

Table of Contents

Editorial	102	Payment of epi subscriptions, by P. Kelly, Treasurer	122
I – Information concerning epi		Rules governing the payment of the <i>epi</i> annual membership fee	125
Council Meeting		<i>epi</i> membership and membership subscription . .	127
Bericht über die 55. Ratssitzung, Cannes, 20.-21. Oktober 2003	103	Important Information from the Secretariat . . .	129
Entwurf der Ratsbeschlüsse	104		
Report of the 55 th Council meeting, Cannes, 20-21 October 2003	105	Information from the Secretariat	
Draft List of Decisions	106	Deadline 1/2004.	118
Compte rendu de la 55 ^{ème} réunion du Conseil, Cannes, 20-21 octobre 2003	107	Themed edition 1/2004	131
Projet de Liste de Décisions	108	<i>epi</i> Membership chart as of 10 November 2003 .	132
President's report	109	<i>epi</i> Disciplinary bodies and Committees	146
Treasurer's report	110	<i>epi</i> Board	U 3
		II – Contributions from epi Members and other contributions	
Committee Reports		Articles	
Report of the Disciplinary Committee, by G. Leherte	111	„Quality of Patent searches“, by E. Lyndon Stanford	133
Report of the EPO Finances Committee, by J. Boff	111	Amicus Curiae Brief in G1/03 and G2/03 (Disclaimers) on behalf of the <i>epi</i>	134
Report of the European Patent Practice Committee (EPPC), by A. Casalonga	112	The case for disclaiming anticipating prior art – whether accidental or otherwise, by A. Rudge .	138
Report of the Harmonisation Committee, by F. Leyder	115	Neue Anmeldungsformulare für Patente und Gebrauchsmuster in Japan, Übersetzung von P. Rosenich	141
Report of the Online Communications Committee (OCC), by D. Speiser	116		
Report of the Professional Qualifications Committee (PQC), by T. Onn	117	Letters to the Editor	
		Postponement of oral proceedings at the EPO letter from I. Wishart, and reply from EPO Vice President Kyriakides	144
European Qualifying Examination		Book Reviews	
Results of the European Qualifying examination 2003	119	„Das US-Patent“ von Richard L. Mayer, Kommentar von H. Bardehle.	145
More <i>epi</i> tutors wanted.	120		
epi Membership/epi Subscription			
Invoice 2004 and direct debiting mandate. . . .	121		

Editorial

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

The election of the next EPO president has, finally, been resolved and, as everyone now knows, the Presidency will be held by Prof. Pompidou for three years and by Ms. Brimelow for the subsequent three years.

The solution appears to have been the only practical solution to which the Administrative Council could come, the two fractions supporting the two candidates being unwilling to compromise in any other way. However, whilst a compromise between two extremes is usually to be considered beneficial, a compromise which is between two disparate but not necessarily opposing solutions does not always share the same benefits.

In this respect, it would seem that the Administrative Council and the Office itself should provide answers as to how the agreed arrangement is to work in a positive manner. In particular, users will wish to know how the two individuals sharing the 6-years term consecutively

will co-operate so as to ensure that their policies are consistent.

The drawn-out procedure for appointing the EPO president this time round has not covered the European Patent Office, most particularly the Administrative Council, with glory. Indeed, the inference to be drawn, from all the deliberations within the Administrative Council, is that, in the present case, political considerations have taken precedence over the practical well-being of the European Patent system.

However, the tortuous process that has led to the present situation is now over. Now that the solution is in place it is important for us to look forward. We trust that the individuals, who have been appointed as EPO Presidents, are able to demonstrate the collective vision to maintain the European Patent Office as a viable centre of service excellence for Patent applicants in Europe.

55th Council Meeting, Cannes, 20. – 21.10.2003



Photo: T. Schuffenecker

Bericht über die 55. Ratssitzung in Cannes 20. – 21. Oktober 2003

Die Sitzung wurde von Präsident Holzer eröffnet, der die Vertreter aus 24 Ländern und die Beobachter weiterer Länder, die dem Institut in Kürze beitreten werden, im Rat willkommen hieß.

Die Stimmenzähler wurden ernannt. Die überarbeitete Tagesordnung wurde mit kleinen Änderungen angenommen. Das Protokoll der vierundfünfzigsten Ratssitzung wurde angenommen. Zu Angelegenheiten, die sich aus dem Protokoll der letzten Ratssitzung ergaben, und zu den Empfehlungen des Vorstands seit der letzten Ratssitzung gab der Präsident über einzelne Punkte einen mündlichen Bericht.

Anschließend gab der Präsident kurz seinen Bericht, der an anderer Stelle in dieser Ausgabe der *epi* Information veröffentlicht ist. Im Anschluss an den Bericht des Präsidenten erläuterten der Generalsekretär und der Schatzmeister dem Rat ihre Berichte. Der Schatzmeister legte den Haushalt 2004 vor. Der Rat beschloss, den von den Mitgliedern zu zahlenden Jahresbeitrag nicht zu ändern, und stimmte für den empfohlenen Beitrag von 150 € bei Zahlung vor dem 1. Mai 2004 und 175 € bei Zahlung nach dem 1. Mai 2004. Der Rat billigte den Haushalt 2004.

TOP 10 beschäftigte sich erneut mit dem Schutz der Bezeichnung „European Patent Attorney“. Bekanntermaßen wird die Bezeichnung im EPÜ nicht erwähnt, es besteht dafür jedoch dringender Bedarf. Der englischen Kurzbezeichnung „European Patent Attorney“ muss der entsprechende deutsche und französische Ausdruck beigelegt werden. Die auf der letzten Ratssitzung in Gent mit einfacher Mehrheit getroffene Abstimmung war zu wiederholen, weil eine qualifizierte Mehrheit von 2/3 der Ratsmitglieder notwendig ist. Ferner baten die Abordnungen aus der Schweiz und Liechtenstein den Rat, die deutsche Bezeichnung „Europäischer Vertreter vor dem EPA“ in „Europäischer Patentanwalt“ abzuändern. Ein zweiter Antrag verlangte die Änderung von „Europäischer Vertreter vor dem EPA“ in „zugelassener Vertreter vor dem EPA“. Der Rat diskutierte den Antrag der Abordnungen der Schweiz und Liechtensteins ausführlich, lehnte ihn aber schließlich ab, da er gegen das herrschende deutsche und österreichische Gesetz verstoßen würde. Dann wurde der Rat aufgefordert, über den zweiten Antrag abzustimmen, und eine eindeutige Mehrheit stimmte für die Änderung. Schließlich stimmte der Rat mit qualifizierter Mehrheit für die Kurzbezeichnungen in den drei Amtssprachen „European patent attorney“, „zugelassener Vertreter vor dem EPA“ und „mandataire européen en brevets“.

Anschließend wurde der Rat über *epi* Positionspapiere betreffend das Gemeinschaftspatent informiert, die im vergangenen Monat an das EPA und nationale Regierungen geschickt wurden. Dann kamen die Berichte der Ausschüsse an die Reihe, beginnend mit dem Bericht des Disziplinarrates. Der Disziplinarrat arbeitet derzeit an

einer Änderung der Vorschriften in Disziplinarangelegenheiten auf der Grundlage der Schaffung eines lediglich beratende und Schlichtungsfunktion ausübenden Disziplinarrates und eines Disziplinarausschusses, der als erste Instanz von Mitgliedern des *epi* und des EPO gebildet wird. Zu diesem Zweck wurde eine Arbeitsgruppe bestimmt. Einige wesentliche Prinzipien der Vorschläge der Arbeitsgruppe wurden dem Rat vorgestellt und besprochen. Der Rat wünschte einige Änderungen, stimmte aber den Vorschlägen grundsätzlich zu.

Der Ausschuss für biotechnologische Erfindungen legte keinen Bericht vor, da seit der letzten Ratssitzung keine Sitzung stattgefunden hat. Dann legte der Ausschuss für berufliche Qualifikation (PQC) seinen Bericht vor. Zunächst legte der Vorsitzende die Ergebnisse der letzten Europäischen Eignungsprüfung vor. Wieder einmal waren die Ergebnisse nicht zufrieden stellend. Der PQC führt wieder ein Sommer- und ein Herbsttutorium ein, da nicht viele Tutoren zur Verfügung stehen. Besonders deutschsprachige Tutoren werden gesucht und wer interessiert ist, als Tutor zu arbeiten, wird gebeten, sich mit dem *epi* Sekretariat in Verbindung zu setzen. Der PQC hat eine Arbeitsgruppe gebildet, um eine Modernisierung und Verschlinkung der Europäischen Eignungsprüfung zu erarbeiten. Die Überarbeitung wird begonnen mit der Versendung eines Fragebogens an alle *epi* Mitglieder, um dessen Beantwortung und Rücksendung an den PQC gebeten wird, wobei es wichtig ist, so viele Antworten wie möglich zu erhalten, um eine breite Grundlage für die Einschätzung durch einen Fachmann von außen zu bekommen.

Anschließend legten die Schriftleitung, der *epi* Finanzausschuss, der Ausschuss für Online-Kommunikation und der Geschäftsordnungsausschuss ihre Berichte vor. Der Rat musste über die Größe der Ausschüsse entscheiden und nach einer Diskussion wurde für jeden Ausschuss abgestimmt. Eine Zusammenfassung vieler dieser Berichte steht an anderer Stelle dieser Ausgabe der *epi* Information.

Dann wurde dem Rat der Bericht des Ausschusses für Europäische Patentpraxis (EPPC) vorgelegt und ein Amicus Curiae Brief zu G1/03 und G2/03 („disclaimer“) wurde diskutiert, der an anderer Stelle in dieser Ausgabe veröffentlicht ist. Danach legte der Harmonisierungsausschuss seinen Bericht vor.

Der nächste Punkt war die Vorstellung eines EPA-Papiers über die organisatorische Autonomie der EPA-Beschwerdekammern innerhalb der Europäischen Patentorganisation. Die Vertretungsbefugnis der zugelassenen Vertreter ist auf die Vertretung vor der gesamten Europäischen Patentorganisation zu erstrecken und zu gegebener Zeit wird das *epi* ein Positionspapier hierzu vorbereiten.

Der Präsident informierte den Rat über den CEIPI/*epi*-Kurs über Patentstreitverfahren in Europa und die

geplante Gründung einer Europäischen Akademie für gewerblichen Rechtsschutz. Der CEIP/*epi*-Kurs über Patentstreitverfahren in Europa hat unter den *epi*-Mitgliedern großes Interesse geweckt. Das Projekt einer Europäischen Akademie und eine Studie über deren Machbarkeit, die gerade ausgearbeitet wird, wurde diskutiert. Anschließend folgte ein kurzer Bericht über die Arbeitsgruppe Streitregelung und das Internationale FORUM 2003 über das EPÜ/PCT-System, das am 3. und 4. November 2003 im Europäischen Patentamt in München stattfinden wird.

Danach stellte der EPA-Finanzausschuss dem Rat seinen Bericht in Verbindung mit einer Präsentation der künftigen Gebührenpolitik des EPA vor. Das EPA plant eine Erhöhung der Gebühren und es wurde Besorgnis geäußert, ob der erweiterte Recherchebericht die gleiche Qualität wie der traditionelle Bericht haben würde.

Dann wurde der Beitritt neuer Länder anhand des Beitritts von Polen, Litauen und Lettland sowie Island und Malta erörtert.

Die Termine der nächsten Ratssitzungen wurden in Erinnerung gerufen. Die 56. Ratssitzung wird am 27. und 28. Mai 2004 in Kopenhagen stattfinden.

Dann wählte der Rat ein neues stellvertretendes Mitglied für Deutschland in den PQC, ein neues Vorstandsmitglied für Rumänien, Frau Oproiu, und neue Mitglieder aus CZ, HU, RO und SK in den SACEPO-Ausschuss und in den Disziplinarrat.

Schließlich wurde das EPA-Projekt „Sammlung chemischer Strukturdaten in elektronischer Form“ vorgestellt.

Der Präsident dankte den französischen Ratsmitgliedern herzlich für die sehr erfolgreiche Organisation der 55. Ratssitzung und schloss die Sitzung um 12.50 Uhr.

Beschluss- und Maßnahmenliste, 55. Ratssitzung, Cannes 20.-21. Oktober 2003

1. Der Begriff „Editorial Board“ wird in „Editorial Committee“ und „Schriftleitung“ in „Redaktionsausschuss“ abgeändert.
2. Der überarbeitete Haushalt 2003 wurde genehmigt.
3. Der Haushalt 2004 wurde genehmigt.
4. Der Rat beschloss einstimmig die Beibehaltung des Mitgliedsbeitrags für das Jahr 2004 von 150 EUR bei Zahlung vor dem 1. Mai und 175 EUR bei Zahlung nach dem 1. Mai.
5. Der Rat stimmte gegen eine weitere Diskussion des Antrags der Abordnungen aus der Schweiz und Liechtenstein, dem Verwaltungsrat den Gebrauch der Bezeichnung „Europäischer Patentanwalt“ vorzuschlagen.
6. Der Rat stimmte mit 2/3-Mehrheit dafür, dem Verwaltungsrat ein Papier vorzulegen zur Änderung von Art. 5(1) der „Vorschriften für die Errichtung eines Instituts“, u. a. durch Einführung der folgenden Kurzbezeichnungen: „European patent attorney“, „zugelassener Vertreter vor dem EPA“ und „mandataire européen en brevets“.
7. Der Rat stimmte dafür, dass der Disziplinarrat mit der Überarbeitung der Disziplinärvorschriften innerhalb der Arbeitsgruppe *epi*/EPA fortfährt.
8. Der Vorsitzende eines Ausschusses kann die Anzahl assoziierte Mitglieder innerhalb des Ausschusses festlegen.
9. Der Ausschuss für Standesregeln soll aus höchstens einem ordentlichen und höchstens einem stellvertretenden Mitglied pro Land bestehen.
10. Der Ausschuss für europäische Patentpraxis (EPPC) soll aus höchstens zwei ordentlichen Mitgliedern pro Land ohne Stellvertreter bestehen.
11. Der Ausschuss für berufliche Qualifikation (PQC) soll aus höchstens je einem ordentlichen und einem stellvertretenden Mitglied pro Land bestehen.
12. Der Ausschuss für biotechnologische Erfindungen soll aus höchstens einem ordentlichen Mitglied pro Land ohne Stellvertreter bestehen.
13. Der Harmonisierungsausschuss soll aus höchstens 7 ordentlichen und höchstens 7 stellvertretenden Mitgliedern bestehen.
14. Der EPA Finanzausschuss soll aus höchstens vier ordentlichen und höchstens vier stellvertretenden Mitgliedern bestehen.
15. Der Redaktionsausschuss soll aus höchstens vier Mitgliedern ohne Stellvertreter bestehen.
16. Der Geschäftsordnungsausschuss soll aus höchstens vier Mitgliedern ohne Stellvertreter bestehen.
17. Der Ausschuss für Online-Kommunikation soll aus höchstens 7 ordentlichen Mitgliedern ohne Stellvertreter bestehen.
18. Der Rat stimmte einstimmig zu, dass Straßburg in Erwägung gezogen werden soll als möglicher Sitz für die Europäische Schulungsakademie für Geistiges Eigentum.
19. Frau K. ZIMMERMANN wurde als Nachfolgerin des zurückgetretenen Herrn MAGIN zur Stellvertreterin von Deutschland für den PQC gewählt.
20. Frau M. OPROIU wurde zum Vorstandsmitglied für Rumänien gewählt.

21. Herr V. ŽÁK (CZ), Herr I. GÖDÖLLE (HU), Frau D. NICOLAESCU (RO) und Herr J. GUNIS (SK) wurden als SACEPO-Mitglieder gewählt.
22. Herr M. GUTTMANN (CZ), Herr I. MARKÓ (HU), Frau D. TULUCA (RO) und Frau M. MAJLINGOVÁ (SK) wurden als Mitglieder des Disziplinarrates gewählt.

23. Herr E. LYNDON STANFORD (GB) wurde zum 1. Januar 2004 als Ersatz für den zurückgetretenen Herrn I. MUIR als Mitglied des EPPC gewählt.

Report of the 55th Council Meeting in Cannes 20 – 21 October 2003

The meeting was opened by the President, Mr. Holzer, who welcomed the representatives of 24 Countries in the Council and the observers of other countries that would be joining the Institute soon.

The scrutineers were appointed. The revised draft agenda was adopted with few amendments. The minutes of the fifty-fourth Council Meeting were approved. With regard to matters arising from the minutes of the previous Council Meeting, and the recommendations made by the Board since the last Council Meeting, there was an oral report from the President on individual issues.

The President briefly presented his report, which is published elsewhere in this edition of *epi* information. Subsequent to the President's Report, the Reports of the Secretary General and the Treasurer were also provided to the Council. The Treasurer presented the budget for 2004. The Council decided not to change the annual subscription payable by the members and voted for the recommended subscription of € 150,00 if paid before May 1 and € 175,00 if paid on or after May 1, 2004. The Council approved the budget for 2004.

Point 10 of the agenda again dealt with the protection of the title „European Patent Attorney“. Council were reminded that the EPC does not mention the title and that there is a serious need for codifying the term in the EPC. The English short term – European patent attorney – needs to be augmented by corresponding expressions in German and French. In this respect, the simple majority achieved in the last Council Meeting, in Ghent, was insufficient, because a qualified majority is needed. Furthermore, the delegations of Switzerland and Liechtenstein brought in a request to the Council to amend the title, in the German version, from „Europäischer Vertreter vor dem EPA“ into „Europäischer Patentanwalt“. A further request asked for amendment from „Europäischer Vertreter vor dem EPA“ into „zugelassener Vertreter vor dem EPA“.

The Council fully discussed the request from the Swiss and Liechtenstein delegation but finally voted not to approve it because it would be against the current German and Austrian Law. Then the Council was asked to vote on the second request and a qualified majority voted for the amendment. Last the Council approved,

with a qualified majority, the short titles in the 3 official languages „European patent attorney“, „zugelassener Vertreter vor dem EPA“ and „mandataire européen en brevets“.

Moving on, the Council was advised about *epi* position papers, sent out to the EPO and national governments in the last month, concerning the Community Patent.

The reports of the Committees were then taken, commencing with the report of the Disciplinary Committee. The Disciplinary Committee is working on a revision of the Regulation on discipline based on the creation of a Disciplinary Committee with an advisory and harmonising function only, and a first instance Disciplinary Board including members from *epi* and EPO. A working group was established for this purpose. Some essential principles of the proposals of the working group were presented to the Council and were discussed. The Council demanded some amendments but agreed with the basic proposals.

Because the Committee on Biotechnological Inventions had not met since the last Council Meeting no report was given by this committee.

