, such as commercial success, can be presented to support a finding of design non-obviousness. However, „[t]o be of value, evidence of commercial success must clearly establish that the commercial success is attributable to the design, and not to some other factor, such as a better recognized brand name or improved function."¹⁶

E. Ornamentality

Under 35 USC 171, a patentable design must be „ornamental.” The exact meaning of „ornamental” in the context of design patents has been debated and the courts have used various definitions and criteria to determine the issue of ornamentality. Some courts have held that „ornamentality” requires at least that the design be esthetically pleasing, attractive, the product of „an artistic conception,”¹⁷ „embellished or adorned, or distinguished by its grace of symmetry of form.”¹⁸

However, the requirement of „ornamentality” is strongly related to the function of the article of manufacture. Specifically, „to qualify for design patent protection, a design must have an ornamental appearance that is not dictated by function alone.”¹⁹ In other words, „if a particular design is essential to the use of the article, it can not be the subject of a design patent. . . . When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose,”²⁰ and to be patentable under 35 USC 171.

It is therefore not enough that a design be esthetically pleasing: „The configuration and appearance of many articles of manufacture, though dictated by functional requirements, are often pleasing to look at. However, if the resulting configuration proceeds primarily from the necessity of functional or mechanical requirements, it is

not a valid design patent.”²¹ Consequently, it seems that „ornamental” means having an overall distinct appearance that is not dictated by the function of the article of manufacture. In other words, the shape or configuration of a functional object may be protectable by a design patent if the shape or configuration is not dictated by the function of the object.

In fact, it turns out that a great variety of articles of manufactures, which are typically protected by a utility patent, are also protectable by design patents because their overall appearance is not fully dictated by their utility. Indeed, the subjective inquiry of whether articles of manufactures are esthetically pleasing seems to have been pushed aside. Examples of patented designs for functional articles of manufactures include a power supply (U.S. D298,824), a telephone handset (U.S. D270,445), an engine (U.S. D416,265), a valve body (U.S. D433,730), a computer battery (U.S. D431,808), a magnetic head (U.S. D398,613), a front element for a magnetic tape cassette (U.S. D356,307), an optical disk cartridge (U.S. D371,548), connectors for printed circuit boards (U.S. D402,273 and D407,383), carrier elements for a semiconductor chip (D405,779, D406,821, and D406,822), various parts for semiconductor manufacturing devices (D401,250, D405,431, and D406,113), a nut (U.S. D433,319), a suitcase (U.S. D285,626) and a shoe insert (U.S. D385,393).²² In recent years, U.S. patent practitioners have witnessed a sharp increase in the number of design patent applications filed on such functional devices.

In fact, it is possible to obtain a utility patent and a design patent for a single article of manufacture as long as „the design patent includes ornamental features which go beyond and are patentable over the structural features as defined in the claims of the mechanical application.”²³ For example, a utility patent and a design patent have been granted on a „flow promoter,” which is a device attached to the base of a storage container and configured to promote flow of material from the container.²⁴ As stated by the CCPA, „patent laws, of course, provide that a design patent and a utility patent may well be issued on the same construction. . . . However, each such patent must claim a separate, distinct patentable invention.”²⁵

When evaluating the ornamentality of a design, it is important to keep in mind that there is a difference between the function of the design and the function of the article of manufacture embodying the design. As noted by the CAFC, „[t]he fact that the article of manufacture serves a function is a prerequisite of design

14 *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124, 25 USPQ2d 1913, 1917 (Fed. Cir. 1997).

15 *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956).

16 *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97, 109 (Fed. Cir. 1984). See also *Avia Group Int'l Inc. v. L.A. Gear Cal. Inc.*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988) („commercial success is relevant only if a nexus is proven between the success of the patented product and the merits of the claimed invention”).

17 *Wabern Packaging Indus., Inc. v. Cut Rate plastic Hangers, Inc.*, 652 F.2d 987, 210 USPQ 777 (2nd Cir. 1981).

18 *In re Stimpson*, 24 F.2d 1012 (D.C. Cir. 1928).

19 *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 US 141, 148, 9 USPQ2d 1847, 1851 (Fed. Cir. 1989).

