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## Editorial

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

Amid all the recent law changes and proposed regulations, the European Patent Office Official Journal for June 2002 contained a rare event – the publication of a Decision of an Opposition Division. The Decision is an important one because the attitude currently being taken by some Examining Divisions with regard to the disclosure requirements that they believe are now necessary for a Patent Application to be valid.

There are, however, a large number of contentious Opposition Division Decisions issued each year and it is extremely rare for one such as this to be published. The question must arise as to why this particular Decision has been published. A look at the record shows that no Appeal has been filed to the Opposition Decision. Accordingly, one conclusion that may be drawn from this publication is that the Opposition Division made the decision that they did in the hope that their theory of how the law should be applied would be tested by a Board of Appeal. When the losing patentees did not appeal, this hope was removed and, therefore, they decided to publish the Decision in an attempt to get their views more widely known and, presumably, eventually have a Board of Appeal decide on this point in another case.

The position of Examiners in the European Patent Office is a difficult one when it comes to legal points

on which they have no guidance or on which they believe current guidance may be wrong. Examiners have no means of referring any question to a Board of Appeal. Accordingly, the only means by which an Examining Division has of obtaining the views of a Board of Appeal on a contentious point is to refuse an Application or Opposition on just that point and await the filing of an Appeal by the Applicants.

Whilst this approach is understandable from the point of view of the Examining Division, it does seem a little unfair on the Applicant selected to become the guinea pig. An Appeal is a time-consuming and expensive process and it seems a little unfortunate that a form of Russian roulette could be played with businesses in order for an internal query to be resolved within the European Patent Office.

It would be ideal if, in the same way that the President can refer conflicting Decisions of the Boards of Appeal to the large Board of Appeal, that a mechanism could be found for referral of contentious points within Examining Divisions to a body that could give a highly influential decision on those points. Until that happens, however, all Applicants will face the possibility that they will be selected for a test refusal of their case which adds, sadly, to the pitfalls facing potential patentees wishing to progress in the ever-competing commercial world.

Redaktionsschluss für  
epi Information  
4/2002

Redaktionsschluss für die nächste Ausgabe der epi Information ist der **7. November 2002** vorverlegt. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein

Deadline for epi  
Information 4/2002

Our deadline for the next issue of epi Information is **7 November 2002**. Documents for publication should have reached the Secretariat by this date.

Date limite pour epi  
Information 4/2002

La date limite de remise des documents pour le prochain numéro de epi Information est le **7 novembre 2002**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

*We would like to inform our readership that the next issue of epi Information will not be published before February 2003.*

## Bericht über die 52. Ratssitzung in Stockholm 27.-28. Mai 2002

Die 52. Ratssitzung fand am 27. und 28. Mai 2002 in Stockholm statt. Die Sitzung wurde vom amtierenden Präsidenten, Herrn Holzer, eröffnet, der mit einem Nachruf auf Herrn Bernhard Feldmann begann, welcher vor kurzem plötzlich und unerwartet verstorben ist. Herr Feldmann war dem Rat des *epi* lange Jahre eine große Unterstützung.

Dann begrüßte der Präsident die Vertreter der Länder, die dem Institut im Juli beitreten werden, Frau Georgieva-Tabakova aus Bulgarien, Herrn Kania aus der Republik Tschechien und Frau ěchalov aus der slowakischen Republik. Der Vertreter Estlands war leider in letzter Minute verhindert teilzunehmen.

Die Stimmzähler wurden ernannt, die Tagesordnung angenommen und die Ergebnisse der Wahlen zum Rat bestätigt.

Unter Berücksichtigung einiger kleinerer Änderungen wurde das Protokoll der 51. Ratssitzung angenommen. Unter den Angelegenheiten, die sich aus dem Protokoll der letzten Ratssitzung ergaben, war ein Bericht des Präsidenten zu den einzelnen Punkten und auch zur Frage der Veröffentlichung der Ausschussberichte. Es folgte eine längere Diskussion über die derzeitige Situation bezüglich des Vorschlags, dass Europäische Patentanwälte zur Vertretung beim vorgeschlagenen Zentralen Patentgerichtshof berechtigt sein sollten.

Nach einem kurzen Rückblick auf die Beschlüsse und Maßnahmen des Vorstands seit der letzten Ratssitzung legte der amtierende Präsident seinen Bericht vor, der an anderer Stelle in dieser Ausgabe der *epi* Information veröffentlicht ist. Nach dem Bericht des Präsidenten wurden dem Rat auch die Berichte des amtierenden Generalsekretärs und des amtierenden Schatzmeisters vorgelegt.

Die internen Rechnungsprüfer legten ihren Bericht vor, der Haushalt 2001 wurde verabschiedet und der Schatzmeister entlastet.

Der bisherige Vorstand wurde formell entlastet und der neue Vorstand nach einer kurzen Diskussion gewählt. Da sich aus der Türkei zwei Kandidaten bewarben, wählte der Rat Frau Arkan als Vorstandsmitglied für die Türkei. Herr Holzer wurde wieder zum Präsidenten ernannt, Herr Macchetta und Herr Mercer wurden zu Vize-Präsidenten, und Herr Kelly zum Schatzmeister ernannt, Herr Baum wurde Generalsekretär.

Dann wurden die Ausschussmitglieder ernannt. Während der Diskussion über die Ernennung von Ausschussmitgliedern kam noch einmal der Punkt zur Sprache, dass einige Ausschüsse möglicherweise unüberschaubar anwachsen könnten, was insbesondere durch die steigende Anzahl von Ländern verursacht würde, die der Europäischen Patentorganisation beitreten. Der Geschäftsordnungsausschuss wurde mit der Suche nach

möglichen Wegen beauftragt, die Ausschüsse in überschaubarer Größe zu halten.

Anschließend wurde ein Bericht über die Revision der Vorschriften des EPÜ und des Gemeinschaftspatents vorgelegt. Mit Blick auf die Revision des EPÜ wurde berichtet, dass die Ausführungsvorschriften demnächst auf die Website des EPA gestellt werden (was inzwischen geschehen ist). Herr Armijo berichtete über das Vorkommen der Vorschriften zum Gemeinschaftspatent; sein Bericht ist an anderer Stelle in dieser Ausgabe veröffentlicht. Dann wurden die Berichte der Ausschüsse vorgelegt, angefangen beim Bericht des Disziplinausschusses, dessen Hauptthema die Information war, dass der Disziplinausschuss eine Änderung des Disziplinarsystems anstreben würde, da es mit dem derzeitigen System laufend Schwierigkeiten gebe. Dann legte der Ausschuss für berufliche Weiterbildung seinen Bericht vor, der Diskussionen über die finanzielle Seite der vom *epi* veranstalteten Seminare und über die Frage auslöste, ob nationale Patentprüfer die Erlaubnis zum Ablegen der Europäischen Eignungsprüfung erhalten sollten. Am Ende wurde beschlossen, dass der Rat eine Teilnahme nationaler Prüfer an der Europäischen Eignungsprüfung nicht billigte. Nach dem Bericht des Geschäftsordnungsausschusses legte die Schriftleitung ihren Bericht vor. Einen längeren Bericht des EPPC folgten die Berichte des OCC und des Harmonisierungsausschusses. Der Bericht des EPA Finanzausschusses führte zu einer Diskussion über die Bewertungsmethoden des EPA und die Grundlage für die vom EPA vorgelegten Zahlen. Schließlich legte der Ausschuss für Biotechnologie seinen Bericht vor. Eine Zusammenfassung vieler dieser Berichte ist an anderer Stelle in dieser Ausgabe der *epi* Information veröffentlicht.

Im nächsten Bericht über die Arbeitsgruppe Streitregelung wurde informiert, dass wir auf einen neuen vollständigen Text vom Europäischen Patentamt warten. Dann wurde die derzeitige Position bezüglich der Erlaubnis für Europäische Patentanwälte zur Vertretung vor jedem neuen Europäischen Patentgerichtshof diskutiert und Wege besprochen, den Standpunkt des *epi* darzulegen.

Dann erläuterte die Abordnung Großbritanniens im Einzelnen Vorschläge für das Seminar zum 25. Jahrestag des *epi*, das zusammen mit der 53. Ratssitzung in Stratford in Großbritannien stattfinden wird.

Das letzte Thema war ein mündlicher Bericht über die Zusammenarbeit mit einer Anzahl weiterer Organisationen, der an anderer Stelle in dieser Ausgabe der *epi* Information steht. Dies führte zu einer Diskussion über einen vorgeschlagenen CEIPI Kurs über Patentstreitigkeiten, den das *epi* sehr befürwortet.

Die nächsten Ratssitzungen werden am 5. und 6. Mai 2003 in Gent und im Oktober 2003 in Frankreich stattfinden.

Zuletzt wurde über die *epi* Broschüre (Patente in Europa) diskutiert. Man kam überein, dass der Text der Broschüre auf die *epi* Website gestellt werden soll und

dass die gedruckten Exemplare in erster Linie zur Verbesserung der Bekanntheit verwendet werden sollen.

Die wie immer lebhaft und interessante Sitzung war am 28. Mai 2002 gegen Mittag beendet.

Die Schriftleitung

## Entwurf der Ratsbeschlüsse, 52. Ratssitzung in Stockholm 27.-28. Mai 2002

1. Der Haushalt 2001 wurde genehmigt und dem Schatzmeister Entlastung erteilt.
2. Dem amtierenden Vorstand wurde Entlastung erteilt.
3. Die nachfolgend aufgelisteten Mitglieder wurden zu Vorstandsmitgliedern gewählt:
 

Präsident	Herr Walter HOLZER (AT)
Vize-Präsident	Herr Francesco MACCHETTA (IT)
Vize-Präsident	Herr Chris MERCER (GB)
Generalsekretär	Herr Wolfgang BAUM (DE)
Schatzmeister	Herr Peter KELLY (IE)
Stellvertr.	
Generalsekretär	Frau Susanne KAMINSKI (LI)
Stellvertr.	
Schatzmeister	Herr Claude QUINTELIER (BE)

Weitere Mitglieder:

  - Frau Selda ARKAN (TR)
  - Herr Enrique ARMIJO (ES)
  - Herr Ejvind CHRISTIANSEN (DK)
  - Herr Frans DIETZ (NL)
  - Herr Henri DUPONT (FR)
  - Herr Kim FINNILÄ (FI)
  - Herr Terry JOHNSON (GB)
  - Herr Theophilos MARGELLOS (GR)
  - Herr Laurent NUSS (FR)
  - Herr João PEREIRA DA CRUZ (PT)
  - Herr Zaid SCHÖLD (SE)
  - Herr Thierry SCHUFFENECKER (MC)
  - Herr Michel SEEHOF (CH)
  - Herr Dieter SPEISER (DE)
  - Herr Christos A. THEODOULOU (CY)
  - Herr Pierre WEYLAND (LU)
4. Der Rat genehmigte die Wahl von höchstens zwei Mitgliedern pro Land in den Ausschuss für Europäische Patentpraxis.
5. Der Rat genehmigte die Ernennung der für die verschiedenen Ausschüsse vorgeschlagenen Mitglieder sowie der internen Rechnungsprüfer wie in Anlage 5 angegeben.
6. Präsident HOLZER und sein Beratergremium, bestehend u.a. aus den Herren CASALONGA, MACCHETTA und MARGELLOS, werden für die Arbeitsgruppe Streitregelung (WPL) ein neues Positionspapier des *epi* zur Vertretung bei EPLP Gerichten erstellen.
7. Der Rat nahm einen Änderungsvorschlag zu Regel 6 der Ausführungsbestimmungen zu den Vorschriften über die Europäische Eignungsprüfung an, und zwar sollen 1) Einzelheiten der Korrektur in den Korrekturblättern enthalten sein und 2) die Antwort- und Korrekturblätter sollen allen Kandidaten zugeschickt werden.
8. Der Rat stimmte mit großer Mehrheit gegen den Vorschlag des Präsidenten des INPI, Herrn HANGARD, Prüfern nationaler Patentämter das Ablegen der Europäischen Eignungsprüfung zu genehmigen.
9. Der Rat genehmigte, dass die Schriftleitung bei der Neuerstellung des Deckblattes der *epi* Information professionelle Unterstützung erhalten solle.
10. Der Rat genehmigte die Kosten in Verbindung mit den Änderungen der Website.
11. Der Rat genehmigte, dass dem EPA ein Brief geschickt wird mit der Forderung, dass die Nummerierung der Paragraphen in Europäischen Patenten keinen Einfluss auf die Auslegung des Schutzzumfangs haben soll.
12. Der Rat genehmigte den Austausch von „DM“ durch „EUR“ im Beschluss von 1991 in Beaune (*epi* 5.3).

## Report of the 52<sup>nd</sup> Council Meeting in Stockholm 27-28 May 2002

The fifty-second Council Meeting took place in Stockholm on 27 to 28 May 2002. The meeting was opened by the President in office, Mr. Holzer, who commenced the meeting by paying tribute to Mr. Bernhard Feldmann, who had suddenly and unexpectedly died recently. Mr. Feldmann had been a great contributor to the *epi* Council for many years.

The President then welcomed representatives of the countries that would be joining the Institute in July, which representatives were Mrs. Georgieva-Tabakova from Bulgaria, Mr. Kania from the Czech Republic and Mrs. Cechvalová from the Slovak Republic. Regrettably, the representative from Estonia was unable to attend at the last minute.

The scrutineers were appointed, the agenda adopted and the results of the elections to Council were confirmed.

Following a request for minor amendments, the minutes of the fifty-first Council Meeting were approved. With regard to matters arising from the minutes of the previous Council Meeting, there was a report from the President on the individual issues and also on the question of publication of Committee reports. There was then an extended discussion of the current situation regarding proposed representation by European Patent Attorneys at the proposed Central European Patents Court.

Following a brief review of the decisions and measures taken by the Board since the last Council Meeting, the President in Office gave his report, which is published elsewhere in this edition of *epi* Information. Subsequent to the President's Report, the Reports of the Secretary General in Office and the Treasurer in Office were also provided to the Council.

The Internal Auditors gave their report and the Treasurer's Report in the 2001 accounts were approved and the Treasurer discharged.

The previous Board was formally discharged and, after a brief discussion, the new Board was elected. Following the submission of two candidates from Turkey, a vote was taken in the Council to appoint Mrs. Arkan as the Turkish Representative on the Board. Mr. Holzer was re-appointed as President and the Vice Presidents were appointed as Mr. Macchetta and Mr. Mercer. Mr. Baum was appointed as Secretary General, and Mr. Kelly was re-appointed as Treasurer.

Committee Members were then appointed. During the discussion of the appointment of Committee Members, the point was raised, yet again, as to the potentially unwieldy size of some of the Committees, particularly given the increase in number of countries joining the European Patent Organisation. Eventually, the By-Laws Committee were charged to re-investigate

potential ways of maintaining the Committees with manageable numbers.

