

eipi Information

Institut der beim Europäischen Patentamt
zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés près
l'Office européen des brevets

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Editorial

T. Johnson (GB)

Whither Patents in Europe?

The EPO launched its scenario's project some three years ago. This set out to consider the patenting landscape, which like a natural landscape, changes over time. President Brimelow referred to the project during her address to those assembled for the 30th anniversary celebration of the epi, referred to elsewhere in this issue. She is optimistic about the future of the EPO, and rightly so if past history is anything to go by. However, history is not always „one thing after another“, particularly in the field of patents. Things move swiftly, and we think it true to say that in future, global development will not be based on economics *per se*, but rather on IP competition. Whoever will have the best system, and access to and control of quality patents will have the better chance of success. Thus the scenarios project was, and is, apposite.

The project seeks to assess future outcomes. If those outcomes can be successfully defined, decisions can be made by those in positions of power such as politicians, business leaders and even social strategists to form a view as to how the world in which we live should, or will, develop. The project is thus of importance to everyone, not least our Members as if any one of the scenarios becomes dominant, or if the scenarios develop to be mutually dependent, the landscape will change. We have seen recently how this can happen with the acceptance of the London Agreement. Another area is the bifurcation of views between Europe and the US over the patenting of business methods.

We know whence patents cometh, whither are they going?

Nächster Redaktionsschluss für epi Information

Wegen der Veröffentlichung der Wahlergebnisse wurde der Redaktionsschluss für die nächste Ausgabe der epi Information auf den **31. Januar 2008** vorverlegt. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

Because of the necessary publication of the election results the deadline for the next issue of epi Information has been brought forward to **31 January 2008**. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour epi Information

En raison de la publication des résultats d'élection, la date limite de remise des documents pour le prochain numéro de epi Information est le **31 janvier 2008**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

On Education

W. Holzer (AT)
former epi President

Before turning to education let us take a brief look at the *object* of our contemplation. What is this species called „European Patent Attorney“? I do know, of course, it is someone who has passed the EQE and has been entered on the list before the EPO, but this does not say very much.

Given today's economical and industrial realities, we might define a Patent Attorney as an *IP intermediary* with particular *technical* and *legal* skills to *interpret* complex realities in diverse technical fields for inventors and business managers, in order to devise appropriate IP protection and defence strategies. In the first place, of course, Patent Attorneys act as *transformers*, turning *tacit* into *codified knowledge* and thus into actual value, as we all know, the mere *idea* in the head is worthless.

When I started in this profession the daily practice of a national Patent Attorney was restricted to work before the national Patent Office or a foreign Patent Office, through a colleague abroad, mostly for foreign clients, e.g. from America, England, Germany or France. Visits of foreign colleagues were frequent, in order to discuss the more complicated cases. It was a time of international collaboration rather than competition.

Naturally also at that time bigger companies built walls of patents around them. We did, however, not speak of „*portfolios*“. We discussed business strategies with our clients, however not on the basis of *due diligence appraisals* in the context of raising venture capital or securing bank loans. Proprietors used patents themselves or licensed them out. That was about all. National oppositions were frequent, litigation a relatively rare occurrence.

As far as *education* was concerned, I enjoyed five years of practice in a patent attorney's office to prepare for the national examination, with a long list of topics to study, including all relevant national laws as well as the laws of the foreign countries in which we operated. Due to this

extensive training also with the help of a tutor we had no problems to work as „grandfathers“ when the European Patent System commenced.

Some 40 year later visits of foreign colleagues are less frequent, except in cases of major importance, such as litigation, because foreign clients' work before the EPO is mainly sent to representatives of the two or three major countries which cover about 75 % of the work before the EPO.

Instead, I receive any number of invitations by mail and telephone call centres to conclude a *contract* with an *international law firm* on future *litigation representation in Austria*, or to attend one or the other *important international conference* on the „*managing of IP rights and patent portfolios in emerging markets*“. My regret not to be able to attend, due to my workload, is usually countered by the remark „*but major firms attend and you will get an insight into the practicalities of patenting*“.

What does all of this signify? Quite evidently the nature of our profession has changed and is changing on a continued basis, and so must *education*. To be quite clear, the very *basis* of our profession is and remains the drafting and processing of patent applications, therefore a sound technical-scientific university training is indispensable, nothing more, nothing less. In this context, technical universities should be induced to offer a curriculum of basic IP laws during basic technical training, preferably with the support of National Associations, the European Patent Academy or the *epi*, and, since our profession lives on linguistic skills, they also should offer training in foreign languages. In my country a university organisation law requires technical universities to submit their curriculum on IP to the national association for approval or amendment. Thus, the initiative must be taken up with the relevant national ministry, which can

Nächste Ausgaben · Forthcoming issues · Prochaines éditions

<u>Issue</u>	<u>Deadline</u>	<u>Publication</u>
1/2008	31 January	13 March
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3/2008	20 August	2 October
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also be done by the *epi*, acting as a legal person in each member state.

Upon leaving university, today's professional candidates face a theoretical and practical full time training of at least 3 years to prepare for the EQE. This time frame is comparatively short as it takes much longer to master the trade. At any rate, candidates should be made aware from the start that *practical training* is of utmost importance, as our profession is one where the master hands down his skills to the disciple. It is of equal importance that candidates understand that this is an *autonomous* profession. You have to look after yourself from the very beginning and you may not expect that you will be taught everything by others. Rather, you have to pick up relevant knowledge on your own as you proceed. Thus, the *quality of training* very much depends on the *initiative* of the trainee. This is a profession for enthusiasts.

As a comparison, we may look to the UK, where in the course of the basic training of medical doctors students are not given lectures in the old fashioned sense; rather, they must prepare their own learning modules. As professional education will become more *complex* in the future, it will also become more *expensive*, both continued and basic education. However, someone who sets out to become a European Patent Attorney earns enough money already as a candidate to be able to *invest* a certain amount in his future career. Neither the *epi* nor national associations or the European Patent Academy will be able to support large scale training activities without any financial contribution. It may then also happen that candidates will take training more seriously and abstain from participating in courses or the EQE on a speculative basis.

On training for the EQE and continued education no one has a monopoly in Europe. *Commercial providers* will increase their activity, as this apparently due to the demand is good business. The *established providers* therefore will face competition and will have to check on their services, as tutoring manpower is not unlimited. This highlights the importance of urgent cooperation between the *epi*, CEIPI and Academy as to the use of tutoring synergies. The established providers must also carefully evaluate with whom else they cooperate, if at all.

Last but not least it is the candidate who must decide on which course to take. The *epi*, I believe, need not act as an arbiter; however it should provide and publish the necessary *information* on availability of training facilities and prices. Whether multiple providers will improve the pass rate remains to be seen.

Today's economical interests in IPs will force Patent Attorneys to acquire more skills in the legal and economic field, such as portfolio management exploitation, contracts etc. This can be done for example by taking IP *masters courses* at university level, such as the one offered by the CEIPI, the IEEPI or the Patentanwaltskammer, although for larger numbers of participants other training provisions need to be made. The profession of a Patent Attorney in other words demands *extra-technical skills* in order to serve the needs of our clients.

We will, of course, normally not become a lawyer or accountant, although there are colleagues with a double or triple competence, however, we need to *understand* our clients' problems in order to refer them to the pertinent specialist, if necessary. I often outsource work to another specialist, if necessary, for example for a special legal opinion.

There are *diploma courses* for gaining extra knowledge in the *litigation* of European patents. The CEIPI in collaboration with the *epi* for the fifth successive year now runs a course on patent litigation in Europe. The purpose of the course is to enable European Patent Attorneys to acquire a deepened knowledge of patent litigation procedures in Europe and of envisaged future centralised court proceedings, as well as of related *rules of procedure*, in order to be able to better advise their clients on the enforcement and defence of European patents.

This course also has a bearing on the work before the EPO, as European litigation case law must be taken into account when dealing with applications before the EPO Boards of Appeal. The aim of the litigation course is not to prepare European Patent Attorneys for representation before courts on their own, although this is wished for in some countries. Rather, the knowledge acquired should enable them to avoid being fully dependent on what a local or foreign attorney tell them.

Likewise, *continued general professional education* has become a practical necessity. With medical doctors, for example, compulsory education continues during their entire professional career, as any university degree may last, let us say, seven years before the knowledge acquired is outdated. I do not ignore the fact that the risk patients run with medical advice or treatment cannot be compared to that of our clients who may only lose money; however I would advocate some sort of „*compulsory*“ or rather „*advised*“ continued professional education, for European Patent Attorneys in certain fields.

We face the competition of attorneys at law, in particular from globalising attorneys' firms, and we must take into account the extreme specialisation attorneys at law go into nowadays, for example in Germany where they have created the „*Fachanwalt für Gewerblichen Rechtsschutz*“.

To cite an example, continued professional education might be required as concerns certain aspects of the EPC 2000. Of course, it is within the normal liability of any European Patent Attorney to get acquainted with the new rules. This arises out of the *epi* Code of Conduct. However, brief follow up courses, at least with attendance certificates would seem appropriate. We might in this regard contemplate extending the *epi*, CEIPI or the Academy *support network* all over Europe in terms of a *permanent decentralised presence*, to provide lectures and courses locally, in particular until the laws governing professional activity are harmonised in all of the member states. Naturally, a large portion of harmonising education falls due to the National Associations that should act in close cooperation with the *epi*, the CEIPI and the Academy.

Of course, the term „*advised*“ or „*compulsory*“ is tricky, in particular with attorneys. What happens if someone does not participate in continued education? Well, sanctions are always a difficult issue, taking into account that we deal with about 8000 members (some of whom might get off the list if education is compulsory, I am thinking of grandfathers!). Entries of qualifications in the list are not very practical and entail bureaucracy. I would plead for simply evidencing an additional qualification or educational certificate, respectively, on the member's website, business card or the like, same as

colleagues mention the passing of the EQE on their website.

I am quite confident that our profession due to the limited number of our members and the unique combination of technical and legal thinking will be able to structure its education in the future in a way that ensures maintaining the traditional high degree of expertise.

Thus, let me close by saying: „Long live the *epi* in permanent revolution within the framework of the European Patent Organisation!“ Thank you for your attention.

30th *epi* Anniversary Nuremberg, 23 October 2007

M. Hössle (DE)

Directeur de la Section Internationale du CEIPI

Mesdames Messieurs, M. Le Président, MM. les Vice-Présidents, werte Kolleginnen und Kollegen, dear colleagues, chers confrères,

C'est non seulement un grand honneur mais aussi un grand plaisir pour moi d'avoir la possibilité de vous adresser la parole aujourd'hui lors de cette merveilleuse occasion, la célébration du 30^{ème} anniversaire de l'Institut des mandataires agréés près l'OEB.

C'est donc avec grande joie que je transmets de la part de l'institution que je représente, le Centre d'Études Internationales de la Propriété Industrielle, le CEIPI, les meilleurs vœux à l'*epi* pour ce 30ème anniversaire et pour les années à venir, qui seront, je l'espère bien, des années de collaboration continue entre l'*epi* et le CEIPI.

Le CEIPI est un institut de l'Université Robert Schuman de Strasbourg, ville dite carrefour européen, qui héberge de nombreuses institutions européennes dont, bien sûr, le Parlement européen, le Conseil de l'Europe, la cour européenne des droits de l'homme. C'est une ville avec une grande et riche histoire, une ville qui a hébergé des sommités comme Johann Gutenberg, Jean Calvin, Louis Pasteur (dont une autre université à Strasbourg porte le nom), Johann Wolfgang Goethe, pour n'en nommer que quelques-uns, ville qui a donné naissance à de grands hommes, pas seulement à nos chers confrères Laurent Nuss et Thierry Schuffenecker, mais aussi à des hommes comme le Général Kléber et Marcel Marceau, et – comme on est en Bavière, je tiens à le dire – auch Ludwig I von Bayern wurde in Straßburg geboren. Le CEIPI donc, ou pour être plus précis, la Section Internationale que j'ai l'honneur de diriger, a en fait accompagné l'*epi* dès le début, fournissant une préparation pour les candidats à l'examen européen de qualification, et une formation de base en droit européen de brevets, formant ainsi – et je

dirais même – produisant les spécialistes en matière de brevets européens.

30 ans, 30 Jahre, 30 years of joint cooperation of *epi* and the Section Internationale de CEIPI are what people like to call a success story. But over the years, the world in general and – as we all know – the patent world in particular has changed dramatically, thus imposing new challenges on the profession and consequently on those responsible for the education of this profession. So, what is the stage at CEIPI right now?

One of the main activities of CEIPI is not only to educate, but also to bring the profession together. We have an elaborate course system, recruiting students (I rather like to call them candidates) at an early stage when they have just entered the profession by offering basic training courses in 35 cities in EPC-countries – exactly one week ago, the most recent course was opened in Oslo thus welcoming Norway even before the EPC becomes effective there.

The most traditional and most well-known courses are, of course, the exam preparation seminars which are held in Strasbourg every year some 2 to 3 months before the exam. At these seminars we bring the candidates from all over Europe together. For most of them, this is the very first opportunity to meet their future colleagues from other countries and where they have the possibility to develop an inter-European exchange. Now, you may appreciate why I emphasized the important history and European tradition of Strasbourg before: it has always been a very European city, and in this respect it is our intention to immerse the candidates in this European spirit during these seminars. So, it's both: it is educating and bringing together.

The pass rates at the EQE could be much better, but on the other hand I am very proud to say that our candidates who have come to CEIPI and have benefited from our course offer have, at least statistically, a much better chance of passing the exam. This alone, however, does not allow us „de nous reposer sur nos lauriers“, to rest on our laurels. As we have already heard, there are a lot of challenges for the profession and there are a lot of threats to the profession. My answer as an *epi* member directing an educational institution, my answer is: quality. In order to survive, as an individual practitioner and as a profession in general, we have to focus on quality – quality is the magic word. Quality was always important in this profession. However, it was never as important as it is today. We have to strive for quality! Quality in the legal services provided by us will lead to an accomplished reputation of the profession which again is one of the prerequisites for the further well-being of all of us.

Quality however results from an excellent basic education as well as ongoing education. And this is where CEIPI is active. CEIPI's aim is to offer the best possible education which is available. Our target group for this education is future *epi* members. We have a pool of more than 250 tutors from over a dozen member states, most of them *epi* members themselves. Therefore, I am convinced that *epi* and CEIPI are most natural partners when it comes to developing new educational concepts and to working together in order to achieve the goal of high quality education.

Earlier on, President Brimelow made a very good remark: she said that, even though 30 years are a wonderful time, there is no time for nostalgia. In my words, this means it is time for the next generation – maybe you remember the „Star Trek“ adventures of the USS Enterprise with Captain Kirk and his crew. This was indeed a very nostalgic, romantic TV series, but some years later, the sequel named „Next Generation“ came up and faced new challenges and was very successful. I am proud to be able to say that for CEIPI, the future has already begun and the next generation is running. We have already complemented our course offer by introducing new elements such as the so-called Pre-Prep Courses in early autumn, held in various cities such as Paris, Milan, Madrid, Stockholm, Strasbourg. These Pre-Prep Courses are intended to provide the candidates with a more basic approach in the exam preparation, enabling them to develop their exam techniques, while the Strasbourg seminars focus on the specific exam preparation. Additionally, a so-called „bachotage“ (Paukkurs or cramming course) was implemented quite recently which is held some two to three weeks before

the actual exam. The „bachotage“ courses are last minute courses before the exam and give the candidates a final preparation and a feeling for real exam conditions. In order to round off our offer (at least for the time being), there is a special Resitter Course for Part C which has been held now for the 3rd consecutive year. And one can observe that here too, once the resitters come to the CEIPI course their chances of success, which statistically seen are extremely low, improve greatly.

As of next year we will provide even more elaborate courses, with the goal, with the vision that we have a complete range of courses on offer which takes the candidates by the hand from the first day of the work in the IP field and accompany them until the last day before the exam. Even better still: once they have passed the exam, we are there again. We are already offering the famous Litigation Course which was implemented by W. Holzer. We are offering a Master Course for Patent Law and Management. Thus, we take the ongoing education, the fact that our profession has to be able to consult with its clients in various fields, interdisciplinary fields, to accompany them successfully through litigation, through negotiations with competitors, licensors and licensees, to evaluate their patent portfolios and so on, very seriously.

The future will bring even more. The biggest challenge now is to integrate our fellow colleagues from the new member countries (I mentioned the Norway example), which will most likely comprise the use of new educational technologies and strategic points of presence in various locations. Our strategy will continue to be one of approaching the client, but a core aspect will also continue to be the gathering, the bringing together in Strasbourg of the candidates from all over Europe which – as I mentioned before – for most of them is the first time that they are able to exchange views with and get to know their future colleagues from other countries and which for all of them is always a very exciting experience.

Our mission is to educate the profession. We take this mission very seriously. The fact that now for the first time, an *epi* member has taken over the role of Director of the Section Internationale of CEIPI means: CEIPI knows the profession and CEIPI knows education, and therefore CEIPI educates the profession.

Von Heinrich Heine stammt ein schöner Satz: „Ein bisschen Bildung ziert den ganzen Menschen“. Ich bin versucht zu sagen: „Ein bisschen CEIPI ziert den ganzen Berufsstand“. In diesem Sinne wünsche ich dem *epi* eine wunderbare Zukunft und uns allen gemeinsam wunderbare kommende 30 Jahre, zu deren Gelingen das CEIPI seinen Beitrag leisten wird.

Bericht über die 63. Ratssitzung und über das 30-Jahresjubiläum des epi Nürnberg, 22.–23. Oktober, 2007

Präsident Chris Mercer eröffnete die Ratstagung um 9 Uhr und dankte dem Sekretariat für die gute Vorbereitung der Veranstaltung. Folgende Punkte wurden besonders erwähnt:

1. Da es sich hier um die letzte Ratstagung handelt, wurden die Ratsmitglieder daran erinnert, dass für ein Verbleiben im Rat die Benennung als Kandidat auf den Benennungslisten notwendig ist, die bis spätestens 2. November 2007 in Sekretariat vorliegen muss.
2. Präsident Mercer (GB) gab bekannt, dass er selbst nicht mehr als Präsident zur Verfügung stehen wird, Herr Nuss (FR) nicht mehr als Vize-Präsident und Herr Baum (DE) nicht mehr als Generalsekretär. Vize-Präsident Finnilä (FI) und Schatzmeister Quintelier werden sich zur Wahl stellen. Es wird noch zwei Vorstandssitzungen bis zur ersten Versammlung des neuen Rates am 8. Mai 2008 geben. Den Mitgliedern, die den Rat verlassen, wurde für ihre jahrelange Arbeit gedankt; Herrn Curell Suñol (ES) wurde mit Beifall gedankt.
3. (i) Die Berichte von Präsident, Vize-Präsidenten und Generalsekretär wurden zur Kenntnis genommen und akzeptiert;
(ii) Der Bericht des Schatzmeisters einschließlich des Kontenberichts wurde akzeptiert und der Schatzmeister und der Vorstand wurden entlastet.

Der Jahresbeitrag 2008 beträgt 160 €, wenn vor dem 1. Mai 2008 bezahlt, 190 €, wenn später bezahlt.

4. Die Zukunft des Patentwesens in Europa wurde diskutiert, aber es wurden keine Entscheidungen getroffen. Der zukünftige epi-Rat wird die Diskussion sicher weiterführen, die durch den andauernden Erfolg des Europäischen Patentamts, die Erweiterung durch die Zahl der Mitgliedsländer und die Bedürfnisse der Nutzer des Systems geprägt ist und sich weiterhin damit auseinandersetzt. Einige der genannten Ziele dabei könnten sein:
 - ein strafferes Ausbildungssystem für zugelassene Vertreter;
 - eine ausgeglichene Verteilung der Patentarbeit unter den zugelassenen Vertretern in den Mitgliedsländern;
 - eine proaktive Einbringung des epi in die Entwicklung des europäischen und des weltweiten Patentsystems.
 Die Haltung des epi zum EPLA ist generell zustimmend, soweit es für die Mitgliedsländer optional bleibt.