The Professional Qualification Committee then reported. The Chairman first presented the results of the last EQE. Once again the results were not satisfying. Due to a shortage of tutors the PQC is reverting to summer and autumn tutorials. There is especially a need for German speaking tutors. Individuals who are interested in working as tutors are asked to apply to the *epi* secretariat. The PQC has set up a working group for carrying out a survey relating to modernizing and streamlining the EQE. The survey will commence with the dispatch of a questionnaire to all *epi* members, who are asked to be good enough to answer it and send it back to PQC. It is important to get as many answers as possible in order to have a broad basis for evaluation by an external expert.

Following this the reports of the Editorial Board, the *epi* Finances Committee, the OCC and By-laws Committee were given. At this point the Council had to decide on the size of the committees and, after discussion, votes were taken for each of the committees. A

summary of many of these reports may be found elsewhere in this edition of *epi* information.

Then the report of the EPPC was presented to the Council and an Amicus Curiae Brief for G1/03 and G2/03 (disclaimers), which is published elsewhere in this edition, was discussed. After that the Harmonisation Committee gave its report.

The next point was the presentation of an EPO paper on the organisational autonomy of the Boards of Appeal of the EPO within the European Patent Organisation. Representation of professional representatives will have to evolve to the representation before the whole European Patent Organization and a position paper, will be prepared by *epi* at given time.

The president informed the Council about the Ceipi/*epi* Course on Patent Litigation in Europe and the planned establishment of a European Industrial Property Academy for education and training in the field of industrial property and in particular European patent law. This course shows great interest within the *epi* members. The project of the European Academy was then discussed, in the light of a feasibility study which is being carried out. This topic was then followed by a brief report on the Working Party on Litigation and the 2003 International FORUM on the EPC/PCT system which will

take place on 3-4 November 2003 in the European Patent Office in Munich.

After this the EPO Finances Committee gave the report to the Council in connection with the recent presentation of the future EPO fee policy. Increase of the fees is contemplated by the EPO and concern was expressed that the quality of the Extended Search Report be maintained to the level of the traditional report.

The question of accession of new countries was then discussed, relating to the accession of Poland, Lithuania and Latvia, as well as of Iceland and Malta.

The dates of the next council meetings were confirmed. The 56th Council Meeting will take place in Copenhagen on 27-28th May 2004.

The Council then elected a new PQC Substitute Member for Germany, a new Board member for Romania, who is Ms. Oproiu, and new members, from the Czech Republic, Hungary, Romania and Slovakia, to SACEPO and to the Disciplinary Committee.

Finally, the EPO project „Collection of Chemical Structure Data in Electronic Form” was discussed.

After having warmly thanked the French delegates for the very successful organisation of the 55th council meeting, the President closed the meeting at 12:50 p.m.

Draft List of Decisions, 55th Council Meeting, Cannes 20-21 October 2003

1. The term „Editorial Board” will be changed into „Editorial Committee”, and „Schriftleitung” into „Redaktionsausschuss”.
2. The 2003 revised Budget was approved.
3. The 2004 Budget was approved.
4. Council unanimously decided to maintain the membership subscription for the year 2004 at € 150 , if paid before May 1, and at € 175 if paid on or after May 1.
5. Council decided against discussing further the motion submitted by the Swiss and Liechtenstein delegations, to propose to the Administrative Council the use of the title „Europäischer Patentanwalt”.
6. Council decided by a 2/3rd majority that a paper should be presented to the Administrative Council for amendment of Art. 5(1) of the Regulation on the establishment of the Institute, i.a by introducing the following short professional titles: “European patent attorney,,, “zugelassener Vertreter vor dem EPA,, and “mandataire européen en brevets”.
7. Council approved that the Disciplinary Committee carries on with the revision of the Regulation on discipline within the *epi*/EPO working group.
8. The Chairman of a Committee may decide on the number of associate members within the Committee.
9. The Professional Conduct shall consist of a maximum of 1 full member per country, and a maximum of 1 substitute member per country.
10. The EPPC shall consist of a maximum of 2 full members per country, without substitute members.
11. The PQC shall consist of a maximum of 1 full member and a maximum of 1 substitute member per country.
12. The Committee on Biotechnological Inventions shall consist of a maximum of 1 full member per country, without substitute members.
13. The Harmonisation Committee shall consist of a maximum of 7 full members, and a maximum of 7 substitute members.
14. The EPO Finances Committee shall consist of a maximum of 4 full members, and a maximum of 4 substitute members.
15. The Editorial Committee shall consist of a maximum of 4 members, without substitute members.
16. The By-Laws Committee shall consist of a maximum of 4 members, without substitute members.
17. The OCC shall consist of a maximum of 7 full members, without substitute members.
18. Council unanimously approved that Strasbourg should be taken into consideration as a possible location of the European IP Training Academy.

19. Mrs. K. ZIMMERMANN was appointed substitute PQC member for Germany, in replacement of Mr. MAGIN who has resigned.
20. Mrs. M. OPROIU was appointed Board member for Romania.
21. Mr. V. ŽÁK (CZ), Mr. I. GÖDÖLLE (HU), Mrs. D. NICOLAESCU (RO), Mr. J. GUNIS (SK) were appointed SACEPO Members.
22. Mr. M. GUTTMANN (CZ), Mr. I. MARKÓ (HU), Mrs. D. TULUCA (RO) and Mrs. M. MAJLINGOVÁ (SK) were appointed Members of the Disciplinary Committee.
23. Mr. E. LYNDON STANFORD (GB) was appointed Member of the EPPC as from 1 January 2004 in replacement of Mr. I. MUIR who has resigned.

Compte rendu de la 55ème réunion du Conseil Cannes, 20-21 octobre 2003

Le Président Holzer ouvre la session de la 55^{ème} réunion du Conseil et souhaite la bienvenue aux représentants des 24 pays du Conseil ainsi qu'aux observateurs d'autres pays qui deviendront bientôt membres de l'Institut.

A la suite de la désignation des scrutateurs, l'ordre du jour est adopté avec des amendements mineurs, ainsi que le compte rendu de la 54^{ème} réunion du Conseil. Le rapport oral du Président sur les différentes questions relevant de la réunion précédente est suivi d'un bref compte rendu des recommandations faites par le Bureau depuis la dernière réunion du Conseil.

Ensuite le Président présente son rapport, lequel est publié dans ce numéro de *epi* Information. Suivent ensuite les rapports respectifs du Secrétaire Général et du Trésorier.

Le Trésorier présente le budget 2004. Le Conseil approuve de maintenir le montant de la cotisation à 150 EUR pour l'année 2004 si le paiement est effectué avant le 30 avril 2004, et à 175 EUR si le paiement est effectué au delà de cette date. Le Conseil approuve le budget pour l'année 2004.

La protection du titre „European patent attorney” est de nouveau à l'ordre du jour, au point 10. Le Président rappelle aux membres du Conseil que le titre abrégé „European patent attorney” n'est pas mentionné dans la CBE et qu'il est urgent de l'y inscrire, de même que des expressions correspondantes en allemand et en français. La proposition de modification de l'article 5 du Règlement relatif à la création de l'Institut, laquelle requiert une participation des 2/3 des membres du Conseil, n'avait pu être votée à la dernière réunion du Conseil à Gand où une simple majorité était représentée. Les délégations de Suisse et du Liechtenstein présentent une motion proposant de remplacer dans la version allemande le titre „Europäischer Vertreter vor dem EPA” par „Europäischer Patentanwalt”. Une seconde motion propose de remplacer le titre „Europäischer Vertreter vor dem EPA” par „Zugelassener Vertreter vor dem EPA”.

Cette proposition des délégations de Suisse et du Liechtenstein fait l'objet d'une longue discussion, suivie finalement par un vote. Le Conseil rejette la proposition

parce que l'adoption du titre proposé contreviendrait au droit national en Allemagne et en Autriche. Le Conseil est ensuite appelé à se prononcer sur la deuxième motion et vote en faveur du titre „zugelassener Vertreter vor dem EPA”. Pour finir, le Conseil vote à la majorité requise des 2/3 les titres abrégés suivants dans les trois langues officielles : „European patent attorney”, „zugelassener Vertreter vor dem EPA” et „mandataire européen en brevets”.

Puis le Conseil est informé que des prises de position de l'*epi* concernant le Brevet communautaire ont été envoyées le mois précédent à l'OEB ainsi qu'aux gouvernements nationaux.

Les Commissions présentent ensuite leur rapport. La Commission de discipline prépare une révision du règlement en matière de discipline, qui reposerait sur la création d'une Commission de discipline ayant pour fonction de conseiller et d'harmoniser, et d'un Conseil de discipline de 1^{ère} instance comprenant des membres de l'*epi* et de l'OEB. Un groupe de travail a été mis en place à cet effet. Les principes essentiels des propositions sont présentés au Conseil, sont discutés et approuvés, mais avec quelques amendements.

La Commission des Inventions en Biotechnologie ne présente pas de rapport car elle ne s'est pas réunie depuis la dernière réunion du Conseil.

Suit ensuite le compte-rendu de la Commission de Qualification Professionnelle. Le Président de la Commission commente les résultats de la dernière session de l'examen de qualification. Les résultats sont de nouveau peu satisfaisants. En raison du manque de tuteurs, le PQC a adopté de nouveau le système de deux tutorats, l'un en été, le deuxième en automne. Il y a besoin de nouveaux tuteurs, plus particulièrement en langue allemande, et les personnes qui seraient intéressées à se porter candidates sont invitées à contacter le secrétariat de l'*epi*. Le PQC a mis en place un groupe de travail dans le but de réaliser une étude concernant la modernisation et la rationalisation de l'examen de qualification. L'étude commencera par l'envoi d'un questionnaire à tous les membres de l'*epi* qui sont aimablement invités à y répondre et à retourner celui-ci au PQC. Il est en effet

important qu'un nombre important de réponses soit reçu afin d'offrir une base assez large pour l'évaluation qui sera réalisée par un expert externe.

Suivent ensuite les rapports du Comité de Rédaction, de la Commission des Finances de l'*epi*, de la Commission des Communications en ligne (OCC) et de la Commission du Règlement Intérieur. Le Conseil doit se prononcer sur l'effectif des Commissions, et après discussion il décide au vote du nombre de membres à attribuer à chacune de ces commissions. Un grand nombre de ces rapports sont publiés dans ce numéro de *epi* Information.

L'EPPC présente ensuite son rapport et une discussion s'ensuit relative à l'*Amicus Curiae* Brief dans les cas G1/03 et G2/03 (disclaimers) qui est publié dans ce numéro. La présentation des rapports de commission se termine avec le rapport de la commission d'Harmonisation.

Le Président aborde ensuite un document de l'OEB sur l'Autonomie organisationnelle des Chambres de recours de l'OEB au sein de l'Organisation européenne des brevets. La représentation des mandataires devra évoluer vers la représentation devant l'Organisation européenne des brevets, et une prise de position de l'*epi* sera préparée en temps voulu.

Le Président informe le Conseil sur la mise en place d'un cours CEIPI/*epi* sur les procédures judiciaires en Europe, et sur le projet de création d'une Académie européenne de la propriété industrielle pour l'enseignement et la formation dans le domaine de la propriété industrielle et en particulier du droit des brevets. Le cours CEIPI/*epi* sur les procédures judiciaires en Europe suscite un grand intérêt au sein des membres de l'*epi*. Le projet de l'Académie européenne est ensuite discuté à la

lumière d'une étude de faisabilité qui est en cours. Vient ensuite un bref rapport sur le Groupe de travail „Contentieux “ ainsi que sur le Forum International 2003 sur le thème CBE/PCT, qui se tiendra à l'Office européen des brevets à Munich les 3 et 4 novembre 2003.

La Commission des Finances de l'OEB présente ensuite son rapport au Conseil, lequel rapport intervient dans le contexte d'une évolution de la politique de l'OEB en matière de taxes. Une augmentation des taxes est à l'étude à l'OEB et des craintes sont exprimées au sein du Conseil que la qualité du rapport de recherche élargi ne dépasse pas celle du rapport traditionnel.

La question de l'accession des nouveaux pays est ensuite évoquée avec l'entrée prochainement de la Pologne, de la Lituanie et de la Lettonie, ainsi que de l'Islande et de Malte.

Les dates des prochaines réunions du Conseil sont confirmées. La 56^{ème} réunion du Conseil aura lieu à Copenhague les 27-28 mai 2004.

Le Conseil élit ensuite Mme K. Zimmermann nouveau membre suppléant de la commission de PQC. Mme Oproiu est élue Membre du Bureau pour la Roumanie et de nouveaux membres de la République tchèque, de Hongrie, de Roumanie et de Slovaquie sont élus membres du SACEPO et de la Commission de Discipline.

Pour finir, le projet de l'OEB „Collection de données de structure chimique sous forme électronique “ est discuté.

Après avoir remercié chaleureusement les représentants français pour l'organisation très réussie de la 55^{ème} réunion du Conseil, le Président clôt la séance à 12.50 heures.

Projet de liste des décisions, 55^{ème} réunion du Conseil, Cannes 20-21 octobre 2003

1. Le terme „Editorial Board“ est remplacé par „Editorial Committee“, et „Schriftleitung“ par „Redaktionsausschuss“.
2. Le budget pour l'année 2003 est approuvé.
3. Le Budget 2004 est adopté.
4. Pour l'année 2004, le Conseil approuve à l'unanimité le maintien du montant de la cotisation à € 150 si le paiement est effectué avant le 30 avril 2004, et à € 175 dans le cas d'un paiement effectué au-delà de cette date.
5. Le Conseil décide de ne pas poursuivre la discussion au sujet de la motion présentée par les délégations de Suisse et du Liechtenstein, laquelle propose de requérir auprès du Conseil d'Administration l'usage du titre „Europäischer Patentanwalt“.
6. Le Conseil décide à la majorité des deux tiers d'adresser une requête au Conseil d'Administration en vue de modifier l'Article 5(1) du Règlement relatif à la création de l'Institut en y insérant, entre autres, les titres professionnels abrégés suivants : „European patent attorney“, „zugelassener Vertreter vor dem EPA“ et „mandataire européen en brevets“.
7. Le Conseil approuve que la Commission de discipline poursuive la révision du Règlement en matière de discipline au sein du groupe *epi*/EPO.
8. Les présidents de commissions peuvent décider du nombre de membres associés au sein d'une commission.
9. La Commission de Conduite Professionnelle comprendra au maximum 1 membre titulaire et 1 membre suppléant par pays.

10. La Commission de Pratique du brevet européen (EPPC) comprendra au maximum 2 membres titulaires par pays, et aucun membre suppléant.
11. La Commission de Qualification Professionnelle (PQC) comprendra au maximum 1 membre titulaire et 1 membre suppléant par pays.
12. La Commission pour les Inventions en Biotechnologie comprendra au maximum 1 membre titulaire par pays, et aucun membre suppléant.
13. La Commission d'Harmonisation comprendra au maximum 7 membres titulaires et 7 membres suppléants.
14. La Commission concernant les Finances de l'OEB comprendra au maximum 4 membres titulaires et 4 membres suppléants.
15. Le Comité de Rédaction comprendra au maximum 4 membres, et aucun membre suppléant.
16. La Commission du Règlement Intérieur comprendra au maximum 4 membres, et aucun membre suppléant.
17. Le Comité pour les Communications en ligne (OCC) comprendra au maximum 7 membres titulaires, et aucun membre suppléant.
18. Le Conseil approuve à l'unanimité que Strasbourg soit envisagé comme lieu d'implantation de l'Académie européenne de la propriété industrielle.
19. Mme K. ZIMMERMANN est nommée membre suppléant du PQC pour l'Allemagne, en remplacement de M. MAGIN qui a démissionné.
20. Mme M. OPROIU est nommée membre du Bureau pour la Roumanie.
21. M. V. ŽAK (CZ), M. I. GÖDÖLLE (HU), Mme D. NICOLAESCU (RO), M. J. GUNIS (SK) sont nommés membres du SACEPO.
22. M. M. GUTTMANN (CZ), M. I. MARKÓ (HU), Mme D. TULUCA (RO) et Mme M. MAJLINGOVÁ (SK) sont nommés membres de la Commission de Discipline.
23. M. E. LYNDON STANFORD (GB) est nommé membre de l'EPPC à partir du 1er janvier 2004, en remplacement de M. I. MUIR qui a démissionné.

Presidents' Report (covering May – October 2003)

W. Holzer (AT)

The President reported that subsequent to the Council meeting in Ghent, a meeting of the Sub-Group of the Working Party on Litigation took place in Munich which was attended by Vice-President Macchetta and him. The estimated workload and cost of the European Patent Judiciary were discussed as well as the final draft paper for an EPLA, and a number of open issues clarified.

In May, Vice-President Mercer, the Chairman of the EPPC, Casalonga, and the President had a meeting with the European Commission, DG Internal Market in order to discuss the position paper of *epi* on the Community patent submitted earlier this year. The Commission's representatives were particularly interested in a discussion about the time frame foreseen for the filing of the claim translations. The *epi* participants promised to forward a further, more detailed position paper, which has been sent in the meantime.

In June, the President represented the *epi* in Skopje, Macedonia to the local patent profession and to the representatives of the Macedonian Patent Office. Also in June, he presented a paper on the „Role of European Patent Attorneys in patent infringement proceedings“ at the FICPI Congress in Berlin. This paper which he had already presented elsewhere has been published in *epi* Information No. 3/2003.

The June Administrative Council (AC) meeting was attended by Vice-Presidents Macchetta and Mercer. This meeting was predominantly devoted to the election of a new president of the EPO, which however did not meet with success. A new election round will take place at the October AC meeting. An AC paper „Progress Report on Quality in Search and Examination“ was discussed and the *epi* offered support in ensuring quality was maintained. Vice-President Mercer also raised the problem of updating the Guidelines.

The proposed independence of the Boards of Appeal was also supported by the *epi*. A concrete proposal will be presented by the EPO to the next AC. The AC moreover elected a Board. The AC also discussed the following topics:

„PCT reform“: The EPO indication of a need for a consolidation/evaluation period after the changes that are being completed by the beginning of next year is shared by the *epi*.

„Harmonization of Patent Law“: The objective and the identification of a European perspective on substantive harmonization were supported by the *epi*. While sharing the list of „non-negotiable points“, *epi* continues to see accepting a „grace period“ as problematic and counter-productive. In addition to the already outlined criteria of restrictiveness and *quid pro quo* for the US adhering to

the first to file principle, also the criteria of international acceptance and simultaneous coming into force in the SPLT Contracting States should be considered as necessary. The fact that the harmonized European law constitutes „the best practice“ can be demonstrated and is already evident in considering criteria of „proportionality“ or „balance“ between a party exclusive rights and the third parties „public“ rights.