20 *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed. Cir. 1997). See also *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 1566, 40 USPQ2d 1048, 1049-50 (Fed. Cir. 1996) („if the design claimed in a design patent is dictated solely by the function of the article of manufacture, the patent is invalid because the design is not ornamental. . . . A design is not dictated solely by its function when alternative designs for the article of manufacture are available”).

21 *Barofsky v. General Elec. Corp.*, 396 F.2d 340, 158 USPQ 178 (9th Cir. 1966).

22 These designs can be viewed on the USPTO web site at www.uspto.gov; „Searchable Databases,” „Patent Full-Text Databases with Full-Page Images,” „Patent Number Search”.

23 *In re Dubois*, 262 F.2d 88, 120 USPQ 198 (CCPA, 1958) (where the patentee obtained a utility patent and a design patent for a strap of a military uniform).

24 See *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983).

25 *Transmatic, Inc. v. Gulston Industries, Inc.*, 601 F.2d 904, 202 USPQ 559, (CCPA 1979) (where the patentee obtained a utility patent and a design patent for an interior lighting fixture).

patentability, not a defeat thereof. . . . The function of the article itself must not be confused with 'functionality' of the design of the article."²⁶

Importantly, the visibility of a design when the article of manufacture is in its normal use is not a requirement for design patentability. What is required is that "the article's design is a 'matter of concern' because of the nature of its visibility *at some point* between its manufacture or assembly and its ultimate use."²⁷ For example, a hip implant intended to be concealed once installed in the patient was deemed potentially ornamental because the implants were displayed in advertisements and at trade shows and because doctors could select implants based on their designs and not solely on their functional characteristics.²⁸ The USPTO now recognizes that the use of an object is "a period in the article's life, beginning after completion of manufacture or assembly and ending with the ultimate destruction, loss, or disappearance of the article. Although the period includes all commercial uses of the article prior to its ultimate destination, only the fact of specific cases will establish whether during that period the article's design can be observed in such a manner as to demonstrate its ornamentality."²⁹ For example, the USPTO's Board of Appeals has held that shotgun cartridge wads (the tampon portions between the powder and the bullet) were potentially ornamental based on the *In re Webb* decision and because there was evidence of record that the wads were sold in clear bags and that their appearance was "a critical factor in the marketplace."³⁰

III. ADVANTAGES OF OBTAINING A DESIGN PATENT

A. Relatively Broad Protection Is Available

1. The Test for Design Infringement and the Doctrine of Design Equivalents

As with utility patents, a design patent is only as valuable as the subject matter that it claims. Perhaps the most important consideration to keep in mind when preparing a design patent application is that the drawings define the scope of protection, so that great care should be taken in preparing the drawings. However, the accused design need not be identical to the drawings of the design patent in order to infringe the patented design. In the 1871 seminal case *Gorham v. White*,³¹ the Supreme Court stated the test for design patent infringement, still in use today:

We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer,

inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.³²

A second prong was added to the test for design patent infringement: "For a design patent to be infringed, no matter how similar two items look, 'the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.'"³³

Furthermore, as with utility patents, a doctrine of equivalents offers design patent owners some flexibility when proving that the accused device infringes their patented designs. This doctrine of design equivalents was also introduced by the *Gorham* Court:

Still, though variances in the ornament are discoverable, the question remains, is the effect of the whole design substantially the same? Is the adornment in the [accused] design used instrumentally to produce an appearance, a distinct device, or does it work the same result in the same way, and is it, therefore, a colorable evasion of the patent, amounting at most to a mere equivalent? In regard to this we have little doubt, in view of the evidence. Both the White designs we think are proved to be infringements of the *Gorham* patent.³⁴

"Federal courts . . . have given a very equitable range of equivalents to design patent claims over the years, in part because of the very reason that patent attorneys preparing design patent applications are not omniscient and cannot foresee the infringer's exact embodiment of the product."³⁵

2. Filing Strategies

The field of design patent includes a number of unique nuances that the applicant must be aware of in order to take full advantage of design patent protection. Useful strategies for obtaining broad design patent protection were presented by Karl G. Hanson in an article entitled "Intellectual Property Strategies for Protecting the Looks of A New Product" and are summarized in this subsection.³⁶

A first step is to identify the broad, generic embodiments and the stylistic or species embodiments of the invention by identifying the feature, or combination of features, distinguishing the invention aesthetically from other designs or what feature or combination of features will induce a consumer to purchase this product.