5. 30-jähriges Jubiläum des epi

Die Ratstagung fiel nahezu auf den Tag genau 30 Jahre nach der Gründung des Instituts. Demzufolge war der

Nachmittag des 22. Oktober einer Feier vorbehalten, an der die Präsidentin des EPA, Frau Alison Brimelow, teilnahm. Wie erwartet hielt die Präsidentin eine anregende Rede, in der sie ihre Haltung zur zukünftigen Entwicklung des Patentsystems in Europa darlegte. Sie erwähnte die laufenden Probleme des Europäischen Patentamts: Streiks des Personals, die Ansprüche der Mitarbeiter insbesondere nach Verbesserung der Altersversorgung und der Rückstau im Bereich der Recherche und der Prüfung. Entsprechend diesen Problemen wird das Ergebnis für das Jahr 2007 geringer ausfallen. Die Zahl der Erteilungen bleibt 12 % unter der Zahl des letzten Jahres. Nichtsdestoweniger war sie bezüglich der Zukunft optimistisch. Es gibt keine Zweifel an Erfolg des Europäischen Patentsystems.

Im nächsten Jahr, 2008, werden Norwegen und Kroatien dem Übereinkommen beitreten und die Zahl der Vertragsstaaten wird sich damit auf 34 erhöhen.

Alison Brimelow legte die ersten Ergebnisse des Europäischen Patent-Netzwerkes vor, welches im letzten Jahr eingerichtet wurde und dessen Ziel es ist, die Produktivität des EPAs zu verbessern. Dieses Netzwerk beruht auf vier Überlegungen:

- 1) ein Nutzungsprojekt, welches den europäischen Prüfern erlaubt, vorausgehende Recherchen- und Prüfungsergebnisse anderer nationaler Patentämter in Betracht zu ziehen;
- 2) eine nachhaltige Qualitätskontrolle, die gerade schrittweise eingeführt wird;
- 3) Ausgliederung einiger Aufgaben wie z. B. die Klassifikation zu nationalen Patentämtern;
- 4) Anwendung derselben modernsten Software-tools wie bei den nationalen Patentämtern.

Es wurde aufgezeigt, dass die Anerkennung von vorgehenden Recherchen und Prüfungen von nationalen Patentämtern durch das EPA noch nicht generell erfolgt, aber der derzeitige Trend zumindest nicht eine komplette Zurückweisung solcher Ergebnisse ist.

Es gab eine lebendige Diskussion, im Verlauf derer die derzeitige Debatte über das Gemeinschaftspatent erwähnt wurde, mit besonderem Bezug auf die Diskussion zwischen den Mitgliedsstaaten der EU und der Kommission über die zukünftige Jurisdiktion über das Europäische Patent, die möglicherweise eine EU-Jurisdiktion wäre.

Weitere Vortragende, eingeschlossen unser Präsident (der auch einen Willkommensgruß entbot) waren: Wolfram Förster, EPA Hauptdirektor Controlling Office, Manuel Desantes, EPA Vize-Präsident GD 5, Markus Hössle, CEIPI Direktor, Christian Brévard, Präsident des IEEPI, und Walter Holzer, früherer epi-Präsident. Die vier letztgenannten Sprecher trugen ihre Ansichten zur Aus-

bildung für das zukünftige Europäische Patentsystem in Europa vor.

Die Feier fand ihr Ende mit einem Gala Dinner im alten Rathaussaal, an dem fünf vormalige *epi*-Präsidenten teilnahmen.

Die Feier war gut geplant und durchgeführt und wurde sehr positiv aufgenommen.

Entwurf der Beschlüsse

63. Ratssitzung, Nürnberg, 22.-23. Oktober 2007 zu *epi* 107/07, genannt „Revised Proposal for Amended By-Laws“

1. Ein Ausbildungsdirektor wird mit einem Ein-Jahres-Vertrag eingesetzt; das Vertragsverhältnis wird am Ende der Frist überprüft. Die Gesamtkosten dürfen 50T € nicht übersteigen.
2. Dem überarbeiteten Vorschlag für die revidierte Geschäftsordnung, Anlage 3 zu *epi* 107/07, genannt „Revised Proposal for Amended By-Laws“ wurde zugestimmt.
3. Der Rat übertrug die „weiteren Rechte“ für den Rest dieser Ratsperiode auf den Vorstand.
4. Der Ad-Hoc Ausschuss soll seine Arbeit zusammen mit dem Geschäftsordnungsausschuss fortsetzen.
5. Herr Liebetanz (CH) wurde als Ersatz für Herrn Schmauder als Mitglied des Disziplinarrates gewählt.
6. Der Mitgliedsbeitrag für das Jahr 2008 beträgt 160 €, soweit er vor dem 1. Mai 2008 entrichtet wird.
7. Der Mitgliedsbeitrag für das Jahr 2008 beträgt 190 €, soweit er am oder nach dem 1. Mai 2008 entrichtet wird.
8. Der Rat beschloss die Bildung eines Ausschusses für Rechtstreitigkeiten.
9. Der Rat beschloss die Bildung eines Ausschusses für Patentedokumentation.
10. Der Rat lehnte den EPA-Vorschlag für eine „Verhaltensregel für die Praxis“ ab.
11. Der Rat lehnte es ab, dass das EPA demselben Inhaber zwei Patente erteilt, welche dieselben Staaten benennen und im Wesentlichen identische Ansprüche enthalten.
12. Der Stellungnahme zu mündlichen Verfahren „Festlegung und Änderung von Terminen“ wurde zugestimmt.
13. Der Stellungnahme „Abhaltung von mündlichen Verhandlungen an nur einem Ort“ wurde zugestimmt.
14. Der „Amicus Curiae Brief G 1/07“ wird vom Ausschuss für Biotechnologische Erfindungen überarbeitet und eingereicht, falls die Mitglieder damit einverstanden sind.
15. Der Stellungnahme zum EPA-Non-Paper vom 7.9.2007 „Missbrauch von Teilanmeldungen“ wurde zugestimmt.
16. Der Stellungnahme zu „Vorgeschlagene Änderung von Regel 36“ wurde zugestimmt.
17. Der Stellungnahme zu „Vorgeschlagene Änderungen von Regel 45(2), 137(1) und 162“ wurde zugestimmt.
18. Der Stellungnahme zu „Vorgeschlagene Änderung von Regel 56“ wurde zugestimmt.
19. Der Stellungnahme zu „Vorgeschlagene Änderung von Regel 60(1)“ wurde zugestimmt.
20. Der Stellungnahme zu „Vorgeschlagene Änderung von Regel 69“ wurde zugestimmt.
21. Der Stellungnahme zu „Vorgeschlagene Änderung von Regel 85“ wurde zugestimmt.
22. Der Stellungnahme zu „Vorgeschlagene Änderung von Regel 136/3“ wurde zugestimmt.
23. Der Stellungnahme zu dem Papier – „Report on Trilateral Working Group Global Patent Application (GPA) or Trilateral Standard Format Pilot Project (TSFPP)“ – wurde zugestimmt.
24. Der Stellungnahme zu dem Papier „Enhancing the Patent System in Europe“ wurde zugestimmt.
25. Dem Papier CA/PL 14/07 „Vorschlag zur Änderung der Vorschriften in Disziplinarangelegenheiten von zugelassenen Vertretern“ wurde zugestimmt.

Report of the 63rd Council Meeting and of the 30th Anniversary Celebration of the *epi* Nuremberg, 22nd – 23rd October, 2007

President Chris Mercer opened the meeting at 9.00 a.m. and thanked the Secretariat for the excellent arrangements which had been made for the meeting. The following points of interest were noted:

1. Since this was the last Meeting of Council, Members were reminded that to stand for election, nomination forms had to be received by the Secretariat by the 2nd November, 2007.
2. President Mercer (GB) announced that he would not be standing again as President, Mr. Nuss (FR) would not be standing as Vice-President and Mr. Baum (DE) would not be standing as Secretary General. Mr. Finnilä (FI), Vice President, would be standing as would Mr. Quintelier (BE), Treasurer General. There would be two Board Meetings before the first meeting of the New Council, to take place in May, 2008.

Thanks were expressed to those Council Members who would leave the Council after many years' service. Mr. Curell Suñol (ES) was thanked with acclamation.

3. (i) Reports of the President, Vice-Presidents and Secretary General were noted, and accepted;
- (ii) The Treasurer's report and accounts were accepted, and the Treasurer and Board were discharged.

Annual Subscriptions 2008: 160 € if paid before 1st May, 2008, 190 € if paid after that date.

4. The future of patenting in Europe was discussed, but no decision was taken. Future Councils will hopefully take the discussion further, the topic arising out of the continuing success of the EPO, the expansion in the number of Member States, and the needs of the users, all of which are of concern to the Institute and its Members. Some aims could be:
 - A strengthened educational system for patent professionals;
 - A more balanced distribution of patent work among professionals in the Member States;
 - A proactive involvement of the Institute in the development of the European and global patent system.

The *epi* position on the EPLA is generally in favour, provided it remains optional in Member States.

5. 30th Anniversary Celebration of *epi*

The Council Meeting fell at an auspicious time, as it was opened almost 30 years to the day from the beginning of the Institute.

Accordingly, the afternoon of the 22nd October was given over to a celebration, attended by Alison Brimelow President of the EPO. As is now to be expected, Ms.

Brimelow gave a resounding address to the Members presenting here views on the future of the European Patent System. She mentioned the current problems at the EPO: staff strikes, the staff claiming, in particular, better treatment on their pension schemes, and the increasing backlogs in the searching and in the examination areas. Due to these problems, in year 2007 the results on productivity will be poorer. The number of publications of grants is 12% lower than last year. Nevertheless, she was optimistic about the future. There is no doubt about the success of the European patent system.

Next year, 2008, Norway and Croatia will be joining the organization and so the number of Contracting States will increase to reach 34.

Alison Brimelow presented the first results of the European Patent Network which was set up, last year, whose aim is to improve productivity of the Office. This Network relies on four different aspects:

- 1) Utilization project permitting the European Examiners to take into account previous searches and examinations made by other National Patent Offices of Europe;
- 2) A thorough quality control programme, already being implemented, step by step;
- 3) Outsourcing of some tasks, like classification, to some National Patent Offices;
- 4) Sharing the newest software tools with these National Patent Offices.

It has to be pointed out that the recognition by the EPO of previous searches or examination made by other National Offices is still not accepted, but the current trend is not to reject it fully.

There was a lively discussion, during which the current debate over the Community Patent was mentioned, with particular reference to the discussions between Member States of the EU, and the Commission on the future jurisdiction for the European patent, which would eventually be Community Patent jurisdiction.

Other speakers included our President (who gave an opening welcoming address), Wolfram Förster, EPO Principal Director Controlling Office, Manuel Desantes, EPO Vice-President DG5, Markus Hössle, CEIPI Director, Christian Brévard, President of IEEPI, and Walter Holzer, former President, *epi*. These latter four speakers presented their views on Education of Future Patenting in Europe.

The celebration ended with a Gala Dinner at the Town Hall at which five past Presidents of the *epi* were present.

The celebration was well-conceived and executed, and reflected well on our Institute.

Draft decisions

63rd Council meeting, Nuremberg, 22-23 October 2007

1. A Director of Education will be employed for a one year contract, to be reviewed at the end of that term. The costs will not exceed 50.000 €/year.
2. The revised proposal for Amended By-Laws, Annex 3 of *epi* 107/07, headed „Revised Proposal for Amended By-Laws“ was approved.
3. Council delegated the „other powers“ to the Board for the rest of this Council period.
4. The Ad-Hoc Committee will continue its work in cooperation with the By-Laws Committee.
5. Mr. Liebetanz (CH) was elected member of the Disciplinary Committee, to replace Mr. Schmauder.
6. The annual subscription fee for the year 2008 is to be 160€ if paid before May 1st.
7. The annual subscription fee for the year 2008 is to be 190€ if paid on or after May 1st.
8. Council approved the constitution of a Litigation Committee.
9. Council approved the constitution of a Patent Documentation Committee.
10. Council disapproved of an EPO „Code of Practice“ proposal.
11. Council disapproved of the EPO granting to the same proprietor at least two patents designating the same states and containing substantially identical claims.
12. The position paper on Oral proceedings – Setting and Changing Dates was approved.
13. The position paper „Holding oral proceedings only in one place“ was approved.
14. The Amicus Curiae Brief G 1/07 will be reviewed by the Committee on Biotechnological Inventions and will be filed if there is a clear result from their side.
15. The position paper on the EPO non-paper dated 2007.09.07 „Misuse of divisional applications“ was approved.
16. The position paper on „Proposed amendment of R. 36“ was approved.
17. The position paper on „Proposed amendments of R. 45(2), 137(1) and 162“ was approved.
18. The Position paper on „Proposed amendments of R.56“ was approved.
19. The Position Paper on „Proposed amendment of R. 60(1)“ was approved.
20. The Position Paper on „Proposed amendment of R.69“ was approved.
21. The Position Paper on „Proposed amendment of R. 85 and National Effect“ was approved.
22. The Position Paper on „Proposed amendment of R. 136/3“ was approved.
23. The Position Paper – Report on Trilateral Working Group Global Patent Application (GPA) or Trilateral Standard Format Pilot Project (TSFPP) – was approved.
24. The Position Paper on „Enhancing the Patent System in Europe“ was approved.
25. The Paper CA/PL 14/07 „Proposed amendments to the Regulation on Discipline for Professional Representatives“ was approved.

Compte-rendu de la 63ème réunion du Conseil et du 30ème anniversaire de l'*epi* Nuremberg, 22-23 octobre 2007

Le Président Chris Mercer ouvre la séance à 9 heures et remercie le Secrétariat pour l'excellente organisation de la réunion. Les points d'intérêt suivants ont été notés:

1. Cette réunion du Conseil étant la dernière avant les prochaines élections, il est rappelé aux membres du Conseil que les personnes désirant s'inscrire sur les listes doivent retourner leur proposition de nomination au Secrétariat le 2 novembre au plus tard.
2. Le Président Mercer (GB) annonce qu'il ne se représentera pas en tant que Président, M. Nuss (FR) ne se représentera pas comme Vice-Président, ni M. Baum comme Secrétaire Général. M. Finnälä (FI), Vice Président, et M. Quintelier (BE), Trésorier seront de nouveau candidats. Deux réunions du Bureau

sont prévues avant la première réunion du nouveau Conseil, laquelle se tiendra en mai 2008.

Le Président exprime ses remerciements aux membres du Conseil qui quitteront le Conseil après de nombreuses années de service. Le Conseil applaudit M. Curell Suñol (ES).

3. (i) Le rapport du Président et des Vice-présidents ainsi que le rapport du Secrétaire Général sont notés et approuvés.

(ii) Le Rapport du Trésorier et les comptes sont approuvés; quitus est donné au Trésorier et au Bureau.

La cotisation annuelle 2008 est de 160 € si celle-ci est payée avant le 1er mai et de 190 € si elle est payée après cette date.

4. L'avenir des brevets en Europe suscite une discussion mais aucune décision n'est prise. Les membres des futurs Conseils continueront la discussion, laquelle porte sur le succès grandissant de l'OEB, l'augmentation du nombre des Etats membres et les besoins des utilisateurs, toutes ces questions étant importantes pour l'Institut et ses membres. Certains des objectifs pourraient être les suivants:

- Un système de formation renforcé pour les professionnels du brevet;
- Une répartition plus équilibrée du travail entre les professionnels des Etats membres;
- Une implication proactive de l'Institut dans le développement du système des brevets au plan européen et mondial.

L'*epi* est généralement favorable à l'EPLA, à la condition que celui-ci reste optionnel dans les Etats membres.

5. *30^{ème} Anniversaire de l'epi*

La date de la réunion du Conseil coïncidant avec la création de l'Institut il y a 30 ans, l'après-midi du 22 octobre fut consacrée à la célébration de cet anniversaire, en la présence de la Présidente de l'OEB, Alison Brimelow. Comme l'on s'y attendait, Mme Brimelow présenta clairement ses vues sur l'avenir du système des brevets européens. Elle mentionna les problèmes actuels de l'OEB: les grèves du personnel et ses revendications, particulièrement en ce qui concerne une amélioration des plans de retraites, l'accroissement du retard dans les domaines de la recherche et de l'examen. En raison de ces problèmes, la productivité baissera en 2007. Le nombre de délivrances de brevets a diminué de 12 % par rapport à l'année dernière. Néanmoins, elle reste optimiste pour l'avenir. Le succès du système des brevets européens ne fait aucun doute.

L'année prochaine, en 2008, la Norvège et la Croatie rejoindront l'Organisation européenne des brevets, faisant ainsi passer le nombre des Etats membres à 34.

Alison Brimelow présenta les premiers résultats du réseau européen en matière de brevets. Celui-ci a été mis

en place l'année dernière dans le but d'améliorer la productivité de l'Office et il s'appuie sur quatre aspects différents:

- 1) Un projet d'utilisation permettant aux examinateurs européens de prendre en compte des recherches et examens antérieurs, réalisés par d'autres Offices nationaux européens;
- 2) Un programme de qualité approfondi, lequel est déjà progressivement mis en application;
- 3) Externalisation de certaines tâches, telles que la classification, vers certains Offices de brevets nationaux;
- 4) Utilisation des tout récents outils informatiques, également par les Offices de brevets nationaux.

On fit remarquer que si la reconnaissance par l'OEB de recherches ou d'examens antérieurs, réalisés par d'autres Offices nationaux, n'est toujours pas acceptée, elle n'est toutefois à l'heure actuelle plus entièrement rejetée.

Une discussion animée suivit, au cours de laquelle fut abordé le débat actuel sur le Brevet Communautaire, avec une référence particulière aux discussions entre les Etats Membres de l'Union Européenne et la Commission en ce qui concerne la future juridiction du brevet européen, lequel serait au final soumis à une juridiction communautaire.

Il y eut d'autres intervenants, entre autres notre Président (qui prononça un discours de bienvenue) Wolfram Förster, Directeur Principal de l'OEB Controlling Office, Manuel Desantes, Vice-Président de l'OEB DG5, Markus Hössle, Directeur du CEIPI, Christian Brévard, Président de l'IEEPI, et Walter Holzer, ancien président de l'*epi*. Les quatre dernières personnes citées présentèrent leur point de vue sur la formation relative à l'avenir des Brevets en Europe.

La célébration d'anniversaire se termina par un dîner de gala à l'Hôtel de Ville, auquel prenaient part cinq anciens présidents de l'*epi*

La célébration d'anniversaire qui était bien préparée et parfaite dans son déroulement fut un succès.

Projet de liste de décisions

63^{ème} réunion du Conseil, Nuremberg, 22-23 octobre 2007

1. Un responsable des questions de formation sera engagé pour un an, le contrat étant reconductible au terme de cette période. Les coûts ne devront pas dépasser 50.000 € par an.
2. La proposition pour une révision du Règlement Intérieur, annexe 3 du document *epi* 107/07, intitulée „Revised Proposal for Amended By-Laws“, est approuvée.
3. Le Conseil délègue les „autres pouvoirs“ au Bureau pour la période restante du Conseil en place.
4. La Commission Ad-Hoc continuera son travail en collaboration avec la Commission de Règlement Intérieur.
5. M. Liebetanz (CH) est élu membre de la Commission de discipline, en remplacement de M. Schmauder.
6. Le montant de la cotisation pour 2008 est maintenu à 160€ en cas de paiement effectué avant le 1er mai.

