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Editorial

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

The present edition was to be a themed edition devoted solely to the issue of the Community Patent. The Editorial Board felt that interest was growing in this subject both inside and outside the community, following the announcement of progress with the issue by the European Union Commission.

The Community Patent remains a difficult issue. It would seem that, politically, it is an extremely desirable aim, primarily because a community-wide Intellectual Property right will be a powerful symbol for the unity of the European Union and an indication of progress towards integration of the market. Unfortunately, for the progress of the symbol, the reality is that, whilst progress remains in the Community, there are inevitable difficulties caused by the attempt to reconcile such a large number of countries with differing historical cultures to a single viewpoint. It is this extremely difficult

balancing act which has been the primary cause of delay in putting the Community Patent into practical effect.

Because the matter clearly remains of political sensitivity, it has proved very difficult to obtain commentaries on the Community Patent. At least two major contributors reluctantly had to turn down the invitation to contribute on the grounds that they were of the opinion that the matter was too politically sensitive to publish commentaries which could be misinterpreted as political stances.

The paradox of the Community Patent remains. Whilst there is no doubt that it is a desirable aim, both politically within the Community and practically, at least for large commercial bodies for whom the Community is a viable market, the difficulties remain, both politically, as outlined above, and practically as the European Patent Office and its success in providing Intellectual Property cover across the Community becomes more firmly established.

Nächster Redaktionsschluss für epi Information

Redaktionsschluss für die nächste Ausgabe der epi Information ist der **12. Mai 2004**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

Our deadline for the next issue of epi Information is **12 May 2004**. Documents for publication should have reached the Secretariat by this date.

Prochaine limite pour epi Information

La date limite de remise des documents pour le prochain numéro de epi Information est le **12 mai 2004**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

55. Ratssitzung Cannes, 20.-21. Oktober 2003

Weitere Beschlüsse:

1. Herr CASALONGA, Herr HOOGSTRATEN und Herr SHORTT wurden zu Mitgliedern des künftigen ständigen Ausschusses für EPA-Richtlinien für die Prüfung ernannt.
2. Der Rat stimmte zu, dass Straßburg als möglicher Sitz der Europäischen Akademie für Gewerbliches Eigentum in Betracht kommen könnte.

55th Council Meeting, Cannes, 20-21 October 2003

Further decisions:

1. Mr. CASALONGA, Mr. HOOGSTRATEN, Mr. SHORTT were appointed members of the future Standing Committee on EPO Guidelines for Examination.
2. Council approved that Strasbourg should be taken into consideration as a possible location of the European IP Academy.

55^{ème} Réunion du Conseil, Cannes, 20-21 octobre 2003

Autres décisions:

1. M. CASALONGA, M. HOOGSTRATEN et M. SHORTT sont nommés membres du futur Comité consultatif permanent pour les recommandations de l'OEB relatives à l'examen.
2. Le Conseil approuve une implantation éventuelle de l'Académie Européenne de la Propriété Industrielle à Strasbourg.

Corrigendum

56. Ratssitzung, Kopenhagen

Der in Ausgabe 4/2003 veröffentlichte Bericht über die 55. Ratssitzung enthält einen Fehler. Die nächste Ratssitzung in Kopenhagen findet nicht am 27. und 28. Mai, sondern am **17. und 18. Mai 2004** statt.

Corrigendum

56th Council Meeting, Copenhagen

An error occurred in the report of the 55th Council meeting published in the issue 4/2003. The date of the next Council Meeting in Copenhagen is not 27th-28th May. The meeting will be held on **May 17th-18th 2004**.

Corrigendum

56^{ème} Réunion du Conseil, Copenhague

Une erreur s'est glissée dans le rapport de la 55^{ème} réunion du Conseil publié dans le numéro 4/2003. La prochaine réunion du Conseil à Copenhague n'aura lieu pas le 27 et 28 mai, mais le **17 et 18 mai 2004**.

Wichtige Mitteilung vom Prüfungssekretariat des Europäischen Patentamts

Europäische Eignungsprüfung 2005: neue Anmeldefristen

Die Europäische Eignungsprüfung 2005 findet vom 8. bis 10. März statt. Als Anmeldefrist wurde der *30. Juli 2004* festgelegt. Für Bewerber, die an der Prüfung im Jahr 2004 teilgenommen haben, wurde als verlängerte Anmeldefrist der *15. November 2004* festgelegt. Für Einzelheiten und Anmeldeformulare siehe ABl. EPA 3/2004.

Important Information from the Examination Secretariat of the European Patent Office

European qualifying examination 2005: new deadlines

The European qualifying examination 2005 will take place from 8 to 10 March. The deadline for enrolment has been set at *30 July 2004*. For candidates who sat the 2004 examination an extended deadline has been set at *15 November 2004*. For detailed information and enrolment forms, see OJ EPO 3/2004.

Information importante du Secrétariat d'examen de l'Office européen des brevets

Examen européen de qualification : nouvelles dates limite d'inscription

L'examen européen de qualification 2005 se déroulera du 8 au 10 mars. La date limite d'inscription a été fixée au *30 juillet 2004*. Pour les candidats qui ont participé à l'examen en 2004 la date limite d'inscription a été fixée au *15 novembre 2004*. Pour de plus amples détails et les formulaires d'inscription, voir JO OEB 3/2004.

epi-Tutorien 2004

Das *epi* bietet 2004 wieder Tutorien zur Vorbereitung auf die Europäische Eignungsprüfung (EEP) 2005 an.

Dieses Jahr werden Tutorien für alle oder Teile der Prüfungsaufgaben von 2002 und/oder 2003 angeboten.

Um den Anforderungen der Kandidaten besser gerecht zu werden, wird es wieder zwei Termine geben, einen im Sommer und einen im Herbst.

Der Sommertermin (Anmeldung bis spätestens 7. Juni 2004) behandelt die Aufgaben A und B und ist für die Kandidaten gedacht, die die EEP im Jahr 2005 zum ersten Mal ablegen wollen (vollständig oder in Modulen). Der Herbsttermin (Anmeldung bis spätestens 11. Oktober 2004) behandelt die Aufgaben C und D und ist für alle Kandidaten von Interesse, auch für diejenigen, die ein Tutorium für die 2004 nicht bestanden Prüfungsleistungen wünschen.

Die Daten für die Tutorien sind wie folgt:

Sommertermin

Angebotene Prüfungsunterlagen:

A und B 2002 und 2003

Anmeldung bis spätestens: 07.06.2004

Versand der Prüfungsaufgaben
an die Kandidaten bis: 28.06.2004

Eingang der Antworten auf die
Prüfungsaufgaben A und B bis: 06.09.2004

Kommentare zu den
Prüfungsaufgaben A und B bis: 14.10.2004

Besprechung: Februar 2005

Herbsttermin

Angebotene Prüfungsunterlagen:

C und D 2002 und 2003

Anmeldung bis spätestens: 11.10.2004

Versand der Prüfungsaufgaben
an die Kandidaten bis: 28.10.2004

Eingang der Antworten auf die
Prüfungsaufgaben C und D bis: 20.12.2004

Kommentare zu den
Prüfungsaufgaben C und D bis: 24.01.2005

Im Sinne eines reibungslosen Ablaufes der Tutorien werden die Kandidaten gebeten, sich an die angegebenen Fristen zu halten. Kandidaten für den Sommertermin werden gebeten, sich sobald wie möglich, spätestens jedoch bis zum 7. Juni 2004 durch Rücksendung des ausgefüllten Anmeldeformulars an das *epi*-Sekretariat (Fax Nr. +49 89 242052-20) anzumelden.

Für weitere Auskünfte wenden Sie sich bitte an das *epi*-Sekretariat (Tel. +49 89 242052-0).

epi tutorials 2004

In 2004 the **epi** will again offer tutorials for candidates wishing to prepare for the European qualifying examination (EQE) in the year 2005.

This year we offer tutorials with the options of doing all or some of the papers of 2002 and/or 2003.

To try to serve the candidates' needs better, there will again be two tutorial terms, one running in the summer and the other in the autumn.

The summer term (enrolment deadline 7 June 2004) comprises papers A and B and is aimed at particularly those candidates who are going to sit the EQE in the year 2005 for the first time (either in full or in modular form). The autumn term (enrolment deadline 11 October 2004) comprises papers C and D and is aimed at all candidates including those who wish to have tutorials for those papers which they failed in the 2004 EQE.

The tutorials will run according to the following timetable:

<i>Summer term</i>		<i>Autumn term</i>	
Papers offered:	A and B for 2002 and 2003	Papers offered:	C and D for 2002 and 2003
Enrolment:	07.06.2004	Enrolment:	11.10.2004
Papers sent by:	28.06.2004	Papers sent by:	28.10.2004
A and B, scripts in by:	06.09.2004	C and D, scripts in by:	20.12.2004
A and B, comments by:	14.10.2004	C and D, comments by:	24.01.2005
Meeting: February 2005			

Candidates are reminded to be ready to stick to the indicated deadlines to allow a smooth progressing of the course.

Candidates for the summer term are encouraged to enrol as soon as feasible, and by 7 June 2004 at the latest, by filling in and sending their registration forms to the **epi** Secretariat (Fax No. +49 89 242052-20).

For further information, please contact the **epi** Secretariat (Tel. ++49 89 242052-0).

Tutorat epi 2004

En 2004, l'**epi** propose de nouveau un tutorat destiné aux candidats qui souhaitent se présenter à l'examen européen de qualification (EEQ) en 2005.

Ce tutorat couvre toutes les épreuves, ou partie des épreuves des années 2002 et/ou 2003.

Afin de mieux répondre aux besoins des candidats deux sessions de tutorat sont à nouveau proposées cette année, l'une en été, l'autre en automne.

La session d'été (date limite d'inscription : 7 juin 2004) comprend les épreuves A et B et s'adresse aux candidats qui se présenteront à l'EEQ pour la première fois en 2004 (soit à l'ensemble des épreuves, soit par modules). La session d'automne (date limite d'inscription : 11 octobre 2004) comprend les épreuves C et D et s'adresse à tous les candidats, y compris ceux qui souhaitent un tutorat pour les épreuves auxquelles ils ont échoué en 2004. Il est recommandé aux candidats qui s'inscriront aux épreuves des deux années de traiter en premier les épreuves 2002 afin de mettre à profit les commentaires de leur tuteur pour améliorer leurs réponses aux épreuves 2003.

Le tutorat se déroulera selon le calendrier suivant:

<i>Été :</i>		<i>Automne :</i>	
Epreuves proposées :	A et B pour 2002 et 2003	Epreuves proposées :	C et D pour 2002 et 2003
Inscription :	07.06.2004	Inscription :	11.10.2004
Envoi des épreuves aux candidats le :	28.06.2004	Envoi des épreuves aux candidats le :	28.10.2004
A et B, envoi des réponses le :	06.09.2004	A et B, envoi des réponses le :	20.12.2004
A et B, envoi des réponses le :	14.10.2004	A et B, commentaires retournés le :	24.01.2005
Réunion :	février 2005		

Il est demandé aux candidats de respecter les dates indiquées afin d'assurer le bon déroulement du tutorat.

Les candidats pour la session d'été sont invités à s'inscrire le plus rapidement possible, au plus tard le 7 juin 2004, en renvoyant leur formulaire d'inscription, dûment rempli, au Secrétariat de l'**epi** (Fax no. +49 89 242052-20). Pour tous renseignements, prière de s'adresser au Secrétariat de l'**epi** (Tel. +49 89 242052-0).

epi Tutorials, Summer 2004

7 June 2004

Please return by →
to: **epi** Secretariat
Postfach 26 01 12
D-80058 München

Tel: +49 89 24 20 52- 0
Fax: +49 89 24 20 52-20

Name:

Address:.....

.....

.....

Telephone No.: Fax No.:

Preferred language: English German French Fields of interest: Electricity/Mechanics Chemistry

I should like to enrol for:

- paper A 2002
- paper B 2002
- paper A 2003
- paper B 2003
- papers A and B, 2002
- papers A and B, 2003

I need a copy of:

- all the examination papers relating to the tutorial requested above
- the following papers:

2002	A	B	2003	A	B
	<input type="checkbox"/>	<input type="checkbox"/>		<input type="checkbox"/>	<input type="checkbox"/>

I am a Student of the **epi** I am not a Student of the **epi**

<u>Fees</u>	<u>non-epi Student</u>	<u>epi Student</u>	<u>Fees due</u>
any single paper	60 EUR	35 EUR	
2 papers (2002)	75 EUR	40 EUR	
2 papers (2003)	100 EUR	50 EUR	
4 papers (2002 and 2003)	150 EUR	75 EUR	

Total: EUR

Tutorial fees are halved for each Paper that the candidate declares he/she does not need a copy from the **epi** Secretariat.

Previous courses attended on intellectual property: (CEIPI, QMW, previous preparatory courses etc.):

.....
.....

If you have already sat one or both of the following examinations, please indicate its date(s):

– a national examination

– the European Qualifying Examination:

Years of professional experience:

Would you be willing to travel to meet your tutors?

.....

Date of fee payment into the following **epi** account, and its amount:

Postbank München
Account No. 703-802
BLZ (Bank Sorting Code) 700 100 80
IBAN No. DE77700100800000703802

.....

