

eipi Information

Institut der beim Europäischen Patentamt
zugelassenen Vertreter

Institute of Professional Representatives
before the European Patent Office

Institut des mandataires agréés près
l'Office européen des brevets

Beilagenhinweis: Dieser Ausgabe liegt das Jahresinhaltsverzeichnis 2008 bei.

Heft · Part · Fascicule 4 Dezember · December · Décembre 2008



Carl Heymanns Verlag

ISSN 1434-8853

2008 **4**



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Verlag · Publishing House · Maison d'édition

Carl Heymanns Verlag GmbH
Ein Unternehmen von Wolters Kluwer Deutschland
Luxemburger Straße 449
D-50939 Köln
Tel. (0221) 94 373-7000
Fax (0221) 94 373-7201
Kundenservice: Tel. (02631) 801-2222
e-mail: info@wolterskluwer.de
<http://www.heymanns.com>

Anzeigen · Advertisements · Publicité

Carl Heymanns Verlag GmbH
Ein Unternehmen von Wolters Kluwer Deutschland

Druck Printing Imprimeur

grafik + druck, München

ISSN 1434-8853

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Vierteljahreszeitschrift

Abonnement im Mitgliedsbeitrag enthalten,
für Nichtmitglieder € 42,00 p. a. zzgl. Ver-
sandkosten (€ 9,90 Inland / € 14,00 Aus-
land), Einzelheft € 12,60 zzgl. Versandkos-
ten (ca. € 2,27 Inland / ca. € 3,20 Ausland)
je nach Heftumfang. Preise inkl. MwSt. Auf-
kündigung des Bezuges 6 Wochen vor Jah-
resende.

Quarterly Publication

Subscription fee included in membership fee,
for non-members € 42,00 p. a. plus postage
(national € 9,90 / abroad € 14,00), indivi-
dual copy € 12,60 plus postage (national
about € 2,27 / abroad about € 3,20) de-
pending on the size of the issue, VAT inclu-
ded. Cancellation of subscription is requ-
ested 6 weeks before any year's end.

Publication trimestrielle

Prix d'abonnement inclus dans la cotisation,
pour non-membres € 42,00 p. a., frais d'en-
voi en sus (national € 9,90 / étranger
€ 14,00), prix à l'unité € 12,60, frais d'en-
voi en sus (national environ € 2,27, étran-
ger environ € 3,20) selon le volume du nu-
méro, TVA incluse. Résiliation de l'abonne-
ment 6 semaines avant la fin de l'année.

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Editorial

T.L. Johnson (GB)

The global credit crunch has hit us all since our last issue. No doubt some of our members foresaw the coming of the crisis. Be that as it may, the current financial situation will impact on all our Member firms, we hope not unfavourably. However, in times of adverse economic conditions, our experience is that clients (employers for those of our Members „in house“) tend to embark on patent filing programmes and also take the initiative in instigating contentious matters, in order to gain an advantage over competitors, and to position themselves in the market for when there is an upturn in the economic cycle. All the economic turmoil, global in effect, has not detracted from global warming, bringing as it does *inter alia* climate change, extreme weather, and melting of the ice caps. All this is generally considered to be a bad thing. What we find interesting is that the climatic arena has given its name to a phenomenon in our field, namely „global patent warming“. By this is meant, we understand, the increase in backlogs in patent offices, including the EPO. This increase, it is said, could lead to grid lock.

But is global *patent* warming a bad thing? We have given our opinion before that it seems to us that, the current „crunch“ excepted, the next phase of economic

and indeed political competition will not be over territory or economies, but over IP. In this context, companies will increasingly file patent applications and indeed in certain cases will be encouraged to do so by their governments. „Global patent warming“ is thus a natural development. Applicants will use the systems available to them. So an increase in pending backlogs is not unexpected. As partners with the Office, we in the Institute should do what we can to make sure that the EPC system is used efficiently, to everyone's advantage. For example, as attorneys we should endeavour to balance the needs of our clients with the need for quality drafting and responses, to assist the Examining Divisions in their work.

A good global patent warming effect proves the IP system is needed, and will continue to be used. Let's make it work.

Meanwhile, have you heard the one about the 313 PCT applications filed on one day at the EPO Berlin Office for the same applicant? No joke, and the applications were filed in hard copy. An example of global patent warming! (Can any reader compute how much in fees might have been saved had the applications been filed on-line?...)

Nächster Redaktionsschluss für epi Information

Informieren Sie bitte den Redaktionssausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der epi Information ist der **2. Februar 2009**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of epi Information is **2nd February 2009**. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour epi Information

Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de epi Information est le **2 février 2009**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Bericht über die 65. *epi*-Ratssitzung München, 24.–25. November 2008

Der Präsident des *epi*, Herr Kim Finnilä, eröffnete die Sitzung und hieß die neuen Ratsmitglieder aus Kroatien und Norwegen willkommen. Diese Sitzung war die erste unter der neuen *epi*-Geschäftsordnung, die sich u. a. auf die Befugnisse des Präsidiums, des Vorstands, des Rats und der verschiedenen Ausschüsse bezieht und nach den Worten des Präsidenten eine Änderung im Umfeld des *epi* mit sich bringt.

Nach der Annahme der ebenfalls neu strukturierten Agenda wurde das Protokoll der vorangegangenen Sitzung besprochen, geändert und angenommen. Danach wählte der Rat einige neue Vorstands- und Ausschussmitglieder.

Unter den Punkten: „Berichte von Präsident und Vize-Präsidenten“ berichtete der Präsident insbesondere über seine Sitzungen mit einer Anzahl von Ausschüssen und über seine Teilnahme an der Verleihungsfeier der Europäischen Eignungsprüfung.

Das Hauptthema im Bericht des Generalsekretärs war, dass 2009 die 66. Ratssitzung eine eintägige Sitzung im Mai in Luxemburg sein wird, gefolgt von einer weiteren eintägigen Sitzung im Oktober in Düsseldorf. Der Rat diskutierte über diese neue Situation, deren Schwerpunkt mehr in substantiellen Tagesordnungspunkten und weniger auf internen *epi*-Angelegenheiten liegen wird.

Dann berichtete der Präsident über Neuerungen im Bereich „Ausbildung“, insbesondere über die Tätigkeit des neuen *epi*-Direktors für Ausbildung, der einige Projekte vorbereitet.

Die gute Nachricht seitens des *epi*-Finanzausschusses und des Schatzmeisters war, dass der Jahresbeitrag 2009 weiterhin 160 EUR betragen wird. Derzeit stehen mehr als 8800 Mitglieder auf der Liste. Der Schatzmeister sagte, dass künftig mehr Geld für Ausbildungsaktivitäten ausgegeben werden wird. Der Rat genehmigte den Mitgliedsbeitrag und den Haushalt.

Der Rat besprach auch mögliche Verbesserungen des PCT-Systems, insbesondere im Hinblick auf die Recherchetätigkeiten. Eine lange Diskussion entspann sich um ein *epi*-Positionspapier zum allgemeinen Umriss einer künftigen europäischen Patentgerichtsbarkeit. Die Diskussion beinhaltete auch die Frage nach den teilnehmenden Vertragsstaaten, der Beziehung zur EU, dem Kassationsgerichtshof und insbesondere der Möglichkeit der Vertretung durch *epi*-Mitglieder. Das Positionspapier wurde nach einigen Änderungen mit großer Mehrheit angenommen. Die Arbeitsgruppe für die Überarbeitung der Vorschriften für die Europäische Eignungsprüfung, eine wichtige Angelegenheit für das *epi*, vertrat den Standpunkt, mit dem EPA weitere Verhandlungen zu führen, z. B. dass die Europäische Eignungsprüfung in jeder Sprache der Vertragsstaaten abgelegt werden kann. Am Ende des ersten Tages wurde der Bericht des Disziplinarausschusses besprochen.

Der zweite Sitzungstag begann mit einer Demonstration des *epi*-Extranet durch den Schriftleitungsausschuss, das die Kommunikation innerhalb des *epi* beschleunigen und vereinfachen wird. Die Folgen des Extranets und seine Entwicklung wurden von einigen Ratsmitgliedern diskutiert. Der Geschäftsordnungsausschuss berichtete, dass die neue *epi*-Geschäftsordnung jetzt wieder für die Allgemeinheit auf der *epi*-Website zur Verfügung steht. Der EPPC (der sich u. a. mit der Zuweisung der Frage der Patentierbarkeit Computer gestützter Erfindungen durch die Präsidentin des Amts an die Großen Beschwerdekammern sowie eines Amicus curiae des *epi* beschäftigte) und weitere Ausschüsse wie der Ausschuss für EPA-Finzen legten dem Rat Papiere vor. Ebenso wurden verschiedene Berichte von *epi*-Gremien bezüglich Sitzungen und Tätigkeiten anderer beruflichen Organisationen, an denen das *epi* teilnahm, besprochen.

Bevor er die Sitzung schloss, dankte der Präsident den Ratsmitgliedern für ihre aktive Teilnahme.

Nächste Ausgaben · Forthcoming issues · Prochaines éditions

<u>Issue</u>	<u>Deadline</u>	<u>Publication</u>
1/2009	2 February	27 March
2/2009	11 May	17 July
3/2009	17 August	30 September
4/2009	26 October	21 December

Report on the 65th *epi* Council Meeting Munich, 24-25 November 2008

The President of the *epi*, Mr. Kim Finnilä, opened the meeting by welcoming the new Council delegates from Croatia and Norway. This meeting was the first meeting to which the new *epi* By-Laws applied, relating inter alia to the powers of the Presidency, the Board, the Council and the various Committees and which – in the words of the President – bring about an environmental change for the *epi*.

After the adoption of the Agenda, which was also given an amended structure, the Minutes of the previous meeting were discussed, amended and approved. Thereafter, a number of new Board and Committee members were elected by Council.

From among the items in the President's and Vice-Presidents reports the President specifically referred to his meetings with a number of Committees and to his attending the EQE award ceremony.

The interesting point in the Secretary General's report was that in 2009 the 66th Council meeting will be a one day meeting in Luxembourg in May, followed by another one day Council meeting in Düsseldorf in October. The Council discussed this new situation which will focus on more substantive issues, less on internal *epi* matters.

The President then reported on education, in particular the activities of the *epi*'s new Director on Education who is developing a number of projects.

The good news from the *epi*'s Finance Committee and the Treasurer was that the membership fee will remain at EUR 160 in 2009. There are currently more than 8800 members on the list. The Treasurer emphasized that more money will be spent on educational activities in the future. The Council approved the membership fee and the budget.

The Council also discussed possible improvements to the PCT system, in particular as regards the search activities. A long discussion evolved around an *epi* position paper to the general outline of the Draft Agreement on the future European Patent Jurisdiction. The discussion included the question of contracting states, the relationship to the EU, the Court of Cassation and in particular possible representation activities by *epi* members. The position paper after some amendments was adopted by a large majority. The task group on the Revision of the Regulation on the European Qualifying Examination (REE), an important matter for the *epi*, presented the status of the ongoing negotiations with the EPO, for example that the EQE can be taken in any language of the contracting States. At the end of the first day, the Disciplinary Committee report was discussed.