7. Le montant de la cotisation pour 2008 est maintenu à 190€ en cas de paiement effectué le 1er mai ou au-delà de cette date.
8. Le Conseil approuve la création d'une Commission de Contentieux.
9. Le Conseil approuve la création d'une Commission de Documentation des Brevets.
10. Le Conseil rejette la proposition de création d'un „Code d'exercice de la profession” par l'OEB.
11. Le Conseil désapprouve que l'OEB attribue à un même propriétaire au moins deux brevets désignant les mêmes états et contenant en substance des revendications similaires.
12. La prise de position „Fixer et changer les dates des procédures orales” est approuvée.
13. La prise de position „Les procédures orales à un seul et même endroit” est approuvée.
14. L' Amicus Curiae Brief G 1/07 sera envoyé à l'OEB s'il est approuvé par la Commission pour les inventions en biotechnologie.
15. La prise de position sur le document non officiel de l'OEB, en date du 7.09.2007, „Utilisation abusive des demandes divisionnaires” est approuvée.
16. La prise de position sur la „Proposition de modification de la Règle 36” est approuvée.
17. La prise de position sur les „Propositions de modifications des Règles 45(2), 137(1) et 162” est approuvée.
18. La prise de position sur les „Propositions de modification de la Règle 56” est approuvée.
19. La prise de position sur la „Proposition de modification de la Règle 60(1)” est approuvée.
20. La prise de position sur la „Proposition de modification de la Règle 69” est approuvée.
21. La prise de position sur la „Proposition de modification de la Règle 85 et de l'Effet National” est approuvée.
22. La prise de position sur la „Proposition de modification de la Règle 136/3” est approuvée.
23. La prise de position sur le „Report on Trilateral Working Group Global Patent Application (GPA) or Trilateral Standard Format Pilot Project (TSFPP) – est approuvée.
24. La prise de position concernant „L'amélioration du système des brevets en Europe” est approuvée.
25. Le document CA/PL 14/07 „Proposition de modification du Règlement en matière de discipline des mandataires agréés” est approuvé.

President's and Vice-Presidents' Report

C. P. Mercer
President

Since the last Council meeting, the following events have taken place and been attended by myself or one of the Vice-Presidents. There have been a number of events to which epi has been invited but which we have not been able to attend.

European Quality System Working Group – 24-25/5/07

Mr. Finnilä and I attended this meeting directly after the Council Meeting in Krakow. It was Ms. Brimelow's last meeting in charge. A report of the meeting was prepared by Mr. Finnilä.

Academy Event in Croatia – 4/6/07

I was invited by the Academy to give a lecture in Croatia to introduce epi to Croatian patent attorneys. Croatia is in the process of acceding to the EPC. There were about 50 people at the event and my talk was, I think, well received.

Meeting of SACEPO Members with the Boards of Appeal (MSBA) – 4/6/07

As I was in Croatia at the time, I had to miss this meeting. However, epi was ably represented by the Vice-Presi-

dents and by a number of epi's SACEPO members. Mr. Finnilä convened a meeting with a number of the epi members the evening before in order for epi to be better prepared for the MSBA meeting. A report was prepared for EPPC.

SACEPO – 5-6/6/07

A report of this meeting was prepared by Mr. Burt. The most interesting part of the meeting was devoted to a discussion on fees. A number of epi's SACEPO members also met the evening before this meeting and especially tried to prepare for the discussion on fees. This discussion will be continued at the forthcoming CPL and BFC meetings. It will then move to the Administrative Council.

FICPI Colloquium – 8/6/07

I attended the first day of this meeting and spoke to the meeting in the afternoon. It was a very interesting meeting. The high point was a speech by Alison Brimelow.

CNIPA – 9/6/07

After the first day of the FICPI meeting, I travelled to Stockholm to attend the CNIPA meeting. Due to thunderstorms, I arrived in Stockholm, with Mr. Lyndon-Stanford, at about 0230 am – not the ideal preparation for a meeting. The meeting discussed various interesting issues, in particular representation in courts and finances. A number of agenda items which were of more interest to epi members did not get discussed.

STOA – 14/6/07

STOA is effectively a committee of the European Parliament. It has a general remit to look into anything technological. As part of this, it has begun studies of the patent system. It then has meetings to discuss various aspects of its remit. This meeting was on patents and the effect they have on business. The meeting was organised in conjunction with the EPO. As usual, there was a lot of discussion as to whether patents were useful/too expensive/stifled innovation. There was also discussion as to whether the EPO's governance should be altered. These are very useful meetings, especially for the meetings on the margins with big business, small enterprises, MEPs and members of the Commission.

Academy Event in Oslo – 20-21/6/07

As Norway is soon to join the EPC, the Academy organised an event to bring Norway up to speed with EPC matters. As part of this, we were asked to give a lecture on how a new country coped with joining the EPC and to give an introduction to epi. As neither Mr. Finnila nor I were able to attend on both days, Mr. Finnila gave the first talk and I gave the second one. It was interesting to note that the Norwegian attorneys were very interested in the EQE. The Norwegian Patent Office is setting up a register and will only allow those on the register to be entered on the List. To get on the Register, it is necessary to have had at least 5 years experience before the Norwegian Patent Office in patent matters. A number of Norwegian attorneys were concerned that they would not be entered on the Register and therefore would need to take the EQE.

German Patent Court Event – 25-26/6/07

As part of the German EU Presidency, the German Patent Court held an event in Munich. This was concerned with patent litigation in Europe. There were a large number of distinguished speakers and an even larger number of distinguished listeners. A report on the event has been made by the Chairman of EPPC. However, there is nothing much to report. The positions of the various interested circles are not changing very fast. However, everyone makes encouraging noises. There will be a lot of discussion at EU level as to what can be done. This will be led by the Portuguese Presidency. It remains to be seen whether anything comes of it.

epi vs EPO Golf Match

I left the above event in haste to take part in the annual golf match between attorneys and the EPO. This took place in the south of Munich in a gale. At first it looked as

if we would not play at all. However, we were eventually able to play and proceeded to allow the EPO to win again, but only just.

Administrative Council – 26-29/6/07

This was the last AC with Prof. Pompidou as the President of the EPO. A report of this meeting prepared was by Mr. Finnila.

On the Thursday, there was an event in the Residenz Chapel to mark the handover. It started with a musical interlude during which an artist prepared a very large painting behind the orchestra. There were then a number of speeches bidding farewell to Prof. Pompidou and welcoming Ms. Brimelow. I gave one of the speeches. Mine was characterised by its brevity in comparison to the others. The best quote came from Mr. Edfjäll (VP DG4) who quoted Groucho Marx. Marx said:

„One man in a thousand is a leader of men. The other 999 follow women.“

I think he was hoping that the employees of the EPO will act like the 999 and will follow a particular woman.

Working Party on Litigation – 27/6/07

A meeting of the WPL took place during the AC meeting. Nothing of any real note took place. It was mainly held in case the German event had yielded any progress. A report has been prepared by the Chairman of EPPC.

CEIPI Masters Examination – 6/7/07

I was asked by CEIPI to act as a third examiner in the final presentations by the candidates on CEIPI's course on the business of patents. A number of the candidates were epi members. It was a very interesting exercise and I learned a lot. This was followed by a celebratory dinner which was also attended by Vice President Nuss.

Meeting on Education and Finances – 25/7/07

This meeting was held at the epi Secretariat. A report is provided elsewhere.

UKIPO Focus Group on Litigation

The UKIPO holds regular meetings where it asks its users for their views on developments in the Patent field. Usually, they invite representatives of the UK patent community. In this case, however, they invited me as President of epi. They were discussing the developments in the area of litigation and trying to get a feel for the areas where there may be possibilities of moving forward. I put forward the epi view that, in general, we are in favour of the EPLA provided that it remains an optional agreement. The view of the UK users was that we should proceed with EPLA, but with a few changes, as soon as possible.

Meeting of the Labelled Members – 10/8/07

A report on this meeting was prepared by Mr. Finnila.

Meeting of Ad Hoc Group on Amendment to REE – 4/9/07

Some progress has been made towards reforming the Regulation on the EQE. However, the matter is now in

the hands of the EPO. A part of the report of PQC relates to this.

Meeting on Education and Finances – 4/9/07

A part of the PQC report relates to this.

Committee on Patent Law – 10-11/9/07

A report will be provided by the Chairman of EPPC.

Supervisory Board of the EPO Academy – 11/9/07

At this meeting, the main emphasis was again on finances and accountability. The Board is very keen to ensure that the Academy spends its money on projects with measurable benefits. The proposed budget for next year still includes a large sum for training professional representatives.

As usual, Vice-President Nuss kept a close eye on matters relating to CEIPI and IEEPI. Reports relating to the meetings he attended were sent to Council.

Mr. Jorritsma represented epi at a co-ordination meeting for NGOs at an AIPPI meeting in Singapore. Mr. Christiansen also represented epi at the AIPPI meeting.

Mr. Johnson represented epi at the FICPI meetings in Seville.

As noted above, I was involved in discussions relating to harmonisation of patent law. I had prepared a draft paper with the great assistance of Mr. Leyder and Mr.

Lyndon-Stanford. After the meeting of the Committee on Patent Law, I was asked if the paper could be made an official CPL paper. I therefore submitted the paper to the Secretariat of the Administrative Council and it has been issued as a CPL paper.

I attended to Partnership for Quality (PfQ) meeting on 10th October, 2007. A report on this will be provided by EPPC.

After the PfQ meeting, I met with Mr. Philpott and Mr. Machwirth regarding the invigilation of the EQE. Further discussions of this matter will follow.

I then attended the first part of the meeting of the tutors with the examination committees. This was very interesting, especially in respect of paper C. It is a very lively meeting and shows how keenly both the examination committees and the tutors work to make the EQE a proper test for candidates. The examination committees certainly took copious notes on the points made by the tutors.

I then attended the award ceremony for successful EQE candidates at which Ms. Brimelow, Mr. Philpott and I gave short speeches and presented the successful candidates with their diplomas. This is a most enjoyable event and I trust that at least some of the successful candidates will feel inspired to become tutors and members of examination committees.

Treasurer's report

C. Quintelier (BE)

A. Financial situation on June 30, 2007

The 2007 contribution was generally paid well within the normal time limit and only 358 members did not pay within this time limit. In comparison with 2006 this shows a stable figure. A point of some concern is that in the first half year of 2007 there were 102 new members registered and 197 deleted. Is this a first signal of a reduction of our total number of members? We will have to watch this. Another point of concern is the income on the epi tutorials. For the summer tutorial there are more tutors than candidates! Hopefully the autumn tutorials will show a more favorable picture.

On the expense side it should be noted that the „train the Trainers meeting“ in May of this year did imply a cost of 65 638€, without the payment proposed to the epi speakers.

B. Education

Pursuant to the discussions within the PQC Working Group on Education and in consultation with the Finance

Committee, it is proposed to create a post „Education“ in the budget. This post includes the former posts of epi tutors, CPE seminars and CEIPI/epi seminars. The inclusion of all those posts in a single education one seems self-explanatory. The post education does not include the epi Students, in order to maintain monitoring on how their number evolves.

The education post has an income part and an expense part. The income will come from what the participants pay for participating to seminars and lecturers organized by epi as well as from candidates requesting an epi tutor. The foreseen expenses are for covering the costs relating to the seminars and lectures, the tutor meeting and for paying a director of education who has to be nominated.

C. 2008 Budget

Continuing with the education topic, one will observe that in the 2008 budget the expenses in the education post are higher than the income. It is thus proposed that

epi partially finances from its resources the education of his members and future members.

The 2008 budget was based on 8 700 members. This takes into account that Norway will join EPC as from January 1, 2008. Further on the income side the amount coming from *epi* Students has been reduced by 3 000€ with respect to 2007, as we will not repeat in 2008 the EPC 2000 effect.

On the expense side the post relating to Council and Board meetings have been somewhat increased to take into account inflation and the fact that Norway will join.

The post for the President and Vice- Presidents has also been increased with respect to 2007 in order to cope with the fact that they are more and more requested to represent *epi* on different events, which requests a high flexibility from them and thus also from *epi*.

As 2008 is an election year, an increase on personnel and auxiliary costs, as well as on postage costs is foreseen.

D. EPC 2000 Seminars

The EPC 2000 seminars are generally running well and several are planned or already took place. In a majority of the EPC Contracting States the information relating to EPC 2000 is thus or will be provided to our members. As most of them are scheduled for the second half of 2007, the first half year figures clearly do not form a basis for extrapolation over the whole year. Only a few EPC seminars took place in this first half year and by the end of June not all costs of them could have been booked simply because some invoices were not yet received.

In order to remind the trainers on their engagement to present seminars and respect the copyright on the material provided to them, a letter was sent to them on September 4, 2007. The European Patent Academy and the *epi* secretariat have regular contact with each other in order to be mutually informed on how the EPC 2000 seminars run.

Report on the EPO/*epi* Biotech Committee Meetings of 27 October 2005 and 6 December 2006

A. De Clercq (BE)
Chairperson

In Attendance from the EPO were : Fernand Eiden (Principal Director, Joint Cluster Biotechnology), Maria Fotaki (dir. 1212, the Hague), Christian Gugerell (dir. 2405), Reinhard Hermann (dir. 2402), Bernd Isert (dir. 2404), Uli Thiele (dir. 2403), Siobhán Yeats (dir. 2406), Francisco Hernandez (FH,1212)¹, Sjoerd Hoekstra (SH, 1223)², K. Doepfer (KD,2404)³

In attendance from the *epi* were several members of the *epi* biotech committee. In 2006, our liaison person from EPPC also attended the meeting.

The following items were discussed at these meetings

1. Stem cells

In 2005, the EPO comments that they were forced to be guided by the Edinburgh Decision. In EPA 98966817.3 (Brüstle) the Examining Division had granted a Fifth Auxiliary Request with a disclaimer (namely of cells obtained without destruction of embryos).

An embryonic stem cell case (95940117.5) had been refused in 2005 under Article 83, with a 1994 priority date (so before the Thompson/WARF case). This has

been Appealed (T1253/04, Board 338). In the meantime the stem cells referral, arising out of the WARF case, was pending as G2/06. It was noted that the WARF hearing was scheduled.

In 2006, the EPO remarked that they saw on TV that a DE court had revoked a Brüstle DE patent insofar as human stem cells were concerned. The EPO will not now automatically stay relevant (stem cell) cases. Instead, the EPO may ask applicants if they want a stay, and will stay proceedings if requested to do so.

In 2006, it was commented by the EPO that we may get the stem cell decision in, perhaps, 1-2 year's time

It was mentioned in 2006 that there would be a Referral on plant breeding case (T83/05) under Art. 53(b) (and may involve Rule 23b being reviewed to see if it is conformity with this Article). The questions to the Board had not yet been decided at the time of the meeting⁴.

Article 53(a). It was commented in 2006 by the EPO that there is only one other decision on this topic, which follows the Oncomouse decision. If an animal is suffering and there seems to be little medical benefit then an objection will be made. The EPO considers ethical committees reports but makes its own decision. If there is a screening method including an animal one may receive

¹ Only in 2006

² Only in 2006

³ Only in 2006

⁴ Now pending as G 2/07

an objection that the method covers a clinical trial (especially if 'animal' includes humans) but one will usually be able to introduce a disclaimer (eg. to non-human) to overcome this. The EPO has an in-house ethical working group that may advise examiners.

2. Predicted Function of Genes and Proteins

In 2005, the following matters were discussed:

i. case law. The *epi* thought they detected a divergence in decisions on this topic between Boards 334 and 338. In T179/01 (Board 338) the art disclosed an ORF and a hypothetical function. The opponent argued that this was novelty destroying but the Board disagreed. In another decision Board 338 decided the prior art was irrelevant, and therefore there was no need (or justification) for the disclaimer. The patent was therefore revoked as the Patentee could not remove the disclaimer without offending Article 123(3). This was regarded as being rather harsh.

It was commented by the *epi* that Board 338 seemed to be quite strict, and does not always follow individual decisions, often preferring to use the White case law book. If possible, applicants should try and avoid disclaimers.

The EPO advocated the need for fallback sets of claims, for example to first and second medical uses, without the need for a disclaimer.

The *epi* wondered whether Examining Divisions had been set a policy not to allow broad claims. The EPO denied this, but acknowledged that such claims would normally be objected under Articles 83 and 84. The EPO said that no special instructions have been given to Examiners on this particular topic.

ii. Arts. 56/57. The EPO referred to T870/04, where there had been a refusal for lack of industrial applicability under Article 57. This was to be compared with the Genentech APO3 case (T70/05).

The *epi* referred to the Johns Hopkins case (T1329/04) where inventive step had been denied as there was allegedly no function, and compared it with T182/03 (which allowed the case) as the protein was thought to be a drug target.

The EPO said that the White case law book is aimed to be republished every second year, and there will be a new version of the Guidelines for Examination.

iii. antibodies. There was a discussion of antibody claims, and in particular the meaning of „specific“ when referring to binding. Applicants often argued that the „specific“ binding rendered the claim novel: the EPO agreed that the burden of proof is then on the Examiner to show lack of novelty. However, it was pointed out that such lack of novelty objections are often raised if the prior art protein (to which an antibody had been raised) was very similar to the one claimed. Some attorneys had received lack of enablement objections to antibodies where the protein was known, but the

EPO thought that antibodies were usually enabled once one had the protein

In 2006, the following matters were discussed:

The *epi* commented that the case law now seems to refer to „plausible“ rather than „credible“ function. How is the case law being interpreted?

Galligani's Board is developing the case law, in particular on how much information is needed to satisfy Arts. 56, 57, 83 and 84.

In T898/05 the Board accepted post-filing evidence for Art. 57 (but not Art. 56). The test seems now to be one of profit, or of immediate concrete benefit. T1329/04 also suggested post-filed evidence was not possible for inventive step.

T182/03 *did* accept post-filed data (namely of being a possible drug target, and evidence of the drug itself).

T870/04 found against applicant, perhaps because the use was too vague, but for better known fields (e.g. cytokine, chemokine receptors) the Board seems more inclined to allow post-filed evidence.

T1329/04 said that the additional evidence cannot be used to solve the problem over the whole area, but can be acceptable if it supports the solution. The EPO said that in practice Examiners will usually accept post-filing evidence.

The *epi* said that attorneys cannot be sure how the EPO is interpreting the case law and which decision Examiners will follow (the case law seems to be confusing). The EPO replied that they are in a development stage and so it is presently difficult to establish some general rules. If it is unclear then Examiners will tend to be more permissive. The EPO admitted that not all instructions are followed by all of the Examiners, indeed it is very difficult to regulate. The EPO said that the case law is in a state of flux but noted that T870/04 was highlighted in the annual review of case law. Many decisions in this area will not be published, however.

As for disclaimers, the stricter of the 2 possibilities will usually be followed by Examiners. Other Boards seem to have followed Galligani's restrictive approach.

The Galligani Board is expected to show a line forward in several areas. Art. 57 is now to be used, but perhaps only in extreme cases. Even if a product can be „made in industry“ then this is not enough. The EPO thought that even though Art. 57 is broad it is non-sensical to only need to be able to make the DNA. Examiners usually use both Arts. 56 and 57 in their objections. The EPO thinks that Examiners are probably on safer grounds under Art. 56.

T898/05 seems to be a step back from the more restrictive interpretation on Art. 57. The *epi* asked how the prior art is interpreted if it states a function. The EPO said that the same standard should be applied. In fact in one biotech Directorate a case was recently granted where the prior art function was not found to be plausible. One other example is

where the prior art speculated on vaccines but no examples of vaccines were provided in that prior art document.

The EPO mentioned T609/02, which is a further decision on second medical use claims, and for Art. 83 one needs at least one example of that use.

3. Summons to Oral Proceedings

In 2005 the following was discussed:

- i. frequency. There were complaints from the *epi* that summons to oral proceedings were now becoming too frequent. The EPO pointed out that the chairman always reviews the Summons, and it should normally be signed by all three examiners. It should not be an „omnibus“ summons, and it must point out the documents relied upon. The EPO encouraged applicants to phone the Examiner or Chairman if they felt aggrieved.

The EPO pointed out that most (60 % or more) of oral proceedings were cancelled. The EPO pleaded for attorneys to inform the EPO at least two days in advance if they were not attending, and, if possible, to also phone and/or e-mail the Examiner. (Note that the standard format of a person's e-mail address at the EPO is: first initial (only) then the family name@epo.org). The *epi* said that some representatives had tried phoning an Examiner, but they only got the answering machine!

- ii. responses. The *epi* said that they found some Examiners did not specifically comment or reply to arguments, but would simply just come back with a sentence saying, e.g. a skilled person would have been able to perform the invention. The EPO invited attorneys to phone the Examiner if they were concerned about the objections they were receiving. It was noted that some Examiners are reluctant to have informal interviews since no decision can be made, and the claims can always be amended afterwards.

The *epi* noted that it can be important for some applicants to receive a positive opinion before committing to the expense of entry into the national phases.

- iii. delays. There was a discussion of the Paris criteria that is placing the EPO under pressure. The EPO does not always want to speed up grant, and attorneys were encouraged to make appropriate representations to senior EPO personnel on this point. The EPO thought that very few companies actually complained about the backlog of their cases.