Please note that **epi** tutorial fees **cannot** be debited from accounts held with the European Patent Office

Date:

Signature:

Name:

More epi tutors wanted

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

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

Being a tutor certainly implies some work, but it also is rewarding. It gives you an opportunity to help younger colleagues and at the same time keep up with the development. Thus it can be seen as a kind of continuing professional development.

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

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

The Professional Qualification Committee

Tutors for epi Tutorials

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

Technical field: Electricity/Mechanics Chemistry

Language: English German French

I am ready to make comments to the following papers

A B C D

Name:

Address:
.....
.....

Phone:

Fax:

e-mail:

.....
Signature

Please return to *epi* Secretariat
P.O. Box 26 01 12
D-80058 MÜNCHEN Germany
Tel: +49 89 24 20 52-0
Fax: +49 89 24 20 52-20
e-mail: info@patentepi.com

Neue Telefon- und Faxnummern

Bitte beachten Sie die neuen Telefon- und Faxnummern des Sekretariats:

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Folgende Personen können direkt angewählt werden:

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Haberl Stefan (Buchhaltung)	+49 89 242052-17
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Please note the new telephone and fax numbers of the Secretariat:

Tel: +49 89 242052-0

Fax: +49 89 242052-20

You can contact the following persons directly:

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Haberl Stefan (Accounting)	+49 89 242052-17
Monéger Dominique (Secretariat)	+49 89 242052-12
Zérafa André (Accounting)	+49 89 242052-16

Nouveaux numéros de téléphone et de fax

Veuillez noter les nouveaux numéros de téléphone et de fax du Secrétariat :

Tel: +49 89 242052-0

Fax: +49 89 242052-20

Vous pouvez contacter directement les personnes suivantes :

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Della Bella Diana (Secrétariat)	+49 89 242052-11
Haberl Stefan (Comptabilité)	+49 89 242052-17
Monéger Dominique (Secrétariat)	+49 89 242052-12
Zérafa André (Comptabilité)	+49 89 242052-16

News from the Secretariat

Christian Böhner joined the Secretariat as from 1. February 2004. Christian is a part-time member of the book keeping staff as well as acting as a receptionist for telephone calls.

Litigation of Patents in Europe: the Proposed European Patent Litigation Protocol and the Proposed Community Patent¹

R. Freeland² (GB)

1. Introduction

In the 1970s, the European Patent Convention („EPC“) established a new system of patent law and a new patent granting authority for all Contracting States, the European Patent Office („EPO“). The EPO grants patents („European Patents“) under the EPC which, upon grant, take effect as national patents in each of the particular Contracting States designated. Validity and infringement of the granted patent can then be litigated in the national courts of the Contracting States. In accordance with the EPC, the Contracting States harmonised their national laws as to patentability, so that as far as possible the national courts of each Contracting State would approach the issue of validity of granted European Patents in the same way as the EPO. The harmonised law included, of course, harmonised rules as to the interpretation of claims. This in turn meant (at least in theory) that the law as to whether a product or process falls within the claims of a patent for purposes of infringement was also substantially harmonised across the Contracting States.

Further, in parallel with the EPC, the member states of the European Economic Community (now the European Union) negotiated the Community Patent Convention („CPC“). The CPC provided for the harmonisation of laws as to what constitute infringing acts in all member states. Although the CPC has never been brought into force, when member states introduced new patent laws to implement the harmonisation required by the EPC, they also implemented the harmonised provisions as to infringing acts provided by the CPC. Otherwise, in all other ways the CPC remains inoperative, although the European Community has recently revived interest in a Community-wide patent (*see below*).

However, the current EPC system is far from perfect. The EPC defines a common substantive law of patentability across the Contracting States. However, apart from decisions by the EPO on oppositions filed within 9 months after grant of a European patent, there is no central court of appeal on issues of validity, and no central court of appeal on issues of infringement at all. Accordingly, over the last 25 years, the law has received differing interpretations by the different national courts of the Contracting States. Further, and equally significantly, the court procedures and practices adopted in each of those countries differ widely.

These areas of disharmony are explained in more detail in the next two sections of this paper. The practical effect is that industry often finds patent litigation in Europe complex and confusing, and the Courts themselves are unhappy with current „forum shopping“ in patent litigation (that is, the selection of the country in which to commence proceedings on the basis of the perceived advantages of local procedures and other tactical considerations, rather than any substantive consideration of the most objectively appropriate court). Further, although the centralised granting procedure of the EPO has reduced significantly the costs of applying for and obtaining a granted patent in Europe (compared with the costs of making separate national applications in each of the Contracting States), the costs of litigating European Patents after grant under the current system can be substantial, since separate proceedings must be taken in each relevant country. The common perception is that things will have to change.

And change may come from two separate sources. The first is a group of EPC Contracting States who, recognising the problems of the current system, have come together and are negotiating a „protocol“ to the EPC to create a single court system which will deal with all post-grant patent litigation concerning European Patents in those particular countries (the „protocol countries“). The second source is the European Union („EU“) itself (this should of course not be confused with the EPC or its Contracting States: the EU treaty and the EPC are wholly independent, and the member states of the EU are not the same as the Contracting States of the EPC). The European Commission in Brussels (the executive arm of the EU) has proposed the establishment of a new patent (the „Community patent“) which upon grant will take effect throughout the EU as a single unitary patent and which can only be litigated in specialised Courts with jurisdiction throughout the EU.

This paper examines, from the point of view of patent litigators, the disadvantages of the present system and the way in which these are addressed by the current proposals for (i) the European Patent Litigation Protocol, and (ii) a single unitary EU patent.

2. Some substantive law and procedure difficulties of current EPC system

In most European countries the court hearing a patent infringement claim may also take jurisdiction over issues of validity, whether raised as a defence or as a counter-claim, enabling the Court to consider the scope of the

¹ This paper was delivered at a seminar of the Oxford Intellectual Property Research Centre, St Peter's College, Oxford University, in January 2003

² Rowan Freeland, Partner, Intellectual Property Group, Simmons & Simmons

claims once, for assessment of both infringement and validity. In Germany and Austria, however, validity lies within the exclusive jurisdiction of a specialist court (part of the Patent Office), which is wholly separate from the infringement courts. This means that invalidity cannot be raised as a defence to an infringement claim. However, an infringement claim may be stayed or suspended pending the decision on validity by the specialist court. In Austria, the infringement case is generally stayed unless there is a strong clear case that the patent is valid. In Germany, the practice is generally to stay the infringement claim only if there is a strong clear case of invalidity. Since the procedures of the infringement court (the Landgerichte) are more rapid than those of the patent court (the Bundespatentgericht), an injunction can be granted in Germany under a patent which is subsequently revoked.

Another consequence of this split procedure is that it is at least theoretically possible in Germany for the validity and infringement courts to reach differing views as to the scope of the patent claims. The problem is highlighted where the alleged infringement is closely similar to the prior art: the Bundespatentgericht may adopt a very narrow construction of the claims, thereby avoiding the prior art and holding the patent valid, whilst the Landgericht may construe the claims much more broadly, and so find the patent infringed.

Another example of differing procedures is that nullity proceedings may not be brought before the Bundespatentgericht in respect of an European Patent (Germany) while the period for filing an Opposition at the EPO is still running, or if an Opposition (which may last, including appeals, in excess of 4 years) is pending. By contrast, in the UK and elsewhere the question of whether proceedings should be stayed during EPO Oppositions is a matter of discretion for the Court, and in the UK stays are rare: to date, only three contested applications have resulted in a stay, all in the past five years.

But differences in approach are not limited to procedural or practical aspects. Although Article 69 of the EPC and the protocol on the interpretation of Article 69 harmonise the approach to be taken to the construction of claims (combining „a fair protection for the patentee“ with a „reasonable degree of certainty for third parties“), the national courts continue to follow their historical approaches to claim construction. There is a lingering perception that the German courts (and also the French courts) still tend to allow patent claims a broader scope than the English courts, although it appears that the differences in approach between the French, German and English courts are diminishing. The best-known example is the *Improver* litigation, where infringement was found in Germany, Austria and the Netherlands, whereas non-infringement was found in England and Italy.

Even in relation to validity, there are differences of national approach, the most extreme example being the (anecdotal) German case where the fact that the English court had revoked the UK designation of a European

Patent was not sufficient to persuade the German Landgericht that there was a strong case that the German designation of the same European Patent was invalid: the Landgericht refused to stay the German infringement case, and granted an injunction.

3. Some further difficulties of the current system: enforcement forums and „forum shopping“

Throughout Europe, patent infringement cases are heard by a first instance court, with the possibility of two levels of appeal (the second level of appeal is generally available only in cases raising significant legal or constitutional issues). At the first level, there is generally an automatic right of appeal. In England, however, leave is required even for the first level of appeal (although we know of no patent cases where leave to appeal against a first instance decision as to infringement or validity has been refused).

The main remedies of an injunction, an appropriate payment to the patentee by the infringer (in the form of damages or an account of the infringer's profits), and confiscation or delivery to the patentee of all infringing goods in the infringer's possession, are available in all European countries, together with some reimbursement of the winner's legal costs (court fees plus, save in The Netherlands, partial reimbursement of attorneys' fees). In some countries (but not Germany, United Kingdom or Sweden) the infringer may be ordered to pay for publication of the decision in appropriate news media.

In most European jurisdictions it is possible to obtain an interim injunction to stop an infringer from continuing the allegedly infringing acts pending the final decision of the infringement court. The ease with which the national courts can be persuaded to grant such an injunction, however, varies widely. In countries such as The Netherlands and Austria, the courts have shown themselves willing to grant interim injunctions (in Austria, it is not even necessary to demonstrate urgency), while in France interim injunctions are granted only in the clearest cases.

Jurisdictions like the United Kingdom and Germany occupy the „middle ground“ where interim injunctions are possible but not common. It is generally considered that, in many cases, interim injunctions are not necessary, since a decision on the issue of infringement can be obtained in urgent cases in these countries within as little as 6 months and sometimes even more rapidly.

Further complexity is provided by the Brussels Convention on Jurisdiction and Enforcement of Judgements, which applied throughout the European Union, and its successor, EC Regulation 44/2001 (the Jurisdiction Regulation) (references to the latter in this section include references to the former). The Jurisdiction Regulation provides that a defendant should be sued in the country where he is domiciled, no matter where in the European Union the wrongful act has taken place. Alternatively, the defendant may be sued in the country where the wrongful act (that is, the alleged act of infringement) took place. Once jurisdiction has been established under

one of these rules, other defendants who are proper parties to the dispute may also be joined. Once one court has been properly „seised“ of a dispute (that is, the necessary formalities for the commencement of proceedings have been complied with), all other courts in the European Union are obliged to decline jurisdiction, although they are permitted to grant interim relief where appropriate.

It has been argued that the rules of the Jurisdiction Regulation allow a patentee to ask a single court in Europe to decide the issue of infringement of a „family“ of patents for all relevant EU countries, particularly where the patent in question is a European patent with the same text in all countries. However, the Jurisdiction Regulation does not abolish national jurisdictional rules. Accordingly, in most European countries, the national courts are reluctant to grant injunctions to take effect outside that country. There is no such rule in the Netherlands, however, and the Dutch courts have shown themselves willing to grant pan-European injunctions in patent cases, that is, injunctions to restrain acts of infringement in all EU member states. Even in the Netherlands, however, this jurisdiction has more recently been limited to cases where the „spider in the web“ (the company chiefly responsible for the infringements) is based in Holland, or where the „spider in the web“ is based outside the EU.

Similar injunctions have been sought from the English court, but these applications have been rejected for the following reason. The Jurisdiction Regulation provides that the validity of a patent (including the national designation of a European patent) is subject to the exclusive jurisdiction of the relevant national court. Thus, the validity of a patent can only be decided by the court of the country in which it is in force. This applies even to European patents: the UK designation of a European patent („European Patent (UK)“) can be invalidated only by the UK courts, while a „European Patent (Germany)“ can only be invalidated by the German courts and so on. The English court takes the view that the issues of validity and infringement are so closely connected that it is not possible for the issue of infringement to be determined by a different court from the court which decides validity. As a result, infringement should in effect be subject to the same exclusive jurisdiction of the national courts as validity, and once validity has been put in issue, the English court may not entertain proceedings relating to non-UK patents. As indicated above, the courts of the Netherlands take the contrary view. Practitioners in Europe are waiting for the European Court of Justice to make a ruling on the issue: although to date three different cases have been referred to the European Court of Justice, they all settled before any hearing.

The conflicting jurisdictional rules have given rise to „forum shopping“ by patentees and companies fearing infringement proceedings, seeking to exploit the jurisdictional rules of the Jurisdiction Regulation to choose a court which will enable the dispute to be resolved rapidly (for the patentee) or slowly (by the putative infringer).

Patentees have therefore tended to prefer the relatively rapid courts of Germany, the Netherlands and England. Putative infringers have developed strategies to counter this, called „torpedoes“, where the putative infringer brings proceedings before the courts of a country whose procedures are slow, seeking from that court a declaratory judgment of non-infringement not only of the local national patent but also of all counterparts throughout Europe. If the patentee then brings infringement proceedings in any other EU member state, the courts of that state must stay the proceedings until the original court has made its own decision as to jurisdiction. In countries such as Belgium and Italy, this preliminary determination of jurisdiction can take two years or more.

