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Editorial

E. Vinazzer · J. Gowshall · T. Schuffenecker

With the publication of a draft Community Patent Regulation (finally) seeming a reality and with the co-pending intergovernmental conference, first called last year, one of the major focuses of the intellectual property community in Europe is, at present, European-wide litigation. The intergovernmental conference has set up a working party on litigation looking at the provision of a potential central European court to deal with litigation matters in Europe. The aim of the working party is to produce a European Patent Litigation Protocol (EPLP) available for all EPC contracting states. Because this protocol is intended for use with European Patents, it is acknowledged that it should have basis in the EPC and it is likely that any protocol produced will have an impact on the proposed revision of the EPC later this year.

Many of the details have yet, apparently, to be decided, not least whether any such court would be a court of first instance or a court of Appeal. There is, however, a strong feeling that a central European litigation court, in some form, will be introduced in the relatively near future. This will, of course, have a potentially profound impact on our profession.

Several factors would appear to be likely to have an effect on such an impact. The first is, of course, the location of such a central court and its potential effect on the demographics of the profession, in geographical terms. The second would be the nature of the system that would be used. At present, the contracting states of the EPC have very different national legal systems in terms of the individuals involved in handling the litigation

as well as the legal framework within which such litigation is conducted. The basis for the central European system may well have an effect on the national attorneys best equipped to deal with it, at least in its initial stages.

The third factor for consideration is the language or languages that are chosen for use in that court. There is, of course, a wide range of possibilities, from a single designated official language, through the three official languages currently used in the European Patent Office, to a choice of language according to the nationality of the participants.

Finally, and possibly most importantly, there is the issue of right of audience before such a court. This is, of course, an area in which *epi* is particularly interested. Whilst a right of audience for European Patent attorneys is, without question, theoretically a good idea, in practical terms, the requirements for such a right will have to be seriously considered. It is not unlikely that additional qualifications will have to be obtained for a European patent attorney to have the relevant right of audience. These would have to be pitched so that those with the drive and self belief to wish to represent clients in court are not deterred by the extent of training required to obtain such a qualification whilst, at the same time, ensuring that the qualified individuals are fit to represent their clients competently.

In any event, the future of European litigation looks likely to change and we can look forward to, in the words of the Chinese saying, 'interesting times'.

Bericht über die 48. Ratssitzung, Luxemburg 8.-9. Mai 2000

Die 48. Ratssitzung fand in Luxemburg statt, wo gerade der 50. Jahrestag der Erklärung von Robert Schuman zum Zusammenschluss Europas gefeiert wurde. Der Präsident eröffnete die Sitzung und begrüßte Frau Selda Erkul-Arkan als erste Beobachterin aus der Türkei. Gleichzeitig gratulierte er ihr zur bestandenen europäischen Eignungsprüfung. Der Präsident wies auf die Bedeutung der politischen Integration im Patentbereich hin, insbesondere im Hinblick auf das europäische Patentsystem und die Rolle des *epi*. Nach der Wahl der Stimmzähler und der Annahme der Tagungsordnung wurden die Protokolle der 47. Ratssitzung in Berlin vom 11./12. Oktober 2000 angenommen.

Der Präsident dankte dem Vorstand und verschiedenen Ausschüssen für die ihm gewährte starke Unterstützung, die insbesondere bei den gravierenden Entwicklungen im Patentbereich besonders nützlich und hilfreich war. Er wies auf die Notwendigkeit hin, dass das *epi* effektiver, professioneller und insbesondere auch weniger bürokratisch arbeiten müsse. Nach diesen einleitenden Worten gab er seinen Rechenschaftsbericht, der in gekürzter Form in diesem Heft der *epi*-Informationen veröffentlicht ist.

Im Bericht des Generalsekretärs wurde u. a. mitgeteilt, dass seit dem 01.01.2000 Herr Haberl als neues ständiges Mitglied das *epi*-Sekretariat verstärkt hat. In der Arbeit sollen mehr und mehr E-Mails auch bezüglich der einzelnen Mitglieder eingesetzt werden¹.

Anschließend wurde der Bericht des Schatzmeisters angenommen, in dem auf die Kontrolle der Ausgaben und die finanziell gute Situation des *epi* hingewiesen wurde. Der Überschuss 1999 beruhte einerseits auf einem höheren Einkommen und andererseits auf niedrigeren Ausgaben. Der vorgelegte überarbeitete Haushaltsplan 2000 wurde beschlossen.

Der Präsident kam auf die Angelegenheit hinsichtlich der Standesregeln in Zusammenhang mit der Entscheidung der Kommission und die dagegen beim Europäischen Gerichtshof eingelegte Beschwerde zu sprechen, wobei er die bisherige Entwicklung zusammenfasste und die derzeitige Situation erläuterte. Der Vorstand hatte feststellen müssen, dass durch die zeitlich bis zum 23. April 2000 begrenzte Freistellung die Artikel 2b, Absatz 1 und 3 als auch Artikel 5c zumindestens bis zur Entscheidung in der Beschwerde nicht mehr in Kraft seien. Die Diskussion brachte das große Interesse der Ratsmitglieder an diesem Thema zum Ausdruck, wobei die Wichtigkeit, eine starke Berufsorganisation zu haben, die auf die europäischen Verantwortlichen zur Entwicklung einer eindeutigen Position im Hinblick auf die technisch ausgebildeten europäischen Patentvertreter hinwirken sollte, betont wurde, wobei auch ein

Hinweis auf die Möglichkeiten des Subsidiaritätsprinzips gemäß dem Maastrichter Vertrag erging.

Der Präsident widmete sich der Artikel 133 und 134 EPÜ im Hinblick auf Änderungsvorschläge. Die Revisionskonferenz zum EPÜ wird vom 20. bis 29. November 2000 in München stattfinden. Ein vom Präsident des EPA herausgegebenes Papier mit vorgeschlagenen Änderungen enthält auch eine stärkere Verankerung des *epi* in Artikel 134 EPÜ. Ein neuer Artikel 134a soll sich speziell mit dem *epi* befassen. Es besteht auch ein Vorschlag, in den neuen Artikel 134a eine Bestimmung über das „Anwalts-Klienten-Privileg“ aufzunehmen.

Am Nachmittag wurde die Sitzung durch einen Beitrag von Frau Heusken als Vertreterin des von der Europäischen Kommission 1998 geschaffenen „Helpdesks“ für gewerbliche Schutzrechte unterbrochen. Dieses „Helpdesk“ sieht sich weder als Ersatz für Dienste der Patentämter noch der Patent- und Rechtsanwälte, sondern will Hilfestellung in vielen verschiedenen Bereichen der gewerblichen Schutzrechte leisten (<http://www.cordis.lu/ipr-helpdesk>). Im Internet des „Helpdesks“ ist auch eine Anweisung zur Nutzung von esp@cenet enthalten. Anschließend wurde die Sitzung mit dem Bericht des EASY-Ausschusses fortgesetzt, indem auch die letzten Entwicklungen des EPA's in Richtung der Vermeidung von Papier in den Verfahren vor dem Amt berichtet wurde (epoline). Jedes Mitglied erhält eine Informationsdiskette über epoline, die diesen *epi*-Informationen beigefügt ist.

Einen erheblichen Zeitraum nahm die Erläuterung und Diskussion eines zusätzlichen Berichts des Ausschusses für Europäische Patentpraxis ein, in dem vorgeschlagene Änderungen des EPÜ aufgeführt und diskutiert wurden. Unter den diskutierten Fragen waren u. a. die letzten Entwicklungen bezüglich des BEST-Programms des EPA's, die Änderung von Artikel 112 EPÜ, die den Parteien das Recht geben, Beschwerde bei der Großen Beschwerdekammer einzulegen, die Patentierungsvoraussetzungen (das EPA schlägt vor, den Ausschluss von Computerprogrammen zu streichen, da die bisherige Bestimmung Probleme hinsichtlich des TRIPS-Abkommens mit sich bringt), die Schonfrist, die Frage eines zentralen Beschränkungsverfahrens, das dem Patentinhaber erlaubt, sein Patent einzuschränken, mögliche Änderungen zum Auslegungsprotokoll mit dem Ziel einen Hinweis auf das kontroverse Konzept der Äquivalenz einzufügen, Fristen und eventuelle zusätzliche Gründe, auf die ein Einspruch gestützt werden könnte. Der zusätzliche Bericht des Ausschusses für Europäische Patentpraxis über die Revision des EPÜ ist in voller Länge in dieser Ausgabe der *epi* Information veröffentlicht.

Bezüglich einer zu schaffenden sachverständigen Organisation (common entity) zur Beantwortung von Fragen zur Rechtsgültigkeit von europäischen Patenten wurde einvernehmlich festgestellt, dass eine derartige

¹ Bitte geben Sie, sofern dies noch nicht geschehen ist, Ihre E-Mail-Adresse im Sekretariat bekannt.

Organisation nicht in das Europäische Patentamt einbezogen werden sollte.

Nach dem Bericht des Disziplinarausschusses und des Geschäftsordnungsausschusses wurde angeregt, die Größe der einzelnen Ausschüsse im Voraus vor den Wahlen zum neuen Rat festzulegen. Der Geschäftsordnungsausschuss wurde gebeten, einen entsprechenden Vorschlag auszuarbeiten. Der Bericht des Geschäftsordnungsausschusses ist in diesem Heft veröffentlicht.

Der Ausschuss für die berufliche Qualifikation wies darauf hin, dass mehr Tutoren benötigt werden, insbesondere in Dänemark, Finnland, Frankreich und Schweden. Der Ausschussvorsitzende erwähnte, dass bei der letztjährigen Prüfung die Zeit für die Bearbeitung von Papier C verlängert wurde. Um einem Kandidaten die Möglichkeit zu geben, zu einem früheren Zeitpunkt festzustellen, ob er den Anforderungen des Berufsstandes genüge, wurde eine Diskussion darüber geführt, ob nicht die Papiere A und B bereits nach zweijähriger Ausbildungszeit abgelegt werden können. Der Ausschuss wird über diese kontroverse Frage weiter diskutieren und gegebenenfalls dem Rat einen Vorschlag unterbreiten.

Die Sitzung wurde dann auf den nächsten Tag vertagt, da die Ratsmitglieder mit ihrer Begleitung der Einladung zu einem Abendessen folgten, das der luxemburgische Minister für Wirtschaft dem *epi* gab.

Am nächsten Tag wurde der Bericht des Ausschusses für berufliche Qualifikation abgeschlossen. Es wurde mitgeteilt, dass ein Fragebogen über die beruflichen Ausbildungs- und Weiterbildungsmöglichkeiten an alle Berufsorganisationen in den Mitgliedsländern gesandt wurde, wobei bereits aus 12 Ländern Antworten eingegangen sind.

Im Bericht der Schriftleitung wurde auf die letzten Entwicklungen der „*epi web site*“ hingewiesen, die – im Hinblick auf ihre Besuche – ein Erfolg zu sein scheint. Mit der neuesten Entwicklung des so genannten „Extranet“ wird es jedem *epi*-Mitglied möglich sein, Nachrichten jedem anderen *epi*-Mitglied zuzusenden. In diesem Zusammenhang wies der Präsident darauf hin, wie wichtig es für alle *epi*-Mitglieder wird, regelmäßig die „*epi web site*“ zu besuchen.

Es folgte der reguläre Bericht des Ausschusses für Patentpraxis, in dem auch mitgeteilt wurde, dass zwei Positionspapiere für die Arbeitsgruppe der französischen Regierungskonferenz zu den Themen Kostenreduzierung und Streitregelung erarbeitet wurden.

Nach den Berichten des Harmonisierungsausschusses und des Finanzausschusses berichtete der Vorsitzende des Biotechnologieausschusses, dass der Ausschuss die Einführung der Biotechnologierichtlinie sowie die weite Aufmerksamkeit in der Öffentlichkeit erregende Frage der Patentierung des menschlichen Genoms diskutiert habe.

Schließlich wurden die neuesten Entwicklungen der von der Regierungskonferenz eingesetzten Arbeitsgruppen zur Kostenreduzierung und zur Streitregelung vortragen. In diesen Arbeitsgruppen sind UNICE, *epi*, das EPA und die EU-Kommission Beobachter.

Nach der Festlegung der Termine und Orte der nächsten Ratssitzungen erklärte der Präsident die Sitzung für geschlossen und dankte allen Teilnehmern für ihre konstruktive Arbeit und besonders dem Luxemburger Organisationskomitee für die hervorragende Vorbereitung dieser Ratssitzung.

Entwurf der Ratsbeschlüsse, 48. Ratssitzung in Luxemburg 8.-9. Mai 2000

1. Der Haushalt 1999 wurde gebilligt und dem Schatzmeister wurde Entlastung erteilt.
2. Der Rat billigte den überarbeiteten Haushalt 2000.
3. Der Rat beschloss Meinungsvoten zu einzelnen Fragen hinsichtlich einer Stellungnahme zur Revision des EPÜ durchzuführen sowie die Vorbereitung eines Positionspapiers seitens des EPPC.
4. Herr J.L. ARNAUT wurde als Nachfolger des verstorbenen Mr. ARANTES E OLIVEIRA zum SACEPO Mitglied für Portugal gewählt.
5. Herr E. FRIMAN, Ratsmitglied der finnischen „Andersweitig Tätigen“ wurde als Nachfolger von Herrn SALOMÄKI, der zu den „Freiberuflern“ gewechselt hat, zum Vorstandsmitglied gewählt.

Report of the 48th Council Meeting, Luxembourg 8-9 May 2000

The 48th Council Meeting was held in Luxembourg where the city was celebrating the 50th anniversary of the declaration of Robert Schuman, towards the European construction. The President formally opened proceedings at 9.30 a.m., on Monday 8th May, 2000. He particularly welcomed the first observer from Turkey, Ms Selda Erkul-Arkan, and congratulated her for having passed the European Examination. The President took the opportunity to stress the importance of political integration in the patent field, including the European patent system and the *epi*. Following the appointment of the scrutineers and the adoption of the agenda, the Minutes of the 47th Council meeting in Berlin on 11th and 12th October, 2000 were approved.

The President thanked the Board and the different committees for their strong support, which was particularly appreciated and useful in a time of substantial developments in the patent field. He stressed the need for *epi* to be more effective, to enhance professionalism and to reduce bureaucracy. He then presented his substantial report which is published in a shortened version elsewhere in this issue of *epi* information.

The report of the Secretary General then followed. In January, Mr. Haberl joined the Secretariat as a new member of Staff and the Secretary General particularly stressed the development of e-mail for general use between the *epi* members¹.

The Treasurer's report was then approved. It stressed the control of the expenses and the financially sound situation of the *epi*. A surplus was generated in 1999 from both a higher level of income and a lower level of expenditure. A draft budget for 2000 was presented and approved.

The President then addressed the question of the Code of Conduct and the EEC letter/appeal. He summarized the numerous developments of what appears now to be a substantial affair. These have resulted, from a decision of the Board, in the deletion of Art. 2b), paragraphs 1 and 3 as well as Art. 5c) of the Code of Conduct, before the final decision of the Appeal. As always, the question of the Code of Conduct resulted in great interest among the council members. There was stress on the importance of having a strong profession, and suggestion that the *epi* urge the European authorities to develop a clear position with respect to the technically trained profession. The possibility of calling the subsidiarity principle of Maastricht Treaty was mentioned.

The President then addressed the question of Article 133-134 EPC in view of the proposed revision of the EPC. The Revision Conference will be held in Munich on 20-29

November 2000. A paper was provided by the President of the EPO for general information. The proposed amendments also include a stronger anchoring of the *epi* within Article 134 EPC. A new Article 134(a) would contain the provision pertaining specifically to the *epi*. There was a suggestion of insertion, within that new Article 134 (a), of a confidentiality/privilege provision.

In the afternoon, the meeting was addressed by a Ms Heusken, who is in charge of the Intellectual Property Rights Helpdesk, launched by the European Commission in 1998. Although this site does not claim to replace the services of Patent Offices and patent agents and lawyers, it provides assistance on many different areas of Intellectual Property. (<http://www.cordis.lu/ipr-helpdesk>). The site particularly contains a tutorial for `esp@cenet`. That presentation was then followed by the report of the EASY Committee, who focused on the last developments (*epoline*) of the EPO, moving towards the abolishing of papers in proceedings. An information diskette on *epoline* is attached to this issue of *epi* information.

Substantial time was then devoted to the supplemental report of the European Patent Practice Committee (EPPC). The proposed revision of the EPC took a substantial part of the discussion of the afternoon. Among the questions discussed were the latest developments regarding the BEST project of the EPO, the amendment of Article 112 EPC, giving a party the right to file an appeal before the Enlarged Board of Appeal, the patentability principles (the EPO suggests removing the exception to „computer programs“, which could raise problems in view of the TRIPS agreement), a grace period, the question of central limitation allowing a patentee to limit the coverage of his patent, possible amendment of the Protocol on Interpretation for the purpose of introducing a reference to the controversial concept of „equivalence“, the question of deadlines and grounds of opposition. The supplemental report of the EPPC on the EPC revision is published in the full version elsewhere in this issue of *epi* Information.

Regarding the question of a possible „common entity“ for answering the question of validity of the European patent, it is interesting to note a unanimous vote of the Council against any form of involvement of the EPO in such a „common entity“.

Then the Disciplinary Committee presented their report followed by the report of the By-laws committee, published in this issue. Regarding the size of the Committees, it was recommended that the latter be fixed in advance, well before the actual votes of the newly elected Council. This question was transferred to the By-laws Committee for a recommendation.

In presenting their report, the PQC Committee stressed the need for more tutors, particularly for Den-

¹ Please send your e-mail address to the Secretariat if you have not done so already.

mark, Finland, France and Sweden. The President explained that, last year, the time for Paper C had been prolonged. A discussion arose regarding the opportunity for a student to have an early feedback on his chance of success, by lowering to two years the experience required for sitting papers A and B. The PQC Committee will discuss this question further.

The President then closed the meeting for the day.

The next morning, the PQC completed their report by addressing the question of continued professional education. A questionnaire has been prepared by the PQC and 12 countries have already answered.

The Editorial report particularly addresses the latest developments in the *epi* web site, which appears to be a wide success in view of the connections requested. With the recent development of a so-called Extranet, each *epi* member will be able to post messages to any other *epi* members by means of that tool. The President took that opportunity to stress the importance for all *epi* members to regularly consult the *epi* web site.

The (normal) report of the EPPC committee was then discussed. The EPPC had prepared two position papers

for the Working Parties of the French Intergovernmental Conference.

The reports of the Harmonization Committee, the Finances Committee and the Biotechnology Committee then followed. The chairman of the biotechnology Committee particularly discussed the implementation of the Biotech-directive, and the wide emotions which surround the question of the patenting of the human genome.