A report was then given as to the revision of the EPC and Community Patent Regulations. With regard to the revision of the European Patent Convention, it was reported that the Implementing Regulations would be published soon on the EPO web site (this has now taken place). Mr. Armijo reported on the Community Patent Regulation progress to date and Mr. Armijo's report appears elsewhere in this edition. The reports of the Committees were then taken commencing with the report of the Disciplinary Committee the main feature of which was the indication that the Disciplinary Committee would investigate amendment of the Disciplinary System in view of current difficulties implementing that system. The Professional Qualification Committee then reported, the report of which led to some discussion of both the finances of the seminars being organised by the *epi* and the question whether national patent examiners should be allowed to take the European Qualifying Examination. In the end it was agreed that Council did not approve of National Examiners sitting the European Qualifying Examination. Following the report of the By-Laws, the Editorial Board presented their report. A lengthy report by the EPPC was followed by the OCC and Harmonisation Committees. The EPO Finances Committee Report led to discussion of EPO evaluation methods and the basis for the figures provided by the EPO. Finally the Biotechnology Committee provided their report. A summary of many of these reports may be found elsewhere in this edition of *epi* information.

The next report related to the Working Party on Litigation in which it was indicated that we are awaiting a new full text from the European Patent Office. The current position with regard to the possibility of European Patent Attorneys being allowed representation in any new European Patents Court was discussed further and ways of presenting the *epi* position were explored.

Subsequently the UK delegation provided proposed details of the twenty-fifth anniversary of the *epi* seminar to be held alongside the fifty-third Council Meeting in Stratford in the United Kingdom.

The final matter of substance was an oral report of co-operation with a number of other bodies, a report of which will be found elsewhere in this edition of *epi* Information. This led to a discussion with regard to a proposed CEIPI Patent Litigation Course of which the *epi* is very much in favour.

The next Council Meetings were agreed to be arranged as 5 and 6 May 2003 in Ghent in October 2003 in France.

Finally, under any other business, a discussion of the *epi* brochure (Patents in Europe) took place. It was

agreed that the text of this brochure would be placed on the *epi* web site and that the paper stocks of the brochure should be used primarily as promotional tools.

The meeting closed at lunch time on 28 May 2002 and, as usual, a lively and interesting debate had taken place.

The Editorial Board

## Draft List of Decisions, 52<sup>nd</sup> Council Meeting, Stockholm 27-28 May 2002

1. The 2001 accounts were approved, and the Treasurer was discharged from liability.
2. The Board in office was discharged from liability.
3. The following members were elected Board members:
 

President	Mr. Walter HOLZER (AT)
Vice-President	Mr. Francesco MACCHETTA (IT)
Vice-President	Mr. Chris MERCER (GB)
Secretary General	Mr. Wolfgang BAUM (DE)
Treasurer	Mr. Peter KELLY (IE)
Deputy Secretary General	Mrs. Susanne KAMINSKI (LI)
Deputy Treasurer	Mr. Claude QUINTELIER (BE)

Further members:

Mrs. Selda ARKAN (TR)  
 Mr. Enrique ARMIJO (ES)  
 Mr. Ejvind CHRISTIANSEN (DK)  
 Mr. Frans DIETZ (NL)  
 Mr. Henri DUPONT (FR)  
 Mr. Kim FINNILÄ (FI)  
 Mr. Terry JOHNSON (GB)  
 Mr. Theophilos MARGELLOS (GR)  
 Mr. Laurent NUSS (FR)  
 Mr. João PEREIRA DA CRUZ (PT)  
 Mr. Zaid SCHÖLD (SE)  
 Mr. Thierry SCHUFFENECKER (MC)  
 Mr. Michel SEEHOF (CH)  
 Mr. Dieter SPEISER (DE)  
 Mr. Christos A. THEODOULOU (CY)  
 Mr. Pierre WEYLAND (LU)
4. Council approved the election of a maximum of 2 members per country in the EPPC.
5. Council approved the appointment of the proposed members to the various Committees, as well as of the internal auditors, as reflected in Annex 5.
6. A new *epi* position paper on Representation before the EPLP Courts will be drafted for the (full) Working Party on Litigation by President HOLZER and his Advisory Committee, consisting inter alia of Messrs. CASALONGA, MACCHETTA and MARGELLOS.
7. Council approved a proposal for amendment to Rule 6 of the Implementing provisions to the Regulation on the EQE, i.e. 1) details of the marking shall be contained on the marking sheets and 2) the answers and marking sheets shall be sent to all candidates.
8. Council voted by a large majority against the proposal of the President of the INPI, Mr. Hangard, to allow national patent office examiners to take the European Qualifying Examination.
9. Council approved the Editorial Board obtaining professional assistance in re-designing the cover of *epi* Information.
10. Council approved the costs in connection with the changes in the web site.
11. Council approved sending a letter to the EPO to request that the paragraph numbering in European patents should have no influence on the interpretation of the scope of protection.
12. Council approved the substitution of „EUR“ for „DEM“ in the 1991 Beaune decision (*epi* 5.3).

## Compte rendu de la 52<sup>ème</sup> réunion du Conseil à Stockholm 27-28 mai 2002

La 52<sup>ème</sup> réunion du Conseil de l'*epi* s'est tenue à Stockholm les 27 et 28 mai 2002. La session fut ouverte par le Président en fonction, M. Holzer, qui invite le Conseil à observer une minute de silence à la mémoire de M. Bernhard Feldmann, décédé subitement peu avant la réunion du Conseil. M. Feldmann a beaucoup contribué, pendant de nombreuses années, au travail du Conseil.

Puis le Président adresse la bienvenue aux représentants des nouveaux pays qui deviendront membres de l'Institut à partir du mois de juillet, à savoir Mme Georgieva-Tabakova de Bulgarie, M. Kania de la République tchèque et Mme Cechvalová de la République slovaque. En raison d'un empêchement de dernière minute, le représentant d'Estonie n'a malheureusement pu être présent.

L'adoption de l'ordre du jour se poursuit avec la nomination des scrutateurs. Les résultats de l'élection au Conseil sont validés.

Après quelques amendements mineurs, le compte rendu de la 51<sup>ème</sup> réunion du Conseil est approuvé. Le Président fait un rapport sur les questions relevant du compte rendu de la dernière réunion, et commente entre autres la question de la publication des rapports de commissions. Un débat s'engage sur la question de la représentation des mandataires européens devant un Tribunal européen pour brevets centralisé.

Après avoir rappelé les décisions et mesures prises par le Bureau depuis la dernière réunion du Conseil, le Président présente son rapport, lequel est publié dans ce numéro de *epi* Information. Puis le Secrétaire Général et le Trésorier en fonction présentent leur rapport.

A la suite du rapport des Commissaires aux comptes internes le rapport du Trésorier ainsi que les comptes pour l'exercice 2001 sont approuvés. Quitus est donné au Trésorier.

Le Bureau sortant reçoit le quitus, puis après une brève discussion le nouveau Bureau est élu. Deux candidats s'étant portés candidats comme membre du Bureau pour la Turquie, la décision est mise au vote et le Conseil élit Mme Arkan. M. Holzer est réélu dans ses fonctions de Président, MM. Macchetta et Mercer sont élus Vice-Présidents, M. Baum Secrétaire Général, et M. Kelly est réélu dans ses fonctions de Trésorier.

Le Conseil procède ensuite à l'élection des membres des commissions. La question de la limitation des effectifs des commissions est à nouveau soulevée, particulièrement en raison de l'élargissement de l'Organisation européenne des brevets. La Commission du Règlement Intérieur est invitée à réexaminer les mesures à prendre pour permettre le bon fonctionnement des commissions.

Un rapport est ensuite présenté sur la révision de la Convention sur le brevet européen (CBE) et sur la Réglementation du Brevet Communautaire. En ce qui

concerne la révision de la CBE, il est précisé que le Règlement d'exécution devrait être publié sous peu (ce qui est fait à l'heure actuelle). M. Armijo présente son rapport sur la Réglementation du Brevet Communautaire, lequel est publié dans cette édition. Les rapports de la Commission de discipline et des autres commissions sont présentés. La Commission de discipline envisagerait favorablement des amendements au système disciplinaire en raison des difficultés rencontrées, inhérentes au système. A la suite du rapport de la Commission de Qualification Professionnelle un débat s'engage sur l'aspect financier des séminaires organisés par l'*epi* ainsi que sur la question de savoir si des examinateurs des offices de brevets nationaux devraient être autorisés à se présenter à l'examen européen de qualification. Finalement, le Conseil vote contre cette proposition. Puis suivent les rapports de la Commission de Règlement Intérieur et du Comité de Rédaction. Un rapport détaillé de la Commission EPPC fait suite au rapport de la Commission OCC et à celui de la Commission d'Harmonisation. Le rapport de la Commission des Finances de l'OEB ouvre le débat sur les méthodes d'évaluation de l'OEB et sur la base des chiffres publiés par l'OEB. La Commission pour les inventions en biotechnologie présente son rapport. Un résumé de la plupart de ces rapports est publié dans ce numéro de *epi* Information.

Le rapport sur le groupe de Travail Contentieux indique que l'OEB doit proposer un nouveau texte complet. La discussion porte sur la question de la représentation des mandataires européens devant les tribunaux européens pour brevets ainsi que sur la manière de présenter la position de l'*epi*.

La délégation britannique donne ensuite des informations sur le colloque organisé à l'occasion du 25<sup>ème</sup> anniversaire de l'*epi* à Stratford-upon-Avon en Grande Bretagne.

Celui-ci précèdera la 53<sup>ème</sup> réunion du Conseil.

La coopération avec un grand nombre d'autres organisations est évoquée dans un dernier rapport oral et présentée dans un rapport publié dans cette édition. Cette question conduit à un débat sur le projet proposé par l'*epi* d'organiser, en collaboration avec le CEIPI, un nouveau cours sur les procédures judiciaires.

Les prochaines réunions du Conseil se tiendront les 5 et 6 mai 2003 à Gand, et en octobre 2003 en France.

La réunion se termine avec une brève discussion sur la brochure de l'*epi* (Brevets en Europe). Il est convenu que le texte de la brochure sera placé sur le site Internet de l'*epi* et que les stocks d'exemplaires seront utilisés principalement à des fins promotionnelles.

La réunion est close le 28 mai 2002 à midi.

Le Comité de Rédaction

## Projet de liste des décisions, 52<sup>ème</sup> réunion du Conseil, Stockholm 27-28 mai 2002

1. Les comptes pour l'exercice 2001 sont approuvés et quitus est donné au Trésorier.
2. Le Bureau sortant reçoit le quitus.
3. Les membres suivants sont élus au Bureau:
 

Président	M. Walter HOLZER (AT)
Vice-Président	M. Francesco MACCHETTA (IT)
Vice-Président	M. Chris MERCER (GB)
Secrétaire	
Général	M. Wolfgang BAUM (DE)
Trésorier	M. Peter KELLY (IE)
Secrétaire	
Général Adjoint	Mme Susanne KAMINSKI (LI)
Trésorier Adjoint	M. Claude QUINTELIER (BE)

Autres membres:

  - Mme Selda ARKAN (TR)
  - M. Enrique ARMIJO (ES)
  - M. Ejvind CHRISTIANSEN (DK)
  - M. Frans DIETZ (NL)
  - M. Henri DUPONT (FR)
  - M. Kim FINNILÄ (FI)
  - M. Terry JOHNSON (GB)
  - M. Theophilos MARGELLOS (GR)
  - M. Laurent NUSS (FR)
  - M. João PEREIRA DA CRUZ (PT)
  - M. Zaid SCHÖLD (SE)
  - M. Thierry SCHUFFENECKER (MC)
  - M. Michel SEEHOF (CH)
  - M. Dieter SPEISER (DE)
  - M. Christos A. THEODOULOU (CY)
  - M. Pierre WEYLAND (LU)
4. Le Conseil approuve que deux personnes par pays au maximum soient nommées à la Commission EPPC.
5. Le Conseil approuve la nomination des membres proposés pour les commissions ainsi que celle des commissaires aux comptes internes (voir annexe 5).
6. Une nouvelle prise de position sur la représentation devant les tribunaux EPLP sera préparée par le Président HOLZER et son comité consultatif comprenant entre autres MM. CASALONGA, MACCHETTA et MARGELLOS. Elle sera présentée au Groupe de Travail (complet) „Contentieux“.
7. Le Conseil approuve la proposition d'amendement à la Règle 6 des dispositions d'exécution du règlement relatif à l'examen européen de qualification, à savoir 1) le détail de la notation figurera sur la feuille de notation et 2) les réponses et feuilles de notation seront envoyées à tous les candidats.
8. Le Conseil vote à une forte majorité contre la proposition du Président de l'INPI, M. Hangard, d'autoriser des examinateurs des offices de brevets nationaux à se présenter à l'examen européen de qualification.
9. Le Conseil approuve que le Comité de Rédaction s'adresse à un professionnel pour un projet de nouvelle couverture de *epi* Information.
10. Le Conseil approuve les frais qui devront être engagés pour effectuer les modifications nécessaires sur le site Internet de l'*epi*.
11. Le Conseil approuve l'envoi d'un courrier à l'OEB pour demander que la numérotation des paragraphes dans les brevets européens n'ait pas d'incidence sur l'interprétation de l'étendue des revendications.
12. Le Conseil approuve que „EUR“ soit substitué à „DEM“ dans la décision prise à Beaune en 1991(*epi* 5.3).

## President's Report (covering October 2001 to May 2002)

W. Holzer (AT)

The President reported that the ASEAN annual meeting to which he had been invited took place on October 20-23, 2001, thus colliding with the *epi* Council meeting. He therefore had asked Board member Joao da Cruz to represent the *epi*.

In November 2001, on an invitation from FICPI/AIPLA he participated in a Symposium on Pendency Reduction in Rome, where he presented a paper. The President of the EPO, Mr. Kober, as well as various National Patent Office Presidents and delegates from national associations took part in the event which mainly dealt with workload strategies.

Secretary General Zellentin and the President attended the final RIPP (Regional Industrial Property Program) Session in Bucharest in November 2001. Representations from all of the New Countries as well as a WIPO delegate gave an appreciation of the Program. The President contributed the viewpoint of the *epi*.

In December 2001 at the Paris CEIPI Board Meeting he presented the *epi*'s plan to introduce a CEIPI course for the further training of European Patent Attorneys as concerns patent litigation procedures in Europe, with particular emphasis on the envisaged new Patent Courts. A concrete proposal for a syllabus will now be drafted.

A first Round Table Conference concerning the Community Patent took place at the EPO in Munich on December 5, 2001 for the EPO staff. The President presented the view of *epi*, inter alia the need for embedding the Community Patent in the EPC without subcontracting, common rules of procedure, applicants' freedom of choice until the end of the proceedings etc.

On December 6, 2001, a similar Round Table Conference was arranged in The Hague with slightly different participants. The attendance was more numerous even than in Munich. The Round Table Conference reassured the staff that all participants supported the idea of dealing with the Community Patent within the EPO and that therefore all efforts should be undertaken to reduce pendency times in the EPC system.

The meeting of the sub-group of the Working Party on Litigation in December was mainly attended by Vice-President Macchetta and dealt with the latest draft of the proposed treaty, which should be finalised by the end of 2002.

In December 2001 the Administrative Council of the EPO met in Munich, attended by Vice-President Le Vaguerèse and the President as observers. The Belgium delegation gave an oral report on the Revision of the EPC, i.e. the envisaged Diplomatic Conference which

would have been necessary to accommodate the Community Patent Regulation, and which will now not take place. There was also an oral report of the Chairman of the ad hoc *epoline*<sup>®</sup> Working Party. An exhaustive meeting had been arranged and taken place between the *epoline*<sup>®</sup> staff and the *epi* Online Communications Committee. The Administrative Council gave a favourable opinion on the medium-term business plan. Productivity results were also presented. Finally, the recruitment procedure for new Vice-Presidents DG1 and DG 6 was agreed on. Also, the amendment of Rule 29(2) EPC was approved.