Next comes the preparation of the drawings, which are the most important aspect of a design patent application. Every line and every surface shading used in the initially filed drawings should be deliberate, with all extraneous and non-essential lines being removed or depicted only in broken lines, or "phantom lines," prior to filing of the design patent application. The courts and the USPTO recognize that portions of the drawings

26 *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 1460, 43 USPQ2d 18871890 (Fed. Cir. 1997)

27 *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990) (emphasis added).

28 *Id.*

29 *Ex Parte Cole* 18 USPQ2D 1175 (BPAI 1990).

30 *Id.*

31 *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871).

32 *Id.* at 528.

33 *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444, 221 USPQ 97, (Fed. Cir. 1984) (citations omitted).

34 *Id.* at 530.

35 Saidman, "Design Patents – the Whipping Boy Bites Back", *JPTOS*, Vol. 73, no. 11, 859, 874, November 1991.

36 See Hanson, patent counsel for the 3M Company, "Intellectual Property Strategies for Protecting the Looks of A New Product," *JPTOS*, Dec. 1999.

drawn in phantom lines merely disclose the environment related to the claimed design and do not limit the scope of the claims.³⁷ On the other hand, the scope of the claims is defined by the portions of the drawings drawn in solid lines, so that each solid line can be viewed as a limitation that narrows the scope of the claim of the design patent. By only depicting in solid lines the feature or combination of features that are essential to the novelty of the embodiment, a relatively broad protection of the design can be secured.

Obviously, various generic embodiments may be depicted as alternative embodiments in a separate set of drawings, which include either other novel features of the invention or novel combinations of various features of the invention. Phantom lines should be used for all non-essential features of any given embodiment. Inherently narrow features, such as color, size, or texture, should only be included in the application if those features are novel and are intended to limit the scope of the application to include those features.

Once a decision has been reached as to which embodiments should be filed, a single design patent application can be prepared that includes both the generic embodiments and the stylistic or species embodiments of the invention. It has been the longstanding practice of the USPTO to limit design patent applications to a single claim. However, multiple embodiments of an invention are permissible for filing in a single patent application. Therefore, it may be desirable to file all of the various embodiments of an invention in a single application, if possible, particularly if the embodiments share at least some common design features. Of course, the design application may be subject to a restriction requirement if the Examiner determines that more than one invention is present within the application.

One benefit of filing the various embodiments in a single design patent application is that only one initial application filing fee will be required. Ideally, all of the embodiments will be examined on their merits by the Examiner. Upon receipt of the first Official Action on the merits, the applicant is in a good position to evaluate the patentability of each of the embodiments. At this point it may be advisable to permit the broadest claimed embodiment to issue by canceling all other embodiments and to file separate divisional applications on any of the other embodiments that are determined by the Examiner to have allowable subject matter. Any rejected embodiment could be prosecuted in a separate divisional application. It may be advisable to ensure that each design patent that issues only contains one embodiment, since the Federal Circuit has stated that a claim covering more than one embodiment may be rejected or found invalid if the prior art demonstrates the obviousness of any one of the embodiments.³⁸ Therefore, by splitting each embodiment into a separate patent, the applicant will ensure that the scope of the patents will not be

limited by the inclusion of alternative embodiments that may be unnecessary for patentability purposes.

The filing strategy discussed above may result in double-patenting rejections. Under a statutory double-patenting rejection (or „same invention“ type double patenting rejection) based on 35 U.S.C. §101, the rejection can generally be overcome either by identifying differences in the embodiments or abandoning the narrower embodiment. Under the judicially created obviousness-type double patent rejection, the rejection can generally be overcome by filing an appropriate terminal disclaimer.

B. Procedural Advantages

One benefit of using design patent protection is that the average pendency (duration of the prosecution before the USPTO) of a design patent application is significantly shorter than the average pendency of a utility patent application.³⁹ Therefore, design patents can provide a relatively quick and effective method of preventing a competitor from infiltrating a market by mimicking the aesthetics of a successful product.