The Council then addressed the last developments regarding the Working Parties on cost reduction and the protocol of the settlement of litigation concerning European patents. It should be noted that UNICE, the EPO, the *epi* and the European Commission are participating to those meetings as observers.

After the discussions, and the timetable for the next council meetings, the President declared the Meeting closed and thanked all for their attendance and contribution, as well as the organizers for the excellent organisation of the Council Meeting in Luxembourg.

Draft List of Decisions, 48th Council Meeting in Luxembourg 8-9 May 2000

1. The 1999 accounts were approved and the Treasurer was discharged from liability.
2. Council approved the revised Budget 2000.
3. Council decided that some questions relating to the revision of the EPC should be put to vote for opinion and that a position paper should be prepared accordingly by the EPPC.
4. Mr. J.L. ARNAUT was elected SACEPO Member for Portugal to replace Mr. J. ARANTES E OLIVEIRA who passed away.
5. Mr. E. FRIMAN, Council Member for the Finnish constituency „other capacity“, was elected Board Member in replacement of Mr. SALOMÄKI who changed to private practice.

Compte rendu de la 48ème session du Conseil, Luxembourg 8-9 mai 2000

La 48ème session du Conseil de l'*epi* s'est tenue à Luxembourg lors de la célébration du 50ème anniversaire de la déclaration Robert SCHUMAN, en faveur d'une intégration européenne. La session est ouverte le lundi 8 mai 2000 à 9.30 heures par le Président, Walter Holzer, qui souligne la participation du premier observateur turc, Mme Selda Erkul-Arkan. Il la félicite pour sa réussite à l'examen européen de qualification. Le président souligne à cette occasion l'intégration politique dans le domaine des brevets, et le rôle de l'*epi* à cet

égard. L'adoption du compte rendu de la 47ème session du Conseil à Berlin les 11 et 12 octobre 1999, est suivie de la nomination des scrutateurs et de l'adoption de l'agenda.

Le Président remercie le Bureau et les différentes Commissions pour leur soutien actif, particulièrement apprécié en cette période de grand changement dans le domaine des brevets. Il souligne l'importance pour l'*epi* de montrer davantage d'efficacité et de professionnalisme, et de savoir réduire au besoin la dose de bureau-

cratie. Il présente ensuite son rapport dont un compte rendu abrégé est publié dans cette édition d'epi information.

Celui-ci est suivi par le rapport du Secrétaire Général. Le Secrétariat compte un nouveau membre, M. Haberl, et le rapport souligne l'importance prise par le courrier électronique qui tend à se généraliser au sein de l'epi¹.

Le Trésorier présente ensuite son rapport. Il souligne la bonne gestion et le suivi des dépenses ainsi qu'une solide situation financière. Un accroissement dans les recettes et une réduction des dépenses a permis de dégager un surplus en 1999.

Le Président évoque ensuite la question du Code de conduite et le recours devant les autorités européennes. Il rappelle les divers épisodes de cette affaire, laquelle a abouti récemment à la décision de retrait des articles 2b) §1 et 3 ainsi que 5c) du Code de conduite, dans l'attente de la décision finale prise par la Cour. Comme toujours, cette question suscite un grand intérêt au sein du Conseil et, parmi les débats, on souligne l'importance de développer une profession forte, et le besoin d'œuvrer pour que les autorités européennes adoptent une politique claire en ce qui concerne la profession de mandataire agréé. On fait également valoir les dispositions en matière de subsidiarité du Traité de Maastricht.

Le Président aborde ensuite la question des articles 133-134 CBE dans la perspective de la révision de la Convention sur le brevet européen. La Conférence de Révision est fixée du 20 au 29 Novembre 2000 à Munich et un document a été préparé à cet effet par le Président de l'OEB, lequel montre le souci de procéder à un ancrage plus important de l'epi dans la disposition de l'article 134 CBE. Un nouvel article 134 (a) contiendrait une disposition visant spécifiquement l'epi, disposition qui, suivant une suggestion exprimée, pourrait fort opportunément contenir une référence expresse à un principe de confidentialité et de privilège.

Dans l'après-midi, Mme Heusken présente l'„Intellectual Property Helpdesk“ qui a été mis en place par la Commission Européenne en 1998. Bien que ce site ne vise pas à se substituer ni aux Offices de brevets, ni aux agents de brevets, ni aux juristes spécialisés, il fournit une assistance pour toutes les questions du droit de la propriété intellectuelle (<http://www.cordis.lu/jpr-helpdesk>). Le site comporte un tutoriel pour esp@acenet. La Commission EASY présente ensuite son rapport, avec les développements les plus récents de l'OEB dans le cadre du projet epoline, en vue d'une suppression totale et définitive du papier dans la procédure. A titre d'information, une disquette est jointe à la présente édition d'epi information.

Une grande partie de l'après-midi est ensuite consacrée au rapport spécial de la Commission „Pratique du brevet européen“ (EPPC) portant sur le projet de révision de la CBE. Les questions d'intérêt concernent le projet BEST, la modification à l'article 112 de la CBE en vue de la saisine par une partie de la Grande Chambre de Recours,

les conditions de brevetabilité dans le domaine des inventions de programmation (et notamment la compatibilité des accords du GATT avec la doctrine de l'OEB qui s'en tient à une simple suppression de l'exception des programmes d'ordinateurs). Les questions portent également sur la période dite de grâce, la question de la „limitation centrale“ d'un brevet par le breveté, et des amendements potentiels du Protocole sur l'interprétation de l'article 69 CBE en vue d'une éventuelle référence à une notion d'„équivalence“, la question des délais et des motifs d'opposition. Le rapport additionnel de l'EPPC sur la révision de la CBE est publié dans son intégralité dans ce numéro de epi Information.

En ce qui concerne la question d'une „entité commune“ chargée d'examiner la question de la validité du brevet européen, il est intéressant de noter que, à l'unanimité, le Conseil se prononce contre toute forme d'implication de l'OEB dans une telle „entité commune“.

Le rapport de la Commission de Discipline est présenté ainsi que celui de la Commission du Règlement Intérieur publié dans ce numéro. En ce qui concerne la question de l'effectif des commissions, un membre du Conseil recommande que celui-ci soit fixé bien avant la session du Conseil nouvellement élu. Cette question est transmise à la Commission du Règlement intérieur pour un examen plus attentif et une recommandation.

Dans son rapport, la Commission de qualification professionnelle (PQC) souligne le besoin d'un nombre supplémentaire de tuteurs, particulièrement pour le Danemark, la Finlande, la France et la Suède. La durée de l'épreuve C a été prolongée l'année dernière et une discussion se développe concernant l'opportunité de réduire la période de pratique requise pour les épreuves A et B. Cette question fera l'objet d'un examen spécifique par le PQC.

Le Président ferme ensuite la session du jour.

Le lendemain, le PQC aborde la question de la formation professionnelle continue. Un questionnaire a été préparé à cette fin et des informations provenant de douze pays ont déjà pu être collectées.

Le rapport du Comité de Rédaction porte sur les derniers développements en ce qui concerne le site de l'Institut, qui suscite un vif intérêt comme le montre le nombre de connections par mois. Les activités les plus récentes portent sur le développement d'un „Extranet“ qui permettra à chaque membre de l'epi de communiquer avec les autres membres. Le Président de l'epi souligne à cette occasion l'importance pour chaque membre de se connecter régulièrement au site de l'Institut.

Le rapport plus habituel de la Commission EPPC s'ensuit. Deux documents ont été élaborés dans le cadre de la Conférence intergouvernementale française.

Les rapports de la Commission d'Harmonisation, de la Commission des Finances, et de la Commission de Biotechnologie se succèdent. S'agissant de cette dernière, son Président évoque les derniers développements relatifs à l'implémentation de la Directive pour la protection des inventions biotechnologiques ainsi que le

1 Veuillez communiquer votre adresse électronique au Secrétariat si celle-ci n'a pas encore été transmise.

profond émoi que suscite inévitablement la question de la brevetabilité du génome humain.

Le Conseil examine ensuite les travaux des groupes de travail sur la réduction des coûts et le Protocole sur les litiges en matière de brevets européens. L'UNICE, l'OEB, l'*epi* et la Commission Européenne compte parmi les observateurs de ces travaux.

Après les débats et la communication du calendrier des prochaines sessions du Conseil, le Président déclare la séance close et remercie tous les membres pour leur participation, ainsi que les organisateurs locaux pour l'excellente organisation de la réunion du Conseil à Luxembourg.

Projet de liste des Décisions, 48ème réunion du Conseil à Luxembourg 8-9 mai 2000

1. Les comptes pour l'exercice 1999 sont approuvés et quitus est donné au Trésorier.
2. Le Council approuve le budget révisé pour l'année 2000.
3. Le Conseil décide que certaines questions relatives à la révision de la Convention sur le brevet européen soient mises au vote pour opinion et que l'EPPC prépare une prise de position de l'*epi* dans ce sens.
4. M. J.L. ARNAUT est élu membre du SACEPO pour le Portugal pour remplacer M. J. ARANTES E OLIVEIRA qui est décédé.
5. M. E. FRIMAN, membre du Conseil pour la circonscription finlandaise „Autre titre“ est élu membre du Bureau en remplacement de M. SALOMÄKI qui a changé de collègue.

President's Report to Council (Summary)

W. Holzer (AT)

The President presented a report on a number of activities since the previous Council Meeting in Berlin. He stated in particular that his report would not have been possible without the numerous contributions from Board and Committee members as well as the work of the Secretariat for which he thanked everyone.

He pointed out some general matters concerning the *epi* during the past period: the consolidation of the Secretariat at the new premises, the submission of position papers to and exchange of views with the European Commission and the establishing of contacts with the expected new member countries.

He then referred to his attendance with Vice Presidents Macchetta and Le Vaguerèse as observers in the Administrative Council meetings and in the Working Parties on Costs and on Litigation in the framework of the Intergovernmental Conference, for which the *epi* also contributed position papers.

The attendance at a welcoming reception given by the *epi* for the President of the EPO, Mr. Kober and his directorate in the new Secretariat, at the introduction of the new President of the German Patent Office Mr. Landfermann and at the Parliamentary Evening of the „Bundesverband der Deutschen Patentanwälte“ in

Berlin were also reported. He had the pleasure of opening the *epi* Artists Exhibition at the EPO together with Mr. Schatz, acting Vice President as well as hosting an invitation for one of the Examination Committees.

He had also attended the Executive Committee Meeting of AIPPI and the 2nd CNIPA Forum which both took place in Italy as well as the PATINNOVA conference in Greece where he spoke on „Litigation Insurance“ and participated in a round table conference. „Litigation Insurance“ was also addressed at a Hearing organised by the European Commission in Brussels where he spoke again on this topic. He also participated in a seminar for members of the liberal profession organised by the TAIEX office of the European Commission's DG for the Enlargement of the European Union. The *epi* in the meantime has established its own contacts with the patent attorneys profession in the expected new member states. An observer from Turkey was invited to the Council Meeting in Luxembourg. Finally, he attended a working conference with the presidents of the three biggest national associations. Other meetings attended were those with the Appeal Boards together with EPPC members, and with a working party on *epoline* together with members of the EASY Committee.

epi Balance Statement on 31st December 1999

		Assets			previous year (thousand)
		DM	DM	DM	DM
A.	Fixed assets				
	I. Tangible assets		1,—		—
	Office machines and equipment				
	II. Financial assets		<u>1.847.500,—</u>	1.847.501,—	1.921
	Securities portfolio				
B.	Receivables				
	I. Membership subscription and others				
	1. Membership subscriptions	43.568,64			44
	2. Others	<u>114.935,63</u>	158.504,27		32
	II. Bank & Cash (incl. money deposits)		<u>1.041.798,09</u>	1.200.302,36	860
				<u>3.047.803,36</u>	<u>2.857</u>
		Liabilities			previous year (thousand)
		DM	DM	DM	DM
A.	Net assets				
	as of 01.01.1999			2.584.082,90	2.324
	results for the year			<u>89.672,34</u>	<u>260</u>
	as of 31.12.1999			2.673.755,24	2.584
B.	Debts				
	I. Provisions		54.900,—		43
	II. Liabilities				
	1. Banks				34
	2. Deliveries and services	87.813,34			13
	3. Others	<u>231.334,78</u>	<u>319.148,12</u>	<u>374.048,12</u>	<u>183</u>
				<u>3.047.803,36</u>	<u>2.857</u>

Expenses and Income for the period from 1 January to 31 December 1999

epi Expenses and Income 1999						
	Budget 1998	Actual 1998	Budget 1999	Actual 1999	Shortfall in receipts Surplus of expenditure 1999	Surplus of receipts Shortfall in expenditure 1999
	TDM	DM	DM			
I. Receipts/Income						
1. from Members						
a. Subscriptions (1998 incl. abandonment)	1.710.000, –	1.691.090,50	1.710.000, –	1.774.181,16	–, –	64.181,16
b. Abandonment of unpaid subscriptions	–, –	–, –	./ 43.602, –	./ 33.989,50	–, –	9.612,50
2. Interests	110.000, –	90.288,52	110.000, –	107.043,56	2.956,44	–, –
3. Others	43.000, –	90.791,94	41.000, –	83.497,84	–, –	42.497,84
	<u>1.863.000, –</u>	<u>1.872.170,96</u>	<u>1.817.398, –</u>	<u>1.930.733,06</u>	<u>2.956,44</u>	<u>116.291,50</u>
II. Expenses						
1. Meetings						
Council	374.400, –	330.969,30	330.000, –	380.494,56	50.494,56	–, –
Board	62.400, –	64.973,56	70.000, –	63.438,12	–, –	6.561,88
Committees	270.400, –	228.164,39	270.400, –	203.574,25	–, –	66.852,75
Delegates & Others	158.000, –	121.514,97	158.000, –	123.792,54	–, –	34.207,46
2. Others						
epi Information	100.000, –	84.874,15	100.000, –	98.048,41	–, –	1.951,59
By-Laws & non-foreseeable	15.000, –	5.495, –	9.000, –	–, –	–, –	9.000, –
ECC-Letter	100.000, –	14.780,76	60.000, –	54.206,28	–, –	5.793,72
Promotional activities (incl. epi-Brochure)	85.000, –	61.068,97	50.000, –	43.221,80	–, –	6.778,20
3. President (+ Vice President)	25.000, –	31.811,28	25.000, –	34.459,51	9.459,51	–, –
4. Treasurer and Treasury						
Treasurer and Deputy	10.000, –	6.424, –	13.000, –	11.489, –	–, –	1.511, –
Bookkeeping	1.500, –	630, –	1.500, –	2.150, –	650, –	–, –
Audit	25.000, –	19.015,40	25.000, –	20.049,08	–, –	4.950,92
Bank charges	25.000, –	18.104,12	22.000, –	16.152, –	–, –	5.848, –
5. Secretariat						
Expenditure on personnel	440.000, –	391.208,89	440.000, –	415.352,89	–, –	24.647,11
Expenditure on materials						
Rent	100.000, –	88.128, –	100.000, –	128.210,60	–, –	3.789,40
Moving expenses	–, –	–, –	227.000, –	103.449,12	–, –	123.550,88
Phone, Fax, e-mail	20.000, –	20.143,17	12.000, –	12.375,30	375,30	–, –
Postage	55.000, –	51.017,83	55.000, –	50.336,01	–, –	4.663,99
Copy, print	30.000, –	31.334,21	30.000, –	25.625,07	–, –	4.374,93
Office supplies	16.000, –	12.206,62	9.000, –	15.618,53	6.618,53	–, –
Maintenance/Repair	3.000, –	5.111,25	10.000, –	14.775, –	4.775, –	–, –
Insurances	1.500, –	666,40	1.500, –	557,90	–, –	942,10
Secretary General and Deputy	5.000, –	1.072,50	5.000, –	1.165,49	–, –	3.834,51
Travel personnel	7.000, –	1.857,47	7.000, –	544,91	–, –	6.455,09
Acquisitions						
Office machines incl. Soft-/Hardware	15.000, –	9.797,68	20.000, –	13.515,83	–, –	6.484,17
Office equipment	3.000, –	–, –	3.000, –	–, –	–, –	3.000, –
Training	5.000, –	500, –	3.000, –	383,96	–, –	2.616,04
Representation	1.000, –	325,48	3.000, –	1.544,06	–, –	1.455,94
6. Extraordinary expenses	–, –	11.250, –	–, –	6.557,50	6.557,50	–, –
	<u>1.953.200, –</u>	<u>1.612.445,40</u>	<u>2.091.400, –</u>	<u>1.841.060,72</u>	<u>78.930,40</u>	<u>329.269,68</u>
III. Surplus of receipts/ expenses	<u>./ 90.200, –</u>	<u>259.725,56</u>	<u>./ 274.002, –</u>	<u>89.672,34</u>	<u>Surplus:</u>	<u>363.674,34</u>

Bericht des Geschäftsordnungsausschusses

C.E. Eder (CH)

Der Rat hat in seiner Sitzung vom 11./12. Oktober 1999 in Berlin den Geschäftsordnungsausschuss beauftragt, einige Bestimmungen, die die Ausschüsse des Instituts betreffen, zu überprüfen und Empfehlungen abzugeben.

Der Geschäftsordnungsausschuss empfiehlt, Artikel 18.2 der Geschäftsordnung derzeit nicht zu ändern, da er der Meinung ist, dass die jetzt gültigen Vorschriften dem Vorsitzenden eines Ausschusses nicht, und daher ermöglichen, in ausserordentlichen Fällen Gäste einzuladen. Dabei kann es sich um Institutsmitglieder, wie z.B. ausserordentliche Mitglieder des Ausschusses, oder Experten von ausserhalb des Instituts handeln, also beispielsweise um Bedienstete des EPA, der WIPO oder

eines nationalen Patentamtes. Der Vorsitzende hat jeweils zu entscheiden, ob der Teilnehmende berechtigt ist, Kostenerstattung in Anspruch zu nehmen.

Der Geschäftsordnungsausschuss empfiehlt ferner, die Auswirkungen des Artikels 18.2 der Geschäftsordnung während der nächsten Jahre zu beobachten, um im Hinblick auf eine etwaige weitere Empfehlung, wie ein Ausschussvorsitzender die Arbeit seines Ausschusses leiten soll, Erfahrungen mit der Handhabung der gegenwärtigen Regelung zu sammeln.

Schliesslich empfiehlt der Geschäftsordnungsausschuss, die vom Rat am 10./11. Mai 1999 in Florenz beschlossene Grösse der Ausschüsse beizubehalten.

Report of the By-laws Committee

In its Council meeting of 11 to 12 October 1999 in Berlin, the Council has invited the By-laws committee to make recommendations regarding committees of the Institute.