In February 2002, at the annual conference with the EPO President and his management staff matters of mutual concern and interest were discussed, such as the future of the EPLP, the situation of biotechnology, the *epi* 25<sup>th</sup> Anniversary Seminar, a conference for the new countries, the status on the Community Patent.

In March 2002 another Administrative Council Meeting took place in Munich, which again was attended by Vice-President Le Vaguerèse and the President as observers. This meeting inter alia dealt with the basics for the election of the next EPO President and in this context questions of management and policies. The vote on two new Vice-Presidents was deferred to the June meeting. The debate also evidenced that there is concern about any change of the EPO centralised procedures, which concern is shared by the *epi*.

The FICPI ExCo in the U.S.A., in March 2002 was attended on the President's behalf by Board member Terry Johnson.

At the Board meeting in Strasbourg, in March 2002, the *epi* officers had a meeting with the representatives from the French associations, both industry and free profession (ACPI, ASPI and CNCPI), to discuss matters of mutual interest.

Upon an invitation by the European Commission/EPO the President represented the *epi* at an International Symposium on Networking of Training Centres & Courts in Bangkok in April 2002, in which IP judges of six Asean countries participated.

In May 2002, the VPP Conference in Ludwigsburg gave an opportunity for discussion with *epi* members from the German industry. Also in May 2002, a special Seminar organised by the EPO for members of the accession states took place in Berlin in collaboration with the *epi*. Another Seminar took place in Belgrade for the local profession, also with participation of the President and of *epi* members as speakers.

## Treasurer's Report

P. Kelly (IE)

The annual accounts to December 31, 2001 have been finalised and a copy of the audited accounts in Euro is enclosed.

The audited results for the year 2001 show a surplus of income over expenditure of E 146990 against a budgeted loss of E 25565. The surplus was achieved by an increase in income over budget of E 59017 and a saving in expenditure on budget of E 113533.

The main items of income over budget were an investment profit of E 13594, interest E 16200 and CPE seminars E 14827. On the expenditure side, the main savings on budget were as follows:-

Committee Meetings	E 32211
Delegate expenses	E 20452
Non-foreseeable	E 11248
Promotional activity	E 10226
Secretariat costs	E 37978

Council should note that the cost of both Council Meetings and Board Meetings marginally exceeded Budget costs. The apparent saving on rent E 7761 is the result of a policy change on the payment date of the rent – which gave the financial result that 2001, from a rent position, was an eleven month year.

It is not proposed to make any recommendations at this time to Council to revise the budget 2002. In this transition year, where the estimate of new membership numbers is fluid and where we are experiencing some unexpected computer problems resulting in a delay in processing the accounts for 2002, deferment of any budget revisions until the autumn appears prudent.

The *epi* have recently made a medium term investment of E 400,000 with Dresdner Bank. The investment will mature in February 2005 and is expected to show a return of 4.5% per annum. The value of the *epi* investment portfolio now stands at E 1.44 million.

### *epi* Excess Liability Insurance 2002/2003

On 1 October 2002 the *epi* Excess Liability Insurance scheme will go into its fourteenth year of existence. It aims to give better insurance coverage at a reasonable price to *epi* members.

The indemnity of basic professional liability insurance schemes is often limited to DM 2 million/ EUR 1.022.584. Therefore, the *epi* Excess Liability Insurance scheme indemnifies losses as far as they exceed DM 2million/EUR 1.022.584/equivalent. Its limit of indemnity is a further DM 3 million/EUR 1.533.876 per loss so that – together with basic insurance – a total loss of DM 5 million/EUR 2.556.40/equivalent is covered.

There is a collective indemnity limit to DM 30 million/EUR 15.338.756 p.a. for all participating *epi* members which according to insurance calculations will hardly be reached. The premium for the *epi* Excess Liability Insurance scheme for the insurance year 2002/2003 amounts to EUR 383,47 plus legal insurance tax.

Persons wishing to join the *epi* insurance policy should directly contact the broker, Funk GmbH, for all policy matters, application forms etc., and payments. Please make your payments to the broker's account mentioned hereafter, free of bank charges, indicating the following reference „*epi* insurance 01

0047425000“ (this is the *epi* client number with the broker) as well as your name.

*epi* invites each member to carefully consider joining the *epi* Excess Liability Insurance scheme since clients' claims may easily reach the sum of DM 5 million/EUR 2.556.460 They may ruin your economic and professional situation if no adequate insurance cover is provided for. The *epi* Excess Liability Insurance scheme improves your insurance cover at a reasonable price and provides insurance cover for you as an *epi* member in all nineteen EPC contractual countries regardless of where you exercise your profession.

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

Funk International GmbH  
Postfach 30 17 60  
D-20306 Hamburg  
Phone: +49 40 3 59 14-4 57  
Fax: +49 40 3 59 14-5 59  
Att: Mrs. T. Zacharias

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

## epi Balance Statement on 31st December 2001

### Assets

	E	previous year (thousand) E
<b>A. Fixed assets</b>		
I. Tangible assets	-51	—
Office machines and equipment		
II. Financial assets	<u>1.071.156,95</u>	<u>1.196</u>
Securities portfolio		
<b>B. Receivables</b>		
I. Others current assets	<u>57.479,65</u>	<u>55</u>
II. Bank & Cash (incl. money deposits)	<u>577.511,56</u>	<u>288</u>
	 <u>1.706.148,67</u>	 <u>1.539</u>

### Liabilities

	E	previous year (thousand) E
<b>A. Net assets</b>		
as of 01.01.2001	1.398.937,50	1.367
results for the year	<u>146.985,36</u>	<u>32</u>
	 1.545.922,86	 1.399
as of 31.12.2001	1.545.922,86	1.399
<b>B. Debts</b>		
I. Provisions	29.859,45	20
II. Liabilities		
1. Bank loans	13.346,90	—
2. Deliveries and services	3.862,62	21
3. Others	<u>113.156,84</u>	<u>99</u>
	<u>130.366,36</u>	<u>120</u>
	 <u>1.706.148,67</u>	 <u>1.539</u>

## Expenses and Income for the period from 1 January to 31 December 2001

<i>epi</i> Expenses and Income 2001						
	Budget 2000	Actual 2000	Budget 2001	Actual 2001	Shortfall in receipts Surplus of expenditure 2001	Surplus of receipts Shortfall in expenditure 2001
	E	E	E	E	E	E
<b>I. Receipts/Income</b>						
1. from Members						
a. Subscriptions	935.664,14	928.327,10	951.002,90	961.228,74	./.	10.225,84
b. Abandonment of unpaid subscriptions	./.	./.	./.	./.	13.259,11	-, -
2. Interests	58.798,57	61.795,39	61.355,03	77.555,69	-, -	16.200,66
3. CPE-Seminars	-, -	-, -	-, -	27.046,33	-, -	27.046,33
4. Others	<u>21.474,26</u>	<u>33.713,57</u>	<u>20.451,68</u>	<u>39.255,-</u>	<u>-, -</u>	<u>18.803,32</u>
	<u>993.695,77</u>	<u>981.068,62</u>	<u>1.012.357,93</u>	<u>1.071.374,97</u>	<u>./.</u>	<u>72.276,15</u>
<b>II. Expenses</b>						
1. Meetings						
Council	194.290,92	161.672,04	204.516,75	206.358,01	1.841,26	-, -
Board	35.790,43	35.076,86	35.790,43	37.716,29	1.925,86	-, -
Committees	138.048,81	124.464,33	144.695,60	112.511,14	-, -	32.184,46
Delegates & Others	76.693,78	43.691,98	56.242,11	35.403,19	-, -	20.838,92
2. Special performances						
<i>epi</i> Information	46.016,27	47.669,03	57.264,69	51.810,92	-, -	5.453,77
By-Laws & non-foreseeable	3.067,75	-, -	12.271,01	815,50	-, -	11.455,51
ECC-Letter	51.129,19	26.883,52	1.022,58	2.827,92	1.805,34	-, -
Promotional activities (incl. <i>epi</i> -Brochure)	20.451,68	17.585,36	16.872,63	6.785,46	-, -	10.087,17
CPE-Seminars	-, -	-, -	2.556,46	12.189,03	9.632,57	-, -
Examination Committee Dinner	-, -	-, -	7.669,38	2.443,76	-, -	5.225,62
3. President (+ Vice President)	25.564,59	31.153,95	30.677,51	25.034,90	-, -	5.642,61
4. Treasurer and Treasury						
Treasurer and Deputy	6.646,79	4.309,68	6.646,79	4.387,11	-, -	2.259,68
Bookkeeping / Audit	12.782,30	10.312,64	12.782,30	11.523,34	-, -	1.258,96
Bank charges	9.203,25	8.122,04	8.180,67	8.767,81	587,14	-, -
5. Secretariat						
Expenditure on personnel	256.668,52	252.914,98	265.871,78	254.305,32	-, -	11.566,46
Expenditure on materials						
Rent	93.055,12	81.104,47	81.295,41	73.533,74	-, -	7.761,67
Phone, Fax, e-mail	7.158,09	5.650,61	7.158,09	5.565,82	-, -	1.592,27
Postage	25.564,59	23.179,51	30.677,51	23.973,18	-, -	6.704,33
Copy, print	15.338,76	15.942,07	15.338,76	14.981,32	-, -	357,44
Office supplies/Representation	11.759,71	11.809,81	15.338,76	10.574,80	-, -	4.763,96
Maintenance/Repair	3.067,75	1.953,65	3.067,75	7.190,15	4.122,40	-, -
Insurances	1.533,88	297,67	511,29	872,98	361,69	-, -
Secretary General and Deputy	2.556,46	696,23	2.556,46	3.149,38	592,92	-, -
Travel personnel	1.533,88	331,59	1.022,58	494,48	-, -	528,10
Training	2.556,46	118,62	1.533,88	255,65	-, -	1.278,23
Acquisitions						
Office machines incl. Soft-/Hardware	3.067,75	6.055,43	10.225,84	7.055,68	-, -	3.170,16
Office equipment	30.677,51	38.058,68	6.135,50	802,73	-, -	5.332,77
6. Extraordinary expenses	2.556,46	145,72	-, -	3.060,-	3.060,-	-, -
	<u>1.076.780,70</u>	<u>949.200,47</u>	<u>1.037.922,52</u>	<u>924.389,61</u>	<u>23.929,18</u>	<u>137.462,09</u>
<b>III. Surplus of receipts/expenses</b>	<u>./.</u>	<u>31.868,15</u>	<u>./.</u>	<u>146.985,36</u>	<u>Surplus:</u>	<u>172.549,95</u>

## Report of the Committee on Biotechnological Inventions

B. Hammer Jensen (DK)  
Chairman

### Introduction

Since the last Council meeting in Lugano in October 2001, the Committee has not held any meeting. Communications and information about international developments in the biotech field have been exchanged by the use of e-mail.

The specific issues discussed have been:

### EU Directive on the legal protection of biotechnological inventions

The status of the implementation process is still being monitored quite extensively. The present situation has fortunately changed a little bit since the last report, because two more countries, Greece and Spain, have implemented the directive, bringing the number of countries that have done so to six. Also, the change in Government in Norway has now opened for the possibility that Norway will implement in 2002 or 2003, while the situation in Switzerland and Lichtenstein is still quite open. On the negative side, the Government of Luxembourg has invited the Commission to renegotiate the directive, and Italy failed an attempt to implement because the Government decided to withdraw the proposed legislation just before it was scheduled for vote in the Parliament. Sweden is expected passed the proposed legislation in the next parliamentary season without major problems, and it is also hoped that Austria and Portugal will implement within a year. Unfortunately the situation in France, Belgium, Holland and Germany is still very problematic and expected to remain so for some time. Members of the committee report at intervals on the progress of the implementation process in their respective member states.

In Germany the discussion about the scope of gene patents is continuing. Prof. Straus of the Max-Planck Institute has made the suggestion that the inventive step of inventions related to chemical compounds should be evaluated differently from what is practised today, namely in a two-step process, whereby first one has to assess whether the product as such, without consideration of its properties, is inventive, then one has to assess whether the use of such product is inventive. Only in cases where the product as such is inventive the absolute product protection would be justified. The argument is in the majority of cases the product/sequence is not inventive since it will be provided by machines. This is in conflict with the present German, European and international practice and case law. Presently a new product is

considered as inventive if the inventor discovered improved/useful/unexpected properties of the product

The Committee noted with approval that the Commission now has issued its 2<sup>nd</sup> warning letter to those Member States that have not yet implemented. Also, the Commission will issue an explanatory/interpretative note expected in June or July. However, rumours are that this note may contain restrictive modifications to the scope of patents for inventions related to genes. It may be that this is inspired by the debate in Germany, and the Committee will certainly enter into discussions with the EPO on this subject, if a study of the Commission report makes this appropriate.

### EPO Guidelines

The Committee was asked to comment a proposal to amend the Guidelines as a consequence of decision T 964/99 relating to the evaluation of the Art. 52.4 exception for inventions relating to diagnostic methods performed on the human or animal body. The Committee recommended that no amendment should be made until the issue had been considered by the Enlarged Board of Appeal. Later it has become known that this issue will not at present be referred to the Enlarged Board of Appeal.

### Actions from last Council Meeting

#### *EPO political statements*

At the Council meeting in Lugano, Council approved that the Committee could take a number of actions in relation to certain statements from EPO officers together with the President of *epi* and the EPPC.

After discussions among the Officers of the Committee it was decided NOT to initiate any action regarding the EPO, since this was too late in the present context. However, the Officers felt that the approval of the Council would be considered as an approval also in case of a future situation, whereby the Committee could initiate a quick reaction to political statements from EPO officers.

#### *Regular meetings with members of DG2*

The Chairman of the Committee has not yet contacted Mr. Kyriakides and Mr. Messerli to initiate the arrangement of regular meetings between the Committee and members of DG2.

## Report of the European Patent Practice Committee (EPPC)

A. Casalonga (FR)  
Chairman

Following the meeting of the EPPC of 22 November 2001 in Munich.

### I. PDG Impact meeting of 26-27 September 2001 in Mainz

Concerning the paragraph numbering, the EPPC proposed to introduce a statement on the first page of the granted patent indicating that the paragraph numbering should not be used for any interpretation of the invention and that those paragraphs were not introduced or verified by the Patentee. A letter was sent to the EPO in this direction.

Concerning access of INPADOC databases incorporated within ESPACENET, the EPPC is in favour of an access available through National patent offices but also directly through ESPACENET.

If questions are asked by third parties, they should remain confidential.

### II. Report on the 9<sup>th</sup> MSBA meeting of 12 November 2001 in Munich

The main points discussed during the meeting were:

- the attitude of the Boards of Appeal toward auxiliary requests filed during oral proceedings,
- technical effect and technical contribution in software related inventions,
- research tools and „reach-through“ claims.

On auxiliary requests filed during oral proceedings, no definitive answer was given but the Boards of Appeal stressed that there was no general attitude of refusal on such auxiliary requests even filed during oral procedure as long as it did not shift the procedure in a fully different direction in order to avoid inadmissible surprise of the other party.

Concerning technical effect and technical contribution, it was generally recognised that non-technical features could contribute to the solution to a technical problem.

On „reach-through“ claims, some examples of possible acceptable claims were given. The position of the Boards of Appeal will need to be defined in the future on the basis of future decisions.