„European Industrial Property Academia“: *epi* shares the objectives indicated for the Academy, including developing, harmonizing and fostering the European dimension of IP professional training, offer common Europe-wide training opportunities and contribute to the process of harmonization of IP rights enforcement and litigation in Europe, and confirms its support to the initiative and its willingness to be among its concept developers and founding partners.

The President reported further that in June he lectured on the role and tasks of European patent attorneys before a class of non-European trainees at the EPO Vienna in the framework of the INPADOC Coordinations Programme. Also in June, the CEIPI Board meeting was convened by President Kober, where the President presented the programme of the CEIPI/*epi* Course on patent litigation in Europe.

Still in June, a meeting of the MSBA had been convened in Munich. The main topic of this meeting was the discussion of a paper presented on the „Organisational Autonomy of the Boards of Appeal“ which was supported by the *epi* members. Furthermore, a paper

entitled „Suficiency of Disclosure“, submitted by members of the *epi* Biotech Committee, and „Patentability of steps which per se are not diagnostic“ were discussed.

At the end of June the President was invited by the EPO International Academy and the Chamber of Commerce of Torino to attend a Symposium entitled „Managing IP-rights in a knowledge-based society“, where he presented a paper entitled „European patent attorneys as information brokers“. The following days a workshop was held at the Fondazione Agnelli where Vice-President Macchetta and the President also gave talks.

In July, the President followed an invitation of President Kober to attend the opening ceremony for the new EPO Liaison Office in Brussels, which will enable a stronger co-operation with the European Commission, a move strongly recommended by the *epi* for some time. President Kober and Commissioner Bolkestein gave opening speeches. The ceremony provided a good opportunity for discussion with the members of DG Internal Market about the Community patent/court system and with the management of the EPO. Following an invitation of the PECO the President presented the *epi* to the profession in Vilnius (Lithuania) and in Reykjavik (Iceland) at September/October seminars. He also talked at a Symposium in St. Petersburg organised by the Eurasian Patent Office and the EPO on the economic value of patents, and at the CNCPI „Rencontres“ in Paris on future court systems.

Treasurer's Report

P. Kelly (IE)

The Management Accounts to June 30 2003 have been compiled. The general trend indicates that income is ahead of budget due to a higher level of income from subscriptions – while expenditure is also ahead of budget due to higher meeting costs. The outcome for the year should not result in a deficit.

In relation to the budget 2003 one change is necessary. Item 5.9 PQC Project (€40,000) has been added to take account of Council's decision in Ghent to fund this project.

In preparing the budget 2004 the following factors were paramount namely

- (a) The annual subscription payable by members to *epi* would not be changed – the recommended subscription for 2004 is €150 if paid before May 1, 2004 and €175 if paid after May 1, 2004.
- (b) Potential subscription income from countries that might join EPC in 2004 has not been included.

- (c) Income from investments is perceived as static consequent upon low interest rates and income from educational activities is not considered as a financial net contributor.
- (d) Higher meetings costs are envisaged and a 9.6% increase is provided. In addition to an anticipated higher level of committee activity, a larger number of members attend both Board and Council meetings as the number of countries ratifying EPC increases.
- (e) Secretarial costs are maintained at current levels except for personnel costs, which are increased primarily to allow for the employment of an additional staff member.

The budget 2004 provides for a small surplus of € 14434.

At June 30, 2003 the financial assets of *epi* including securities and bank deposits amounted to € 2.2m.

Report of the Disciplinary Committee

G. Leherste (BE)
Chairman

The disciplinary committee had a meeting in Munich on the 10th of June 2003; 11 members from 9 countries participated in a discussion on a revision of the disciplinary regulations.

Subsequently the working group on the revision of the disciplinary regulations (consisting of Mrs. Dybdahl and G. Leherste) discussed a first draft proposal for revised rules, in a working session on 10.6.03, the principles of this draft proposal were circulated to the members of the committee.

Some aspects of the proposal raised serious objections.

The working group continues its work on a new draft improving those aspects, following a further working session on 30.9.03.

Since the previous report one new complaint was registered;

one complaint was withdrawn after the complainant obtained satisfaction, and two cases were decided by dismissing the complaint;

thus, two complaints are pending.

One request for an opinion on a matter of principle (received by *epi* in September 2002) is still waiting for an appropriate reply from the chairman of the committee; a request for an opinion received in June 2003 has been resolved through a telephone conversation between the chairman of the committee and the requestor.

Report of the EPO Finances Committee

J. Boff (GB)
Chairman

EPO's Fees Policy

The EPO will be increasing the PCT Search Fee from €945 to €1550 as of 1st January 2004. This increase represents a 64 % increase in fees and the effect on PCT Filing cost overall will be an increase in fees of ~33 %. The reason behind this increase is stated to be to pay for the additional work involved in producing an Expanded Search Report. Such an increase in the up-front cost of filing PCT applications is bound to influence applicant's choice of filing route, particularly as long as the European Search fee remains as €690.

For the high fees that are being asked we should expect prompt service. Accordingly a counter-proposal might be to reduce the fee by 50 % if the search report is mailed after the PCT time limit.

Further changes in fees are proposed, but not yet decided upon, to reflect the different pattern of work that faces the EPO in the near future. These include

Two-level filing fee:-

The EPO propose a reduced fee for electronic filing and an increased fee for paper filing. Given the large number of people who are extremely reluctant to consider online

filing, this change will probably mean a slight increase in EPO income for filing fees.

Increase in search fee:-

An increase in search fee to €900 has been proposed, but as the EPO have stated in their business plan that the EPO will not invest as much time in a PCT ISO as they will in a European EESR (approximately 10 % less time) a higher fee would appear more likely (if extremely unwelcome).

Progressive claims fees:-

An escalating scale of claims fees has been proposed such that there would be a scale of increasing per-claim fees, rising drastically (e.g. €400 per claim above 100) if there are more than 100 claims.

The same proposal has been made for the introduction of PCT claims fees.

It would seem inappropriate for such progressive claims fees, if paid at the International stage, to be also paid at the European regional phase.

This should encourage US applicants to file European style claims. (Some may even seek advice from European patent attorneys before filing their PCT applications).

Reduced examination fee:-

It has been proposed that if the applicant pays the examination fee on filing, this should be reduced from the current €1430 to €1000 with a partial refund on the fee if the application is withdrawn within 6 month of receipt of the search report. This seems a sensible idea. Any reduction in fees is welcome, particularly if it is unlikely to affect overall demand.

Reduced designation fees:-

Gradual phasing out of designation fees is contemplated, starting with a reduction in the designation fee. This is welcome.

These changes are unlikely to take place before 2005.

Conclusion

The EPO is concerned about fee income, particularly in view of the changes related to International Accounting Standards mentioned above.

Additionally, the major changes in EPC and PCT practice that are coming will lead to uncertainty in how demand will be affected. The prudent response of the EPO is to be cautious about the outcome.

There is however a risk that the unintended consequences of the change in PCT search fees, and the further proposed changes (particularly changes in up-front fees), will exceed the intended consequences.

Report of the European Patent Practice Committee (EPPC)

A. Casalonga (FR)
Chairman

The EPPC met on 18 June 2003 in Munich and studied the following items.

I. 34th SACEPO meeting of 19 February 2003 in Munich

The main point to be noted from this meeting is the proposal of the EPO relating to the introduction of an extended European search report.

II. SACEPO/PDI meeting of 13 March 2003 in Vienna and of the PDG IMPACT Meeting of 27-28 March 2003 in Paris

The EPPC was represented by its Vice-President Wim Hoogstraten. Indications have been received that the EPO was willing to make the „similarity finder“ software available to epi members if the project is successful.

III. 12th EUROTAB Meeting of 15-16 May 2003 in Berlin

The EPPC was represented by its Secretary Paul Denerley. This meeting discussed the following items:

- Supplementary protection certificate;
- Support of the claims by the description;
- Novelty requirements for selection inventions.

On the support of the claims by the description, the EPPC noted that the EPO is apparently applying more strict requirements. According to the present position of the EPO, the requirement of Article 84 EPC goes further than a mere formal correspondence between the claims and

the description. Article 84 should be understood to mean that all essential features of a claim must be supported in the description. Furthermore, the extent of the claims should be justified by the technical contribution to the art as expressed in the description.

The EPPC decided that this change should be monitored carefully in the future before considering any intervention at the EPO.

IV. PCT Reform Working Group Meeting of 19-23 May 2003 at WIPO in Geneva

The EPPC was represented by Leo Steenbeek.

The main points discussed during this meeting were:

- Increase of PCT-I fees;
- Restoration of priority rights;
- Common quality free work;
- Missing parts;
- Enhanced cooperation within the PCT countries;
- Tradition knowledge/genetic resources.

Concerning particularly the cooperation between PCT countries, the EPPC was of the opinion that the International Search Report should contain a complete written opinion of the Examiner particularly in the case such report is established by the EPO. There should be preferably no difference between the new enhanced European search report (EESR) and a future enhanced International search report (EISR).

V. Question 165 – Disclaimers

The *epi* Council had decided that the EPPC should prepare an *amicus curiae brief* to be sent to the Enlarged Board of Appeal in the presently pending cases G1/03 and G2/03 concerning the acceptability of disclaimers. The EPPC discussed the issue extensively and made the following main points:

- the decision of whether a disclaimer should be accepted or not should not be based anymore on the concept of „accidental disclosure“;
- disclaimers should only be accepted in the case of a novelty destroying prior art, no difference being made between Article 54(2) and 54(3);
- the possibility of using disclaimers should in any case be maintained however with strict conditions;
- disclaimers should be allowable with the same conditions in all technical fields and not only in the chemical field;
- the main criterion which should be applied to decide the acceptability of a disclaimer should be that no new matter is added to the invention.

A small group of EPPC members was appointed to prepare a draft of *amicus curiae brief*. This draft was prepared after a meeting held in Paris on 9 July 2003. The draft was further distributed by e-mail among EPPC members and a final paper was prepared taking into consideration the remarks made by the EPPC members.

The final document was sent to the Enlarged Board of Appeal.

VI. Question 160 – New proposal of a Community Patent

The proposal for a Council Regulation on the Community Patent dated June 11, 2003 was discussed at the EPPC meeting.

Concerning the transitory provisions, a majority of the EPPC was in favour of the possibility to obtain a Community Patent for EP applications filed before entry into force of the Community Patent Regulation and designating all Member States of the European Union.

The EPPC favoured the possibility of obtaining a Supplementary protection certificate on the basis of a Community Patent.

The EPPC considered that the question of the date up to which an Applicant can freely choose between a Community Patent and a European Patent is linked to the question of the so-called „mutualization of costs“ for the translation of an application filed in one language of the European Union which is not one of the three official languages of the EPO.

After a lengthy discussion, the majority of the EPPC was in favour to leave a free option to applicants having designated all Member States of the Community to choose between a European patent or a Community patent until the patent is granted.

The wording of the Article 24(c) of the proposal relating to the legal effect of the compulsory translations of the Community patent claims in all the languages of the European Union was further discussed.

The majority of the EPPC was in favour of linking the legal effect of translations with the possibility to obtain damages. In such a way, according to the EPPC, the unitary character of the Community patent would be maintained and the interests of third parties safeguarded.

A draft *epi* position paper commenting the proposal for a Community Patent Regulation was prepared taking into consideration the remarks of the EPPC members. This paper was sent to the *epi* Board which requested some further amendments.

The final *epi* position paper, after amendment (Annex 1), was sent to the EPO and to the EU Commission.

Annex 1

13 May 2003

epi preliminary position on the main features of the Community Patent

Following the decision taken on March 3, 2003 by the EU Competitiveness Council on a common political approach regarding the main principles and features of the Community Patent, the *epi* would like to make the following remarks.

1. The *epi* notes the introduction of a Community Patent and welcomes the fact that it will be examined and granted by the European Patent Office, according to the EPC.
2. The *epi* approves of the creation of a centralised jurisdiction for the Community Patent which would therefore be capable of issuing high quality decisions according to a uniform procedure and dealing

with both infringement and the validity of the patent.

I – The jurisdictional system

3. The *epi* approves of the creation of a unitary Court for the Community Patent having exclusive jurisdiction for all actions relating to the Community Patent and particularly that invalidity and infringement proceedings will be heard together.
4. The *epi* notes the creation of the judicial panel Community Patent Court (CPC) having its seat at the Court of first instance (CFI) and welcomes the

fact that the Community Patent Court may hold hearings in any Member State as long as the Rules of procedure and the judges are determined centrally so as to guarantee the necessary harmonisation of decisions and legal certainty.

5. Concerning the appointment of the judges, the *epi* would like to stress that the increasing complexity and technicality of inventions frequently requires a high technical expertise of the Judges. Consequently, in order to guarantee the quality of legal decisions, the *epi* considers it necessary that at least one of the three judges sitting in each Chamber of the CPC would have a technical background. The introduction of technical experts assisting the judges throughout the handling of the case, but not participating in the decisions, does not appear sufficient to arrive at the desired result.
6. The *epi* would like to stress in this connection that the Boards of Appeal of the EPO generally comprise two technically trained members and one legally trained member, and will continue to issue decisions concerning the validity of Community Patents within the framework of the opposition procedure before the EPO. It would therefore be advisable that the Community Patent Court, which will also decide on the validity of Community Patents should have a similar approach to technical questions.
7. Concerning the language of the procedure, the *epi* considers that account should be taken of the essential principle of the right for the parties involved to be heard. No party domiciled in a Member State should be put in a position where its arguments cannot be clearly and completely presented, either in writing or orally. Similarly, the Court should also be able to understand the arguments of the parties fully, even if this necessitates the filing of translations of written documents or interpretation of oral statements. The costs involved in providing any translation or simultaneous interpretation should be borne by the Court, except if the circumstances are such that it would be more appropriate that they be borne by the losing party. The court should have the responsibility for ruling on this matter.
8. The proposal that the Community Patent Court should conduct the proceedings in the official language of the Member State where the defendant is domiciled or in any official EU language, could in practice create difficulties since the Community Patent will in any event be granted in one of the three languages of the EPO. The *epi* would like to stress that discussion of validity and infringement of a patent is easier in the language of the granted patent than in any other language.
9. The *epi* is therefore of the opinion that if the defendant is not domiciled in a Member State of the European Union, then the language of the proceedings should be the language of the granted patent.

II – Languages and costs for the Community Patent

10. The *epi* notes that the Community Patent will be granted in one of the three languages of the EPO and that only the claims of the patent will have to be translated in the official languages of the Member States within a reasonable time period from the grant of the patent, which was considered by one delegation to be two years.
11. The *epi* welcomes the possibility now proposed of converting the Community Patent into a European Patent designating all Member States before expiry of the same reasonable time period.
12. The *epi* further notes that the Commission has been invited to carry out a study into the possibility of saving costs, including in respect of services rendered by patent agents. While the *epi* is keen to reduce unnecessary costs each time it is possible, it would like to stress that the provision of quality professional work by European patent attorneys is essential for the protection of innovation in Europe. It should be remembered too that European patent attorneys operate in a free market for professional services and any regulation could interfere with that free market.
13. Further savings in costs for patent protection should therefore take this situation into account and should also consider the opportunity of decreasing the level of fees for renewing patent each year. The level and periodicity of renewal fees is lower in many countries of the world compared to some European countries.

The fact that an important part of the renewal fees for Community Patents is transferred to National Patent Offices which do not contribute to the granting of Community Patents leads in practice to the creation of a special tax on innovation.

III – Role of National Patent Offices

14. The *epi* notes with satisfaction that the EPO alone will be responsible for examining and granting the Community Patent.
15. If search work is carried out by some National Patent Offices of Member States, it will be essential, according to the *epi*, that strict quality control be exerted by the EPO so as to avoid discrepancies between searches used to examine the patent. National Patent Offices carrying out searches on behalf of the EPO should meet all objective quality requirements laid down in Rule 36 PCT.
16. In view of the fact that „Community Patent applications“ will not exist, there will only be „European patent applications“ designating the Community with other EPC Member States, the *epi* does not clearly understand whether and how National Patent Offices of the EU Member States could be involved in searches for European patent applications. Clearly, the decision by the EU Competitive-

ness Council should not affect the way in which European Patents to be granted for non-EU States are examined.

17. Further, the *epi* does not see how this could be compatible with the future organisation of the EPO where the same Examiner carries out search and examination under the BEST programme.

Report of the Harmonisation Committee

F. Leyder (BE)
Chairman

The Harmonisation Committee follows the work of the Standing Committee on the Law of Patents in the framework of WIPO. All WIPO documents relating to the Standing Committee on the Law of Patents are available on the WIPO website via the link <http://www.OMPI.int/scp/en/>

The 9th session was held in Geneva from 12 to 16 May 2003; John Brown and Klas Norin represented *epi*. A draft report of the meeting prepared by WIPO is available.

The 10th session is planned for the week of 10 to 14 May 2004. Draft documents, namely a draft Substantive Patent Law Treaty and draft Regulations under the same, have been posted on the WIPO website and can be downloaded via the link http://www.wipo.int/scp/en/documents/session_10/index.htm. The Harmonisation Committee will meet in due time to instruct the *epi* delegates who will be nominated. Comments by *epi* members are welcome.

The Harmonization Committee has represented *epi* at a meeting of the Committee on Patent Law on 29-30 April, the main points on the agenda being related to the position to adopt with regard to the draft SPLT. Our delegates were John Brown and the undersigned. As a follow-up, the EPO issued a document CA 62/03 „Harmonization of Patent Law -SPLT“ which was presented orally at the Council meeting in Cannes. In particular, it was mentioned that users should be consulted on three aspects:

- (i) the proportionality of claims: the issue is that, in addition to the existing mechanisms under the EPC to determine whether the claims are commensurate with the disclosure, US law provides an additional test, namely that the applicant must not claim subject matter that he had not recognised and described on the filing date. This test is unknown in Europe, but it could be argued to constitute „best practice“. The Council expressed support for the present European practice.
- (ii) the prior art effect of PCT applications in the international phase: the Harmonisation Committee has long been of the opinion that in the context of worldwide harmonisation (and only in that context) it would be advantageous for applicants to obtain prior art effect from a published PCT application without having to enter any national phase (thus saving national fees). UNICE has presented the same position during the meeting. At the suggestion of the President, the Council requested the Harmonisation Committee to prepare a position paper and submit it to the Board as well as to EPPC and the Biotechnology Committee.
- (iii) the prior art of earlier applications for inventive step: the Council confirmed its preference for the EPC option, namely that earlier applications have no prior art effect for inventive step.