The EPO commented that they would encourage attorneys to talk to Examiners, but personalities varied, and some enjoyed the contact, while others did not.

In 2006 the following was discussed:

The *epi* admitted that there had been some exceptional cases where oral proceedings were used to put pressure on the Applicant. It is, perhaps,

unfair on small, impecunious applicants. One representative had received a summons to oral proceedings after he had amended the description since the Examining Division had changed (and so had the view on allowance). The EPO said that this behaviour was unusual. Certain directorates are instigating more summons to oral proceedings as they think that it is a particularly efficient way of dealing with cases.

One representative said that he had delayed a case that was ready for allowance where the applicant was concerned about the post-grant validation costs. The EPO thought it would be nice if we could sort it all out in writing after two examination reports, but some applicants are holding out for too much (the *epi* replied that we do not always agree with the Examiner!). At the Summons stage all 3 Examiners are involved.

The *epi* thought that Examiners in The Hague issued more summons to oral proceedings and earlier. The EPO thought that the process was thus more streamlined! The *epi* said that some summons can include new prior art and new grounds, esp. after first response. The EPO thought that this was inappropriate and should not happen.

The *epi* asked about informal interviews. The EPO said Examiners spend a similar amount of time as for oral proceedings, but for oral proceedings there is a final decision. Phone calls to/from the Examiners are, though, welcome. The EPO encouraged attorneys to phone Examiners, but the *epi* said that sometimes answering machines are not working. Apparently the default system on the telephone is not to accept messages, so one has to program the telephone specially to take messages!

The *epi* said that the adaptation of the description can vary as to extent and when (at oral proceedings or later). The EPO answered that there were discussions inside the EPO to scrap this requirement, as in the USA. Examiners do not usually place much weight on the adaptation. Whether you must adapt on the day may depend on the time of the day the decision is issued. If it is at 2pm, yes, but perhaps not at 7pm in the evening. The EPO thought that Examiners now were more reliant on Applicants amending the description and are less stringent.

4. Diagnostic Methods

In 2005, the EPO thought that the Enlarged Board of Appeal Decision would be published by the end of the year, as two members of that Board were expected to retire before the end of 2005. Decision T1020/03, concerning second medical use claims, may not go to the Enlarged Board in view of EPC 2000 coming into force.

In 2006, the *epi* said that G1/04 is not particularly clear, so what is the Examiner's practice? There are now 5 decisions since G1/04: T152/02, T143/04, T1123/06, T619/03 and T1102/02. The EPO said that they will circulate an instruction note, especially after decisions

from Board 3.2.02. Claims are likely to be allowable if there is only one (data collection) step. One case involved measuring lung function and so one needed to collect air, this was interaction with the patient. A separate decision suggested that one cannot just rewrite claims to refer to one step, rather than 4, under Art. 84 and 123(2) EPC. The EPO said that they will thus issue internal guidelines (not available to the public, including the *epi*!). The Guidelines will not change for a while as their major review has been postponed until after EPC 2000. Internal advice will be in the form of newsletter to the Examiners, so it will not be an official document. The EPO may still accept a one step method even if the claim refers to a 'diagnostic method' so one can pay less attention to literal wording. The EPO is unlikely to insist on inclusion of other 3 steps if the method has only got one (eg. data collection) step.

5. Origin of Biological material

In 2005, the *epi* noted that some countries require this in their national law. The matter is currently under consideration in WIPO, and the US is against it. The EPO commented that it would not have a big impact on EPO procedure, but thought that it could be introduced in a few years time. The EPO at present is just observing, rather than commenting, and is not playing an active role in the debate.

This item was not debated in 2006.

6. Priority exhaustion

In 2005, it was argued that there were two conflicting decisions (T98/99 and T15/01). The EPO clarified that the second, and later, decision should be followed and the first one ignored, so that there is no change in practice.

This item was not debated in 2006.

7. Divisional Applications

In 2005, this issue was debated but is now of course all history in view of the decisions of the Enlarged Board of Appeal.

In 2006, the divisionals were not debated further.

8. Rule 51(4) Procedure

In 2005, it was mentioned by the EPO that apparently there may be new guidelines for the Examiners. There are two situations where changes may be allowed, namely where auxiliary requests have been filed, and the Applicant wants to return to his main request, or where the Examiner wants to make amendments without the consent of the Applicant.

In 2006, the *epi* said we see many amendments by the Examining Division (and not by the Applicant) in the Druckexemplar. Examiner's instructions are *not* to amend the claims without first contacting the representative – this is EPO policy (unless the change is relatively

minor, e.g. deletion of an omnibus claim). The *epi* said that some Examiners think the amendments do not change the scope, but attorneys can disagree. The EPO pointed out in the Guidelines there are exceptions when one does not need to pay the fees and file translations. If the Applicant says do not amend description or claims (unless contact Applicant first) then the EPO said Examiners should not make any amendments (unless they are purely trivial).

9. Other matters discussed in 2005

- i. A consensus was reached that a consolidated document, containing a summary of the minutes of the DG2/*epi* meetings, could be published in the *epi*.
- ii. process claims. G2/88 seemed to acknowledge that there were two types of process claims, but it was doubtful that the two-part claim (where one first identifies the compound, then manufactures a composition containing it) would actually give protection for the final composition.
- iii. Lack of unity. There were concerns, however, in the EPO about Rule 29, and complex applications, partly resulting from the US *Festo* decision. The EPO encouraged an Applicant to amend claims to deal with disunity, especially when he thought that the document showing potential *a posteriori* disunity was actually mentioned in the specification by the Applicant himself. It was pointed out that this depends on how one interprets disunity, and Applicants are not going to file lots of (additional) cases, especially in advance, as it was not possible to accurately predict future EPO objections.

The *epi* commented that Examiners seemed to be too keen to find disunity, so that they could easily restrict their search only to the first invention. The *epi* acknowledged some Examiners can be rather formalistic on this point, but the EPO commented that there is intense pressure to be more efficient. The *epi* commented that under BEST, Examiners rarely went back on their opinions at the search stage, but the EPO said that it is the entire three man Examining Division that deals with substantive examination, and so there are two other Examiners involved at this stage.
- iv. strategy issues. The EPO was concerned that Applicants were filing too early, so that there is little exemplification in the specification. This of course leads to problems later on. The *epi* pointed out that there was always a balance to be struck between filing before ones competitors and waiting for more data. The *epi* said applicants are aware of the problem, and said that experiments can be difficult, expensive and time consuming.
- v. (in)activity. One attorney noted that his case had been particularly inactive for a long period of time. It turned out that the Examiner was on maternity leave. The EPO invited attorneys to contact the Chairman or Director to find out the status, or why there was a lack of progress.

10. Pathway claims {use of an antagonist to receptor X in the manufacture of a medicament for treating disease Y}.

In 2006, the EPO said there can be problems with this type of claim under Arts. 83 and 84 EPC, as (possibly) the antagonist is unclear and can cover future (as yet undiscovered) antagonists. Functional definitions are usually allowable if they satisfy the 3 criteria:

1. antagonists are known (eg. from text books, not just prior art),
2. antagonistic function can be easily verified (by known techniques or those in specification),
3. data in application shows problem has in fact been solved.

There may be objections at the search stage, of course. The EPO can give us a list of Board of Appeal decisions relevant to these issues and „pathway claims“ (note T669/04 is from biotech board), they are: T68/85, T435/91, T893/02, T107/00, T669/04, T336/00, T1286/01, T125/02, T143/04 (the most important), T1123/06, T619/03 and T210/02.

11. 3D Structure claims

In 2006, the EPO said that these would be interpreted as a reach-through claims, as the compound is completely undefined. They argued that in most cases no compounds are disclosed, merely pharmacophores which could be considered as presentation of information. The EPO cannot yet search 3D structures (there is one database, but not yet complete). The EPO thought they

could search it if the compound was an antibody. They also referred to the trilateral project (case 8), issued in 2001.

12. Timeliness/Paris Criteria

The *epi* was not generally in favour of the Paris criteria, as we can always request accelerated processing.

The EPO said industry would like competitor's patents granted quickly, but not their own cases. The *epi* said the DE PO allows 3rd parties to request examination. The *epi* said that EPPC will be writing a paper on the Paris criteria issue. They also mentioned that the relevant AC decision says that the quality must not decrease in use of the Paris criteria; we were encouraged to emphasise this before the EPO.

The EPO requested whether we would want a search at 6 months, rather than 9 months, on a priority filing? The EPO commented that an earlier one might just miss the odd publication. Perhaps allow the applicant to choose between the two options?

Remarks to conclude:

The EPO commented that they enjoyed the meetings, and wanted to build a partnership between the two parties. The *epi* Biotech Committee finds these meetings very useful and hopes that they can continue to be held on a yearly basis. The items for discussion for these meetings are set in advance by both parties.

Another meeting was scheduled for October 24, 2007. A report of this meeting will be published in *epi* information in the near future.

Report of the Disciplinary Committee

P. Rosenich (LI)
Chairman

For 2007, four complaints have been received until now. Only three of them have been designated to respective Chambers. One was solved by the Chairman of our Committee by Mediation. One of the other cases relates to a former *epi* Member who was deleted from the List by Rule 102(1) EPC. As this ex-Member still allegedly creates trouble with respect to clients and/or other colleagues, the disciplinary bodies will have to consider how to treat this case. One option is seen in a referral to the Disciplinary Board with the proposal to sanction by not allowing to re-enter the List for a certain time. This case is still under consideration by the responsible Chamber. In another case some difficulties arose due to the fact, that the complaint – although properly designated to the fixed German-language Chamber –

contains plenty of documents in French. This problem will be solved by some internal help of another French speaking Member of our Committee.

The fixed Chambers of the DC are well prepared to deal with all complaints currently pending.

For 2006 all four Complaints that have been decided by an intermediate decision (interruption of proceedings), have been reopened and closed after successful Mediation of the responsible Chairman of the responsible Chamber. One case is not decided and the Registrar – in close contact with the Chairman – urged the responsible Chamber to file a request for extension of time or to hand out the decision. Against one decision an appeal is pending.

For 2005 one complaint was rejected after the Complainer contacted the President of *epi*. The President investigated and learned that the Complainer's accusations are too blurred to be of use in a proceeding in our Committee and hence confirmed the rejection of this case.

Earlier years: all cases are decided by our instance.

DC-Members

The long standing Member Mr. Klaus Schmauder/CH left the Disciplinary Committee and was honoured by the Chairman of this Committee for his valuable work in the past. The Chairman requested the Swiss national organizations for European Patent Attorneys to instantly nominate a fresh Member in order to have him/her elected by the Council. The Chairman respectfully advised that in order to assist proper operation of our fixed Chambers, Switzerland should nominate a Member with working ability in French.

Development of Disciplinary Committee

The long standing debate of the function and usefulness of our Committee seems over. As the standards have been improved, as the qualification of the Members has been improved and as the Committee has drawn a clear line assisted by the Council and by the President, the activities and pressure of Members of the EPO towards our Committee have been – seemingly – stopped and relieved.

Further development of the Mediation Skills of the DC-Members

Sofia Trainings-Meeting and debate called for a second training session on Mediation for the DC-Members. Istanbul Council allowed a further Budget of Euro 2500 for such further training. For that reasons such further training Seminar will be held at the DC-Meeting from Oct. 19th to Oct 20th 2007 in Nuremberg. The Chairman of DC invited again Prof. Dr. James Peter of

Switzerland in order to receive his valuable training instructions at said DC-Meeting. Due to successful negotiation with Prof. Peter, the costs could be kept low and the allowed Budget will not be used completely.

EPC 2000

The Chairman, assisted by a DC-Officer and another DC-Member of a new Member state discussed with the responsible EPO Members of the legal department the amendments to the Additional Rules of procedure of the DC.

All Members have been invited to comment on the final proposal and all comments have been considered. The final proposal was then discussed in the EPO-Committee on Patent Law, where the Chairman of EPPC as briefed by the Chairman of our Committee represented *epi*'s opinion. The final draft was also allowed by the EPO-Committee on Patent Law, and it is believed that said final Draft of the amended Additional Rules will be implemented by the Administrative Council of EPO in due course.

Regarding the needs for amendment of the Additional Rules of Procedure of the Disciplinary Board and the Disciplinary Boards of Appeal the Chairman of DC prepared a paper which was then presented by the Chairman of EPPC before the Committee on Patent Law. Said paper was based on comments which have been received by Mr. Leo Steenbeek (EPPC), said DC-Officer and said DC-Member of DC.

Unfortunately due to resistance of EPO the proposed improvements have not been accepted by the Committee on Patent Law and hence will not be forwarded to EPO's Administrative Council. However other EPC-based amendments of said regulations as prepared by the EPO were checked and confirmed by the Chairman of DC. Please find attached the Additional proposed amendments on paper XXX *epi* e of 8.9.2007 and the Final amended Additional Rules as decided by the Committee on Patent Law CA/PL 12/07 e and CA/PL 13/07 e,d,f and 14/07 e (Amendments to the Regulation on discipline).

DECISION: NO Decision of the Council necessary

Themed issue 1/2008

„Effects and Expectations of EPC 2000“

Submissions are requested as soon as possible,
at the latest by 31 January

Editorial Committee Report

W. Holzer (AT)

The Editorial Committee met on 4th July 2007, in Munich. The Committee *inter alia* dealt with the following topics:

1. epi Information

1. *Circulation*: The number of copies has been increased from 9.500 to 9.700 as from issue 1/2007.
Overall costs are approximately 20.000 EUR per issue and remain stable.
2. *Forthcoming issue and further issues*
Terry Johnson will try to arrange an interview with the new EPO President, Mrs. Brimelow.

Issue 4/2007 (deadline 2 November 2007) will contain the Council Meeting and Committees reports, standard info (invoice, payment rules etc.) as well as the publication of presentations at the 30th Anniversary Celebration of *epi*. The speakers should provide their contributions electronically in due time.

Issue 1/2008 will be a themed issue „Effects and Expectations of EPC2000“. The deadline for issue 1/2008 will be set at the beginning of February 2008 (2 weeks earlier as usual) because of the election results which should be published by 15 March.

Issue 4/2008: Since the autumn Council meeting will be held on 24-25.11.2008 only, there will not be enough time available until Christmas to get the various Committee reports in time. It was therefore decided to restrict the publication of papers related to the Council meeting to a Council report which will be drafted in English by T.

Johnson on 25 November and translated into German and French, respectively by W. Holzer and T. Schuffenecker. The Committee reports will be published on the website.

2. epi – Website

1. *Search Index*: The Search Index has been implemented and is working.
2. *Extranet*: The Committee had various meetings with the Datenwerk with reference to Kim Finnilä's paper presented at the last Council meeting which suggested setting up different levels of access.

The Extranet will comprise the following access levels: Presidency, Board, Council and the following Committees: By-Laws, *epi* Finances, Professional Conduct, EPO Finances, EPPC, PQC, Biotech, Harmonization, OCC and Editorial Committee. Passwords are required to access the different groups. The Extranet was ready for being tested by the labelled members at their meeting on 10 August 2007. A demonstration will be given at the Nuremberg Council meeting.

3. *Website updates*: The surveys „The Patent Profession in the EPC Contracting States“, published in *epi* Information 1/2007, as well as E. Lyndon-Stanford's survey on „Representation in National proceedings for Patent matters need continued updating with the *support of Council members*.

A list of newly elected Council members (without their contact details) will be published next year (to date there is only a list of Board members and Committee members).

Report of the European Patent Practice (EPPC)

E. Lyndon-Stanford (GB)
Chairman, EPPC

The Ratification of EPC 2000

The revised text will enter into force on 13th December 2007. The EPO expects that all member states will have deposited their instruments of ratification though it is possible that one state may have a problem.

The work of the EPPC

We have reviewed the EPC 2000 Implementing Regulations insofar as they apply to patent practice and have reviewed the first publication of the EPC 2000 Guidelines. We have considered most aspects of oral proceed-

ings and procedures before the Boards of Appeal. In addition, the Partnership for Quality meetings, initiated last year by the EPO, have introduced new issues.

This year, we have had one day meetings in Munich on 19th April and 9th October. The next meeting is on 23rd and 24th April 2008, a day and a half meeting.

The EPC 2000 Implementing Regulations

The EPC Sub-Committee under Mr. Francis Leyder reviewed the EPC 2000 Implementing Regulations and advised which Rules should be considered for requesting (further) amendment. Council approved the following papers:

- *Rule 36 and misuse of divisional applications* (the EPO is concerned about repeated filing of divisional applications) – Council supported initially taking administrative measures to deter misuse, with no change in the Rule;
- *Rule 36(2), language of divisionals* – to enable the text of the divisional to be in the same language as the parent if the parent was filed in a non-official language, and thus avoid any conflict with Rule 35;
- *Rule 45(2), etc.*, the consequence of fees on filing being paid by automatic debiting – to enable applicants to reduce the number of claims after filing and to pay a correspondingly reduced claims fee;
- *Rule 56, missing drawings* – to cover parts of drawings;
- *Rule 60(1), designation of inventor* – to require a communication to be sent to the applicant;
- *Rule 69, communication of publication* – to avoid the possibility that as the EPO will no longer send the published European search report and as the communication under R. 69(1) may not be received, the applicant may not receive notice;
- *Rule 85, etc.*, registering post-grant transfers – to deal with the problem that at present transfers of the patent cannot be recorded at the EPO after the opposition period or opposition proceedings, which is relevant to determining who is the proprietor when applying for limitation at a later date;
- *Rule 136(3), re-establishment of rights and further processing* – to make the Rule comply with Art. 12 PLT by omitting the refusal to accept a request for re-establishment of rights in respect of any period for which further processing is available.

Rule 4(6), the minuted language of statements made in oral proceedings, is under active consideration.

Rule 30, sequence listings for nucleotide or amino acid sequences, is under active consideration by the Biotech Committee, with the assistance of the EPPC.

Rule 71, the grant procedure, is under active consideration.

The EPC 2000 Examination Guidelines

The Guidelines Sub-Committee under Mrs. Anette Hegner will review the final English version of the

Guidelines and also review the French and German versions

The EPO is proposing to review the Guidelines in the future on a continuous basis and has also proposed the formation of a standing EPO/epi Guidelines Sub-Committee.

epi-EPO Liaison

The Liaison Sub-Committee under Mrs. Gabriele Leißler-Gerstl is responsible for attendance at the Vice-President's meeting and the Partnership for Quality meetings and to a certain extent is responsible for submissions made to the annual meeting between SACEPO and the Boards of Appeal (MSBA). The Sub-Committee has considered the various issues raised at the Partnership for Quality meetings and has also thought through the problems which arise in connection with procedures before the Opposition Divisions and the Boards of Appeal, especially in relation to oral proceedings. As a consequence of the work done by the Sub-Committee, Council has agreed papers on the following questions:

- *the Paris Criteria* (maximum period to grant of European patents), including steps that could be taken by the EPO to shorten the period to grant – Council agreed to a flexible approach, including deferred examination;
- *the UK IPO Code of Practice* – Council voted that it was not desirable to have such a code;
- *double patenting* (claims having the same scope in two different applications) – in general terms, Council voted against allowing this;
- *oral proceedings – setting and changing dates*, time for parties to object to the date proposed – Council approved this;
- *holding oral proceedings in different places*, provided different places were not appointed within a short time of each other and provided proper attorneys' facilities were available at each place – Council approved this;
- *amicus curiae brief on G 01/07* – the paper supported the grant of the patent and was approved by the Biotech Committee and by Council.

Amicus curiae brief on G 02/07 – the EPPC will assist the Biotech Committee.

The EPPC will continue working on a draft position paper on *auxiliary requests and late-filed documents in oral proceedings* before the Opposition Divisions and the Boards of Appeal (including costs as a sanction), to determine what position the epi should initially take, with a view to preparing a further position paper proposing that there should be the same rules for all the Boards of Appeal (not the Opposition Divisions) and what those rules should be, or failing this, requesting that each Board of Appeal publishes its rules.

The Commission and the European Parliament have considered *sleeping patents* but the EPPC will not review the question until a formal report is issued.