For example, defendants who have feared that they might be sued for infringement in countries such as England, the Netherlands or Germany where a relatively rapid decision can be expected, could apply in Belgium or Italy, for example, for a declaration that the English, Dutch and German (and other) patents were not infringed. Such an application would require the courts in England, the Netherlands or Germany to stay any subsequent proceedings for infringement of the same patents until the jurisdictional issue had been decided by the Belgian or Italian courts. This could take a considerable time even where it is clear that, under Belgian or Italian law, such a claim is not permissible. During the period of this delay, negotiations for settlement could take place.

As indicated above, the Jurisdiction Regulation does permit the courts which are not seised with the primary dispute to grant interim relief, and the courts in Germany have held that the filing of „torpedo“ proceedings in another jurisdiction can be sufficient by itself to satisfy the „urgency“ requirement so that the German court can then grant an interim injunction in Germany. Another German court has decided, however, that this does not apply if the „torpedo“ claim is brought in what a common lawyer would call the *forum conveniens* (for example, a claim in Belgium by a company whose European Headquarters are in Belgium). It is too early to tell how the courts of England or the Netherlands will deal with the question of interim relief.

These procedural „games“ are likely to continue until the European Court of Justice gives an authoritative decision on the underlying jurisdictional questions. However, if a case is referred for decision to the European Court of Justice on a jurisdictional issue, the case so far as it is governed by that issue (and, frequently, all the proceedings) in the national court will be stayed until the European Court of Justice gives its ruling, and this in a typical case will not be handed down for over two years or so. In most multinational disputes, there is considerable pressure to negotiate a settlement following the first decision by a national court, and the slowness of the European Court of Justice procedure means that most disputes are likely to have been resolved by decisions elsewhere (for example, in the US) before the European Court of Justice can give its ruling. It is therefore likely

that most referrals to the European Court of Justice will continue to be settled in advance of any ruling.

A potential defendant who is afraid of being sued in a court which it dislikes, but which does not simply want to delay matters, might be able to exploit these procedures in what may be called an „ECJ torpedo“. It would commence a conventional national action to revoke the national patent and/or for a declaration of non-infringement, but it would add to this a claim for a declaration of non-infringement of all the European counterpart patents. In England, at least, the issue whether the court has jurisdiction over the claim relating to the European counterparts is likely to be referred to the European Court of Justice, and that part of the claim in the national court would be stayed: but the claims relating to the national patent would proceed to trial and judgment (which in England would take typically about a year). In this way the putative infringer could try to obtain a favourable judgment relatively rapidly, while preventing the patentee from proceeding in the courts of his own choice (for example, Germany, where the bifurcated procedure can lead to an adverse decision on infringement a year or more before the decision as to validity).

4. The proposed solutions: the EPLA and Community patent

At present, there are two separate proposals which can deal with these problems. One is the draft European Patent Litigation Agreement („EPLA“) (which initially started as a proposal for an optional „litigation protocol“ to the EPC), which is being considered on behalf of certain European states (the so-called „protocol countries“) interested in harmonising litigation procedures, and the other is the proposed Community patent (and Community Patents Court) which is being debated at the European Commission and Council level. However, there remains a significant dispute as to whether the EPLA group are competent to discuss the proposed Agreement because of the Jurisdiction Regulation (EC Regulation 44/2001) on Jurisdiction (which replaced – and is essentially identical – to the Brussels and Lugano Conventions). The European Commission takes the view that the EU Member States lost their competence to negotiate the EPLA due to the ratification of the Jurisdiction Regulation. However, the protocol countries take the view that each country which enters into the EPLA can nominate the proposed European Patents Court („EPC“) as its „national court“ for the purposes of the EC Regulation to handle disputes in relation to European patents. This is yet to be resolved.

This paper focuses on the provisions in the EPLA which, as currently proposed, are more developed than the details which have been published on the Community patent.

From the first proposal for what was then called the European Patent Litigation Protocol, a „Working Party“ was set up comprising delegations from the countries most interested in the concept. This Working Party has

established a „sub-group“ to take forward and draft the detailed proposals, the sub-group comprising delegations from the UK, Germany, France, The Netherlands, Denmark, Sweden, Switzerland, Luxembourg and Monaco. The sub-group appointed Jan Willems, formerly a judge in The Hague and now of the EPO, to prepare possible draft treaty text. Judge Willems prepared the first draft proposal in July 2000 which, following much debate by the protocol countries, has now resulted in a draft European Patent Litigation Agreement („Agreement on the establishment of a European patent litigation system“). The draft Agreement was published by the EPO in November 2002 following a meeting of the sub-group the previous July. The draft Agreement sets out the provisions for the legal system for litigation of European patents, the structure, procedure and jurisdiction of the „European Patents Court“ (including the Court of first instance and Court of Appeal), and how the system and Courts will be administered and financed. A brief summary of the main provisions is set out below.

5. Current EPLA Proposals

The EPLA system envisages two courts – a court of first instance (called „EPC1“), and a court of appeal from the EPC1 (called „EPC2“). After the expiry of the transitional provisions, the EPC1 and EPC2 will have exclusive jurisdiction over all proceedings relating to the infringement and validity of European Patents in any or all of the protocol countries. Patentees can commence proceedings in EPC1 for infringement of patents in any or all of the protocol countries. Defendants in those proceedings can counterclaim for revocation of the patents on the grounds of invalidity in all of the countries in which infringement is alleged, plus any or all of the other protocol countries. Further, parties can commence invalidity proceedings in EPC1, seeking revocation of European patents in any or all of the protocol countries.

However, national courts of the protocol countries will continue to have jurisdiction over interlocutory (interim) injunctions and other provisional matters. Any such injunctions given by national courts will cease to have effect if not followed speedily by proceedings before the EPC1 (eg within 31 days) and in any event will have no cross-border effect. Interlocutory injunctions will also be available from EPC1, with cross-border effect.

Structure of the Court and allocation of cases

The EPC2 will have a seat somewhere in Europe (at a location to be decided – a highly political issue). It will sit in panels of three judges of mixed nationalities, comprising at least one technical judge.

The structure of the EPC1 will be somewhat more complicated. This court will also have a central division somewhere in Europe, probably at the same location as the EPC2. However, there will also be regional divisions of the EPC1. Every country or group of countries can request the creation of such a regional division, having „territorial jurisdiction“ (see below) for the territory of that state(s). Such a request will have to identify two

experienced patent judges in that country or group of countries who are willing and able to sit as judges of the EPC in that regional division. These judges may also continue sitting as judges in their national courts. If a regional division has more than 100 patent cases to deal with each year the administrative committee can create an additional regional court in any division.

It will be possible for parties to agree that a particular division will have jurisdiction. Alternatively, the Claimant may nominate either the central division or a specific regional division (in respect of which he would follow the rules as to „territorial jurisdiction“ under EU Regulation 44/2001: for example the regional division may be (or include) the domicile of (one of) the defendants, the place of infringement, or the place where an attacked patent is registered). If no regional division has jurisdiction, the case will be brought before the central division. The central division will also hear all cases that consist of pure claims of invalidity (that is, not as part of a counter-claim).

A case may be filed at either the central division or a regional division. When a case is filed, the president of the central division or the regional division, as the case may be, will allocate it to the appropriate central or regional division: there is no appeal from this allocation. After the allocation of a case the relevant division of the court will appoint a panel of judges to sit on the case.

Whether the case is to be heard in the central or regional division, the three judges making up the panel will be appointed, probably according to a pre-determined rota, from the international „pool“ of judges.

Judges

Any person may be appointed as a judge who has sufficient relevant experience. This has been arbitrarily fixed to mean that a judge must have experience of 10 patent cases during the previous three years. It is envisaged that the judges will comprise some members of the Boards of Appeal of the EPO and specialist or experienced patent judges from the protocol countries. Judges will be appointed as either legal or technical judges. Technical judges will be appointed as competent for one or more of chemical, biotechnical, physical, mechanical, electro-mechanical and software cases.

Each panel of judges in EPC 1 will include one technical judge and two legal judges. One of the legal judges will be appointed rapporteur and the other will be the chairman of the panel. The rapporteur will be responsible for case management up to the last procedural step (the oral hearing) and will have wide ranging powers in connection with that responsibility. It will be possible for the chairman to appoint a co-rapporteur where necessary, but usually the three-person panel of EPC 1 will comprise a chairman, rapporteur and technical judge.

The EPC2 panel will consist of three judges, at least one of whom will be a technical judge.

Language

The language of the proceedings and the judgment thereafter shall be one of the three official EPC lan-

guages used in the EPO, viz French, German or English. In the central division, unless the parties agree otherwise, the language will be the EPC language in which the EPO granted the patent. In the regional division, the rules are more complex but in essence the language of the proceedings and judgment shall be the EPC language which is most closely associated with that particular region.

Procedure

All cases will proceed in three stages. Stage one will be the written stage, stage two will be the instruction stage and stage three will be the oral stage.

At the first stage (the „written stage“), the parties must file written submissions. First, the plaintiff files a statement of claim, containing a concise statement of the nature of the claim and the facts on which he is relying. The statement of claim should include the whole case for the plaintiff. The defendant must file a full statement of defence within three months, stating which allegations he denies and stating his reasons for doing so. If the defendant intends to put forward a different version of events he must do so in writing at this stage.

The second stage (the „instruction stage“) will consist of a conference of the parties with the rapporteur and, if appropriate, the taking of evidence. Evidence can be taken in written or electronic form or by the hearing of parties, witnesses, and/or experts. The rapporteur will conduct the first conference, the aim of which is to identify and clarify the main issues and to fix a time schedule for the proceedings. The rapporteur should examine the possibilities of an amicable settlement at this time. The conference can be adjourned and continued at a later date and time if appropriate. During the instruction stage, the rapporteur will ensure that the evidence is as complete as possible for the efficient conduct of the oral proceedings. To this end the rapporteur can allow parties to hear witnesses, can appoint a court expert, can order experiments, can order the production of documents or order local inspection.

The third stage (the „oral stage“) consists of an oral hearing which will take place following the end of the instruction stage. The oral hearing is not automatic: it will be held only if requested by one of the parties or by the court. The court can hear further witnesses or experts at this stage if it thinks fit, but it is envisaged that such further evidence will only be required in exceptional circumstances. At the close of the oral proceedings, the chairman of the panel will announce the probable date of the decision. The decision will be in writing, with full reasons. Judges may also write concurring or dissenting opinions.

Throughout the proceedings, all parties must be represented before the court by a lawyer registered by the Registrar as a European patent counsel. The Registrar shall register any lawyer who is entitled to represent parties in normal civil proceedings before a civil court in any of the protocol countries and who applies in writing for such registration. Further, a technical adviser who is an authorised patent agent (patent attorney) in a proto-

col country may assist the representing counsel. The technical adviser will be allowed to speak alongside the lawyer at hearings under certain conditions.

Evidence

Normally, a party relying on a fact must offer proof of that fact. This will most often be done by way of written witness statements. Witnesses (on points of fact) will only be heard with the leave of the court, and even then they will be heard only on points formulated by the court. Leave can be given by the rapporteur, or on more contentious issues by the court, and shall be given if the parties contest the contents of a statement. If leave is given by the court, the onus of proof lies on the party which has offered to call the witness in relation to the relevant facts addressed by that witness. Witnesses will be heard in front of the court, or the rapporteur, in the presence of the representatives of the parties. Witnesses will normally be heard in the country of their domicile, and they can be heard via video or telephone conference facilities.

After the questioning by the court (or rapporteur), the representative of the party bringing the witness and, after him, the representative of the other party or parties will be allowed to put questions to the witness regarding his evidence and/or circumstances directly concerning the credibility of the witness. The court (or rapporteur) will decide whether or not a certain question is allowed and should be answered.

After the hearing of a witness the court (or rapporteur) will dictate a summary of the essentials of the statement of the witness. This summary will be read out to the witness and the witness will state whether it contains the essentials of his statement and, if so, will sign it.

In relation to experts (on matters of technical opinion), the court or the rapporteur can at any time during the proceedings appoint one or more *court* experts to advise it about certain technical aspects of the case or to answer questions about the case. The appointment of a court expert does not prejudice the parties from producing expert evidence themselves but it appears that such evidence may have little persuasive impact because the court will recognise that the parties' experts may be partisan.

The court will discuss its wish to appoint an expert with the parties, who are free to make suggestions about the identity and number of experts, and to suggest possible questions to be put to them. After considering these suggestions, it is then the court's responsibility to formulate the questions to be put to the expert, in written form, and to give deadlines and reminders to the expert as appropriate for his written responses in the form of a report. Before sending his finalised report to the court, the expert should seek views on the matter at hand from the parties and the report must state that these views have been obtained. In addition, the parties can comment on the report once it has been presented to the court. These views can be in writing or can be given at the oral stage.

The court can allow a party to prove its case by experiment. The party must draw up a detailed protocol to describe the experiment, and all parties and their representatives and experts must be present when the experiment is carried out.

The court may also order a party to produce to the other party documents if the another party has made a reasonably plausible case that those documents should be disclosed. Further, the court can itself at any time request that a party produce a document. If the party does not comply with such a request the court may draw such inferences as it sees fit.

Finally, on the application of an actual or potential party to proceedings, the court will also have the authority to make an order for the inspection and preservation of evidence which is or may be relevant in those proceedings. This power is very similar to the current power of the French court to make such orders for inspection (called „saisie contrefaçon“). It represents a powerful weapon for patentees and a real concern for potential infringers.