Report of the Online Communications Committee (OCC) (covering May – October 2003)

D.K. Speiser (DE)
Chairman

Following the last meeting of the Council of our institute in May 2003 the Online Communications Committee published on the web site of the *epi* ([www.patent-](http://www.patent-epi.com)

[epi.com](http://www.patent-epi.com)) the announcement regarding the EPO online filing system which announcement had been approved by Council and conveyed the message to the *epi* mem-

bership that by now enough confidence has been built up in the present online filing system of the EPO to allow the OCC to recommend the use of the system.

The Online Communications Committee continued to exchange information and views among Committee members but additionally with *epi* members in general and the European Patent Office. This was mainly done by e-mail or telephone but a meeting became desirable between the Committee and the European Patent Office which meeting took place on 6 October 2003 in Berlin.

About three months earlier the EPO had made available to the applicants a new version 2.0 of the eOLF (electronic on-line filing) software which version allows not only to file European patent applications and Euro-PCT applications online but now also allows to file PCT applications with the EPO as receiving office.

The presently available software is a stand-alone version and therefore has to be installed individually on each PC which is intended for online filing. A LAN-version of the software will become available shortly.

Trust in the online filing system is spreading as becomes apparent from recent filing figures. According to the EPO 13 % of EP applications and 6 % of Euro-PCT applications are filed online. Since the availability of PCT online filings a few months ago about 1 % of the PCT applications were filed using the eOLF software.

In the view of the Committee motivating further applicants to file their applications online will require a further improved user interface of the software and a perfectly functioning two way electronic interface between the eOLF software and the patent management systems (PMS) of the users. The OCC explained that once a user has entered all necessary data for an application into his own PMS and has provided in his system the description, claims, drawings, and abstract for the intended application it should be possible for the user to file the application online with just a few clicks; the OCC coined the term „one click application“ knowing that to achieve this goal the PMS developers have to do some work but also knowing that the eOLF software of the EPO must comply and be made ready for such a streamlined process. The EPO is working on these points and intends to role out a completely new version 3.0 of the eOLF-software by mid 2004 which is said to become much more user-friendly than the current version and hopefully will allow a higher degree of automation on the side of the applicants.

Also, the EPO will present to the Administrative Council of the European Patent Organisation later this year a proposal for a fee reduction for user of the system. The *epi* had proposed such reduction since its first involvement in the preparations for online filing as early as about 1985. The proposal of an incentive was based not only on the consideration that online filing will save the EPO a substantial amount of money. More importantly, an incentive in the view of the *epi* would provide users with some kind of compensation for the burden of changing their established routines to a completely new system as well as for the need to build up new experiences from scratch.

The Japanese Patent Office introduced online filing at the end of the 80s and attracted users with a reduced filing fee. WIPO did the same for applicants filing PCT applications on floppy discs. The EPO now decided to adopt the practice of the JPO and WIPO. At the forthcoming meeting of the Administrative Council the EPO will propose to reduce as of 1 July 2004 the present filing fee of EUR 125 to EUR 75 for electronic filing and to increase the present filing fee to EUR 175 for paper filings.

In this context it is to be mentioned that WIPO will also change its fee system. Presently applicants of PCT applications sending in a floppy disc get a reduction of the filing of SFR 100. As of 1 January 2004 PCT applications filed electronically and submitting documents in the PDF-format will receive a reduction of SFR 200 while applicants electronically submitting the documents in the new XML-format will get a fee reduction of as much as SFR 300.

In the past a substantial part of the work of the Online Communications Committee was dedicated to recognizing and avoiding disclosure problems in electronically filed applications which problems originated from errors made by conversion software. Those earlier problems have been overcome and the Committee now looks forward to testing the forthcoming XML-format of documents which format is said to be less error prone. For reasons too technical to be explained in this report this new XML-format will have substantial benefits in the processing of documents filed online and in the processing by the applicants patent management systems of documents received from the EPO. For these reasons the new XML-format was selected by WIPO as the standard format for documents used in online filing and online communication.

At the recent meeting with the EPO the OCC addressed a problem related to the on-line Register of the European Patent Office after having received information from members that there are instances where the on-line Register seems to be incorrect. The EPO explained that the on-line Register is an exact copy of the data which is available inside the office to its offices and Examiners and is updated every night so that information entered on one day is available for the public on the next day. It seems, therefore, that deferred updates of the on-line Register are mainly due to backlogs of the formalities officers or due to internal procedures which for legal reasons prevent an immediate entry into the Register.

Also, at the recent meeting the OCC thanked the EPO for the fine work of the *epoline*[®] key account managers. As anticipated the setting up by the EPO of a system of key account managers (see OCC report in *epi* Information 2003, p.49) has substantially improved communication between the office and the users and has helped to overcome problems much more rapidly than before.

Finally, it will interest our members that the EPO reported progresses with the incorporation into the eOLF software of so called plug-ins which will allow users to

use the EPO software not only for EP and PCT filings but also for national filings. The first of those plug-ins apparently will be for electronically filing German national patent applications with other countries to follow shortly. It is even envisaged to provide plug-ins for filing national trademark and utility model applications. In this

way the serious concern of all interested circles worldwide about the need to install and update dozens of different makes of online filing software for the various kinds of filings is overcome together with the even greater concern regarding the respective training of the staff of the users. Good news indeed.

Report of the Professional Qualification Committee (PQC)

T. Onn (SE)
Chairman

1. Students of the epi

Today we have 373 students from 15 countries. 64 of these have registered in 2002.

2. epi Tutorials

Due to a shortage of tutors we only organized one tutorial last year. This year we are back with summer and autumn tutorials.

In the summer tutorials the candidates have been offered to write papers A and B of 2001 and 2002. Their answers will be commented by a tutor. There are 66 candidates (from 10 countries) who are doing 248 papers and 24 tutors (from 8 countries) will comment the answers.

The last date to enrol for the autumn tutorial was 10 October 2003 and 73 candidates have enrolled to write papers C and D of 2001 and 2002. They will do 255 papers and we have only 14 tutors to comment the answers. We still have 33 German candidates to whom there are no tutors. I therefore urge you to help us recruiting German speaking tutors so that we can take care of all candidates.

3. Tutors' meeting

On 13 November 2003 the annual tutors' meeting will be held at the epi premises in Munich. The tutors of epi have been invited together with the chairmen/secretaries from Examination committees I, II and III and some tutors from CEIPI.

We hope that also this year the Examination Secretariat will send us the Examiners' Report as well as the statistics of the EQE 2003 in good time before the meeting. This will enable us to distribute the Examiners' report to our tutors well in time before the Tutors' meeting.

4. Continuing Professional Education (CPE)

The fifth CPE seminar was held in Eindhoven on 9 September 2003. The topic was *PCT* and Mr. Patrick Genin from WIPO was the speaker. As the costs for arranging this seminar were not as large as those for arranging the seminars on Oral Proceeding we lowered the fee for participation to €150. There were 48 persons attending the seminar which gave a modest positive financial result.

Thus all CPE seminars so far have shown positive financial results.

Portugal has now announced its interest to organize a CPE seminar on *PCT* next year. Ireland is considering the possibility of organizing a seminar on the topic *Oral proceedings at the EPO* next spring.

5. EQE

The EQE 2003 took place on 26-28 March. It was unfortunately a very low total passing rate, and of the first sitters less than 30 % passed.

The EQE 2004 will take place on 24-26 March and the last date to enrol is 31 October 2003.

6. Changes in the Examination Secretariat

Ms. Dybdahl has left the Examination Secretariat for other responsibilities of more legal character. Mr. Machwirth has taken over as the person responsible for the Secretariat. The Secretariat will be under the supervision of Mr. Yung. Ms. Dybdahl has informed that she will remain member of the Examination Board.

After our last PQC meeting Mrs. Leissler-Gerstl and myself had a meeting with Mr. Yung and Machwirth and discussed about the cooperation between the PQC and the Secretariat. This was just a first meeting to find out the routines we had followed and what could be improved.

7. Modernizing and streamlining the EQE

The Board has asked PQC to look into this matter. To accomplish this we have set up a working group (WG) consisting of Susanne Kaminski and Gabriele Leissler-Gerstl. They have contacted Professor Herrmann from the University of Ulm who is helping us to carry out this survey.

The background for the project of „Modernizing and Streamlining the EQE“ is the permanent low passing rate of the candidates sitting the EQE which worries *inter alia* epi and particularly PQC, but also the Examination Secretariat and the Examination Board of the EPO.

We need more information on the reasons for the continuing poor results and how to improve the passing rate. It was decided to ask someone to carry out a survey of the situation (overall and in the various member countries). This should be a person having an external view and being „professional“ in the field of pedagogics. This approach was kindly approved by the epi Council in Ghent. Therefore, Prof. Herrmann a specialist for evaluation of academic courses was asked to help us.

In a first meeting between the WG members and Prof. Herrmann the basic facts and questions were discussed. It was concluded that in a first step the training situation should be analyzed and this analysis should be accomplished by sending a questionnaire to all epi members.

It is important to mention that this survey is *not* an evaluation of the training work done by the patent attorneys or the patent departments but an analysis of the present state in the member states.

After thorough discussions in two PQC meetings and in close cooperation with Prof. Herrmann a questionnaire has been established and will be finished in the in the near future. It will be sent to all epi members with an e-mail address. The key questions in this questionnaire refer to those fields deemed to be important for the analysis of and proposals for the modernizing and

streamlining of EQE.

The questionnaire will be sent out within shortly from an institute working with the University of Ulm and the answers will be anonymous. A preliminary evaluation of the results can be expected relatively soon after the deadline for answering.

The next step of this project will be an analysis of the results obtained and a number of interviews with persons of the groups involved, i. e. candidates, employers, members of the examination committees. Based on the results both of the questionnaire and the interviews, proposals will be drawn up for improving the training and examination situation.

It will be essential that as many epi members as possible will answer the questionnaire to get statistical confident results. Therefore I ask all council members to encourage the epi members in your home country to answer and send back the questionnaire within the time limit given.

As mentioned by our President the EPO is planning to start a „European IP Academy“ which shall provide training for candidates and European patent attorneys on the list. It will be of utmost importance to be involved in the development of such an institution and it seems to be necessary to have a well-founded opinion based on the analysis of this survey by professor Herrmann. The project outlined has thus become even more importance by this fact.

To accomplish this there is a need for an extra PQC meeting next year. It is my hope that the Council will approve of this so that we can finish the survey and have a well-founded basis for our future discussions with EPO.

The Council is invited to take note of the content of this report and is kindly asked to approve an extra PQC meeting in 2004.

Nächster Redaktions- schluss für epi Information	Next deadline for epi Information	Prochaine limite pour epi Information
Redaktionsschluss für die nächste Ausgabe der epi Information ist der 13. Februar 2004 . Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.	Our deadline for the next issue of epi Information is 13 February 2004 . Documents for publication should have reached the Secretariat by this date.	La date limite de remise des documents pour le prochain numéro de epi Information est le 13 février 2004 . Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

RESULTS OF THE EUROPEAN QUALIFYING EXAMINATION 2003

FIRST SITTING – Examination in full and modular sitting

Nationality	Candidates (in total)	PASSED				FAILED			
		Total	%	Examination in full	modular sitting (2modules)	Total	%	Examination in full	modular sitting (2modules)
AT	15	4	26,7	2	2	11	73,3	7	4
BE	11	2	18,2	1	1	9	81,8	8	1
CA	2	1	50,0	1	0	1	50,0	1	0
CH	9	4	44,4	3	1	5	55,6	5	0
DE	224	76	33,9	61	15	148	66,1	118	30
DK	12	2	16,7	1	1	10	83,3	8	2
ES	5	2	40,0	2	0	3	60,0	3	0
FI	10	0	0,0	0	0	10	100,0	7	3
FR	73	24	32,9	16	8	49	67,1	35	14
GB	90	39	43,3	35	4	51	56,7	44	7
GR	1	1	100,0	1	0	0	0,0	0	0
IE	7	2	28,6	0	2	5	71,4	3	2
IT	34	8	23,5	5	3	26	76,5	11	15
NL	15	6	40,0	3	3	9	60,0	6	3
NO	1	0	0,0	0	0	1	100,0	0	1
PT	2	1	50,0	0	1	1	50,0	1	0
SE	32	9	28,1	5	4	23	71,9	16	7
US	3	0	0,0	0	0	3	100,0	3	0
ZA	1	0	0,0	0	0	1	100,0	1	0
TOTAL	547	161	29,4 %	118	43	386	70,6 %	295	91

RESITTING -Examination in full
Total number of candidates: 37
Passed: 0 (0 %); Failed: 37 (100 %)

RESITTING – Examination in part
Total number of candidates: 639
Passed: 185 (29,0 %); Failed: 454 (71,0 %)

More epi tutors wanted

The *epi* tutorials are a most important part of the preparations for the EQE. Here candidates get the possibility to write old examination papers and have their answers commented on by an *epi* tutor.

The *epi* tutorials offer the candidates to write some or all EQE papers from two previous years. This has become more and more popular and there is an increasing need for more tutors. Therefore we ask you to volunteer as an *epi* tutor.

Being a tutor certainly implies some work, but it also is rewarding. It gives you an opportunity to help younger colleagues and at the same time keep up with the

development. Thus it can be seen as a kind of continuing professional development.

The number of candidates varies from year to year. Some years there is a need for many tutors whereas it is less some other years. Our aim is to build up a staff of tutors (the larger the better) to be able to match the needs of the candidates. Features that are important to match are „Technical field“; „Language“; „Geographical vicinity“.

Please volunteer by sending in the enrolment form printed hereafter to the *epi* Secretariat:

The Professional Qualification Committee

Tutors for epi Tutorials

I enrol to be on the list of tutors for the *epi* tutorials and understand that my services may not be needed every year.

Technical field: Electricity/Mechanics ☐ Chemistry ☐

Language: English ☐ German ☐ French ☐

I am ready to make comments to the following papers

A ☐

B ☐

C ☐

D ☐

Name:

Address:

.....

.....

Phone:

Fax:

e-mail:

.....
Signature

Please return to *epi* Secretariat
P.O. Box 26 01 12
D-80058 MÜNCHEN Germany
Tel: +49 89 201 70 80
Fax: +49 89 202 15 48
e-mail: info@patentepi.com



*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*

epi - Postfach 26 01 12 • 80058 München • Deutschland

5 January 2004

RECHNUNG
epi-Beitrag 2004

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epi Subscription 2004

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EUR 150

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Bitte nutzen Sie die Einzugsmöglichkeit vom laufenden EPA-Konto, s. beiliegendes Formular zur Einzugsermächtigung, das bis zum 15. Februar 2004 an das epi zurückgeschickt werden muss.

Please use the possibility for direct debiting from EPO deposit accounts, see enclosed direct debit mandate form which must be returned to epi by February 15, 2004.

Nous recommandons le prélèvement sur le compte courant à l'OEB, voir autorisation de prélèvement annexée, à retourner à l'epi avant le 15 février 2004.

Banküberweisungen (Euroschecks sowie alle deutschen Schecks werden akzeptiert) sind zu tätigen **in EUR**.

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Bei Zahlungseingang nach dem **30. April 2004** ist der Beitrag **EUR 175**.

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 EPU. 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
Peter Kelly

Subscription payments made after **30 April 2004** must be in the amount of **EUR 175**.

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 re-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
Peter Kelly

La cotisation est de **EUR 175** si le paiement est effectué après le **30 avril 2004**.

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
Peter Kelly

Payment of *epi* subscriptions

P. Kelly,
Treasurer

The Secretariat needs your co-operation in relation to the payment of *epi* subscriptions. In order to minimise the workload in processing accurately and efficiently subscription payments it is very important that each payment can be clearly identified with a specific member. At present we have each year a significant number of payments (30 %) made to the *epi* in respect of subscriptions where the payment does not identify the member and/or his/her firm or company. Obviously such unidentifiable payments subsequently cause considerable problems for our staff and in many instances in unnecessary protracted correspondence with, often irate, *epi* members.

It will be appreciated that the additional work load in sorting out these problem payments is very time consuming. On behalf of the Secretariat I therefore request

your help and ask that all members personally ensure that their subscription payment – whether by EPO deposit account (before February 15), bank transfer, bank draft or euro cheque – gives as a basic level of information **your name and membership number**. For example when instructing a bank transfer payment please inform your bank that your name and membership number must be shown on the transfer advise sent to the *epi*.

If your firm or company is making a single payment to pay the subscriptions of a number of members please ensure that the name and membership number of each *epi* member covered by this single payment is given on a list accompanying the payment.

I thank you on behalf of the Secretariat in anticipation of your understanding and co-operation.

Bitte einreichen an / Please return to / retournez s.v.p. à:

epi-Sekretariat
Postfach 26 01 12
D-80058 München

Telefax +49 89 202 15 48

Einzugsermächtigung

**Eingangsfrist im
epi-Sekretariat:**

15. Februar

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

Bitte verwenden Sie **nur dieses Formular**, gegebenenfalls mit einem gesonderten Blatt für die Namen mehrerer **epi**-Mitglieder. Wenn die Liste der **epi**-Mitglieder sich seit letztem Jahr geändert hat, schicken Sie bitte eine neue Einzugsermächtigung.

Direct debiting mandate

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

15 February

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

Please use only this form, if necessary with a separate sheet for the names of several **epi** members. If the list of **epi** members has changed since last year please send a new mandate.

Autorisation de prélèvement

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

15 février

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

N'utilisez que ce formulaire; ajoutez si nécessaire sur une feuille séparée les noms de plusieurs membres de l'**epi**. Si la liste des membres de l'**epi** a été modifiée depuis l'année dernière, envoyez s.v.p. une nouvelle 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 Einzugsermächtigung gilt für mehrere epi-Mitglieder Falls "ja", bitte ein gesondertes Blatt mit den Namen und Mitgliedsnummern beifügen.	
This direct debiting mandate applies to more than one epi member If "yes", please list names and membership numbers on a separate sheet.	nein ja ☐ no ☐ yes non oui
L'autorisation de prélèvement s'applique à plusieurs membres de l'epi : Dans l'affirmative, prière de joindre au présent formulaire une feuille séparée portant le nom et le numéro de ces membres.	
Name des Kontoinhabers : 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 unten angegebene *epi*-Mitglied in der jeweils gültigen Höhe von dem nachstehend genannten und beim Europäischen Patentamt (EPA) geführten laufenden Konto einzuziehen. Die Einzugsermächtigung gilt für den nächstfälligen und künftig fällige Beiträge bis auf schriftlichen Widerruf. Sie gilt ebenso für offene Beiträge vergangener Jahre. Der Einzug erfolgt auf der Grundlage der zwischen dem EPA und dem *epi* getroffenen Verwaltungsvereinbarung vom 5. April 1993 (ABl. EPA 1993, 367) und der Nr. 9 der Vorschriften über das laufende Konto (ABl. EPA 1993, 366).