The By-laws Committee recommends that no change be made to the Article 18.2 of the presently existing By-laws. Indeed, Article 18.2 of the By-laws does not prohibit and therefore allow Chairmen of Committees to invite guests, be they members of the Institute, for example associate members, or experts chosen from outside the Institute, such as, for instance, officials of the EPO, WIPO or national patent offices. The Commit-

tee Chairmen's invitation may or may not cover the reimbursement of a guest's expenses.

The By-laws Committee also recommends that the working of Article 18.2 should be monitored over the next few years to provide experience of the practicability of the present rule, with a view to a possible further recommendation concerning how chairmen of Committees may govern the working of their committees.

Finally, the By-laws Committee recommends that the respective sizes of the Committees as decided by the Council during the 46th Council meeting held in Florence from 10th and 11th of May 1999, should not be changed.

Compte rendu de la Commission du Règlement intérieur

Lors de sa session des 11 et 12 octobre 1999, le Conseil a invité la Commission du Règlement intérieur à faire des recommandations concernant les commissions de l'Institut.

En l'état actuel, la Commission du règlement intérieur préconise qu'aucune modification ne soit apportée à l'article 18.2 du Règlement intérieur. En effet, l'application de la disposition actuellement en vigueur ne fait pas obstacle à ce qu'un président d'une commission invite, sur une base exceptionnelle, un membre de l'Institut comme par exemple un membre associé de cette commission, ou un expert extérieur à l'Institut, notamment émanant de l'OEB, de l'OMPI ou d'un office national. L'invitation du président de la Commission peut, en tout

état de cause, prévoir ou non le remboursement des frais afférents à cette invitation exceptionnelle.

La Commission du règlement intérieur recommande également que la présente disposition de l'Article 18.2 soit soumise à l'épreuve du temps dans le but de vérifier son adéquation aux besoins de l'Institut. A la lumière de cette expérience, de nouvelles recommandations concernant le fonctionnement des diverses commissions pourront être utilement établies.

Enfin, la Commission du règlement intérieur recommande que l'effectif respectif des différentes commissions reste celui qui a été défini par le Conseil les 10 et 11 mai 1999 lors de sa 46ème session à Florence.

Report of the EPPC meeting of 23rd November, 2000

A. Casalonga (FR)

A. Information

I. Short report from the SACEPO 30th Meeting (17-18 June 1999 in Munich)

The EPO explained a proposal for treatment of „complex applications“ and broad claims.

The search examiner would execute the search taking into account the future examination. Therefore, in fact, this proposal is only workable within the frame of the BEST project.

It was proposed to amend Rule 38 EPC (priority) to take into account the possibility now opened for the EPO to obtain automatically from the Japanese Patent Office on line copies of priority documents.

It was pointed out however that this could create some difficulties in view of the present wording of Article 88 which requires the applicant to file a copy of the previous application. Consequently, Rule 38 should be amended to state that, in the case previously mentioned, the applicant „is deemed to have complied with Article 88“.

The proposal of the EPO to make public the name of a third party requesting a file inspection was unanimously rejected.

The EPO will reconsider the proposal.

II. Short report from the 8th MSBA Meeting (22 November 1999 in Munich)

Main topics discussed were :

- Proof of prior use (standard of proof and gathering of evidence)
- Evidence of disclosure of a software method invention by selling of a device incorporating said method
- Excessive duration of appeal procedure

Another topic discussed was relating to the so-called file wrapper estoppel. The European Patent Office mentioned that some kind of consideration from the file history could be introduced in Article 69 EPC or in the Protocol for interpretation.

New amended rules of the procedure of the Boards of Appeal (RPBA) were presented and discussed.

Amended Article 11(2) RPBA relates to the preparation of oral procedure and introduces a Rule similar as Rule 71a for the Boards of Appeal.

The sending of a communication by the Board of Appeal informing the parties of any point of special significant, is provided but is not mandatory.

A time limit for answering this communication may also be given, but is not compulsory. The amended Article 11(2) provides that any submission filed after that date may be disregarded.

Article 11(4) RPBA – Closure of the debate

According to this amended Article „When a case is ready for decision during oral proceedings, the chairman declares the debate closed. No submissions may be made by the parties after the closure of the debate unless the Board decides to reopen the debate.“

Article 14a (RPBA) – Deadline for dispatch of decision

According to this new Article: „If the Board takes the decision at the conclusion of the oral proceedings or reserves its decision after closure of the debate, it indicates a date by which the written decision is expected to be dispatched.“

It was also proposed that the Board of Appeal would be allowed, not to issue a detailed written reasoning for a decision, if the parties so agree. This would only be possible if :

- the decision refuses a European patent application or revokes a European patent
- if the parties expressly declare their consent.

The members of the *epi* expressed their disagreement with this proposal. It was mentioned that written decisions could be useful, if corresponding patent applications were still pending in other countries. Written decisions can also be interesting for third parties and for development of the jurisprudence.

B. Substantive Matters

I. Question 160 – Intergovernmental Conference on the Reform of the Patent System in Europe

The EPPC discussed the proposals made by the two Working Party preparing the Intergovernmental Conference.

On cost reductions, the EPPC discussed the various proposals, i.e.:

- centralized filing of translations
- optional protocol
- compacted translation
- postponment of the filing date of the translation

A draft position paper was prepared by the EPPC.

II. Question 158 – Harmonization of evidence taking in court actions for European patent infringement

The EPPC discussed this question and considered advisable to prepare a survey of the different possibilities of evidence taking in the various Contracting States.

After this survey has been finished, it is proposed that the EPPC would try to prepare some ideas for action to be taken in view of a possible harmonization.

III. Question 120 – Proposed amendments to the PCT and Rules

The EPPC discussed about the proposal for awarding a date of filing on the basis of a „ticket“ and a „hash“ as opposed to the transmission of a complete text of an application. The proposal is aimed at overcoming the problem of online filing for long transmission times with lengthy specifications.

It was pointed out that it could be difficult for developing countries to establish a date using such a „ticket“ and „hash“ without having an advanced and stable transmission technology.

This position was expressed by a letter sent to WIPO.

IV. Question 144 – Utility Models – EC Directive

EPPC members were requested to submit written comments to the amended proposal on EC Utility Model Directive.

The EPPC intends to prepare a new position paper after its next meeting where all written comments will be studied.

V. Preparing for epoline (PDG Impact Meeting of 30 September-1st October 1999)

According to the information obtained, epoline would begin in the course of year 2000.

No extra fee would be required to use the system. The necessary special hardware equipment would be provided free by the European Patent Office. This would involve a keyboard with a box. It would be possible to have a smart card or a simple signature stored in the machine.

Report of the Finance Committee

B. Feldmann (DE)

1. General

At its last meeting (04/05 April 2000) the Committee elected Dr. J.J.P. Weyland as its Deputy Chairman. Also arising from that meeting, the following items are briefly reported for information.

2. Unidentified subscriptions

The recommendation was made to the Treasurer (who kindly and most helpfully attended the whole of the meeting) that his presentations of accounts to the Council should show the current total of unidentified subscriptions, in other words, the amount of subscription income which, for the time being, has not been possible to attribute to named individuals. By subtraction from figures given for outstanding subscriptions, a better picture is obtainable of how many subscriptions actually remain unpaid in 1999.

3. Budgeting of subscription income

In revising Budget 2000, the Treasurer used for calculating subscription income the number of members on 1 January. The round number at that date is 6,100 so that, when the round number of 5,800 was used for the original Budget 2000 approved at the last Council meet-

ing, the revised budget will show subscription income increased by DEM 90,000 from DEM 1,740,000 to 1,830,000. At this early stage in the year, the uncertainties are greater for estimating the number of subscriptions eventually due; therefore the previous practice of deferring adjustment of this item until Autumn is thought to be preferable.

4. „Delegates & Others“

By way of reminder, Council at its meeting in The Hague (October 1998 Decision 8) gave its approval to the following recommendation for making more orderly the budget structure:

„Starting with the 1999 Budget, as much as is reasonably possible of the expenditure on „Delegates & Others“ should be omitted from item 1.4 by adding instead to other items with which connections exist.“

5. Noted with satisfaction by the Committee has been the transfers to item 2 („President & Vice Presidents“) of their expenses that had previously been entered in item 1.4. Nevertheless, there continues to be in item 1.4 a mixed bag of different missions scattered around Europe. The Treasurer has been urged to proceed further.

Report of the Harmonisation Committee

F. A. Jenny (CH)

On March 30th/31st the Harmonisation Committee met in the *epi* Secretariat in Munich for the preparation of the Diplomatic Conference which will take place from 11th May to 2nd June 2000, and at which the *epi* will have the status of an observer organisation and will be represented by the Secretary and the Chairman of the Committee. All full members and one substitute member were present at that meeting.

The discussions centred mainly on the Basic Proposal for the Patent Law Treaty („PLT“) as adopted by the Standing Committee on the Law of Patents (SCP) at its third meeting in last September [see item A: „Content of the Draft Patent Law Treaty („Basic Proposal“)“ reprinted in *epi* information 4/1999, pages 136/137]. All decisions could be taken by consensus.

The PLT is to be welcomed in principle and it is hoped that it will be possible to still improve some details.

The possibility to file applications in any language and submit translations later within 2 months is of benefit to applicants and third parties, because good translations are in the interests of everybody, but cannot be prepared in great haste. As to the proposal that the filing date should be „no later than“ the date on which all necessary elements were received by the Office, the said words should be introduced into the Treaty, because otherwise some countries could no longer accord the date of posting. Alternatively, the words „or has deemed to have received“ should be added.

epi will not take position concerning the exceptions to mandatory representation. If an address for correspondence is provided for, then the Office *should* send its notifications to this address. Neither will *epi* take position on the question of translations of priority documents.

The provision that a description can – for the purpose of the filing date – be replaced by a mere drawing can remain in the Treaty, as the quality of the description is never checked at this stage and anyway lies entirely in the responsibility of the applicant / patent attorney.

It should be clarified that the provision that a patent cannot be revoked, without the owner being given at least one opportunity to make observations and/or

amendments must apply in each instance. However, it is preferable to have the present (not wholly clear) article, rather than losing the article.

It is very important that a notification be sent by the Office when a time limit was not complied with and there is a possibility of continued processing. It is also very important that the time limit for requesting continued processing starts from that notification and not from the expiration of the time limit not complied with. Moreover it should not be permitted for an Office to exclude time limit extensions or continued processing in *inter partes* proceedings, in proceedings before Boards of Appeal or in accelerated proceedings. Neither should it be possible to exclude e.g. continued processing when an extension of time has already been granted.

Similarly, it should not be possible for a Contracting Party to exclude *restitutio in integrum* in *inter partes* proceedings, for the payment of maintenance fees, for filing a request for search or examination and for filing a translation of a regional patent.

In paragraph (2) of the article on transitional provisions the term „procedure“ should be defined. As long as it is not clear whether the granting procedure is one procedure or is composed of several procedures (e.g. formality examination, search, substantive examination) it is not clear to which applications pending at the entry into force the Treaty has to be applied.

The Harmonisation Committee further decided to prepare a paper on *epi*'s position concerning the Basic Proposal. In view of the fact that the Diplomatic Conference starts already on 11th March, this paper should be sent as soon as possible by the *epi* Board to the Director General of WIPO. In addition, this paper should also be distributed as a Written Statement at the Diplomatic Conference under Rule 46(3) of the (Draft) Rules of Procedure.

At the end of the meeting, the Chairman announced that he will resign as a member of the Harmonisation Committee after the Council meeting of October 2000. The Committee therefore elected Mr. Francis Leyder (BE) as his successor after the said Council meeting.

Report of the Professional Qualifications Committee

T. Onn (SE)

1. Students of the epi

17 students have enrolled during the first three months of 2000, giving a total number of students of 200.

Training Guidelines for the candidates are in the final stage of preparation and will be published soon.

2. epi Tutorials

32 candidates (from BE, DE, DK, FI, FR, GB and SE) participated in the autumn session. The Tutorials involved 20 tutors from BE, CH, DE, DK, FR, GB and SE.

The 2000/2001 Tutorials will start by the end of June 2000. There will be a summer term covering the 1999 papers and the last date for enrolment is 9 June 2000. There will also be an autumn term covering the year 2000 papers. Last date for enrolment to the autumn term is 13 October 2000.

There is a need for more tutors especially from Denmark, Finland, France and Sweden. The PQC urges the members of the Council to ask the *epi* colleagues in their countries if they are willing to help us with the tutorials. All *epi* members willing to do so are requested to contact the *epi* Secretariat.

3. Tutors' meeting

On 22 and 23 November 1999 the annual tutors' meeting was held. The first afternoon was spent analysing the feedback from the candidates regarding the different papers of the 1999 Examination. The background material to be studied for Papers A and B was generally considered too extensive for the total time available to sit the papers. However, the additional time given for Paper D was much appreciated by the candidates.

On the second day the tutors were joined by chairmen/secretaries from Examination committees I, II and III. After presentation of the statistics of the EQE there was constructive discussions between the members of the Examination Committees and the tutors i.a. on the subject of marking.

It is noted with great satisfaction that the draft of the Examiners' Report was sent out before the meeting.

4. Continuing Professional Education (CPE)

The aim of CPE is to maintain a highly qualified profession. When new states join the EPC there will be more grandfathers/grandmothers representing clients. An important task is to integrate them in the European profession. Another important question is how to safeguard that the European Patent Attorney really does fulfil the quality requirements laid down by the entrance

suitability examination and the professional demands above and beyond it.

As informed at the Berlin Council meeting PQC is taking a multiple-track approach in the matter of CPE:

- Continuing education at a national level supported by suitable institutions; this should cover the needs which are perhaps purely specific to a certain country and could be effected on the spot.
- Joint ventures with i.a. the EPO, CEIPI and Deutsche Anwalts Akademie (DAA) on different topics, such as mock interviews, opposition and appeal procedures.

A Working Group (WG-CPE) of the PQC has been in contact with CEIPI and DAA discussing the possibilities of future collaboration in the area of CPE and they have both declared their interest in collaborating with us. Both organizations are considered competent in running this type of programs. Therefore the PQC in the name of *epi* wishes to appoint both organizations for the implementation of a seminar. This will be a test that will give us a good comparison between these two organizations. In the future there will be a need for further organizers and we will also look for other organizations for collaboration in this matter.

The WG-CPE has sent out an enquiry to the national professional associations of the Contracting States in order to assess the national situation and requirements throughout all Contracting States. We have recently received replies from 12 countries and a 13th has advised us that we will receive their response in the near future. We have thus only had time for a preliminary evaluation, which is briefly presented below:

At a national level all countries but one seems to have good opportunities for the training of professional practitioners.

Training (on a local national level or a central level) in the following topics is regarded to be helpful:

- Litigation proceedings in infringement and revocation cases
- Comments on the decisions of the EPO Board of Appeals
- Oral proceedings in general
- Amendments of EPC /PCT
- Opposition proceedings at the EPO.

8 out of 12 countries would like to have the training in their own national language. In addition to this all replies indicated that the training also should be carried out in one of the official languages of the EPC. Finally 8 out of 12 countries indicated the need for training one or more of the official languages.

A sort of a la carte menu will be prepared, giving appropriate recommendations, essentially with a non-compulsory and liberal approach.

In order to give the *epi* members access to better information about existing CPE the WG-CPE plans to include this on the Home Page.

Today we are admitted representatives before the European Patent Office and we definitely wish to reserve the right to be able to represent our clients also with respect to Community Patent/European Patent in the European courts to be created. A consequence of this may be a need of additional education, and PQC is of the opinion that such an education should not be mandatory for admitted representatives.

The Council is invited to approve the proposal of developing CPE along the lines as depicted above.

5. Reduction in periods of professional activity

Following the decision of the Berlin Council meeting a letter with the *epi* proposal on amending the REE was addressed to the President of the Administrative Council. The proposal was to amend Article 10 REE and delete Article 11 REE.

Mr. Kober has replied that he is of the opinion that „either the provision should stay as it is at present or no possibility for reduction should be provided for at all“. PQC has asked its German member to initiate a discussion on this matter within the German group. The PQC will follow up this matter after information on how the German discussions are proceeding.

6. Restrictions in resitting the EQE

The EPO proposal for restrictions in resitting by amending Article 18 REE was rejected unanimously by the Council meeting. At the same time Council approved of proposed amendments of Articles 27 and 28 REE for a quicker appeal procedure. EPO was informed of this and they have thereafter replied that these Articles will be amended in accordance with their proposal. However, at the same time they informed that it is their intention to raise the appeal fee pursuant to Article 27(2) from 178 euro to 1.022 euro. The reason claimed by the Office is that they want conformity with the fee for appeal in granting proceedings. A response has been sent to EPO wherein is emphasized the importance of a viable appeal procedure and that the envisaged level of the appeal fee will be prohibitively high for individual candidates. *epi* has therefore suggested that the appeal fee shall remain unchanged. In this matter discussions with representatives of the EPO is going on and the PQC has after these discussions found that an increase of the appeal fee to twice the present amount is reasonable considering the fact that the fee has been at the same level for quite some time.

The Council is invited to approve the raise of the appeal fee pursuant to Article 27(2) REE from 178 euro to 356 euro.

As we did not hear anything from the EPO on the proposal of a joint *epi*/EPO working group on the statistics of the EQE this question was also taken up in connection with the above mentioned discussions. The idea with a joint working group is to make more detailed statistics of the EQE available to the PQC, thereby giving us a possibility of a more thorough analysis. If there will be further delays before a decision in this matter is taken by the office, PQC intends to send out a questionnaire to the candidates in order to gather information on some points of vital interest.

In the absence of any reaction from the EPO the PQC has prepared a draft questionnaire to be sent out to the candidates sitting the EQE. The answers of this will hopefully give us some statistical material that will be helpful in the analysis of what steps and measures that should be taken in order to increase the passing rate of the EQE.

7. Joint meeting PQC/Examination Board

The annual joint meeting took place in the *epi* premises in the afternoon on 3 May 2000. On the agenda was i.a. the 1999 and 2000 EQE papers. In the morning the same day PQC had a sitting with some tutors to prepare the afternoon's meeting.

The PQC notified the Examination Board that we had not received any copies of the 2000 EQE papers before the meeting. Therefore the PQC was not prepared to discuss these papers. It was also pointed out that for a number of years the PQC had not received the current papers in advance of the joint meeting.

The 1999 EQE papers were commented by the PQC and the tutors present, whereafter we had a very fruitful dialogue with the Examination Board. PQC stressed that the longer time for sitting papers C and D has really been appreciated by the candidates and the Examination Board informed us that in a foreseeable future there will be no change in the time available for the different papers. PQC stressed the importance of a relatively constant level of difficulty of the examinations from one year to another. The Examination Board informed us that they always strive to achieve a constant level.