### III. Substantive matters

*11<sup>th</sup> meeting of European round table on patent practice (EUROTAB) 16-17 May 2002 in Kilkenny*

The following points were discussed:

- The concept of „technical invention“,

- Priority and the concept of the same invention,
- Treatment of complex applications at the EPO.

#### *Question 165 – Study of rules of procedure of proposed EPLP*

The third proposal for an EPLP was discussed. A draft position paper was prepared and sent to the EPO.

The following main points were discussed:

- a) The Court of 1<sup>st</sup> Instance (EPC 1)
 

The present proposal contains three possible alternatives, one being the use of presently existing national courts, the second, the use of national courts for a transitional period of seven years and the third, a purely centralised court.

In any case, even if national courts are used, the provisions of the Brussels Convention would apply.

The EPPC also considered the situation of an action between two parties of the same European country. Some EPPC members wondered whether an exception should not be made in that case.

A vote was taken on this, showing that a majority of the EPPC was against such an exception.

However, if in the future special provision would be made for such a situation, the EPPC felt that national courts should then have jurisdiction at the first instance level rather than a „regional“ European court.
- b) Language of the procedure
 

After discussion, the EPPC suggested that all languages of the EPLP member states could be used to file written arguments and documents as long as the translation in the language of the procedure would be made. The language of the procedure should be the language of the patent as granted.

During oral procedure, any language of the Member States of the EPLP could be accepted as long as interpretation is organised by the party wishing to use this language of translations should be the costs born by the Court or by the losing party, depending on the circumstances according to equity.
- c) Obtaining evidence of alleged infringement
 

The EPPC suggested to use the main points of the proposal already made for a European system similar to „saisie-contrefaçon“ presently used in France and in some other European countries.
- d) Hearing of witnesses
 

The EPPC considered that cross examination of witnesses should be strictly limited if accepted by the Court.

## e) Representation

The EPPC stressed again the views already expressed by the *epi* concerning possibility of representation by European patent attorneys.

#### IV. Question 168 – Search report for business methods

It was pointed out by one EPPC member that the EPO issued on August 14, 2001 a press release according to which the EPO when acting as ISA will not issue a search report if the Examiner considers the invention relates to a business method devoid of technical effect.

After discussion, the EPPC considered that this could create difficulties in borderline cases and that the EPO should not decide without any justification that a patent application does not relate to an invention as defined in the EPC.

A letter was sent to the EPO.

#### V. PCT reform working group

For preparing the second section of the PCT reform working group, the subcommittee of the EPPC prepared a position paper which was sent to WIPO.

Further information can be obtained by contacting directly the EPPC via the *epi* secretariat.

## Report of the Online Communications Committee for the time period May-June 2002

D. K. Speiser (DE)  
Chairman

The Online Communications Committee following the meeting of the Council of the *epi* in Lugano last fall published the problems located with respect to the EPO electronic online filing (eOLF) system on the web-site of the Institute. The EPO was not happy with our publication but knew that we were not exaggerating so that it was apparently accepted that the OCC was under the obligation to inform the membership about certain deficiencies of the OLF system which deficiencies might well lead to severe problems with the original disclosure.

Shortly after our publication the EPO which had been informed by the OCC of all located problems changed an important part of the software, with the consequence that the number of problems was reduced and the OCC could remove part of its warning notice from the web-site.

The OCC at its last meeting and prior to the Council meeting in Lugano had proposed to our president to write to the EPO and suggest a meeting between the *epi* and the EPO on the online filing problems. This meeting took place on 10 December 2001. It was chaired by Vice-President Edfjäll and Vice-President Michel. All points of importance to the OCC were discussed in sufficient detail and the OCC conveyed the message to the EPO that representatives using the present OLF system have a severe liability problem stemming from the danger of possible omissions by the software of parts of the invention filed online.

The problem of incomplete disclosure originates from the desire of the EPO to receive the texts in a particular common format called PDF (portable document format).

The PDF format is not the native storage format for most word processing and drawing programs but requires a separate conversion step.

Texts, claims, drawings, graphs etc are made or generated these days by using a large variety of word processing and other software products. To convert the output of those products into the needed PDF format a software called PDF converter is required and up to now there is no PDF converter known that works error-free.

The EPO was of the opinion that an error-free PDF converter is possible. The OCC in contrast thereto does not believe that a PDF converter can be made which is error-free, given the variety of software products and versions on the market. For instance, the EPO supplied PDF converter (Amyuni) messes up all fonts in the output of a well known graphics program (Micrographx Designer) if both portrait and landscape orientations are used in the same document. Further, the OCC takes the position that whenever one of the above mentioned existing software products is improved or otherwise changed or in case a new software product comes onto the market the PDF converters must be adapted and until then cannot be considered to work error-free. Accordingly, in the view of the OCC it cannot be excluded that at least from time to time errors will occur during the conversion of the patent application documents into the PDF format resulting in respective liability problems of the representatives.

Therefore, the OCC proposed to the EPO during the meeting of 10 December 2001 to allow the applicants using the OLF system to add during online filing to the

documents in PDF format a second set of documents in their original text or drawing format such as the DOC (Word) format or others. In other words, the files the applicants hopefully can add are the pre-conversion files which after filing can be used to heal or cure liability problem stemming from differences between the pre-conversion files and the converted files. The EPO at our meeting appeared reluctant vis-à-vis our proposal but promised to give it a legal check.

On 18 March 2002 another meeting was held in the Hague between the OCC and the EPO *epoline* group. This meeting, again, was chaired by vice-presidents Edfjäll and Michel. We learned that the EPO lawyers in the meantime had been consulted and had agreed that our proposal to add the pre-conversion files be implemented in the coming version 1.10 of the OLF software. The EPO confirmed that WIPO and the trilateral offices (US; JP and EPO) were content with the proposal.

The availability of the pre-conversion files as a means to correct conversion errors in the present legal environment is problematic because in this environment the converted (PDF) files are considered to form the original disclosure while the pre-conversion files although reaching the EPO at the same moment as the converted files are not foreseen in the regulations. This problem according to the lawyers of the EPO will be overcome by an official Notice of the EPO President the wording of which will be available within the next weeks. This notice will bind the EPO examiners and it remains to be seen whether it will likewise be accepted by the Technical Boards of Appeal in those cases where it is necessary to use the pre-conversion files to correct conversion errors.

At the meeting of 18 March 2002 the EPO informed the OCC on forthcoming developments and other issues. Version 1.10 of the OLF software of the EPO will come in two versions, a standalone version and a version for networking as a windows client. The standalone version will be available shortly and the networking version is likely to be available in the middle of this year.

Version 1.10 of the OLF software in addition to online filing of European patent applications will allow online filing of EPO form 1200 which is needed to enter the European regional phase. The members of the OCC were given the possibility to inspect version 1.10 and concluded that entering the European regional phase online would appear to be a major step forward; very little work is required to complete form 1200 and some of the information which has to be entered into form 1200 can be derived out of the user's patent management system thereby making the completion of this form even simpler.

The EPO informed us that some European patent offices were shortly going to accept the EPO eOLF

standard and the OLF program while a few others such as Germany continued on a national approach. Irrespective of the Resolutions of national and international user organizations all requesting a harmonized online filing software some patent offices as the German, Danish and Swedish offices stick to the development of an own online filing software thereby forcing the applicants to train and stay familiar with several software packages. The situation according to what we heard from the German PTO might be eased by the inclusion into the German software package of a module allowing not only German online filings but also the online filing of European patent applications. Correspondingly, the EPO eOLF software could be given national modules to file national patent applications using the EPO software. Very recently the US Commissioner announced that the USPTO intends to give up their internal development of an eOLF software and will rather introduce the *epoline* software which will get for this purpose a national US module. This will be a major step forward towards international harmonisation of eOLF. Let us hope that other patent offices will follow and stop wasting the applicants money for national versions of eOLF software.

Once again the OCC at a meeting with the EPO raised the question of an incentive for the users of the online filing system. The OCC pointed out in this context that online filing would be of benefit for the EPO only and that there would be no significant benefit for the users. The OCC expects that the extra training and extra work needed for online filing of applications would keep the number participants small so that the EPO would have to do something in terms of an incentive if it was interested in a substantial increase of the number of users of the online system. In a letter that the *epi* received one or two years ago the President of the EPO had made clear that in the view of the EPO there was no need for an incentive. However, the present number of online filings in the EPO as compared to the total number of filings tells a different story.

Members might be interested to learn of training seminars provided by the *epoline*<sup>®</sup> team of the EPO. One such event called „regional *epoline*<sup>®</sup> user day“ was held recently in Frankfurt and more are planned in other European cities; details can be found on the websites of the *epi* ([www.patentepi.com](http://www.patentepi.com)) and *epoline*<sup>®</sup> ([www.epoline.org](http://www.epoline.org)).

The committee looks forward to the new versions of the software and in particular to the expected Notice of the EPO President regarding the addition of the pre-conversion files and their use in correcting conversion errors. The committee will report on these issues in due course.

## Report of the Professional Qualifications Committee (PQC)

T. Onn (SE)  
Chairman

### 1. Students of the *epi*

Today we have 302 students from 13 countries.

### 2. *epi* Tutorials

As usual there is a shortage of tutors. An appeal for more members volunteering as tutors was published in *epi* Information 1/2002.

It was very difficult to recruit tutors to the current autumn tutorials. We could not appoint tutors to all candidates until February this year.

Due to this situation we have made some minor amendments of the tutorials. Earlier we have had a summer and an autumn tutorial. In order to get the tutorials better organized we now have one tutorial. The candidates still have the opportunity to have two years' papers commented and the only change is that we have only one enrolment date. It gives us some more time to find tutors and we hope that this model will work satisfactorily.

The Tutorials this year will start by the end of June. The 2000/2001 papers will be offered to the candidates and the last date for enrolment is 7 June 2002.

### 3. Tutors' meeting

On 13 November 2001 the annual tutors' meeting was held. Six chairmen/secretaries from Examination committees I, II and III had accepted our invitation and so had 15 *epi* tutors. To confirm the continuation of our closer collaboration with CEIPI and Mr. Dieter Stauder and five CEIPI tutors were also present.

Also this year the draft of the Examiners' Report was received already in September. All participants expressed their satisfaction of receiving it well before the meeting.

The chairman of Examination Committee III presented the EQE statistics for 2001. Thereafter each paper was discussed in more detail. Most participants stressed the importance of a transparency of the system. It is important for the tutors to know about the marking principles in order to give better instructions to the candidates. Everybody expressed their satisfaction of the open discussion on the marking of the papers. The Examination Committee members were presented some feedback comments from the candidates regarding the different papers of the 2001 EQE.

### 4. Continuing Professional Education (CPE)

The CPE started last year with two seminars on the topic Oral proceedings at the EPO. It is a full day seminar and most of the day is spent on a mock oral proceeding in Opposition. In addition to this there is a few hours covering a more general information and advices about the opposition procedure in the EPO. The first seminar attracted 78 participants in Copenhagen and in Milan in December there were 46 participants. On May 6 2002 we had a third seminar on this topic in Eindhoven and the number of participants was 100.

We are also planning seminars on other topics.

The next seminar will be held in Helsinki this autumn and Portugal as well as Ireland are countries that have announced their interest in organizing future seminars.

We will also arrange seminars on other topics but it takes some time to build an organization for these activities.

As to the price for attending one of our seminars a comparison with corresponding seminars offered by commercial organizers is certainly to our advantage. Their price is about three times as high as ours.

### 5. EQE statistics

This time 245 of the candidates sitting last years EQE have answered our questionnaire. The questionnaire was quite extensive so it will take some further time for our working group to analyse all the answers. A first, preliminary report was discussed in our committee at the April meeting. Unfortunately the responses are not statistically significant for the overall population of candidates. The total passing rate of the respondents were for the EQE 2001 was 48.6% as compared with 30.3% for all sitters.

What we already can see is that there is a significant difference between candidates from Germany, France and Great Britain as compared with candidates from the other countries. This is not surprising as the languages of these countries are the official languages of the EPO and in addition to this they have national examinations and a long tradition of training candidates.

Further the statistics indicate clearly that of all candidates those with a mother tongue in one of the official languages have a higher passing rate (41%) than those having another language as their mother tongue (24%). It is also evident that candidates from countries with a national examination have a higher passing rate (39%) than those from countries without any examination (22%).

Is it the influence from the good figures of Germany, France and Great Britain that makes this difference? The answer is that there may be some influence, but if one looks only at the figures of the other member countries there is almost the same, significant difference between candidates having the official language as their mother tongue as compared with those who do not have it. When it comes to national examination or not there is a difference also in this group of countries, but the difference is not as significant as when all countries are included.

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

This group has had some meetings and i.a. discussed the poor passing rate of paper C. One explanation to this is probably that the candidates, especially those coming from the peripheral countries, do have very little – if any – experience of opposition proceedings before the EPO. Therefore in this group we are now looking at the possibility of producing a CD-ROM containing some interesting and educative opposition cases. At present our aim is to cover some cases in different fields of technology and in each of the official languages. Within this epi/EPO/CEIPI working group we are now looking for representative cases that will be good for educational purposes.

In this group we have also discussed the candidates' poor knowledge of priority questions that is revealed by their answers to the papers. Mr. Stauder has promised to make a compendium of the questions on this matter in papers C and D for the last five years. He will include the questions of the papers, the correct answers and a number of erroneous answers given throughout the years.

## 7. EQE

1454 candidates enrolled to sit the EQE 2002, which took place on 20-22 March. As always a large majority of the candidates are resitters, but the number of first sitters has increased.

The EQE 2003 will take place on 26-28 March.

The appeal for more epi members to volunteer to the examination committees has been successful. 20 members have applied and so far 9 have been appointed.

## 8. Joint meeting PQC/Examination Board

In the morning of 18 April 2002 we had our annual joint meeting with the Examination Board. As usual the EQE papers of last year and this year were discussed. Feedback from candidates was presented to the Board.

We also had a discussion on making the marking of the papers available to all candidates in order to increase the transparency of the EQE marking system.

We also discussed a modernisation of the EQE by introducing lap tops or the like as a working tool for the candidates. There are a lot of technicalities that have to be solved, but I am pretty sure that this will be done within some years.

The chairman of the Examination Board Mr. Vivian will retire later this year and will be replaced by Mr. Bertil Hjelm. Further the chairmen of Examination committees I and II Mr. Combeau and Mr. Weinhold leave the committees and will be replaced by Mr. Ian Harris and Mrs. Susan White, respectively. PQC thanked the three leaving chairmen and expressed the appreciation of their work.

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

## 9. Proposed amendment of Rule 6 REE

The Examination Board has presented a proposal for amendment of Rule 6 REE as follows:

### *Present wording*

- (1) Details of the marking shall be contained on the marking sheets filled in by the persons who marked the paper.
- (2) Subject to paragraph 3, the answers and marking sheets are sent to all unsuccessful candidates.
- (3) Candidates who have sat the examination in modules as mentioned in Article 14(1) REE shall, before sitting the second module be informed only on the grades awarded in the first module. However, where such a candidate either chooses to sit first module again pursuant to Article 14(1), last sentence, REE or has been awarded a grade „FAIL“ In each of papers A and B, paragraph 2 Shall apply mutates mutandis.