On the second day the meeting commenced with the demonstration of the *epi* Extranet by the Editorial Committee which will speed up and ease communication within the *epi*. The implications of the Extranet and its development were considered by a number of Council members. The By-Laws Committee reported that the *epi* by-laws are now on the *epi* website for the general public. The EPPC (dealing inter alia with the referral of the President of the Office to the Enlarged Boards of Appeal the question of computer implemented inventions and an *epi* amicus curiae) and other Committees, such as the EPO Finances Committee submitted papers to the Council, and likewise various reports of *epi* bodies regarding meetings with the outside world and activities of professional associations collaborating with the *epi* were presented.

Before closing the meeting the President thanked the Council members for their active participation.

Compte-rendu de la 65ème Réunion du Conseil de l'*epi* Munich, 24-25 novembre 2008

La séance fut ouverte par M. Kim Finnilä, Président de l'*epi*, qui a souhaité la bienvenue aux nouveaux délégués de Croatie et de Norvège. Cette première session du Conseil s'est déroulée sous le régime des nouvelles dispositions du Règlement Intérieur à présent en vigueur, lesquelles fixent notamment les pouvoirs du Président, du Bureau, du Conseil et des diverses commissions, ce qui – selon l'expression du Président – apporte un changement significatif à l'environnement de l'*epi*.

Après l'adoption de l'agenda, lequel a reçu également un nouveau format, le compte-rendu de la réunion

précédente du Conseil fut discuté, révisé puis approuvé. Suivit alors l'élection d'un certain nombre de nouveaux membres du Bureau et du Conseil.

Parmi les éléments figurant au „rapport du Président et des Vice-Présidents“, le Président a souligné ses nombreuses réunions avec un certain nombre de Commissions ainsi que sa participation à la cérémonie de remise des prix EQE.

On notera avec intérêt dans le Rapport du Secrétaire Général que la 66ème réunion du Conseil qui se tiendra au Luxembourg au mois de mai 2009 se déroulera sur

une seule journée. La réunion du Conseil qui suivra, d'une seule journée également, se tiendra à Düsseldorf en octobre 2009. Une discussion s'est engagée au sujet de cette nouvelle situation, laquelle conduira le Conseil à se concentrer davantage sur des problèmes de fond, et moins sur les affaires internes de l'*epi*.

Le Président a ensuite rendu compte en matière de formation professionnelle et notamment des activités du nouveau Directeur de la Formation Professionnelle de l'*epi* et des projets en cours de développement.

Une bonne nouvelle de la part de la Commission des Finances et du Trésorier, à savoir que la cotisation des membres sera maintenue à 160 Euro en 2009. Plus de 8800 membres sont inscrits actuellement sur la liste. Le trésorier a évoqué les ressources supplémentaires qui seront allouées à l'avenir aux activités en matière de formation. Le budget ainsi que le montant de la cotisation furent approuvés par le Conseil.

Il s'ensuivit un débat au sein du Conseil sur la question des améliorations potentielles envisagées au système du PCT, en particulier en ce qui concerne les activités de la recherche. Il y eut une longue discussion, en marge d'une prise de position de l'*epi* concernant le projet d'accord portant sur la future juridiction en matière de brevet européen. La discussion a porté sur la question des Etats contractants, les relations avec l'Union Européenne, la Cour de Cassation et notamment la question particulière de la représentation pour les membres de l'*epi*. Le document de prise de position fut adopté par une large majorité à la suite de quelques modifications. Le groupe de travail sur la révision de la réglementation

de l'examen européen de qualification (REE) – question importante pour l'*epi* – présenta l'état des négociations en cours avec l'OEB, par exemple le fait que l'examen doit pouvoir être présenté dans n'importe quelle langue des Etats contractants. Le rapport de la Commission de discipline fut évoqué et discuté à la fin de la première journée de session.

La seconde journée commença par une démonstration de l'Extranet par le Comité de Rédaction. Cet outil permettra d'accélérer et de faciliter la communication au sein de l'*epi*. Les implications de l'Extranet et son développement furent abordés par le Conseil. La Commission du Règlement Intérieur a rendu compte et confirmé que le Règlement Intérieur de l'*epi* se trouve à présent sur le site de l'*epi*, disponible au grand public. La Commission EPPC présenta son compte-rendu d'activités et évoqua notamment la saisine de la Grande Chambre de Recours par le Président de l'OEB au sujet de la question de la brevetabilité des inventions mettant en oeuvre un programme ordinateur et l'opportunité d'une „Amicus Curia” à ce sujet. D'autres commissions, au rang desquelles la Commission des Finances de l'OEB, ont rendu leur rapport respectif et informatif. De manière similaire, de nombreux compte-rendus furent présentés par des organes de l'*epi*, sur des réunions avec des tiers et sur les activités des associations professionnelles collaborant avec l'*epi*.

Avant de clôturer la session, le Président remercia chaleureusement les membres du Conseil pour leur participation active.

Treasurer's report

Claude Quintelier (BE)

1. Half year account

1.1 Income

On January 1, 2008 there were 8 875 *epi* members. Of those 130 were deleted in the period running from January 1 to June 30, 2008. 60 new members entered the list and 336 members had not paid their contribution. No particular changes were observed in the payment behavior of our members. About 6.25 % of the *epi* members used the credit card payment possibility.

The rather low amount of received interest is due to the fact that the majority of *epi* assets have an interest payment term in the second half year.

The income on education was rather low as only a few seminars were organized in the first half year after the EPC 2000 came into force. However in the second half year a seminar in Eindhoven and Istanbul has already

taken place. On November 10 -12 a Mock EQE took place in Helsinki.

With respect to CPE seminars, a new policy was introduced as participants will now only be admitted to participate in a seminar if their payment was received on beforehand. Too much time has been spent by the personnel in the *epi* secretariat in chasing those who did not pay!

1.2 Expenses

Postage costs are already over budget, mainly due to elections. The *epi* secretariat has been asked to control the postage expenses quite closely.

The costs for Personnel and auxiliaries (4.4) are high, due to increased auxiliary personnel and a premium which was allotted to the permanent staff members in compensation of the amount of work they did. Indeed

the backlog caused by the illness of one staff member and the work related to the EPC 2000 seminars and elections caused a substantially higher workload for the staff.

The costs under the computer costs post are caused by new computers, which were bought.

Although only two CPE seminars took place in the first half year, the costs amount under education is caused by payments for EPC 2000 seminars which took place in 2007 and by the CEIPI/*epi* seminars, for which the contribution was paid in 2008.

1.3 Miscellaneous

The organization of the Nurnberg Council meeting and the Munich Board meeting caused a V.A.T. reimbursement of 45 056 €. It is thus advantageous to organize Council and Board meetings in Germany!

2. Budget 2009

The 2009 budget is based on 8 950 members and on an unchanged contribution of 160€.

On the expense side an inflation correction is applied on Board and Committee meetings, taking also into

account that the numbers of participating members will increase due to accession of the new countries.

In view of the fact that Council meetings will each only take one day in 2009, the expense post for Council meeting could be reduced with respect to 2008, even taking into account inflation.

The rent of the secretariat office will increase, according to the contract with the landlord, and this has been taken into account in the 2009 budget. Also the office supply post was increased with respect to 2008 as some new furniture will be required. Investigation for buying an office building had no results, as no suitable offer could be found. There is a lot to rent and nearly nothing to buy. Investigation for renting another office space is now being undertaken.

20 000€ has been reserved for an audit on the operation of the *epi* secretariat. 65 000 € is foreseen for the staff manager.

A deficit of 39 900 € is foreseen, mainly due to the audit and the furniture costs. As these are non-yearly repeating items, the deficit should be admissible.

epi Artists Exhibition 2009

As reported in issue 2/2008 of *epi* Information the next *epi* Artists Exhibition will be held from

19 February to 6 March 2009

at

European Patent Office

PschorrHöfe building

Bayerstraße 34, Munich.

The opening will take place on Thursday, 19 February 2009 at 6 p.m.

For further details please contact:

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Report on the EPO/*epi* Biotech Committee Meeting of Wednesday 24 October 2007

A. De Clercq (BE)
Chairperson

In Attendance:

Maria Fotaki (MF, dir. 1212, the Hague)
Reinhard Hermann (RH, dir. 2402)
Bernd Isert (BI, dir. 2404)
Uli Thiele (UT, dir. 2403)
Siobhán Yeats (SY, dir. 2406)
Victor Kaas (VK, dir)

Ann De Clercq (AdC) – BE
Dieter Wächter (DW) – CH
Gunther Keller (GK) – DE
Bo Hammer Jensen (BHJ) – DK
Anne Desaix (AD) – FR
Arpad Petho (AP) – HU
Simon Wright (SW) – GB
Bart Swinkels (BS) – NL
Gabriela Staub (GS) – IT
Dieter Wachter (DW) – CH
Francisco Noriega (FN) – ES
Gabriele Leissler-Gerstl (liaison member of EPPC)

Introduction

1. Stem cells (G2/06) and Referrals to Enlarged Board

Fernand Eiden sent his apologies for not being able to attend. ADC thus chaired the meeting and thanked the EPO for yet another one of these meetings, and hoped that it will be as equally productive as previous ones. The *epi* has provided Minutes of the previous meeting, since approved by the EPO. A consolidated document covering both previous meetings will be prepared and sent to the EPO for approval before publication of the *epi* journal. We will prepare a further set for this meeting too.

2. Function of genes and proteins

On G2/07 the *epi* will submit an amicus brief, probably arguing for a narrow interpretation. On G1/07, *epi* will also submit a brief by the end of the month. The stem cell case has priority before the EBA (and G2/06) as it is more political. For G1/07, the purpose of the method may be important (the background case law is T542/06 and T924/05). The administration route (by injection or otherwise) may be irrelevant, and the EPO will look at the description for the background purpose and whether one can omit the administration step (either as an inessential feature, under A84, or for added matter, under A123(2)). Screening methods are generally patentable,

but may need to be restricted to non-human methods (the view is that it may not be moral to patent clinical trials). G1/04 doesn't seem to draw a distinction in terms of the administration method, but it does look at the purpose.

No cases are being stayed in view of G1/07 and G2/07, and indeed the general policy now is not to stay cases. The EPO may though stay a case at the Applicant's request, if that is the only issue remaining. The WARF case may have oral proceedings scheduled in the second half of next year.

In G2/07, it may be important why the Patentee included the microbiological (molecular marker) step in the process – was it purely to evade the bar on patentability? The question perhaps is whether the provision will exclude plant breeding techniques in the 1950's or techniques employed now (where molecular markers are usually used). Note that T1242/06 suggests an EBA referral on similar grounds, and in particular draws reference to Rule 23b(5) EPC.