The matter of statistics available to the PQC was discussed and we were informed that the revision of the EPC occupies so much of EPO's resources that the question of a joint *epi*/EPO working group will not be on Mr. Kober's agenda until next year. The PQC presented a draft questionnaire which in its final version will be sent to the candidates sitting the 2000 EQE. The Examination Board kindly promised us that our questionnaire will be enclosed with the results of the EQE when they are distributed to the candidates.

Code of Professional Conduct

Adopted by the Council of the Institute on October 3, 1997. Put into force by decision of the Board on May 3, 1999. The Board of the Institute on April 21, 2000 has taken note that Article 2b) paragraphs 1 and 3 as well as Article 5c) of the Code of Conduct of the Institute are deleted as from April 23, 2000 pursuant to the decision of the European Commission (L106, OJ April 23, 1999), and decided that the Code of Conduct will be re-published at the earliest possible date after April 23, 2000 in the epi Information. The appeal filed by the epi is still pending.

Walter Holzer
President

Richtlinien des Instituts der beim Europäischen Patentamt zugelassenen Vertreter für die Berufsausübung ab 23. April 2000

Code of Conduct of the Institute of Professional Representatives before the European Patent Office, as from April 23, 2000

Code de conduite professionnelle concernant les membres de l'Institut des mandataires agréés près l'Office européen des brevets à compter du 23 avril 2000

Diese Richtlinien dienen zur Regelung des Verhaltens und anderer Tätigkeiten der Mitglieder insoweit, als diese Tätigkeiten sich auf das Übereinkommen über die Erteilung europäischer Patente (Europäisches Patentübereinkommen) unterzeichnet in München am 5. Oktober 1973, oder dessen etwaige abgeänderte Fassungen beziehen.

This Code is to govern the conduct and other activities of the members insofar as such activities are related to the Convention on the Grant of European Patents (European Patent Convention) signed in Munich on 5 October 1973, as may be amended from time to time.

Ce Code a pour objet de régir la conduite et les autres activités des membres, pour autant que de telles activités ont un rapport avec la Convention sur la délivrance de Brevets Européens (Convention sur le Brevet Européen) signée à Munich le 5 octobre 1973, et telle qu'elle peut être révisée de temps en temps.

In diesen Richtlinien sind die folgenden Definitionen anwendbar:

In this Code, the following definitions are applicable:

Dans ce Code, les définitions suivantes sont applicables:

„Institut“
bedeutet das Institut der beim Europäischen Patentamt zugelassenen Vertreter;

„Institute“
means the Institute of Professional Representatives before the European Patent Office;

„Institut“
signifie l'Institut des Mandataires Agréés près l'Office Européen des Brevets;

„Mitglied“
bedeutet ein Mitglied dieses Institutes;

„Member“
means a member of this Institute;

„Membre“
signifie un membre de cet Institut;

„Übereinkommen“
bedeutet das Europäische Patentübereinkommen;

„Convention“
means the European Patent Convention;

„Convention“
signifie la Convention sur le Brevet Européen;

„Rat“
bedeutet der Rat des Institutes;

„Council“
means the Council of the Institute;

„Conseil“
signifie le Conseil de l'Institut;

„Mandant“
bedeutet jede natürliche oder juristische Person, die von einem Mitglied eine Beratung entgegen nimmt oder Dienste erbittet;

Client
means any natural person or legal entity who takes advice or asks services of a Member;

„Client“
signifie toute personne physique ou morale qui prend avis ou utilise les services d'un Membre;

„Disziplinarorgane“
bedeutet die in Artikel 5 der Vorschriften in Disziplinarangelegenheiten aufgeführten Organe;

„Disciplinary Bodies“
means those listed in Article 5 of the Disciplinary Regulation;

„Instances disciplinaires“
signifie celles énumérées à l'article 5 du Règlement en matière de discipline;

„Disziplinarrat“
bedeutet den in Artikel 5 der Vorschriften in Disziplinarangelegenheiten aufgeführten Rat.

„Disciplinary Committee“
means the Committee listed in Article 5 of the Disciplinary Regulation.

„Commission de discipline“
signifie la Commission mentionnée à l'article 5 du Règlement en matière de discipline.

1. Allgemeines

1. General

1. Généralités

a) Die allgemeinen Anforderungen an Mitglieder des Institutes sind in den Vorschriften in Disziplinarangelegenheiten niedergelegt.

a) The general requirements for members of the Institute are laid down in the Disciplinary Regulation.

a) Les obligations générales des membres de l'Institut sont fixées par le Règlement en matière de discipline.

b) Die allgemeinen Grundsätze des beruflichen Verhaltens sind in diesen Richtlinien niedergelegt, die die gegenwärtigen Ansichten des Rates wiedergeben. Kein Mitglied wird durch diese Richtlinien von seiner Verantwortung entbunden, die in den Vorschriften in Disziplinarangelegenheiten in den Artikeln 1, 2 und 3 enthaltenen beruflichen Regeln zu befolgen.

b) The general principles of professional conduct are laid down in this Code, which reflects the present views of the Council. A member is not released by this Code from his own responsibility to comply with the Rules of Professional Conduct set out in the Disciplinary Regulation in Articles 1, 2 and 3.

b) Les principes généraux de conduite professionnelle sont fixés dans le présent Code, qui reflète les vues actuelles du Conseil. Ce Code ne dégage pas un membre de sa propre responsabilité de respecter les Règles de Conduite Professionnelle fixées dans le Règlement en matière de discipline, en ses articles 1, 2 et 3.

c) Die grundsätzliche Aufgabe eines Mitgliedes ist es, den an Patentangelegenheiten interessier-

c) The basic task of a member is to serve as a reliable adviser to persons interested in patent

c) Le devoir fondamental d'un membre est d'agir en donnant des avis dignes de confiance aux

ten Personen als zuverlässiger Berater zu dienen. Er sollte als unabhängiger Berater dadurch wirken, dass er den Interessen seiner Mandanten vorurteilsfrei und ohne Berücksichtigung seiner persönlichen Gefühle oder Interessen dient.

matters. He should act as an independent counsellor by serving the interests of his clients in an unbiased manner without regard to his personal feelings or interests.

personnes s'intéressant aux questions des brevets. Il doit agir comme un conseiller indépendant en servant les intérêts de ses clients d'une façon impartiale, sans tenir compte de ses sentiments et intérêts personnels.

d) Ein Mitglied soll Maßnahmen treffen zur Sicherung der Interessen seiner Mandanten für den Fall, dass es an der Ausübung seines Berufs gehindert ist.

d) A member shall take measures to safeguard his client's interests in the event he would be prevented from exercising his profession.

d) Un membre prendra des mesures pour sauvegarder les intérêts de ses clients pour le cas où il serait empêché d'exercer ses fonctions.

e) Gute Kollegialität zwischen den Mitgliedern ist eine Notwendigkeit für die Wahrung des Ansehens des Berufsstandes und sollte ohne Rücksicht auf persönliche Gefühle geübt werden.

e) Good fellowship among members is a necessity for preserving the reputation of the profession and should be exercised irrespective of personal feelings.

e) Une bonne confraternité parmi les Membres est nécessaire pour préserver le renom de la profession et doit s'exercer indépendamment de sentiments personnels.

f) Jedes Mitglied soll diese Richtlinien kennen und kann sich nicht mit deren Unkenntnis entschuldigen.

f) Each member should know of the Code and cannot plead ignorance of it.

f) Chaque membre doit connaître ce Code et ne doit pas alléguer qu'il l'ignorait.

g) Ein Verstoß gegen diese Richtlinien kann nicht mit Instruktionen durch einen Mandanten gerechtfertigt werden.

g) A breach of this Code cannot be justified by referring to instructions from a client.

g) Une infraction au Code ne peut être justifiée par son auteur en se référant aux instructions d'un client.

2. Werbung

2. Advertisements

2. Publicité

a) Werbung ist im Allgemeinen erlaubt, soweit sie wahrheitsgemäß und sachlich ist, und mit wesentlichen Grundsätzen, insbesondere der Redlichkeit und der Achtung des Berufsgeheimnisses, in Übereinstimmung steht.

a) Advertising is generally permitted provided that it is true and objective and conforms with basic principles such as integrity and compliance with professional secrecy.

a) La publicité est généralement autorisée, pour autant qu'elle soit véridique, objective et conforme aux principes essentiels notamment la loyauté et le respect du secret professionnel.

b) Von der erlaubten Werbung sind ausgenommen:

b) The following are exceptions to permitted advertising:

b) Des exceptions à la publicité autorisée sont:

1) _____

1) _____

1) _____

2) Angaben zur Person eines Mandanten, es sei denn, der Mandant willigt hierin ausdrücklich ein;

2) the identification of a client without the express authorisation of that client;

2) la mention de l'identité d'un client, sauf autorisation expresse dudit client;

3) _____

3) _____

3) _____

4) das Anzeigen, Ankündigen oder Veröffentlichung von Angeboten betreffend den Kauf, Verkauf oder die Vermittlung von gewerblichen Schutzrechten, es sei denn auf Instruktionen eines Mandanten.

4) the advertisement, announcement or publishing of offers to buy, sell or negotiate industrial property rights, except upon the instructions of a client.

4) la publicité, l'annonce ou la publication d'offres d'achat, vente ou négociation de droits de propriété industrielle, sauf sur instructions d'un client.

3. Beziehungen zur Öffentlichkeit

3. Relations with the Public

3. Rapports avec le public

a) Ein Mitglied soll den guten Ruf dieses Institutes, seiner Mitglieder und der Praxis der Vertretung vor dem Europäischen Patentamt hochhalten.

a) A member shall uphold the public reputation of the Institute, of its members and of the practice of representation before the European Patent Office.

a) Un membre doit maintenir le bon renom de l'Institut, de ses membres et de l'exercice de la représentation devant l'Office européen des brevets.

b) Ein Mitglied soll an Büroräumen, auf Drucksachen oder anderweitig keinerlei Angaben machen, die die Öffentlichkeit irreführen.

b) A member shall not give any indication on office premises, stationery or otherwise which is misleading to the public.

b) Sur les lieux de ses bureaux, sur son papier à lettres et autres articles de papeterie, ou autrement, un membre ne doit donner aucune indication qui puisse induire le public en erreur.

c) Ein Mitglied soll Dritten keine Provision für die Vermittlung von Arbeit geben, dies erstreckt sich jedoch nicht auf den teilweisen oder vollständigen Erwerb einer anderen Patentvertretungspraxis.

c) A member shall not give any commission to others for the introduction of business, but this does not extend to the acquisition in part or in whole of another patent agency practice.

c) Un membre ne doit pas donner de commission à des tiers pour la transmission de travaux, mais cette clause ne s'étend pas à l'acquisition partielle ou totale de la clientèle d'un autre cabinet de brevets.

d) Ein Mitglied soll berufliche Tätigkeiten im Zusammenhang mit dem Europäischen Patentamt durch ein Nichtmitglied unter seinem Namen oder dem Namen eines Zusammenschlusses ohne angemessene Beaufsichtigung nicht gestatten.

d) A member shall not permit without adequate supervision professional activities related to the European Patent Office under his name or the name of his association by a person who is not a member.

d) Un membre ne doit pas permettre, sans contrôle adéquat, à une personne qui n'est pas membre, d'exercer au nom de ce membre, ou au nom du groupement auquel il appartient, des activités professionnelles ayant un rapport avec l'Office Européen des brevets.

e) Soweit es die Ausübung seines Berufs betrifft, ist ein Mitglied für die Handlungen seiner Gehilfen, die Nichtmitglieder sind, verantwortlich.

e) As far as the exercise of his profession is concerned, a member is responsible for the acts of non-member assistants.

e) En ce qui concerne l'exercice de sa profession, un membre est responsable des actes de ses collaborateurs non-membres.

4. Beziehungen zu Mandanten

a) Ein Mitglied soll auf die ihm von seinen Mandanten anvertrauten Angelegenheiten jederzeit angemessene Mühe, Aufmerksamkeit und Sachkenntnis verwenden. Ein Mitglied soll die Mandanten über den Stand ihrer Angelegenheiten informiert halten.

4. Relations with Clients

a) A member shall at all times give adequate care and attention and apply the necessary expertise to work entrusted to him by clients. A Member shall keep clients informed of the status of their cases.

4. Rapports avec les clients

a) Un membre doit, à tout moment, consacrer le soin et l'attention convenables à tout travail qui lui est confié par des clients, et faire preuve de la compétence nécessaire dans ce travail. Un membre doit tenir ses clients informés de l'état de leurs dossiers.

b) Grundsätzlich ist ein Mitglied nicht verpflichtet, den Interessen eines Mandanten in Angelegenheiten zu dienen, die nicht mit beruflichen Angelegenheiten verbunden sind, die der Mandant dem Mitglied anvertraut hat.

b) In principle, a Member does not need to serve the interests of a client in matters not connected with professional work entrusted to him by the client.

b) En principe, un membre n'est pas tenu de servir les intérêts d'un client dans des affaires sans relation avec le travail professionnel qui lui a été confié par un tel client.

c) Ein Mitglied darf von einem Mandanten Vorschüsse verlangen.

c) A member may demand advance payments from a client.

c) Un membre a le droit de demander des provisions à un client.

d) Zusätzlich zu den Anforderungen von Artikel 3 (2) der Vorschriften in Disziplinarangelegenheiten soll ein Mitglied einen Auftrag ablehnen, der im Widerstreit mit seinen eigenen Interessen steht. Wenn in solchen Fällen der Auftrag nicht aufgeschoben werden kann, ohne dass möglicherweise dem Mandanten Schaden entsteht, soll ein Mitglied den Auftrag annehmen und ausführen, soweit dies unmittelbar notwendig ist, um diesen möglichen Schaden zu verhindern, und danach die Angelegenheit niederlegen.

d) In addition to the requirements of Article 3(2) of the Disciplinary Regulation, a member shall decline an order which is in conflict with his own interests. In all such cases, if the order cannot be postponed without possible damage to the client, a member shall accept and perform the order so far as immediately necessary to avoid such possible damage: thereafter he shall resign from the case.

d) En plus des exigences de l'Article 3(2) du Règlement en matière de discipline, un membre doit décliner un ordre qui entre en conflit avec ses intérêts propres. Dans tous les cas de ce genre, si l'ordre ne peut être différé sans dommage éventuel pour le client, le membre doit accepter et exécuter l'ordre dans la limite de ce qui est immédiatement nécessaire pour éviter un tel dommage éventuel; ensuite il se démettra du dossier.

e) Ein Mitglied soll nicht ein finanzielles Interesse an irgendeinem gewerblichen Schutzrecht unter solchen Umständen erwerben, die zu einem Widerstreit zwischen Berufspflichten und Interesse führen. Er soll keine Honorare in Rechnung stellen, die unmittelbar vom Ergebnis der von ihm besorgten Dienste abhängen.

e) A Member must not acquire a financial interest in any industrial right in such circumstances as to give rise to a conflict between professional duty and interest. He must not charge an attorney fee directly related to the outcome of the services he provides.

e) Un membre ne doit pas acquérir d'intérêt financier dans un droit de propriété industrielle quelconque, dans des circonstances propres à donner naissance à un conflit entre ses obligations professionnelles et son intérêt. Il ne demandera pas d'honoraires en relation directe avec le résultat des services qu'il fournit.

f) Zusätzlich zu Artikeln 2 und 3 der Vorschriften in Disziplinarangelegenheiten soll ein Mitglied keinerlei Handlungen gegen eine bestimmte Angelegenheit vornehmen, die von dem Mitglied oder von einer anderen Person in seinem Büro bearbeitet wird oder bearbeitet wurde, es sei denn, dass der Mandant in dieser Angelegenheit mit der Handlung einverstanden ist oder dass dieses Mitglied keine Kenntnis von dieser Angelegenheit hat und nicht mehr in der Lage ist, von dieser Angelegenheit Kenntnis zu nehmen. Es ist diesem Mitglied nicht gestattet, bei einer solchen Handlung Informationen zu verwenden, die erhalten wurden, als die Angelegenheit früher bearbeitet wurde, es sei denn, dass diese Information öffentlich ist.

f) Supplementary to Articles 2 and 3 of the Disciplinary Regulation, a member shall not take any action against a particular matter which is being handled or has been handled by the Member or another person in his office, unless the client in the matter agrees to this action or unless the Member has no cognizance of the matter and is no longer in a position to take cognizance of it. The Member is not permitted to make use in the action of information obtained during the time the matter was previously handled, unless the information is public.

f) En complément aux articles 2 et 3 du Règlement en matière de discipline, un membre ne doit engager aucune action contre une affaire particulière qui est en cours de traitement ou qui a été traitée par un tel membre ou par une autre personne de son bureau, à moins que le client concerné par cette affaire ne soit d'accord sur cette action ou à moins que ce membre n'ait pas connaissance de l'affaire en question, et ne soit plus en mesure d'en prendre connaissance. Le membre n'est pas autorisé à utiliser au cours de l'action des informations obtenues pendant la période où l'affaire avait été antérieurement traitée, à moins que ces informations ne soient publiques.

g) Ein Mitglied wird automatisch von seiner Verschwiegenheitspflicht gemäß Artikel 2 der Vorschriften in Disziplinarangelegenheiten entbunden, wenn die geheimen Informationen öffentlich geworden sind.

g) A member is automatically released from his secrecy obligation according to Article 2 of the Disciplinary Regulation if the secret information becomes published.

g) Un membre est automatiquement libéré de son obligation de secret selon l'article 2 du Règlement en matière de discipline, si les informations secrètes sont devenues publiques.

5. Beziehungen zu anderen Mitgliedern

a) Ein Mitglied hat gegenüber den anderen Mitgliedern gute Kollegialität zu wahren. Darunter versteht sich ein höflicher Umgang sowie die Tatsache, dass ein Mitglied sich über ein anderes Mitglied nicht in unhöflicher oder verletzender Weise äußern soll. Beschwerden gegenüber einem anderen Mitglied sind erst mit ihm persönlich, entweder direkt oder durch die Vermittlung eines dritten Mitglieds, zu erörtern, danach notwendigenfalls auf den durch dieses Institut

5. Relationship with other Members

a) A member must observe good fellowship towards other members, and this includes courtesy and the fact that a member may not speak of another member in discourteous or offensive terms. Grievances in respect of another member should first be discussed in private with the other member, either directly or through a third member, and then if necessary through the official channels prescribed by the Institute and in the disciplinary Regulation.