Parties authorised by such an order are permitted to enter premises (other than a private home) in any protocol country and, while on the premises, to take any steps specified in the order. These steps are likely to include taking samples, inspecting a process, copying documents or taking photographs. The order may also direct the person concerned to provide information to persons specified in the order and to allow any person described in the order to retain for safe keeping anything described in the order. If proceedings are not brought before the court within 21 days after the visit, the order will cease to have effect, and the applicant will be liable for damages caused by its enforcement.

Provision can be made to preserve the confidentiality of evidence provided as a result of a court order.

Decisions and Appeals

The decision of the court will be reasoned and be given in writing, signed by all members of the panel. Any member of the panel will be allowed to express his opinion separately in the decision, whether he concurs or dissents. The decision of the court will be treated as if it were a decision of a national court in each relevant protocol country, and a decision revoking a European Patent (wholly or in part) shall have effect in all protocol countries for which it is designated.

All decisions of the EPC1 may be appealed to the EPC2. An appeal from the EPC1 must be filed within three months. The grounds for the appeal must be set out in numbered points stating exactly which parts of the decision and/or reasoning the appellant opposes and the reasons why. Any party wishing to respond to the appeal must do so within two months after receiving a copy of the appeal from the registrar. The EPC2 will only decide, on the basis of the detailed grounds of appeal, whether the EPC1 has correctly established the facts alleged by the parties at first instance and whether it has correctly applied the law to those facts: it appears that new

evidence and arguments will be admitted only in exceptional circumstances.

EPLA Timetable

Although a draft Agreement on the establishment of a European patent litigation system has been published, the progress of the EPLA is still subject to the resolution of the issues raised by the European Commission as to the competence of the protocol countries (rather than the Institutions of the European Union) to set up supra-national courts.

The provisions in the draft Agreement are currently being considered by the full Working Party, originally with a view to presenting an agreed text to the next Intergovernmental Conference, which was due to take place in Spring 2003. However, it now appears that the EU Member States can not agree on a date for a Ministerial Conference because of uncertainty as to the on-going negotiations for the Community Patent Regulation (see below): this is important because a number of countries support the EPLA only if the Community Patent is not introduced. Accordingly, it is understood that the Working Party have agreed that the sub-group should meet again in early Summer 2003 to discuss the outstanding issues such as the financing of the EPC and the administrative bodies following which the EPLA should be ready to be signed. The Working Party currently anticipate meeting again at the end of 2003 to decide whether the legal and political situation within the EU will allow a Ministerial Conference in 2004.

In any event, a number of other key issues have yet to be resolved. A consensus has not yet been reached in a number of key areas. Thus, there is as yet no final agreement on the language(s) to be used in the court proceedings, the way in which expert evidence is handled, the location of the „centralised“ EPC1, and whether the second instance EPC2 should be restricted to a review of the decision at first instance, or whether it should re-hear the case, and admit new evidence.

Finally, it appears that Sweden, Switzerland, Finland and the UK currently support both the EPLA and the Community Patent proposal. Germany, Holland and Denmark will support the EPLA if the Community Patent proposal fails (they are unable to envisage the two systems working together) and Italy, Spain, Belgium, Austria and Portugal are against the EPLA. The remaining EPC protocol countries are currently undecided either way.

6. The unitary Community patent

In addition to the draft EPLA, there is a separate proposal from the European Commission for the creation of an unitary Community patent, taking effect throughout the EU. Despite the publication by the European Commission of the „Working Document on the planned Community Patent Jurisdiction“ on 30 August 2002, little detail has been published about the proposed judicial arrangements for the Community patent.

Following the publication of the initial EU „Proposal for a Community Patent Regulation“ on 08 August 2000, the EU Members States (via meetings of the „Internal Market, Consumer Affairs and Tourism Ministers“ now renamed the „Competitiveness Council“) have grappled with the main issues concerning a Community Patent system. The basic concept is straightforward: the the EU will accede to the European Patent Convention, and the EU will be an alternative (compulsory?) to the designation of specific member states.

For enforcing a Community Patent, there is sufficient basis for the establishment of a Community Patents Court within the Nice Treaty which was signed in December 2000. Article 229a of the Nice Treaty confers jurisdiction on the European Court of Justice („ECJ“) to determine issues relating to Intellectual property rights. Article 225a of the Nice Treaty allows the establishment of judicial panels (including a Court of Appeal) within the Court of First Instance (which is part of the European Court of Justice).

Granting of Community patents

Once the EU has acceded to the EPC, the EU would be designated a state under the EPC, so that instead of designating, say, Germany, UK, France and the Netherlands in an European patent application, an applicant may designate the EU. The EPO would then examine and grant the patent in the usual way, although on grant the patent would have unitary effect Community-wide.

The Court

The European Commission's draft proposal for a Community Patent Regulation provided for a central Community Patents Court with jurisdiction in all patent matters (validity and infringement), at both first and second instances, and working to a timetable designed to provide a final (second instance) decision within two years.

The recently published „Working Document“ envisages a centralised court in Luxembourg (which is part of the CFI), divided into two chambers (first and second instance) and a number of divisions, each division handling a case load of approximately 75 cases each. In the event that more than 150 cases are „introduced“ (i. e. commenced) in a year, it would then be possible for a regional (or decentralised) court to be established in the member state from which the most claims had originated in the centralised court. This is in contrast to the proposal in the draft EPLA where regional courts can be created where a protocol country (or group of countries) requests its creation, and two experienced patent judges in that country (or group of countries) have been identified who are willing and able to sit as judges of that regional EPC.

Judges/Rapporteurs

As with the EPLA, the „Working Document“ envisages specialised patents judges and technical judges. Two patent judges and a technical judge would sit at first instance, with a further two patent judges and a technical judge sitting on appeal. Three technical judges

would be appointed, one in each of the areas of physics, chemistry and mechanics, in respect of each of the first instance and appeal courts. Where necessary, rapporteurs would be appointed to assist the Court in relation to other technical fields, although they would not be able to vote.

Procedure

The procedure of the CPC would be governed by the current Statute of the Court of Justice (which governs procedure in the ECJ) together with new Rules of Procedure („RoP“) specifically dealing with (1) actions between private parties (rather than Member States), and (2) patent actions.

Problems and progress to date

There are two major issues that have to date seriously delayed the implementation of a Community Patent system. The first is the question of the languages in which the Community patent should be published (and the related issue of the cost of providing translations). The second issue is whether there should initially only be a centralised court or both centralised and decentralised courts. To date neither question has been resolved.

With regard to language, the current proposal is that a Community patent application could be made to the EPO in any EU language; whereupon it would be translated into one of the three EPO procedural languages (namely English, French or German). However, on grant, all the claims would then have to be translated into all the official EU languages. Even before enlargement of the EU in 2004, this would make the grant of a Community Patent more expensive than the grant of a European Patent, a US patent or a Japanese patent.

Following the publication of the Commission's Working Document in August 2002, the Competitiveness Council met on 14 and 26 November 2002. It is understood that no significant progress was made at either meeting other than to identify 8 points of principle in relation to the proposed Court system which remain subject to agreement. It is understood that these are now being considered at ministerial level under the Greek presidency with a further meeting scheduled in Spring 2003 to discuss them.

The points in question include the language of proceedings, the jurisdiction of Court over compulsory licences, the ability of Member States to band together in regions for the purposes of decentralised courts and the role of legal/technical judges.

Far and away the biggest issue remains the question of centralised/decentralised courts. It appears that France now supports Germany in wanting decentralised courts from the outset, arguing that forum shopping between decentralised courts is actually a good thing. This attitude appears to reflect intense lobbying by the local legal profession, and renders pointless the attempt to secure a unitary system for litigating a unitary patent. Other states (including the UK) are adamant that the first instance court must be centralised, and must operate to a single agreed procedure. It is hard to envisage that these issues will be resolved in the near future.

Nevertheless, the officials in the European Commission have expressed a determination to implement a community patent system. If they succeed, it will include for the first time a supra-national court system for determining disputes between private parties rather than Member States – an achievement indeed.

The uncertainties of the proposal for a Community Patent Regulation

E. Armijo (ES)

The latest draft of the proposal for a Community Patent Regulation (CPR), issued on 21 November 2003 (15086/03) by the Presidency of the Council of the European Union, the latest proposal for the Revision of the European Patent Convention (revised (EPC)) issued on 25 September 2003 (12705/03) and the two Proposals for Decision of the Council in relation to the jurisdictional system, issued by the Commission on 23 December (2003/0324-0326 CNS), involve some uncertainties taking into account the provisions of the common political Approach, approved by the Competitiveness Council of Ministers of the European Union, on 3 March 2003.

I – Uncertainties concerning the procedural part of the CPR

1. The mutualisation of costs (revised EPC)

Which Body or which Office will be doing the translation into one of the 3 EPO languages of the text filed in a different language?

How to control the quality and costs of these translations?

Who will pay for these translations? The EU system? The European Patent system?

Will it be confined only to filings by applicants from Member States or to filings in an official language of a Member State or to any filing from any applicant from any State?

Will there not be a discrimination between nationals who file in an EPO language and nationals who file in their own language?

2. *The role of the National Patent Offices (revised EPC)*

Will the national searches only be possible when the European Patent application only designates the EU as a whole (1st alternative) or will the national searches also be possible when the European Patent application designates at the same time the EU as a whole and one or several non-EU Member States (2nd alternative)?

In the 2nd alternative how might the result of the national search (in a non-EPO language) be applicable to the non-EU Member States designated in the European Patent application? Will it be accepted by these non-EU Member States, or will it have to be repeated or supplemented and will the national search have to be translated and who will pay the cost (the applicant or the system)?

How will the EPO make the substantive examination when a search has been done by a national patent office in a non-EU language? Again, will the result of the search have to be translated into the EPO language chosen by the applicant? Which Organism will be doing the translation? How to control the quality? Will it also have to be done at the system's expense or at the applicant's expense? If it were to be made at the system's expense how will the taxes be applied so that non-EU members will not be jeopardized?

How can the Best system be applicable in the first and in the second alternative?

3. *The choice of the EU designation in the European Patent application (Art. 1 – CPR)*

Will it have to be made at the application date, so as to have the following three possibilities:

- mutualisation of costs
- national searches
- EU provisional rights after the publication of the patent application?

Will it be possible to make the choice of the EU designation at any other moment of prosecution, up to grant? Will this be possible taking into account that third parties rights will be affected from the application date due to the fact that the translated text to be respected by them will be more limited in one case than in the other and the binding jurisdictional system will be different in one case and the other? Will this be possible in the case where the applicant will not be able to benefit any more from any of the already referred three possibilities, or can the applicant renounce them?

4. *The EU provisional rights after publication of the patent application (Art. 11 CPR)*

Will it be compulsory to file the translation of the claims into all of the official languages of the EU, unless a Member State agrees to dispense with a translation into its language?

5. *Place of filing of the claim translations (Art. 24a CPR)*

Would there not then be a progressive disappearance of the National Offices and loss of control over the quality of the texts translated due to the proposal for a centralized filing at the EPO?

6. *The maximum term for filing the translation of the claims (Art. 24a-para. 3 –CPR)*

The latest Council discussions are aiming at a maximum term of nine or twelve months following grant of the patent.

Will there not be a lack of equilibrium in favour of the owner to the detriment of third parties over a long period, on the latter not knowing with exactitude the rights they have to respect and their possible inexistence?

Will not a discrimination occur between those opposing a Community Patent whose official language is one of the 3 EPO languages and those whose official language is any other?

7. *The consequence of the absence of the compulsory filing of the translation of the claims (Art. 24 b-paragraph 2-CPR)*

In this case the proposed text establishes that it will be possible for the holder of the Community Patent to convert it into a European Patent designating one or more Member States.

Will this be a way to delay filing of the translations on the deadline compulsorily required in the European Patent system under Art. 65 EPC?

Will not this absence of compulsory filing imply an exhaustion of rights in the Member States where no translation has been filed?

Will this optional alternative be possible taking into account that the applicant may have already had the benefit of mutualisation of costs, and/or have applied for national searches and/or provisional protection for his European Patent application for the EU as a whole?

Will this optional alternative be possible taking into account that third parties rights will be affected from the application date due to the fact that the translated text to be respected by them will be more limited in one case than in the other and the binding jurisdictional system will be different in one case and the other?

Will this proposal not open the door to abuse by those interested solely in the European Patent, on thus obtaining all these benefits not provided for in the EPC?

8. *The authentic text of a Community Patent or Community Patent Application (Art. 24c CPR)*

Will it be possible to have different effects on the scope of protection of the community patent when the corresponding translation into the different languages of the Member States is not in line with the text granted in one of the 3 EPO languages?

Will there be an emergence of prior user rights in the Member State where a more limited scope of protection results from a wrong translation or from a translation not

defining the invention in a clear, sufficient and complete way?

Will a third party be able to select the country where the translation will be more limited for exporting from that country the exported product to the rest of the EU Member States without infringement due to exhaustion of the rights?

Will a third party be able to claim damages whenever jeopardized by a translation with a wider scope than the original text?

Will the scope of the translated claims be interpreted in accordance with Article 69 EPC jointly with the text of the Specification translated into the language of the defendant at the time litigation starts or jointly with the text of the Specification in the granted EPO language?