### *Proposed amendment*

- (1) *Details of the marking shall be contained on the marking sheets.*
- (2) *The answers and marking sheets shall be sent to all candidates.*
- (3) *Deleted*

In the present system a candidate failing in one paper receives marks also for the other papers whereas someone who passes have no information at all about the marking. In view of this PQC is pleased of the quick response of Examination Board increasing the transparency of the system.

*The Council is invited to approve this proposal of the modifications of the REE.*

## Standing Committee on the Law of Patents Report of the 7<sup>th</sup> Session held from 6<sup>th</sup> to 10<sup>th</sup> May, 2002 from the Harmonisation Committee

K. Norin (SE); J.D. Brown (GB)

1. After a short welcome from WIPO, the chairman David Herald took over and the agenda was adopted.
2. The main purpose of the meeting was to discuss the new drafts SCP/7/3 and SCP/7/4 prepared by the International Bureau but first some other issues were raised.
3. In addition to the ordinary sessions, it was agreed to have Working Group sessions on Tuesday, from 9:15 to 11:15 and Wednesday, from 8:00 to 10:00.
4. The chairman proposed to focus on issues of the draft treaty where progress was expected to be made and start with core issues like prior art, enabling disclosure and claims. It was decided to take the discussions in the order of Articles 10, 8, 11, 12, 7, 2-5 and 9 and the rules when they turn up. At least initially, SCP should leave matters related to subject matter, technical effect and grace period.
5. The intergovernmental organisation South Centre was accepted for accreditation.
6. The draft report SCP/6/9 was commented upon. The FR delegation drew attention to the fact that the French version was released two months after the English version and asked the IB to speed up the process.
7. Discussions started with Article 10, Enabling disclosure. Not many objections to the wording were made. Comments on the differences to PCT Article 5 was touched upon but waved away with the remark that the PCT was drafted in the 60-ties. The *epi* delegate proposed to change „the invention“ in the last but one line to „the whole of the invention“, which was noted by the chairman. CEIPI proposed to move the last sentence to the rules. Some problems with undue experimentation were raised. In summery, there seemed to be a broad support for the article.
8. Rule 10, Sufficiency of disclosure. There were some comments on redundancy of parts of the rule. There were some discussions on language problems in the Spanish and French versions. Undue and excessive experimentation may have different meanings. EPO spoke in favour of „undue“ that has been used for a long time and is recognised by the courts. In summery, a broad support.
9. Rule 11, Deposit of biologically reproducible material. CN made comments on the changes and how they might be interpreted. US supported alternative „shall“ in (2)(b). The EPO said the wording of (1) was unclear and voted for alternative „may“ in (2)(b). The *epi* delegate supported the EPO and said the original draft of (1) was much better. It also supported „may“. GB wanted to support „shall“ in harmonisation treaties but questioned whether they could do it here. In summery, Rule 11 has to be redrafted, bearing in mind a majority for „may“.
10. Rule 2, Person skilled in the art. A new wording was proposed by the IB. The passage: „have access to and to understand all prior art under Article 8 and to“ was deleted. The remaining part was not much discussed. In summery, ready for adoption.
11. Guidelines. It was suggested to delete average in G1.02 and to replace required by deemed in G1.01. The EPO wanted to insert some explanations in G1.02 believed to be in line with the *epi* concern.
12. Article 1(viii), Claim date. A couple of delegations questioned the need for the expression. US were reluctant to accept more than one claim date for one claim. The two alternatives were discussed. The IB explained that there were no significant differences between them. The EPO proposed „a claim made in accordance with Paris Convention“ instead of „applicable law“ but was outvoted by DE and GB. Article 1(ix) was also raised. AU pointed out that divisional on divisional etc. must be covered. In summary, a majority seemed to be in favour of the concept of a claim date.
13. Article 8(1), Prior art. US wanted prior art admitted by applicant to be included. They said it would be unfair to first keep the invention as a trade secret and then be granted a patent. The EPO were opposed to that and was supported by DE, JP and FR. AU supported US. In summery, secret prior use has been debated before and the problem apparently remains.
14. Rule 8, Availability to the public. CN had problems with the meaning of (2), would a disclosure to a friend become novelty destroying? They did not want such a possibility. Discussions on „reasonable“, many against but as many in favour to keep it. In summery, divided opinions.
15. Article 8(2), Prior art effect of earlier applications. A new draft was presented by IB. The paragraph has been divided into two sub-paragraphs (a) with no claim to priority and (b) with claim to priority. US

- stated that it should cover both novelty and inventive step. It was suggested to delete „in, or“ in (a) second line and to change „provided that“ on line 7 to „to the extent that“. In summary, the over-all text seems to be accepted. Still limited to novelty, discussed last session.
16. Working Group session. It was decided to start with Unity. First the general concept of unity was to be discussed and then more detailed provisions like „clear and concise claims“. However, the different delegations interpreted this very differently and caused some confusion. A number of delegations mentioned that they have problems with PCT applications and that the international standard should be reviewed. The question was raised whether just a large number of claims may give reasons for objections to clarity. None accepted this as the only reason. A NGO delegate gave a background to the PCT provisions and pointed out that all members including the US had supported the present rules. Is the real problem workload and revenue for patent offices? US accepted that this is a part of the story but not all. It said that the treaty should bring a balance between the interests of the patentee, third parties and the patent offices. EPO suggested a start of more detailed discussion, e.g. payment under protest and other specific procedures under PCT.
  17. Rule 9, Prior art effect of earlier applications. The IB submitted a new draft with substantial changes of 9(1) and 9(2). US was concerned to cover plant and plant varieties by (1) (b). *epi* proposed new wording of (a) „filed with the application“ instead of „prepared by the applicant“ and stated it did not support a prohibition of double patenting and was against the anti self collision clause. EPO wanted 9(4) to be within square brackets. FICPI was in favour of 9(4). In summary, some consensus, abstract clause will be changed, the diverted views on 9(4) noted.
  18. Rule 3, Exceptions to applications and patents to which the treaty applies. US was the only one in favour of deleting the square brackets to let the treaty cover all PCT applications. Many spoke against e.g. EPO and FICPI. In summary, the square brackets will remain.
  19. Article 11(1), Content of claims and 11(2), Style of claims. Reference was made to the document SCP/7/6, Relationship between the claims and disclosure. US suggested new wording. Instead of „for which protection is sought“ they wanted „the inventor considers his invention“. However, they were outvoted by many delegations. RU questioned the wording but most others agreed to it. In summary, supported by a majority. Clear and concise will be further elaborated by the Working Group.
  20. Article 11(3), Relationship of claims to the disclosure. A new draft was presented. (3)(b) had been redrafted and moved to the rules as Rule 11bis. There was broad support for the new article and rule. However US still wanted recognized to changed to possessed. In summary, broad support.
  21. Article 11(4), Interpretation of claims. JP argued the article was too detailed and would prevent the courts from working on case by case basis. Some concern of leaving out the reference to Article 7 was expressed. Discussion on primary and secondary, should only be interpreted as a chronological order. In summary, general support, the definition specification as amended and corrected will remain, equal importance of primary and secondary.
  22. Rule 12(1)-(3), Interpretation of claims. EPO had problems with the wording of the last part of (2)(b). US stated that a claim should not be limited to the embodiments in the description. In summary, some redrafting needed, as a whole accepted.
  23. Rule 12(4), Special types of claims. New draft presented by IB. They withdraw paragraph (b) and the last part of (d). Support for removing the square brackets in (a) by US and others. (d) much discussed. Concerns on use claiming in general and related to medical indications. In summary, the square brackets will be taken away, (b) deleted and (d) needs to be redrafted. IB would welcome written proposals.
  24. Rule 12(5), Equivalent. UK objected to „at the time“ but this term was accepted by DE and US. DE also stated that this paragraph might be written as two alternatives as it was in the old treaty proposal. Discussion not finished (see paragraph 26 below)
  25. At the end of the Working Group Second Session, it was agreed that concept of a Working Group was a welcome development. However, specific questions of practice should be posted on the electronic forum and answered thereon in advance, to aid discussions.
  26. The discussion on Rule 12(5) was resumed. The *epi* delegate objected to (and proposed deletion of) „at the time of any alleged infringement“ when considering infringements (this would mean that the scope of a claim could change with time). This suggestion received wide support, the chairman also concluding that a patent should have seen same interpretation at all times NGO's were generally opposed to the inclusion of the second limb of Rule 12(5). In summary, the rule will be revised to take account of these points.
  27. Rule 12(6), Prior statements. The majority (specifically excluding the US) wanted this rule deleting, *epi* supporting its deletion. Because not many reasons had been given for keeping or deleting this rule, the chairman summarised by saying that more discussion will be needed at the next meeting of SCP.
  28. Article 12(1), Subject Matter eligible for Protection. ES on behalf of the EU member states proposed the deletion of the square brackets, so as to include „in all fields of technology“ and to include some reference to Articles 27(2) and (3) of TRIPS. This proposal was supported by all who spoke, except those from the US. The chairman concluded that two versions

- of this rule should be in the next draft and the IB should make some new proposals to deal with the TRIPS issues. This therefore also dealt with Article 12(4) and (5).
29. Article 12(2), Novelty. The only comment made was by SE, who wanted the exceptions in the Article, not the rule.
  30. Rule 14(1), Primary Item of Prior Art...US, supported by *epi*, wanted assessment on the claim date. *epi* also queried (2), in that „the claimed invention“ should be something within the claimed invention. Some delegates queried the need for the second clause in (2). In summary, this will be looked at again by the IB and discussed again at the next meeting.
  31. Rule 14(2), Scope of the Primary Item of Prior Art. *epi* suggested deletion of (b) and (c). DE supported the deletion of (b) and queried the meaning of (c). In summary, (b) will be deleted and the IB will review (c).
  32. Rule 14(3), Earlier Application as Primary Item of Prior Art. *epi* suggested that, if claim date was used in Rule 14(1), then this was redundant. The IB promised to consider this.
  33. Guideline under Rule 14, Methodology for Assessment of Novelty. UK proposed deletion of the Guideline, supported by *epi*. US and CA queried G3.02. IB said that it was presently not clear if the Guideline would be binding, but will depend on the final treaty wording. In summary, the IB will review the need for the Guideline.
  34. Article 12(3), Inventive Step/Non-Obviousness. *epi* suggested deletion of „as a whole“ in line 2 and the replacement of „that invention“ by „the whole of the claimed invention“ in line 3. The IB promised to look at this suggestion.
  35. Rule 15, Items of Prior Art Under Article 12(3). No real discussion.
  36. Guidelines Under Rule 15. *epi* suggested replacing „can“ by „would“ at the end of line 5 of G4.03, in view of Rule 15(4). The IB promised to look into this. In G4.01, UK suggested replacing „scope“ by „disclosure“ in (ii) and „the invention as a whole“ by „any part of the claimed invention“ in (v). In summary, the IB to review, for further discussion at the next meeting.
  37. Article 7(1), Opportunity to Make Observations, Amendments or Corrections in Case of Intended Rejection or Refusal. The chairman opened the discussion by saying that Article 7(1)(b) was very unuser friendly. AU and DE, as well as AIPLA and some other NGO's, asked if this article was to apply after grant, in which case an equivalent to Article 123(3) EPC would be needed. *epi* requested that divisional applications be deleted from (b), whereas RU suggested the complete deletion of (b). US supported *epi* regarding divisional applications, as did AIPPI and BIO, but US wanted drafting changes rather than complete deletion of the reference to divisional applications. In summary, the IB will consider this again.
  38. Article 7(2), Amendments or Corrections on applicant's Initiative. AU suggested deletion of „only“ in the penultimate line, to make the provision more flexible. The IB said that a Contracting Party could be more generous if it so wished. There was some discussion as to how various types of Office would apply this article. In summary, discussion to be continued.
  39. Article 7(3), Limitation of Amendments or Corrections. DE spoke against the inclusion of the abstract, so that the abstract could not be used under Article 8(2). US wanted to treat the abstract as part of the description, because US Courts sometimes used the abstract to interpret claims (see Article 5(3) in this regard). JP was reluctant to include the abstract and CN agreed with DE and EPO and *epi* also supported DE. The chairman queried the reference to „anyone“ in 3(b). Chile suggested „any person normally familiar with the matter“, whereas JP preferred the skilled person, supported by AU and BR and many others. The chairman concluded that there was overwhelming support for the skilled person, despite what is said in PCT Rule 91(1).
  40. Article 1, Abbreviated Expressions, and Rule 1, Abbreviated Expressions. No comments were made.
  41. Article 2, General Principles. BR, supported by many South American and African states, proposed the addition of a new paragraph 3 to allow them to protect health, biodiversity, traditional knowledge, etc, with the Dominican Republic wanting a similar addition to Article 2(2), including a reference to TRIPS Articles 7 and 8. US spoke strongly against these proposals, which should be considered elsewhere, not in SCP in relation to SPLT. This position was supported by DE and BIO (who could not see how SPLT could conflict with the CPD. IE also supported this position and queried why (2) was in the draft. The debate will continue.
  42. Article 3, Applications and Patents to Which the Treaty Applies, and Rule 3, Exceptions under Article 3. IE queried the absence of transitional provisions. The IB said that these will be dealt with in the final administrative provisions. The IB will also look at the wording of 3(1)(l).
  43. Article 4, Right to a Patent. US wanted some „false claiming of inventorship“ provisions and wanted 4(2)(b) deleting. DE, NL and NO supported this deletion. RU and CN wanted the whole article deleting. JP supported the 4(2)(b) deletion and said that 4(3) needed some clarification. The debate will continue, on the basis of a revised proposal from the IB.
  44. Article 5, Application, Rule 4, Further Requirements Concerning Contents and Order of Description Under Article 5(2), and Rule 5, Further Requirements Concerning Claims Under Article 5(2). EPO wanted „technical“ reinstating in Rule 4(1)(l) and (iii), as well as stating in Article 5(3) that the abstract was not prior art under Article 8(2), this latter suggestion being supported by ES and DE. US,

supported by UK, wanted Rule 5(1)(iii) deleting and US were concerned by the EPO proposal relating to Article 5(3). There was an inconclusive discussion about the wording of Article 5(1)(iv), which the IB will reflect on. EPO then wanted „preferably“ reinstated in Rule 4(1)(ii), which was supported by US. JP supported this as drafted, but non compliance should not be a ground of refusal or revocation. The conclusion by the chairman was that there are many views, more discussion is needed, but remember the aim is harmonisation. In Rule 5, EPO said that „technical“ can be deleted from Rule 5(2) and (3)(l) and RU and US agreed. Numerous references were made to „limitations and features“ and these will be reviewed by the IB. There was also limited support for allowing claims to refer to drawings, as well as graphs, etc.

45. Article 9, Information Not Affecting Patentability (Grace Period). There was much debate as to whether (4) was worded correctly, as well as whether this provision should be in SPLT at all. UK indicated that their consultation on grace periods last week and no conclusions have been reached yet. However, it has been noted that small entities and universities have said that they do not need a grace period, but some large entities have said that a short grace period would be fine. UK also asked what the grace period was for and suggested that

the NGO's should get together and decide what is needed. US proposed a special provision relating to experimental use. The chairman summed up by saying that the whole question of a grace period was still under debate in many states. The presence of (\$) was causing problems for many delegations and the term of any grace period was an open question. The debate will continue.