5. Rapports avec les autres Membres

a) Un membre doit observer une bonne confraternité envers les autres, ce qui sous-entend la courtoisie et le fait qu'un membre ne doit pas parler d'un autre membre en termes discourtois ou blessants. Les griefs à l'égard d'un autre membre doivent d'abord être débattus en privé avec cet autre membre, soit directement, soit par l'intermédiaire d'un troisième membre, et ensuite si nécessaire, par intermédiaire des voies

vorgeschriebenen Wegen unter Einhaltung der Regeln in Disziplinarangelegenheiten vorzubringen.

b) Da ein vorrangiges Interesse des Institutes in der Aufrechterhaltung eines einheitlichen Berufsstandes liegt, soll kein Mitglied eine Diskriminierung zwischen Mitgliedern, insbesondere im Hinblick auf Sprache oder Nationalität, ausüben oder fördern.

c) _____

d) Wenn ein Mitglied von einem Mandanten einen Auftrag erhält, die Bearbeitung einer Angelegenheit von einem anderen Mitglied zu übernehmen, darf das beauftragte Mitglied diesen Auftrag annehmen, muss dann aber sicherstellen, dass das andere Mitglied davon Kenntnis erhält. Das andere Mitglied ist verpflichtet, alle für die Bearbeitung der Angelegenheit erforderlichen Schriftstücke ohne Verzögerung dem neuen Vertreter auszuleihen oder zu übergeben oder in Kopien zu angemessenem Kosten zur Verfügung zu stellen.

6. Beziehungen zum Europäischen Patentamt

Im Verkehr mit dem Europäischen Patentamt und seinen Bediensteten soll ein Mitglied höflich handeln und soll alles, was möglich ist, tun, um den guten Ruf dieses Institutes und seiner Mitglieder hochzuhalten.

7. Beziehungen zum Institut

a) Die Mitglieder haben das Institut über ihre Zustellanschrift informiert zu halten, an die ihnen vom Institut Korrespondenz und andere Informationen zugesandt werden sollen. Jede Änderung dieser Anschrift muss dem Generalsekretär unverzüglich mitgeteilt werden.

b) Die Mitglieder haben den gemäß Artikel 6 der Vorschriften über die Errichtung des Institutes zu entrichtenden Jahresbeitrag entsprechenden vom Rat festgelegten und mitgeteilten Anordnungen zu zahlen.

Wenn ein Mitglied den Jahresbeitrag nicht entsprechend den Anordnungen zahlt, kann die Angelegenheit vom Schatzmeister dem Disziplinarrat vorgelegt werden.

c) Kein Mitglied darf ohne Genehmigung durch den Präsidenten des Institutes irgendwelche schriftlichen oder mündlichen Mitteilungen im Namen des Institutes abgeben.

d) Ein Mitglied hat das Recht, durch den Generalsekretär um eine Meinungsäußerung zu ersuchen, ob irgendeine Handlung, die es vorschlägt oder billigt, aufgrund dieser Richtlinien zulässig ist. Diese Meinungsäußerung ist für die Disziplinargane nicht verbindlich.

e) Unbeschadet der Bestimmungen in Artikel 5b sollten Verstöße gegen diese Richtlinien schriftlich dem Disziplinarrat zur Kenntnis gebracht werden.

b) Since a prime interest of the Institute is to maintain a unified profession, no member must exercise or promote discrimination between members, for example on grounds of language or nationality

c) _____

d) Where a member is instructed by a client to take over the handling of a case from another member, the Member so instructed is free to accept such instruction but then shall ensure that the other member is informed. Such other member shall without delay, loan or transfer all documents necessary for the handling of the case or provide copies at reasonable expense to the new representative.

6. Relationship with the European Patent Office

In all dealings with the European Patent Office and its employees, a member shall act courteously, and shall do everything possible to uphold the good reputation of this Institute and its Members.

7. Relationship with the Institute

a) Members must keep the Institute informed of their address to which correspondence and other information from the Institute are to be sent. Changes of address must be notified to the Secretary-General without delay.

b) Members must pay, in accordance with arrangements laid down and notified by the Council, the annual subscription required by Article 6 of the Regulation on the establishment of the Institute.

If a member fails to pay the subscription as required by the arrangements, the matter may be referred by the Treasurer to the Disciplinary Committee.

c) No member may, unless authorised by the President of the Institute, make any written or oral communication on behalf of the Institute.

d) A member has the right to seek through the Secretary-General an opinion on the permissibility, under this Code, of any act the member proposes to do or sanction. Such opinion shall not be binding on the Disciplinary Bodies.

e) Except as provided in paragraph 5b), breaches of the Code should be brought to the notice of the Disciplinary Committee in writing.

officielles prescrites par cet Institut et dans le règlement en matière de discipline.

b) Etant donné que l'un des principaux intérêts de l'Institut est de maintenir une profession unifiée, aucun membre n'exercera ou ne favorisera de discrimination entre les membres en raison notamment de sa langue et de sa nationalité.

c) _____

d) Quand un membre reçoit d'un client des instructions aux fins de prendre en charge un cas provenant d'un autre membre, le membre qui reçoit les instructions est libre d'accepter ces instructions mais doit alors s'assurer que l'autre membre est informé. Cet autre membre est obligé, sans délai, de communiquer ou de transférer tous les documents nécessaires au traitement de ce cas ou en fournir des copies au nouveau mandataire, à un prix raisonnable.

6. Rapports avec l'Office européen des brevets

Dans tous les rapports avec l'Office européen des brevets et ses employés, un membre doit agir de façon courtoise, et faire tout son possible pour maintenir le renom de l'Institut et de ses membres.

7. Rapports avec l'Institut

a) Les membres sont tenus d'aviser l'Institut de l'adresse à laquelle toute correspondance ou communication de l'Institut doit leur être transmise. Tout changement d'adresse devra être notifié sans délai au Secrétaire Général.

b) La cotisation annuelle requise à l'article 6 du Règlement de création doit être payée par les membres, conformément aux dispositions fixées et notifiées par le Conseil.

Si un membre ne paie pas sa cotisation conformément auxdites dispositions, le Trésorier peut porter l'affaire devant la Commission de Discipline.

c) A moins d'y être autorisé par le Président de l'Institut, aucun membre ne peut faire, au nom de l'Institut, une communication écrite ou orale, quelle qu'elle soit.

d) Un membre a le droit de solliciter par l'intermédiaire du Secrétaire Général un avis sur le caractère licite, selon ce Code, de toute action que ce membre propose d'entreprendre ou de sanctionner. Un tel avis ne lie pas les instances disciplinaires.

e) A l'exception de ce qui est prévu au paragraphe 5b ci-dessus, les infractions à ce Code doivent être portées par écrit à la connaissance de la Commission de discipline.

Mitteilung des Präsidenten des Europäischen Patentamts vom 24. März 2000 über die Revision des Europäischen Patentübereinkommens

Der Verwaltungsrat der Europäischen Patentorganisation hat mit Beschluss vom 24. Februar 2000¹ eine Konferenz der Vertragsstaaten zur Revision des EPÜ einberufen. Die Konferenz wird vom 20. bis 29. November 2000 in München stattfinden. Neben den EPÜ-Vertragsstaaten sind zu der Konferenz als Beobachter die Staaten, die dem EPÜ beitreten können sowie die übrigen Staaten mit Beobachterstatus im Verwaltungsrat der Europäischen Patentorganisation und zahlreiche am europäischen Patentsystem interessierte zwischenstaatliche und nicht staatliche Organisationen eingeladen.

Das vom Verwaltungsrat bereits 1998 eingeleitete Revisionsvorhaben trägt dem Mandat der Pariser Regierungskonferenz vom Juni 1999 Rechnung (ABl. EPA 1999, 545, 550 unter Nr. 5). Damit bietet sich die willkommene Gelegenheit, das Europäische Patentübereinkommen von 1973 bald 30 Jahre nach seinem Abschluss im Lichte der technischen und rechtlichen Entwicklungen und der in mehr als 20 Jahren praktischer Erfahrung gewonnenen Erkenntnisse einer umfassenden Prüfung zu unterziehen. Mit der Revision soll das europäische Patentsystem – unter Wahrung der bewährten Grundlagen des materiellen Patentrechts und des Verfahrensrechts nach dem EPÜ 1973 – behutsam modernisiert werden. Es soll sichergestellt werden, dass die Europäische Patentorganisation, nicht zuletzt im Hinblick auf ihre bevorstehende Erweiterung auf mindestens 28 Mitgliedstaaten, auch auf künftige Herausforderungen flexibel reagieren kann.

Mit dem Revisionsvorhaben sollen Bedürfnisse und Anregungen der Benutzer, Vorschläge aus dem Kreis der Vertragsstaaten und eigene Bedürfnisse des EPA aufgegriffen und, wo dies notwendig oder zweckmäßig erscheint, durch Änderung des Übereinkommens umgesetzt werden. Leitend für die Revision ist das Gesamtinteresse an einer zügigen, effizienten und transparenten Durchführung aller Verfahren vor dem EPA, ohne die

bisherigen Qualitätsstandards zu gefährden. So sollen Bestimmungen über verfahrenstechnische Einzelheiten (Formerfordernisse, Fristen, Gebühren) aus dem Übereinkommen in die Ausführungsordnung überführt werden, um das europäische Patentrecht auch in Zukunft rasch und wirksam an neue Erfordernisse anpassen zu können. Vorgeschlagen wird die Einführung eines zentralen Beschränkungsverfahrens vor dem EPA. Die Rechtsbehelfe der Verfahrensbeteiligten sollen verbessert und erweitert werden.

Auch der internationalen Rechtsentwicklung ist Rechnung zu tragen. Anpassungen des EPÜ sind in Bezug auf das TRIPS-Abkommen, das künftige Gemeinschaftspatent und die Bestimmungen des in Kürze zu erwartenden Patent Law Treaty (PLT) erforderlich, z. B. im Hinblick auf die Erfordernisse für einen Anmeldetag, die elektronische Einreichung von Anmeldungen oder die Wiedereinsetzung in die Prioritätsfrist.

Alle Revisionsvorschläge sind vom Verwaltungsrat dem Ausschuss „Patentrecht“, in dem auch *epi* und UNICE vertreten sind, zur näheren Prüfung überwiesen worden und werden gleichzeitig SACEPO zur Stellungnahme zugeleitet.

Der Vorentwurf des sog. „Basisvorschlags“, der alle Revisionspunkte enthält und die Grundlage für die Beratungen der Diplomatischen Konferenz bilden wird, wird derzeit vom EPA unter Berücksichtigung der bisherigen Beratungsergebnisse und der Stellungnahmen der beteiligten Kreise erstellt und Anfang Juli dem Ausschuss „Patentrecht“ vorgelegt. Parallel dazu wird der Vorentwurf den zur Teilnahme an der Konferenz eingeladenen nicht staatlichen Organisationen zur ergänzenden Stellungnahme zugeleitet. Die endgültige Fassung des „Basisvorschlags“ soll dann auf einer Sondersitzung des Verwaltungsrats Anfang September festgelegt und den Konferenzteilnehmern sowie der interessierten Öffentlichkeit zugänglich gemacht werden.

Notice from the President of the European Patent Office dated 24 March 2000 concerning revision of the European Patent Convention

In a decision dated 24 February 2000² the Administrative Council of the European Patent Organisation convened an EPC revision conference of the contracting states. The conference is to be held in Munich from 20 to 29 November 2000. Invitations to attend the conference as observers have also been extended to the states

entitled to accede to the EPC, the other states with observer status on the Administrative Council and numerous intergovernmental and non-governmental organisations with an interest in the European patent system.

The revision project, launched by the Administrative Council back in 1998, takes the mandate of the June 1999 Paris intergovernmental conference into account

1 Abgedruckt im ABl. EPA 4/2000, S. 173.

2 Printed on p. 173 of OJ EPO 4/2000.

(OJ EPO 1999, 545, 550, point 5). It will provide a welcome opportunity to undertake a comprehensive review of the 1973 European Patent Convention, almost 30 years after its signing, in the light of technical and legal developments and over twenty years of practical experience. The aim of the revision is to subject the European patent system to cautious modernisation, while maintaining the proven principles of substantive patent law and procedural law which underlie the 1973 EPC. The European Patent Organisation is to be given the power to respond flexibly to future challenges, particularly in view of its forthcoming expansion to at least 28 member states.

The revision project will examine the needs and suggestions of users, proposals originating from the contracting states and the EPO's own requirements and will implement them by amending the Convention where this seems necessary or appropriate. The guiding principle behind the revision is everyone's interest in the smooth, efficient and transparent conduct of all proceedings before the EPO, without putting existing quality standards at risk. Thus provisions relating to procedural details (formal requirements, time limits, fees) are to be transferred from the Convention to the Implementing Regulations so that European patent law can continue in future to be quickly and effectively brought into line with new requirements. There is a proposal to introduce a central limitation procedure before the EPO. Legal

remedies for parties to proceedings are to be improved and expanded.

Developments in international law are also to be taken into account. The EPC needs to be brought into line with the TRIPs Agreement, the future Community patent and the provisions of the forthcoming Patent Law Treaty (PLT), eg regarding the requirements for according a filing date, electronic filing of applications or re-establishment of rights in respect of the priority period.

All revision proposals have been transmitted by the Administrative Council to the Committee on Patent Law, which includes *epi* and UNICE representatives, for further consideration and are also being submitted to SACEPO for its opinion.

The preliminary draft of the Basic Proposal, which will contain all the points for revision and form the basis for deliberations at the Diplomatic Conference, is currently being prepared by the EPO in the light of the results of discussions to date and opinions from the interest groups involved and will be submitted to the Committee on Patent Law in early July. It will also be supplied to the non-governmental organisations invited to attend the conference for an additional opinion. The final version of the Basic Proposal is due to be fixed at a special meeting of the Administrative Council at the start of September and made available to conference participants and interested members of the public.

Communiqué du Président de l'Office européen des brevets, en date du 24 mars 2000, relatif à la révision de la Convention sur le brevet européen

Par décision en date du 24 février 2000¹, le Conseil d'administration de l'Organisation européenne des brevets a convoqué une conférence des Etats contractants en vue de la révision de la CBE. Cette conférence se tiendra du 20 au 29 novembre 2000 à Munich. Sont invités à la conférence, non seulement les Etats parties à la CBE, mais aussi, à titre d'observateurs, les Etats habilités à adhérer à la CBE et les autres Etats ayant le statut d'observateurs au sein du Conseil d'administration ainsi que de nombreuses organisations intergouvernementales et non gouvernementales intéressées par le système du brevet européen.

Le projet de révision lancé dès 1998 par le Conseil d'administration tient compte du mandat de la conférence intergouvernementale de Paris de juin 1999 (JO OEB 1999, 545, 550, point 5). Il offre ainsi opportunément l'occasion de soumettre la Convention sur le brevet européen de 1973, une trentaine d'années après sa conclusion, à un examen en profondeur à la lumière des évolutions techniques et juridiques et de l'expérience

pratique acquise en plus de vingt ans. Cette révision vise à moderniser avec circonspection le système du brevet européen tout en préservant le fondement, qui a fait ses preuves, du droit des brevets et du droit procédural mis en place par la CBE en 1973. Il s'agit de permettre à l'Organisation européenne des brevets de réagir avec souplesse aux défis futurs, notamment dans la perspective de son élargissement prochain à au moins 28 Etats membres.

Le projet de révision doit prendre en considération les besoins et les suggestions des utilisateurs, les propositions émanant des Etats contractants ainsi que les besoins de l'OEB même et, là où cela semble nécessaire ou opportun, les mettre en oeuvre en modifiant la Convention. La révision doit être guidée par l'intérêt général attaché à un déroulement rapide, efficace et en toute transparence de l'ensemble des procédures devant l'OEB, sans que le niveau de qualité actuel s'en trouve affecté. Ainsi, il est prévu de transférer de la Convention dans le règlement d'exécution un certain nombre de dispositions régissant des points de procédure (exigences de forme, délais, taxes) afin de pouvoir à l'avenir aussi

¹ Reproduite dans le JO OEB 4/2000, page 173.

adapter avec rapidité et efficacité le droit européen des brevets aux nouvelles exigences. Il est notamment proposé d'introduire une procédure centralisée de limitation devant l'OEB.

Les recours légaux des parties à la procédure doivent également être améliorés et étendus.

Il importe aussi de prendre en considération l'évolution du droit international. Aussi est-il nécessaire d'adapter la CBE pour tenir compte de l'accord sur les ADPIC, du futur brevet communautaire et des dispositions du prochain Traité sur le droit des brevets (PLT), par exemple en ce qui concerne les exigences en matière de date de dépôt, le dépôt électronique de demandes ou la restituo in integrum quant au délai de priorité.

Toutes les propositions de révision ont été soumises par le Conseil d'administration pour plus ample examen au comité „Droit des brevets“, au sein duquel l'*epi* et

l'UNICE sont également représentés, et transmises simultanément au SACEPO pour avis.

L'avant-projet de la „proposition de base“, qui contiendra tous les points susceptibles de révision et qui constituera la base des délibérations de la conférence diplomatique, est actuellement élaboré par l'OEB à la lumière des résultats des discussions menées jusqu'ici et des avis émis par les milieux intéressés, et sera présenté début juillet au comité „Droit des brevets“. Cet avant-projet sera transmis parallèlement, pour avis complémentaire, aux organisations non gouvernementales invitées à participer à la conférence. Il est prévu d'arrêter ensuite la version définitive de la proposition de base lors d'une session extraordinaire du Conseil d'administration, devant se tenir début septembre, et de la mettre à la disposition des participants à la conférence ainsi qu'aux milieux intéressés.

Supplemental Report of the EPPC concerning revision of the EPC

A. Casalonga (FR)
EPPC Chairman

This supplemental report contains the outcome of the discussions and positions taken by the EPPC following the various proposals of the European Patent Office for the revision of the EPC.

1. Article 11 Appointment of senior employees

CA/PL 106/99 + Add.1 (CPL Meeting of 1-2 February 2000)

The EPO proposed an amendment of Art. 11(5) EPC making possible to appoint legally qualified national judges as members of the Enlarged Board of Appeal for a time period of three years.

The proposal was accepted.

2. Articles 16 / 17 / 18 / 91 Receiving Section / Search Divisions / Examination Divisions / Examination as to formal requirements

CA/PL 2/98 – (CPL Meeting of 27-28 January 1998)

Various amendments were proposed and discussed for deleting any geographical reference to Den Hague in order to permit Office wide introduction of BEST.

Further amendments were proposed which are not directly linked with the introduction of BEST but which aim at increasing the flexibility of examination.

This is particularly the case for Art. 16 EPC where it is proposed to leave the responsibility of questions relating to designation fees to the examining division.

The Dutch delegation suggested to abolish any legal distinction between the search division and the examining division.

Further amendments were proposed and discussed relating to the Centralisation Protocol so that the branch of Berlin can also have the same tasks as in Munich or Den Hague.

3. The representatives of the EPO insisted on the fact that with complete introduction of BEST, the generic principle of organization of the EPO would not change in that the search would still be separated in time from the examination. It was mentioned that the PCT also has those two different steps of the procedure so that a change of the EPC in this regard would lead to considerable political problems and would have severe consequences.

It was stressed again that the principle of three members in the examining division would be retained.