Der Einzug des Beitrags erfolgt mit Wirkung vom 25. Februar des laufenden Jahres. Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen gehen dem Einzug des *epi*-Beitrags vor. Mehrere Beiträge, die vom selben Konto abgebucht werden sollen, faßt das *epi* zu einem Gesamtbetrag zusammen. Demgemäß erteilt das *epi* dem EPA einen 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 Einzugversuch informiert. Überweist es den Beitrag dann nicht bis spätestens 30. April (Kontoeingang) für das *epi* spesenfrei im normalen Bankverkehr, erfolgt ein Einzugversuch 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 beigelegt wird, braucht es nicht gesondert unterschrieben zu werden.

Direct debiting mandate

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

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

Subscriptions are debited with effect from 25 February of each year. All fees and costs payable to the EPO on the debiting date have priority over the *epi* subscription. The *epi* will combine several subscriptions to be debited from the same account into one overall sum, for which it will then issue the EPO with a debit order. If, after priority payment of EPO fees and costs, the credit balance is not

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

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

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

Autorisation de prélèvement

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

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

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

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

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

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

Regeln für die Zahlung der epi-Mitgliedsbeiträge

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

- 1) Der jährliche *epi* Mitgliedsbeitrag ist innerhalb von zwei Monaten nach Fälligkeit zu zahlen und zwar vor dem 1. März.
- 2) Für Mitglieder, die bereits zu Anfang eines Jahres in die Liste der zugelassenen Vertreter eingeschrieben sind, ist das Fälligkeitsdatum der 1. Januar.
- 3) Für Mitglieder, die erst im Verlauf eines Jahres in die Liste der zugelassenen Vertreter aufgenommen werden, ist das Fälligkeitsdatum der Tag der Eintragung in die Liste.
- 4) Der jährliche Mitgliedsbeitrag wird erlassen, wenn
 - der schriftliche Antrag des Mitgliedes auf Löschung von der Liste der zugelassenen Vertreter vor dem 1. April beim Europäischen Patentamt eingeht;
 - eine Person nach dem 30. September in die Liste der zugelassenen Vertreter aufgenommen wird.
- 5) In allen anderen Fällen muß der volle jährliche Mitgliedsbeitrag bezahlt werden. Ratenzahlungen, Stundungen oder Beitragsreduzierungen können nicht gewährt werden.
- 6) Zahlt ein Mitglied, das bereits zu Anfang des Jahres auf der Liste der zugelassenen Vertreter stand, seinen Beitrag nicht vor dem 1. Mai (Eingang auf dem *epi* Konto), ist sein Beitrag EUR 175,-. Gleiches gilt für Mitglieder, die erst im Verlauf des Jahres in die Liste der zugelassenen Vertreter aufgenommen worden sind, falls sie ihren Mitgliedsbeitrag nicht innerhalb von vier Monaten nachdem sie durch „epi-Information“ oder einen Brief über seine Höhe informiert worden sind, zahlen.
- 7) Zahlungen müssen mittels Banküberweisungen, in Euros und frei von Bankspesen für *epi* erfolgen. Dabei sind der Name und die Mitgliedsnummer

jedes einzelnen Mitglieds, für das die Zahlung erfolgt, anzugeben.

- 8) Wegen der beachtlichen Bankgebühren und darüber hinaus wegen des 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-In-

formation“ erhalten haben, müssen Zahlungsvorgehens innerhalb der oben genannten Zeitspanne treffen, ohne daß eine zusätzliche Aufforderung hierzu erfolgt. der Schatzmeister wird jedoch zu Beginn eines Jahres bzw. bei neuen Mitgliedern nach Eintragung in die Liste zusätzlich Rechnungen an alle Mitglieder verschicken. Verspätete Zahler, von denen angenommen werden kann, daß sie die oben genannte „epi-Information“ erhalten haben, können sich aber nicht darauf berufen, diese Rechnung nicht erhalten zu haben.

Rules Governing Payment of the epi Annual Membership Fee

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

- 1) The *epi* annual membership fee has to be paid within two months after its due date, namely before March 1st.
- 2) The due date for members being on the list of professional representatives at the beginning of the year is 1 January.
- 3) The due date for members entering the list of professional representatives in the course of the year is the moment of entry on this list.
- 4) The annual membership fee is waived if
 - a member's written demand for deletion from the list of professional representatives arrives at the European Patent Office prior to 1 April;
 - a person is registered on the list of professional representatives after 30 September.
- 5) In all other cases the entire annual membership fee has to be paid. No instalments, extensions of the term of payment, or reduction of payment may be granted.
- 6) Members on the list of professional representatives on 1 January who fail to pay their membership fee prior to 1 May (reception on *epi* account) will have to pay a subscription of EUR 175. The same applies to members who entered the list during the course of the year if they have not paid the fee within four months after being notified of its amount through „epi Information“ or by letter.
- 7) Payments have to be made by money transfers, in 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 et 12 mai 1992

- 1) Le paiement de la cotisation annuelle *epi* est dû dans les deux mois qui suivent la date d'exigibilité, c.à.d. avant le 1^{er} mars.
- 2) La date d'exigibilité pour les personnes inscrites sur la liste des mandataires agréés au début de l'année est le 1^{er} janvier.

- 3) La date d'exigibilité pour les personnes admises sur la liste des mandataires agréés en cours d'année est la date d'admission sur cette liste.
- 4) N'est pas redevable de la cotisation de l'année en cours:
 - un membre qui demande par écrit à l'OEB sa radiation de la liste des mandataires agréés avant le 1er avril;
 - toute personne inscrite sur la liste des mandataires agréés après le 30 septembre.
- 5) La cotisation annuelle doit être payée dans son intégralité dans tous les autres cas. Aucun versement partiel, report d'échéance ou réduction du montant ne peut être accepté.
- 6) Toute personne inscrite sur la liste des mandataires agréés au 1er janvier et dont la cotisation n'est pas payée avant le 1er mai (date de réception sur le compte de l'*epi*) doit payer une cotisation de 175 EUR. Ceci s'applique également à toutes les personnes inscrites sur la liste en cours d'année, dont la cotisation n'est pas réglée dans les quatre mois qui suivent la notification dans „epi Information“ ou par lettre.
- 7) Le paiement doit être fait par virement, en 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 aussi un appel de cotisation à tous les membres au début de l'année, de même qu'aux nouveaux membres après leur inscription. Toute personne recevant en tant que membre „epi Information“, mentionné plus haut, et n'ayant pas payé sa cotisation à temps ne pourra pas alléguer qu'elle n'a pas reçu l'appel de cotisation.

epi-Mitgliedschaft und Jahresbeitrag

1. Internationale Kammerorganisation

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

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

2. Mitgliedschaft

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

Nach einer Streichung aus der Vertreterliste kann jederzeit ein Antrag auf Wiedereintragung in die Liste gestellt werden. Es dürfen jedoch keine gegenteiligen

disziplinarischen Maßnahmen vorliegen. Eventuell in früheren Zeiten nicht entrichtete Mitgliedsbeiträge müssen zuvor nachentrichtet werden. Bei einer Wiedereintragung in die Vertreterliste braucht keine Eignungsprüfung abgelegt zu werden.

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

3. Jahresbeitrag

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

Verschiedentlich ist der Wunsch nach Aus- oder Herabsetzung dieses Beitrages von z.Z. EUR 150,- geäußert worden. Diese Frage hat mehrfach den *epi*-Rat und Vorstand beschäftigt. U.a. angesichts der vergleichsweise geringen Höhe des Beitrages wurde eine Aus- oder Herabsetzung abgelehnt. Damit gilt, daß der Mitgliedsbeitrag für das laufende Jahr nur entfällt, wenn

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

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

Bitte beachten Sie, daß der Vorstand und Rat des *epi* bei allen Entscheidungen zu beachten haben, daß es sich bei dem *epi* nicht um eine nationale Einrichtung handelt, sondern daß 27 Staaten am Patentübereinkommen beteiligt sind.

epi membership and membership subscription

1. Professional Association

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

epi is an international public law corporation.

2. Membership

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

After having been deleted from the list, a member may at any time file an application for reinstatement. There must, however, be no contradicting disciplinary measures. Outstanding membership subscriptions have to be paid before reinstatement. There is no need to pass the European Qualifying Examination again for being reinstated.

epi has only one membership status, no associate membership or the like. Persons who do not want to

pay their annual subscription for one or more years need a deletion from the list of professional representatives before 1 April of the current year. They may apply for reinstatement later on. Application for reinstatement has to be sent to the EPO, Directorate 5.1.1.

3. Membership subscription

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

Occasionally, requests have been made for suspension or reduction of the membership subscription, currently amounting to 150 EUR. The *epi* Council and Board have considered this question many times and have decided that the membership subscription may neither be suspended nor reduced. One of the reasons for this decision is the already low amount of the membership subscription. It is waived if

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

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

Please keep in mind that the *epi* Board and Council have to take into consideration that all decisions they take concern an international organization involving 27 Contracting States to the European Patent Convention and not only one single country.

Affiliation à l'*epi* et cotisation annuelle

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

L'*epi* remplit auprès de l'Office européen des brevets les mêmes fonctions que, au niveau national, le Barreau

pour les avocats ou l'Ordre pour les médecins, avec cependant la particularité que non seulement les personnes appartenant à la profession libérale mais également celles qui exercent dans l'industrie ou dans le secteur public en sont membres.

Peuvent faire partie de l'*epi* les personnes titulaires d'un diplôme scientifique ou technique de niveau universitaire ou bien ayant des connaissances scientifiques ou techniques de niveau équivalent, qui ont accompli un stage d'au moins trois ans dans le domaine du brevet et réussi l'examen européen de qualification de l'Office européen des brevets.

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

2. Affiliation

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

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

Les membres de l'*epi* sont tous des membres actifs. Il n'est pas possible de suspendre l'affiliation. Si une personne désire ne pas payer de cotisation annuelle pendant quelque temps, elle doit demander sa radiation de la liste

des mandataires de l'OEB avant le 1er avril de l'année en cours et refaire une demande d'inscription plus tard. La demande de radiation/réinscription doit être adressée à l'OEB, direction 5.1.1.

3. Cotisation annuelle

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

Une suspension du paiement de la cotisation ou une réduction de son montant, actuellement de 150 EUR, n'est pas possible. Une éventuelle suspension ou réduction de la cotisation a souvent été considérée par le Conseil et le Bureau de l'*epi*. Cette possibilité a été rejetée en raison, entre autres, du montant relativement peu élevé de la cotisation. Une personne est toutefois dispensée d'acquitter la cotisation annuelle si

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

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

Nous vous rappelons que le Bureau et le Conseil de l'*epi* doivent, pour chaque décision, tenir compte du fait que l'*epi* est une organisation internationale constituée non pas d'un seul pays mais de 27 Etats Contractants de la Convention sur le brevet européen.

Wichtige Information des Sekretariats zur Zahlung des epi-Beitrags 2004

W. Baum,
Generalsekretär

Im vergangenen Jahr ergaben sich im Sekretariat wieder in erheblichem Umfang enorme Schwierigkeiten bei der Buchung von Mitgliedsbeiträgen, die durch direkten Einzug von laufenden EPA-Konten erfolgen. In 1/3 der etwa 3000 Fälle, in denen der Mitgliedsbeitrag durch direkten Einzug vom EPA-Konto erfolgt, waren Unzulänglichkeiten aufgetreten, die Nachforschungen, Telefongespräche, Mahnungen und ähnliche zeitraubende Beschäftigung nach sich zogen.

Ein erster Teil der Schwierigkeiten ist darauf zurückzuführen, dass der direkte Einzug vom laufenden EPA-Konto nur 1 x im Jahr erfolgen kann und zwar nur dann, wenn vor dem **15. Februar** des Kalenderjahres eine entsprechende Erklärung mit dem hierzu eigens geschaffenen Formblatt des *epi* beim Sekretariat eingeht. Im

vergangenen Jahr hat das Sekretariat nach dem 15. Februar noch eine große Anzahl von Einzugsermächtigungen erhalten. Solche Einzugsermächtigungen sind *wirkungslos*, weil der Bankeinzug dann bereits abgeschlossen ist.

Ein weiterer Grund für Störungen im Geschäftsablauf in einer beträchtlichen Anzahl von Fällen war der Wechsel eines zugelassenen Vertreters von einer Kanzlei oder einer Industriefirma zu einer anderen, ohne dass dieser Wechsel dem Sekretariat angezeigt wurde und der Abbuchungsauftrag entsprechend geändert wurde. Mit anderen Worten: Sobald ein zugelassener Vertreter vor dem EPO aus der Firma, sei es ein Industrieunternehmen oder eine Kanzlei ausscheidet, ist es absolut notwendig, dies dem *epi*-Sekretariat mitzuteilen und

Name und Mitgliedsnummer des betreffenden zugelassenen Vertreters anzugeben und gleichzeitig ein geändertes Formblatt „Einzugsermächtigung“ an das Sekretariat zu schicken. Es ist selbstverständlich, dass dasselbe auch notwendig ist, wenn ein zugelassener Vertreter in eine Firma oder Kanzlei eintritt.

Ein dritter Teil der Problemfälle besteht darin, dass im elektronischen Bankverkehr oft nur begrenzter Platz für Bankcodes auf Überweisungsformularen vorgesehen ist,

der nicht ausreicht, den vollen Namen oder die ganze Registrierungsnummer des zugelassenen Vertreters einzusetzen. In diesen Fällen kann dann vom Sekretariat der eingehende Mitgliedsbeitrag nicht mehr zum entsprechenden Mitglied identifiziert werden.

Das Sekretariat bittet dringend alle Mitglieder durch Rückfrage bei den ausführenden Buchhaltungen sicherzustellen, dass ihre Überweisung bzw. ihr Bankeinzug vollständig und korrekt erfolgt.

Important information from the Secretariat relating to the payment of the subscription fee for 2004

W. Baum
Secretary General

It is obvious from the present situation that those members, who achieved a direct debiting mandate made enormous difficulties with the staff of the Secretariat during the year 2003. In a third of about 3 000 direct debiting cases there arose deficiencies having caused searches, telephone calls, reminders, etc.

A first part of these cases result in the fact that the direct debiting mandate can only be achieved before the **15th of Feb.** of a calendar year and the secretariat received lots of requirements for direct debiting after said deadline. There is absolutely no possibility for the *epi* to collect the subscription fee in those cases and consequently reminders had to be sent out!

Another reason for trouble in a considerable number of cases was a changing of a member from one firm to another without informing the Secretariat and without amending the direct debiting mandate accordingly; in other words: As soon as a professional representative

before the EPO leaves a company, either industry or law firm, it is absolutely necessary to notify the *epi*-Secretariat indicating the name of the said professional representative and his registration number and at the same time sending an amended form „direct debiting mandate“ to the Secretariat. It goes without saying that the same procedure is necessary if a new professional representative enters a company or a law firm.

Another part of trouble cases in connection with payment of subscription fees is caused by electronic banking, where with respect to the limited space for bank codes the remittance form lacks either the full name or the full registration number (including resets!) and thus cannot be related to a specific member.

epi members are urgently asked to check their payments of membership fees accordingly and to make sure that the full name and registration number is transmitted with every payment.

Information importante du Secrétariat concernant le paiement de la cotisation pour l'année 2004

W. Baum
Secrétaire Général

La situation actuelle met clairement en évidence que le recouvrement des cotisations pour les personnes ayant choisi de payer par prélèvement automatique a causé des difficultés considérables au personnel du Secrétariat. Un tiers des 3000 demandes de paiement par prélèvement automatique a en effet généré des problèmes et occasionné d'innombrables recherches, communications téléphoniques, rappels, etc.

Une grande partie des problèmes s'explique par le fait que de nombreuses demandes de paiement par prélèvement automatique sont envoyées au Secrétariat après la date limite du **15 février** de l'année en cours. Celles-ci ne peuvent être alors satisfaites puisque l'*epi* n'est pas autorisé à prélever la cotisation sur les comptes de l'OEB au-delà de cette date, et le Secrétariat par conséquent doit envoyer des rappels.

Les difficultés rencontrées sont liées également au fait que beaucoup de mandataires changent d'employeur sans en informer le Secrétariat et sans modifier leur autorisation de prélèvement automatique. Tout mandataire qui modifie son activité professionnelle, qu'il soit dans l'industrie ou dans la profession libérale, doit impérativement en informer le Secrétariat en indiquant son nom et son numéro d'affiliation et doit également envoyer une modification de son autorisation de prélèvement automatique. La même procédure s'applique bien entendu aux nouveaux mandataires qui sont engagés dans l'industrie ou dans un cabinet de conseils en brevets.

Les virements par voie électronique sont aussi à l'origine de nombreux problèmes en raison du peu de place réservé pour la mention de références bancaires. Le nom ou le numéro d'affiliation mentionnés sur le relevé se trouvent alors fréquemment tronqués, et par conséquent le paiement ne peut pas être correctement attribué au membre concerné.

Les membres de l'*epi* sont priés de veiller à ce que le paiement de leur cotisation soit correctement effectué, et de s'assurer que leur nom et leur numéro d'affiliation sont indiqués sur chaque virement.

Note from the Secretariat

With the payment of their *epi* annual subscription fee at the beginning of the year, many *epi* members ask the *epi* Secretariat for confirmation of their payment. Please be aware that because of the large *epi* membership it is not possible to answer individual requests for confirmation of payment.

If your payment has not been duly received, you will receive a reminder from the Secretariat before April 2004.

epi Information 1/2004 – Themed edition

Community Patent and the current proposals for the Community Patent

We would greatly appreciate receiving your contributions on this topic.

Please forward any contributions to:

Editorial Committee (*epi* Information 1/2004)

epi Secretariat,

P.O. Box 260112,

D-80058 München,

e-mail: info@patentepi.com

The deadline for provision of articles for *epi* Information 1/2004 is 13 February.