46. Articles 13 to 17 were only very briefly discussed, with BR wanting to add into Article 13 an equivalent to the proposal in Article 2. The chairman said that further discussion on the articles should await further developments on the earlier Articles.
47. The chairman reported that in the Working Group lack of unity had been discussed in detail in the first session, it being concluded that this was essentially a fiscal matter. In the second session the linking of claims (dependency of multiply dependent claims on multiply dependent claims) and the number of claims – clear and concise and unity requirements, as well as the number of independent claims in each category.
48. The draft summary of the chairman was presented to the meeting and accepted with a few minor amendments. EPO requested that more time be allocated to the Working Group. The IB noted this.
49. The next meeting of SCP was provisionally arranged for 18<sup>th</sup> to 22<sup>nd</sup> November, 2002 in Geneva.

## Report on the State of the Debates over the Proposal for a Council Regulation on the Community Patent

E. Armijo (ES)

Since October 2001, concerning the state of the debates over the proposed EU Council Regulation on the Community Patent, the following facts are highlighted.

1.- On the occasion of the meeting held in Brussels on 20<sup>th</sup> December 2001 by the Council of Ministers of the EU Internal Market (the Council), the Belgian Presidency submitted a proposal in the following terms:

- As to the language regime:
 

Application	– In any of the languages of the EU Member States.
Prosecution	– At the choice of the applicant, in English, French or German. The translation of the text as applied for into the language of prosecution would be at the system's expense.
Publication	– In the language of the prosecution and in the language of the applicant if different. A kind of enhanced abstract

was also proposed to be published at that time in all the languages of the Member States.

Claims	– Not translated into any language, not even into the other two official languages of the European system.
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Final Text	– The applicant would have the choice of translating it into his own language at his expense.
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- As to the role of National Patent Offices:
 

Search	– Decentralised through the Member States which so wish and are capable of performing it following the PCT requirement (Rules 36 and 63) and with the cooperation of the EPO in the manner provided for in Section III (2) of the EPC
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Protocol on Centralisation. Those Member States would be able to perform the search in their own language.

This proposal did not meet the unanimous approval of the Council.

2.- At the 21st May 2002 Council meeting, the Spanish Presidency submitted a modified proposal in the following terms:

- As to the language regime:
  - Application – In any of the languages of the EU Member States.
  - Prosecution – At the choice of the applicant, in English, French or German.
    - The compulsory translation of the claims into the other two languages of the system as per Art. 14.7 EPC and Rule 51.6 would be maintained.
    - The translation of the text as applied for, into the language of prosecution would be at the system's expense.
  - Granted Claims – Translation of the same into all of the EU languages, except when a Member State expressly so renounces.
    - Filing of such translations in centralised manner before the EPO.
- As to the role of the National Patent Offices
 

The Spanish Presidency maintained the Belgian proposal on decentralisation of the filing of applications and of the search, making though a distinction among the Member States whose official language differs or is one of the 3 official EPO languages, and

among those having experience of cooperating with the EPO and needing to maintain a critical mass of work.

- As to the maintenance fees
 

A 50% distribution is proposed, between the EPO and the National Offices of the Member States with a distribution key to be determined by the Council.
- As to the Jurisdictional system
 

To be established in accordance with Articles 225A and 229A of the EC Treaty approved at Nice, once this enters into force.

  - At 1st Instance level there would be a Centralised Community Patent Court dependent on the Luxembourg Court of 1st Instance.
 

A limited number of regional Chambers would be established, selected at various points in the EU, following objective cost-effective criteria, volume of litigation, possible infrastructures close to users, etc.
  - At 2nd Instance level, appeals would be filed before the Luxembourg Court of 1st Instance.
  - As far as the linguistic regime is concerned, it is foreseen that provision would be made for all of the official EU languages to be used at both levels, with possibility, on the other hand, of agreement between the parties. The possibility would be established of other linguistic regimes more adapted to the regional chambers without prejudice to the languages utilised by the respective members in their deliberations.
 

This proposal did not obtain either the unanimous approval of the Council who, in its Conclusion Minutes, reiterated the fundamental principle that „nothing is finally agreed until everything has been agreed“.

## Networking of the *epi* Relationship between the *epi* and training institutions

W. Holzer, *epi* President

The *epi* in the past years has continuously broadened its collaborative activities with other institutions in the professional field, predominantly with the CEIPI (Centre d'Études Internationales de la Propriété Industrielle – Université Robert Schuman), the International Academy of the EPO and the RIPP (Regional Industrial Property Program for the accession states, organised by the EPO/European Commission). The volume of these activities is likely to increase further, last but not least due to the fact that the knowledge based economy demands keeping up to date with developments in the industrial property field and deepening of personal knowledge.

The CEIPI in Strasbourg is a major centre of teaching for the patent profession in Europe. Together with the *epi* the CEIPI provides a basic diploma on European patent law. About 200 tutors (the major part consist of *epi* members) lecture about 400 participants in nearly 30 courses organised in a great number of cities of the contracting states. CEIPI seminars and symposia are moreover held in Strasbourg. For example, the *epi* contributed to a CEIPI Symposium in 2001 on the Results of the Revision of the Munich Convention. The International Section of the CEIPI is itself networking with other European Intellectual Property Institutes, such as

the Queen Mary College, the Westfield College, the ETH Zürich and the University of Alicante. At the same time, the PQC (Professional Qualifications Committee) of the *epi* has intensified its collaboration with the CEIPI not only as concerns training of candidates for the European Qualification Examination (EQE) but also in terms of „continued professional education“ by organising seminars on a more or less regular basis in different European cities.

The *epi* is moreover contemplating a new joint *epi*/CEIPI course in the context of the possible setting up of pan-European patent courts. The course should convey to the members of the *epi* a wide range of knowledge of European Conventions, rules and laws, such as the European Court of Justice litigation rules, general and comparative procedural law, the principles of Community law as well as civil Law/common law pertaining to patent infringement litigation procedures. The course in the long run could enable European patent attorneys wishing to participate in litigation to obtain an additional qualification.

It is recognised today that European patent attorneys play a major, sometimes *the* important role in patent litigation proceedings. There simply should be no proceedings without the active participation of European patent attorneys, both as concerns infringement and validity issues as well as declarations of infringement and non-infringement, in countries where these exist (also foreseen in the draft Community patent regulation). The formal rights of European patent attorneys to participate in such proceedings vary from country to country in Europe. There are countries, for example, where patent attorneys enjoy the right of audience, that is they are allowed to assist their party in court proceedings and

have the right to speak and to be heard. In the UK patent attorneys may even become patent litigators. In most countries it is also the patent attorney who conducts invalidity proceedings or proceedings for a declaration of infringement or non-infringement (which have a similar structure as infringement proceedings) before the national authorities, in the same manner as the European Patent attorney conducts an opposition and appeal proceedings before the European Patent Office. (In this respect the Article of Prof. Uwe Dreiss in *epi* Information No. 2, 2002 is of relevance). The *epi* would be interested in this context to learn how much interest there is in the profession for such a special training, which for example could be taken in modules over a certain period of time in one of the official languages and which eventually could provide the participant with a certificate.

In the context of the European Patent Office International Academy which is active in organising seminars for patent office examiners and patent attorneys, on various topics such as appeal procedures, search and examination, administrative procedures, in particular for participants from non-member states (e.g. in regional seminars for Africa and the Middle East), to mention a few activities, the *epi* is contributing by providing lecturers and agenda items. The *epi* for instance together with the Max Planck Institute participated in a successful Symposium on Enforcement of Intellectual Property Rights and Patent Litigation organised by the EPO International Academy in 2001.

These co-operations prove extremely fruitful in disseminating knowledge about the European Patent System and in shaping common professional standards in a now much wider Europe.

## Training Programme in Preparation for the European Qualifying Examination 3<sup>rd</sup> to 5<sup>th</sup> February 2003

The Training Programme on the European Patent for students preparing for the European Qualifying Examinations will be held from 3<sup>rd</sup> – 5<sup>th</sup> February 2003.

Cost: £ 850 inclusive of documentation, refreshments and lunches.

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

For further details, please contact Queen Mary Intellectual Property Research Institute, Centre for Commer-

cial Law Studies, Queen Mary, University of London, Mile End Road, London E1 4NS.

Tel: (020) 7882 5126

Fax: (020) 8981 1359

Email: S.C.Ng@qmw.ac.uk

Details and a booking form can be downloaded directly from the website address:

<http://www.ccls.edu/iplaw/index.html>

*epi* 25<sup>th</sup> Anniversary Seminar  
Ettington Chase Conference Centre,  
Stratford upon Avon, GB  
26<sup>th</sup> October 2002

We publish below an updated programme for the above event.

*epi* Council approved the arrangements for the Seminar at the Stockholm Council Meeting. The Gala Dinner at Warwick Castle following the Seminar will now be a „black tie“ event. The cost of attendance by accompanying persons at the dinner is additional to the Seminar registration fee. The language of the event will be English.

A copy of the registration form was available in *epi* Information 2/2002. Further copies of the form are available by downloading from [www.patentepi.com](http://www.patentepi.com)

Completed registration forms should be sent to Conference Line, 5 Leopold Road, London, GB-SW19 7BB. The fax number is + 44 20 8944 0866. There is a dedicated e-mail address concerning the Seminar and Gala Dinner. This is [episeminar@conferenceline.co.uk](mailto:episeminar@conferenceline.co.uk)

Please address any enquiries for the attention of Ms. Clare Jiggins.

We remind members of *epi* Council that registration for the Seminar and Gala Dinner is separate from registration for the Council Meeting at the same venue on 28<sup>th</sup> & 29<sup>th</sup> October. The Secretariat of *epi* will receive Council Meeting registration forms in the usual manner.

As of 20<sup>th</sup> August 2002 approximately 65 delegates had registered for the Seminar. We expect that the Seminar will reach its capacity before the beginning of October. Therefore we urge all who are considering registering for this prestigious event to do so as soon as possible. We wish all the delegates an enjoyable and stimulating time at the Seminar and Gala Dinner.

Timothy Powell

On behalf of the *epi* Seminar Working Party

## Programme

- |       |  |
|-------|--|
| 14:00 | Opening address<br>Walter Holzer, <i>epi</i> President<br>John Brown, CIPA President                                       |
| 14:15 | The next 25 years for the EPO<br>Dr. Ingo Kober, EPO President   |
| 14:35 | The next 25 years for National Patent Offices<br>Alison Brimelow, Chief Executive of the UK Patent Office                  |
| 14:55 | The next 25 years for IP and the EU<br>Erik Nooteboom, Directorate General for the Internal Market                         |
| 15:15 | The next 25 years for WIPO<br>Philip Thomas, WIPO Director, Patent Policy Department                                       |
| 15:35 | Coffee break   |
| 16:00 | The next 25 years for IP Litigation in Europe<br>His Honour Mr. Justice Laddie, The High Court (Chancery Division), London |
| 16:20 | The next 25 years for <i>epi</i><br>Thierry Sueur, VP Intellectual Property, L'Air Liquide S.A.                            |
| 16:40 | Q&A panel<br>All speakers  |
|       | Closing address  |
| 19:00 | Departure from Ettington Chase to the Gala Dinner at Warwick Castle, return after midnight.                                |

## *epi* Art Exhibition 2003

As first reported in the last issue of *epi* Information the next *epi* Art Exhibition will be held in March 2003. Held for the first time in 1991, it was followed by further ones in 1994, 1996, 1998 and 2000. The interesting works on display ranged from paintings to graphical and fine art works such as ceramic works, sophisticated watches and jewellery, and artistic textile creations. The exhibitions which were opened by the *epi* President and by the EPO President aroused great interest. We hope that the forthcoming exhibition will be just as successful. It is planned to take place from

13 to 31 March 2003

in the premises of the European Patent Office,  
Erhardtstrasse, Munich.

A prerequisite for having the exhibition held again is a large participation of artists coming from various countries. Therefore, all creative spirits among the *epi* membership are invited to participate. Please pass the information round!

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The European Patent Office  
in co-operation with  
The Institute of Professional Representatives before  
the European Patent Office (*epi*)  
&  
The Max Planck Institute for Intellectual Property,  
Competition and Tax Law

### International Forum on The Protection of Computer-Related & Business Model Inventions

EPO, Munich

Thursday, 21<sup>st</sup> and Friday 22<sup>nd</sup> November 2002

Information:

[internationalacademy@epo.org](mailto:internationalacademy@epo.org)

[www.european-patent-office.org](http://www.european-patent-office.org)

## The Patentable Business Methods

G. Bloch (FR)

This presentation deals with the patentability, in Europe, of methods for doing business. The object of it is to present the recent case law of the European Patent Office, its recently amended Guidelines and the last proposal for a Directive of the European Parliament on the patentability of computer-implemented inventions. Our wish is that the practitioners, either making use of IP rights or counselling in IP matters, who will do us the favour to get through, won't get confused anymore with computer software, computer program products and computer-implemented business methods and that they will recognize that Europe had to move forward and that Europe did.

The question of the patentability of computer software has been solved a long time ago. Today, the European Draft Directive deals with nothing but the protection of business methods. It should not be regarded as a legal regression. Tomorrow, the Directive shall open a window to the protection of the inventions of the future.

### A.- Business methods

#### A1.- Article 52 of the European Patent Convention

According to it, schemes, rules and methods for doing business as such shall not be regarded as patentable inventions.

Thus, if the subject-matter of a patent application extends beyond a business method per se, it might be patentable. This is what the recently amended EPO Guidelines say.

#### A2.- The EPO Guidelines

Let us quote them :

If the claim specifies computers, computer networks or other conventional programmable apparatus, or a program therefore, for carrying out at least some steps of a scheme (rule or method), it is to be examined as a *computer-implemented invention*.

The last Draft Directive is even more positive.

#### A3.- The proposal for a Directive of the European Parliament and of the Council on the patentability of computer-implemented inventions (CII)

Article 4 sets forth the classical conditions for patentability (novelty, inventive step and industrial application) and, in addition thereto, requires for an invention to involve an inventive step to make a technical contribution.

But of great interest is the official explanation of this article.

According to it,

*the invention, aspects of which lie in a field of subject-matter excluded under Article 52(2) (for example a method for doing business) may still be patentable if a non-obvious contribution is present.*

Therefore, a computer-implemented invention might well be patentable.

### B.- Computer-implemented inventions

#### a) They are different from computer software related inventions.

The patentability of these inventions has been admitted by the European Patent Office a long time ago, and we refer to the two following monumental decisions :

- VICOM T 208/84 (OJ/1987), Board of appeal 3.5.1 (15.7.1986)
- KOCH & STERZEL T 26/86/OJ/1998), Board of Appeal 3.4.1 (21.5.1987)

Vicom relates to a method of digitally processing images in the form of a two-dimensional data array having elements arranged in rows and columns in which an operator matrix of a size substantially smaller than the size of the data array is convolved with the data array, including sequentially scanning the elements of the data array with the operator matrix.

Koch & Sterzel relates to an X-ray apparatus for radiological imaging having an input unit both for selecting one of several X-ray tubes with adjustable focal spot size and rotating anode speed and for selecting X-ray tube current and exposure time, said apparatus also having a data processing unit which stores the X-ray tube rating curves for different exposure parameters and uses these to set the tube voltage values for the exposure parameters selected.

#### b) Computer-implemented inventions might also be different from the computer programs, of which the definition is given by the EPO Guidelines, the Council Directive on the legal protection of computer programs and the Draft Directive on the patentability of C.I.I.