We will send the EPO the *epi*'s comments on both G1/07 and 2/06 (*SMW to do*).

3. Rule 51(4) Procedure

Examiners are encouraged by the EPO not to make changes at this stage, but for example they may insert trivial changes such as 'non human' or '*in vitro*'. Sometimes the EPO Examiners will try and contact the applicant's representative but if they get no response from the attorney then they may go ahead and amend anyway. The difficulties that are caused to applicants and attorneys when unapproved changes were made were explained by the *epi*.

4. Function and Article 57

For prior art purposes, the annotation of a sequence can play an important role for inventive step (a later sequence is arguably not obvious if there is no annotation in the art). The case law (T870/04, T898/05, T1452/06) looks at whether the art just predicts a function, and the evidence for the function of the gene in the art. The case law is developing and in particular the method for predicting the function can be important.

5. Summons to Oral Proceedings

The Biotech Directors discussed the factors involved when deciding whether to issue a Summons including:

1. How many O/Ls have been sent (usually this should not be 2 or less, but in special circumstances there may be only one).
2. Is the applicant's reply reasonable, and has the applicant limited to a specific embodiment that may be patentable: if not, the EPO will try to indicate patentable subject matter in the Summons.
3. The applicant must have been given a chance to comment on all objections, so new objections should be avoided.

In the Summons, all claims must be examined and commented on. New documents can only be cited if new claims have been filed that give rise to further objections. All outstanding objections must be mentioned again. In complex cases a two month period under Rule 71a will be sent. Summons are normally issued in cases where there has been a written discussion of the objections beforehand.

Once a reply has been filed the Examiner is to check immediately if Oral Proceedings can be cancelled and is to send a response as soon as possible. The Examiners usually have a preparatory meeting 1-2 days in advance of the OPs. Quite often the EPO gets submissions only a few days before the hearing, well after the Rule 71a period. However, the usual situation is where submissions are made one month before the hearing. The EPO will try and deal with the case within three weeks and inform the attorney of their decision one week before the hearing. Bear in mind that cancellation requires consent of the chairman and people may be absent. SY said that there are more grants than refusals after Oral Proceedings; she is a fan of two O/L's and then a Summons. SY asked for not too many Auxiliary Request (perhaps no more than three).

Postponement of Oral Proceedings. BHJ mentioned a case for a US applicant where Oral Proceedings were scheduled for Thanksgiving; the epi thought that this was a bit insensitive. The EPO may also postpone if an attorney is schedule to attend two Oral Proceedings on the same day. It is the Examining or Opposition division that decides on the requests. SY thought they would be flexible. The EPO is very short on rooms. A plea was made for no Oral proceedings on Mondays and for no Oral Proceedings in Munich and The Hague in the same week. MF said that the EPO tries to be flexible and reasonable; Examiners have in the past come to see Directors where the reasons for the postponement do no fall squarely within the list of accepted excuses. They will understand if one has a holiday even if there is little evidence of booking (e.g. driving in home country, so no flight or ferry tickets and at family home). Attorneys don't like Oral Proceedings on Mondays (and less so on Fridays) but if that was followed they would only be scheduled for the three days mid week. The new building, near Capitellum, has no rooms for *inter partes* hearings (but has some larger rooms for *ex parte* ones).

Amendments at Oral Proceedings in manuscript are often (due to scanning, etc) illegible, so please write changes and insertions on a separate sheet. The EPO will try to provide printing facilities.

6. EPC 2000

Rule 30: (Sequence Listings): the epi will lobby for further changes (no late fee, refusal for non-compliance, which sequences are to be included, when a further listing will be required). Formalities Officers will deal with these requirements. No formal decision on how to handle this has been made by the Receiving Section; it seems that Examiners have spotted this issue. A sequence will need to be included in the listing if it is an essential feature. Avoid putting accession numbers (and may be even sequences) in the claims. Sequences are still needed even if say, your invention is a second medical use of a known protein. Initially it was thought that literature sequences won't need to be included in the listings, but that is against OJ EPO guidelines (Special Edition No. 3). Small changes or corrections (eg human rather than *homo sapiens*) could, the EPO think, be sorted out just by a correction (maybe without a late fee). Mr Keller said that PatentIn is now more user friendly but requested an updated even better version. There are unilateral discussions, including WIPO, but JPO has not yet agreed. We are concerned that even on further processing there is an error then the case could be lost. SY said the EPO doesn't want to be harsh but it is encouraging applicants to file the listings early.

7. 2nd Medical Use Claims

Both types of claims will be allowed (old style Swiss claims and new style EPC 2000 format) as independent claims (no Rule 29 objection) in existing and future cases. One can include new style EPC 2000 claims without adding matter.

8. Rule 112

The EPO's computer systems will change to EPC 2000 on 26 November. They won't send out Rule 112 communications after that. Examiners have been asked to send Rule 112's soon if appropriate. They are amenable to requests from applicants for a Rule 112 communication.

9. Divisionals

The Directors agreed that the new novelty rules for Article 54(3) citations apply to divisional cases filed after 13 December 2007. So, perhaps the EPO can expect a rash of divisionals before 13 December! Hence prior overlapping art will be treated differently (regarding the designated states) for post 13 December divisionals, despite the fact that the divisional is entitled to the parent's effective date.

10. Electronic filing of Sequence Listings

There is no intent to make electronic filing mandatory but just allow submissions by email. The attorneys explained why we are against online filing. It is not

favoured by the Directors also, but management is very keen, and it looks as if the EPO will move to electronically filing in the next few years.

11. Article 124

The EPO may require information concerning prior art cited by other Offices. Interestingly the Australian patent Office has just dropped this requirement. The EPO does not intend to routinely ask for prior art under Article 124.

12. Utilisation of National patent Offices (Search Reports)

The idea that the EPO could use the results of a prior search made by an NPO (e.g. in Germany, United Kingdom) has been raised. Some attorneys want the two searches to be independent; we don't want the EPO simply doing the same search or just issuing a substantially similar report. There is more chance of finding all relevant prior art found if the two searches are separate.

13. Paris Criteria

Alison Brimelow wants to stick to this, and the EPO want to deal with old cases first. This includes biotech; there

are no special reasons for excluding biotech. The EPO is now split into 14 clusters, one of which is biotech. Those clusters needing staff have recruited, and developed tools for reducing the backlog.

14. Divisionals

In view of recent decisions we have now gone back to the old practice. However, the biotech group has a higher percentage of divisional cases (two have priority dates before 1992!).

15. Rule 51(4)

EPO Examiner credits will be increased for refusals, to reflect the amount of work needed.

16. Disclaimers

Recent decisions suggest that if a feature is presented positively, as within the invention, then it cannot be used as a disclaimer.

The meeting closed at 12.30 with ADC and SY thanking all for attending. The EPO then invited everyone to lunch at Il Castagno.

Date of next Meeting: this has yet to be decided.

Report of the Harmonisation Committee

F. Leyder (BE)
Committee Secretary

The Harmonisation Committee deals with all questions concerning the worldwide harmonization of Patent Law, and in particular within the framework of WIPO.

1. As reported previously, the Standing Committee on the Law of Patents (SCP) asked WIPO to establish, for the next session of the SCP, preliminary studies on four issues, which are not to be considered prioritised over the other issues:

- Dissemination of patent information;
- Exceptions from patentable subject matter and limitations to the rights;
- Patents and standards; and
- Client-attorney privilege.

It has now been announced that the 13th Session of the SCP will be held in Geneva from 23rd to 27th March 2009.

2. As known from previous reports, Group B+ members (all members of WIPO Group B enlarged to include the members of the EU, the European

Commission, the member states of the EPO and the EPO; no observers) agreed back in 2005 to convene meetings of the Plenary and of a Working Group to consider substantive patent law issues, with a view to seeking a common basis for further discussions in WIPO.

Group B+ held a plenary meeting in Geneva on 21st September 2008. A report was presented at the 35th meeting of the Committee on Patent Law (CPL) on 27th-28th October 2008, at which meeting *epi* was represented as an observer. The report briefly mentioned:

- the progress in the discussions,
- a mandate to the Chair of the Working Group to convene an information session to review the status of practical measures of cooperation between offices, and
- membership (KR was admitted) and admission of observers (encouraged to contribute).

Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE)
Chairman

1. New EPC member state:

The EPC will enter into force for MK on 01.01.2009.

2. New referral to the Enlarged Board of Appeal:

On 22.10.2008, the President of the EPO referred a set of questions to the Enlarged Board of Appeal under Art. 112(1)(b). The referral relates to Computer-Implemented Inventions (CII) and can be downloaded from the EPO website: <http://www.epo.org/patents/appeals/pending.html>

At its last meeting, the Council decided that an *amicus curiae* should be prepared by EPPC; I will set up a special task group within EPPC.

EPC SUB-COMMITTEE

3. 34th session of the Committee on Patent Law (CPL) (30.06.2008-01.07.2008)

The existence of a problem with divisional applications was not denied; there is a consensus that the problem needs to be addressed by appropriate measures. As the chairman concluded, these measures may be legislative, must be proportionate, must be targeted to real abuses, should not narrow the room of manoeuvre for good faith applicants, and should not render difficult the filing of legitimate divisional applications.

CPL recommended adopting a three-month period for paying renewal fees before the due date.

epi proposals for amending the Implementing Regulations should be discussed with the EPO first. The EPO will propose an amendment of Rule 36 allowing the filing by reference for divisional applications, in the original language and with a translation in the language of the parent proceedings. The EPO did not support any of the other amendments proposed by *epi* (Rules 45, 56, 60, 69, 85, 136 and 162).

Nearly all delegations opposed the proposed increase of the opposition and appeal fees. The matter was referred to the Budget and Finance Committee (BFC).

4. 35th session of the Committee on Patent Law (27-28.10.2008)

The main items on the agenda were two papers submitted by the EPO.

Paper CA/PL 14/08 was not accepted by CPL: it contained proposals for a new Rule 62a (no search beyond R. 43(2)), an amendment of Rule 63 (allowing the search examiner to request clarification of the claims), new Rule

70a and amendments to Rules 161 and 137 (demanding a response to the written opinion when filing/confirming the request for examination; demanding details of the support for claim amendments).

CPL had a favourable opinion with reservations about paper CA/145/08, which proposed rigid time limits for filing divisionals (24 months from the first communication of the Examining Division or from any communication alleging lack of unity).

Interestingly, several delegations insisted on the importance of the users' views.

5. 115th session of the Administrative Council (21-23.10.2008)

The AC adopted some amendments to the Implementing Regulations to the EPC due to enter into force on 01.04.2009. The most notable amendments are:

- the page fee, now part of the fee for grant and printing, will become part of the filing fee;
- it will no longer be possible to pay renewal fees more than 3 months before they fall due (now one year).

6. 36th session of the Committee on Patent Law

The 36th session will take place on 02.02.2009 and 03.02.2009. It can be expected that the EPO will present an amended version of paper CA/PL 14/08, taking into account the comments made during the 35th session. If the EPO has not taken the risk to submit paper CA/145/08 (as such or in an amended version) to the Administrative Council in December, it can also be expected to be on the table again.