LIST OF PROFESSIONAL REPRESENTATIVES AS OF 10.11.2003

by their place of business or employment in the Contracting States and their entry according to A134 or A163

No.	Contr. State	A134	% A134	A163	% A163	Total Repr.	% of Tot/Repr.
1	AT	45	51	43	49	88	1,15
2	BE	75	60	49	40	124	1,62
3	BG		0	113	100	113	1,48
4	CH	171	52	160	48	331	4,34
5	CY		0	15	100	15	0,20
6	CZ		0	136	100	136	1,78
7	DE	1581	62	964	38	2545	33,33
8	DK	57	42	80	58	137	1,79
9	EE		0	32	100	32	0,42
10	ES	5	3	152	97	157	2,06
11	FI	8	5	145	95	153	2,00
12	FR	364	55	298	45	662	8,67
13	GB	899	60	592	40	1491	19,53
14	GR		0	33	100	33	0,43
15	HU		0	150	100	150	1,96
16	IE	6	18	28	82	34	0,45
17	IT	119	39	189	61	308	4,03
18	LI	5	50	5	50	10	0,13
19	LU	8	47	9	53	17	0,22
20	MC		0	3	100	3	0,04
21	NL	204	71	83	29	287	3,76
22	PT		0	46	100	46	0,60
23	RO		0	65	100	65	0,85
24	SE	102	40	155	60	257	3,37
25	SI		0	33	100	33	0,43
26	SK		0	51	100	51	0,67
27	TR	1	0	356	100	357	4,68
	Total	3650	48	3985	52	7635	100,00

Quality of Patent Searches

E. Lyndon-Stanford¹ (GB)

1. I have a largely domestic client practice and having clients that primarily want patents that are valid. These clients generally make searches before filing even the priority application, carefully consider all search results in relation to the whole family of patents, and inform examiners about all the relevant prior art. The overall objective is to be granted patents that cannot be challenged. For drafting, it is important to be able to formulate the main claims and the fall-back claims in the knowledge of the closest prior art, but by the time we receive the normal Patent Office searches, it is in any case too late. It is however also important to avoid amending a patent „in one direction“ because of one item of prior art and then after grant finding another item of prior art which forces an amendment „in another direction“ with the overall result that the final claim is narrower than it need be.
2. Undoubtedly, if searchers use different databases, the search results are different. In the overall strategy, this on the one hand is extremely valuable because the „cover“ of the searches is greater. On the other hand, it gives considerable problems of synchronisation because, unless special steps are taken, the search results come in over a period of years. However, I am not discussing searches using different databases.
3. I have problems with the concept that if the same databases are searched by different patent offices, the work is duplicated, and that therefore costs could be saved and delays could be avoided by Patent Offices co-operating and carrying out a single search. Undoubtedly, it is necessary to reduce the amount of searching work done by Patent Offices. Searching back-logs are high in some Offices, giving poor service. Furthermore, it is wrong that the scientific and technical talent of countries should be engaged in the secondary activity of searching rather than the primary activity of research and development. Nonetheless, it should be recognised that if Patent Offices co-operate and carry out a single search, the search results will be significantly poorer. It is a fact that different searchers working on the same family of patent applications and using the same databases produce different search results.
4. I have arrived at this conclusion from my own practice. However, in order to prove the point, I have collaborated with a large British corporation in order to evaluate the search results that they received. We selected six cases at random amongst those cases where there was a complete set of searches in United States, the Japanese Patent Office, the European Patent Office and the British Patent Office. As the cases were selected at random, I believe that they are representative. In each case, the searches were done on the same specifications and claims. The European, Japanese and British Patent Offices used the same databases, whilst the US Patent Office used some of the same databases but also their own classification database.
5. I attach summaries of the search results for the six cases. The results of the six cases were as follows:

Case 1. There is no correlation at all between the citations found. The US Patent Office found one „X“ citation and two „A“ citations. The Japanese Patent Office found another X citation. The European Patent Office did not find either X citation but found three A citations different from the US ones. The British Patent Office did not find any of the citations.

Case 2. There is some correlation, but not very strong. The British Patent Office found eight X citations but did not find five X citations which were found elsewhere.

Case 3. There is no correlation. The Japanese Patent Office did not find any of the citations.

Case 4. There is no correlation. The British and Japanese Patent Offices did not find any of the citations.

Case 5. There is weak correlation (and to a certain extent a Y citation depends on what else is found by the searcher). The Y citations found by the European Patent Office and the Japanese Patent Office were not found by the British and US Patent Offices.

Case 6. There is weak correlation but the majority of the X or Y citations made by a Patent Office were not found by another Patent Office.
6. Thus, in summary, in three of the six cases (numbers 1, 3 and 4), no citation made by any one Patent Office was cited by any other. In every case, at least one X or Y citation was discovered uniquely by one Patent Office.
7. The reasons for these discrepancies can be stated in general terms. Searching is a particular skill and requires significant expertise and benefits enormously from the experience of the searcher. In a classification search, the quality of the search will depend upon the quality of classification of the references, which can be imperfect. In addition, the searcher must decide the sub-classes for the patent claims he is searching. Often this is not particularly easy because patents are always new and need not fit comfortably into a classification which had probably been written many years before. In a database

¹ Edward Lyndon-Stanford 2003

search, the searcher must decide what combination of words to search. This requires not only knowledge of the words (or jargon) used in the patent he is searching, but also knowledge of the words which may have been used in the huge variety of potential prior art in the database.

8. Undoubtedly the movement of major Patent Offices to share databases, the common use of classification systems, and mutual exchanges of searchers to achieve a common approach will make searching more uniform. My concern however remains that, however skilful the searchers may be, having a

single search would significantly reduce the number of hits, compared to the present multiple searches.

9. A more brutal conclusion can be reached from a review of the cases above, namely that with the present searching methods, none of the Patent Offices involved do a satisfactory search. However, I think that is an unfair comment. As I noted above, searching is a particular skill and requires significant expertise. The task is extremely difficult. One cannot expect any individual searcher to find everything that is relevant.

Amicus Curiae Brief in G1/03 and G2/03 (Disclaimers) on behalf of the epi, July 2003

The *epi*, highly concerned with the questions presented to the Enlarged Board of Appeal in the cases G1/03 and G2/03, herewith presents its position on admissibility of „disclaimers“.

I – Introduction

1. Definition of a disclaimer

A „disclaimer“ is a statement in a claim whose effect is to exclude part of the subject-matter claimed from the scope of the claim, which statement has no basis in the application as filed.

The disclaimer was defined in T 433/86 (reason 2), where the Board stated :

„when there is an overlap between prior art and the claimed subject-matter defined in generic terms, a specific prior art may be excluded even in the absence of support for the excluded subject-matter in the original document“.

This possibility was recalled in T 170/87 (reason 8.4.1) :

„It is permissible to exclude a certain state of the art from the claimed invention by means of a disclaimer even if the original document gives no basis for such an exclusion“.

The *epi* considers that the definition of disclaimers should be limited to such cases and should not include statements in a claim which have a support in the originally filed application as for example in the situation of T4/80 where the expression „negative statement“ could be used.

II – Factual situation

1. Historical outline

Disclaimers as such are not mentioned in the European Patent Convention, either in the Articles or the Rules, but the Convention was not intended to lay down an

exhaustive code. Rather, the European Patent Office was left to develop its own practice in conformity with the European Patent Convention as interpreted by the Boards of Appeal.

The concept of introduction into a claim of a negative statement (however not a disclaimer within the definition given above) appeared in the jurisprudence of the Boards of Appeal for the first time in decision T 4/80 with the condition that the subject-matter remaining in the claim could not be defined directly more clearly and concisely. The introduction of a disclaimer during the European proceedings was allowed by T 433/86 where the Board stated :

„when there is an overlap between prior art and the claimed subject-matter defined in generic terms, a specific prior art may be excluded even in the absence of support for the excluded subject-matter in the original document“

This was confirmed by T 170/87 :

„It is permissible to exclude a certain state of the art from the claimed invention by means of a disclaimer even if the original document gives no basis for such an exclusion“.

2. Conditions for disclaimers before T 323/97

The criteria, defined in particularly in decision T 934/97, to be applied when examining the allowability of a disclaimer pursuant Article 123(2) EPC are the following :

- (i) There is a novelty-destroying prior art.
- (ii) The prior art is an accidental anticipation.
- (iii) The „excluded“ prior art disappears from the state of the art to be considered for the assessment of inventive step.

Another criterion has been defined in T 1071/99 : the wording of the disclaimer should be based clearly and unambiguously on the disclosure of the prior art document. This criterion was also indicated in T 43/82

However, some decisions have allowed disclaimers excluding more than what was disclosed in the prior art. Reference may be made to T 296/87 and T 12/90.

According to the jurisprudence, the definition of an „accidental anticipation“ is not the same when the disclosure belongs to the state of the art pursuant to Article 54(2) EPC or when the disclosure belongs to the state of the art pursuant to Article 54(3) EPC.

By „accidental anticipation“ for a disclosure belonging to the state of the art pursuant to Article 54(2) EPC, is meant either an anticipation belonging to a completely different technical field or, in view of its subject-matter, one which would not help in solving the technical problem underlying the claimed invention. (T 608/96, point 6 of the reasons).

Concerning a disclosure belonging to the state of the art pursuant to Article 54(3) EPC, by „accidental anticipation“ is meant an anticipation belonging to any technical field, whether identical or not. As a matter of fact, the different applicants were entitled to the patent in different areas and it was not possible for an applicant, when preparing his application, already to be familiar with conflicting applications under Article 54(3) EPC.

This position was recently confirmed by the Board of Appeal in decisions T 351/98 and T 525/99 :

„the later applicant could not know of the Article 54(3) EPC prior art content and so could not formulate his originally filed claims to avoid their contents.“ (T 351/98, point 45 of the reasons)

„the later applicant will normally have had no knowledge of the earlier application deemed to be prior art by article 54(3) EPC, and cannot be expected to have appropriately delimited his application in respect of such unknown deemed prior art“ (T 525/99, point 2.1.3 of the reasons)

3. Decision T 323/97

The headnote of this decision is as follows :

I. An amendment to a patent by the introduction of a „negative“ technical feature into a claim resulting in the exclusion of certain embodiments is, regardless of the name „disclaimer“, none the less an amendment governed by Articles 123(2) and (3) EPC.

II. The practice of permitting disclaimers having no support in the application as filed to make a claimed subject-matter novel by delimiting it against an accidental anticipation cannot be maintained in the light of the Enlarged Board of Appeal's opinion G 2/98.

III. Any amendment of a claim not having support in the application as filed and aiming at distancing the claimed subject-matter further from the state of the art, in particular by way of a disclaimer, contravenes Article 123(2) EPC.

The decision T 323/97 in points 2.3 and 2.4 of the reasons purports to find support for its view in the Enlarged Board of Appeal Opinion G 2/98 directed to a legal situation based on Article 87 EPC. G 2/98 relates namely to the meaning of „the same invention“ for acknowledging priority under Article 87 EPC.

III – epi Opinion

1. The importance of disclaimers

The *epi* wishes to stress the usefulness of disclaimers in many cases and more particularly in the chemical field.

Without the possibility of introducing disclaimers in the claims of a patent application or a patent, it would be necessary to draft the patent applications in a complete different way and to increase considerably the length of the description as well as the number of claims so as to state every detail of the invention.

The legal certainty for patentees, who used disclaimers for years all over the world, would be seriously damaged if disclaimers would not be possible anymore.

Nevertheless, the *epi* also considers that disclaimers should not be used without limits, in order to safeguard the interests of third parties as well as the legal certainty.

As stated by the Enlarged Board of Appeal in its decision G1/93, point 9 of the reasons:

„with regard to Article 123(2)EPC, the underlying idea is clearly that an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application“

The *epi* therefore considers that disclaimers should only be accepted under clear and legally founded conditions.

In any case, introducing a disclaimer is always linked to a certain risk for the patentee. If a national court would eventually consider that a disclaimer initially accepted is unacceptable, the claim would be declared void by the court, the patentee not having the possibility of canceling the disclaimer without violating Article 123 (3) EPC.

2. The „accidental“ disclosure

The state of the art is defined in Article 54 (2) EPC as being any information which has been made available to the public. A disclosure is therefore part of the prior art as soon as it is available to the public. The EPC does not suggest any interpretation of this absolute concept of the prior art.

The characterization of a disclosure being „accidental“ is an appreciation of the disclosure which is not provided in the EPC.

Introducing the problem to be solved for characterizing a disclosure as was made in many previous decisions of the Boards of Appeal introduces in fact a confusion with the problem/solution approach of the inventive step determination.

The *epi* is of the opinion that acceptability of disclaimers should not depend of such an appreciation of a disclosure.

It follows therefore that the theoretical extension of the prior art defined by Article 54 (3) does not introduce a difference in the nature of the disclosure. In any case, novelty is an absolute concept which is to be determined on the basis of the prior art defined in Article 54, without making a difference between paragraph 2 and paragraph 3 of this Article.

3. The disclaimer as a partial waiver

Art. 125 EPC states that :

„in the absence of procedural provisions in this Convention, the European Patent Office shall take into account the principles of procedural law generally recognized in the Contracting States“.

In the National Laws of the Contracting States it is generally recognized that an applicant can waive totally or partially his right to a national patent. This provision should be applied in the case of a disclaimer.

Decision G 1/93 is based on this right to waive partially the right to the European Patent Application. As a matter of fact, G1/93, in point 16 of the reasons, gives the possibility of adding a feature which has not been disclosed in the application as filed without contravening Art. 123 (2) EPC.

„A feature which has not been disclosed in the application as filed but which has been added to the application during examination and which, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, is not to be considered as subject-matter which extends beyond the content of the application as filed within the meaning of Article 123(2) EPC.“

Furthermore, the legal security for third parties is guaranteed and it was stated by the Enlarged Board in G 1/93, point 12 of the reasons :

„From the point of view of legal security for third parties, obviously this case differs fundamentally from the above situation in that third parties, having relied on the application as filed and published, are not being faced with a granted patent with a wider scope of protection than could be foreseen but with a patent conferring less protection and thus interfering to a lesser extent with their activities.“

The *epi* is therefore of the opinion that disclaimers should be considered as partial waivers of the rights to the patent protection. The applicant and the patentee should be allowed to waive whatever part of the protection they are seeking.

This however does not mean that every disclaimer should be accepted: certain conditions must be fulfilled for a disclaimer to be acceptable.

4. No technical contribution

Article 123(2) states that

„A European patent application or a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.“

According to G 1/93, point 16 of the reasons :

„If an undisclosed added feature, although limiting the scope of protection conferred by the patent, has to be considered as providing a technical contribution to the subject-matter of the claimed invention, it would, in the view of the Enlarged Board, give an unwarranted advantage to the patentee contrary to the

above purpose of Article 123(2) EPC. Consequently, such feature would constitute added subject-matter within the meaning of that provision. A typical example of this seems to be the case, where the limiting feature is creating an inventive selection not disclosed in the application as filed or otherwise derivable therefrom. If, on the other hand, the feature in question merely excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such feature cannot reasonably be considered to give any unwarranted advantage to the applicant. Nor does it adversely affect the interests of third parties (cf. paragraph 12 above). In the view of the Enlarged Board, such feature is, on a proper interpretation of Article 123(2) EPC, therefore not to be considered as subject-matter extending beyond the content of the application as filed within the meaning of that provision. It follows that a patent containing such a feature in the claims can be maintained without violating Article 123(2) EPC.“

Disclaimers can therefore be introduced in claims without contravening Article 123(2) EPC if they provide no technical contribution to the subject-matter of the claimed invention.

It must be noted that the French version of Article 123 (2) EPC expressly mentions „l'objet“ de l'invention. In the same way, the German version expressly mentions „der Gegenstand“ der Erfindung. The French and German versions of this Article are more precise than the English version and Article 123 (2) must be interpreted in the way giving it its full meaning i.e. that new matter should not result in an addition to the substance of the invention.

A similar interpretation has already been made in decision T11/82, points 21 and 22 of the reasons, in connection with Rule 27 EPC:

21. Article 123(2) EPC provides that a European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. The expression used is „subject-matter“, not „matter“. The corresponding expressions in the French and German texts are, respectively, „son objet“ and „ihr Gegenstand“. Article 84 EPC, which requires the claims to define „the matter for which protection is sought“, also uses the expressions „objet“ and „Gegenstand“ in a related context.

22. On no reasonable interpretation of the expressions „subject-matter“, „ihr Gegenstand“ (einer europäischen Patentanmeldung), or „son objet“ (d'une demande de brevet européen) in the context of Article 123(2) EPC could it be held that the mere addition to a description forming part of a European patent application of a reference to prior art would constitute a contravention of Article 123(2) EPC. Nor is it inevitable that the addition of a discussion of the advantages of the invention with reference to such prior art would constitute a contravention of that Article. Whether it

did so would clearly depend on the actual language used and the circumstances of the case.

As to the point of time to be considered in analysing the technical contribution, the priority date (or filing date in case of a first filing), should be taken into consideration so that the condition of acceptability of the disclaimer does not vary in time even in case of technological changes.

As an example of lack of technical contribution, the invention with disclaimer should not constitute a novel selection invention as stated in G 2/98, point 8.4 of the reasons :

„If the invention claimed in a later European patent application constitutes a so-called selection invention – i.e. typically, the choice of individual entities from larger groups or of sub-ranges from broader ranges of numerical values – in respect of the subject-matter disclosed in a first application whose priority is claimed, the criteria applied by the EPO with a view to assessing novelty of selection inventions over the prior art must also be considered carefully when assessing whether the claim in the European patent application is in respect of the same invention as the priority application within the meaning of Article 87(1) EPC. Otherwise, patent protection for selection inventions, in particular in the field of chemistry, could be seriously prejudiced if these criteria were not thoroughly complied with when assessing priority claims in respect of selection inventions. Hence, such priority claims should not be acknowledged if the selection inventions in question are considered „novel“ according to these criteria.“

In fact, if a claim containing a disclaimer could be interpreted as defining a novel selection, this would mean that the disclaimer has indeed introduced a technical contribution to the claim. Such a disclaimer would not be acceptable.

5. Clarity and conciseness

The disclaimer should also not affect the clarity and conciseness of the claim.

It should be left to the applicant or the patentee to define the exact wording of the disclaimer which is to be introduced in a claim as partial waiver of rights as long as the claim remains clear and concise.

Nevertheless, for reasons of clarity and legal security, the reasons for introducing the disclaimer should be stated in the description of the patent as required for the prior art.

IV – Proposals for answers to questions before the Enlarged Board

Case G1/03

1. *Is an amendment to a claim by the introduction of a disclaimer unallowable under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed?*

No, such an amendment should be considered as a partial waiver of rights which the applicant or patentee is entitled to make. The fact that an amendment by disclaimer has no basis in the application as filed is not relevant as long as the disclaimer does not introduce in the claim a technical contribution.

2. *If the answer to question 1 is no, which criteria are to be applied in order to determine whether or not a disclaimer is allowable?*

(a) *In particular, is it of relevance whether the claim is to be delimited against a state of the art according to Article 54(3) EPC or against a state of the art according to Article 54(2) EPC?*

No, the EPC makes no difference between the prior art defined in Article 54. paragraph 2 or paragraph 3. Making an artificial difference could also lead to difficulties if for example the validity of the priority claimed in an application would finally not be recognized, such that a disclosure considered initially under Article 54 (3) would have to be regarded under Article 54 (2).