##### b1) The EPO Guidelines

Within the meaning of the Guidelines, programs for computers are a form of „computer-implemented invention“, which expression is intended to cover claims which involve computers, computer networks or other conventional programmable apparatus whereby prima facie the novel features of the claimed invention are realised by means of a program or programs. Such claims may e.g. take the form of a method of operating said conventional apparatus, the apparatus set up to execute

the method or, following T.1173/97 (OJ 10/1999.609), the program itself.

T.1173/97 is one of the two famous IBM decisions of the Board of Appeal 3.5.1.

*b2) The Council Directive of 14.5.1991 on the legal protection of computer programs (91/250/EEC)*

Its preamble portion makes clear that only the expression of a computer program is protected and that ideas and principles which underlie any element of a program, including those which underlie its interfaces, are not protected by copyright under this Directive and that, to the extent that logic, algorithms and programming languages comprise ideas and principles, those ideas and principles are not protected under this Directive.

What this Directive accords, is a copyright protection for the expression of computer programs, that is the source code, perhaps the object code.

### C.- The Draft Directive and the computer programs

The Draft Directive refers to computer programs directly in article 2(a) and indirectly in article 5, where they are excluded from patentability. Prior to commenting on this second issue, we shall introduce the IBM decisions.

*C1) Article 2(a) of the Draft Directive*

Again, we better quote :

„computer-implemented invention“ means any invention the performance of which involves the use of a computer, computer network or other programmable apparatus and having one or more *prima facie* novel features which are realised wholly or partly by means of a computer program or computer programs.

*C2) The two IBM decisions of the Board of Appeal 3.5.1 of EPO T.0935/97 and T.1173/93*

These two decisions have admitted patentability of computer program products, such as the one of claim 7 in case T.0935/97 :

A computer program product comprising a computer readable medium, having thereon:

computer program code means, when said program is loaded, to make the computer execute procedure to display information within a first window in a display; and

responsive to the obstruction of a portion of said first window information by a second window, to display in said first window said portion of said information that had been obscured by said second window, including moving said portion of said information that had been obscured by said second window to a location within said first window that is not obscured by said second window.

We never shared the views of the Board. Article 52(3) of the European Patent Convention does not restrict the scope of the exclusion under Article 52(2), as was the idea of the Board, but it just explains this scope. According to the Board, there should have been computer

programs which are as such and computer programs which are not as such.

As matter of fact, the Draft Directive excludes computer programs from patentability.

*C3) Explanation of article 5 of the Draft Directive*

The exclusion is to be found in the official explanation which points out and, once more, we quote, that the proposal has not followed the practice of the EPO in permitting claims to computer program products either on their own or on a carrier, as this could be seen as allowing patents for computer programs „as such“.

### D.- The patentable business methods

According to the Draft Directive and the EPO Guidelines, business methods should be patentable if they are computer-implemented inventions.

*D1.- The Draft Directive*

Referring to article 4, paragraph 1, „member States shall ensure that a computer-implemented invention is patentable on the condition that „it meets the classical requirements“.

A method for doing business is given as an example, in the explanation of this article, of an invention, aspects of which lie in the field of subject-matter excluded under article 52(2) EPC, but which may still be patentable.

*D2.- The EPO Guidelines*

a) In the passage of the Guidelines devoted to schemes, rules and methods for doing business, a scheme for organising a commercial operation is given as an example of non-patentable matter but which, if it specifies computers, computer networks or other conventional programmable apparatus, should be examined as a computer-implemented invention.

b) The computer program related passage of the Guidelines

It instructs the examiner to look for an objective technical problem which has been overcome and for the solution to that problem, it being the invention's technical contribution to the art establishing that the claimed subject matter has a technical character and therefore qualify for being an invention within the meaning of article 52(1) EPC.

Consequently, and unlike the US provision, a business method which could not be considered as a computer-implemented invention, would not be patented in Europe.

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Now, it will not be always so easy to implement both of the EPO Guidelines and the Council Directive. Indeed, there are points of agreement, but also points of conflict.

## E.- Points of agreement

There are two main points of agreement between the two texts, the refusal of the contribution approach and the requirement of a technical contribution.

### E1.- No contribution approach

#### a) The EPO Guidelines

The provision is clear :

If the claimed subject-matter specifies an apparatus or technical process for carrying out at least some part of the scheme (for doing business), that scheme and the apparatus or process have to be examined as a whole.

#### b) The Draft Directive

Article 4.3 provides that „the technical contribution shall be assessed by consideration of the difference between the scope of the patent claim considered as a whole, elements of which may comprise both technical and non-technical features, and the state of the art“.

Since this is a key issue, the official explanation insists :

„Article 4 paragraph 3 provides that in determining the technical contribution, the invention must be assessed as a whole. This is consistent with the decisions of the EPO Technical Boards of Appeal in *Controlling Pension Benefits* and *Koch & Sterzel* according to which there must be no assessment of a „weighting“ between technical and non-technical features in an attempt to determine which aspect makes the more important contribution to the invention's success“.

### E2.- Technical Contribution

#### a) The EPO Guidelines

The end of the passage related to the computer programs, already quoted above (see D2 b), defines the compulsory technical contribution.

#### b) The Draft Directive

The technical contribution is a condition for patentability (article 4.2), is defined in article 2b

technical contribution means a contribution to the state of the art in a technical field which is not obvious to a person skilled in the art

and further discussed in the associated explanation by way of a presentation of the possible sources of this contribution:

- the problem underlying, and solved by, the claimed invention ;
- the means, that is the technical features, constituting the solution of the underlying problem ;
- the effects achieved in the solution of the underlying problem ;
- the need for technical considerations to arrive at the computer implemented invention as claimed.

## F.- Points of conflict

F1) The European Patent Office is not a member of the European Union and this may give rise to difficulties if it does not follow the Directive, as already evoked above with respect to the patentability of computer program products.

Incidentally, if a conflict does arise in relation thereto, the IBM decisions of the EPO Board of Appeal do not solve the question of patentability of a computer program product as intermediate product of a larger *computer related system*. As a matter of fact, referring to decision T 0935/97, paragraph 9.6, the Board said that

the claim must comprise all the features which assure the *patentability of the method* it is intended to carry out.

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G.- At this stage of the presentation, a word should also be said about the possible conflict between the Search Directorate and the Boards of Appeal of the European Patent Office, after the EPO press release of last year about the business methods and in connection with the duty of EPO to act as International searching authority within the frame of the PCT system. EPO announced thereby i) it would not carry out an international search on an application to the extent that its subject-matter relates to no more than a method of doing business, in the absence of any apparent technical effect and ii) claims to commonplace technological implementations of such methods would not be searched because it would not serve any useful purpose to do so !

In addition thereto, it should be pointed out that EPO also acts as the searching authority for the French Patent Office and that quite a few French Patent Applications got stuck through lack of search report.

However, it seems today as if the EPO searching people have accepted to reduce their resistance.

We should hope that, if this tendency is confirmed, it is at the invitation of the European Parliament and the Council expressed in the explanation of articles 2 and 4 of the Draft Directive :

- a) the „novelty“ of any invention within the scope of the Directive does not necessarily need to reside in a technical feature. The employment of the expression „prima facie“ to qualify „novel features“ means that it is not necessary to establish actual novelty (for example through the carrying out of a search) in order to determine whether an alleged invention falls within the scope of this definition.
- b) although a valid claim may comprise both technical and non-technical features, it is not possible to monopolise the purely non-technical features in isolation from the technical features.

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Thus, computer-implemented methods for doing business may well be patentable if they meet the requirements of article 52 of the European Patent Convention.

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*The most significant case law of the EPO Boards of Appeal*

#### **Decision T 769/92 – 3.5.1 of May 31, 1994 (Sohei)**

This case relates to a method for operating a general purpose computer management system.

According to the Board, in case of a non patentable method carried out by a program run on a computer, if the computer is a conventional one and if the implementation of the method does not produce any contribution to the state of art, the method does not become patentable just because the computer is hardware.

The Board keeps going on by saying that there was apparently no new hardware unit as such from a technical point of view.

Yet, the Board made the statements that

- an invention had technical character because it implied a need for technical considerations when carrying out that invention,
- a technical invention could not lose its technical character, because it was used for a non-technical purpose.

#### **Decision T 1002/92-3.4.1 of July 6, 1994 (Pettersson)**

- The invention of claim 1 of the patent, to be revoked but not revoked, is a System for determining the queue sequence for serving customers at a plurality of service points.
- Claim 1 explicitly indicates that the system comprises a turn-number allocation unit, a selection unit, terminals, an information unit and computing means.
- For the Board, the claimed apparatus is clearly technical in nature and has practical application to the service of customers.
- The last function in claim 1 describes the basic working principle of the claimed computing means which is to decide which particular turn-number is to be served at the particular free service point.

The wording of claim 1 links this functional term logically with the remaining technical features of the claim in an inseparable way, in that it is indispensable for achieving the intended technical result disclosed in the description, column 1, lines 37 to 45. Hence, within the overall teaching of claim 1, the nature of the above functional term is limited to a hardware property. Claim 1 excludes,

in the board's opinion, any interpretation of the above functional term as a step of an unpatentable method for doing business, and only allows this functional term to be understood as a computer program according to which the claimed hardware operates.

#### **Decision T 953/94 of July 15, 1996 (Georges)**

- It relates to a method of generating with a digital computer a data analysis of the cyclical behaviour of a curve.

It lies outside the scope of our topic; it relates, not to a business method, but to a mathematical method.

- Still, and after exclusion of „a programmable general purpose computer, operating under the control of a program excluded as such from patentability, the board of appeal pointed out that they could not find out any technical effect produced by the claimed method.
- Also of interest in this decision is the fact that the addition, in the main claim of the last auxiliary request, of the features, according to which the curve should be used in the control of a physical process, could allow the object of the claim to be considered as not excluded from patentability.

This looks definitely like the Post Activity requested in the US.

#### **Decision T 0931/95 3.5.1 of September 8, 2000 (Pension Benefit Systems Partnership)**

It relates to a method for controlling a pension benefits program by administering at least one subscriber employer account, the claim including nothing but steps of processing and producing information with purely administrative, actuarial and/or financial character.

- The Board happened to state that
  - i) a feature of a method, which concerns the use of technical means, for a purely non-technical purpose and/or for processing purely non-technical information, does not necessarily confer a technical character to such a method;
  - ii) methods only involving economic concepts and practices of doing business are not inventions within the meaning of Article 52(1) EPC, but
  - iii) if technical considerations are required to carry out an invention, the invention may be an invention within the meaning of Article 52(1) EPC;
  - iv) the contribution approach is not appropriate for deciding whether something is an invention within the meaning of Article 52(1) EPC and does not have any basis in the EPC.

## Prosecution History Estoppel and the *Festo* Decision

Richard L. Mayer (US)<sup>1</sup>

In May, 2002, the United States Supreme Court rendered its decision in the case of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*<sup>2</sup> (hereinafter „*Festo*“). The Supreme Court vacated and remanded an *en banc* decision of the Court of Appeals for the Federal Circuit<sup>3</sup> („Federal Circuit“) relating to the U.S. patent law doctrine of prosecution history estoppel. The Federal Circuit decision had generated a great deal of discussion and controversy among patent professionals.

When applicable, the doctrine of prosecution history estoppel precludes the doctrine of prosecution history estoppel. When applicable, precludes patent owners from using the doctrine of equivalents to expand the scope of their patent coverage to include subject matter outside the literal scope of the claims. The doctrine is denoted „prosecution history estoppel“ because it is based on the applicant’s actions during the prosecution of the patent, as reflected in the patent’s prosecution history. Prosecution history estoppel most frequently arises when an applicant has narrowed the literal scope of the patent claims during prosecution, and later seeks, on the basis of the doctrine of equivalents, to assert the patent against subject matter that was within the literal scope of the original claims but that is outside of the literal scope of the issued (narrowed) claims. If prosecution history estoppel applies, it will prevent the patent owner from asserting that the subject matter in question is covered by his patent, even if, under the applicable standard for determining equivalence, that subject matter is, in fact, equivalent to the subject matter literally included in the issued patent claims.

The doctrine of prosecution history estoppel as a restriction to the application of the doctrine of equivalents has been a feature of the American patent system for a considerable time. A classic exposition of the reasoning upon which the rule is based is given in the 1942 Supreme Court decision in the case of *Exhibit Supply Co. v. Ace Patents Corp.*<sup>4</sup>:

Whatever may be the appropriate scope and application of the doctrine of equivalents, where a claim is allowed without a restrictive amendment, it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee has surrendered by amendment.

\* \* \*

By the amendment he recognized and emphasized the difference between the two phrases and pro-

claimed his abandonment of all that is embraced in that difference.

In a typical example, an applicant responds to a rejection of a broadly formulated claim contained in the original application by narrowing the claim either by adding an additional element or by narrowing an existing element. Thus, for example, the original claim „the device comprising A, B and C“ is narrowed by adding the element X, so that the amended claim reads: „the device comprising A, B, C and X.“ The alleged infringer sells a device comprised of elements A, B, C and Y. If prosecution history estoppel is applicable, the patentee is precluded, as a matter of law, from even asserting that element Y is the equivalent of element X in the claim. By way of further example, the original claim „the device comprising A, B, C and D“ is narrowed by changing the element D to D<sup>I</sup>, D<sup>I</sup> being a limited version of the element D. Thus, the amended claim reads: „the device comprising A, B, C and D<sup>I</sup>.“ The alleged infringer sells a device comprised of elements A, B, C and D<sup>II</sup>. D<sup>II</sup> would have been covered by D, but is not covered by D<sup>I</sup>, so that the device A, B, C and D<sup>II</sup> at issue does not literally infringe the amended claim A, B, C and D<sup>I</sup>. By changing D to D<sup>I</sup>, the applicant has surrendered the literal protection for D<sup>II</sup>. If prosecution history estoppel is applicable, the patentee is precluded, as a matter of law, from asserting that element D<sup>II</sup> is the equivalent of element D<sup>I</sup> in the claim. Because the applicability of prosecution history estoppel is a question of law, it is decided by the judge, even in a jury trial. Thus, in the above described cases, if prosecution history estoppel is applicable, the questions of whether Y is equivalent to X, or D<sup>II</sup> is equivalent to D<sup>I</sup>, ordinarily questions of fact for a jury to decide, would never be presented to the jury.

When considering whether prosecution history estoppel is applicable in a given case, the Federal Circuit had, in the past, typically concerned itself, *inter alia*, with two fundamental questions. First, the reason for narrowing a claim during prosecution had to be established. In most older decisions of the Federal Circuit, the court took the position that only those claim limitations introduced because of prior art cited by the Examiner could trigger a prosecution history estoppel, and that instances of narrowing due to other requirements of the Examiner, for example due to an objection raised on the basis of §112 of the patent law, normally did not create any prosecution history estoppel<sup>5</sup>.

<sup>1</sup> Richard L. Mayer is a partner of the law firm Kenyon and Kenyon/New York and author of commentary „Das US-Patent“ (Carl Heymanns Verlag KG), which will be available in due time.