On the other hand, it was made clear that after introduction of BEST, full search as well as examination and probably also opposition would be made in the same way in Den Hague, in Munich and in Berlin. Apparently, the EPO thinks of specializing each branch of the Office in specific technical fields. This means also that interviews as well as oral procedures would have to be held at the place where the respective division of the EPO stands.

4. Articles 22 and 112a Review of Board of Appeal decisions by the Enlarged Board of Appeal

CA/PL 17/00 (CPL Meeting of 3-6 April 2000) / (EPPC – CPC Subcommittee Meeting of 27 March 2000)

It is proposed by the EPO to introduce the possibility that the Enlarged Board of Appeal could review decisions of BoAs in case of a fundamental procedural defect or the occurrence of a criminal act that may have had an impact on the decision. The cases would then be remitted to another BoA.

5. The question was discussed by the EPPC – CPC Subcommittee.

The majority of the Subcommittee was against the idea that the Enlarged Board of Appeal could study facts again. Even if a review is provided, the case should therefore come back to the Board of Appeal for considering any facts and evidence. The majority of the Subcommittee members felt that it was most important to avoid increasing the duration of the procedure so that the present situation should be maintained and no third instance should be introduced.

It was also mentioned that leaving the grounds for filing a request for review in the Implementing Regulation could lead to abuses in the future if the Implementing Regulation were amended.

6. Article 23(1) Maximum age limit for members of the Boards of Appeal

(CPL Meeting of 12-13 May 1998)

Accepted.

7. Article 23(3) EPC – Independence of the members of the Boards of Appeal

CA/PL 5/99 – (CPL Meeting of 16-18 March 1999)

It was decided that the Boards should not be explicitly bound to e.g. TRIPS and ECHR. They should be bound only by the EPC that, as a matter of course, should be kept in line with generally accepted conventions. Therefore, Art. 23(3) EPC should not be amended.

8. Articles 33 / 35 Competence of the Administrative Council in certain cases / Voting rules

CA/PL 3/00 (CPL Meeting of 1-2 February 2000)

It was proposed to extend the possibility for the Administrative Council to amend the EPC so as to bring it into line with patent related international treaties, agreements and Community law, thus avoiding a lengthy revision procedure. The proposal also insisted on the fact that unanimity of the Member States would be necessary in the Administrative Council. If unanimity would not be attained, the normal revision proceedings should be used.

9. CA/PL 3/00 + Add.1 (CPL Meeting of 3-6 April 2000)

The discussion of February about the plans to give the Administrative Council the power to amend EPC articles by unanimous decision went on. Most countries agreed provisionally to a Swiss proposal that a Member State could veto such a decision of the AC within a period of 12 months. Background is, that a national Parliament could have a different opinion than that country's AC delegate about the question if the amendment is indeed required to bring the EPC articles in conformance with international obligations.

10. At the meeting of July it will be decided if absence of a country at the voting will be non-blocking. The EPO will make a new proposal including a definition of the international treaties („on patents“) involved. Of course a closed list would further limit the possible scope of the provision considerably.

11. Articles 33 / 95 Competence of the Administrative Council in certain cases / Extension of the period within which requests for examination may be filed

(CPL Meeting of 12-13 May 1998) Time limit for filing request on examination

This was not pursued.

12. Articles 37 / 38 / 42 / 50 Financial provisions

CA/IF 3/00 (CPL Meeting of 3-6 April 2000)

Accounting principles were accepted.

13. Articles 51 / 126 Rules relating to Fees / Termination of financial obligations

CA/PL 8/00 (CPL Meeting of 3-6 April 2000)

Fee system. See the discussion on Art. 164, a fee is one of the obligations meant there.

14. Articles 52(1)-(3) Patentable inventions

CA/PL 6/99 – (CPL Meeting of 16-18 March 1999)

The majority of the countries accepted the proposal to align Art. 52(1) EPC with the TRIPS wording and to delete Art. 52(2) and 52(3) as a whole. However, no change of practice is intended: only technical inventions are and will be patentable. This is and will also be true for computer related inventions. It was proposed to transfer some of the examples of excluded matter from Art. 52(2) to the Rules, in order to give more guidance to the meaning of „technical/technological“.

15. At the CPL Meeting of 12-13 May 1998, the representative of **epi** expressed the wish to adopt the generic language used in TRIPS, i.e. that inventions can be patented in all technological fields without discrimination.

16. Articles 52(4) and 54(5) Patentability of medical methods and novelty

CA/PL 7/99 – (CPL Meeting of 16-18 March 1999)

The EPO presented the problem and made clear that cancelling Art. 52(4) would authorize patents on medical treatment methods. However in that case, the provisions of Art. 54(5) could not be sustained according to the EPO so that only use claims could be obtained for pharmaceutical compositions and products and not any more pharmaceutical product claims.

During the discussion, it was mentioned that while medical treatments are frequently within the field of technology and should therefore be protected, the possibility of obtaining product claims for pharmaceutical products and compositions should be retained.

It was mentioned that some kind of limitation of the protection should be provided if medical methods would be patentable in order to permit medical doctors to exercise freely.

It was also made clear that adequate protection should be available in the case of a first medical indication as well as in the case of subsequent medical indications.

17. CA/PL 4/00 (CPL Meeting of 1-2 February 2000)

At this meeting, the EPO presented a proposal for amendment of Art. 54(5) according to which the product protection in case of a first medical indication, would be limited to the specific use disclosed in the patent application.

The *epi* considered that the proposal of the EPO was acceptable in that it defined in a clearer way the protection of the invention in case of a second or a further medical indication making it possible to obtain in such a case a product claim limited by the specific use disclosed in the application.

However, the *epi* pointed out that the wording proposed in the amended Art. 54(5) by the EPO made doubtful that a compound claim not limited by the specific use indicated in the description could be obtained in the case of a first medical indication as it was presently the case according to the case law of the Boards of Appeal as well as some courts, such as the French courts.

The *epi* stressed that the broad protection presently available in the case of a first medical indication was fully justified by the fact it corresponded exactly to the invention made, i.e. that a given product could be used in human or animal therapy which meant that toxicity, testing and clinical tests had been made.

The UNICE representative approved completely the position of the *epi*.

18. Article 53(a) – Exceptions to patentability

CA/PL 8/99 – (CPL Meeting of 16-18 March 1999)

It was generally agreed to amend Art. 53(a) along the lines of Art. 27(2) of TRIPS. Inventions, which would be contrary to „ordre public“ or morality when they are commercially exploited, would not be patentable. The publication of patent applications relating to such inventions would not any more be forbidden.

19. Article 54(4) Novelty / Prior rights

CA/PL 17/99 – (CPL Meeting of 8 July 1999)

The EPO proposes to cancel Art. 54(4) so that all European patent applications become automatically prior right independently of the designated states. This would lead to a corresponding cancellation of rule 23a and amendment of rule 87.

It was pointed out that national laws should be amended correspondingly. This is already the case in UK and is under way in Denmark and Ireland.

The *epi* spoke also in favour of the proposal of the European Patent Office.

20. Article 55 Non-prejudicial disclosure (grace period)

This highly controversial question was not yet discussed by the Administrative Council but could be presented for discussion at the next meeting of the Committee on Patent Law.

A study has been requested by the EPO from Mr. Galama and Mr. Straus for April 2000.

21. The *epi* has expressed several times its position against introduction of a grace period in the EPC.

22. Articles 68 / 105a-b-c Central limitation procedure

The European Patent Office is proposing a possibility for the patentee to request a limitation or revocation of a granted European patent, for example when the patentee has discovered a new document of the prior art. The review, which would be made by the European Patent Office, would be a simple review only based on Art. 84 and Art. 123(2). The European Patent Office would not reexamine the patent, particularly on questions of novelty or inventive step.

Initially, the European Patent Office intended to make the effects of the limitation *ex tunc* and did not provide for any amendment of the specification.

However, the Committee on Patent Law was not certain that the effects of limitation should not be ex

nunc. Consideration of intervening rights of third parties could also be considered.

The EPPC felt that the proposal was interesting but should also include an examination of Art. 123(3).

23. Article 69 Protocol on Interpretation – Extent of protection

The EPO intends to propose in July 2000 an amendment of Art. 69 or to the Protocol on interpretation in order to „strengthen protection by mentioning equivalents, prosecution history estoppel“.

24. The EPPC – CPC Subcommittee met on 27 March 2000 and discussed the question. It was suggested that no definition of equivalency should be introduced, but only possibly the mention of equivalence in the Protocol for interpretation of Article 69.

On file wrapper estoppel, after discussion, it was felt that such an estoppel limited to the European patent files could be introduced, particularly for balancing the introduction of equivalency in the Protocol for interpretation of Article 69. It was mentioned that file wrapper estoppel could be even more important if the European Patent Office would decide that the description of the European patent was not any more amended after examination.

25. Article 69(2) Provisional protection when the European patent is maintained amended after opposition

The practice has shown that some difficulties occur when a European patent is maintained amended by a decision of an Opposition Division while a litigation is pending before a national court.

26. In order to clarify this situation, the EPPC felt it would be advisable to clearly indicate, for example in Article 69(2), that the effects of the European patent are defined within this period of time by the claims of the patent maintained amended by the Opposition Division.

Of course, when provisional protection requires in a Contracting State a translation in an official language, this translation should also be provided.

27. Article 79 Designation of Contracting States

CA/PL 13/00 (CPL Meeting of 3-6 April 2000)

The proposal of the European Patent Office, according to which all Contracting States would be automatically designated upon filing a European patent application, was generally accepted.

The Article will be adapted to reflect the recent measures with respect to the designation fee including the decision by the CPL to delete Art. 54(4) on collision and to open the possibility to abolish the designation fee altogether.

28. The EPPC considered however that designation fees should be maintained at least for the interest of third parties.

29. Articles 80 / 90 / 91 Date of filing of a European patent application / Examination on filing / Examination as to formal requirements

CA/PL 5/00 (CPL Meeting of 1-2 February 2000)

The EPO proposed to shift the main provisions for obtaining a filing date, in the Implementing Regulation.

Some delegations wished to maintain in the Convention the main requirements for obtaining a filing date at least according to Art. 5 of the PLT draft.

The *epi* spoke in favour of amending the provisions for obtaining a filing date so that the claims would not be anymore required. The EPO acknowledged that this was the intention.

30. Articles 84 / 100 / 138 Support of the claims / Grounds for opposition / Grounds for revocation

CA/PL 27/99 – (CPL Meeting of 18-19 November 1999)

A proposal presented by the UK delegation consists in introducing the lack of support of the claims by the specification as a new ground for opposition (Art. 100) and for nullity (Art. 138).

In the presentation document, the European Patent Office explained the present practice of the European Examiners towards broad claims. According to the guidelines, the scope of the claims must not be broader than justified by the extent of the description and drawings.

According to the Boards of Appeal, the claims must be both consistent and commensurate with the description. Accordingly, a claim which does not contain a feature identified as essential in the description is inconsistent with and not supported by the description.

31. All national delegations were however against the idea of introducing Art. 84 as a new ground for opposition and revocation.

The proposal of the UK delegation was therefore not accepted.

32. Article 87 – Priority right

CA/PL 16/98 – (CPL meeting of 3-4 November 1998) / (CPL Meeting of 3-6 April 2000)

The EPO proposes amending Art. 87 (priority right) in order to permit more easily a priority claim of applications firstly filed in a country not Member of the Paris Convention and particularly, Taiwan.

The EPO remarks that the priority right defined in Art. 87 EPC is broader than the priority right defined in the Paris Convention in that, according to Art. 87 EPC, the „person who filed the first application“ may be any person, i.e. also a national from any other country. On the contrary, in the Paris Convention and this is confirmed by WIPO, this person must be a national of one Member State of the Paris Convention.

33. CA/PL 9/99 (CPL Meeting of 16-18 March 1999)

The EPO proposes to enlarge the reciprocity requirement for priority according to the EPC, stating in Art. 87(5) that reciprocity on the basis of a first application filed at the EPO would be sufficient.

The EPO also proposes to solve the problem of Taiwan by mentioning the filing at an „industrial property authority“ instead of in a „State“.

34. Article 88(1) – Claiming priority

CA/PL 17/98 – (CPL Meeting of 3-4 November 1998)

The EPO proposes that formal requirements of Art. 88 (claiming priority) be shifted to the Implementing Regulation.

However, it is important to bear in mind that third parties must have ready access to the priority document and a translation in one of the official languages, from the point of view of verifying the validity of the priority right claimed vis-à-vis their own application, or a consideration of the validity of the patent application, e.g. for Opposition purposes. Therefore, in any new arrangement, it would be important that third parties have quick access to the priority document on request to the EPO.

35. Articles 92 / 93 and 98 The drawing up of the European search report / Publication of a European patent application / Publication of a specification of the European patent

Matter of streamlining without material change. The basis for the Search will be retained in Art. 92(1) but details will be shifted to the Rules. In Art. 98 the proposed English and German texts should be clarified to make sure that the publication of the patent specification will take place together with or as soon as possible after the mention of the grant in the Bulletin.

36. Articles 94 to 97 Request for examination / Extension of the period within which requests for examination may be filed / Examination of the European patent application / Refusal or grant

CA/PL 6/00 (CPL Meeting of 1-2 February 2000)

The EPO proposed to shift all provisions related to those questions in the Implementing Regulation. This was generally accepted.

37. Articles 99-105 Opposition / Grounds for opposition / Examination of the opposition / Revocation or maintenance of the European patent / Publication of a new specification of the European patent / Costs / Intervention of the assumed infringer

CA/PL 15/00 (CPL Meeting of 3-6 April 2000)

The EPO proposes to shift a number of details of the opposition procedure to the Implementing Regulations. Among them is the ninemonth period for filing the opposition in Art. 99.

38. The *epi* representative argued that this period is a fundamental compromise between the interests of patent owners and third parties and should remain in the Convention at least for psychological reasons and even if the Administrative Council has already the power to amend this period as any other deadline mentioned in the Convention. A letter was sent to the EPO to confirm this position.

39. Art. 101 will be rewritten to safeguard the right to be heard.

The obligation Art. 102(5) to file translations of the amended claims in the official languages remains in the Convention.

The principle of fairness in any apportionment of costs will remain in the Convention (Art. 104).

40. Articles 106-111 Appeal procedure

CA/PL 16/00 (CPL Meeting of 3-6 April 2000)

Shifting details of the appeal procedure to the Implementing Regulations. *epi* made a similar remark to Art. 108 (time limit for appeal) as with respect to Art. 99 (see above). Accepted.

41. Articles 115 / 117 / 119 / 120 / 123 / 124 / 127 / 128 and 130 Common provisions

CA/PL 18/00 (CPL Meeting of 3-6 April 2000)

Shifting procedural details to the Implementing Regulations.

The non-exhaustive list of sources of evidence in Art. 117(1) will be retained.

In Art. 119 it will be assured that the present quality of notification of parties will not diminish.

On request of *epi*, the opportunity for applicants to amend their applications at least once on their own volition will be maintained in Art. 123(1).

Furthermore, the *epi* asked for clarification of the proposed text of Art. 124, which could lead to American-type practices in providing „useful information“ about corresponding national applications. An *epi* proposal to limit this to bibliographic data, search reports, cited prior art and, if unavailable at the EPO, copies of cited art was accepted. The EPO will make a proposal to make the

sanction for non-compliance (application deemed withdrawn) less severe.

The official Register (Art. 127) will be combined with the present so-called EPIDOS-register.

42. Articles 121 and 122 Further processing of the European patent application and restitutio in integrum

CA/PL 19/99 (CPL Meeting of 8 July 1999)

The proposal of the EPO consists in shifting the procedural questions to the Implementing Regulation for Art. 121 as well as for Art. 122 and in enlarging the coverage of further processing (Art. 121) so that re-establishment of rights (Art. 122) would be less resorted to.

43. The *epi* supported the shift of some aspects of the procedure to the Implementing Regulation, asked to define intervening rights for third parties and proposed to calculate the time limit for further processing from the time of removal of the cause of non compliance with the time limit, while still applying the two years maximum of present Art. 122 in order to preserve legal certainty. Furthermore, *epi* suggested to make these repair possibilities also available to third parties (opponents).

44. The EPPC – CPC Subcommittee discussed the question at its meeting of 27 March 2000 and made two proposals.

According to the first proposal, the sentence „in spite of all due care“ stated in Art. 122 should be replaced by „unintentionally“.

According to the second proposal, Art. 122 (restitutio in integrum) should apply also to the situations where further processing is possible according to Art. 121 so that another possibility would still be opened.

45. Article 123 Amendments

CA/PL 26/99 (CPL Meeting of 18-19 November 1999)

The European Patent Office explained the situation of the so-called „inescapable trap“ created in the European patent law by the joined application of paragraphs 2 and 3 of Art. 123 EPC.

It was made clear that the difficulty is not limited to the opposition procedure but extends to revocation in view of Art. 135, § c and d. In certain Member States, the claims may be amended during an infringement action by introducing not only a disclaimer, but also any added feature or explanation. In that case, the risk of a similar trap exists for the granted European patent.

The European Patent Office explained the two solutions developed in German law to avoid revocation in a similar situation, i.e.:

- maintaining the patent with a „limiting declaration“ explaining that a feature added during examination

in a claim will confer no right to the patent's proprietor. Such a declaration therefore indicates that the feature question should not be taken into consideration for assessing patentability but limits the protection conferred by the patent;

- deleting the undisclosed limiting feature. Accordingly, even in a post-grant opposition, it is possible to limit the subject-matter to what was originally disclosed. In that case, intervening rights of third parties could also be considered.

The European Patent Office explained that none of those two solutions was absolutely satisfactory and that the German Supreme Court could in the near future arrive at a different position. The European Patent Office concluded that nothing should be done and Art. 123 EPC should be left unamended.

46. The *epi* indicated that the first solution (footnote or declaration solution) was preferred if it is defined with care. In any case, maintaining the present situation was not a good solution.

The majority of the national delegations spoke in favor of the *status quo* proposed by the European Patent Office.

In conclusion, it was considered advisable to wait for a possible evolution of case law. Further possibilities including the shifting of the filing or priority date, as proposed by the Austrian delegation, should be further studied.

47. Article 129(a) (periodical publications)

CA/PL 19/98 – (CPL Meeting of 3-4 November 1998)

The EPO wishes to split the European Patent Bulletin and the Register with the idea of having in the Bulletin only the main information and, on the contrary, all information on the Register, i.e. in the future more and more directly in line while the Bulletin would remain on paper.

48. Articles 133 / 134 General principles of representation / Professional representatives

CA/PL 22/00 (CPL Meeting of 3-6 April 2000)

The EPO has proposed some amendments to Arts. 133 and 134 as well as a new Art. 134a.

The EPO proposes to take over the substance of present Art. 163(6) („grandfather clause“ for professional representatives) into Art. 134 (professional representatives).