9. *The prior national rights as ground for invalidity (Art. 28/CPR)*

Will it be possible to convert a community patent or a community patent designation into a bundle of national patents or national patent designations when becoming aware of prior national rights, (patents and utility models), unpublished at the application date?

10. *Maintenance fees on the community patent (revised EPC)*

How will these be calculated so as not to exceed the average cost of the maintenance fees on an average European Patent? What is an average European Patent?

Will these maintenance fees on the community not turn out prohibitive for owners when exceeding the current maintenance fees for the set comprised solely by DE, UK, FR for example?

II – Uncertainties concerning the jurisdictional system of the CPR

1. *The language of the proceeding*

What will be the language of the proceeding when the defendant is non-resident in the EU and in those cases where there are various defendants?

2. *The public hearings*

In what cases can the Community Patent Court (CPC) hold public hearings in States other than those where it has its seat? How? Who will bear the cost?

3. *Linguistic skills of the judges*

What degree of linguistic skill are the judges required to possess in order to handle proceedings in the languages of the defendants? Does the Court of Justice have to be comprised by as many judges as there are official languages in the EU?

4. *The technical experts*

During legal proceedings what importance will the assistance of technical experts have? Will their role be public or secret? Will they take part at the hearings? Will they take part in the Court's deliberations? What influence will they have with technically inexperienced judges, who are to have not technical qualification, upon the jurisdic-

tional system being based on Article 225A of the EC treaty?

5. *The necessary number of judges*

Will it be possible to find sufficient judges with the required characteristics, as mentioned above, to be able to judge in relation to any defendant in any Member State, taking into account the possible large number of community patents that may be the – active or passive – subject of litigations before the CPC?

6. *Damages*

Why does article 11 CPR establish the possibility of obtaining a reasonable compensation if the applicant happens to have sent the person working the invention, or deposited before the Office, a translation of the claims in the official language of the Member State in which said person resides whereas, on the other hand, article 44 CPR only speaks in these circumstances, of compensation by way of damages.

7. *The procedural rules*

Will the judicial procedure be established on the basis of civil law or on the basis of common law?

How will proving the facts constituting the infringement be ruled? By the continental system or by the Anglo-Saxon system of discovery and cross-examination of witnesses?

8. *The text of the patent basis of the action*

Will it suffice to have a full translation of the text of the patent at the beginning of the lawsuit?

What will happen in the case of a petition for injunction without having the full translation of the text? Will this affect bonds and damages?

If, in accordance with the entitlement established in article 58, said translation of the full text does not occur, how will this affect interpretation of the scope of the patent based on the translation of the claims alone, and how will the doctrine of equivalents be applied?

9. *Simultaneous interpretation during hearings*

When the parties and the witnesses express themselves in an official EU language differing from the language of the proceeding and the necessary translations and interpretations, in that case, be provided in that language, will the party sharing the same language as the judge have an advantage over the other party needing these interpreters and translations?

Who will pay the corresponding expenses?

10. *The transitional period*

During the transitional period, once the Member States have designated National Courts with jurisdiction over actions and claims relating to community patents, can the defense against an infringement action be based upon the lack of a fully translated text, in the official language of the defendant, violating the European Convention on Human Rights?

Can the defendant, as pre-trial question, allege that the lack of such text translated into the official language of his State violates his constitutional rights?

Will the national courts have to limit the indemnifications to the national level, or may they set these at community level?

Official Position Paper of the German „Patentanwaltskammer“

E. Popp¹ (DE)

The right of representation of patent attorneys in Community Patent litigation.

On March 3, 2003, the Council decided on a political orientation towards the Community Patent. On June 11, 2003, the Commission presented a proposal for a Regulation on the Community Patent and on June 17, 2003, a proposal for Revision of the European Patent Convention. Another proposal concerning the transfer of jurisdiction in Community Patent litigation to the Court of Jurisdiction of the European Communities, the creation of a Court Division, and the amendment of the Statutes of the Court of Justice, is expected shortly.

It is the expressed wish of the patent attorney profession in the member states that the right of representation of patent attorneys be clearly defined in the Statutes of the Court up to the occasion of the amendment of the Statutes when jurisdiction in matters concerning Community patent litigation is transferred to the European Court of Justice.

We propose that a *new paragraph 8 be inserted in Article 19 of the Statutes of the Court:*

„Patent attorneys, who are citizens of member states where the legal order permits them to act in court as representatives of a party, have the legal status before the Court in Community Patent lawsuits which this Article grants to lawyers.“

- (1) This supplement would clarify Article 19, paragraph 4 of the Statutes of the Court which read that „only a lawyer (Anwalt) who is entitled to appear in a court of a member state may appear before the Court as a representative of a party“. Paragraph 4 requires that the person be a „lawyer“ (Anwalt), rather than an *attorney-at-law* (Rechtsanwalt), *solicitor* or *barrister*. According to the legal order of member states such as Austria or Germany, a patent attorney, is also a lawyer admitted to act as counsel within legally defined limits in matters of intellectual property rights and entitled to appear as such in court. Thus, in addition to attorneys-at-law, patent attorneys in Germany are independent agents of the law (§ 1 of the Patent Attorney Code) enjoying the same statutory rights and obligations as the former (obligation of secrecy, right to refuse to give evidence, prohibition of seizure). In Great Britain, a

patent attorney may appear before the Patents County Court and, in addition, acquire the position of a „Patent Agent Litigator“ or „Patent Attorney Litigator“ which corresponds to that of a „Solicitor“. The introduction of a new system for resolving disputes relating to Community Patents, therefore, should be the occasion to expressly and explicitly include in the Statutes the right of representation of the patent attorneys of the member states.

- (2) The provision suggested above makes due allowance for the *circumstances actually existing under the law of the member states*. In several member states, such as Great Britain, Austria, and Germany as well as in future member states, such as Hungary and Poland, the respective national legal systems permit a patent attorney to appear in court as a representative of a party. In Germany, for example, patent attorneys are entitled to representation in nullity procedures before the Federal Patent Court and the Federal Court of Justice (BGH), enjoying equal rights in this respect as do attorneys-at-law (§ 111, paragraph 4 of the German Patent Law). Our above mentioned proposal, moreover, also corresponds to the provision included in the Statutes specifically for university professors. Similarly, the basic situation varies from one member state to the other. Therefore, according to Article 19, paragraph 7 of the Statutes, the prerequisite for the right of representation before the Court is the respective authorization under national law to represent a party. It is only logical to provide an analogous regulation for patent attorneys in Article 19 of the Statutes, based on the fact that the legal order of the member state grants them the right to represent a party in court.
- (3) With respect to its content, the proposal also is in line with the model *agreed upon by the representatives of the member states of the European Patent Convention, within the framework of the so-called European Patent Litigation Agreement (EPLA) regarding the right of representation in a possible European Patent Court*. Following intensive discussions of the Draft Statute of the European Patent Court, an opening clause for Article 34 of the EPLA draft of April 24, 2003 was accepted by a large majority with only a few reservations. The clause is

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intended to permit not only attorneys-at-law but also other persons to represent a party in patent litigation before the so-called European Patent Court. The term „person“ was chosen to broaden the group of party representatives admitted to the court to include patent attorneys possessing the requisite legal knowledge.

- (4) The proposed regulation safeguards a party's lawful right to be heard in Community patent litigation. It is, after all, one of the essential functions of counsel to ensure that a party seeking justice is granted its right to the opportunity of being heard in court. In recognition of the principles of due process of law and fair trial, it is provided in Article II-47, paragraph 2, second sentence of the Draft European Constitution that 'it shall be possible for any person to seek advice and have its case pleaded and represented'. Contributions to preliminary discussions according to which this right should refer exclusively to „attorneys-at-law“ were not reflected in the basic rights charter. Particularly, in disputes over patent matters, it is only expedient to leave it to the party concerned whether it chooses to be represented by a patent attorney offering his/her technical and legal background, by a legally trained attorney-at-law, or by both and, in the latter case, to decide who should be the leading attorney. It must be kept in mind particularly that in patent matters the wording of requests to be submitted (technical definition of patent infringement, language of patent claims to be pursued) is very demanding as such matters are characterized by great technical complexity. The means of attack and defence of a party seeking justice will be curtailed and due process hampered in Community patent litigation if the party is not

allowed to have its interests represented by a patent attorney, contrary to approved legal rules and regulations and well established practice in various member states and in spite of the fact that the party may consider representation by a patent attorney to be a better solution in view of the complicated technical and legal issues.

- (5) If the right of representation were questioned on the European level for those patent attorneys who enjoy that right so far under the law of their respective member state this would amount to depriving them of work as patent attorneys in an important field which is characteristic of their profession. It would be tantamount to challenging without sufficient reason the position of patent attorneys as lawyers and *encroaching upon the freedom to exercise their profession* (Article II-15, paragraph 1 of the Draft European Constitution). The counter-argument set forth that there is no equivalent professional training, experience, and right of representation for this profession in all member states does not hold water for the simple reason that the situation with university professors likewise is not uniform in all member states. Moreover, both Article 19 of the Statutes and Article 104, § 2 of the Procedural Regulations for Preliminary Rulings, which deals with a modified form of statutory requirement of representation by a lawyer, are concerned only with the right of representation in the member states. Additionally, Article II-52, paragraph 6 of the Draft European Constitution also expresses that 'the legal provisions and practice applied in individual states must be fully allowed for', 'especially considering the bearing and interpretation of laws and principles'.

European Patent Litigation Agreement

Final drafts available on the EPO's website

<http://www.european-patent-office.org/epo/epl/index.htm>

U. Joos and E. Waage
(EPO Directorate 5.2.2, International Legal Affairs)

1. Almost five years have elapsed since the Paris Intergovernmental Conference mandated a working party to present proposals for setting up a common European litigation scheme for European patents (see OJ EPO 1999, 548). The aim was to solve long-standing problems arising from multiple patent litigation in Europe, which involves high costs, legal uncertainty, cross-border litigation and forum shopping.
2. The basic legal instruments needed for a new litigation scheme were finalised at the last meeting of the Working Party on Litigation in November 2003:
 - Draft Agreement on the establishment of a European patent litigation system.
 - Draft Statute of the European Patent Court.
 These instruments constitute the European Patent Litigation Agreement (EPLA), formerly known as the „European Patent Litigation Protocol“ or „Willems Proposal“.

3. The main characteristics of the EPLA are the following:

- It is an *optional* agreement negotiated between those EPC contracting states which are prepared to move forward; DE, UK, FR, NL, CH, SE, DK, FI, MC and LU, in particular, have been active in the working party.
 - It is a *self-contained* international agreement setting up a *new organisation* (the European Patent Judiciary) comprising a supervisory body (the Administrative Committee) and the *European Patent Court* (Court of First Instance, Court of Appeal and a Registry) with jurisdiction to deal with infringement and revocation actions concerning European patents.
 - The *Court of First Instance* will comprise a Central Division and a number of Regional Divisions to be set up on request in the participating states. One common *Court of Appeal* will hear appeals against decisions of the Court of First Instance, and also act as *Facultative Advisory Council*, with the task of delivering, on request, non-binding opinions on any point of law concerning European or harmonised national patent law to national courts trying infringement and validity actions.
 - At first and second instance, *international panels* comprising *legally and technically qualified judges* will deal with cases in accordance with *uniform rules of procedure* including extensive powers to order provisional and protective measures and impose sanctions.
 - The *language regime* will be based on the language regime of the EPC (three official languages), as adapted to post-grant litigation (on the model of the London Agreement on the application of Article 65 EPC).
 - *Representation* before the new Court will be entrusted to persons registered as European patent counsel, who may be assisted by professional representatives (*epi* members).
4. European industry (UNICE) and other interest groups (*epi*, AIPPI, FEMIP) strongly support the project, which in principle would be ready for sub-

mission to a Diplomatic Conference. However, at the end of its last meeting, the Working Party on Litigation adopted a declaration announcing that the establishment of a litigation system for European patents has to be held in abeyance on account of the work being done by the European Union with a view to introducing a Community patent with a jurisdictional system of its own. The working party also stressed that the coming months will be used for consultations to resolve potential conflicts between the law of the European Union and the planned European patent litigation system.

5. The EPLA has reached maturity at a time when much attention is directed to the Community patent project. Yet both projects offer exciting prospects for users and there is actually no rivalry between the two:

- The future Community patent system will not include any jurisdictional arrangement for the 650 000 European patents granted by the EPO since 1980, nor for the many European patents that the EPO will continue to grant for the next few decades.
- A litigation system for European patents is already badly needed by European industry, and the proposed European Patent Court could be fully operational within, say, five years. By contrast, it will still take a considerable time for the first Community patents to be granted, and even then it is unlikely that a significant volume of infringement and revocation actions will be initiated immediately.
- Finally, in the long run, if it turns out that users need both the Community patent and the European patent, it must be possible to design legal mechanisms to ensure that the Community Patent Court and the European Patent Court elaborate harmonised case law. After all, the two courts will have much in common: they will both be internationally composed European courts dealing with the infringement and validity of patents granted by the same Office on the basis of the same substantive patent law.