GUIDELINES SUB-COMMITTEE

7. New structure of the Guidelines

The EPO is planning to restructure and thoroughly revise the Guidelines. Upon request, the Guidelines Sub-Committee provided comments on a rough draft of the new structure.

LIAISON SUB-COMMITTEE

8. Partnership for Quality (PfQ) (06.10.2008)

Delegates of *epi* and BusinessEurope met EPO representatives from various entities having a link with quality.

The EPO reported on advancements in drafting the Manual of Best Practice. *epi* insisted that the Manual should clearly state its non legally binding character.

The current status of raising the bar program was also explained. Users requested additional statistical information.

The Trilateral arrangements are seen as one of the tools for improving the quality and reducing the workload at the EPO.

The next meeting is scheduled around mid-Spring. Items planned for discussion include R. 164 and its consequences.

9. Annual VP meeting

A meeting with Mr Hammer, Vice-President of DG1, has now been set for 29.01.2009. Items suggested for discussion can be forwarded to Ms Leißler-Gerstl.

PCT SUB-COMMITTEE

10. Meeting of *epi* with the EPO (16.09.2008)

The EPO invited *epi* on 16.10.2008 to discuss how to improve the PCT. Some proposals coming from the USPTO or from the EPO were shown to us; these have been commented upon by EPPC and the comments were sent to the EPO once approved by the Board. Further ideas were discussed at the last Council meeting, but the paper proposed by EPPC was not accepted.

11. Meeting of EPPC with WIPO (17.09.2008)

WIPO had expressed the wish to increase contacts with the users. The EPPC invited WIPO on 17.10.2008 for a presentation of the latest information about WIPO and the PCT, followed by a discussion. The feedback on our side was positive, and I plan to invite WIPO again.

COMMUNITY PATENT SUB-COMMITTEE

12. EU Council document 9465/08

The Board decided on 10.10.2008: „general comments shall be filed to the EC and FR INPI pointing at the fact that the EPC 2000 has now come into force and asking for a revised document on this basis.“

MISCELLANEOUS

13. SACEPO Working Groups:

The SACEPO Working Group on Guidelines had been created when the Guidelines were being revised in preparation of the entry into force of the EPC 2000. The *epi* delegation now consists of Mrs Hegner, EPPC Vice-Chairman in charge of the Guidelines Sub-Committee, Mrs Leißler-Gerstl and Mr Samuelides.

At the initiative of the EPO, a second SACEPO Working Group is being set up to deal with the Implementing Regulations. The *epi* delegation consists of Mrs Leißler-Gerstl, Mr Lampe and myself.

Report of the Professional Qualification Committee (PQC) (Summary for June – October 2008)

F. Schweinzer (AT)
Chairman

EQE 2008 had a pass rate for the first sitters of 41.5 % which is high compared with previous years. The reason for this is not yet clear.

Since April Henk Hanneman is working for the *epi* as Director of Education. He is strongly involved in the joint projects of the Memorandum of Understanding between *epi*, EPO and CEIPI. A new study guide for candidates has been prepared and will be published soon. Online testing programs are developed and a brochure „My preparation for the EQE“ to help candidates will be prepared in the near future.

CPE seminars have been held in Eindhoven in September and in Istanbul in October with a very positive

response from the participants. Now a number of topics for CPE seminars are available and PQC will be happy to assist national groups in organising such seminars in their country.

Further a new approach for training of candidates has started with a mock examination in November and a meeting with tutors in December.

In the last Council Meeting in Munich new PQC members from NO, HR, GR and SK have been elected. Now nearly every member state of the EPC is represented.

Next Board and Council Meetings

Board Meetings

79th Board meeting on 25 April 2009 in Toulouse (FR)
80th Board meeting on 12 September 2009 in Ljubljana (SI)
81st Board meeting on 28 November 2009 in Munich (DE)

Council Meetings

66th Council meeting on 23 May 2009 in Luxembourg (LU)
67th Council meeting on 10 October 2009 in Düsseldorf (DE)

Update of the European Patent Attorneys database

For the attention of all *epi* members

Kindly note that an error occurred in the contact data of the Legal Division of the EPO, published in issue 2/2008 of *epi* Information. The correct data is as follows:

European Patent Office
Dir. 524
Legal Division
Patent Administration
80298 Munich
Germany

Tel.: +49 (08) 2399-5283
Fax: +49 (0) 89 2399-5148
legaldivision@epo.org
www.epo.org

Please send any change of contact details to the European Patent Office so that the list of professional representatives can be kept up to date. Be aware that the list of professional representatives, kept by the EPO, is the list used by the *epi*. Therefore, to make sure that *epi* mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 524 of any change in your contact details.

Thank you for your cooperation.

Corrigendum

2008 Council elections – DK other practice

It was erroneously reported in issue 2/2008 of *epi* Information that, following Mrs Hegner's change of constituency, Mr. Bart VAN DER HAZEL had become a full member of the Danish constituency „Other prac-

tice“. As Mr. VAN DER HAZEL stood as substitute only for the 2008 elections, he remains a substitute member for the 2008-2011 Council period.

New Council Members from Croatia

The following Croatian representatives have been appointed to the *epi* Council by the EPO President:

Full Members:

Mr Davor Bošković
Mr Mladen Vukmir

Substitute Members:

Ms Mira Bunčić
Mr Tomislav Hadžija



*Institut der beim Europäischen Patentamt
zugelassenen Vertreter*

*Institute of Professional Representatives
before the European Patent Office*

*Institut des mandataires agréés
près l'Office européen des brevets*

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2 January 2009

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epi-Beitrag 2009

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FACTURE
Cotisation epi 2009

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siehe beiliegendes Formular zur Einzugsermächtigung, das bis zum 24. Februar 2009 an das epi zurückgeschickt werden muss;

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

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

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

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see enclosed direct debit mandate form which must be returned to epi by February 24, 2009.

2. by bank transfer in EURO

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

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

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

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

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

1. par retrait du compte courant OEB

voir autorisation de prélèvement annexée, à retourner à l'epi avant le 24 février 2009.

2. par virement bancaire en EURO

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

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

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

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

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

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

b) Kartenzahlung mit Fax

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

Bei Zahlungseingang nach dem **30. April 2009** ist der Beitrag € 190.

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

Sollten Sie Ihren Jahresbeitrag nicht bezahlen, nehmen Sie bitte zur Kenntnis, dass **Ihr Name von der Liste der zugelassenen Vertreter gelöscht wird**, gemäß Regel 154(1) der Ausführungsordnung zum EPÜ. Ihr Name kann jedoch gemäß den derzeit gültigen Regeln wieder in die Liste aufgenommen werden, sobald Sie den ausstehenden Beitrag bezahlt haben, gemäß Regel 154(3).

Der Schatzmeister
Claude Quintelier

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

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

Name:

**Membership
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verification number:

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Subscription payments made after **30 April 2009** must be in the amount of € 190.

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

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The Treasurer
Claude Quintelier

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Le Trésorier
Claude Quintelier

1Inv09 date

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D-80058 München

Telefax 089 – 242052-20

Neue
Einzugsermächtigung

New direct debiting
mandate

Nouvelle autorisation de
prélèvement

Eingangsfrist im
epi-Sekretariat:

Deadline for receipt by the
epi Secretariat:

Date limite de réception au
Secrétariat de l'epi:

24. Februar**24 February****24 février**

Bitte verwenden Sie **nur dieses Formular**,
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 für die Namen mehrerer **epi**-Mitglieder.

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 several **epi** members.

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 si nécessaire avec une feuille séparée pour
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Wenn die Liste der **epi**-Mitglieder sich seit
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 Abbuchung automatisch entsprechend der
 vorhandenen Liste erfolgen und es ist kein
 Formular an das **epi** zu senden.

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

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

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

NOT FOR USE AFTER FEBRUARY 24

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Please return to:

Retournez s.v.p. :

epi-Sekretariat
Postfach 26 01 12
D-80058 München

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**Änderungen für eine
 bereits bisher existierende
 Einzugsermächtigung**

**Changes to be applied to
 an existing direct debiting
 mandate**

**Changement à appliquer à
 une autorisation de
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**Eingangsfrist im
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**Deadline for receipt by the
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24. Februar

24 February

24 février

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nur an das epi-Sekretariat, wenn
 notwendig.

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

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

Die folgenden **epi**-Mitglieder sind von jetzt an auf der Liste für die Einzugsermächtigung zu **ergänzen**:

The following **epi** members should from now on be **added** to our list of names for direct debiting mandate:

Les membres de l'**epi** repris ci-dessous doivent à partir de maintenant être **ajoutés** à votre liste de noms pour l'autorisation de prélèvement :

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

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

Die folgenden **epi**-Mitglieder sind ab sofort in der Liste für die Einzugsermächtigung zu **streichen**:

For the following **epi** members the membership fee should from now on **no longer be debited** from our EPO account:

Pour les membres de l'**epi** repris ci-dessous la contribution ne doit à partir de maintenant **plus être débitée** de notre compte auprès de l'OEB :

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

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

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

Datum · Date

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

NOT FOR USE AFTER FEBRUARY 24

Einzugsermächtigung

Eingangsfrist im
epi-Sekretariat:

24. Februar

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

Der Einzug des Beitrags erfolgt mit Wirkung vom 25. Februar des laufenden Jahres. Alle an das EPA am Abbuchungstag zu entrichtenden Gebühren und Auslagen gehen dem Einzug des **epi**-Beitrags vor. Mehrere Beiträge, die vom selben Konto abgebucht werden sollen, fasst das **epi** zu einem Gesamtbetrag zusammen. Demgemäß erteilt das **epi** dem EPA einen Abbuchungsauftrag über den Gesamtbetrag. Reicht das Guthaben nach Begleichung der vorrangigen EPA-Gebühren und Auslagen zur Ausführung des Abbuchungsauftrags des **epi** nicht aus oder trifft die vorliegende Einzugsermächtigung beim **epi** nach dem 24. Februar ein, kann der Abbuchungsauftrag nicht ausgeführt werden. Das **epi**-Mitglied wird über den fehlgeschlagenen Einzugsversuch informiert. Überweist es den Beitrag dann nicht bis spätestens 30. April (Kontoeingang) für das **epi** spesenfrei im normalen Bankverkehr, erfolgt ein Einzugsversuch des erhöhten Jahresbeitrags am 25. Juni. Schlägt auch dieser Versuch fehl, muss der erhöhte Beitrag im normalen Bankverkehr beglichen werden.