According to the proposed wording, a new paragraph 3 is introduced in Art. 134 leaving a period of one year from the date of accession of a new Member State to the EPC for persons to be entered on the list of professional representatives. One condition is that said person be „a national of one of the contracting states“.

It is pointed out that this provision could possibly lead to some, at least theoretical, abuses. As a matter of fact, if no condition is provided in a new Member State for

representation before the local patent Office, any person national of the Member States previously within the EPC and not on the list of professional representatives (for example having failed the European Qualifying Examination), could open a branch office in this new State a few years before accession and, by this way, benefit of those transitory provisions to enter on the list.

49. A further amendment in paragraph 7-b of Art. 134 takes up a previous passage of Art. 163(4)(a) authorizing the president of the EPO to grant exemption in special circumstances to an applicant of such a new Member State who has not habitually acted before the central patent Office of that State for at least five years.

50. Article 138 Grounds for revocation

CA/PL 19/00 (CPL Meeting of 3-6 April 2000) Partial revocation

According to the proposed amendment for Art. 138(1), the grounds for revocation are only defined in the EPC and not in national laws.

This was generally accepted.

According to the proposed amendment for Art. 138(2), national courts would be compelled to consider a possible limitation of the patent, either on their own or upon request of the patentee.

Some delegations stated that they needed more time to consult on this question.

The *epi* suggested that the limitation be made by modifying the claims, only leaving description and drawings unamended, in order to facilitate the work of national courts, especially in countries where such an amendment of the patent is rare or not allowed.

It was finally decided that the proposal for Art. 138(2) would be redrafted and Art. 68 amended for aligning the effects of limitation to those of full revocation.

51. Articles 142 to 149 Unitary patents

CA/PL 7/00 (CPL Meeting of 1-2 February 2000)

The Intergovernmental Conference in Paris requested the EPO to prepare an amendment of the EPC to adapt the Convention to the future Community Patent Regulation.

The EPO proposed a first alternative with only a few amendments and a second alternative with more amendments.

52. CA/PL 7/00 Add.1 (CPL Meeting of 3-6 April 2000)

The Danish delegation presented a proposal for decentralisation of the work for the community patent by which the national Patent Offices could, if they so wish, act as subcontractors of the EPO for community patent prosecution.

A number of delegations felt the proposal interesting and favoured a discussion at the next Administrative Council meeting.

Other delegations stated that it was contrary to the Protocol of Centralisation and that the CPL was not competent to discuss such a political question.

UNICE and *epi* expressed a strong opposition to any subcontracting of work to national Offices.

The President concluded that the CPL not being competent, the Danish delegation would have to present a paper before the Administrative Council if it wished the matter to be pursued.

53. Articles 150-158 International application pursuant to the Patent Cooperation Treaty

CA/PL 21/00 (CPL Meeting of 3-6 April 2000) Euro-PCT applications

The *epi* suggested that Art. 152 (relating to the search and examination work made by the EPO as an International Authority for US and Japanese PCT applicants according to an agreement between the EPO and WIPO) be amended to state that this kind of work would only be made by the EPO as long as it would not create or increase a backlog in the normal work of the EPO, ie for direct EP applications.

After discussion however, the initial proposal of the EPO was accepted with some drafting changes.

54. Articles 154(3) / 155(3) The European Patent Office as an International Searching Authority / The European Patent Office as an International Preliminary Examining Authority

(CPL Meeting of 12-13 May 1998) Protest procedure under the PCT

The EPO proposed to abolish the possibility of judicial review by the BoA. The review panel would be the last instance.

55. Articles 159 to 163 and 167 Transitional provisions / Final provisions

CA/PL 18/98 – (CPL Meeting of 3-4 November 1998)

Those articles relate to transitory provisions which are no more applicable. The substance of Art. 163 concerning professional representatives has been shifted into Art. 134 and new Art. 134a.

It is proposed to cancel the other transitional provisions.

56. Article 164 Implementing Regulations and Protocols

CA/PL 21/00 (CPL Meeting of 3-6 April 2000)

This article should be adapted to contain an umbrella provision to make it possible to shift many details from the Convention to the Rules. The Committee felt that the

proposals in this connection went too far. In any case the basis for obligations and sanctions for non-compliance should remain in the Convention.

57. Article XX Provisions for future optional Protocols

CA/PL 24/00 (CPL Meeting of 3-6 April 2000)

According to the EPO, the proposal is necessary to anchor the future Protocols in the EPC.

Art. XX §2a provides that members of the Boards of Appeal could serve in the future European Patent Court.

Art. XX §2b relates only to the future Common Entity (only competent to answer to interpretation questions) and not to the future European Patent Court. It provides that the EPO will finance that this Entity and offer support staff and premises within the EPO. The EPO mentioned that Entity was anyhow provisory and would be merged with the European Patent Court as soon as it would come into operation.

The majority of delegations approved the proposal in principle but wished to further consult before final acceptance.

CA/13/00 Streamlining procedures at the EPO

Following a paper of the French delegation, the EPO issued several proposals for „streamlining“ the procedures.

The EPPC prepared comments on the proposals of the European Patent Office which will be sent to the EPO on the following points:

- search examination interface (issuing the first examination report together with the search report)
- final phase of the grant procedure (combining rules 51(4) and 51(6))
- amending the description (avoiding the necessity of amending the description during examination opposition or appeal)
- revision of Article 114 (making it more difficult to submit documents at a later stage)
- waiving the obligation of the Boards of Appeal to give written reasons

Patent Agent Litigators in the United Kingdom

E. Lyndon-Stanford (GB)

For most of the twentieth century, there was a perception that patent litigation (in particular) was too expensive in the United Kingdom. However, although small moves were made to improve the quality and decrease the cost of patent litigation, nothing substantive was done until the Patents County Court was instituted by the Copyright, Designs and Patents Act 1988. The Patents County Court had a special jurisdiction which was for proceedings relating to patents for designs or matters ancillary to or arising out of such patents or designs. In this Court, a registered patent agent was permitted to do anything which a solicitor could do (other than prepare a deed), which meant that the patent agent could organise the litigation and speak in Court.

Meanwhile however the privatising and competition-inclined Conservative government was looking more generally at competition amongst those providing legal services, and the Courts and Legal Services Act 1990 was passed which (inter alia) made provision for new or better ways of providing such legal services and a wider choice of persons providing them, though it stated that the proper and efficient administration of justice should be maintained. As far as patent agents were concerned, the important provision was that any suitable professional body could be designated as an authorised body for granting rights in Court. Under this Act, the

Chartered Institute of Patent Agents was on 25th November 1999 designated as an authorised body, and can grant to its Fellows (who will be registered patent agents) rights roughly equivalent to those of a solicitor in the High Court and in the Court of Appeal, in relation to intellectual property litigation. Intellectual property litigation includes inventions, designs, technical information (including copyright relating to technical information), trade marks and passing-off, and any matter ancillary thereto.

The Chartered Institute has set up a patent agent litigator accrediting board, and the first applications are now being received. There is a transition period of four years in which those with experience can be appointed. Subsequent to that, in order to be appointed candidates must have done a second degree (LLM) in litigation and have had a minimum of six months experience under the supervision of a person who has the right to conduct litigation. The Chartered Institute is at present negotiating for a litigation course with a British University which will last two years, will be mainly distance learning but with six long weekends of hands-on work.

Everything I have written above applies only to England and Wales. In Scotland and in Northern Ireland there are different jurisdictions and the rights so far do not extend to those jurisdictions.

Recent Changes in U.S. Patent Law

G. J. Maier & P. Signore¹

On November 29, 1999, a new bill affecting U.S. patent law was enacted.² The changes in the law will significantly affect a variety of U.S. patent law areas, and have already been labeled the most significant changes in the U.S. patent system since passage of the 1952 Patent Act.

The most important changes are the following:

- Pending U.S. patent applications will be published 18 months after their earliest claimed priority date, instead of being kept confidential until issuance. Patentees will now be able to recover under certain conditions a reasonable royalty calculated back to the application publication date.
- The new law also changes the prior art effect of patents issued from PCT applications.
- A third party may challenge a patent in the USPTO through a new „inter partes“ reexamination procedure which allows the third party to actively participate in the procedure.
- A number of patent term guarantees are added to provide patent term extensions to compensate for delays created by the USPTO.
- A new prior inventor defense is provided for accused infringers of patents claiming methods of doing business.

The purpose of this article is to discuss these changes and their consequences, and where possible, to suggest new strategies taking advantage of the changes.

I. NEW RULES AND ADMINISTRATIVE CHANGES

The U.S. Patent and Trademark Office (USPTO) is establishing new rules implementing the changes in the law. The USPTO is releasing the new rules in packages relating to different topics covered by the changes in the law. Because the changes in the law become effective at different dates,³ the publication of the rule packages will be scattered throughout the year. For most rule packages, a set of proposed rules will be published, followed by a sixty day public comment period, then the rules will be finalized.⁴

In addition to changes in substance, the new law, entitled „American Inventor Protection Act of 1999“

(the „Act“), also affects the administration of the USPTO. Henceforth, the highest official at the USPTO, formally called the „Commissioner“, effective March 29, 2000, is called the „Director,“ and becomes the chief intellectual property policy officer of the U.S.. Under the Director is the „Deputy Director,“ beneath whom is a Commissioner for Patents and a Commissioner for Trademarks, each appointed for a 5-year term.⁵ A Patent Public Advisory Committee and a Trademark Public Advisory Committee is being established to advise the Director on agency policies, goals, performance, budgets, and user fees. These administrative changes are believed to increase the autonomy of the USPTO and to make it less subject to political pressures.

II. PUBLICATION OF PENDING U.S. APPLICATIONS

The following provisions will be effective November 29, 2000.

A. Publication: 35 USC 122

Until the Act, pending U.S. applications were „kept in confidence“ by the USPTO under 35 USC 122. Some exceptions applied to this general rule, such as when the applicant authorized a third party to inspect the pending application, when an issued patent referred to a pending application, or when the pending application was a reissue application.⁶

The Act amends 35 USC 122 to provide publication of pending U.S. applications 18 months after their earliest claimed priority date,⁷ thereby matching European, Japanese and PCT publication practices. The publication will most likely be in electronic form to reduce cost and to facilitate searching of publications. Five categories of applications will not be published: (1) abandoned applications, (2) applications subject to a secrecy order, (3) provisional applications, (4) design patent applications, and most importantly (5) applications not filed abroad and requested not to be published.

However, it is important to note that the amendment to the statute does not necessarily open the prosecution of the patent application to the public. In other words, it is unclear whether amendments, arguments and rejections presented after filing the application will be open to the public. At the ABA February meeting, Commissioner Dickinson hinted that the public would not be able to inspect a pending application, but may be able to obtain copies of the papers in the file. He further indicated that the application „as filed“ would be published, with the

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² The full text of the Act can be found on the Internet at <http://www.abanet.org/Intelprop/106legis/s1948doc.doc>.

³ A few of the new provisions are already effective as of November 29, 1999 and March 29, 2000; others will become effective on May 29, 2000; and yet others on November 29, 2000.

⁴ The new published rules can be found at the USPTO web site: www.uspto.gov.

⁵ See § 4713 of the Act amending 35 USC 3.

⁶ See 37 CFR 1.14, and MPEP chapter 100.

⁷ See § 4502 of the Act adding 35 USC 122(b).

possibility for the applicant to request a republication at a later time during prosecution, in order to have any amendment to the application published.

Furthermore, in order to prevent a slowing down of issuance of applications due to their publications, the Act provides that „no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.“⁸

Under the Act, an applicant may request a publication before eighteen months.⁹ As discussed below, early publication may be beneficial to take full advantage of the new provisional rights provisions.

Under the Act, applicants may also request not to publish, but only if the applicant certifies upon filing „that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or a [PCT application], that requires publication of applications 18 months after filing.“¹⁰ Upon subsequently filing a PCT application, or a foreign application, which requires publication of applications 18 months after filing, the Applicant will have 45 days to notify the USPTO of such subsequently filing. „A failure of the applicant to provide such notice . . . shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.“¹¹

The publication of U.S. pending patent applications will have at least four effects:

1. English translations of foreign applications being prosecuted in the U.S. will become available to the public sooner.
2. Published U.S. applications will become 35 USC 102(e) prior art which will be easily searchable by USPTO examiners.
3. Published U.S. applications will facilitate USPTO examiners' interference searches.
4. Published U.S. applications will put inventors and assignees on notice of another's application containing interfering claims.

The last two effects should combine to increase the number of interferences declared in the USPTO.

B. Provisional Rights for Published Claims: 35 USC §154

A US patentee can be compensated for the infringement of his claimed invention by obtaining „damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and cost as fixed by the court.“¹² Prior to the Act, the reasonable royalties could only be calculated back to the

issue date of the patent. However, the Act now provides that „a patent shall include the right to obtain a reasonable royalty from any person who . . . makes, uses, offers to sell, sells, or imports in the United States“ the invention as claimed in the published application (either US national or PCT application), „during the period beginning on the date of publication of the application . . . and ending on the date the patent is issued,“¹³ if the infringer had actual notice of the published patent application.

Unfortunately, the provisional right statute raises a number of unanswered questions. For example, it does not define „actual notice.“ Thus, it is unclear, whether „actual notice“ means a simple notice of publication, or whether the notice must also include an identification of the alleged infringing products, with an explanation of how these products read on the published claims? The expression „actual notice“ is already used in the context of limitation on damages,¹⁴ where damages for unmarked products are calculated back to the date the infringer was given „actual notice.“ The CAFC has interpreted „actual notice“ in this context as requiring that „the recipient is informed [by the patentee] of the identity of the patent and the activity that is believed to be an infringement, accompanied by a proposal to abate the infringement, whether by license or otherwise.“¹⁵ It is therefore likely that the „actual notice“ for provisional rights be interpreted as including similar requirements.

Furthermore, when a PCT application, filed in a language other than English, is the basis for the provisional rights, the Act requires that the person subject to the provisional right must have „had“ an English translation of the PCT application.¹⁶ However, the Act does not specify whether the period of royalties depends on the date at which the alleged infringer „has“ the translation, nor whether the translation must be supplied by the patentee.

The Act further specifies that the above provisional rights „shall not be available . . . unless the invention as claimed in the patent is substantially identical to the invention as claimed in the published patent application.“¹⁷ The interpretation of the expression „substantially identical“ is likely to be debated. Possibly, the same criteria will be used as those used in determining whether reissued, or reexamined, claims are „substantially identical“ to originally issued claims when addressing the question of intervening right.^{18, 19} Specifically, the CAFC has held that „[t]o determine whether a claim change is substantive it is necessary to analyze the claims

8 § 4502 of the Act adding 35 USC 122(c).

9 § 4502 of the Act adding 35 USC 122(b).

10 § 4502 of the Act adding 35 USC 122(b)(2)(B)(i). Note that it is unclear whether this provision would apply to inventions disclosed in a foreign country where publication would be required after a period different from 18 months.

11 § 4502 of the Act adding 35 USC 122(b)(2)(B)(iii).

12 35 USC 284.

13 §4504 of the Act adding 35 USC 154(d).

14 See 35 U.S.C. § 287(a).

15 SRI International Inc. v. Advanced Technological, 127 F3d 1462, 1470, 44 USPQ2d 1422, 1428 (Fed. Cir. 1997).

16 §4504 of the Act adding 35 USC 154(d)(1)(B).

17 §4504 of the Act adding 35 USC 154(d)(2).

18 §4507 of the Act amending 35 USC 252 by changing „identical“ to „substantially identical.“

19 Under 35 U.S.C. § 252 and 307(b) an accused infringer may be entitled to „intervening rights“ that limit the patentee's right to exclude others from performing certain activities that did not infringe the original claims, but that do infringe the reissued, or reexamined, claims.

of the original and the reexamined patents in light of the particular facts, including the prior art, the prosecution history, other claims, and any other pertinent information."²⁰ In general, a claim change made in order to clarify the claim is less likely to be held substantial compared to a change made in order to overcome a rejection based on prior art. However, there is no per se rule and the courts will perform a case by case analysis of what constitutes a substantial change.

It seems clear, however, that provisional rights will be lost if the claims are substantially amended between the publication of the application and the issuance of the patent. Consequently, it may be beneficial to either 1) file claims already complying with U.S. claim drafting practice and having a wide range of scope, or 2) request a re-publication of the application every time the claims are substantially amended. In particular, for foreign applicants filing translations of foreign applications, revising their claims by a U.S. practitioner before filing in the USPTO might avoid having to re-publish the application. By waiting until prosecution is started to revise the claims, applicants take a chance that a court will later find the issued claims substantially different from the published claims. Furthermore, it is expected that the re-publishing of application will be expensive.

The new provisional rights provision may motivate certain applicants to publish as soon as possible, before the 18 month date of the earliest filing date, as provided in amended 35 USC 122(b)(1). For example, an inventor foreseeing that her Internet related invention will be obsolete by the time the USPTO issues her patent, may chose to publish early so as to potentially increase the amount of royalty to which the inventor may be entitled. Therefore, for rapidly evolving technology, it may be beneficial to file a request to publish at the earliest possible time.

Finally, 35 USC 154(d)(3) provides that reasonable royalty under the provisional right provision is only available in an action brought not later than 6 years after the patent is issued.

C. Claiming Priority: 35 USC §§119 and 120

Prior to the Act, claiming priority under 35 USC §§119 and 120 could be performed at any time during pendency of the application. However, under the Act, since the priority date must be known in advance for the date of publication to be set, 35 USC §§119 and 120 are amended to give the USPTO the authority to require applicants to „timely“ claim priority.²¹

1. Claiming Foreign Priority: 35 USC §119

With respect to claiming foreign priority, 35 USC §119 is amended so that the certified copy of the priority document is no longer required. However, the „Director may require a certified copy of the original foreign application . . . and . . . a translation if not in the English language.“²²

20 *Laitram Corp. v. NEC Corp.*, 952 F2d 1357, 1362-3, 21 USPQ2d 1276, 1280 (Fed. Cir. 1991).

21 § 4503 of the Act amending 35 USC §§119 and 120.

22 § 4503 of the Act adding 35 USC §119(b)(3).

This differs from the older practice where a claim and a certified copy of the priority document were needed to claim priority. This change thus may lighten the burden on foreign applicants of having to file the certified copy of the priority document at the time of claiming priority.

On the other hand, the Act provides that the „Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim.“²³ It is unclear at this time what the Director will consider „timely,“ but presumably no later than within 18 month of the priority date, so that the application may be published at the 18 month date. In order to avoid any waiver of the right to claim priority, priority should preferably be claimed when filing the application in the USPTO.

2. Claiming Domestic Priority: 35 USC §§119(e) and 120

The amendments to 35 USC §§119(e) and 120 provide that the Director may set a time limit on claiming priority under these sections. Failure to meet such time limit would result in a „waiver“ of any benefit under these section, although the failure may be curable via petition.