EPO-Eurasian Seminar on Patents in the 21st Century

On September 1, 2003, a joint EPO-EAPO seminar on „Patents in the 21st Century“ was attended by representatives from the Russian IP profession as well as speakers from various organizations, EPO, EAPO, WIPO, Rospatent, UNICE and the *epi*. The topics comprised mainly economic issues, such as investment, the economic

evaluation of patent rights and various aspects of international law and national law. One of the Russian speakers contributed a paper on the Eurasian patent system which might be of interest for the members of the *epi*.

Walter Holzer, *epi* President

Eurasian and European Patents – similarities and differences

V. Medvedev¹ (Russia)

When we speak of European Patent Conventions, what is meant is: European Patent Convention (EPC), adopted in October 1973 in Munich, and Eurasian Patent Convention (EAPC), which was adopted in February 1994 in the WIPO headquarters in Geneva.

The 17-year difference between the terms of existence of the two Patent Offices of course had an effect on the number of countries party to the said patent conventions. But, in the case where these two Patent Offices are given consideration within the frame of the world patent system, then thanks to them the issue of getting patents in Europe on the whole has become significantly simpler and of higher quality. These two conventions provide a patent protection over the territory of about 40 countries.

There are two sides to the experience of Russian and Eurasian patent attorneys cooperating with EPO and EAPO. On the one hand there are 25 years of relationship with European patent attorneys and through them with EPO, but at the same time, taking the specificities of the Russian economy into account, this interaction in respect to particular patent applications, taking their number into account, leaves much to be improved. So, in 2001 and 2002, patent attorneys of „Gorodissky & Partners“ sent respectively 16 and 13 European applications to EPO.

At the same time, we have been working with EAPO for a substantially less period of time, but, in the first place, directly with examiners of EAPO, and in the second place, with a significantly greater number of patent applications. Thus, during the indicated years we filed 567 and 561 Eurasian applications, respectively, with EAPO.

Both Patent Offices act as centralized offices for filing, searches and examination of applications. Both of the regional conventions are harmonized with international treaties.

Exclusive rights in accordance with European (EP) and Eurasian (EA) patents enter into force from the day of

publication of the indication (EP)/information (EA) of the grant thereof in the EP and EA Bulletins, the patents providing the same rights and being subordinate to the same provisions as a national patent, if the conventions do not provide otherwise.

The term of validity of the said patents is 20 years from the filing date of an application. However, European Convention provides party countries with the right to extend the term of validity of a patent in the case where the subject matter of the patent is a product or method of preparation, which was subjected to the Administrative Permission procedure prior to marketing of the patent (Article 63 of the European Convention). Such a provision, unfortunately, is not to be found in Eurasian Convention, although national patent legislation in a number of countries party to that convention, including the Russian Federation, already contains this provision.

In accordance with both conventions, the scope of protection provided by a patent is determined by the content of claims. The specification and drawings are used for interpretation of claims. Both conventions are close in their approach to interpretation of claims, i.e. neither literal nor liberal interpretation is maintained. In our opinion an extremely important feature is that not only the specification, but also the drawings, are used for interpretation of claims. This undoubtedly normalizes a consideration of matters concerning infringement of patentee's rights in controversial situations and provides greater possibilities to applicants and patentees with the proviso that the specification of an application and drawings are properly executed.

In respect to questions relating to infringement of a patent, European Convention does not contain provisions relating to the definition of acts which are an infringement of the patent. Issues concerning infringement and validity of a European patent relate to the competence of national legislation and courts.

Eurasian Convention (Rule 17) contains the aforementioned provisions, although questions relating to infringement and validity of a patent are also given

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consideration by courts of the party countries and their decisions have force only on the territory of the country in which the matter has been instituted. And there is a comprehensive list in Eurasian Convention of acts which constitute an infringement and this list provides a patentee with wider authority for bringing charges against a patent infringer as compared with patentees in the majority of countries party to Eurasian Convention, who have been granted national patents.

European applications may be filed with EPO in Munich, The Hague, Berlin or in any national Patent Office of party countries. The applications may be filed in any of the three official languages of EPO, in particular English, French or German. Since EAPO is located only in Moscow, Eurasian applications are only filed with EAPO in Moscow or in national Patent Offices of party countries, if this is provided for by the national patent legislation of these countries. The official language of EAPO is Russian.

The procedures for filing an application, search and substantive examination, publishing the application and granting a patent are similar in a number of respects in EPO and EAPO. The main differences are due to the three official languages, which may be used in proceedings of EPO, and also to the subsequent procedure for entering a granted European patent into force in countries in which the state language is not one of the official languages of EPO.

These differences begin to manifest themselves directly at the stage of filing applications in EPO and EAPO. On the whole, both Patent Offices require the presentation of one and the same set of documents when an application is filed.

When a European application is filed, those countries should be indicated in respect to which a European patent will be requested. Such an indication is carried out by paying a fee in respect to each country or paying a fee for seven countries, which automatically means that a European patent is being requested in all the countries party to European Convention. This is a relatively strict requirement of European Convention, since after expiration of the time limit for indicating the countries in which the European patent will be in force, the introduction of countries not already indicated becomes impossible. A similar procedure is not provided for in Eurasian Convention.

Filing an application with EPO without the presentation of a translation of that application into one of the official languages results in that such an application is deemed to be withdrawn, but EPO leaves an applicant with a possibility of presenting the translation within two months following the date of receipt by the applicant of a notification from EPO that the application, which does not contain a translation, is deemed to be withdrawn and that a relatively significant fine (500 euros) should be paid. There is an exception to this requirement – applicants from countries party to European Convention may present the application materials in the state language of their country with the presentation of the translation into the official language of EPO not later than thirteen

months following the date of the earliest of the requested priority dates. Furthermore, applicants from such countries enjoy a 20 % discount, which is granted in respect to the fees for filing an application, for examination thereof and also for filing an appeal against an Official Action.

An application is filed with EAPO in the Russian language. A translation of the application filed in another language into Russian should be presented within two months following the date of filing the application or, under condition of payment of an additional fee in an amount of \$100 USD – within two more months following the date of expiration of the preceding two months.

Case proceedings in EPO may be carried out in any of the three official languages, but the main language for the case proceedings, which should be used for introduction of amendments into an application, is that language in which the application is filed. A divisional application should be filed in the same language as the patent application.

EPO stipulates several other requirements in respect to international applications in which EPO is indicated as the receiving Office and which are published in one of the official languages of EPO. It is considered that such applications comply with EPO requirements in respect to the language in which the application materials are presented, but an applicant may present a translation thereof into another official language if he desires to select the latter as the main language for further case proceedings.

An applicant filing an application in accordance with PCT and indicating EPO may go to the European phase within 31 months following the filing (priority) date of the PCT application independent of whether or not a request will be submitted for an international preliminary examination.

EAPO will not begin consideration of an international application or a formal examination in respect thereto until 31 months have passed from the priority date of the international application. However, in accordance with a special request submitted by an applicant, EAPO may begin examination of the international application at any time prior to expiration of the indicated time limit.

In accordance with both Conventions, patents are granted for inventions that are novel, involve an inventive step and are industrially applicable. Both Conventions contain virtually identical lists of exclusions from patentability, differing only in lists of exclusions. In accordance with Eurasian Convention, patents are not granted for plant varieties and animal breeds, nor also for solutions, the use of which is contradictory to public order and morals. European Convention supplements this list with methods of acting on a human or animal organism by means of surgery or therapy, and also methods for diagnosis of a human or animal organism. In accordance with the direct indication of section 4 of Article 52 of European Convention, such solutions are not deemed to be patentable in view of the fact that they are not industrially applicable, but a more detailed inter-

pretation of this provision is provided on a precedential level in the decision G3/95 of Board of Appeal, in which, in particular, it is indicated that such an exception is not valid in respect to devices and instruments intended for use in surgery or therapy or to materials intended for producing thereof. Furthermore, this exception does not extend to other methods of acting on a live human or animal organism, for example, for the removal of body tissue, while methods for diagnosis are patentable in the case where they are realized in respect to, for example, body tissues, which after being subjected to the method for diagnosis are not returned to the organism from which they were taken.

Using interpretation provided on a precedential level as an example, one more specificity of the procedure for obtaining a European patent in particular and of European Convention in general should be noted. In particular – at the moment a relatively large portion of European Convention is provided in addition to material and procedural norms by precedential norms developed by the Board of Appeal. These precedential norms provide the necessary interpretation of virtually all the provisions of European Convention, which makes it possible for EPO to develop a homogeneous practice, and for all those engaged in patenting inventions in accordance with the procedure of that Convention – to act in accordance with that practice.

Together with carrying out preliminary (formal) examination of applications, EPO and EAPO carry out a patent search in respect thereto and send the results of the search to an applicant. In respect to original applications filed with EPO, it has stated that they do everything possible to send the applicant the results of a patent search within six months following the date of filing the application. EAPO has not made such statements, but practice shows that in respect to original applications filed with EAPO, the results of the search are sent within virtually the same six-month time limit. The early dispatch of results of the search to an applicant makes it possible for him to make a conclusion on the advisability for further examination proceedings in respect to the filed application or for supplementation of the application. Since the results of the search come to the applicant before the official publication of the original application, the applicant may also withdraw the application without any consequences and, for example, after revising it file it again.

The results of the patent search are published by EPO and EAPO together with the application itself 18 months after the filing date or priority date, if the latter is requested. In EPO, this is publication A1. In the case where there is no search report, only the application is published – publication A2. The search report may be published separately, but with indication of the application to which it relates – A3. There is a slightly different procedure carried out in respect to PCT applications. Rule 70 states that the international search report and its publication replace the international search report and its publication which are stipulated by Eurasian Convention. A similar provision is provided by Article 157 of

European Convention, but with indication that EPO carries out an additional search in respect to all international applications.

Provisional legal protection, granted to a claimed invention within the scope of the published claims, enters into force from the date of publication of the application. However, the conditions in accordance with which a provisional legal protection enters into force are different for European and Eurasian applications. In respect to a published European application, provisional legal protection accrues only for designated states, the selection of which is confirmed by payment of a corresponding fee when the application was filed. Furthermore, a provisional legal protection for an invention according to a European application does not accrue in respect to those countries, the state language of which is not one of the official languages of EPO, and a translation of the claims published in that state language was not presented.

As distinctive therefrom, the publication of a Eurasian application in Russian in accordance with Rule 10 causes the accrument of provisional legal protection of an invention within the scope of the published claims over the territory of all states party to Eurasian Convention.

The accrument of provisional legal protection in respect to European and Eurasian applications filed with those offices in accordance with the PCT procedure is regulated in an identical manner – for EPO, a provisional legal protection accrues from the date of publication of the European application in the international phase in one of the official languages of EPO, for EAPO – accordingly in the Russian language.

Both Conventions stipulate that an applicant should submit, within a six-month time limit from the date of publication of the search report, a request that substantive examination of the claimed invention(s) be carried out. In respect to international applications filed with EPO and EAPO on the 31st month–completion of the PCT international phase the aforesaid time limit is missed for sure. Therefore, in respect to these applications, the request for conduction of substantive examination should be submitted by payment of corresponding fees when such applications are filed.

The period of time that passes before the first Official Action is issued after a request is submitted for the conduction of examination may depend on the backlog of an examiner of EPO. This period of time may be reduced if a request for acceleration of proceedings in respect to the application is submitted.

Further proceedings in respect to examination in EPO and EAPO differ mainly only in respect to the approach of these Offices to the question of a possibility of introducing further changes into the application materials. Both Offices undoubtedly exclude the possibility of changing the essence of the claimed inventions. However, the procedure adopted by EPO is more strict as compared with the procedure of EAPO in respect to a number of other amendments. According to EPO procedure, amendments, which are introduced into the claims and relate to subject matters that were not given con-

sideration in the process of the search and are not related to the subject matters claimed in the original claims by one and the same inventive concept, are not accepted. Furthermore, subject matters that were withdrawn from consideration in the course of examination cannot be subsequently restored.

During the whole term of consideration of a European application by EPO, annual fees should be paid for maintaining the application in force. Such fees in EAPO are paid after the grant of a Eurasian patent and are calculated by adding the fees for maintaining a granted patent in states party to Eurasian Convention EAPC from the filing date of the application.

In EAPO, as in EPO, the procedure of substantive examination is completed either with the agreement of an applicant with a notification being sent to him by the examiner containing a final draft of specification and claims with which a patent may be granted or with a decision issued by the examiner to refuse the grant of a patent.

After the publication of information on the grant of a patent, EPO provides a third party nine months, EAPO – six months, in which an appeal against the grant of the patent may be sent. Grounds for satisfying such an objection are the same – nonconformity of the granted patent with the conditions of patentability or the presence of features in the patent which were not mentioned in the original application.

An Official Action of EPO and EAPO to refuse the grant of a patent may be appealed.

In accordance with Eurasian Convention, an appeal against a decision to refuse the grant of a Eurasian patent shall be filed within a three-month time limit from the date of receipt of a notification of such a decision. A appeal shall be given consideration by a Board of Appeal consisting of three examiners, at least two of which did not earlier be involved in examination of the application in respect to which the refusal decision was issued.

In accordance with European Convention, an appeal against a decision to refuse the grant of a European patent shall be filed within a two-month time limit from the date of notifying an applicant of such a decision. An originally submitted appeal shall be given consideration by Examination Department that issued the refusal decision, and in the case where the appeal is sufficiently well-founded, this Department is empowered with the right to reconsider its decision. In the case where the decision remains without change, the appeal is forwarded to the Board of Appeal. The Board of Appeal gives consideration to the essence of the appeal and issues a decision thereon. In the case where a decision is issued to satisfy the appeal and to return the application for further examination.