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

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

Direct debiting mandate

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

24 February

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

Subscriptions are debited with effect from 25 February of each year. All fees and costs payable to the EPO on the debiting date have priority over the **epi** subscription. The **epi** will combine several subscriptions to be debited from the same account into one overall sum, for which it will then issue the EPO with a debit order. If, after priority payment of EPO fees and costs, the credit balance is not sufficient to carry out the **epi** debit order, or if the direct debiting mandate is received by the **epi** after 24 February, the debit order is not carried out. The **epi** member will be informed. Then, if the annual subscription has not been credited to the **epi** account through the standard banking procedure and at no expense to the **epi** by 30 April (reception on **epi** account), an attempt will be made to debit the higher annual subscription on 25 June. Should this attempt also prove unsuccessful, the higher annual subscription must be paid to the **epi** through the standard banking procedure.

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

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

Autorisation de prélèvement

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

24 février

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

Le prélèvement de la cotisation prend effet le 25 février de l'année en cours. Le règlement de toutes les taxes et de tous les frais dus à l'OEB à la date de débit a priorité sur le prélèvement de la cotisation annuelle à l'**epi**. L'**epi** regroupe en un seul montant plusieurs cotisations devant être débitées du même compte. A cette fin, l'**epi** donne à l'OEB un ordre de débit pour le montant total. Si, après règlement prioritaire des taxes et des frais dus à l'OEB, la provision du compte ne suffit pas pleinement pour exécuter l'ordre de débit de l'**epi** ou si la présente autorisation parvient à l'**epi** après le 24 février, l'ordre de débit ne peut être exécuté, et le membre en est informé. Si celui-ci ne vire pas le montant de la cotisation le 30 avril au plus tard (date d'inscription au compte de l'**epi**), par une opération bancaire normale et sans frais pour l'**epi**, il sera procédé, le 25 juin, au prélèvement du montant majoré de la cotisation annuelle. Au cas où ce prélèvement non plus ne peut être effectué, le montant majoré de la cotisation doit être acquitté par une opération bancaire normale.

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

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

Regeln für die Zahlung der epi-Mitgliedsbeiträge

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

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

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

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

Rules Governing Payment of the epi Annual Membership Fee

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

- 1) The *epi* annual membership fee has to be paid within two months after its due date.
- 2) The due date for members being on the list of professional representatives at the beginning of the year is 1 January.
- 3) The due date for members entering the list of professional representatives in the course of the year is the moment of entry on this list.
- 4) The annual membership fee is waived if
 - a member's written demand for deletion from the list of professional representatives arrives at the European Patent Office prior to 1 April;
 - a person is registered for the first time on the list of professional representatives after 30 September.
- 5) In all other cases the entire annual membership fee has to be paid. No instalments, extensions of the term of payment, or reduction of payment may be granted.
- 6) Members on the list of professional representatives on 1 January who fail to pay their membership fee prior to 1 May (reception on *epi* account) will have to pay a subscription of EUR 190.–. The same applies to members who entered the list during the course of the year if they have not paid the fee within four months after being notified of its amount through „*epi* Information“ or by letter.
- 7) Payments by money transfers have to be made in Euros and free of bank charges for *epi*. They must indicate the name and registration number of each member for whom the fee is paid.

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

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

Règles relatives au paiement de la cotisation annuelle epi

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

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

190.– . Ceci s'applique également à toutes les personnes inscrites sur la liste en cours d'année, dont la cotisation n'est pas réglée dans les quatre mois qui suivent la notification dans „epi Information“ ou par lettre.

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

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

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

The Patent Valuation Practices of Europe's Top 500

Martin A. Bader¹ (CH), Frauke Rüther²

Innovations and patents make important contributions towards corporate success. A survey on the top 500 patent applicants of the European Patent Office on behalf of PricewaterhouseCoopers conducted by the Institute of Technology Management at the University of St.Gallen, Switzerland and its innovation and intellectual property management advisory spin-off BGW reveals the status quo of valuation procedures and methods. A detailed report of the study can be ordered in English or German at: *PatentValuationStudy@bgw-sg.com*.

Since innovations are of immense significance in the attainment of a competitive edge today, their protection may create durable corporate success. Innovations and patents are therefore considered to be success factors for companies of all sizes and industries. In view of companies' increasing capital requirements, and growing exploitation opportunities on international financial markets, patents are also of considerable interest for stakeholders and investors. Accordingly, the management of immaterial assets is an important element of strategic management that is constantly increasing in significance.

As a consequence of the introduction of the International Financial Reporting Standards (IFRS) and the palpably increasing interest of the capital market in immaterial assets, a Europe-wide study was conducted seeking to investigate the status quo of patent valuation in corporate practice. The questionnaire was sent to the top 500 Europe-based patent applicants before the European Patent Office. In particular, the investigation focused on the current general importance of technologies and patents, valuation motives and valuation methods in companies, and the position of the value-oriented management of technologies and patents.

More than 90 % of the interviewees emphasized the importance of innovations and patents for corporate success. Innovative products account for 66 % of the interviewees' turnover and for 60 % of their profits. Patents, which are one segment of the overall field of innovation, are also held in high esteem as drivers of success. 58 % of the interviewees confirmed the importance of patents. Correspondingly, 57 % of the companies interviewed indicated that value-oriented innovation management is firmly entrenched in their organization; only 12 % answered this question in the negative.

To determine the contributions of patents to corporate success patents should be managed and valued. This could happen through monetary and non-monetary valuation methods. While the costs for the issuance of a patent can be determined with relative ease, the actual valuation of a patent requires an appropriate set of tools. Monetary valuation can be carried out with the help of capital-value, market-price and cost-oriented methods (a more detailed description is given in the last sections of this article). This high number of methods, combined with the non-standardized specific procedures they involve, results in a great deal of uncertainty in the valuation of patents.

The results with regard to monetary valuation methods came as a surprise. For one thing, the interviewees indicated that monetary valuations are conducted relatively rarely. For another, 44 % of the companies stated that they use a cost-oriented valuation process even for management events (see Figure 1).

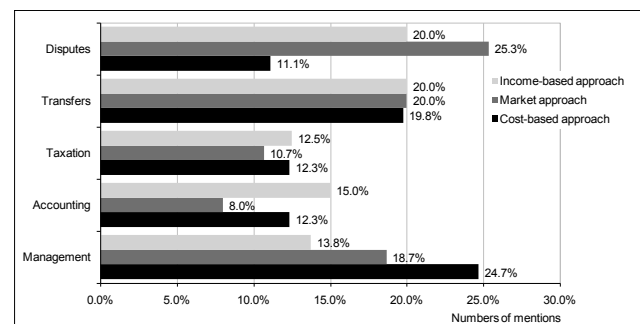


Figure 1: Application of monetary methods by valuation occasion

This result is surprising since particularly the management who frequently asks to be informed about the potential value contribution of their patents will find it difficult to infer it from this method. It is also surprising in the light of the importance of value-oriented innovation management.

Even if all the monetary valuation processes are applied more frequently or more rarely depending on the various occasions, there appears to be a wide dispersion of their application (see Figure 2). On the strength of this wide spread it can be deduced, however, that cost- and market-price-oriented processes tend to be used as specialized instruments, whereas capital-value-oriented procedures tend to fulfill more of a broad-band function.

The results of the study thus confirm that patents no longer are solely used for protection but started to be seen as a corporate success factor and as an asset. However the increasing awareness of patents the study's result identified many problems and uncertainties

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2 Dipl.-Kffr. Frauke Rüther M.A., Research Associate and Doctoral Candidate at Institute of Technology Management at University of St. Gallen; <http://www.item.unisg.ch/>; e-mail: frauke.ruether@unisg.ch

regarding the valuation of these assets, i. e. patents. The path from a currently dominating risk and cost approach in patent portfolio management and patent valuation to an at least application dependent opportunity and market or income based approach still seems to be steep and breathtaking for Europe's top enterprises.

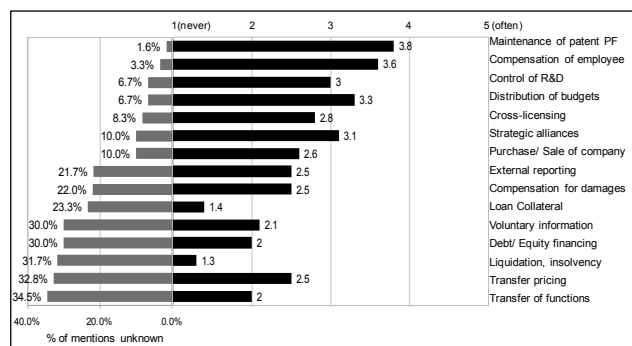


Figure 2: Occasions for valuation of patents and technologies

Valuation Approaches

As a final completion to the interested reader, some general information is given in the following about the state-of-art in valuation approaches.

In order to value intangible assets, in principle, three valuation approaches can be used (source: IDW ES 5):

- market approach,
- income approach, and
- cost approach.

Within these approaches, several valuation methods can be applied (see Figure 3).

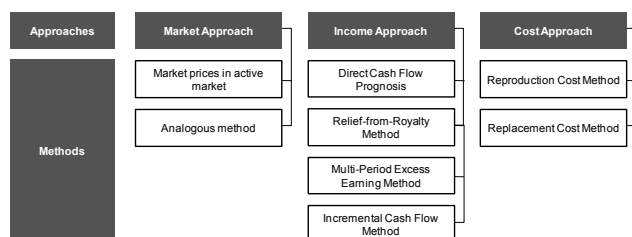


Figure 3: Valuation Approaches and Valuation Methods according to the IDW ES 5 standard

a) Market Approach

In case a reason for valuation calls for a valuation which draws on market prices, this is generally only possible if and to the extent the market prices concern sufficiently comparable assets. In addition, the market concerned must be active.

A market is active if all the following conditions are fulfilled:

- the goods in the market are homogenous
- purchasers and sellers willing to enter into agreement can generally be found at any time and
- prices are publicly known.

Since intangible assets are generally not traded in active markets, it must be determined whether comparable transactions can be drawn upon for the valuation of an intangible asset. By means of analogies a comparison between the observable price for a comparable object and the value sought for the (to be valued) intangible asset can be made. Since adequate data from comparable transactions are very rarely accessible, it is necessary to provide a detailed background and reasoning for the choice of comparable transactions and the key indicators deducted therefrom.

b) Income Approach

The income approach is based on the assumption that the value of an intangible asset results from the future success which will be generated by the asset in the form of cash flows.

The value of an asset is considered to be the sum of the present value of the future cash flows that can be generated as of the day of valuation (*Discounted Cash Flow*) from the use of the intangible asset within the expected economic useful life and possibly its divesture/ disposal. The central tasks within a valuation are therefore the prognosis of the cash flows relevant for the valuation and the determination of the capitalization interest rate/capitalization cost rate depicting the risk of the concerned intangible asset.

A major task in connection with the valuation of single assets is isolating the specific cash flows that can be credited to the asset to be evaluated. These cash flows are a type of added value to the cash flows that could be generated without the specific asset.

The planning period for the cash flows is to be based on the economical useful life of the intangible asset or its remaining useful life. The useful life of intangible assets is usually limited wherefore a valuation may not consider revenues in perpetuity from such an asset. In exceptional cases, revenues in perpetuity may be considered in case the useful life of the asset is sufficiently long so that it becomes irrelevant whether the present value of a limited series of cash flows is considered or whether the present value of cash flows in perpetuity is considered.