(b) *Is it necessary that the subject-matter excluded by the disclaimer be strictly confined to that disclosed in a particular piece of prior art?*

The amendment made to a claim by a disclaimer should not alter the clarity and conciseness of the claim. If the disclaimer is strictly confined to that disclosed in a particular piece of prior art, for instance in a specific example thereof, the clarity of the claim could well be affected.

As the disclaimer should be considered as a partial waiver of rights, it should be allowed to draft the disclaimer in an appropriate way such that the claim remains clear and concise. It should not be compulsory that the disclaimer is strictly confined to that disclosed in a particular piece of prior art.

For example, if a particular piece of prior art specifically discloses an active ingredient in a composition also including certain non active additives, it should be acceptable to draft a disclaimer excluding only the active ingredient without mentioning the additives.

(c) *Is it of relevance whether the disclaimer is needed to make the claimed subject-matter novel over the prior art?*

The fact that a claim is rendered novel by the introduction of the disclaimer should not be a condition of acceptability of the disclaimer. However, it remains to be seen in which other situation a disclaimer could be acceptable i.e. would not add a technical contribution to the substance of the invention. For example, a disclaimer cannot render a claim inventive since this would mean introducing a technical contribution to the claim.

(d) *Is the criterion applicable that the disclosure must be accidental, as established by prior jurisprudence, and, if yes, when is a disclosure to be regarded as being accidental,*

An accidental disclosure is part of the prior art as defined in the EPC as any other information which has been made available to the public. An appreciation of

an „accidental“ character should not be used for judging the acceptability of a disclaimer.

or

(e) is the approach to be applied that a disclaimer which is confined to disclaiming the prior art and has not been disclosed in the application as filed is allowable under Article 123(2) EPC, but that the examination of the subject-matter claimed for the presence of an inventive step has then to be carried out as if the disclaimer did not exist?

An acceptable disclaimer should not introduce any technical contribution in a claim. The state of the art remains unchanged and is clearly still opposable to the patentability of the claimed invention. Normally, the claim with the disclaimer will be novel, but apart from clarity which has to be checked, the entire state of the art according to Article 54(2) EPC, including the disclosure containing the disclaimed subject matter, remains opposable for considering inventive step.

The claim containing the disclaimer must meet all the requirements of the EPC. In principle, the examination should be made on the wording of the claim defined by the applicant or the patentee i.e. the claim with the disclaimer.

However, there should be no difference for considering the inventive step since the acceptable disclaimer

does not add any technical contribution i.e. does not modify the situation of the claim towards inventive step. Therefore, in practice, the examination of the inventive step may as well be carried out as if the disclaimer did not exist.

Case G 2/03

Is the introduction into a claim of a disclaimer not supported in the application as filed admissible, and therefore the claim allowable under Article 123(2) EPC, when the purpose of the disclaimer is to meet a lack-of-novelty objection pursuant to Article 54(3) EPC ?

A disclaimer may be admitted to meet a lack-of-novelty objection pursuant to Article 54(3) EPC.

In fact, a disclaimer may also be admitted in a similar situation resulting from an objection pursuant to Article 54(2) EPC.

If yes, what are the criteria to be applied in assessing the admissibility of the disclaimer ?

A disclaimer must not introduce a technical contribution to the substance of the invention and must not constitute such an amendment to a claim that a novel selection invention is defined.

The case for disclaiming anticipating prior art – whether accidental or otherwise

A. Rudge¹ (GB)

The Enlarged Board of Appeal of the EPO are presently considering the allowability of amending a claim, to restore novelty, by the introduction of a disclaimer, when there is no direct basis in the application as filed for such an amendment. In this article, the Enlarged Board is urged to establish a simple, pragmatic set of rules under which such amendments are held to be allowable and any consideration of inventive step is left for separate consideration.

Some things are best kept separate in the interests of a proper and orderly existence. Water and electricity, work and recreation, mistresses and wives – the list is extensive. In the field of patent law, novelty and inventive step are also worthy of inclusion. These two important pillars of patentability are quite separate concepts, differently defined and independently accommodated at Articles 54 and 56 EPC. When the crystal clear waters of novelty

become contaminated with the muddy subjectivity of inventive step, all manner of problems arise; for examination candidates, patent examiners and patent attorneys alike. One area in which the Boards of Appeal of the EPO have allowed such contamination is in the formulation of rules governing the use of a disclaimer to establish novelty over a prior art reference uncovered for the first time during the prosecution of a patent application. Whether novelty can be restored in this way, there being no direct basis for such an amendment in the application as filed, is dependent on whether the disclaimer is seen to be added matter pursuant to Article 123(2) EPC. Such matters are currently the subject of debate before the Enlarged Board of Appeal as joined cases G1/03 and G2/03. It will be argued below that the introduction of such a disclaimer does not add matter to an application and that there is no need to consider inventive step in reaching such a conclusion.

Article 123(2) EPC states that 'A European patent application or a European patent may not be amended

¹ Andrew Rudge, September 2003.

The views expressed in this article are the personal views of the author and not necessarily those of his employer.

in such a way that it contains subject-matter which extends beyond the content of the application as filed.' The purpose of this provision, as explained by the Enlarged Board of Appeal in decision G1/93, is to ensure that an applicant is not allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. In particular, the adding of subject-matter could result in the protection conferred by the granted patent being broader than a third party would have expected based on an analysis of the published application. In principle, since Article 69(1) EPC demands that the claims be interpreted with reference to the description and any drawings, the addition of subject-matter to the claims, description or drawings could have an effect on the protection conferred by the patent and for such reason, Article 123(2) prohibits the addition of subject-matter to any part of the application.

Crucial to the understanding of Article 123(2) is the interpretation accorded to the phrase 'subject-matter'. Principles of interpretation relevant to the EPC were considered by the Enlarged Board of Appeal in case G5/83, with reference being made to the Vienna Convention. Broadly speaking, terms should be given their ordinary meaning, having regard to the context in which they are used and in light of the purpose they serve within the EPC. The term 'subject-matter' is used widely in the EPC. In many instances (e.g. Articles 70, 76, 100, 138 and Rule 7) neither the meaning nor the context differ from Article 123(2). Article 52(3) equates 'subject-matter' with the concept of what may or may not be regarded as an invention. Articles 63(2) and 64(2) equate 'subject-matter' with various kinds of invention including products, processes and the uses of a product. Article 75(2) talks of inventions whose 'subject-matter' may not be communicated abroad due to national security provisions. Rule 29(1) proves that the claims should in appropriate cases include a statement indicating the designation of the 'subject-matter of the invention'. Rule 29(2), restricting the circumstances where two or more claims in the same category are to be tolerated, refers to the 'subject matter' of an application involving alternative inventions such as 'a plurality of inter-related products' or 'different uses of a product or apparatus'. According to Rule 86(4), amended claims may not relate to unsearched 'subject-matter' which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. In all these Articles and Rules the term 'subject-matter' is clearly being used to refer to an invention, as described in a patent application. In this light, 'subject-matter' as used in Article 123(2) must be given the natural meaning of 'subject-matter related to the invention'. Such a definition does no violence to the natural meaning of the words and accords with their context and the purpose they serve in the EPC. In particular, it is the addition of subject matter related to the invention that would

enable the applicant to improve his position and extend the protection available.

It therefore follows that the addition of subject-matter not related to the invention would not fall foul of the provisions of Article 123(2). Naturally, the addition of most non-related material would not in any case be allowed since Rule 34(1)(c) prohibits 'any statement or other matter obviously irrelevant or unnecessary under the circumstances'. One kind of subject-matter which is neither related to the invention nor irrelevant or unnecessary is subject matter related to the prior art. Not only should it therefore be possible to add such subject matter to the application without offending against Article 123(2) but, in certain circumstances, such addition is explicitly encouraged by the EPC itself. According to Rule 27(1)(b), the description of a European patent application must 'indicate the background art which, as far as known to the applicant, can be regarded as useful for understanding the invention, for drawing up the European search report and for the examination, and, preferably cite the documents reflecting such art. If such background art is not discussed in the application as filed, or becomes known after the application is filed, it is common practice for an accurate summary of its contents to be inserted in the description during examination. Such matter, being subject-matter related to the prior art rather than the invention, is not taken to contravene Article 123(2).

This approach is no more than reasonable since the skilled person, the addressee of the patent application and the person through whose eyes the application is to be construed, is taken, for the purposes of assessing novelty and inventive step, to have read and to be familiar with all the relevant prior art at the filing date of the application. It can therefore be no surprise to him to be reminded of what he already knows by the insertion of references to the prior art in the application. Such references may not have been in the application at its filing date but were already in the mind of the skilled person at that time. It cannot therefore be, in the words of G1/93, damaging to the legal security of third parties relying on the content of the original application, to add subject-matter related to the prior art to the application at a later date. The one caveat to this argument is that the subject-matter added must be fairly based on the prior art – the addition of comments not reflecting the contents of the prior art would indeed be new information to the skilled person which he could not have derived either from the application as filed or his knowledge of the prior art.

Is there, then, any difference between adding subject-matter related to the prior art to the description, in the form of a short précis of its disclosure and adding it to the claims in the form of a disclaimer? The skilled person is aware that a claim must be novel to be valid and is therefore aware that the applicant could not have intended his claim to encompass anything already described in the prior art. It is therefore not going to be a great surprise to him, nor will it impair his legal certainty, to find disclaimed that which the skilled person

knew did not belong to the applicant in the first place. According to G1/93, the applicant should not be allowed to 'improve his position' by adding subject matter and it could be argued that by making an invalid claim valid, he has done just that. However, in context, it is clear that the Enlarged Board in G1/93 were considering any improvement in the applicant's position vis-à-vis scope of protection and a disclaimer, by reducing the scope of protection, can hardly improve the applicant's position in this respect. The applicant has a legitimate right to amend his application to make it valid. Unlike the fictional skilled person, the real applicant does not have access to all the prior art, which may be in any language and no more widely circulated than the dusty shelves of a single, uncatalogued library in a remote and unvisited corner of the world. Since the applicant is not omniscient in this way, it is only equitable that he is allowed the chance to restore the novelty of his claims over particular items of prior art by disclaiming what he and the skilled person both know he is not entitled to. In many ways, this is merely an exercise in making explicit what was already implicit.

Furthermore, if a new piece of prior art relevant to inventive step is produced during examination, the applicant is allowed to improve his position by producing data demonstrating that his invention has an unexpected advantage over that art, even though such data was not in the application as filed. Far from needing to be explicitly disclosed, the reformulated problem only has to be implied by or related to the problem originally suggested (T184/82). Such data are subject-matter related to the invention and cannot be added to the application without contravening Article 123(2) but its use is nevertheless sanctioned. It would seem fatuous to allow such a remedy, as a result of which the skilled person will indeed be surprised by new information, in relation to a reference relevant to inventive step whilst denying the simple expedient of a disclaimer to restore novelty over a reference the skilled person is already taken to be aware of.

The simple logic of all this is that the applicant should be allowed to limit his claim in the face of a novelty-destroying reference by the introduction of a disclaimer since the matter introduced is not subject-matter related to the invention but subject-matter based on the prior art and does not therefore contravene Article 123(2) EPC. Naturally it is important that the disclaimer is specifically based on the prior art, in the sense of being directly and unambiguously derivable from it, since the skilled person should not be presented with new information he cannot derive from either the application as filed or the prior art. Furthermore, it is only the precise area of overlap that the skilled person understands to belong to the prior art rather than to the applicant and it therefore follows that the disclaimer should be worded to remove only that which is novelty-destroying; otherwise the amendment would be introducing matter neither disclosed in the application as filed nor legitimately based on the prior art. By such equitable means, the right of the applicant to

obtain fair protection for his invention and the right of a third party to have legal certainty are properly balanced.

So far in this discussion, I have not had recourse to consider the relevance of the anticipatory prior art to inventive step. And neither should any consideration be necessary since the discussion has related to restoring novelty over that art. The assessment of inventive step can then follow in the normal way. However, the consistent case law of the Boards of Appeal has hitherto restricted the use of disclaimers to situations where the reference is an 'accidental' anticipation. An anticipation is accidental, according to that case law, when 'a skilled person would not take account of it when evaluating the inventive merit of the patent (or patent application) since it either belongs to a completely different technical field or in view of its subject-matter would not help in solving the technical problem underlying the claimed invention' (T323/97) or when 'the cited document containing the said disclosure has no relevance for any further examination of the claimed invention and it must then disappear from the prior art field to be taken into account' (T863/96) or when it is 'prior art relating to a different purpose and solving a different problem'. Does that make things clear? Only with a great deal of generosity could these different interpretations be held to have an identity of meaning.

The assessment of inventive step is fundamentally a subjective one. It can always be argued both ways and when all the intricate machinery of the 'Windsurfer' or 'problem and solution' approach has ground to a halt one is still left with the same blunt question: is the invention obvious, yes or no? There will never be a definitive right or wrong answer, just the subjective opinion of a patent examiner or judge which is hopefully more or less reasoned. The same subjectivity therefore rears its ugly head when deciding whether an anticipation is 'accidental'. Successive Boards of Appeal cannot even agree a consistent definition of 'accidental', much less can they, or an examining division, judge objectively on the facts of a given case whether the preferred definition is met or not. Not only is the use of such a subjective approach detrimental to the legitimate expectations of the applicant to have his invention assessed in a fair, consistent and, as far as possible, objective fashion; it is also unnecessary. Firstly, it is unnecessary since there are good reasons for allowing the use of disclaimers whatever the status of the prior art reference vis-à-vis inventive step, as already discussed. Secondly, the use of a disclaimer cannot put the applicant in a better position when it comes to the assessment of inventive step than he would have been had the disclaimer not been used.

When considering patentability, a piece of prior art can be likened to a pointer on a map having a certain location and a certain direction. As far as novelty is concerned, the position of the pointer is crucial; if it falls within the ambit of the claim as marked on the map then the claim lacks novelty, regardless of the pointer's direction. When it comes to inventive step, both position and direction are important. The pointer must be both close

enough to the claim and pointing in the right direction to provide an effective starting point for the skilled person to have arrived at the invention without using inventive skill. The pointer can lie very close to the claim but, if it points in a different direction, inventive step is not prejudiced (i.e. the prior art teaches away from the invention). Equally, the pointer can lie some distance away from the claim but be highly relevant if it points towards that claim. If, on the other hand, the pointer lies within the claim but is carefully cut out of it by means of a disclaimer then only two possibilities remain: (a) if the direction of the pointer is orthogonal to the axis on which the claim is laid out on the map, i.e. it has no relevance to the problem solved, then inventive step remains untouched; (b) if the direction of the pointer is in any other direction then no inventive step can remain since the merest movement in any direction will arrive inside the claim. What this rather clumsy analogy seeks to illustrate is the following: a disclaimer, when properly used as advocated above, cannot put any meaningful 'distance' between the prior art and the invention and cannot therefore improve the applicant's position when it comes to the assessment of inventive step. Any consideration of how relevant the anticipatory prior art is to inventive step when considering the legitimacy of a disclaimer is therefore quite otiose. If the invention is obvious then it will always be obvious, disclaimer or no disclaimer. There is no need to conduct the assessment of inventive step 'as if the disclaimer did not exist' as the Enlarged Board referral in case T507/99 contemplates. After all, if the disclaimer did not exist, there would be no need to assess inventive step at all, there being no step to measure.

However, even though a disclaimer cannot make a non-inventive claim inventive, it does not follow that if a

citation arguably has some relevance to the analysis of inventive step it is legitimate to short-cut the patentability analysis by denying the applicant the chance of obtaining a novel claim. The relevance of the citation must be established by proper argumentation and it is important that the applicant is given the chance to defend inventive step using, for example, the established framework of the problem-solution approach. This is the real injustice of judging the allowability of a disclaimer by reference to its supposed relevance to inventive step – it amounts to a lazy and shabby way of denying inventive step without having to present a proper *prima facie* case of obviousness and without giving the applicant a chance to rebut such a *prima facie* case. Not being able to overcome the novelty hurdle, the applicant is denied the chance to argue inventive step properly at all.

One further merit of the approach to disclaimers advocated above is that there is no discrimination between prior art cited under Article 54(2) and prior art cited under Article 54(3). This is desirable since there is no justification for taking a different approach to novelty depending on the route by which a citation finds itself in the state of the art, a view echoed by the UK High Court and Court of Appeal recently in the case of *Smithkline Beecham's Patent*.

In summary, therefore, an applicant should be allowed to amend a claim by the introduction of a disclaimer having no basis in the application as filed providing:

- (a) a prior art citation exists which destroys the novelty of the claim;
- (b) the disclaimer removes the actual area of overlap and no more; and
- (c) the wording of the disclaimer is directly and unambiguously based on the wording of the prior art citation.

Neue Anmeldeformulare für Patente und Gebrauchsmuster in Japan

Dankenswerter Weise wurden uns von Herrn Patentanwalt Paul Rosenich (Patentbüro Paul Rosenich AG, Liechtenstein) deutsche Übersetzungen der seit September 2003 für Japanische Patentanmeldungen gültigen Anmeldeformulare zur Verfügung gestellt, die wir nachfolgend zur allgemeinen Kenntnisnahme und Verwendung veröffentlichten möchten.

Das Japanische Patentamt (JPO) hat vor kurzem für japanische Patentanmeldungen ein neues obligatorisches Formular eingeführt. In den folgenden Seiten finden Sie die erläuternden Informationen, die aus den unten aufgeführten Seiten der amtlichen JPO Web-Seiten entnommen wurden:

(<http://www.jpo.go.jp/tetuzuki/index.htm>)

(http://www.jpo.go.jp/tetuzuki/t_tokkyo/shutsugan/tokujitu_meisai_info.htm)

(http://www.jpo.go.jp/tetuzuki/t_tokkyo/shutsugan/pdf/h15_7_newspaper.pdf)

Anm, d. Übers.: *tetuzuki*: Prozedur; *tokkyo*: Patent; *shutsugan*: Anmeldung; *tokujitu*: Patent und Gebrauchsmuster; *meisai*: Einzelheiten

Das JPO hat begonnen, neben den bisherigen Anmeldungen die Anmeldungen mit den neuen Formularen anzunehmen, und ab September dieses Jahres nimmt sie *nur* noch Anmeldungen mit den neuen Formularen entgegen. Um mögliche Probleme oder Mehrkosten

zu vermeiden, ist es empfehlenswert, bei allen Dokumentationen in Japan diese neue Regelung zu beachten.