The EPPC will agree with the Biotech Committee a discussion paper on *disclosed and undisclosed disclaimers* (adding disclaimers to claims), with the intention of publishing the paper in *epi* Information.

The EPPC will consider the extent to which a *recording of oral proceedings* should be available to the public.

The EPPC has assisted Mr. Finnilä in providing the EPO with a *list of facilities* which would be desirable in attorneys' rooms for oral proceedings.

Partnership for Quality meetings

In the last half year, there has been one Partnership for Quality meeting. Although strictly these meetings should be discussing only quality of examination and granted patents, they are a useful and friendly forum for discussing many problems that arise during the prosecution of patent applications. The main topics were:

- the desirability or otherwise of raising the level of invention required for the grant of European patents and what could be done within the existing legal framework, mainly improving the quality of the examination and looking at what ability one could expect of the person skilled in the art as well as considering the effect of the problem/solution approach – at present the EPO has no intention of changing the EPC or the Rules;
- what statistics and metrics are available for measuring the level of the inventive step;
- improving the quality of the applications filed;
- what measures the Office is taking to speed up grant;
- the evaluation of a sample of the files of granted patents.

SACEPO

Within the terms of reference of the EPPC, the following topics were discussed:

- the EPLA – the President of the EPO suggested that the desire for the EPLA was waning (see later in this report);
- the utilisation pilot project – national offices disclosing their search reports to the EPO – this is being done with the GB, DE, AT and DK offices on the basis of a restricted number of files – the operation will be assessed and reported on during 2008;
- trilateral (EPO, USPTO and JPO) work-sharing (see later in this report);
- quality issues of practices and procedures, the EPO monitoring and assessing as well as setting up standards and metrics to measure whether those standards are being achieved;
- the electronic priority document exchange – which is being implemented.

MSBA (meetings of SACEPO and the Boards of Appeal)

The June 2007 meeting was friendly and we had had some success in explaining the point of view of attorneys when discussing the various items. We discussed the following topics:

- recording oral proceedings and the detail of the minutes of oral proceedings;
- case management by the Boards of Appeal;
- inappropriate behaviour by patent attorneys during oral proceedings;
- late-filed documents, auxiliary requests and costs as a sanction against late submissions;
- setting and changing dates for oral proceedings;
- electronic filing of appeals and appeal briefs;
- decisions on the „state of the file“;
- notifying the EPO if a client has no further interest in the proceedings;
- shortening the time between filing an appeal and the decision;
- level of inventive step – the Boards of Appeal pointed out that they are not a political or policy-making body and merely had to apply the law – there is no doctrine of precedent and each Board has its own view of how the law should be applied, but the person skilled in the art was not taken as an idiot with no brains.

The level of invention for European patents

The EPPC voted by a large majority that the level of invention should be raised. However, the feeling of the October 2007 Council meeting was that the level as defined in the EPC and Rules was about right but that the EPC criteria should be applied more strictly.

A Patent Jurisdiction for Europe

Response to the February 2007 Commission Communication on the Future of Patents in Europe (the Commission suggestions as to the way forward to achieve a Community Patent)

Council agreed the EPPC paper, which supported a compromise proposed by the Commission, between EPLA and the 2003 Community jurisdiction, and which approved of the creation of a unified and specialised patent judiciary outside the ECJ, working under common rules of procedure and comprising both legally and technically qualified judges, with no obligation on all states to adhere.

The EPLA

There was a meeting of the EPLA working party on 27th June 2007.

The Commission representative gave a report of the discussion in the recent Council of Ministers. They discussed the three alternatives proposed:

- a) the EPLA;
- b) the French proposal;

- c) a compromise between (a) and (b) – decentralisation of the courts of first instance, centralisation of the court of appeal and a technical qualification in the courts.

It was noted that (a) was the most developed, that (b) was better suited for a uniform patent jurisdiction but needed more work, and that there were no details of (c).

The EU Commission representative commented that technical expertise was guaranteed but that it had to be discussed whether it was through technically-qualified judges or having technical assistants with no vote. It was noted that there was support for the details in the EPLA.

EU Council working document, 10th October 2007, „Towards an EU patent jurisdiction“

This is the most recent proposal, originating from the Portuguese presidency. It has not yet been debated by the EPPC or the new Litigation Committee, or by Council. The proposal involves a first instance with a central division and divisions located in the member States or regional groups of Member States if there is enough work for the latter divisions. For litigation, the plaintiff would be able to choose the division where infringement took place or where the defendant is domiciled, if there is such a division. There would be a central second instance. The central division and the second instance would be specialised (with mixed chambers of legally and technically qualified judges) but linked to the ECJ. The central division would hear all self-standing validity cases and at the request of the patentee any linked to infringement cases. The language would be an official language of the Member State or group if the language of the patent is not agreed. Before the central division, the language would be the language of the patent.

The Trilateral (EP, US, JP) Proposals – Trilateral Standard Format Pilot Project (TSFPP), also called Global Patent Application (GPA)

Mr. Hatzmann has participated in the meetings and in the preparatory work, drafting a specification in the standard format tentatively agreed by the EPO, USPTO and JPO. He estimated that it would take an attorney about 30 minutes of extra work to comply with the format proposed. Council approved a paper stating that unless applicants are compensated by the offices for the additional costs, the *epi* was not in favour.

The Utilisation Pilot Project (UPP) (collaboration in searching and examination between various European national patent offices)

See the SACEPO report above.

EPPC Archives

The Documentation Sub-Committee under Mr. Peter Indahl is setting up an EPPC archive which will provide easy access to all papers voted on by Council since 1999.

Internet disclosures

A draft paper has been prepared and will be submitted later.

The Litigation Committee and the Patent Documentation Committee

Council agreed that the work of the Litigation and Documentation Sub-Committees should be split off and separate Committees formed.

EPPC Appeal for Assistance

Please note the EPPC „Appeal“ published hereafter.

Comments on the publication „National law relating to the EPC“

P. Indahl (DK)

Chairman of the Patent Documentation Committee

A new edition of the printed publication „National Law relating to the EPC“ was published by the EPO in November 2006. The information in this publication has been provided mainly by the national patent offices.

If you have any comments or possible corrections to the information given for your country, please feel free to direct such to the Patent Documentation Committee at ind@ipb.dk in an e-mail marked National Law in the subject.

Report of EPO Finances Committee

J. Boff (GB)
Chairman

This report addresses the 91st Budget and Finance Committee meeting held 8th to 11th October.

The BFC meeting: –

- made clearer than ever that changes in the applicable accounting standards, while altering nothing of substance in the EPO, presents a less rosy picture than the previous accounting standard and has led to negative perceptions within the EPO and Member States
- that decisions concerning the tax situation of EPO pensioners has had a major one-off impact on EPO finances that has aggravated these negative perceptions
- that the Office has a view of developments in the patent arena that may lead to some uncomfortable decisions in the future.

IFRS

The EPO has moved from the former EPO-GAAP accounting practices [a cash based presentation of figures used only by the EPO, that has been consistently criticised by the auditors in the past] to International Financial Reporting Standards (IFRS) which is becoming the generally accepted reporting protocol for financial matters.

IFRS is a collection of standards dealing with how particular items of accounts should be handled, but it has several attributes that lead to unfortunate perceptions.

Firstly, it is a system of accounting in which income is not recognised as such until the service for which the income is intended has been provided. Until such time as the service is provided any payments to the EPO are treated as prepayments and considered as liabilities.

Secondly, despite accruing income to when the service is delivered, a seeming inconsistent approach is taken to liabilities. The net present value of future liabilities is recognised in the accounts even if not due for payment for many years.

Thirdly, future income cannot be recognised as an asset unless it meets strict criteria as to the certainty of its recovery. Since no one is obliged to maintain their patents, this means that the net present value of renewal fees for granted patents cannot go on the balance sheet but must instead be recognised in notes to the accounts.

The result of this is that the EPO balance sheet shows the EPO as having „negative equity“ [surplus of liabilities over assets] of ~1.2bn€. This makes people nervous.

However the balance sheet and the notes to the accounts need to be read together to get a reasonably true picture of the health of the organisation. The notes to the accounts show the net present value of future

renewal fees as ~2.3bn€, leading to a net positive (and healthy value).

Tax treatment of pensions

The arrangements whereby Member States have reimbursed the EPO for tax reimbursements to EPO pensioners has ceased leading to an additional liability for the office. The net present value of this obligation is ~680m€. This will be recognised as a liability in the accounts for 2007 and on the basis of the Budget for 2008 this will result in the negative equity increasing to ~-2bn€.

This shows the distorting effect of IFRS accounting standards, since the actual amount spent each year at present on these adjustments is in the low millions forecast [on assumptions that are susceptible to change] to rise to a peak of ~80m€ in 2045.

The Office's Opinion

In connection with discussion of fee increases the Office gave the following reasoning:-

- 1) The Office is of the opinion that patents are under political threat worldwide
- 2) The Office is concerned that patent lifetimes appear to be declining and that this will reduce the volume of renewals and hence renewal fee incomes
- 3) The decision ending the arrangement whereby the Member States reimbursed the EPO for certain tax allowances that the EPO granted to its pensioners has strained the finances of the Office
- 4) Because of the vulnerability of renewal fee income to decline in the future the Office wants to move long term to an arrangement whereby *the procedural fees during the application procedure meet all of the costs of the application procedure.*

epi has argued broadly and in detail against the pessimistic nature of these assumptions.

Fee increases

CA/100/07 and CA/44/07 presented to the BFC propose fee increases for April 2008 and April 2009 respectively that range from the merely irritating through to the dangerous. The proposals are as follows: –

In April 2008 [CA/100/07]

- 1) a general fee increase of 5% or more
- 2) an increase in renewal fees averaging ~20%
- 3) an >100% increase in claims fees from 45€ to 100€

- 4) an increase in the late payment fee for renewals from 10 % to 50 % of the fee

In April 2009 [CA/44/07]

- 5) moving the page fee from an on grant fee to an on filing fee [NB sequence listings are excluded from this]
- 6) introducing a punitive claims fee for claim 51 and above of €500 per claim
- 7) replacement of separate designation fees with a flat fee of €500 to designate all states.
- 8) tinkering with the refund system to improve clarity.

epi has argued that: –

- the *epi* is not convinced of the need for increases
- if increases are necessary the proposed increases are too large
- some of the problems addressed by the fees may diminish as a result of the change in claiming rules in the USA
- if applicant behaviour is to be managed through use of fees, it should be certain that the management goes in the right direction and does not lead to adverse effects
- any significant increase in the extra claims fees should be matched by an increase in the threshold at which these fees are payable, perhaps to 25 claims or more, so that the *average* applicant does not have to pay them
- the effect of the 2008 increase and the effect of the changes in US rules should be monitored before deciding on the necessity of the fee increases proposed in CA/44/07.

It should be noted that the President indicated that if applicant behaviour does not change the Office will be coming back with more proposals relating to fees and/or procedure.

Staff relations

A series of papers were presented at the BFC as a „balanced package“ aimed at improving staff relations while giving the Office more flexibility. These proposals include: –

- increase of the compulsory retirement age to 68
- amendment of the reduction coefficients for pensions for those retiring between 55 and 60 to present less of a penalty for early retirement
- amendments to the methods of calculating basic salaries

These were presented as a means to clear past discontents, remove the risk of strikes, and to place the office in a good position to tackle issues such as productivity.

Building matters

The proposed new building in The Hague will not proceed at present.

Pension fund

300m€ will be injected into the RFPSS.

Performance of EPO

Workload up – backlogs growing.
This report represents highlights only.

Report of the Harmonisation Committee

F. Leyder (BE)
Chairman

1. As the readers of this journal know, the Harmonisation Committee deals with all questions concerning the worldwide harmonization of Patent Law, and in particular within the framework of WIPO.
2. The 33rd meeting of the Committee on Patent Law (CPL) had „SPLT issues“ on its agenda, for opinion only. *epi* was represented by John Brown. In a nutshell, the chairman of CPL reported that the June meeting of the Administrative Council had considered the issues, the chair of the Working Group I of Group B+ [the coordination group of industrialised countries in the negotiations on inter-

national patent law harmonisation] advised that the Working Group met informally in Copenhagen, and the delegations exchanged views.

The next steps were to be an EU coordination meeting on 14 September, then a Plenary Session of Group B+ on 26 September. No observers are admitted at these meetings.

The WIPO delegate advised that the Chair of the WIPO General Assembly had had informal discussions on SPLT/SCP and that he had found that flexibility did not generally extend to substantive matters. WIPO proposed that they prepare a report

on the „International Patent Position“ by March 2008, with a June 2008 meeting of SCP (see WO/GA/34/5, available at http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=83692).

3. The WIPO General Assembly (24 September to 3 October) considered the proposal. *epi* was not represented. The relevant part of the press release reads as follows:

Standing Committee on the Law of Patents (SCP)

With regard to the future work program of the SCP, member states unanimously agreed to commission a report, by WIPO, on issues relating to the international patent system covering the different needs and interests of all member states. This report would, upon completion, constitute the working document for a session of the SCP to be held in the first half of 2008. Member states also agreed to a draft outline for the report and specified that it would contain no conclusions. The report would be made available to all SCP members and observers by the end of March 2008.

4. At the same dates, there was also held a PLT Assembly. It considered the applicability of certain amendments and modifications of the PCT to the PLT and the proposed model international forms.

The relevant part of the press release reads as follows:

Patent Law Treaty (PLT)

The PLT Assembly unanimously agreed on the applicability to the PLT of a number of modifications to the Administrative Instructions under the PCT made in the past year (see document PLT/A/3/1), and adopted four model international forms, which can be used for the relevant purposes before the patent office of any contracting party to the Treaty (PLT/A/3/2), namely: Request for Recordation of Change in Applicant or Owner, Certificate of Transfer, Request for Recordation/Cancellation of Recordation of a License and Request for Recordation/Cancellation of Recordation of a Security Interest. For further information, please see: [...].

Member states took note of measures to provide developing and least developed countries and countries in transition with additional technical assistance to meet their obligations under the PLT, in particular, in relation to the filing of communications in electronic form in those countries.

The documents are available at http://www.wipo.int/meetings/en/details.jsp?meeting_id=13305.

Report of *epi* On-line Communications Committee

R. J. Burt (GB)
Chairman

The On-line Communications Committee (OCC) has been expanded to include one further member, Dieter Speiser (DE), and now includes the following nine members:

Roger Burt (GB) (Chairman)
Debra Smith (GB)
Kurt Stocker (CH)
Luciano Bosotti (IT)
Antero Virkkala (FI) (Secretary)
Johan van der Veer (NL)
Jean-Robert Callon de Lamark (FR)
Dieter Speiser (DE)
Peter Indahl (BE) (liaison with EPPC)

The committee held its first meeting on September 6th with the EPO team in The Hague lead by John Bambridge.

Update on the current EPO systems:

The use of on-line filing continues to expand and now stands at 46 to 48 % of filings; it was noted that Germany has the slowest uptake with the use of on-line filing. Germany uses a system for on-line filing different from that used by the EPO and this may explain the lower usage by German applicants.

Priority is being given by the EPO to changes to the system necessary for EPC 2000. Once this is complete, work will proceed on the filing system for oppositions, and subject to a decision from DG3, work will be undertaken to develop an on-line communication system for appeals. *Please remember that until the new system is announced by the EPO, filing opposition or appeal documents electronically will lead to a loss of rights.*

A number of small items were raised, such as problems with the inability of the current system to automatically handle the 20 % fee reduction for non-official language filings and the placing on the file of the electronic receipt for PACE filings thus losing secrecy; the EPO considered these problems to be serious and undertook to investigate and ensure the problems were resolved.

The EPO confirmed that on-line filing version 4 should be released in March or April 2008; the major change from the current version 3.20 is in the patent management system interface which will allow applicants to initiate a filing from within their own patent management systems. A development kit will be made available by the EPO as soon as possible to enable applicants/patent management system providers to start work on the integration.

Future plans

The EPO has been carrying a detailed study under the title „Strategic renewal“ and one of the strands being studied is „end to end electron processing“ to be abbreviated to „e2e“. Within a few years the EPO would like to have 100 % electronic filing and handling of subsequent communications. All paper forms would

be replaced by electronic forms and there would be a complete shift from paper to electronic files. Issues such as the involvement of national patent offices, security concerns, continuous availability of systems etc will need to be resolved to make the system work to the satisfaction of all users. The EPO has undertaken to work with the *epi* OCC on the planning and strategy for introduction of e2e; a group of 10 firms and IP department will be needed to participate in analysing and testing the proposals and subsequent implementations. From previous experience with the *epoline* systems, it is clear that, in addition to beta testing by dummy filings, there will be a need for real filings which can put the system under sufficient stress to identify weaknesses in the system (as attorneys we will require protection from the adverse consequences of failures during the testing). The EPO will communicate to the OCC the parameters for a testing and focus group to work with them on the development of e2e.

Future meetings

The OCC and the EPO agreed that the first meeting had been a success and it was further agreed that meetings should be held on a six-monthly basis.

Report of the By-Laws-Committee

C. Eder (CH)
Chairman

1. The By-Laws-Committee has complied with the Council decisions of the Krakow meeting as follows:

It has amended the provisions of *epi* 5.2 with regard to:

- the costs of the Secretariat in relation to the accounts of the Institute;
- the itemization of meeting costs;
- the handling of the non reimbursable costs of participants and accompanying persons at meetings of the Institute.

The new provisions are available on the Internet.

2. Following a suggestion of the Board, the Committee has drafted an amended version of Art. 35 of the By-Laws regarding the provision and the distribution of documents for Council meetings. Council is requested to vote on the Committee's proposal at the next meeting of Council.

3. The Committee proposed an amendment to the earlier Decision (*epi* 1.1) of the Council regarding the Collection of decisions so as to bring it in line with the present practice of the Secretariat. Council is requested to vote on the Committees proposal at the next meeting of Council.

RESULTS OF THE EUROPEAN QUALIFYING EXAMINATION 2007

FIRST SITTING – Examination in full and modular sitting

Nationality	Candidates (in total)	PASSED				FAILED			
		Total	%	Examina- tion in full	modular sitting (2modules)	Total	%	Examina- tion in full	modular sitting (2modules)
AT	15	5	33,3	4	1	10	66,7	9	1
AU	2	0	0,0	0	0	2	100,0	2	0
BE	17	3	17,6	2	1	14	82,4	3	11
CH	11	3	27,3	3	0	8	72,7	8	0
CZ	1	0	0,0	0	0	1	100,0	1	0
DE	256	57	22,3	49	8	199	77,7	163	36
DK	17	2	11,8	2	0	15	88,2	10	5
ES	30	9	30,0	5	4	21	70,0	10	11
FI	16	2	12,5	1	1	14	87,5	11	3
FR	96	24	25,0	19	5	72	75,0	47	25
GB	100	35	35,0	30	5	65	65,0	59	6
HU	1	0	0,0	0	0	1	100,0	1	0
IE	8	1	12,5	1	0	7	87,5	7	0
IT	40	6	15,0	5	1	34	85,0	18	16
LU	3	0	0,0	0	0	3	100,0	2	1
NL	24	5	20,8	3	2	19	79,2	14	5
PL	1	1	100,0	1	0	0	0,0	0	0
PT	3	1	33,3	0	1	2	66,7	2	0
RO	1	0	0,0	0	0	1	100,0	1	0
SE	38	11	28,9	6	5	27	71,1	12	15
SI	1	0	0,0	0	0	1	100,0	1	0
TR	3	0	0,0	0	0	3	100,0	3	0
TOTAL	684	165	24,1%	131	34	519	75,9%	315	135

RESITTING -Examination in full
Total number of candidates: 54
Passed: 0 (0,00%); Failed: 54 (100,00%)

RESITTING – Examination in part
Total number of candidates: 1071
Passed: 242 (22,60%); Failed: 829 (77,40%)

Next Board and Council Meetings

Board Meetings

76th Board Meeting, 29th March 2008, Rome
77th Board meeting, 11th October 2008, Barcelona

Council Meetings

64th Council Meeting, 26th-27th May 2008, Vilnius
65th Council Meeting, 24th-25th November 2008,
Munich

Report of EPC 2000 Seminar in Nicosia

C. A. Theodoulou (CY)

The EPC Seminar in Cyprus was held in Nicosia on 6th July 2007. It was attended by ten participants and it was coordinated and supervised by the *epi* Board Member Mr. Christos A. Theodoulou. Two tutors taught, Mr. Claude Quintelier and Mr. Christos A. Theodoulou.