Article 21 of European Convention stipulates the makeup of the Board of Appeal. In accordance with the provisions of that article, the Board of Appeal giving consideration to an appeal against a refusal decision is given consideration by three examiners who have a legal qualification.

Appeals against decisions adopted by an Examination Department consisting of less than four examiners are given consideration by the Board of Appeal with a makeup of two examiners who have a technical qualification and one expert who has a legal qualification.

Appeals against decisions adopted by an Examination Department, consisting of four examiners, or appeals, the essence of which so requires, are given consideration by the Board of Appeal with a makeup of three examiners who have a technical qualification and two examiners who have a legal qualification.

Appeals against all other decisions adopted by an Examination Department are given consideration by the Board of Appeal with a makeup of three examiners who have a legal qualification.

Appeals against the grant of a European patent are given consideration by the Board of Appeal with a makeup of two examiners who have a technical qualification and three examiners who have a legal qualification.

In order to resolve particular legal questions during the consideration of appeals or in accordance with a decree of the President of EPO, and also with the aim of ensuring an identical practice of application of rights during examination of applications, Article 22 of European Convention introduces the structure of an Expanded Board of Appeal. The Expanded Board of Appeal consists of two experts who have a corresponding technical qualification and five experts who have a legal qualification. One of the experts who has a legal qualification is designated as a Chairman of the Expanded Board.

European Convention provides particular conditions that guarantee the independence of the examiners drawing up the decision of the Board of Appeal.

Decisions issued by the Board of Appeal are subject to obligatory publication and become, as was already mentioned above, a source of precedential right, i. e., interpretations obligatory for all participants of the process of patenting inventions according to the EPC procedure.

As regards a decision in respect to an appeal, which has been issued by the Board of Appeal of EAPO, this decision may also be appealed by filing an appeal in the name of the President of EAPO. The President either designates another Board of Appeal or independently issues a final decision, which is not subject to further appeal.

Administrative revocation of European and Eurasian patents may be carried out at the request of any person. Wherewith grounds for revoking in accordance with the conditions of both Conventions virtually coincide. However, a decision is issued on the basis of legislation of a party state and is valid on the territory of the party state where the request for revocation was filed.

In the case where this is allowed by national legislation, the revocation may relate to a part of the patent, not the whole, i. e., limitation of the patent is declared.

A comparative analysis of Official fees of EPO and EAPO is presented below.

The structure of the fees for filing applications with the Offices is somewhat different:

The following is usually paid when an application is filed with EPO:

- a) basic fee = EUR 125
- b) fee for each claim over 10 = EUR 40
- c) fee for search = EUR 690
- d) fee for indication of countries = EUR 75*N (N=1, 2...7, where N is the number of designated countries) = EUR 525.

Wherein it should be taken into account that the fee for indication of the countries may be paid later when the request for conduction of the examination is filed.

The fee for the search is not paid if the search was carried out by EPO.

The fee for the search is reduced if the search in respect to an international application was carried out by some Patent Offices, including the *Russian Patent Office*.

As an example let's take an application with about 50 pages of specification, 2 independent claims and the total number of claims – 20. The maximum total sum to be paid when filing the application is EUR 125 + EUR 690 + EUR 525 + EUR 400 = *EUR 1740*.

When the application is filed with EAPO, the following is paid:

- a) basic fee = EUR 734
- b) fee for each claim above five = EUR 64.

The basic fee and the fee for each claim above five are reduced by 25 % in the case where there is an international search report and by 40 % in the case where the search in respect to an international application was carried out by the Russian Patent Office.

The total sum to be paid when this application is filed is EUR 734 + EUR 960 = EUR 1694.

Thus, the sums for filing applications are comparable.

In EPO, when an application is filed, a one-month delay in payment of the basic fee, the fee for more than 10 claims and the fee for the search is permissible with payment of a 50 % fine.

In EAPO, when an application is filed, a two-month delay in payment of the basic fee and the fee for more than 5 claims is permissible with payment of a 20 % fine.

The fee for examination should be paid within six months following the date of publication of the European Fee Report.

When a request that examination be carried out is filed with EPO, a fee in the amount of *EUR 1430* is paid.

When a request that examination be carried out is filed with EAPO, a fee in the amount of *EUR 733* is paid for one independent claim and *EUR 1284* for several independent claims.

The first fee for extension in EPO corresponds to the end of the second year following the filing date of a European application and annually after that if the

application is still under consideration. In the case where the first fee for extension is paid prior to the entering of a PCT application into the European phase, the next fee may be paid during the transition (i. e., after 31 months following the priority date) without payment of a fine.

In EPO, when a patent is granted, a fee is paid for the grant and publication of the patent in an amount of *EUR 715* for the first 35 pages of the application and *EUR 10* for each page above 35.

In EAPO, when a patent is granted, a fee is paid for the grant and publication of the patent in an amount of *EUR 500* for the first 35 pages of the application and *EUR 5* for each page above 35.

A delay in payment of this fee is not provided for in EPO.

A two-month delay in payment of this fee or a three-month delay from the date at which an additional notification is sent is provided for in EAPO. In the last two cases a *EUR 92* fine is paid.

In EPO, an annual fee is paid for maintaining the application in force, beginning with the third year after the filing date of the application, in an amount of from *EUR 380* to *EUR 1020*.

A delay in payment of this fee in EPO is provided for with a 10 % fine.

In EAPO the payment of a fee for maintaining an application in force is not provided for.

In EPO an annual fee is paid for maintaining a patent in force, beginning from the third year of validity of the patent (in some cases from the first or second) in an amount of from 37 euros to EUR 1147 for each of the countries in which the patent is maintained in force.

A six-month delay in payment of this fee is provided for in EPO with a 50 % fine.

In EAPO an annual fee is paid for maintaining a patent in force, beginning with the third year from the filing date of an application (in some cases from the first or from the second) in an amount of from *EUR 37* to *EUR 1147* for each of the countries in which the patent is maintained in force.

A six-month delay in the payment of this fee in EAPO is provided for with a 50 % fine.

In EPO a return of the fee is provided for acts which are not carried out by EPO during a search in respect to the application or during of substantive examination.

In EAPO a return of the fee is provided for in the case where payment of that fee was carried out in an amount exceeding the prescribed amount or when the act for which the fee was paid was not carried out.

In EAPO countries party to the Paris Convention with low incomes of the population, a 90 % discount is granted in respect to all official fees of EAPO.

Freedom of information or freedom of infringement?

S. Riccardi (IT)

The new millennium has been defined by many as the millennium of the free circulation of ideas and information apart from that of globalisation, but it could also be the millennium of the end of industrial property, at least judging by some worrying tendencies.

It seems clear to me that we are living in a historical moment in which many of the values of the Western world, for instance progress, technology, property, and inevitably, the protection and the exclusive right for intellectual work are being questioned once more and strongly challenged. A clear sign of this refusal of science and technology is the continuous decrease in number of students in the technological and scientific university courses. How can one promote research when there are no researchers?

If we examine in detail the challenge of industrial and intellectual property, it becomes evident that this refusal crisis was notably increased after the signing of the WTO and TRIPs agreements, regarded as an imposition and not an instrument of cultural, technological and economical growth.

In this way biotechnological patents, pharmaceutical patents, software protection, the prohibition to reproduce sound and images without authorization are challenged and questioned and the list goes on and on, neither can it be denied that some capable theorists of our own field are in favour of introducing limits here and there. It goes without saying that in this way the patents would be reduced to simply being a documentary evidence of merit in front of mankind and the firms' patent portfolios would merely serve the purpose to draw up a ranking of the number of documents in possession, actually forcing the firms to hide behind industrial confidentiality, behind know-how and consequently depriving the patent institution of any value.

Unfortunately, another powerful tool for promoting the freedom of infringement is the free access to all patent documentation (and it being for free) and most of all to the entire granting procedure of the patents, no doubt very useful indeed to patent professionals, but a potential danger to inventors and firms. In this way the general impression, and also that of many engineers and managers as well, is now that freedom of information equals freedom of exploitation, in the same manner that most people deem it perfectly legitimate or in any case a right (even though it is forbidden by law) to download and copy anything from the Internet or from television.

It is clear that an average technician with fairly good Internet skills, with the possible aid (not always required and/or needed) of a patent attorney and/or lawyer, is

capable of studying in depth any patent, capable of discovering weaknesses surfacing during the course of the examination and/or search, and sooner or later to find a way to work around it.

Furthermore, the length and the expenses of a trial discourage small and medium enterprises (SMEs) from defending their patents, thus increasing a sense of distrust and creating a feeling of helplessness in the event of infringement.

In my opinion, in order to save the credibility of the patent system and to send out a clear message that freedom of information does not mean freedom of infringement, the judicial system needs to seriously consider the violations of industrial and intellectual property rights, especially acting with extreme rapidity and granting without hesitation, every time they are well-founded, all the required precautionary measures, at most against deposit of a reasonable security. Otherwise one will have to resort to repressive measures, that is by the general use of criminal law and repressive and timely intervention by the police and other government agencies.

Certainly, in medium and especially in long term perspective, it cannot be overlooked that globalisation, which cannot be stopped and that in one way or another will bring, perhaps in a century or more, to some kind of worldwide political unity, should bring about as an unavoidable consequence the establishment of a worldwide patent or the pure and simple disappearance of patents, but fortunately we will leave it to our posterity.

Back to the present, another not so marginal way to strengthen the patent protection system came to me by the current debate in Italy among intellectual property scholars regarding the omnibus claim.

For instance, as in Germany the law courts tend to extend with the theory of equivalents the scope of protection excessively restricted by local examiners, I believe that the idea, put forward by the well-known Prof. Mario Franzosi, to add and grant a more detailed omnibus claim, that specifies the solved problem, the use and/or the generic means employed for this purpose is an excellent idea. In my opinion, such a final claim could have a very similar or almost identical format to the Abstract or the Summary of the Invention, as they are drafted by several patent law firms not only in the U.S., but also in Europe.

In conclusion, if one does not wish to return to a period of obscurantist conservatism, there can be no scientific, technical, social and economical progress without reward and protection for intellectual work.

La politique pro-déposant de l'OEB a des conséquences négatives

Francis Hagel (FR)

Le brevet est un instrument d'incitation à l'innovation qui a pour contrepartie la diffusion au public d'une description de l'invention. La protection accordée au déposant étant une restriction à la liberté d'action des tiers, il importe qu'elle soit justifiée, dans son existence et dans sa portée, par la contribution technique de l'inventeur. L'équilibre entre le déposant et les tiers est donc l'objectif d'intérêt général du système des brevets. La CBE contient à cet effet les mécanismes de *checks and balances* permettant au déposant/breveté comme aux tiers de défendre leurs intérêts et l'OEB, autorité chargée de l'application de la CBE et comptable à ce titre de l'intérêt général, doit tenir la balance égale entre le déposant et les tiers. Ce rôle est à l'oeuvre de la façon la plus caractéristique dans la procédure d'opposition, où l'OEB agit comme arbitre entre le breveté et un tiers, tout en conservant la capacité de poursuivre la procédure d'office en cas de désistement de l'opposant.

Il nous apparaît que la politique actuelle de l'OEB se concentre trop exclusivement sur l'intérêt du déposant et néglige le public en tant que partie prenante. Ceci est préjudiciable à l'image de l'OEB, à l'autorité dont bénéficient ses décisions et à la crédibilité des brevets délivrés, et un retour à l'équilibre nous semble indispensable. A cet égard, les graves perturbations qui agitent aujourd'hui l'USPTO, et qui sont le fruit d'une politique pro-brevet agressive, doivent servir d'avertissement.

La mission de l'OEB

Selon le „mission statement“ par lequel l'OEB définit officiellement son rôle, l'OEB est „l'autorité de délivrance des brevets en Europe“. Cette définition est correcte. On doit cependant regretter que le „mission statement“ ne fasse aucune référence à la procédure d'opposition, qui est pourtant une composante essentielle de l'équilibre entre les intérêts en présence, et que des „utilisateurs“ soient mentionnés sans autre précision. De même la notion d'„organisation de service public“ reste dans le vague, le contenu du „service“ offert et l'articulation avec la fonction d'autorité n'étant pas explicités.

Cette définition de l'OEB en tant qu'*autorité* disparaît toutefois dans le site internet de l'OEB, où l'on peut lire que la „tâche“ de l'OEB consiste à délivrer des brevets européens. Ceci est littéralement inexact : „la tâche de l'OEB“, au sens du travail à accomplir pour remplir sa mission, est avant tout l'examen des demandes de brevet. L'OEB ne remplit pas moins sa mission en rejetant une demande qu'en délivrant un brevet. Si la „tâche de l'OEB“ était la délivrance des brevets, il faudrait conclure que la délivrance des brevets est un résultat auquel l'OEB s'engage vis-à-vis des déposants – ou, exprimé autre-

ment, que dans l'examen, la délivrance est la norme et le rejet l'exception – ce qui est évidemment contraire à la fonction d'autorité de l'OEB.