The income approach allows valuations from different perspectives. Aside from standardized concepts of value, e.g. the fair value, which are relevant for company external objectives, it is possible to include individual and subjective components and thereby reach strategically relevant decision values. This is relevant in cases in which the valuation is carried out not only for tax or accounting purposes but for example shall be used for a purchase price finding or shall facilitate other decision making processes.

There are basically four different methods to evaluate intangible assets based on an income approach each of which allows for a different way of isolating the specific cash flow for the relevant intangible asset. These methods are generally equivalent. In individual cases, one method or the other may be better suited than another due to the importance of the specific intangible

asset for a company or the fact that the information required for the application of one specific method may be difficult to come by.

Within the income approach, the following methods are applicable:

- Direct Cash Flow Prognosis Method,
- Relief-from-Royalty Method,
- Incremental Cash Flow Method and
- Multi-Period Excess Earnings Method.

c) Cost Approach

The third approach for the evaluation of intangible assets consists of the Reproduction Cost Method and the Replacement Cost Method. However, this approach has a major conceptual weakness since it is not use-driven and since the data used always refers to the past. For these reasons, the cost approach for the valuation of intangible assets can generally only be used to verify plausibility or to determine minimum price thresholds, e.g. in purchase price negotiations.

In applying the cost approach, either the costs required to create an exact duplicate of the asset in

question (Reproduction Cost Method) or the costs for the manufacture or acquisition of a use-equivalent asset (Replacement Cost Method) can be used. It has to be verified whether discounts are to be applied to properly consider economical, technical or functional obsolescence.

The depreciation must be oriented towards the expected useful life defined by economical criteria.

References

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Decision of the Disciplinary Board of Appeal regarding the 2007 EQE Paper C

J. Ford (GB)

In 2007 the EQE Examination Board badly let down candidates and the profession as a whole with their marking of Paper C (Opposition). There were at least 20-30 appeals and the Disciplinary Board has recently issued what are essentially identical Decisions on these cases¹. The Disciplinary Board fully upheld the appeals and found the performance of the Examination Board to be lacking at virtually every level.

Background and Submissions

Simon Roberts' article (epi Information 4/2007) addresses the problems with the paper itself, and these are not discussed in detail here. In summary, two issues needed to be addressed in the Appeal proceedings:

- The fact that zero marks were awarded for obviousness attacks if, what the Examination Board/Examination Committee deemed to be the wrong closest prior art, was chosen at the outset
- The fact that the Examination Board awarded a blanket addition of 10 marks to the grade of all C papers in

the EQE 2007 irrespective of the individual assessment of each candidate's work.

Various grounds of appeal were available to candidates, including infringement of Articles 8, 12 and/or 16 of the REE, and infringement of the basic principles of fairness in law and of the expectation of a uniform and reasonable examination marking scheme.

The Examination Board have issued no public explanation of the additional 10 marks. However, in their Appeal submissions they said they recognized that an unexpectedly high number of candidates had „erroneously“ used Annex 3 as the closest prior art and they were (or came to be) of the opinion that some credit could be seen in a properly drafted problem and solution approach even when the wrong starting document had been used. It was apparently in this context that the Examination Board decided to award the 10 marks to all papers, stating that „an extra 10 marks was the maximum that could be awarded in any circumstance, including reassessment of the individual paper“ and „given the lateness of proceedings and the impossibility of remarking all the papers the fairest option would be to award everyone this maximum amount of marks, such that everyone would benefit and no-one would suffer any negative consequences.“

¹ An Appellant has posted a Decision in full on the IPKat website and it can be viewed at: http://groups.google.co.uk/group/ipkat_readers/files.

As prescribed under the Appeal proceedings, both the President of the epi and of the EPO were asked to comment. In a carefully worded statement, the President of the EPO said she thought the Examination Board had given „*careful consideration of all circumstances*“ but was noticeably silent on the merits of the Examination Board's action itself. The President of the epi commented that the decision not to award marks for the wrong closest prior art contradicted the fit-to-practice criterion and was unfair. He also questioned whether the addition of 10 marks was contrary to the implied provision to mark each candidate's paper individually.

The Decision

Whilst there has been considerable debate within the profession of what should have been the closest prior art (it is certainly arguable either way), the Board confirmed that the question of which document is correctly viewed as closest prior art is not relevant in the context of the appeal.

Regarding the principle of not awarding marks if the wrong closest prior art was chosen at the outset, the Disciplinary Board confirmed that „*awarding points for an (in the Examination Board's view) incorrect yet logical and in keeping with recognized practice, justified attack, is not just due practice but is also legally prescribed*“. They stated that it is not reconcilable with Rule 4(2) and (3) IPREE „*to mark an examination paper as if it were a list of unrelated individual questions (as in a multiple choice system) to which there is only one correct answer. The fit to practice criteria obliges the examiners in marking individual parts of answers not to disregard their merit in the context of the paper as a whole and to allow for fair marking of answers which deviate from the scheme but are reasonable and competently substantiated. This is something to which every candidate has a legal entitlement.*“

With regard to the 10 marks, the Board found that there is legally no room for the Examination Board to change the marks awarded by the Examination Committee, so the Board acted *ultra vires*. In addition, „*the abstract awarding of marks with no regard to the fit to practice criteria or to the individual candidates' examination papers infringes the principles of objectivity in general.*“ The fact that no candidate was disadvantaged by the blanket addition of marks was deemed not to offset its illegality.

The Remedy

The Disciplinary Board has ordered the Examination Board to commission an Examination Committee to undertake a new marking of Paper C 2007 (for Appellants' papers), taking into account the merits of any solution to the problems in the paper. Furthermore, the Board deemed that the 10 marks awarded by the Board cannot be taken as compensation for the disadvantage suffered by the appellants through being denied a legally

correct mark for Paper C and, if only on the basis of equality, appellants are to be allowed to retain the additional 10 marks.

As the Disciplinary Board made clear in their decision, there is to be no legal limitation to a maximum of 10 additional marks as the outcome of the re-examination. It is hoped the Examination Board and Committee will now step up to the task and correctly, and fairly, remark the papers.

The Behaviour of the Examination Board

The primary reason I, and I am sure many other candidates, appealed was to ensure that the Examination Board would be held accountable and would not behave in this manner again; after all, there was never likely to be any resolution of the grades for at least 12 months, and the appeals are almost meaningless from that point of view (for the record, I comfortably passed the paper in the 2008 re-sit!). It is therefore encouraging to read that the Examination Board's behaviour was not considered excusable on any ground. To quote the Disciplinary Board, „*No supra-statutory predicament made it impossible to act keeping within the law. There was nothing to stop the Examination Board from fulfilling its obligation to ensure the papers were marked correctly. The fact that all the examination committees awarded no points when candidates failed to select the „right“ starting document would suggest that the Examination Board is actually accountable for this approach.*“ The Board pointed out that „*re-marking the papers may have involved extra effort and held up the entire examination procedure. But the Examination Board cannot cite that as a reason to justify its actions because those actions were its own mistake.*“

Regarding the addition of 10 marks, the Board stated that „*infringing the relevant legal principles systematically does not make the infringement irrelevant; furthermore, the EQE is not about treating candidates fairly but rather assessing their objective aptitude for a demanding job of a professional representative. Any marks awarded for reasons unrelated to the individual candidate's ability to answer the questions is absolutely irreconcilable with the purpose of the EQE, whatever the „overriding“ aspects might have been for the measure.*“ They also include a telling remark suggesting that the extra marks may have been motivated „*to achieve a statistically and/or politically acceptable pass rate.*“

Comments and Conclusion

It is, of course, possible that appellants will now obtain 45 to 55 marks on appeal (including the extra 10 marks) and thus pass, in place of what would in more usual circumstances, have been a fail. However, candidates cannot be held accountable for such a situation, and more importantly to deprive one group of candidates of additional marks awarded to other candidates in the same paper would clearly be inequitable.

Given the 62 marks awardable for Inventive Step in the 2007 paper, the awarding of 10 to represent the maximum for „other“ attacks has always seemed a little low. Unfortunately, the Disciplinary Board never felt the need to consider how the value of 10 marks was arrived at, and some questions still remain unanswered. For example, was the decision to award 10 marks influenced by the number of 'failed' candidates the Board would thereby knowingly pass? Was the decision to award 10 marks, influenced by the highest mark awardable? (I have been told a French candidate scored 89 marks, excluding the 10 marks). Unfortunately, we shall probably never get to the bottom of this issue.

Despite the successful appeal, I still find the whole situation terribly sad. The Examination Board opted for an administrative quick fix and failed in its primary objective to provide a fair and reasonable marking of

the EQE paper. They have, I am sure, done a good job in the past, with perhaps little recognition, but that does not help the hundreds of candidates who were at the receiving end of this disaster. My suspicion is that the marking scheme was over-simplified in order to facilitate the introduction of a shorter period between sitting the examinations and the issuance of results. I completely endorse attempts to reduce this waiting time, but never at the expense of the integrity of the examination itself. It goes without saying that it would have been better to get a correct result late, than the incorrect result on time.

The inescapable fact is that the Examination Board should never have got into this situation in the first place. Their ill thought out and slap-dash approach has seriously de-valued the EQE system as a whole. I can only hope that this Decision will go some way to preventing such a sorry affair ever being repeated.

The London Agreement and the language situation in Belgium

J. Gevers (BE)

The European Patent Convention (EPC), the London Agreement (LA) and the very specific Belgian linguistic situation are an impossible mix. The purpose of this article is to explain to the European patent profession why this is the case and what should be changed to enable Belgium to adhere to the London Agreement.

The practical and very legitimate purpose of the London Agreement is to decrease the cost of translations of European patents when they are validated in the European countries where the patentee wishes to have his European patent to take effect.

The LA reflects a reasonable consensus that is accepted by many European countries where it is now considered that filing a translation of the claims only into their official language with their national patent office (or with the EPO if an official language of the country is English, German or French) should be the only requirement in order for a European patent to be enforceable in the country. Additionally, and if the language of the procedure of the patent is French or German, it is usually further required that a translation of the specification in English or in the official language of their country be also filed.

Only recently, it became apparent that this compromise, although considered reasonable elsewhere, is very difficult to accept – to put it mildly – for the majority of the Belgians, namely the Flemish, whose mother tongue is Dutch.

It is indeed necessary to realize that about 60 % of the Belgian population (10 500 000 Belgians) have Dutch as mother tongue, 39 % French and less than 1 % are of German mother tongue.

Dutch and French are the two official languages of Belgium. French is also a procedural language of the EPO. Therefore, should Belgium ratify the LA, and under the terms of the LA, Belgium could not require that a translation of the claims (in whatever language) be filed with our patent office. The consequence is that all European patents valid in Belgium would have their claims translated (and filed at the EPO) in the two minority languages of Belgium namely French and German and none in the majority language: Dutch.