After an introductory speech by Mr. Theodoulou the program of the seminar started. There was first an introduction and background to EPC 2000 and a comparison between EPC 1973 and the provisions of EPC 2000. Further there was a discussion on problems relating to Cyprus Law and practice and a comparison of the Cyprus Patent Law with the relevant provisions of EPC 2000. There was also a study of the relevant Cyprus case Law.

After the above the tutors presented the substantive changes contained in the EPC 2000 and also the new

and changed procedures including further processing and re-establishment of rights, limitation and revocation proceedings, patentable inventions, priority rights and other subjects.

An interesting discussion followed and questions were asked especially on the relationship of various aspects of the Cyprus Patent Law with provisions of EPC 1973 and EPC 2000.

The tutors summarized the main subjects of the seminar and also the points which were highlighted by the discussion.

The participants expressed their appreciation about the seminar and its usefulness in also comparing the Cyprus Patent Law with EPC 1973 and EPC 2000.

Benelux *epi*-seminar on EPC 2000

C. Quintelier (BE), F. Smit (NL)

A two days regional seminar was organised by *epi*, in cooperation with EPO, for the Benelux on October 16th and 17th 2007 in the Auditorium of the High Tech Campus Eindhoven. About 140 *epi* members and students participated on the first day, 120 on the second day. The main speakers were Robert Cramer of EPO-DG

5 and Derk Visser, *epi* member and author of „the Annotated EPC“. A panel with *epi* members from the three countries discussed items with the speakers. At the end of the second day, special EQE exercises for *epi*-students were presented by Cees Mulder and Bart van Wezenbeek.



The speakers: Robert Cramer, EPO (left) and Derk Visser (NL) (right)



Among the participants, a blind man with his dog



Institut der beim Europäischen Patentamt
zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés
près l'Office européen des brevets

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Die Rechnung kann wie folgt bezahlt werden (drei Möglichkeiten):

1. durch Einzug vom laufenden EPA-Konto

siehe beiliegendes Formular zur Einzugsermächtigung, das bis zum 15. Februar 2008 an das epi zurückgeschickt werden muss;

2. durch Banküberweisung in EURO

Eurochecks sowie alle deutschen Schecks werden akzeptiert.
Die Bankgebühren gehen zu Ihren Lasten.
Auf dem Überweisungsträger muss angegeben sein für jedes einzelne Mitglied:

- Name
- Mitgliedsnummer (neben dem Namen auf dem Adressaufkleber).

Fehlt der Name und/oder die Mitgliedsnummer, kann der Beitrag nicht ordnungsgemäß verbucht werden!

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

The invoice can be settled as follows (three possibilities):

1. by debiting the EPO deposit account

see enclosed direct debit mandate form which must be returned to epi by February 15, 2008.

2. by bank transfer in EURO

Euro cheques and banker's drafts are also accepted.
All bank charges are payable by the subscriber.
Please note that it is mandatory that each member states:

- name
- membership number (shown next to the name on the label above).

The lack of the personal name and/or of the membership number makes it impossible to book correctly the subscription payment!

Cette facture vous est envoyée pour raison de déclaration fiscale, même si vous avez déjà fait une demande de prélèvement automatique.

La facture peut être réglée de la façon suivante (trois possibilités) :

1. par retrait du compte courant OEB

voir autorisation de prélèvement annexée, à retourner à l'epi avant le 15 février 2008.

2. par virement bancaire en EURO

Les eurochèques et les chèques bancaires sont également acceptés.
Les frais bancaires sont à votre charge.

Il est indispensable d'indiquer pour chaque membre sur l'ordre de virement:

- nom
- numéro d'affiliation (inscrit à côté du nom sur l'étiquette).

S'il manque le nom et/ou le numéro d'affiliation, le paiement de la cotisation ne peut être correctement effectué !

Secretariat: P.O. Box 26 01 12 • D-80058 München • Im Tal 29 • D-80331 München
Tel.: +49 (89) 24 20 52-0 • Fax: +49 (89) 24 20 52-20
e-mail: info@patentepi.com

3. durch persönliche Kreditkarte (nur Visa oder Mastercard)a) online-Kartenzahlung:

- 1) Aufrufen der **epi** Website:
www.patentepi.com
- 2) Link: Mitgliedsbeitragszahlung
Bitte geben Sie an den angegebenen Stellen Ihren Namen, Ihre **epi**-Mitgliedsnummer sowie Ihre Kreditkartendaten ein und bestätigen Sie, Sie erhalten eine on-line-Bestätigung, dass die Buchung erfolgreich war.

b) Kartenzahlung mit Fax

In diesem Fall kopieren Sie bitte **lesbar** in das nachstehende Feld die Frontseite der Kreditkarte und geben Sie im 3-stelligen kleinen Feld die Kontrollnummer an. Das sind die letzten drei Ziffern im Unterschriftsfeld. Das **epi**-Sekretariat wird nach Eingang dieser kopierten Rechnungsseite alles Notwendige für die Abbuchung von Ihrem Kreditkartenkonto veranlassen.

3. by credit card (Visa or Mastercard only)a) online payment

- 1) surf to the epi Website
www.patentepi.com
- 2) Link: Subscription payment
Please introduce your name and epi membership number, as well as your credit card data in the allotted boxes. Confirm your payment as indicated. You will receive an on-line confirmation.

b) via fax

In this case please copy **legibly** the credit card in the box below and write the verification number in the three small boxes. The verification number is the last three digits on the signature panel. After receipt of a copy of this page the **epi** Secretariat will process the debiting of the credit card account.

3. par carte de crédit (uniquement Visa ou Mastercard)a) paiement en ligne

- 1) visiter le site Web de l'epi
www.patentepi.com
- 2) Cliquer sur paiement cotisation.
Veuillez introduire votre nom et numéro d'affiliation ainsi que les données de votre carte de crédit dans les cases indiquées. Veuillez confirmer votre paiement comme indiqué. Vous recevrez une confirmation en ligne.

b) par télécopie

Si vous désirez utiliser cette possibilité, veuillez copier **lisiblement** la carte de crédit dans le cadre repris ci-dessous et écrire le numéro de vérification dans les trois petites cases. Le numéro de vérification est formé par les trois derniers chiffres repris sur la bande où la signature est appliquée. Après réception d'une copie de cette page, le secrétariat de l'**epi** traitera le retrait du compte de la carte de crédit.

Name:

Membership
number:

verification number:

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Bei Zahlungseingang nach dem **30. April 2008** ist der Beitrag € 190.

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

Sollten Sie Ihren Jahresbeitrag nicht bezahlen, nehmen Sie bitte zur Kenntnis, dass **Ihr Name von der Liste der zugelassenen Vertreter gelöscht wird**, gemäß Regel 102(1) der Ausführungsordnung zum EPÜ. Ihr Name kann jedoch gemäß den derzeit gültigen Regeln wieder in die Liste aufgenommen werden, sobald Sie den ausstehenden Beitrag bezahlt haben, gemäß Regel 102(3).

Der Schatzmeister
Claude Quintelier

Subscription payments made after **30 April 2008** must be in the amount of € 190.

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

Please note that if you fail to pay your annual subscription **your name will be deleted from the list of professional representatives**, cf. Rule 102(1) of the Implementing Regulations of the EPC. However, you may, upon request, be entered under the current regulations on the list of professional representatives as soon as your outstanding subscription has been paid, cf. Rule 102(3).

The Treasurer
Claude Quintelier

La cotisation est de € 190 si le paiement est effectué après le **30 avril 2008**.

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

Nous vous rappelons que, si vous n'avez pas acquitté votre cotisation annuelle, **votre nom sera radié de la liste des mandataires agréés**, voir Règle 102(1) du Règlement d'exécution de la CBE. Toutefois, vous pouvez faire une demande de réinscription sur la liste des mandataires agréés selon les règles en vigueur après avoir acquitté votre cotisation impayée, voir Règle 102(3).

Le Trésorier
Claude Quintelier

1Inv08 date

Bitte einreichen an:

epi-Sekretariat
Postfach 26 01 12
D-80058 München

Please return to:

Retournez s.v.p. :

Telefax 089 - 242052-20

Einzugsermächtigung
nur für neue Mitglieder

Direct debiting mandate
only for new members

Autorisation de prélèvement
uniquement pour les
nouveaux membres

Eingangsfrist im
epi-Sekretariat:**15. Februar**Deadline for receipt by the
epi Secretariat:**15 February**Date limite de réception au
Secrétariat de l'epi:**15 février**

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

Wenn die Liste der **epi**-Mitglieder sich seit letztem Jahr **nicht** geändert hat, wird die Abbuchung automatisch entsprechend der vorhandenen Liste erfolgen und es ist kein Formular an das **epi** zu senden.

Bitte senden Sie diese Einzugsermächtigung oder eine Kopie davon **nur an das epi-Sekretariat**.

Please use only this form, if necessary with a separate sheet for the names of several **epi** members.

If **no changes** apply to your existing list, the debiting will be done automatically, based on the existing list and there is no need to send any document to the **epi Secretariat**.

Please return this form, if applicable, **to the epi Secretariat only**.

Veillez utiliser uniquement ce formulaire, si nécessaire avec une feuille séparée pour les noms de plusieurs membres de l'**epi**.

Si **aucun changement** ne doit être fait à votre liste existante, le prélèvement sera fait automatiquement, basé sur la liste existante et il ne faut envoyer aucun formulaire au **Secrétariat de l'epi**.

Veillez, si nécessaire, renvoyer ce formulaire **uniquement au Secrétariat de l'epi**.

Name/Vorname des epi -Mitglieds: epi member's surname/first name: Nom/prénom du membre de l'epi :	
epi -Mitgliedsnummer: epi membership number: Numéro d'affiliation à l'epi :	
Name des Kontoinhabers : Account holder's name: Nom du titulaire du compte :	
Kontonummer beim EPA: EPO account number : Numéro de compte auprès de l'OEB :	
_____	_____
Datum · Date	Unterschrift des Kontoinhabers · Account holder's signature Signature du titulaire du compte

NOT FOR USE AFTER FEBRUARY 15

Bitte einreichen an:

Please return to:

Retournez s.v.p. :

epi-Sekretariat
Postfach 26 01 12
D-80058 München

Telefax 089 - 242052-20

**Widerruf oder Änderungen
für eine bereits existierende
Einzugsermächtigung**

**Revocation or changes to
be applied to an existing
direct debiting mandate**

**Révocation ou changements à
appliquer à une autorisation
de prélèvement existante**

Eingangsfrist im
epi-Sekretariat:

Deadline for receipt by the
epi Secretariat:

Date limite de réception au
Secrétariat de l'epi:

15. Februar

15 February

15 février

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

Wenn die Liste der **epi**-Mitglieder sich seit letztem Jahr **nicht** geändert hat, wird die Abbuchung automatisch entsprechend der vorhandenen Liste erfolgen und es ist kein Formular an das **epi** zu senden.

Bitte senden Sie gegebenenfalls diese Einzugsermächtigung oder eine Kopie davon **nur an das epi-Sekretariat**, wenn notwendig.

Please use only this form, if necessary with a separate sheet for the names of several **epi** members.

If **no changes** apply to your existing list, the debiting will be done automatically, based on the existing list and there is no need to send any document to the **epi Secretariat**.

Please return this form, if applicable, **to the epi Secretariat only**.

Veillez utiliser uniquement ce formulaire, si nécessaire avec une feuille séparée pour les noms de plusieurs membres de l'**epi**.

Si **aucun changement** ne doit être fait à votre liste existante, le prélèvement sera fait automatiquement, basé sur la liste existante et il ne faut envoyer aucun formulaire au **Secrétariat de l'epi**.

Veillez, si nécessaire, renvoyer ce formulaire uniquement **au Secrétariat de l'epi**.

Die folgenden **epi**-Mitglieder sind von jetzt an auf der Liste für die Einzugsermächtigung zu **ergänzen**:
The following **epi** members should from now on be **added** to our list of names for direct debiting mandate:
Les membres de l'**epi** repris ci-dessous doivent à partir de maintenant être **ajoutés** à votre liste de noms pour l'autorisation de prélèvement :

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

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

Die folgenden **epi**-Mitglieder sind ab sofort in der Liste für die Einzugsermächtigung zu **streichen**:
For the following **epi** members the membership fee should from now on **no longer be debited** from our EPO account:
Pour les membres de l'**epi** repris ci-dessous la contribution ne doit à partir de maintenant **plus être débitée** de notre compte auprès de l'OEB :

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

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

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

Datum · Date

Unterschrift des **Kontoinhabers** · **Account holder's** signature
Signature du **titulaire du compte**

NOT FOR USE AFTER FEBRUARY 15

Einzugsermächtigung

Eingangsfrist im *epi*-Sekretariat:
15. Februar

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

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

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

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

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

Direct debiting mandate

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

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

Subscriptions are debited with effect from 25 February of each year. All fees and costs payable to the EPO on the debiting date have priority over the *epi* subscription. The *epi* will combine several subscriptions to be debited from

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

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

deadline for receipt of the direct debiting mandate by the *epi* is then 15 June.

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

Autorisation de prélèvement

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

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

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

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

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

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

epi-Mitgliedschaft und Jahresbeitrag
epi Membership and membership subscription
Affiliation à l'*epi* et cotisation annuelle

Visit the *epi* website: www.patentepi.com
Section Information/membership

Regeln für die Zahlung der *epi*-Mitgliedsbeiträge

Beschluss des *epi*-Rates auf seiner Sitzung in Kopenhagen am 11./12. Mai 1992; geändert auf den Ratssitzungen am 22./23. 10. 2001 in Lugano, am 15./16. Mai 2006 in Salzburg und am 16./17. Oktober 2006 in Istanbul

- 1) Der jährliche *epi*-Mitgliedsbeitrag ist innerhalb von zwei Monaten nach Fälligkeit zu zahlen.
- 2) Für Mitglieder, die bereits zu Anfang eines Jahres in die Liste der zugelassenen Vertreter eingeschrieben sind, ist das Fälligkeitsdatum der 1. Januar.
- 3) Für Mitglieder, die erst im Verlauf eines Jahres in die Liste der zugelassenen Vertreter aufgenommen werden, ist das Fälligkeitsdatum der Tag der Eintragung in die Liste.
- 4) Der jährliche Mitgliedsbeitrag wird erlassen, wenn
 - der schriftliche Antrag des Mitgliedes auf Löschung von der Liste der zugelassenen Vertreter vor dem 1. April beim Europäischen Patentamt eingeht;
 - eine Person nach dem 30. September zum ersten Mal in die Liste der zugelassenen Vertreter aufgenommen wird.
- 5) In allen anderen Fällen muss der volle jährliche Mitgliedsbeitrag bezahlt werden. Ratenzahlungen, Stundungen oder Beitragsreduzierungen können nicht gewährt werden.
- 6) Zahlt ein Mitglied, das bereits zu Anfang des Jahres auf der Liste der zugelassenen Vertreter stand, seinen Beitrag nicht vor dem 1. Mai (Eingang auf dem *epi* Konto), ist sein Beitrag EUR 190.–. Gleiches gilt für Mitglieder, die erst im Verlauf des Jahres in

die Liste der zugelassenen Vertreter aufgenommen worden sind, falls sie ihren Mitgliedsbeitrag nicht innerhalb von vier Monaten nachdem sie durch „*epi*-Information“ oder einen Brief über seine Höhe informiert worden sind, zahlen.

- 7) Soweit die Zahlung mittels Banküberweisung erfolgt, hat dies in Euro und frei von Bankspesen für *epi* zu geschehen. Dabei sind der Name und die Mitgliedsnummer jedes einzelnen Mitglieds, für das die Zahlung erfolgt, anzugeben.
- 8) Wegen der beachtlichen Bankgebühren und darüber hinaus wegen des zusätzlichen Verwaltungsaufwand werden keine Schecks angenommen.
- 9) Der *epi*-Rat beschließt Änderungen des Mitgliedsbeitrages vor Anfang des Folgejahres. Er informiert alle Mitglieder durch „*epi*-Information“ über den neuen Beitragsbetrag und die Zahlungsmodalitäten. Alle Mitglieder, von denen angenommen werden kann, dass sie die entsprechende „*epi*-Information“ erhalten haben, müssen Zahlungsvorkehrungen innerhalb der oben genannten Zeitspanne treffen, ohne dass eine zusätzliche Aufforderung hierzu erfolgt. Der Schatzmeister wird jedoch zu Beginn eines Jahres bzw. bei neuen Mitgliedern nach Eintragung in die Liste zusätzlich Rechnungen an alle Mitglieder verschicken. Verspätete Zahler, von denen angenommen werden kann, dass sie die oben genannte „*epi*-Information“ erhalten haben, können sich aber nicht darauf berufen, diese Rechnung nicht erhalten zu haben.

Rules Governing Payment of the *epi* Annual Membership Fee

Decision taken by the *epi* Council at its meeting in Copenhagen on 11/12 May 1992, amended at the Council Meetings in Lugano on 22/23 October 2001, in Salzburg on 15/16 May 2006 and on 16/17 October 2006 in Istanbul

- 1) The *epi* annual membership fee has to be paid within two months after its due date.
- 2) The due date for members being on the list of professional representatives at the beginning of the year is 1 January.
- 3) The due date for members entering the list of professional representatives in the course of the year is the moment of entry on this list.
- 4) The annual membership fee is waived if
 - a member's written demand for deletion from the list of professional representatives arrives at the European Patent Office prior to 1 April;

– a person is registered for the first time on the list of professional representatives after 30 September.

- 5) In all other cases the entire annual membership fee has to be paid. No instalments, extensions of the term of payment, or reduction of payment may be granted.
- 6) Members on the list of professional representatives on 1 January who fail to pay their membership fee prior to 1 May (reception on *epi* account) will have to pay a subscription of EUR 190.–. The same applies to members who entered the list during the course of the year if they have not paid the fee within four months after being notified of its amount through „*epi* Information“ or by letter.
- 7) Payments by money transfers have to be made in Euros and free of bank charges for *epi*. They must

indicate the name and registration number of each member for whom the fee is paid.

- 8) Due to the substantial bank charges and furthermore to the additional administrative requirements no personal cheques will be accepted.
- 9) The *epi* Council decides on modifications of the amount of the annual membership fee before the beginning of a year. It informs all members through „*epi* Information“ of the new amount of the fee and the conditions for payment. All members

deemed to have received the respective „*epi* Information“ will have to make provisions for payment within the above mentioned time-limit without further request. The Treasurer will, however, also send out fee invoices to all members at the beginning of the year or to new members after their registration. Late payers deemed to have received the before mentioned „*epi* Information“ may not plead not having received this invoice.

Règles relatives au paiement de la cotisation annuelle *epi*

Décision prise par le Conseil de l'*epi* à la réunion de Copenhague les 11-12 mai 1992, modifiée aux réunions du Conseil à Lugano le 22-23 octobre 2001, à Salzburg les 15-16 mai 2006 et à Istanbul les 16-17 octobre 2006

- 1) Le paiement de la cotisation annuelle *epi* est dû dans les deux mois qui suivent la date d'exigibilité.
- 2) La date d'exigibilité pour les personnes inscrites sur la liste des mandataires agréés au début de l'année est le 1er janvier.
- 3) La date d'exigibilité pour les personnes admises sur la liste des mandataires agréés en cours d'année est la date d'admission sur cette liste.
- 4) N'est pas redevable de la cotisation de l'année en cours:
 - un membre qui demande par écrit à l'OEB sa radiation de la liste des mandataires agréés avant le 1er avril;
 - toute personne inscrite pour la première fois sur la liste des mandataires agréés après le 30 septembre.
- 5) La cotisation annuelle doit être payée dans son intégralité dans tous les autres cas. Aucun versement partiel, report d'échéance ou réduction du montant ne peut être accepté.
- 6) Toute personne inscrite sur la liste des mandataires agréés au 1er janvier et dont la cotisation n'est pas payée avant le 1er mai (date de réception sur le compte de l'*epi*) doit payer une cotisation de EUR 190.–. Ceci s'applique également à toutes les

personnes inscrites sur la liste en cours d'année, dont la cotisation n'est pas réglée dans les quatre mois qui suivent la notification dans „*epi* Information“ ou par lettre.