Il faut ajouter que les aspects de la CBE qui permettent aux tiers de jouer leur rôle – accès au dossier, opposition – sont passés sous silence dans le texte accessible sur le site internet.

Les déposants sont-ils des clients ?

Une autre expression de cette politique consiste à qualifier les déposants de „clients“. Si l'on parle de „clients“ au sujet des déposants, il faut s'interroger sur le „produit“ ou le „service“ fourni par l'OEB dans le cadre des procédures d'examen.

Un brevet n'est pas un „produit“, c'est un droit de propriété, dont l'effet s'exerce sur les tiers par une restriction de leur liberté d'action.

L'examen sur le fond qui conduit à la délivrance est l'activité par excellence dans laquelle l'OEB exerce son autorité. Cette autorité s'exerce à l'égard du déposant, donc éventuellement à son détriment par un rejet. L'examen sur le fond ne saurait donc être considérée comme un service au bénéfice du déposant et la relation entre le déposant et l'OEB n'a rien d'une relation commerciale.

Dans le cas de la recherche, on pourrait arguer que le rapport de recherche est un „produit“, un document fourni au déposant qui lui apporte des informations utiles pour prendre ses décisions. Néanmoins, une telle assimilation est contestable : d'une part les éléments d'appréciation du rapport de recherche impliquent un jugement (même s'il n'est pas explicité en détail) qui émane de l'OEB en tant qu'autorité ; d'autre part ce rapport est rapidement porté à la connaissance des tiers.

Il est clair que le terme „client“ appliqué au déposant est un message par lequel l'OEB souligne sa volonté de prendre en compte les besoins des déposants, d'alléger les formalités, de réduire les coûts et de traiter avec les déposants sur un mode de relation coopératif plutôt que formaliste – tout ceci bénéficiant aux déposants comme à l'OEB sans porter aucun préjudice aux tiers. Néanmoins, ce terme de „client“ porte préjudice à l'image d'autorité légale de l'OEB en lui donnant une coloration commerciale déplacée, et affecte la crédibilité de l'OEB en tant que garant de l'intérêt général.

Il pose aussi la question de la différence de traitement entre le déposant et les tiers: ces derniers sont-ils aussi des „clients“ ? Dans le cas de l'opposition, cela n'est pas possible, car l'OEB, arbitre du débat entre le breveté et l'opposant, ne peut avoir simultanément comme „clients“ deux parties en conflit. Les tiers prenant connaissance du dossier d'examen ou de la littérature

brevets par le site *espacenet* sont des *utilisateurs* de l'OEB et non des clients, car ces informations sont accessibles sans restriction et gratuitement. Si donc seuls les déposants sont considérés comme des „ clients “, cela suggère un traitement préférentiel, contraire à l'équilibre souhaitable entre les déposants et les tiers. Cela comporte en outre de grands risques en termes d'image.

Le fait de qualifier les déposants de „ clients “ crée un tel risque en raison de la relation existant entre les déposants et l'OEB sur le plan financier. Les taxes payées par les déposants constituent la source essentielle de financement de l'OEB. L'indépendance financière de l'OEB est un atout crucial qui lui a permis de se doter des ressources humaines, techniques et de documentation adéquates et de les moderniser constamment, il faut éviter qu'elle apparaisse comme impliquant un défaut d'indépendance envers les déposants et devienne dès lors un handicap. En présentant les déposants comme ses „ clients “, l'OEB nourrit la critique, devenue courante, d'une „ communauté brevets “ formée des Offices de brevets et des spécialistes brevets, qui serait avant tout préoccupée par l'accroissement du volume de dépôts dans le souci d'accroître ses revenus. Une telle critique interprète en particulier toute décision d'extension du domaine brevetable comme un élargissement du marché au profit de ladite „ communauté “. L'OEB emploie d'ailleurs, à tort, le terme de „ patenting community “ qui est significatif en ce qu'il inclut les déposants mais exclut les tiers.

Le fait pour l'OEB de privilégier la relation avec le déposant et de le présenter comme un „ client “ risque aussi de faire apparaître l'OEB comme trop influencé par les intérêts des grands déposants. Dans une relation de nature commerciale, il est normal qu'un fournisseur soit particulièrement attentif aux besoins de ses clients les plus importants. Mais dans le cas de l'OEB, l'égalité de traitement entre déposants, quel que soit leur volume de dépôts, est un impératif, et il serait dangereux que l'OEB soit perçu comme privilégiant le point de vue des grands déposants.

Il est symptomatique qu'une réforme visant à institutionnaliser l'indépendance des Chambres de Recours soit aujourd'hui proposée. Ce projet nous paraît inspiré par le souci pour les Chambres de Recours de prendre de la distance vis-à-vis d'une organisation perçue comme trop favorable aux déposants¹.

¹ Une telle réforme, à notre avis, serait inefficace, le problème de fond concernant l'OEB dans son ensemble. D'autre part, sa logique pose un problème de cohérence avec le système judiciaire européen. La proposition serait pertinente si les Chambres de recours devaient avoir compétence exclusive pour la validité des brevets européens. Ceci supposerait un système dans lequel le contentieux de la validité et celui de la contrefaçon sont séparés et traités par des juridictions distinctes. Mais dans la grande majorité des Etats de la CBE, la même juridiction traite la validité et la contrefaçon, et le même principe est retenu dans le projet de Règlement sur le brevet communautaire et le projet de Protocole sur le contentieux relatif au brevet européen (EPLP). Sur le plan pratique, on peut en outre s'étonner d'une telle proposition, qui exige des ressources supplémentaires non négligeables sans apporter de bénéfice évident aux utilisateurs.

Le contexte international : „ état de crise “ à l'USPTO

Il faut noter que l'OEB n'est pas seul dans ce cas, cette référence au „ client “ est constante dans la communication de l'Office américain des Brevets et des Marques (USPTO) et d'autres Offices. En 1999, le système américain a été réformé pour faire de l'USPTO un „ profit center “ censé apporter de l'argent au budget général au lieu d'être financé par l'argent du contribuable. Dans son „ Corporate Plan 2002 “, l'USPTO décrit d'ailleurs son activité comme un „ business “ et, logiquement, les déposants comme des clients.

Il faut signaler que dans un rapport publié en octobre 2003², intitulé „To promote innovation : the proper balance of competition and patent law and policy “, la Commission Fédérale du Commerce américaine (FTC) critique la délivrance de nombreux brevets sans valeur par l'USPTO et offre des analyses détaillées et des propositions de réforme de grande ampleur. Citons, en liaison avec la discussion qui précède, la manière dont la FTC conçoit la mission de l'USPTO : „L'Office a pour fonction d'être le gardien de l'intérêt général et non le serviteur des déposants“ („*The PTO functions as a steward of the public interest, not as a servant of patent applicants*“).

Selon les déclarations de son précédent Directeur, M. Rogan, et d'autres personnalités, l'USPTO est aujourd'hui „ en état de crise “: engorgement massif dû à une croissance astronomique des dépôts, qualifiée de „ bulle brevets “ par des économistes, avec un afflux de dossiers complexes dans les domaines des logiciels et méthodes de gestion, dégradation de la qualité des brevets délivrés. Tout ceci résulte d'une politique probrevet délibérée initiée au début des années 1980, amplifiée dans les années 1990 par l'extension non planifiée du domaine brevetable. Même si la surcharge que connaît l'OEB est, fort heureusement, très loin d'avoir la même ampleur et est localisée à certains domaines, les difficultés de l'USPTO donnent matière à réflexion. L'OEB devrait se garder de toute autosatisfaction et en tirer toutes les leçons. La croissance des dépôts conjuguée à la pression pour réduire les délais de procédure pose un grave problème de qualité. Il faut considérer tous les leviers, en particulier ceux susceptibles d'agir en amont sur la charge de travail. Les remarques ci-après sont destinées à ouvrir le débat.

La communication de l'OEB

L'OEB devrait rectifier sa politique de communication afin de souligner sa fonction d'autorité garante de l'intérêt général, et cesser de se présenter comme un „ business “ au service des déposants. Une telle attitude est inévitablement comprise comme impliquant une moindre exigence de qualité et encourage à des dépôts pour des innovations de faible mérite.

² Disponible sur le site de la FTC www.ftc.gov.

Recherche

L'un des enseignements évidents de la situation actuelle de l'USPTO est l'importance primordiale de la recherche de l'état de la technique. Selon une formule consacrée, l'examen de brevetabilité ne peut valoir mieux que ce que vaut la recherche de l'état de la technique. L'OEB doit donc maintenir son exigence de qualité en manifestant vis-à-vis des examinateurs l'importance des tâches de documentation telles que l'indexation des nouveaux documents afin que ces tâches conservent une priorité élevée et ne risquent pas d'être sacrifiées sur l'autel de la productivité de l'examen. Il est également important que, dans le contexte actuel de réformes (BEST, fusion DG1/DG2, PCT, coopération internationale,...), l'OEB reste inflexible sur la qualité de la recherche.

Les difficultés dans le domaine des technologies de l'information et d'une façon générale dans tout domaine correspondant à une extension du domaine brevetable sont très largement dues à l'absence de littérature brevets. Il faut donc saluer l'effort en cours à l'OEB visant à numériser la littérature non brevets pour la rendre accessible au travail des examinateurs. Il serait souhaitable en outre que dans la mesure du possible, cette littérature soit rendue accessible au public sur un site du type espacenet.

La documentation de l'OEB, si elle était accessible plus efficacement au public, offrirait en outre un levier pour agir en amont sur le volume de dépôts, notamment de la part des non-Européens. L'OEB devrait envisager la possibilité de proposer à des opérateurs qualifiés (qui pourraient être des agences commerciales), l'accès aux outils de recherche développés pour le travail interne.

Examen

Une opinion largement partagée parmi les professionnels est que l'exigence d'activité inventive est devenue très faible, au point que la nouveauté suffit en fait pour obtenir un brevet. On ne saurait écarter la discussion à ce sujet en citant la stabilité du taux de brevets délivrés par rapport aux demandes, car face à la très forte croissance des demandes observée depuis 10 ans, on aurait dû s'attendre à une baisse du taux de brevets délivrés. Quoi qu'il en soit, l'OEB ne peut se résigner à ce que cette perception perdure, en invoquant l'argument que les tiers ont l'opposition à leur disposition. La présomption de validité d'un brevet délivré n'est pas seulement un concept procédural, c'est aussi un label de qualité dont l'OEB est garant. L'OEB devrait donc manifester une attitude de plus grande exigence et entreprendre une évaluation approfondie avec la participation de professionnels indépendants, par exemple en examinant une série de brevets délivrés récemment.

Il serait en outre utile que les décisions de délivrance soient systématiquement accompagnées par une moti-

vation détaillée incluse dans le dossier accessible aux tiers, afin que ceux-ci puissent pleinement évaluer la portée du brevet et le cas échéant leurs chances de succès dans une opposition.

Logiciels et méthodes de gestion

La situation actuelle de l'examen pour les logiciels et méthodes de gestion est marquée par l'incertitude³. Pour résumer la position de l'OEB telle qu'elle s'exprime dans les Directives pour l'examen (III C.2.2), un produit-logiciel est protégeable s'il est destiné à la mise en œuvre d'un procédé à caractère technique, ce qui implique le caractère déterminant du caractère technique et fait prévaloir le fond sur la forme (la rédaction de la revendication). Mais d'autre part, un ordinateur programmé pour mettre en œuvre un procédé non technique peut également être protégé en vertu de ses „ caractéristiques physiques “ : dans ce cas la forme paraît prévaloir sur le fond. Ces instructions apparaissent donc contradictoires ou du moins non cohérentes. L'impression d'ensemble qui s'en dégage est qu'un professionnel expérimenté est toujours en mesure de présenter les choses pour obtenir une protection, ce qui est loin d'être satisfaisant. Une clarification de la position de l'OEB est donc nécessaire. Elle permettrait aux innovateurs de mieux évaluer la possibilité de protection et d'écarter les dépôts voués au rejet, contribuant ainsi du point de vue de l'OEB à la maîtrise du volume de dépôts et au renforcement de sa crédibilité. Elle réduirait aussi les risques de décisions divergentes des juridictions nationales.

Le système des brevets dans l'économie de la connaissance

Le système économique se caractérise de façon croissante comme une économie de la connaissance. Dans ce système, le brevet joue un rôle majeur et est devenu depuis quelques années un enjeu politique. La diffusion de l'information brevets par internet a sensiblement élargi le public intéressé aux brevets et, au-delà de l'information technique, accru la connaissance du public pour le système des brevets. Tous ces facteurs concourent pour placer le système des brevets, naguère un domaine pour spécialistes, en pleine lumière, et le confronter à des regards sans indulgence. Cela crée pour l'OEB une exigence plus aiguë dans l'accomplissement de sa mission au service de l'intérêt général et dans sa communication publique.

De par sa situation d'autorité centrale en Europe en matière de délivrance des brevets, au sein d'un système où les institutions judiciaires restent fragmentées et souvent divisées, l'OEB est l'acteur majeur du système et exerce une influence éminente. Ceci lui crée une responsabilité toute particulière.

³ Cf. „ Uncertain times “ de Fabian Edlund et Urban Lindt, paru dans Patent World # 155, septembre 2003 pp. 26-30.

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

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

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<p style="text-align: center;">epi-Delegierte epi Delegates Délégués de l'epi</p>		
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