<sup>2</sup> 122 S. Ct. 1831; 62 U.S.P.Q. 2d 1705 (2002)

<sup>3</sup> 234 F.3d 558, 56 U.S.P.Q. 2d 1865 (Fed. Cir. 2000)

<sup>4</sup> 315 U.S. 126, 62 S.Ct. 513, 52 U.S.P.Q. 275 (1942)

<sup>5</sup> See for example, *Mannesmann Demag Corp. V. Engineered Metal Products Co., Inc.* 793 F.2d 1279, 230 U.S.P.Q. 45 (Fed. Cir. 1986)

In its decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*<sup>6</sup>, the Supreme Court assessed this state of affairs somewhat differently. According to this decision, every narrowing of a claim undertaken to attain patentability of the claim („a substantial reason related to patentability“) gives rise to a prosecution history estoppel. In those cases in which no reason for an amendment to a claim can be determined from the prosecution history, the Supreme Court ruled that there exists a presumption that the amendment was made to secure allowance of the claim (i.e., the amendment is related to patentability), so that a prosecution history estoppel would result. The patent owner can, within the context of later infringement proceedings, attempt to rebut this presumption and to establish another reason for the narrowing of the claim. However, if no evidence is available to him to accomplish this, the presumption remains and, thus, prosecution history estoppel is applicable.

The second fundamental question with which the Federal Circuit repeatedly concerned itself in its decisions concerns the extent of the prosecution history estoppel caused by narrowing of a claim. Which potential equivalents are precluded? In many of its older decisions, the court promulgated a very flexible ruling. Even if the claim had been narrowed in response to prior art, so that a prosecution history estoppel might result therefrom, a determination of equivalents was not necessarily precluded. In each case, a determination had to be made as to what the applicant had given up by narrowing the claim, and to what extent this surrender of subject matter precluded a later assertion of equivalents. The Federal Circuit was of the opinion that the preclusion could be from 0 to 100%<sup>7</sup>. In the second example above, even assuming that element D was narrowed to D<sup>I</sup> in order to distinguish the claim from the prior art, it would not necessarily follow that prosecution history estoppel bars the patentee from asserting equivalence between element D<sup>I</sup> in the claim and element D<sup>II</sup> in the accused object. In accordance with this earlier Federal Circuit approach, this could only be determined on a case by case basis. If, in another case, an element D<sup>III</sup> rather than element D<sup>II</sup> were present in an accused object, the decisions as to the applicability of prosecution history estoppel in the two cases could be different.

This „flexible bar“ ruling of the Federal Circuit was not uniformly applied by the courts, however, and, in any case, caused considerable uncertainty when assessing the preclusive effect of a prosecution history estoppel as a limitation to the application of the doctrine of equivalents.

In its *en banc* decision rendered in November, 2000, in the *Festo* case, the Federal Circuit undertook the task of clarifying these ambiguities and uncertainties. To sum-

marize, the Federal Circuit made the following three rulings in its *Festo* decision:

1. Every narrowing of a claim undertaken in the course of prosecution to satisfy the requirements of the patent law with reference to the patentability of the claim triggers a prosecution history estoppel. The applicability of prosecution history estoppel is not restricted to limitations undertaken to distinguish prior art.
2. That a claim is limited voluntarily (i.e., not in response to an objection or rejection by the Examiner) is irrelevant. Such limitation triggers prosecution history estoppel to the same degree as if the limitation had resulted as a consequence of an Examiner's action.
3. If the narrowing of a claim in the course of prosecution results in prosecution history estoppel, no range of equivalents is available for the limiting element (X in the first example above) or for the limited element (D<sup>I</sup> in the second example above). Thus, the Federal Circuit had completely reversed its earlier flexible ruling regarding the application of a prosecution history estoppel.

Twelve judges of the Federal Circuit participated in the *en banc* decision in the *Festo* case. With respect to rulings 1 and 2, the judges were nearly unanimous. Regarding ruling 3, a minority of four Federal Circuit judges rendered detailed, dissenting opinions to the effect that the prior flexible rule, according to which prosecution history estoppel should not result in a complete bar to the application of equivalence, should be maintained.

Because the Federal Circuit decision raised considerable doubts within patent circles, particularly with respect to the categoric nature of ruling 3 and because the *Festo* decision supposedly represented a considerable departure from prior Supreme Court and also Federal Circuit precedents, the Supreme Court agreed to accept the *Festo* case for further review of the Federal Circuit rulings 1 and 3.

The Supreme Court's *Festo* decision was rendered in May, 2002. In this decision, the Supreme Court affirmed ruling 1 of the Federal Circuit decision: every narrowing of a claim undertaken to ensure the patentability of the claim triggers a prosecution history estoppel. The Supreme Court did not review ruling 2 of the *Federal Circuit* decision so that ruling remains in effect.

However, the Supreme Court rejected ruling 3 which prescribed an absolute preclusion of the possibility of equivalents for a claim element introduced to narrow a claim or a claim element narrowed during prosecution. While reversing this ruling, the Supreme Court nevertheless reaffirmed, the ruling of the *Exhibit Supply* decision which underlies the principle of prosecution history estoppel, namely that an area of literal claim coverage surrendered by the narrowing of a claim cannot be recaptured by application of the doctrine of equivalents. According to the Supreme Court decision, however, an absolute preclusion of equivalents in this area is not appropriate. The rejected Federal Circuit ruling may well

6 520 U.S. 17, 41 U.S.P.Q. 2d 1865 (1997), affirming 62 F.3d 1512, 35 U.S.P.Q. 2d 1641 (Fed. Cir. 1995)

7 See, for example, *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 219 U.S.P.Q. 473 (Fed. Cir. 1983), *La Bounry Mfg. Inc. v. United States Int'l Trade Comm'n*, 867 F.2d 1572, 9 U.S.P.Q. 2d 1995 (Fed. Cir. 1989). The Federal Circuit maintained this position until 1998. See *Litton Systems v. Honeywell Inc.*, 140 F.3d 1449, 46 U.S.P.Q. 2d 1321 (Fed. Cir. 1998)

have provided certainty when determining the scope of a claim; however, certainty is not the sole criterion for a satisfactory rule. There are situations, even in the case of the narrowing of claim coverage, in which the patentee should still have the possibility of asserting equivalency. There are circumstances where the narrowing of a claim is not necessarily to be equated with the surrendering of all possible equivalents in the abandoned area.

Instead of the absolute bar to equivalents, the Supreme Court promulgated another rule. In the case of a claim limitation in the course of prosecution which would, as such, trigger prosecution history estoppel, a presumption exists that all equivalents in the abandoned area were surrendered. However, this presumption is rebuttable. The burden of proof on this issue is on the patentee, and, to rebut the presumption, he must prove that that equivalent was not surrendered by the narrowing of the claim. As to how the patentee could possibly rebut this presumption, the following language from the Supreme Court decision is particularly germane:

There are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.

\* \* \*

The patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.

Thus, the Supreme Court offered unforeseeability and the limitations of language as two specific circumstances which might permit a patent owner to assert equivalency, despite the narrowing of a claim which would otherwise result in prosecution history estoppel.

The practical utility of these suggested ways to circumvent prosecution history estoppel is hard to foretell. How readily, for example, will the patent owner be able to establish that, during prosecution, the applicant could not have drafted a claim which would literally have encompassed the alleged equivalent while excluding the prior art cited against the original broader claim? Moreover, while the „unforeseeability“ of an alternative to a claimed element may avoid the application of prosecution history estoppel, how likely is it that such an alternative will meet the substantive test („insubstantially different“) of equivalence?

Until there are further decisions, particularly by the Federal Circuit, and also by trial courts, interpreting and applying this new ruling (which in no way merely restores the status quo prior to the Federal Circuit *Festo* decision), the impact of the Supreme Court decision will be difficult to assess or evaluate.

## Greeting address

W. Baum (DE)

It happens, that the first 100-day period since I started work in my new function as Secretary General coincides approximately with the 25<sup>th</sup> anniversary of our Institute. Let me take this opportunity to address you all, the members of the *epi*.

You can imagine that running the secretariat for our Institute with about six and a half thousand members causes a considerable daily workload in correspondence, organising and managing the daily routine. In this respect it seems to be worthwhile to have in mind the long-range targets of our profession.

We, the professional representatives before the EPO, have to be responsible actors in the „opera which is called the European patent system“ (an illustration used by the former president of UNICE, Dr. Heimbach, in his laudatio on the occasion of the 10<sup>th</sup> anniversary of the EPO). No doubt, the said role of taking part in the further

development of the European patent system consequently includes the task to create, to install and to perform the next act in the said opera, namely the Community Patent. We, the professional representatives, have to face the responsibility as co-composers that the coming act in the European patent system will not be a dull and boring performance, but an attractive system leading to causing the applause of all potential users. Even a cursory view over the commercial and industrial situation in the world shows us that today's globalisation provokes the danger of the uncontrolled worldwide transfer of technical know-how and research results, and this without doubt is one of the reasons behind the rising number of patent applications and industrial property rights worldwide. Against the background of this worldwide development our profession

plays a key role, the social political relevance of which will increase further.

Under these circumstances, it seems to be one of our major tasks to promote and assist increasing collaboration between the national professional organisations and our Institute, thus creating the prerequisite to over-

come any hindrance and any lack of European spirit on our way through the next 25 years. The secretariat is prepared to support and assist you all in mastering the said tasks and wishes you a pleasant anniversary seminar in Stratford upon Avon.

## Comment on „Impact of EPO Limitations (on acting as ISA and/or IPEA) from a U.S. perspective“ (epi Information 2/2002)

R. Maury (GB)

I found the letter on „Impact of EPO Limitations (on acting as ISA and/or IPEA) from a U.S. perspective“ from R.G. Sharkey and W.T. Christiansen interesting, especially where they say that US applicants would pay the EPO extra for their superior search, for the subject-matter areas now excluded. It struck me then that, if they are not already doing so, US applicants, or indeed any applicants, might wish to buy an EPO „standard“ (i.e. contractual) search – those searches are available for all subjects and all applicants within 3 to 6 weeks of the request, if urgent.

The applicant would request the standard search and pay the fee of 1738 euros (about \$1900), accompanied by a copy of the first-filed US application, or of a PCT application claiming priority from it – say 6 to 18 months from the priority date. The EPO say that they need 6 or 7 months for publications to be entered onto their search databases, so a delay of this sort of time between the

priority date and the EPO search is desirable for the quality of the search. The EPO standard search report would issue whilst the PCT application is still in the international phase, and quite likely even before the international search report issues on the application. The applicant would then have time to review both search reports before committing to regional and national phase applications.

Assuming the application proceeds to the EPO regional phase, the official search fee (690 euros or about \$760) would need to be paid in full, but it would be refundable in due course, to the extent that the standard search would assist the later search – in most cases, the refund would be 100%. Thus the extra cost by this route would be about \$1900-760 = 1140.

I should think that this route ought to be attractive to many US applicants, and I would welcome comments from anyone who has already used it.

## European Patents<sup>1</sup>, by Lise Dybdahl<sup>2</sup>

T. Onn (SE)

After having dealt with this topic in a Danish and German edition Lise Dybdahl's book has now been published in an English edition. This is not merely a translation of the earlier editions but also a revision, which has been updated with the recent development and decisions in this field.

This book includes a list of abbreviations as well as a survey of recent literature on European patents. It is very satisfactory to see the number of books that has been published during the last decade on this topic. As a

reader one may think that it will be superfluous with still another book on European patents, but after having read Ms. Dybdahl's book you realize that this is a worthwhile book.

The European Patent Convention, EPC, and the European Patent Organization, EPO, are presented in the two introductory chapters. They describe the historical background from the 40s onwards with the creation of the IIB in the Hague and all the various vicissitudes leading to the Munich agreement in 1973 and the creation of EPC. The so far fruitless discussions on a Community patent system are also described. There is also a good presen-

<sup>1</sup> Carl Heymanns Verlag, 2001.

<sup>2</sup> Lise Dybdahl, Director, Head of the Legal Division, EPO.

tation of the European Patent Organization and its structure, giving a brief introduction of the Directorates General, the procedure of the office and some statistics.

After this introduction Lise Dybdahl enters the field of substantial law and its application at the EPO. In the chapter on Patentability she gives a detailed survey on inventions that are excluded from patent protection according to Article 52(2) EPC. Here is described the current practice and the reasons for the exclusion of some areas from patent protection. She then describes „Industrial application“ under Article 57 EPC and ends this chapter with the various patent categories (*inter alia* product, process and use patents etcetera). She even mentions the revised EPC and that in the future Article 54, when entering into force, there will be no exception of patentability for a known substance or composition for a specific use that is novel.

The Novelty chapter discloses how novelty is established by searches at the EPO. It is discussed how a European patent application as well as oral disclosure and public use affects novelty. It is further discussed in connection with selection inventions, first medical use, second and further medical as well as non-medical uses. The inventive step concept is introduced by presenting the problem-solution approach used at the EPO. In this approach, the closest prior art is determined, the technical problem defined and the obviousness of the invention is determined in the light of the closest prior art. In this chapter she also gives an analysis of the interpretation of the expression „the man skilled in the art“.

The book also covers the importance of priority. This should be of special interest to candidates of the European Qualifying Examination, EQE, as questions on priority seem to be a pitfall for many candidates. Further topics that are covered are the requirements of a European patent application, including a special emphasis on inventions in the biotech field and unity of invention. Amendments of an application during prosecution and after grant are illustrated and a special interest is directed towards the conflict situation that in this context may occur between Article 123(2) and 123(3). Another chapter discusses the rights to a European patent, its transfer and licensing.

Naturally the most comprehensive chapter concerns the procedures before the EPO. Oral proceedings and taking of evidence are discussed and it is *inter alia* evident that opinions by experts do not play an important role before the opposition divisions or the boards of appeal. Ms. Dybdahl also discusses the standard of proof that is required by different EPO bodies in various situations. The reader finds that the boards of appeal as a

rule apply the „balance of probabilities“ as a standard. Further he/she can read about some principles that the boards of appeal practice concerning the burden of proof, namely that the applicant bears the burden of proof for facts talking in his favour in *ex parte* proceedings. In opposition proceedings the patent proprietor enjoys the benefit of the doubt if the opposing party allege that a patent should be revoked.

As in all patent systems the time limits are vital and the different time limits of the European system are also disclosed. The possibility of re-establishing of rights according to Article 122 for an application in which a time limit has passed is discussed quite extensively. The requirement „all due care“ and how this is met is discussed *inter alia* by defining the requirements for different categories of persons (applicant, professional representative, assistant etcetera). The system with representation, European patent attorneys (EPA) and how this works is presented as well as the EQE and the qualification to become an EPA. The *epi* is also presented. The chapter concludes with more everyday practice like formalities examination, search, substantive examination, the opposition and appeal procedure, together with a presentation of the boards of appeal, the Enlarged Board of Appeal and their different functions.

The book ends with chapters on the language arrangement, *inter alia* giving the present situation in the London agreement on dispensation with the translation requirements. Further the PCT system and the Euro-PCT applications are dealt with having a natural emphasis of EPO in its role as International Receiving Office, as International Search Authority and International Preliminary Examining Authority. Ms. Dybdahl has also foreseen the amendment of Rule 107 EPC that entered into force this year (extending the 21 months term to 31 months). The final chapter of the book gives a brief presentation of the rights conferred by a European patent.

To summarize Ms. Dybdahl has presented a book that is easy to read and has good current case law footnotes. Further the book contains a very good index, which refers to marginal numbers instead of the traditional references to pages. This really facilitates for the reader to find the relevant paragraph when looking for a special question. This is a worthwhile book for anyone wanting an introduction to the European patent system, for candidates studying for the European Qualifying Examination and also for professional patent attorneys who in this book will find a quick way to relevant case law.

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