- 7) Les paiements par virement doivent être faits en Euros, sans frais bancaires pour l'*epi*. Le nom et le numéro d'affiliation de la/les personne(s) pour qui la cotisation est destinée doivent être indiqués clairement sur le virement.
- 8) Les chèques ne sont pas acceptés en raison des frais bancaires importants et du supplément de travail que leur traitement nécessite.
- 9) Le Conseil de l'*epi* décide des modifications du montant de la cotisation annuelle avant le début de l'année. Tous les membres sont informés par „*epi* Information“ du nouveau montant de la cotisation et des conditions de paiement. Toute personne qui, en tant que membre, reçoit „*epi* Information“ devra s'assurer que sa cotisation est payée dans le délai imparti, ci-dessus mentionné, sans autre notification. Le Trésorier enverra toutefois un appel de cotisation à tous les membres au début de l'année, de même qu'aux nouveaux membres après leur inscription. Toute personne recevant en tant que membre l'„*epi* Information“, mentionné plus haut, et n'ayant pas payé sa cotisation à temps ne pourra pas alléguer qu'elle n'a pas reçu l'appel de cotisation.

Requirement of Inventiveness For Utility Models¹

J. Markó² (HU)

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1. Introduction

We believe – on the basis of our 35-year experience in the IP field – that the utility model system is a useful legal means, especially for smaller, improvement-like technical inventions, and mainly for individual inventors or small and medium-size companies. The main advantage of the granting procedure of utility models is that it is relatively quick and cheap compared to patent prosecution. On the other hand, except the relatively shorter term, the exclusive right provided by the utility model protection is essentially the same as that of a patent.

Because utility models have generally been granted by patent offices without any substantive examination, their validity will be examined for the first time after granting only, mainly in revocation and/or infringement proceedings. In these proceedings, the competent authority must also decide the main question, whether the granted utility model complies with the statutory requirement of „inventive step“.

As to the methodological aspects and practice of assessment of the inventiveness requirement in different countries, various statements and approaches have been published, but unfortunately they mostly differ from each other, on the other hand they contain some controversies. Furthermore, clear methodological guidelines, which could really assist a unified evaluation of this important question, are not known for the time being.

In this paper we wish to focus exclusively on this question of the utility model law and our intention is to propose steps in the direction of the more uniform assessment of the inventive step requirement for utility model practice.

2. Brief International Outlook

For the time being, utility model protection is available in 48 countries or regions according to the latest publication³ of WIPO, this figure proves that the utility model, as a younger brother of the patent system, represents an important legal means worldwide, too.

Below we wish to deal briefly with a few selected countries only.

2.1. Austria

Since the enactment of the Austrian Utility Model Law in 1994 no guidelines have been given by the Austrian courts on how to evaluate the level of inventiveness to meet the statutory requirement of „inventive step“. According to the approaches given by the Austrian legislator and experts, a lower quantity of inventiveness – compared to the inventive activity required by the patent law – was considered sufficient for a valid utility model in Austria.⁴

In its decision,⁵ the Austrian Supreme Court (ASC) took for the first time the opportunity to define precisely the „level of inventiveness“ as required for utility models. The ASC decided that in order to satisfy the requirement of inventive step it would not be enough that the inventive effort must have been non-obvious for a person skilled in the art. Furthermore, non-obviousness would be a requirement of patent law, but for a valid Austrian utility model it was sufficient if the utility model was not merely the result of routine work.⁶

So the level of inventiveness for utility models was explicitly defined by the ASC as being lower than for patents.⁷ It means that in the Austrian practice the

3 http://www.wipo.int/sm/en/ip_business/utility_models/where.htm

4 R. Beetz: „Level of inventiveness for utility models“ (Managing Intellectual Property, November 2006)

5 Decision of the Austrian Supreme Court (No. 4 Ob 3/06d of July 12, 2006)

6 „... dass sich eine Erfindung als auf einem erfinderischen Schritt beruhend definieren lasse, wenn sie mit dem durchschnittlichen Fachkönnen des Fachmanns einerseits grundsätzlich zwar auffindbar sei, andererseits sich für ihn aber nicht ohne weiteres aus dem Stand der Technik ergibt. Für die Praxis sei eine solche mögliche Legaldefinition schlagwortig auch dahin formulierbar, dass zur Anerkennung der gebrauchsmusterrechtlichen Erfindungshöhe objektiv eine Leistung vorliegen müsse, die über fachmännische Routine hinausgeht. ... Wird erfinderischer Schritt in diesem Sinn verstanden, so ist sein Vorliegen beim klägerischen Gebrauchsmuster zu bejahen, wird doch eine Aufgabe in vorteilhafter Weise gelöst.“

7 „Im Bereich des Gebrauchsmusters seien die materiellen Schutzvoraussetzungen geringer; gefordert sei nur ein erfinderischer Schritt, für den ein geringeres Ausmaß an Erfindungsqualität genüge, als es für die Patentierung erforderlich wäre“

1 This paper is a streamlined English version of the study „Requirement of Inventive Step in Utility Model Law“ published in Hungarian in the *Industrial Property & Copyright Review*, Volume 2 (112) No. 4, pp. 12-43, August 2007, issued by the Hungarian Patent Office, Budapest, Hungary

2 The Author: Hungarian & European Patent Attorney Contact by Phone: +36-1/214-6302 or by E-mail: j.marko@t-online.hu or majo@danubia.hu

criteria of inventive step for utility models should be less strict than for patents.

Furthermore, it was also stressed that a technical effect in itself would not be sufficient to acknowledge the inventive step, because a (known) technical effect could be achieved by known means, too. But, if the technical effect was new, then it would most probably be based on an inventive step.⁸

2.2. Denmark and Spain

In Denmark and Spain, the intention of the legislators was to keep a distance in the terminology of inventiveness relating to utility models on the one hand, and to patents on the other hand. That is why, to the level of inventiveness for utility models the following terms were proposed: „not very obvious“ or „not clearly obvious“.⁹

It is to be noted that in the practice of both countries the required level of inventiveness should involve some practical advantage or progress, but not necessarily a „technical effect“.

2.3. Germany

Since the amendment of the German Utility Model Act in 1986, by which the requirement of inventive step was introduced as a statutory requirement, the German Supreme Court (GSC) dealt in its decision¹⁰ thoroughly with the level of inventiveness of utility models for the first time.

Differing from the long-standing practice of the Federal German Patent Court, academic approaches and legislator's considerations, the GSC concluded that there was a bar to consider obvious solutions as being based on an inventive step just because the person skilled in the pertinent art could not have found the protected solution as a matter of routine.¹¹ In contrast, it is to be noted that according to the practice of the Federal German Patent Court the inventive step is to be acknowledged when the inventive level of the utility model exceeds the framework of routine-like activity of the skilled person.¹²

The GSC pointed out, furthermore, that the criteria for inventive step should be a qualitative and not a quantitative requirement for utility models. Therefore, its assessment should be a result of valuation.¹³

8 „Das bloße Vorhandensein eines technischen Effekts reiche für das Vorliegen eines erfinderischen Schrittes nicht aus, denn ein (bekannter) technischer Effekt könne auch mit bekannten Mitteln erreicht werden. Wenn der erzielte Effekt neu sei, Dann könnte dies auf einen erfinderischen Schritt schließen lassen.“

9 M. Kern: Bericht über das RINGBERG Symposium „Europäisches Gebrauchsmusterrecht“ des Max-Planck Institutes, 7-12. November 1993, (GRUR Int. 7/1994);

Citation: „In Spanien und Dänemark zum Beispiel werde der Abstand durch den Zusatz eines Eigenschaftsworts wiedergegeben; demgemäß werde der im Patentrecht gängige Ausdruck „nicht in naheliegender Weise“ im Gebrauchsmusterrecht durch „nicht in sehr“ oder „nicht in deutlich naheliegender Weise ersetzt.“

10 Decision of the German Supreme Court No. X ZB 27/05 (Beschluss des Deutschen Bundesgerichtshofes vom 20. Juni 2006)

11 „Es verbiete sich dabei, Naheliegendes etwa unter dem Gesichtspunkt, dass es der Fachmann nicht bereits auf der Grundlage seines allgemeinen Fachkönnens und bei routinemäßiger Berücksichtigung des Stands der Technik ohne weiteres finden könne, als auf einem erfinderischen Schritt beruhend zu bewerten.“

12 „Erfinderischer Schritt sei bereits zu bejahen, wenn der Fachmann den Rahmen routinemäßigen Handels überschreite.“

2.4. European Union

In the European Union long preparatory discussions for establishing a regional-type utility model system (community utility model) were carried out, but for the time being without any success.

According to a Summery Report¹⁴ the European Commission suspended the consultations in this respect. According to the reasoning of the above report, one of the main reasons for this suspension was that the negotiating parties could not agree on the requirement of „inventive step“ for utility models.

2.5. Hungary

Since the enactment of the Utility Model Act¹⁵ in 1991 neither official statements nor guidelines have been published by the competent courts or the Hungarian Patent Office on the delicate question: How to estimate the statutory requirement of „inventive step“?

According to Art. 3 (1) of the Utility Model Act „The utility model involves an inventive step if it is not obvious to a skilled craftsman as compared with the state of the art.“

The essence of the ministerial reasoning thereof was as follows:

„Similarly to patents, where national laws generally require an inventive activity for granting a patent, an inventive step having a relatively lower level is an important qualitative precondition for utility models. The exact determination of this legal measure should be the task of the jurisprudence, taking into consideration that the knowledge of the skilled craftsman differs not only in its level, but also in its quality from that of the skilled person of the patent law; so practical skill plays a more important role than theoretical preparedness.“

It is clear from the above citations that different terminology has been used for indicating the levels of inventiveness in Hungary, that is, the term „inventive step“ for utility models and the term „inventive activity“ for patents in order to stress the difference in advance between utility model and patent practices. So this difference in terminology sets a lower threshold of required inventive step for utility models than for patents.

In our prior paper¹⁶ we thoroughly analysed 13 decisions of the competent Hungarian courts and the patent office, dealing with the evaluation of „inventive step“ as required for utility models. Our conclusion was that although the legal framework of the utility model system in Hungary is sufficiently up-to-date compared to other countries in Europe, but some „standardization“ (unification) for assess-

13 „Das Kriterium des erfinderischen Schritts im Gebrauchsmusterrecht sei ... kein quantitatives, sondern ein qualitatives die Beurteilung des erfinderischen Schritts ist das Ergebnis einer Wertung.“

14 Summary Report of March 1, 2001 Containing the Replies to the Consultation on the Impact of the Community Utility Model with a View to Updating the Green Paper on the Protection of Utility Models in the Single Market [SEC (2001) 1307]

15 Hungarian Utility Model Act No. 38 of 1991

16 See foot-note¹

ment of „inventive step“ would be highly appreciated. We are afraid that the same remark should be valid for other countries as well.

Our intention is to provide some contribution in this direction.

3. Proposal for a New Legal Test

The author of the present paper was also member of an expert group of the Hungarian Group of AIPPI preparing a report on harmonisation of the utility model systems.¹⁷ In this report it was already stressed that a clear distinction was to be made between the level of inventiveness of patents and that of utility models. It was proposed, furthermore, to make a difference between „skilled persons“ being competent for patents and utility models when evaluating the inventive step requirement.

Basically maintaining the above approach, we are still of the opinion that instead of too sophisticated formal distinctions, e.g. „not clearly lacking inventive step“, „not clearly obvious“, „creative efforts“, (or in German: „nicht in sehr naheliegender Weise“, „die erfinderische Tätigkeit fehlt nicht eindeutig“) etc., and too academic interpretations, the question of utility model inventiveness is to be dealt with much more practically, and the subjective factors of the decision should be eliminated as much as possible.

We think that a quasi unified court practice (jurisprudence) regarding the assessment of the level of inventiveness for utility models within one single country and even in different countries, first of all in Europe, can be expected only if clear and easily useable methodological approach will be proposed and widely accepted.

Only for the sake of comparison, we refer to a study¹⁸ proposing a pragmatic approach and legal test for evaluation of the inventive activity for patents.

3.1. Who is the competent person?

We believe that the very first step in every individual case must be to determine clearly and practically, depending on the subject-matter of a given utility model, who actually the competent „skilled person“ in the pertinent art is, because all questions in connection with inventiveness are to be considered „through his eyes“. Of course, the pre-selected „skilled person“ must always be a fictitious person, who provides an objective external „measure“ for the involved judge or examiner.

It is to be stressed that the „skilled person“ cannot be a natural person, in sharp contrast, he or she is always an artificially created fictitious person, who is to be provided with some abilities, discussed below. Consequently, the inventor of the utility model, or the judge or the examiner involved in an infringement or revocation case, or an expert witness can never be the „skilled person“ in the above sense, so he must always be an „Anonymus“ (a

man or women without any face, as we illustrated in the drawing below).



Anonymus = Always a fictitious person skilled in the pertinent art

Generally the national utility model acts and their implementing rules do not deal with the question, who actually the „skilled person“ should be, they entrust it „generously“ to the court and/or patent office practice.

In our opinion, an *ordinary worker*, that is, a *skilled workman/craftsman* of the workshop, or at the very most a *technician* is to be understood as the fictitious „skilled person“ in the pertinent art in case of utility models, in sharp contrast with patent practice, wherein the skilled person is generally an engineer or researcher having higher technical background.¹⁹

According to our approach this preliminary determination of the fictitious „skilled person“ is a very important precondition in carrying out an assessment method of the inventive step for utility models, because thereby we can provide a guarantee for the proper examination of the relatively lower quantitative requirement (inventive step) of the utility model, with a distance from the higher level of inventiveness for patents.

On the other hand, such a purposeful prior determination of the fictitious „skilled person“ in the pertinent art and his unambiguous selection is substantial, because thereby we also determine his expectable level of knowledge and ability for combinations. It means that all the answers to the succeeding questions during the evaluation method of the inventive step result from the proper prior determination of the skilled person.

For example, if the subject-matter of the utility model under review is a road surface prism, e.g. in an infringement case, we think that the fictitious „skilled person“ in the pertinent art (road-building industry) should be a *road-building worker*, who usually builds in such surface prisms into the asphalt/concrete road layers, or repairs and maintains such prisms.

3.2. Level of knowledge and skill

Another important precondition is to determine the expectable level of knowledge of the selected fictitious

¹⁷ Report Q -117 of the Hungarian Group of AIPPI (AIPPI Yearbook 1995/II; Authors: Mrs. H. Kalmár, Gy. Kovári Gy. and Dr. J. Markó)

¹⁸ Dr. J. Markó: „The Requirement of „Inventive Activity“ at the Examination of Patentability in the United Kingdom and North-America“ (Industrial Property Review, Volume 97, No. 3, July 1992, published in Hungarian by the Hungarian Patent Office, Budapest, Hungary)

¹⁹ Dr. J. Markó: „The Inventive Step Requirement“ (UNION Newsletter No. 1/1995)

„skilled person“ in the pertinent art. In this step the technical books used during his education and his expectable technical skill obtained in the workshop practice are to be taken into consideration.

If we accept the selection and/or determination of the fictitious „skilled person“ depending on the subject-matter of the actual utility model (as disclosed in item 3.1.), then we are in the position to define objectively in this step the outlines of his expectable general technical knowledge on the basis of his education and practice.

Going back to the example mentioned above, if the selected fictitious „skilled person“ is a road-building worker, then it is relatively easy to determine the level of his general technical education and practical skill, for which we can use the books and other educational means (handbooks, etc.) of the technical school and workshop educating road-building workers.

It is also important to note that under the term „expectable general technical knowledge“ is to be understood in the present case the knowledge of this fictitious road-building worker at the competent time, consequently a knowledge being published or becoming available in any other way to the public after this competent date is to be left out of consideration. For example, in a revocation procedure of a utility model, this competent/material date is the priority date of the utility model (in Europe) and not a later date.

3.3. *Teaching of the prior art*

Further important question lies in that: What kind of teaching and information the elected fictitious road-building worker (as competent skilled person) could have got on the basis of his general knowledge from the prior art, that is, from the cited relevant publications at the competent date? In this step, the scope and content of the prior art are to be determined unambiguously.

This step must also involve the determination of the really relevant documents, which together with the general knowledge of the skilled worker constitute the „basis“ or „background“ for evaluation of the inventive step requirement for the utility model.

Obviously, due to his expectable general technical knowledge and skill, the selected road-building worker could have understood a more simple teaching from the given prior art in the present case, than another skilled person having higher education and skill (e.g. a technician). Evidently, concerning the ability of the skilled person for combinations, similar difference exists between a road-building worker and a technician.

It also needs some examination, whether the selected road-building worker could have got any direct teaching or at least stimulation from the relevant prior art in the direction of the utility model, or not.

The judge or examiner has now to put himself in the place of the selected fictitious road-building worker (competent skilled person) having the mentioned level of technical knowledge and skill, and he has to construe the prior art „through his eyes“. It is really not an easy task, but a highly intellectual task in each individual case.

With some exaggeration, we could define this step as a „schizophrenic“ situation, wherein the judge or examiner has to put himself artificially in this special mental status, because he has to forget all his other knowledge for the time of the inventive step test and to use actively only the expected knowledge and skill of the fictitious road-building worker at the priority date.

3.4. *Construction of the claimed utility model*

The next task to be solved is to construe the claim/s of the utility model in question on the basis of the description and drawings. Because the addressee of the specification is the fictitious road-building worker, the claimed utility model is to be construed by the judge or examiner on behalf of the skilled worker.

The essence of this step is to determine the scope of protection clearly and unambiguously. The judge or examiner has to put himself again in the place of the selected fictitious road-building worker (competent skilled person) having the mentioned level of technical knowledge and skill, and he has to interpret „through eyes of the skilled worker“ the scope and meaning of the claims. The claims of the utility model are to be considered again as of the relevant date, as mentioned above.

3.5. *Is there any difference?*

In the next phase of evaluating the level of inventiveness, a comparative analysis is to be made in order to define the existing substantial difference or differences between the claimed utility model and the relevant prior art, if any. The „difference“ is to be considered from the point of view of the selected skilled person (road-building worker).

If there isn't any difference between the claimed utility model and the relevant prior art, then the claim is evidently invalid, and in this case we cannot speak of inventive step at all. So the evaluation step of a „difference“ has a sense only, if the claimed utility model and the relevant prior art are not the same (the claimed subject-matter meets the requirement of novelty).

After proper construction of the prior art and the claimed utility model (as discussed above) the judge or examiner can objectively determine the difference by making a simple comparison of facts, and by putting himself in the place of the selected fictitious road-building worker. This difference can be of various characters, e.g. difference in structure, arrangement, use, material, operation or effect, etc.

3.6. *Effect due to the difference*

If at least one substantial „difference“ has already been determined/evaluated between the claimed utility model and the relevant prior art, then in the next step the expected effect due to this difference should be examined.

In this respect we refer again to the cited study²⁰ per analogy. From this paper it is also known that the so-called „secondary considerations“ are mostly used as

²⁰ See foot-note¹⁹

„tools“ for assessment of the inventive step in the patent practice of different countries.

In our view, these secondary considerations could also be used in the utility model practice to assist the ultimate decision of the judge or examiner relating to the level of inventive step, e.g.:

- „long-felt want“
- „unsuccessful attempt by others to solve the problem“
- „overcoming a prejudice“
- „combination“
- „adaptation“
- „doctrine of equivalency“
- „unexpected effect“
- „commercial success“.

Considering the fact that the „inventive step“ is a qualitative requirement in the utility model law, which requires some intellectual/inventive activity from the inventor, we think that the „commercial success“ as a secondary consideration, in itself, would be insufficient for proving the inventive step, because the commercial success may be the result e.g. of marketing activity, too. But, the „commercial success“ in combination with any of the other secondary considerations could be much more convincing.

It is to be noted that the existing „difference“ of the claimed utility model may result in a new product having quasi the same technical parameters as the competing similar products, but it widens the assortment on the market. We think that this assortment-widening effect of the utility model, in itself, may be sufficient for acknowledging the inventive step in a given case, although this effect is not a technical one.