In many circumstances it is advantageous to file for utility patent protection on the functional aspects of an invention, and design patent protection on the ornamental aspects of the invention. For example, a patentee who holds a design patent and a utility patent can sue an infringer on the basis of both patents. In most patent litigations, an infringer's defense includes a claim that the patent is valid. As explained in the first part of this article, the requirements for patentability for a design patent are somewhat different from those of a utility patent. Consequently, while one patent may be invalidated during litigation, the other may not. Therefore, obtaining a design patent and a utility patent increases the odds that the patentee recovers damages.

One strategy for filing for design and utility patent protection is to file a utility patent application and, once the utility patent application is in condition for allowance, file a divisional design patent application based on the original utility patent application. Alternatively, if a rejection is received and it is apparent that none of the claims of the utility patent will likely be allowed, a design divisional application can be filed. In order to effectively follow this strategy the original utility patent application must be prepared and filed with drawings that are of design application quality, and a brief description of the ornamental aspects of the invention should be included in the specification.

In certain circumstances, the applicant may wish to file a divisional design patent application earlier than mentioned above, or may wish to file the design patent application simultaneously with the filing of the utility patent application. Such a situation may arise if the applicant is aware of a competitor producing a product that falls within the scope of the patent protection being sought by the design patent. In this situation, it may be

37 *In re Zahn*, 617 F.2d 261, 204 USPQ 998 (CCPA 1980).

38 *In re Klein* 987 F.2d 1569, 1570, 26 USPQ2d 1133, 1134 (Fed. Cir. 1993).

39 Recently, the USPTO reported that the average pendency for a utility patent application is approximately 24 months, while the average pendency for a design patent application is approximately 18 months.

advantageous to file the design patent application as soon as possible in hopes that a design patent will issue quickly, and can then be used to prevent the competitor from continuing to produce the product. One should keep in mind, however, that under this strategy the design patent may issue first so that the utility application can be rejected for double patenting. If a terminal disclaimer is filed to overcome this rejection, the term of the utility patent will be limited to the term of the design patent, which is fourteen years from issue of the design patent.

One caveat that foreign applicants should keep in mind is that, in order to claim priority to a foreign priority document, the first U.S. application (either utility or design) must be filed within sixth (6) months of the filing date of the foreign priority document.⁴⁰ Applicants should also be aware that a design application cannot claim priority to a provisional application.⁴¹

Finally, applicants should keep in mind that the term of a design patent is different from that of a utility patent: the term of the design patent is fourteen years from the issue date, while the term of the utility patent is twenty years from the earliest U.S. filing date of the utility application. In other words, the design patentee is guaranteed a 14 year of patent term regardless of the duration of the prosecution. Furthermore, a design patentee does not have to pay maintenance fees. Consequently, once the issue fee is paid, the design patent can remain enforceable for fourteen years without further payments.

C. Infringer's Total Profits Are Available

The monetary remedies provided for utility patent infringement apply equally to design patents.

Under 35 USC 284, the owner of a utility or design patent is entitled to „damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together and cost as fixed by the courts.“ Typically, the damages awarded under this section of the statute correspond to a reasonable royalty. When the patent owner can prove that he or she would have made the infringer's sales but for the infringement, the patent owner is entitled to „lost profits“ under 35 USC 284. When the patent owner proves that the infringement was willful, „the court may increase the damages up to three times“ the compensating amount.⁴²

As already stated, a design patent owner is entitled to the monetary damages prescribed by 35 USC 284. However, the design patent owner has the additional option of demanding the infringer's „total profits“ under 35 USC 289 which states that:

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such

design or colorable imitation has been applied shall be liable to the owner to the extent of his *total profit* . . . (emphasis added).

The design patent owner, however, is not entitled to recover twice: once under 35 USC 284 and once under 35 USC 289. Nonetheless, having the option to choose damages under 35 USC 289 may be advantageous, for example when the infringer's total profits are substantially greater than any reasonable royalty.

D. Preliminary Injunctions Are Available

A preliminary injunction is a court order commanding the accused infringer to stop its (allegedly) infringing activities before or during trial. In general, preliminary injunctions are issued if the court believes that there is a likelihood of success that the plaintiff (typically the patent owner) will prove that the patent is valid and infringed, and that the plaintiff will suffer irreparable damages if the preliminary injunction is not issued. It is often difficult to convince a court to issue preliminary injunctions. However, preliminary injunctions are often sought because of the threat they impose on defendants.