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 E-Mail: PA0C00@jpo.go.jp

Juni, HEISEI 15 (2003) Japanisches Patentamt

Um das Gesetz Nr. 24 (HEISEI 14), Patentgesetz o.dgl. teilweise zu ändern, sind der zweite Paragraph des Artikels 36 des Patentgesetzes und der zweite Paragraph des Artikels 5 des Gebrauchsmustergesetzes geändert worden, und auch das Formular ist ab 1. Juli 2003 an geändert, in dem der erläuternde Text und die Patentansprüche voneinander getrennt sind.

Die in der Beschreibung anzugebenden Items o.dgl. sind seit 1. Juli 2003 auch an die Internationale Standardisierung angepasst.

- Die Änderung, dass von dem „Erläuternden Text“ die „Patentansprüche“ oder die „Gebrauchsmuster-Schutzansprüche“ getrennt und als ein einzelnes Dokument eingereicht wird, wird seit 1. Juli 2003 ausgeführt.
- Die Änderungen zum Anpassen an die Internationale Standardisierung werden auch seit 1. Juli 2003 ausgeführt.

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– In der Beschreibung wird zuerst danach nummergeschrieben.

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- Ein KATAKANA von einem halben KAKU darf nicht verwendet werden.
- Ein queres Doppel-KAKU darf nicht verwendet werden.

Anm. d. Übers.: KAKU ist ein Quadrat, dessen Größe einem normalen Druck- oder Computer-Schriftzeichen der japanischen Sprache entspricht.

- Es wird gebeten, seit 1. Juli 2003 mit den neuen Formularen anzumelden.
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- Die Angabenbeispiele nach dem neuen Formular (Erläuternder Text des Patentbesitzes und Patentansprüche) sind in dem getrennten Blatt <PDF 10KB> zu finden. Beim ersten Verwenden der PDF-File sehen Sie Adobe Acrobat Reader Download-page.
- Die Korrekturmethode, die wegen der Trennung der Ansprüche von dem Erläuternden Text erforderlich geworden ist, ist unter „Topics ⇒ Formular-Prüfungswörterbuch ⇒ 126.01 Korrektur 12“ auf der JPO Homepage zu finden.

[Erneuerungstag: 20.06.2003]

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.../...P. 143

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【Bezeichnung】 Handscanner	⇒ 【Bezeichnung】 Handscanner	⇒ Patentansprüche
【Patentansprüche】	⇒	⇒ 【Anspruch 1】
【Anspruch 1】 Linsensystem...	⇒	Linsensystem...
【Anspruch 2】 Dimension...	⇒	⇒ 【Anspruch 2】
【Beschreibung der Erfindung】	⇒	Dimension...
【0001】	⇒ 【Technisches Gebiet】	⇒ *Angabe dieses Items
【Technisches Gebiet der Erfin- dung】 Die Erfindung betrifft in ...	⇒ 【0001】 Die Erfindung betrifft in ...	ist nicht erforderlich
⇒	⇒	⇒ *Itemname ist geändert.
⇒	⇒	⇒ *Abschnitte werden
⇒	⇒	über das ganze Doku- ment folgerichtig nume- riert.
【0002】	⇒ 【Technischer Hintergrund】	⇒
【Stand der Technik】	⇒ 【0002】	⇒ *Itemname ist geändert.
In der Eingabevorrichtung ...	⇒ In der Eingabevorrichtung ...	⇒
【0003】	⇒ 【0003】	⇒
Aber ist das Teilimage des Doku...	⇒ Aber ist das Teilimage des Doku...	⇒
【Patentliteratur 1】 JP-OS 2000-...	⇒ 【Patentliteratur 1】 JP-OS 2000-...	⇒
【Nicht-Patentliteratur 1】	⇒ 【Nicht-Patentliteratur 1】	⇒
Nach dem Werk von Smith ...	⇒ Nach dem Werk von Smith ...	⇒
⇒	⇒ 【Offenbarung der Erfindung】	⇒
【0004】	⇒ 【Die Aufgabe, die durch Erfindung zu lösen ist】	⇒ * neues Item
【Die Aufgabe, die durch die Erfindung zu lösen ist】	⇒ 【0004】	Vor der Angabe von
Die zu Lösenden Probleme sind ...	⇒ Die zu Lösenden Probleme sind ...	【0004】 bis 【0006】
⇒	⇒	muss zuerst dieses Item
⇒	⇒ 【Mittel zum Lösen der Aufgabe】	geschrieben werden, je- doch direkt danach kann
【0005】	⇒ 【0005】	keine Inhaltsangabe
【Mittel zum Lösen der Aufgabe】	⇒ Die Erfindung, ...	mehr folgen.
Die Erfindung, ...	⇒	⇒
⇒	⇒ 【Wirksamkeit der Erfindung】	⇒
【0006】	⇒ 【0006】	⇒ *Itemname ist geändert
【Wirksamkeit der Erfindung】	⇒ Gemäß der Erfindung ist Scan...	⇒
Gemäß der Erfindung ist Scan...	⇒	⇒
⇒	⇒ 【Beste Form zur Ausführung der Erfindung】	⇒
【0007】	⇒ 【0007】	⇒
【Ausführungsform der Erfindung】	⇒ das Gehäuse ist draußen oder ...	⇒
das Gehäuse ist draußen oder ...	⇒	⇒
⇒	⇒ 【Ausführungsbeispiel 1】	⇒
【0008】	⇒ 【0008】	⇒
【Ausführungsbeispiel 1】	⇒ Abb. 1 zeigt das Gerät nach der ...	⇒
Abb. 1 zeigt das Gerät nach der ...	⇒ 【Ausführungsbeispiel 2】	⇒
⇒	⇒ 【0009】	⇒
⇒	⇒ Das Ausführungsbeispiel 2 ist ...	⇒
⇒	⇒ 【Industrielle Anwendungsmöglich- keit】	⇒
⇒	⇒ 【0010】	⇒
⇒	⇒ Der am Gerät angebrachte Schalter...	⇒
⇒	⇒ 【Kurzbeschreibung der Zeichnun- gen】	⇒
【Kurzbeschreibung der Zeichnun- gen】	⇒ 【0011】	⇒
【Abb.1】 Verwendungsmethode ...	⇒ 【Abb.1】 Verwendungsmethode ...	⇒
【Abb.2】 Zur Erläuterung der ...	⇒ 【Abb.2】 Zur Erläuterung der ...	⇒
⇒	⇒ 【Kurzbeschreibung der Zeichen】	⇒
【Kurzbeschreibung der Zeichen】	⇒ 【0012】	⇒
1, Gehäuse des Handscanners	⇒ 1, Gehäuse des Handscanners	⇒
2. Eingabedatei	⇒ 2. Eingabedatei	⇒

Anmerkung: Gebrauchsmuster ist in gleicher Weise geändert.

Postponement of oral proceedings at the EPO

Letter by I. Wishart (GB)
and Reply by Mr. Kyriakides, Vice President of DG2

I believe that *epi* representatives need to persuade the EPO to change its inflexible (and arrogantly applied) practice on postponement of oral proceedings. In recently reported „Tektronix“ T1080/99, the patentee's representative had a pre-arranged business trip to the Far East; this was considered inadequate reason to justify postponement under the 2000 Notice of the Vice-Presidents. I myself have had to cancel and reschedule oral proceedings in Moscow (at considerable expense) appointed for the same day as oral proceedings in Munich, because of the particular wording of the Notice.

In T1080/99, the Board referred to the need to protect the other party to the proceedings, who will be „affected ...because travel schedules have to be cancelled“.

Recently, the EPO cancelled oral proceedings 14 days before the hearing date. The reason given was that a written response from the Patentee had been placed on the wrong EPO file, and this had not come to the attention of the Opposition Division. Three people from my firm had been booked to travel to Munich on special tickets which were non-refundable. Knowing the EPO's attitude to postponement, cancellation could not reasonably have been expected.

I considered that the EPO should refund our costs, and wrote to request this. No response whatsoever was received. Four weeks later, I wrote again, with identical result. I have since written to the Director of DG-2, P. Kyriakides. A letter from Mr M Fucci, Director of the Contract Law/General Law directorate was received on 1st September, claiming that no liability exists under the German Civil Code, unless „wilful or negligent misconduct on the part of the Office is to be construed as a breach of official duty“. I have responded that the decisions that conclude that omission of a letter from an EPO file is a substantial procedural violation, makes this equivalent to negligent misconduct. This matter still has not been resolved.

Is it not time that *epi* pressed the EPO to be more responsive and accountable to its „customers“?

Reply by Mr. Kyriakides, Vice President of DG2

Mr Wishart mentions an oral proceeding to which he had been invited, but which was subsequently cancelled by the EPO. In March and April this year he wrote letters to the opposition division requesting reimbursement of

the cost of flight tickets. In May he wrote a further letter drawing my attention to the situation and in mid-June received a response from a formalities officer acknowledging this letter. At the same time, the case was transferred to our legal department, DG5, for a decision on Mr Wishart's request. I understand that a reply is currently in preparation and that Mr Wishart can expect to receive a decision on his request at the beginning of August.

I regret the delays in answering Mr Wishart's letters. Normally letters of complaint are answered by the EPO within four to six weeks.

In his email to the *epi*, Mr Wishart criticises the EPO practice with regard to the appointment of oral proceedings.

The current practice is explained in OJ 10/2000 and is designed to enable a maximum number of oral proceedings to be held in a minimum time span, taking into account the organisational complexity owing to the opposition divisions, boards of appeal and parties having various commitments. The EPO does not intend to change this practice, which has been working successfully for more than two years.

With regard to the setting of dates for proceedings, I would point out that invitations are normally issued at least two months in advance, so it is not unreasonable to expect a representative to organise his calendar accordingly.

Once oral proceedings have been appointed, they will only be cancelled on the side of the EPO if there are very serious reasons.

In the application to which Mr Wishart refers, important documents for the oral proceedings were placed in the wrong file and only came to the attention of the opposition division three weeks before the appointed date. The opposition division felt that it would not be appropriate to hold the oral proceedings under the circumstances and decided to cancel them.

It is regrettable that in the case concerned the proceedings had to be cancelled by the EPO at relatively short notice.

The EPO is very much open to the needs of its users and strives to provide a high quality service despite the present high workload. To master its workload the EPO has taken a number of steps, including high recruitment and the streamlining of numerous procedures, one of which is the new system of appointing oral proceedings.

„Das US-Patent“¹ von Richard L. Mayer

H. Bardehle (DE)

Im Deckblatt des deutschsprachigen Kommentars „Das US-Patent“ wird zu recht darauf verwiesen, dass es sich dabei um eine „völlig neue Bearbeitung und erweiterte Auflage“ handelt. Das 585 Druckseiten umfassende Werk mit ausführlichen Stichwort- und Fundstellenverzeichnissen macht es dadurch den in erster Linie mit dem deutschen und europäischen Patentverfahren vertrauten Benutzer leicht, zu Problemen, auf die er während der Behandlung der von ihm verfolgten US-Patentanmeldungen stößt, eine Klärung zu finden. Hierzu trägt erheblich die Einleitung „Zum besseren Verständnis des amerikanischen Patentwesens“ bei, deren Lesen zunächst jedem Benutzer des Buches zu empfehlen ist, da sie von den Autoren offensichtlich aus dem Verständnis für den deutschen Benutzer verfasst worden ist. Der Leser gewinnt Verständnis für das in den USA geltende Erfinderprinzip (first-to-invent), zu dem auch rein in der praktischen Durchsetzung liegende Probleme dargestellt werden. Dies macht auch das im US-Recht geltende Erfordernis der Erfindungshöhe gegenüber dem älteren Recht verständlich, was für eine weltweite Patentharmonisierung ein möglicherweise schwer überwindbares Problem bilden kann. Der Praktiker lernt, wie er sich bei Ablehnung funktioneller Merkmale in Patent-

ansprüchen verhalten kann, um die dort bestehenden Vorurteile zu überwinden und unsere anerkannte Praxis der Verwendung auch funktioneller Merkmale zur Geltung zu bringen. Die anmelderfeindliche **Festo**-Entscheidung des US Supreme Court wird hinsichtlich ihrer Auswirkungen auf den Verletzungsprozess aufgrund der Einbeziehung der Vorgänge im Prüfungsverfahren für die Bewertung von Äquivalenten ausführlich erläutert. Diese Art der Einbeziehung der Vorgeschichte der Patenterteilung kann den herrschenden Widerstand gegen diese Praxis auch im Rahmen des europäischen Patentsystems nur verstärken und ist insofern eine interessante Lehre. Schließlich wird auch die Verantwortung des Anmelders hinsichtlich umgehender Mitteilung von dem Anmelder bekannt gewordenem Stand der Technik an das US-Patentamt erläutert, die ernst genommen werden muss. Am Ende der Kommentierung schließt sich der geltende Gesetzestext an, der insofern eine wichtige Ergänzung der Kommentierung bildet, als er in vielen Zusammenhängen das Verständnis der Kommentierung erleichtert.

Wer sich mit US-Patentanmeldungen befassen muss, dem ist dieser Kommentar eine sehr wertvolle Hilfe.

¹ Carl Heymanns Verlag KG, Köln, 3. Auflage 2003, 585 Seiten, ISBN 3-452-20117-1, 178,00 €

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AT – W. Katschinka AT – P. Révy von Belvard BE – G. Leherte* BE – T. Debled CH – K. Schmauder CZ – M. Guttman DE – W. Fröhling DE – G. Keller** DK – U. Nørgaard ES – V. Gil Vega	FI – P. C. Sundman FR – P. Gendraud FR – J.-P. Kedingen GB – S. Wright GB – G. Szabo GR – T. Kilimiris HU – I. Markó IE – G. Kinsella IT – G. Mannucci	IT – B. Muraca LI – P. Rosenich LU – J. Waxweiler NL – J. de Vries NL – A. Ferguson PT – A. J. Pissara Dias Machado RO – D. Tuluca SE – P. O. Rosenquist SK – M. Majlingová TR – T. Yurtseven
Disziplinausschuss (EPA/epi) epi-Mitglieder	Disciplinary Board (EPO/epi) epi Members	Conseil de discipline (OEB/epi) Membres de l'epi
CH – C.-A. Wavre DE – W. Dabringhaus	FR – M. Santarelli	GB – J. Boff
Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi) epi-Mitglieder	Disciplinary Board of Appeal (EPO/epi) epi Members	Chambre de recours en matière disciplinaire (OEB/epi) Membres de l'epi
CH – C. Bertschinger DE – H. Lichti FR – A. Armengaud Aîné	GB – E. Lyndon-Stanford GR – C. Kaloniarou	IT – E. Klausner SE – C. Onn
epi-Finanzen	epi Finances	Finances de l'epi
AT – P. Pawloy BE – P. Vandersteen CH – T. Ritscher	DE – M. Maikowski DK – K. Vingtoft FR – H. Dupont GB – T. Powell	IT – S. Bordonaro LU – J. P. Weyland* SE – B. Erixon
Geschäftsordnung	By-Laws	Règlement intérieur
CH – C. E. Eder* DE – L. Steiling**	FR – T. Schuffenecker	GB – T. L. Johnson
Standesregeln	Professional Conduct	Conduite professionnelle
AT – E. Kunz AT – E. Piso BE – P. Overath CH – U. Blum DE – H.-H. Wilhelm DE – K. Zimmermann DK – L. Roerboel ES – C. Polo Flores	FI – J. Kupiainen FR – J. Bauvir FR – P. Vidon GB – J. D. Brown* GB – J. Gowshall GR – A. Patrinos-Kilimiris IE – M. Walsh IT – A. Perani	LU – J. Bleyer NL – F. Barendregt NL – F. Dietz PT – N. Cruz PT – F. Magno (Subst.) SE – L. Stolt SE – M. Linderöth TR – K. Dündar TR – E. Dericioglu

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Europäische Patentpraxis	European Patent Practice	Pratique du brevet européen
AT – M. Beer AT – G. Widtmann BE – P. Jacques BE – J. van Malderen CH – W. Bernhardt CH – E. Irniger CY – C. Theodoulou DE – G. Schmitt-Nilson DE – F. Teufel DK – P. J. Indahl DK – P. Stahr	ES – E. Armijo ES – L. A. Duran FI – E. Grew FI – A. Weckman FR – A. Casalonga* FR – J. Bauvir GB – P. Denerley** GB – E. Lyndon-Stanford GR – D. Oekonomidis IE – P. Shortt IE – C. Lane (Substitute) IT – E. de Carli	IT – A. Josif LU – Bruce Dearling NL – W. Hoogstraten NL – L. J. Steenbeek NL – R. Jorritsma (Substitute) PT – P. Alves Moreira PT – N. Cruz SE – A. Bornegård SE – M. Holmberg TR – A. Deris TR – O. Mutlu TR – S. Coral (Substitute)
Berufliche Qualifikation Ordentliche Mitglieder	Professional Qualification Full Members	Qualification professionnelle Membres titulaires
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Stellvertreter Substitutes	Suppléants	
AT – P. Kliment BE – G. Voortmans CH – K. Schwander DE – K. Zimmermann	DK – A. Secher FI – J. Salomäki FR – M. Le Pennec GB – J. Laredo	IT – P. Rambelli NL – A. Hulsebos PT – J. de Sampaio SE – M. Linderöth TR – B. Kalenderli
(Examination Board Members on behalf of the epi)		
CH – M. Seehof	GB – I. Harris GB – S. White	IT – G. Checcacci
Biotechnologische Erfindungen	Biotechnological Inventions	Inventions en biotechnologie
AT – A. Schwarz BE – A. De Clercq* CH – D. Wächter DE – G. Keller DK – B. Hammer Jensen ES – A. Ponti Sales FI – M. Lax	FR – M. Le Pennec FR – J. Warcoin GB – S. Wright GB – C. Mercer** IE – C. Gates IT – G. Staub IT – D. Pieraccioli (Substitute)	NL – J. Kan PT – J. E. Dinis de Carvalho PT – A. Canelas (Substitute) SE – L. Höglund TR – H. Cayli TR – C. Özbay
EPA-Finanzen	EPO Finances	Finances OEB
DE – W. Dabringhaus ES – I. Elosegui de la Pena	FR – S. Le Vaguerèse	GB – J. Boff*
Harmonisierung	Harmonization	Harmonisation
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		NL – F. Dietz
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DE – L. Steiling	IE – D. McCarthy	SE – L. Karlsson
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Wahlausschuss	Electoral Committee	Commission pour les élections
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Interne Rechnungsprüfer	Internal Auditors	Commissaires aux Comptes internes
Ordentliche Mitglieder	Full Members	Membres titulaires
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	Stellvertreter	Substitutes
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