Similarly, many other effects deriving from the „difference“ could be acceptable, so e.g. relatively cheaper and/or easier manufacturing, easier installation, promoting technical progress, using energy-saving technology, etc.

3.7. Decision

The last step is the ultimate conclusion of the evaluation method: Is the „difference“ inventive or obvious?

If the prior steps were carried out properly, now there is nothing else to do; the examiner or judge has to put himself again in place of the elected skilled workman (in the present case, a road-building worker) and to decide whether the „difference“ – preferably in view of at least one of the mentioned secondary considerations – would have been obvious to said skilled worker at the relevant date, or involved an inventive step.

3.8. The proposed TEST

Summarizing the above approach, our Inventiveness Evaluation TEST comprises the following 3 steps, wherein the disclosed sequence of the steps is of high importance:

1. *Depending on the subject-matter of the utility model in question, the first step is to determine what teaching a competent fictitious „skilled person“ could have got from the pertinent prior art at the material date.*

2. *The second step is to determine how this skilled person would have interpreted the claims of the utility model, and whether he would have found any substantive difference between the claimed utility model and the prior art.*
3. *In the third step, the judge has to put himself in place of said skilled person and make an ultimate decision: whether said difference would have been obvious at the material date or it involved an inventive step.*

4. Final Remarks

We believe that the most difficult and complex question of the utility model practice, that is, the level of inventiveness („inventive step“ in Hungary) can be evaluated much easier and objectively by using this proposed legal test than before.

As it is clear from the above disclosure, the „inventive step“ is a qualitative requirement for utility models in Europe, which requires some creative activity from the inventor.

In order to eliminate misunderstandings in this matter and for the sake of comparison of the different levels of inventiveness, it can be said that the „inventive step“ required for utility models constitutes symbolically a „medium degree“ between the higher „inventive activity“ required for patents („high degree“) and a lower framework of routine-like activity of a skilled person („basic degree“).

We tried to illustrate diagrammatically the mutual relationship of patents and utility models compared to the prior art in the next figure. The expected different levels of inventiveness are illustrated on the imaginary vertical axis, and their relative degrees are designated by arrows.

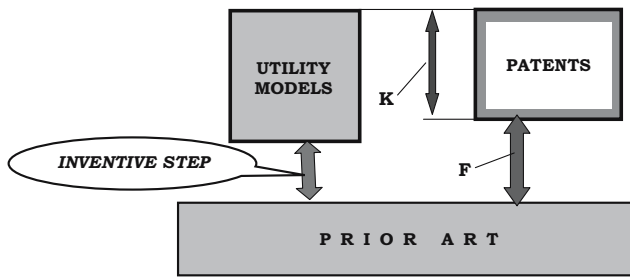
Theoretically even a patent involving the highest level of inventive activity can be converted into utility model according to the Hungarian regulations, provided that the subject-matter of the patent fulfils all the requirements.²¹ It means that in exceptional cases the highest level of the „inventive step“ for utility models can be the same as the highest level of the „inventive activity“ for patents, as indicated in the figure, wherein the upper side of a square indicating the mass of the utility models and that of the patents lie in the same horizontal level.

But, the lowest level of the „inventive step“ for utility models (see the lower side of the square indicating the mass of the utility models) lies much lower than the lowest level of the „inventive activity“ for patents (see the lower side of the square indicating the mass of the patents) as marked by arrows from the basis (prior art).

In the figure, the following reference characters are used:

- K – Convertible territory
- F – Arrow designating the relatively higher level of the inventive activity for patents from the prior art.

²¹ Hungarian Utility Model Act of 1991, Art .30 and Patent Act, Art. 62, respectively.



The convertible territory (domain) K means that in this territory the utility models can be converted into patents and vice versa.²²

Summing up, it is believed that the proposed legal TEST can provide easily useable unambiguous guidelines and method for evaluation the „inventive step“ for utility models, especially for judges and examiners.

By using this TEST properly, the perceptible uncertainty of judges and examiners at making decisions concerning the inventive step could be eliminated, the decisions could become more objective than before and consequently a more unified jurisprudence can be developed at least on national level.

FICPI Executive Committee Seville, 4th – 6th November, 2007

T. Johnson (GB), E. Armijo (ES)

The President of the *epi*, Chris Mercer, was invited to represent the Institute as an invitee to the FICPI Ex-Co in Seville. Chris Mercer asked Terry Johnson to be his stand-in as he could not go. At the last minute, I had to cry off owing to sudden work commitment, so Enrique Armijo kindly took my place. Enrique gave a brief presentation, developed by us both, about *epi*'s current thinking as discussed at our Nuremberg Council Meeting.

FICPI ten years ago had a „brain storm“ session led by an outside facilitator, the purpose being to define FICPI's

future objectives. The Seville Ex-Co revisited that project and developed it for the future. Interestingly, the future includes the continuing need to develop education to provide a quality patent attorney profession, which chimes nicely with the *epi*'s views for qualified attorneys in every Member State of the EPC.

The Ex-Co was well-organised and well attended, and was followed by an open Forum, which was equally successful.

Bemerkungen über den Aufsatz von Herrn Patentanwalt S.V. Kulhavy Arten der Beurteilung von Erfindungen *epi* Information, Juni 2007, S. 63-65

S. Gedeon (HU)

Der Verfasser weist darauf hin, dass eine möglichst einfache, logische und überschaubare Definition der Erfindung (meiner Meinung nach in engerem Sinne: Definition der patentierbaren Erfindung) derzeit nicht zur Verfügung steht. Eine Definition, die den Vorprüfern der Ämter und den Patentanwälten helfen würde um die Patentierbarkeit einer Erfindung mit entsprechender Sicherheit zu beurteilen.

Der Verfasser geht davon aus, dass die Beurteilung jenes Begriffs an einem außerordentlich breiten Bereich bewegen kann, demgemäß eine Lösung als eine patentfähige Erfindung zu betrachten ist, wenn sie auf Grund des Standes der Technik nicht naheliegend ist. Der Verfasser schlägt die folgende Definition vor: „Eine gewerblich anwendbare neue Lösung eines technischen

²² See foot-note²¹

Problems ergab sich nicht in einer naheliegenden Weise aus dem Stand der Technik, wenn lösungsgemäß ein neues technisches Mittel verwendet wurde oder wenn lösungsgemäß ein zwar bekanntes technisches Mittel jedoch aufgrund der Entdeckung einer bei diesem technischen Mittel noch nicht bekannten Wirkungsfähigkeit verwendet wurde.“

Abgesehen davon, dass diese Definition weitere Probleme aufwirft (z.B. eine Konstruktion ist auch ein neues technisches Mittel), bezweifle ich, dass diese Definition in dieser Form, ohne eine ausführliche Analyse zu einer mehr oder weniger ausführlichen objektiven Beurteilung führen kann. Da zahlreiche Studien, Kommentare in der Fachliteratur mit der Abgrenzung der Kombination von der Addition sich beschäftigen, will ich nicht diese Definition analysieren. Vielmehr möchte ich den Ausgangsgrund des Verfassers bestreiten.

Der Verfasser ließ nämlich außer Acht, dass der zitierte Teil des Art. 103 US-PatG ergänzend wie folgt lautet: „A patent may not be obtained...if the differences...as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.“ (Ergänzung in Kursivschrift). Art. 56 des EPÜ, auch ergänzend, lautet wie folgt: „Eine Erfindung gilt als einer erfinderischen Tätigkeit beruhend, wenn sie sich für den Fachmann nicht in naheliegender Weise aus dem Stand der Technik ergibt.“ (Ergänzung in Kursivschrift). In beiden Gesetzen ist also der Fachmann erwähnt.

Es ist mir nicht ganz verständlich, warum der Verfasser die beiden Gesetzesstellen unvollständig zitierte, um den solchen Anschein zu erwecken, dass der (Durchschnitts)Fachmann in diesen Gesetzen nicht erwähnt würde.

In weiteren wurde erwähnt, dass „In den Bestimmungen mancher Patentgesetze ... wird auf den Fachmann in Bezug genommen.“ Ferner wird das Folgende festgelegt: „Dies ist allerdings nicht in jedem Patentgesetz der Fall.“ Als Beispiel wurde nur der Art. 1 CH-PatG

erwähnt. Diese Vorführungsweise gibt ein, dass die bereits beiden, früher erwähnten Gesetze (US und EP) zu den Gesetzen gehören, die auf den Fachmann nicht in Bezug nehmen. Der Durchschnittsfachmann der Recherche wird gut bestimmt und danach kommt die folgende Feststellung: „Die Grenze zwischen den naheliegenden und nicht naheliegenden Lösungen liegt ausschließlich innerhalb des Könnens des Fachmanns. Folglich kann der Fachmann sowohl naheliegende als auch nicht naheliegende Lösungen schaffen.“ Mit diesem letzteren Satz wird die Anwendung des Durchschnittsfachmanns bei der Prüfung der erfinderischen Tätigkeit bestritten. Zum Beispiel in den Richtlinien der Verfahren vor dem Ungarischen Patentamt wird diese Anwendung im Teil III. Abs. 4.3.1 so formuliert: „Der Prüfer soll die erfinderische Tätigkeit auf seine eigene Kenntnis ... stützend prüfen, aber die Naheliegenschaft der Erfindung soll vom Gesichtspunkt des fiktiven Fachmanns beurteilt werden.“ (Aushebung von mir – S.G.)

Der Durchschnittsfachmann des Patentrechts unterscheidet sich von den, im täglichen Leben tätigen Fachmännern, weil er nur naheliegende neue Lösungen herstellen kann, aber nicht naheliegende neue Lösungen nicht. Der Durchschnittsfachmann ist darum ein fiktiver Begriff, da kein solcher lebender Fachmann vorhanden ist, aus dessen Gehirn mehrere, bis zum Prioritätstag rückgängige Jahre ausgewischt würden, aber er kennt bis diesem Zeitpunkt weltweit alle in seinem Fach und in den naheliegenden Fächern bereits veröffentlichten Lösungen. Angenommen, dass die These, nach welcher die Anwendung einer naheliegenden Lösung eine Addition ist, und die Anwendung einer nicht naheliegenden Lösung eine Kombination ist, ist zu sagen, dass der fiktive Durchschnittsfachmann des Patentrechts eine Addition auszuarbeiten fähig ist, aber eine Kombination nicht schaffen kann. *Folgendermaßen der Fachmann, der sowohl naheliegende als auch nicht nah liegende neue Lösungen schaffen kann, kein Durchschnittsfachmann des Patentrechts ist.*

Comments on Paper C of the 2007 European Qualifying Examination

S. Roberts (GB)

Quis custodiet ipsos custodes? – or what should happen when Mr Cockup comes to call on the Examination Board and a Committee of the EQE?

Colin Philpott, Chairman of the Examination Board of the EQE gave an interesting speech at this year's EQE Award Ceremony. He stressed the importance of the EQE failing candidates who do not demonstrate that

they are fit to practise. But he was most loquacious on the subject of the Board's utmost faith and belief in the correctness of everything that the Examination Committees had done this year and that certainly everything had been marked uniformly. Indeed, this message was repeated so emphatically that one could not help thinking he „doth protest too much“.

In fact the EPI and CEIPI tutors who had earlier sat in the meetings with representatives of the Examination Committee for paper C already knew that there was something rotten to cover up. Principal among these was the fact that any candidate who made an obviousness attack starting from Annex 3 received no marks for that attack (they also lost marks for use of information). Although the representatives of the Exam Committee strove to suggest that this was only because no such candidate's attack was plausible (an assertion that defied belief) – I have been informed that in reality the members of the committee had agreed before the exam was sat that no marks would be awarded for any such attacks.

The Committee's position was apparently that candidates have shown that they cannot reliably identify the single document which represents the closest state of the art – and hence this is a skill that needs to be tested by paper C. I will return to this rather dubious position later, but even if one accepts it arguendo, the logic of refusing to consider any obviousness arguments starting from annex 3 is seriously flawed.

Claims 1 to 6 of the patent to be opposed concerned a „receptacle for hot liquids... having a grip area which is thermally insulated from the wall“ of the receptacle. Here hot meant over 50 degrees centigrade. Annex 3 concerned a waxed paper drinking container, for beverages cooler than about 30 degrees centigrade, which had a cardboard sleeve wrapped about its mid-portion so that „the drinking container is sufficiently insulated by the cardboard and then can be gripped without getting cold fingers or warming up the beverage“. The Exam Committee's position is that the limitation to cold drinks in annex 3 means that it cannot form an appropriate starting point for an obviousness attack on any of claims 1 to 6 – although it could be used as secondary reference! This position was not accepted by any of the tutors who were present in the presentation I attended (among whom was at least one DG 1 Director).

The common position of tutors was that annex 3 provides two distinct technical teachings: one concerning the use of waxed paper in containers for cold beverages; the other concerning the use of an insulating sleeve about a beverage container to provide thermal insulation between a user's fingers and a beverage in the container. This is the same general problem as that addressed by the contested patent. Adopting a conventional problem and solution approach, the objective technical problem becomes how to modify the arrangement of annex 3 to make it suitable to contain hot liquids. On this basis one can construct a sound obviousness attack, which in real life would I am sure succeed. But the Exam Committee decided, before the exam was sat, that no such arguments would receive any marks.

Contrast this with the position of those candidates who started obviousness attacks from the annex decreed by the Committee to be the closest state of the art. In such cases, the strength and merits of the attacks were assessed and high or low marks awarded accordingly.

This contrast in the state of affairs for those who selected the „correct“ closest state of the art, and those

who did not, hardly seems fair. More than that, it clearly demonstrates that candidates' papers were not marked in a uniform manner:

- those who started from annex 3 had their arguments ignored unread – or at least received no marks irrespective of the strengths and merits of those arguments (which amounts to the same thing);
- while those who started from the Committee's closest prior art were given marks according to the strengths and quality of their arguments.

This clearly violates Article 16 of the Decision of the Administrative Council of the EQE:

The Board shall give the member of the Examination Committees the necessary instructions to ensure that candidates' answers are marked in a uniform manner.“

This violation constitutes a ground of appeal – but no candidate should need to rely on filing an appeal in order to have this violation corrected. All the relevant papers should be re-marked.

What of the Exam Committee's fixation with testing candidates' ability to identify the single document which constitutes the closest state of the art? This pre-occupation is clearly leading the Exam Committee astray. The instructions to candidates for preparing their answers to the EQE say „the notice of opposition should contain all those (and no other) grounds – where possible against all the claims, which candidates consider in this particular case to be prejudicial to the maintenance of the patent. The omission of a good ground of opposition will lead to a loss of marks commensurate with the importance of the ground in the case concerned.“ There is nothing telling candidates that success or failure in the exam depends upon the correct identification of the closest prior art – rather than simply on formulation of an obviousness attack which is plausible and well argued. Nor is it appropriate to include such a requirement – there are generally several plausible starting points for any obviousness attack, and if obviousness can be demonstrated (without ex-post facto analysis) starting from a particular document it does not matter that it is more remote than the closest state of the art – the attacked subject matter is still obvious. Clearly there are obviousness attacks that are untenable because the prior art on which they are based is inappropriate. But the Examiners' approach this year has clearly demonstrated that they are incompetent to judge which ones might be tenable and which not. For this reason, there must be no more instructions to ignore (or give zero marks to) obviousness arguments merely because of the choice of starting point.

It is important to air this subject because it seems likely that, following the „success“ of the 2007 paper C (success because so many candidates chose the wrong starting point for their obviousness attacks and in consequence failed), the same issue will arise with the 2008 paper and its marking. While it is no doubt too late to change the contents of the 2008 paper, it is certainly not too late to get the marking instructions changed.

Those EPI members who have not been exposed to the 2007 paper C and the way that it was marked will no doubt be surprised to learn that the Examination Board decided to give all candidates 10 extra marks (raising the overall pass rate (for first time and resitting candidates) to just under 27 %). The paper was also set on the basis of a simplistic approach to the assessment of priority entitlement – annex 2 was deemed to be the first application for the subject matter of claim 1 of the contested patent because that claim lacked novelty over the disclosure of annex 2 – but no consideration was given by the Examiners to the question of whether annex 2 and claim 1 were in respect to the same invention (which was quite arguably not the case). But the two novelty attacks that the Examiners wanted raised against claim 1 both relied on the claim not being entitled priority.

The official Examiners' Report for this paper begins „This year's paper focussed on two key aspects: the selection of the closest prior art document for a proper problem-solution approach and the issue of priority". How sad is it that the Examiners themselves failed to deal properly with these very two issues. The examination paper certainly failed candidates – but sadly not just in the sense meant in Colin Philpott's speech.

In defence of their position the examiners reported that the trial run of the paper with „guinea pigs" revealed no problems with the paper. But this is not really surprising when one learns that at least one of the few guinea pigs was a former long-serving member of the paper C exam committee. Such a person will be so steeped in the approach of the exam committee that they can be expected to see immediately what the examiners want. So again this practice of using current or former members of an exam committee as guinea pigs on papers set by that committee should stop.

In conclusion, while I appreciate that the Examination Committees and the Examination Board perform a noble and difficult task with neither thanks nor gratitude, and that they have historically done this quite well, I do not believe that this absolves them from blame and responsibility when they err as they so clearly did this year. It is not enough for someone to fall on their sword – although that would be an appropriate starting point – remedial action is required to repair the damage done to the candidates who failed this year's paper C. Moreover, something concrete should be done to prevent the paper C Exam Committee pursuing this hobby horse in the future.

C-Book – How to write a successful opposition and pass paper C of the European Qualifying Examination by Hugo Meinders and William Chandler (Second Edition)¹

P. Low² (GB)

Paper C of the Qualifying Examination does not get any easier. Indeed the poor results of the 2007 examination would suggest that it is actually getting more difficult – unless one accepts that the quality of the candidates has declined, which seems unlikely. So it is more important than ever that candidates are as well prepared as possible for this paper. Added to which candidates must now be ready to deal with the requirements of EPC 2000 which will form part of the Syllabus for EQE 2008 and subsequent examinations. So three cheers for Hugo Meinders and Bill Chandler who have revised their C-Book to take account of EPC 2000 and to follow suggestions made after publication of the first edition in time for it to be published well in advance of the 2008 examination.

The overall format of the book follows that of the first edition. The authors' „matrix claims" form of attack is compared to the more traditional „matrix features" method and using paper C of 1999 the step by step preparation of a notice of opposition is developed. But possibly that is now becoming the less difficult aspect of Paper C.

From a study of past papers it does seem that the Paper C examiners will always try to raise issues which have not been specifically asked before. This is not to say that there will never be points concerning priority, added subject matter, novelty, inventive step and so on in future papers. But that when those points do arise they will be presented differently or in a form which is not quite the same as in past papers. The importance of this aspect of Paper C cannot be over emphasised because failure to deal with these points correctly can be disastrous.

¹ W.E. Chandler and H. Meinders, C-Book 2nd edition, Carl Heymans Verlag GmbH Cologne, Berlin, Munich 2007, ISBN 978-3-452-26521-0.

² Peter Low, European Patent Attorney.

For example in the 2007 paper candidates were expected to be able to identify the closest prior art for the purposes of making inventive step attacks and to explain why the selected document was the closest prior art. This is standard procedure and most candidates would think they knew how to do it. Yet it happened that a lot of candidates were judged to have got that wrong and as result failed the paper completely.

So this makes the part of the book that analyses points which crop up in past papers of particular help to candidates. While it will not tell them precisely what the examiners will do it should nevertheless help them to prepare for the sort of thing that they may find in the paper.

From experience of tutoring over many years I have found that what many candidates are looking for is a

magic formula that will get them through the qualifying examination, preferably without doing any work. They are not much comforted when I tell them that I do not have a magic formula. The C-Book is not either but it is the next best thing and should be part of every candidate's essential kit. But it is not enough just to have it. It is absolutely necessary for candidates to practice on past papers the methods explained in the book to see which one suits them best. And as well it is essential to be able to deal with the other points that may occur in the paper in whatever guise they appear.

When I reviewed the first edition I said it was a bargain if it leads to qualification as a European Patent Attorney. At 68 euros the price of the second edition has gone up a little bit but it is still fantastic value.

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