Understandably, the Dutch speaking population has difficulties admitting that the majority language be so handled, compared to the two minority languages and this more so that the Flemish Region of Belgium is currently negotiating with the other entities of Belgium additional institutional autonomy.

Furthermore the Flemish can rightfully not accept that their „nation“ be the only in Europe that, under the EPC and the LA, may not require that the claims of the patents that can be opposed to their industry be translated into their language. Why should they accept to be treated worse than Slovaks, Lithuanians or Danes?

The purpose of this article is to suggest a solution which would allow Belgium to adhere to the LA together with an interim solution.

The first, and best, solution would be to modify the EPC in order to allow countries where the language of the majority of the population expresses itself in a language that is not one of the three procedure languages of the EPO, to require for validating a patent in their country, the filing of a translation of the claims only into that majority language and this regardless of the language of the patent.

This would be a rather simple change to Article 65 EPC and no member state should oppose this change. Obviously, it cannot be reasonably suggested to amend the EPC for this purpose only; however, this change should be added to the other possible changes to the EPC that are currently being examined.

Since this change might take quite some years to materialise, another – interim – solution is currently being examined: Belgium – similarly to Albania, Lithuania, Latvia, Macedonia and Slovenia – would not adhere to the LA but would modify its translation requirement for validating a patent in Belgium to the filing of a translation of the claims in Dutch.

Both solutions are in the spirit of the LA and in line with the situation in the many countries that do not have as main official language a procedural language of the EPO. Indeed, it replaces the necessity of a complete translation in Dutch or French by a translation limited to the claims in Dutch which costs substantially less. Furthermore, since a majority of the European patents that are validated in Belgium are also validated in the Netherlands, in most cases one translation in Dutch could be used in both countries similarly to the Greek translation that can be

used in Greece and Cyprus or the English translation in Ireland and Malta.

The interim solution is compatible with the current wording of Article 65 EPC. It is a step into the right direction since this would substantially decrease the unfavourable language effect of the LA against the use of Dutch. It is however not completely satisfactory since it would not totally suppress the discrimination against Dutch since Belgium may not, under the current text of Article 65 EPC, require a translation of the claims in Dutch for the European Patents obtained in French.

Another drawback of this interim solution is that it would not clarify the situation for European patents obtained in German. Indeed, in Belgium, Dutch and French are 'official' languages and German is a 'national' language. Even if the Belgian administration has been willing to accept the direct effect of European patents granted in German, without requiring a translation either in French or in Dutch, the issue remains discussed among practitioners (see OJ EPO 1999, 320). So far, no Court decided thereupon. The recent law of April 21, 2007 has not completely clarified the situation for patents filed in German after December 13, 2007.

As a conclusion I would like to state that I believe the second solution (no adhesion to LA but translation of the claims in Dutch only) to be the best short term pragmatic solution, both taking into consideration the specifics of the Belgian linguistic landscape and the interest of European patent owners. This „pragmatic“ solution should, however, only be an interim solution until the EPC is amended as suggested above.

Diamanten, Peanuts und Patente (Anekdoten¹ zur Synthese von Diamanten)

T. Ritscher (CH)

Irgendwo, tief im Chaos meiner Sammlung von Dingen, die man vielleicht irgendwann irgendwozu einmal brauchen kann, liegt eine walnussgrosse Lupe aus Acrylglas, durch die man ein paar gelbliche Krümel betrachten kann.

Dieses Ding schenkte mir ein Mitarbeiter von General Electric (GE), ich denke, es war Bob Wentorf, dem ich berichtet hatte, dass es für das englische Wort „carbonaceous“ keine direkte Übersetzung ins Deutsche gäbe.

Wir einigten uns darauf, dass der Begriff „Kohlenstoff enthaltend“ dem englischen Ausdruck am nächsten käme. „Kohlenstoffisch“ wäre zwar richtig, aber dieses Adjektiv würde jeder Prüfer im schweizerischen und wohl auch im deutschen oder österreichischen Patentamt – jedenfalls als Merkmal in einem Patentanspruch – als „unbestimmt“ zurückweisen.

Das Sprachproblem hatte seinen Ursprung in vier Patentanmeldungen von GE, die ich gerade (1959) übersetzt und am 8. September an das Schweizer Patentamt abgesandt hatte². Sie betrafen die Herstellung von Diamanten aus „kohlenstoffigem“ Material unter sehr

¹ Die Anekdote ist eine literarische Gattung, die eine bemerkenswerte oder charakteristische Begebenheit zur Grundlage hat aber (ανέκδοτον, anékdoton – nicht herausgegeben) nicht oder nicht vollständig dokumentarisch belegt werden kann; die nachfolgenden Patente sind z.B. in swissreg.ch auch bei Eingabe der Nummern nicht zu finden.

² erteilt als CH 365 059; CH 365 713; CH 393 279; CH 395 947

hohem Druck und hoher Temperatur, und von kubischem Bornitrid.

Der GE-Mitarbeiter, nehmen wir an, es war Bob, erzählte mir dazu, dass auch der Prüfer des U.S. Patentamtes die englische Bezeichnung „carbonaceous“ beanstandet habe, aber nicht als unbestimmt sondern als zu breit, weil in den konkreten Beispielen der Patentanmeldung nur Graphit beschrieben worden war. Darauf habe Bob dem Prüfer angeboten, Diamanten aus einem vom Prüfer gewählten, Kohlenstoff enthaltenden Material herzustellen.

Der Prüfer habe um sich geblickt, dabei sein Mittags-sandwich mit Erdnussbutter gesehen und verlangt, dass eben aus diesem Brotaufstrich Diamanten gemacht werden sollten. Denn auch Erdnussbutter enthält Kohlenstoff und ist somit ein „carbonaceous material“ für die Diamantsynthese. Und die gelben Krümel unter der Lupe, die er mir mitgebracht hatte, seien Diamanten aus Erdnussbutter.

Vor einigen Jahren ist ein Buch³ erschienen, das im Vorwort die Diamantsynthese aus Erdnussbutter als historische Tatsache erwähnt, aber ohne Hinweis auf den patentrechtlichen Grund der Wahl gerade dieses Ausgangsstoffes. Nachdem der Autor seinen Stoff ziemlich gründlich recherchiert zu haben scheint, wäre der Zusammenhang zwischen Patentrecht und der Herstellung von Diamanten aus Erdnussbutter literarisch vielleicht verloren, wenn ihn nicht noch schnell jemand festhielte. Und das ist der Grund für diesen Bericht.

Das historisch mögliche Interesse am Zusammenhang von Patentrecht und Diamantsynthese ist aber mit der Erdnussbutter-Geschichte nicht erschöpft. Da könnte man zunächst einmal über den Stand der Technik zum Zeitpunkt der Anmeldung der Patente von GE nachsinnen, und auch darüber, was man mit der EPÜ bei einer patentrechtlichen Würdigung der Diamantsynthese als erfinderischen Schritt und in den U.S.A. mit „non-obviousness“ bezeichnet.

Schliesslich wusste man aus der Thermodynamik schon in den Dreissigerjahren, dass die natürliche Bildung von Diamanten nur bei sehr hohen Drucken und Temperaturen erfolgt sein könne. Ein russischer Thermodynamiker (dessen Arbeit nach meiner Erinnerung vom österreichischen Prüfer zum Stand der Technik zitiert worden war) hatte bereits 1938 die kritischen Werte für Druck und Temperaturwerte errechnet, die für die Bildung von Diamant nötig waren und die auch mit GE-Patentanmeldungen beansprucht wurden. Aber eine reproduzierbare Diamantsynthese hatte vor GE noch niemand beschrieben. Im Gegenteil: ich erinnere mich aus meiner Studentenzeit an eine Publikation von zwei namhaften deutschen Thermodynamikern, in der die synthetische Herstellung von Diamanten als prinzipiell unmöglich dargestellt worden war.

Schon im 19. Jahrhundert hatten verschiedene Forscher behauptet, Diamanten künstlich erzeugt zu haben. Ein einziges Produkt einer solchen Synthese ist im Britischen Museum erhalten, erwies sich aber als Diamant

natürlichen Ursprungs und war – wohl von einem mitleidigen Mitarbeiter – in die Reaktionsmasse eingeschmuggelt worden⁴.

Auch der Nobelpreisträger Moissan starb 1907 im Glauben, er hätte Diamant synthetisch hergestellt. Die Nacharbeitung lässt vermuten, dass die effektiv hergestellten glänzenden Kristalle aus Siliciumcarbid bestanden (das später als Carborundum® bekannt wurde) und Diamant im Reaktionsprodukt wiederum nur von einem mitfühlenden Assistenten stammen konnte⁵, der die Verzweiflung und Selbstgefährdung seines Chefs nicht mehr länger mit ansehen wollte.

Es gilt jedenfalls als patentrechtlich und daher wohl auch wissenschaftlich sicher, dass keiner der vor dem Anmeldedatum der GE-Patente publizierten Versuche zur Diamantsynthese geführt hat.

Später (1962) wurde behauptet, Balthazar von Platen hätte bei der ASEA bereits vor GE eine Diamantsynthese entwickelt. Authentisches Material – etwa datierte Diamantproben – hierzu scheint es nicht zu geben und eine patentrechtliche Überlegung macht die Behauptung noch fragwürdiger: Platen war – unbeschadet seiner sonstigen Eigenheiten – ein erfolgreicher Erfinder; er hatte den Absorber-Kühlschrank erfunden, patentiert und seine Erfindung mit Gewinn an die Firma Elektrolux verkauft⁶. Also wusste er, dass sich der rechtzeitige Gang zum Patentamt lohnen könne und soll dies nun gerade bei der finanziell ungleich bedeutsameren Diamantsynthese unterlassen haben?

Aber es gibt noch einen weiteren Gesichtspunkt, der den Anspruch der GE-Erfinder auf den Ruhm als Erfinder der Diamantsynthese stützt: auf einer Pressekonferenz am 15. Februar 1955⁷ wurde die geglückte Diamantsynthese von GE bekannt gegeben. Prioritätssichernde Patentanmeldungen lagen da bereits im U.S. Patentamt und wohl auch im britischen Patentamt. Keine dieser Anmeldungen ist bisher veröffentlicht worden. Jedenfalls gilt der 15. Dezember 1954 als der Tag, an dem die Diamantsynthese erstmals gelungen ist⁸.