Design patent owners can request and obtain preliminary injunctions against accused infringers. For example, in 1988 American Antenna Corp. successfully stopped its competitor Wilson Antenna Inc. from further manufacturing, using, distributing and selling its KW-1000 antenna pending final judgement because the design of that antenna likely infringed American's design patent U.S. D255,449. In 1990, Oscar Mayer Foods Corp. successfully enjoined competitor Sara Lee from selling its product, „Lunch 'N Munch“ in a red package because the red package likely infringed Oscar Mayer's design patent U.S. D305,204.⁴³ In 1990, National Presto Industries, a manufacturer of household appliances, successfully stopped giant retailer Wal-Mart from selling, just prior to the peak in the selling season, the „Quick Fry“ electric deep fryer manufactured by Dazey Corporation and allegedly infringing Presto's design patent U.S. D246,686.⁴⁴

A survey of all reported decisions involving design patents in motions for preliminary injunctions showed that between 1986 and 1990 design patent owners were successful 70% of the time in having the court grant a preliminary injunction against the accused infringer.⁴⁵ With this kind of record, a design patent owner comes to the bargaining table with a powerful weapon in hand when negotiating with a potential infringer. This impressive statistic on preliminary injunctions reflects the increased respect for design patents granted by U.S. district courts, which held valid 66% of

40 See 35 USC 172.

41 See 35 USC 172.

42 See 35 USC 284, second paragraph.

43 *Oscar Mayer Foods v. Sara Lee*, 15 USPQ2d 1204 (W.D.Wis. 1990) (note that the judge refused to grant a second preliminary injunction to enjoin Sara Lee from selling the „Lunch 'N Munch“ in a white package because Sara Lee, after investing in the new white package design, stood to suffer disproportionately more than Oscar Mayer in the event of a wrong preliminary decision. See *Oscar Mayer Foods v. Sara Lee*, 16 USPQ2d 1369 (W.D.Wis. 1990)).

44 *National Presto Indus. v. Dazey*, 18 USPQ2d 1113 (N.D.Ill. 1990)

45 Saidman, „Design Patents – the Whipping Boy Bites Back“, *JPTOS*, Vol. 73, no. 11, 859, 866 November 1991.

the design patents at issue between 1986 and 1991.⁴⁶ In that sense, the district courts seemed to have received the message sent from the Federal Circuit, which upheld 80% of all lower court findings of validity during that period,⁴⁷ thereby giving real meaning to the presumption of validity for design patents.⁴⁸

IV. CONCLUSION

As discussed above, design protection can be obtained on very functional articles of manufacture. Patent practitioners should thus always consider whether their clients' functional inventions deserve design patent pro-

tection. Drafted carefully, design patents can be obtained relatively quickly and can provide relatively broad protection for fourteen years without payments of maintenance fees. Design patents are enjoying a renewed judicial respect and today their presumption of validity is real. Armed with a design patent, businesses may be entitled to their competitors' total profits and can stop their competitors' activities, via a preliminary injunction, before the completion of a lengthy litigation. Design patents can thus become powerful cards to play during negotiations, and are potent members of an effective patent portfolio.

Special Preparatory Course for the CEIPI Seminar on European Patent Law for Paper D (legal questions) Pre-Preparatory Course Friday, 5 October 2001, Strasbourg

The special preparatory course is intended especially, but not only, to candidates who have attended the CEIPI/EPI basic training course in European patent law and who would like advice on preparing themselves better for paper D. The need for the course is based on the finding that a number of participants at the examination preparation seminar in January (21 to 25 January 2002) do not have sufficient knowledge of European patent law and are not adequately prepared to meet the demands made of them. The general language of the proceedings will be English, but participants may also use French or German. Individual or group discussions will accordingly be held in the requested language – English, French or German.

The program will be:

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The venue is
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Mrs Rosemarie Blott
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⁴⁶ *Id.* at 868.

⁴⁷ *Id.* at 870.

⁴⁸ See 35 USC 282 („A patent shall be presumed valid“).

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