U.S. Patentanmeldungen werden bekanntlich daraufhin geprüft, ob sie Erfindungen enthalten, deren Geheimhaltung im Interesse der Vereinigten Staaten liegen könne⁹. Bei der Diamantsynthese wurde ein solcher Anspruch jedenfalls bejaht und die Nachanmeldung von Patentanmeldungen im Ausland mit der Priorität der U.S. Patentanmeldungen unter Strafe mit einer sogenannten „secrecy order“ verboten. Die Knappheit an Industriediamant für die Metallbearbeitung im Zweiten Weltkrieg hatte tatsächlich gezeigt, dass so etwas kritisch sein könnte. Erst Anfang September 1959 wurde dieses Geheimhaltungsedikt aufgehoben, aber da hatten schon alle Welt Proben der von GE hergestellten Diamanten, die als Beweis der geglückten Syn-

4 Hazen, loc. cit. S. 19

5 Hazen, loc. cit.

6 s. z. B. US 1 609 334

7 Hazen, loc. cit., S. 132

8 Hazen, loc. cit. S. 134

9 U.S. Patent Act 1952

3 Robert M. Hazen, *The Diamond Makers*, Cambridge University Press 1999

these herumgereicht und auch schon frei als „Man Made Diamonds“ verkauft worden waren.

Meine Laufbahn als Patentanwalt war bei der Aufhebung der Secrecy Order gerade acht Monate alt, aber ich war für die deutsche Übersetzung der in der Schweiz zu hinterlegenden Patentanmeldungen zuständig. Der Übersetzungsauftrag war schon einige Wochen früher eingegangen, damit die Auslandsanmeldungen sofort mit der Aufhebung der „secrecy order“ hinterlegt werden konnten.

Die Welt – d. h. die Hochdrucklaboratorien der Konkurrenz – hatte also viereinhalb Jahre Zeit, die synthetischen Diamanten von GE zu analysieren und daraus nicht nur auf die prinzipielle Machbarkeit, sondern auch auf die Syntheseparameter zu schließen. Aber offenbar ist es keinem Labor, keiner Gruppe gelungen, die GE-Synthese vor Ablauf der Secrecy Order nachzumachen. Anders ist es nicht zu erklären, dass es keine Patentanmeldungen Dritter gibt, die ein früheres Datum als die erst im September 1959 eingereichten GE-Patentanmeldungen für die Diamantsynthese haben und den Rechtsbestand der erteilten GE-Patente mindestens in Zweifel gezogen hätten.

Die Erklärung hängt mit der Tragik des Mannes zusammen, der die Hochdrucktechnik – Drucke im Bereich von über 10 Kilobar – zu einem brauchbaren Instrument gemacht hat und mit dem Nobel-Preis geehrt worden ist: Percy Bridgman (1882 – 1961). Er musste zusehen, wie andere mit seinen Methoden und Geräten die von ihm vergeblich versuchte Diamantsynthese verwirklichten.

Temperaturen im Bereich von 1000 – 2000°C sind mit hoher Genauigkeit relativ einfach und direkt zu messen, weil der elektrische Widerstand von Metallen ziemlich linear von der Temperatur abhängt. Die genaue Messung von Drucken im Bereich von 100 Kilobar ist viel problematischer und überhaupt erst durch die bahnbrechenden Arbeiten von Bridgman möglich geworden.

Auch hier wird der elektrische Widerstand von Metallen eingesetzt, der sich jedoch nicht wie bei Temperatur linear, sondern bereichsweise sprunghaft ändert, wie dies für Phasenänderungen typisch ist. Wie man heute weiss¹⁰, liegen die „wirklichen“ Drucke etwa um 30 % über den Werten, die nach den damaligen Methoden von Bridgman erhalten wurden, und es ist diese „einfache“ Erkenntnis, welche den Misserfolg der Konkurrenz von GE einleuchtend erklärt: Man kannte zwar den notwendigen Druck für eine erfolgreiche Dia-

mantsynthese, war aber über den Unterschied zwischen den gemessenen und den tatsächlich erzeugten Drucken im Unklaren und arbeitete daher mit zu niedrigen Drucken. So besehen bestünde der erfinderische Schritt der Diamantsynthese in der Erkennung eines Messfehlers.

Der wohl „schärfste“ Konkurrent von GE im Kampf um die Diamantsynthese war die Firma deBeers, die bis dahin einer Art Monopol nicht nur für Schmuck, sondern auch für Industriediamanten hatte. Sie betrieb in Südafrika ein Hochdrucklabor mit dem Ziel, Diamanten auch synthetisch herzustellen und hatte – offenbar in der Zeitspanne zwischen der Hinterlegung der GE-Patentanmeldungen Anfang September 1959 und deren erster Publikation (zuerst wohl in Belgien nach wenigen Monaten) – selbst eine Patentanmeldung für eine nacharbeitbare Diamantsynthese angemeldet.

Ich halte es für eines der echten Ruhmesblätter des Rechtssystems von Südafrika, dass dieser Streit zwischen GE und deBeers um das Patent für die Diamantsynthese zu Gunsten von GE entschieden wurde. Aber dann machte GE einen patentrechtlich relevanten Fehler: In Irland wurde das Diamantsynthesepatent von GE nicht angemeldet und deBeers – jetzt wird mein Bericht wieder anekdotisch – verlud mehr als ein Dutzend Hochdruckpressen auf zwei Schiffe, die nach Irland fuhren und dort auf dem Zollfreigebiet von Shannon eine Diamant-Syntheseproduktion einrichtete, die noch heute existiert.

Und wiederum zwei patenrechtliche Fakten in der Geschichte der Diamantsynthese: (1) Nach U.S.-Rechtspraxis kann für die synthetisch erzeugte Form eines in der Natur vorkommenden Stoffes kein Sachpatent sondern nur eine Verfahrenspatent erteilt werden, und (2) nach der damaligen Fassung des U.S. Patentgesetzes erstreckt sich die Wirkung eines Verfahrenspatentes anders als in fast allen anderen Ländern der Welt nicht auf das unmittelbare Produkt des Verfahrens.

Mit anderen Worten: Der wohl wichtigste Konkurrent deBeers konnte während der ganzen Laufzeit der GE-Diamantsynthese-Patente die in Irland patentfrei hergestellten synthetischen Diamanten in die Vereinigten Staaten, d. h. das Land mit dem damals wohl größten Markt für Industriediamanten, von Patenten unbehindert einführen.

Kurt Vonnegut – einer meiner Lieblingsautoren – würde dazu sagen: So it goes.

10 Hazen, loc. cit S. 55

55th Council Meeting of the Asian Patent Attorneys (APAA) Singapore 18th – 21st October, 2008

T. L. Johnson (GB)

The APAA is an association of patent and trade mark attorneys in the Asian region, and is organised on a country-by-country basis via recognised country groups. As such, bearing in mind the increasing economic importance of Asian countries, the APAA is an important body and well-placed to monitor and indeed seek to influence where necessary IP developments in the region.

APAA has forged relationships with sister organisations of which the *epi* is one. As such, the *epi* is invited to attend Council meetings of the APAA as a special guest. Our President could not attend the 55th Council Meeting so he kindly asked me to stand-in for him, as I have represented the *epi* at previous APAA meetings.

Part of the duties of a special guest is to give a brief address to a lunch hosted by the APAA President for special guests, the APAA Council and leaders of their working groups. At the lunch, on behalf of the *epi*, I brought greetings from our President, Board, Council and Members. This was followed with my brief report on how we are organised, including our compulsory Mem-

bership, the fact that our Membership covers both in-house and free profession attorneys, and that we are part of the European Patent Organisation by virtue of the Founding Regulation. I commended APAA on the choice of workshop for topics for the Council Meeting, namely „Client-Attorney Privilege“ and „getting the best out of the PCT“. (I attended the „Privilege“ workshop, it was of the highest quality with speakers from round the world, including one of our Members, D. Musker (GB)). I finished my address to the lunch by saying that our Members stood ready to assist APAA members in handling matters before the EPO, and that we very much appreciated the cooperation *epi* members enjoyed with APAA members in handling cases both in the EPO and in the Asian Region.

APAA Country groups provide National reports, and at a subsequent open meeting of the APAA Council, I also thanked APAA for these reports, which are very useful in keeping non-APAA members such as our members up-to-date with changes in law and practice in the Asian Region.

Validation of European Patents in Spain that have been limited at EPO after grant under Article 105c EPC

L.A. Durán (ES)

Spanish Royal Decree 1431/2008, which entered into force on September 16, 2008, provides that a full translation of any European patent designating Spain limited under article 105b.2 EPC must be filed before the Spanish Patent and Trade Mark Office within 3 months after the publication of the limitation by the EPO under article 105c EPC. The translation must reflect the changes introduced in the limitation. Failing to do so, the corresponding European patent will cease to have effect in Spain.

It is to be remembered that, according to Spanish Law, a translation into Spanish of a European patent must be certified by a Spanish Patent Attorney or by a Spanish certified translator and that, following what is provided in article 70(3) EPC, for infringement proceedings, when the Spanish translation confers a narrower protection than the language of the proceedings, the Spanish text will apply. Therefore, it is highly advisable to ensure that the Spanish translations of European patents are accurate.

Disziplinarorgane und Ausschüsse
Disciplinary bodies and Committees · Organes de discipline et Commissions

Disziplinarrat (epi)	Disciplinary Committee (epi)	Commission de discipline (epi)
AT – W. Poth BE – T. Debled BG – E. Benatov CH – M. Liebetanz CY – C.A. Theodoulou CZ – V. Žak DE – W. Fröhling DK – U. Nørgaard EE – H. Koitel ES – V. Gil-Vega FI – C. Westerholm	FR – P. Monain GB – S. Wright** GR – A. Tsimikalis HR – D. Korper-Zemva HU – J. Markó IE – G. Kinsella IS – A. Vilhjálmsson IT – B. Muraca LI – P. Rosenich* LT – L. Kucinskas LU – P. Kihn	LV – L. Kuzjukevica NL – A. Hooiveld NO – E. Anderson PL – A. Rogozinska PT – A. J. Pissara Dias Machado RO – C. Pop SE – H. Larfeldt SI – J. Kraljic SK – T. Hörmann TR – T. Yurtseven
Disziplinarausschuss (EPA/epi) epi-Mitglieder	Disciplinary Board (EPO/epi) epi Members	Conseil de discipline (OEB/epi) Membres de l'epi
BE – G. Leherte	DE – W. Dabringhaus	DK – B. Hammer-Jensen GB – J. Boff
Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi) epi-Mitglieder	Disciplinary Board of Appeal (EPO/epi) epi Members	Chambre de recours en matière disciplinaire (OEB/epi) Membres de l'epi
DE – N. M. Lenz DK – E. J. Christiansen ES – P. Sugrañes Moliné	FR – P. Gendraud GB – H.G. Hallybone	GB – T.L. Johnson NL – B. van Wezenbeek
epi-Finzen	epi Finances	Finances de l'epi
AT – P. Pawloy* CH – T. Ritscher DE – M. Maikowski	FR – J.-L. Laget GB – T. Powell** IE – P. Kelly IT – S. Bordonaro	LT – M. Jason LU – J. Beissel SE – K. Norin
Geschäftsordnung	By-Laws	Règlement intérieur
CH – C. E. Eder* DE – D. Speiser	FR – P. Moutard	GB – T. Johnson
Standesregeln Ordentliche Mitglieder	Professional Conduct Full Members	Conduite professionnelle Membres titulaires
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