It is unclear whether the statutory amendments of 35 USC §§119 and 120 would preclude a patentee from filing a reissue application for the purpose of correcting the failure to claim priority for the issued patent. In a number of cases, the failure to claim priority has been considered an error correctable through reissue applications.²⁴ The new statute could open the door for a reinterpretations by the courts of whether a „waiver“ of a claim to priority is an „error“ under 35 U.S.C. § 251, and thus correctable by reissue.

III. CHANGES TO THE DEFINITIONS OF PRIOR ART

A. Changes to 35 USC 102(e)²⁵

The effective date of this provision is November 29, 2000. 35 USC 102(e) is amended to provide prior art effect both to U.S. patents (35 USC 102(e)(2)) and published U.S. applications (35 USC 102(e)(1)), as discussed below.

Prior to the Act, 35 USC 102(e) defined the earliest date at which a U.S. patent became effective prior art. A U.S. patent thus became an offensive tool against competitors' U.S. patent applications as of the patent's 35 U.S.C. § 102(e) date (the „102(e) date“). As noted

23 § 4503 of the Act adding 35 USC §119(b)(2).

24 See MPEP 1402 stating that „[t]he most common bases for filling a reissue application are: . . . applicant failed to or incorrectly claimed foreign priority; and . . . applicant failed to make reference to or incorrectly made reference to prior copending applications.

25 At the ABA meeting of April 28, 2000, entitled „Implementation Perspectives of the USPTO on the American Inventors Protection Act of 1999,“ Mr. Kunin of the USPTO took the position that new 35 U.S.C. §102(e) was flawed, unworkable, and that the section would be further amended by the U.S. Congress. At this time, the authors of this article are not aware of how and when 35 U.S.C. §102(e) would be further amended. The 35 U.S.C. §102(e) analysis presented in this article is based on the text that was approved by the U.S. Congress. The readers are invited to follow any new development on this issue, which could change the article's conclusions.

above, the Act provides for the publication of U.S. pending patent applications. New 35 USC 102(e)(1) defines the 102(e) date of published U.S. applications: except for PCT applications which are discussed in details below, the 102(e) date of published U.S. applications will be the U.S. filing date. However, new 35 USC 102(e) also drastically changes the 102(e) date of patents issued from PCT applications in the U.S. national stage.

First, it is important to note that the Act did not change the 102(e) date of a patent issued from a regular (non-PCT) U.S. application filed under 35 USC 111(a), i.e., the 102(e) date is still *the earliest U.S. filing date*. For example, the 102(e) date of a patent issued from an application claiming foreign priority to a foreign national application is still the U.S. filing date, not the filing date of the foreign application. Consequently, for U.S. patents not linked to PCT applications, the earliest filing date still defines the earliest date at which the U.S. patent becomes prior art under 35 U.S.C. § 102(e). Under the new law, this may not be true for U.S. patents linked to PCT applications, as discussed next.

1. 102(e) date of patents linked to PCT applications, prior to the Act

Prior to the Act, the 102(e) date of a patent issued from a PCT application in the U.S. national stage was the date of entry in the national stage, i.e., the date on which the 35 USC 371(c)(1), (2) and (4) requirements were met („the 371 date“)²⁶. On the other hand, the 102(e) date of a patent issued from a continuation of a PCT application was the PCT application filing date, always earlier than the 371 date. This discrepancy motivated some U.S. applicants to „by-pass“ the national stage by filing a continuation application of a PCT application, thereby obtaining an earlier 102(e) date of their issued patent.

2. 102(e) date of documents linked to PCT applications, after the Act

i. 35 USC 102(e)(1) – Published Applications

New 35 USC 102(e)(1) provides that the publications of 1) U.S. applications and 2) PCT applications published in the English language will be assigned a 102(e) date as of the applications' filing dates. This section precludes assignment of a 102(e) date to a published PCT application filed in a non-English language. Of course, the non-English publication of a PCT application will still be 35 USC 102(a) and (b) prior art as of the publication date. However, the publication date is always later than the PCT application's filing date. Furthermore, the document being in a non-English language might not be properly considered by a U.S. examiner examining another's patent application. It is therefore beneficial under the new law to file all PCT applications in English so as to obtain an early 102(e) date.

ii. 35 USC 102(e)(2) – Patents

New 35 USC 102(e)(2) provides that U.S. patents will be assigned a 102(e) date as of their earliest filing dates (no

change from prior to the Act). New 35 USC 102(e)(2) also states that „a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under [PCT].“ The meaning of the expression „based on“ is ambiguous. It may (probably does) include patents issued from PCT applications in the U.S. national stage, so that the new law seems to preclude assignment of a 102(e) date to any patent issued from a PCT application in the national stage. It is a surprising result of the new law that a U.S. patent may not be assigned a 102(e) date. On the other hand, the expression „based on“ may (probably does not) include patents issued from a national application filed as a continuation application of a PCT application, also called „by-pass“ applications. „Based on“ probably does not include „by-pass“ applications because „by-pass“ applications are regular U.S. applications filed under 35 U.S.C. § 111.

Considering new 35 U.S.C. § 102(e)(1) and (2) together, a non-English PCT application will not produce a document having a 102(e) date.²⁷ Again, this means that the PCT application will become part of the prior art only as a 35 U.S.C. § 102(a) and (b) printed publication, i.e., only as of its date of publication, which will always be later than its filing date.

The new 102(e) date provisions are summarized below.

Type of Document	Assigned 102(e) date
Publication of a U.S. national application	Earliest U.S. filing date
Publication of a U.S. national application claiming priority to a foreign national application	Earliest U.S. filing date
Publication of a foreign national application in any language	No 102(e) date
Publication of a PCT application designating the U.S., filed anywhere in the world and published in English	Filing date of the PCT application
Publication of a PCT application designating the U.S., filed anywhere in the world but not published in English	No 102(e) date
U.S. patent issued from a U.S. national application	Earliest U.S. filing date
U.S. patent issued from a PCT application designating the U.S., in the U.S. national stage (any language)	No 102(e) date
U.S. patent issued from a continuation of PCT application designating the U.S. (by-pass application)	depends on the meaning of „based on“ in 102(e)(2), but possibly earliest U.S. filing date

Recapitulating, a non-English language PCT application will not be assigned a 102(e) date, nor will a patent issued from a PCT application in the U.S. national stage. It seems therefore advantageous to file all PCT applications in the English language, so that they may be assigned the earliest possible 102(e) date, i.e., the filing date of the

²⁶ The 35 USC 371(c)(1), (2) and (4) requirements are (1) payment of a national fee, (2) copy of the international application with an English translation if the PCT application is not in English, and (4) an oath or declaration of the inventors.

²⁷ This does not seem to be a violation of the PCT in view of PCT Article 64.4(a).

PCT application, thereby becoming prior art against competitors' patent applications at the earliest possible date.

If filing the PCT application in the English language is not possible, then it may be beneficial to file a „by-pass“ application so as to obtain a 102(e) date, for the application and (possibly) the patent, as of the filing date of the „by-pass“ application.

There are other good reasons to file „by-pass“ applications: filing „by-pass“ applications may avoid the dangers of 35 U.S.C. § 375(b), which limits the enforceability of a patent granted on a PCT application not originally filed in the English language and having a scope enlarged due to an error in translation. For PCT applications filed in languages difficult to translate literally (e.g. Japanese), 35 U.S.C. § 375(b) raises serious questions as to the scope of the claims granted on any U.S. patent. The „by-pass“ application being a regular U.S. national application, a patent issued from a by-pass application should not fall under 35 U.S.C. § 375(b). Furthermore, „by-pass“ applications do not have to be literally translated, instead the application may be fully revised by a U.S. practitioner prior to its filing, so as to comply better with U.S. patent practice. In many cases, such revisions shorten the prosecution and thus lengthen the enforceable term of the patent. In addition, a revision prior to filing may reduce the number and importance of claim amendments required during prosecution, and may thus avoid unnecessary prosecution history estoppel.²⁸ Finally, as discussed above, revisions may also preserve the newly created provisional rights.

B. Changes to 35 USC 103(c)

The amendment of 35 USC 103(c) is significant: new 35 USC 103(c) explicitly excludes obvious variations of 35 USC 102(e) prior art, owned by, or under an obligation to be assigned to, the same person, for purposes of obviousness determinations. In other words, claims of an application may no longer be rejected as being obvious over a 35 USC 102(e) assigned to the same person/company to which the application is assigned. Prior to the Act, only 35 USC 102(f) and (g) prior art owned by, or under an obligation to be assigned to, the same person/company was excluded from obviousness prior art. Now, all three types of prior art (102(e), (f) and (g)) are excluded. New 35 USC 103(c) should favor large companies and research teams that often see their own patents applied as prior art against their pending applications.²⁹

The new 35 USC 103(c) provision applies to any application filed on or after November 29, 1999. Consequently, it may be advantageous to re-file pending applications, e.g., by filing a Continued Prosecution Application (CPA), so as to benefit from new 35 USC

103(c). If a patent has already issued, but a descendant application is still pending, a new continuation application may be filed with slightly different claims to avoid a 35 U.S.C. § 101 (same invention type) double patenting rejection.³⁰ The new continuation application will benefit from the new law and the patent issued from the continuation should be safe from an invalidity finding based on an obviousness argument relying on commonly owned/assigned 102(e) prior art.

Before re-filing an application, one should always take into consideration the patent term, which may be significantly affected by the re-filing. For example, if the application was filed before June 8, 1995, filing a CPA would set the end of the patent term 20 years from the earliest US priority filing date, instead of 17 years from issue.

C. Changes to 35 USC 135(b)

The Act rewrite 35 USC 135(b) as 35 USC 135(b)(1). This provision prevents applicants from claiming the same or substantially the same subject matter as claimed in an issued patent, unless the claim is made prior to one year from the issue date of the patent. In general, this provision protects patentees by reducing the likelihood that a patent will be drawn into an interference more than one year after issue of the patent. Note, however, that a patent may still become part of an interference after the first anniversary of the issue date under certain circumstances. For example, claims are presented in an application within one year of the issue date of the patent, but prosecution delays in the USPTO prevent the interference from being declared for several years.

The Act also adds new 35 USC 135(b)(2), effective November 29, 2000, in order to prevent applicants from claiming the same or substantially the same subject matter as claimed in a published application, unless the claim is filed prior to one year from the publication date. The new provision will have the effect of substantially advancing in time (from one year post issuance to one year post publication) the requirement to file a claim to „the same or substantially the same subject matter“ in order to avoid the claim bar. As a result, more application-application interferences are expected to be declared, instead of patent-application interferences or patent-patent actions under 35 USC 291.

IV. OPTIONAL INTER-PARTES REEXAMINATIONS – 35 USC 311

The following new provisions apply to „any patent that issues from an original application filed in the United States on or after [November 29, 1999].“³¹ Presumably, these provisions also apply to U.S. patents issued from PCT applications in the U.S. national stage and having an effective U.S. filing date which is on or after November 29, 1999.

28 Under *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 117 S. Ct. 1040, 1051 (1997), a claim amendment is presumed to create prosecution history estoppel barring the applicability of the doctrine of equivalents to the amended claim element, thereby reducing the maximum enforceable scope of the amended claim.

29 It is important to keep in mind that commonly assigned/owned 35 USC 102(e) prior art still applies for lack of novelty purposes, i.e. for rejections under 35 U.S.C. § 102(e).

30 An obviousness type double patenting rejection may apply, however such rejection can easily be overcome by filing a terminal disclaimer.

31 § 4608 of the Act.

A reexamination is a procedure in the USPTO, requested either by a patent owner, a third party or the USPTO, that provides for the re-examination of an issued patent. Reexaminations are reserved for cases where one or more patents or printed publications raise a substantial new question of patentability. In other words, only new issues of novelty under 35 USC 102 and obviousness under 35 USC 103, raised by prior art patents and publications, may be re-examined in a reexamination. A request for reexamination is not granted to resolve issues not raised by printed references, e.g. on sale or public use bars, inequitable conduct, or typographical errors in the patent.

Typically, a patent owner requests a reexamination when he/she becomes aware of a prior art printed reference, not considered during the prosecution of the patent and that raises a substantial new question of patentability of the claims. Instead of launching into an expensive litigation, with patent claims potentially invalid by the newly discovered reference, the patent owner decides to let the USPTO reexamine the claims and hopefully issue a certificate confirming patentability. A patent that successfully survives a reexamination usually carries an increased presumption of validity during litigation because the examiners of the USPTO, experts in the field, determined that the claims were patentable, despite consideration of the new prior art.

On the other hand, a third party may also be interested in having a patent re-examined based on a newly discovered prior art reference. Again, the idea being that resolving issues through a reexamination procedure costs a lot less than resolving them through litigation. Furthermore, if the argument for invalidity based on the new reference are rather technical, then it may be better to have the technically trained examiners of the USPTO review the case, instead of a judge or jury.

Prior to the Act, however, third parties were discouraged from filing reexaminations because the reexaminations were conducted „ex-parte“, i.e., the third party is excluded from the procedure taking place between the USPTO and the patentee. After the initial request for reexamination, the third party in an ex-parte reexamination has almost no opportunity to reply to the patentee's arguments in support of patentability of his/her claims in view of the new printed reference.³²

The Act provides the third party requester the option to either request an ex-parte reexamination,³³ or request an „inter partes“ reexamination in which the third party can participate in the reexamination procedure. The new provisions, provided in new 35 USC §§ 311-318, were added to reduce the amount of litigation in the US courts and to make the reexamination procedure a more viable

alternative to litigation. The new provisions also brings U.S. law a step closer to European patent practice, as inter-partes reexamination resembles the European opposition procedure, although with some important differences, as discussed next.

A. Third Party participation

Under the Act, any person can file a request for inter partes reexamination.³⁴ In an inter partes reexamination, the third-party requester stays informed of the status of the procedure because the Act requests that the patentee and the third party requestor serve a copy on the other party of every paper each files in the reexamination and that the USPTO send a copy of every communication with the patentee to the third party requestor. The Act also permits a more active third-party participation by specifying that „[e]ach time that the patent owner files a response to an action on the merits from the [USPTO], the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto.“ However, the third party requester must file the „written comments“ within 30 days. In other words, the third party requester must be ready to respond quickly to the patent owner arguments and amendments. Before filing the request, the third party should therefore try to anticipate the patent owner's future response and prepare any evidence, such as a technical expert's affidavit, or at least brief the expert so that he may draft an affidavit within a short time.

It is not clear yet whether the patentee or the third party requester will have the opportunity to interview the examiner in an inter partes reexamination. The explicit wording of „written comments,“ the deleting of proposed provisions including the right to participate in interviews during the legislative history of the Act, and the practical difficulties associated with holding interview with opposite parties, may convince the USPTO to not allow third party interviews.

Contrary to the situation in ex parte reexaminations, the third party requester in an inter partes reexamination has the option of appealing the case to the Board of Patent Appeals and Interferences. However, the third party requester may not appeal the Board's decision. On the other hand, the patentee may appeal the Examiner's decision to the Board and the Board's decision to the U.S. Court of Appeals for the Federal Circuit (CAFC). If the patentee appeals to the Board, the third party requester may participate in the appeal. However, if the patentee appeals to the CAFC, the new laws do not permit the third party to participate.

B. Estoppel Effects

In ex parte reexaminations, third party requesters may stay anonymous. However, in inter partes reexaminations, the identity of the third parties requester must be identified.

32 The third party can file a „Reply by Requester“ if and only if the patentee files a „Patent Owner's Statement“ pointing out why the patent claims are patentable. Such „Patent Owner's Statement,“ which must be filed after the reexamination is ordered, are however discouraged because they trigger a third-party's opportunity to reply. Instead, the patentee involved in an ex parte reexamination is better off waiting for the first Office Action and presenting arguments of patentability in a „Response“, so as excludes the third party from participating.

33 See 35 USC 302.

34 See §4604 adding 35 USC 311.

The Act provides for three different estoppels against an inter partes third party requester.³⁵ First, an inter partes requester „is estopped from asserting at a later time, in any civil action ..., the invalidity of any claim finally determined to be valid and patentable on any ground which the third party requester raised *or could have raised* during the inter partes reexamination proceedings.“³⁶

Second, an inter partes third party requester is also estopped from raising issues raised, *or that could have been raised*, in a civil action, or in a previous inter partes reexamination, sustaining the validity of the patent claims.³⁷ These first two estoppels do not apply however to invalidity arguments based on „newly discovered prior art unavailable to the third party and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.“ The meaning of „unavailable“ is not clear and is likely to generate litigation. It is clear however that if a third party requester is in possession of a reference, that reference is available to the third party. Consequently, third party requesters should not request an inter partes reexamination based on one reference and keep a second reference for future use. Under the new law, the third party requester will be estopped from later raising issues of novelty or obviousness based on the second reference because the third party requester „could have raised these issues“ during the inter partes reexamination. The first two estoppels also do not apply to invalidity arguments that cannot be raised in reexamination such as inequitable conduct, lack of enablement, failure to disclose the best mode, or prior use or sale.

The third estoppel provision states that „[a]ny party who request an inter partes reexamination ... is estopped from challenging at a later time, in any civil action, any fact determined during the process of such reexamination, except with respect to a fact determination later proved to be erroneous based on information unavailable at the time of the inter partes reexamination decision.“³⁸

These estoppel provisions will surely discourage parties from filing inter partes reexaminations, at least until the courts clarify how strictly the estoppels provisions will be applied. Inter partes reexamination could however become a popular tool for entities who do not expect to go to litigation, either because the parties involved cannot afford the cost of litigation, or because the damages at stake do not warrant the cost of litigation. In addition, if a third party is confident that a newly discovered reference invalidates the patent claims, but the arguments are highly technical, then the third party may prefer the technically oriented forum of the USPTO to make its case. Finally, the third party requester only has to convince the examiner that the patent is invalid by a „preponderance of the evidence.“ On the other hand, in litigation a patent carries a presumption of

validity, so that the accused infringer has to convince the trier of facts (judge or jury) that the patent is invalid „by clear and convincing evidence,“ which is a higher standard of proof to meet than the „preponderance of the evidence“ standard. The advantages of filing an inter partes reexamination must therefore be measured on a case by case basis, and will strongly depend on the implementation of the Act by future court decisions and the USPTO new rules. In that respect, the Act requires the USPTO Director to submit a report to the US Congress within five years evaluating whether inter partes reexamination is „inequitable to any of the parties in interest“ and, if appropriate, containing recommendations for changes in the procedures mandated by the Act.

V. PATENT TERM GUARANTEES

The Act provides for a number of „patent term guarantees“ by providing patent terms extensions to make up for delays created by the USPTO. Patent term extensions are not new to U.S. patent laws. Section 35 U.S.C. § 154(b) provides for two kinds of extensions: 1) for delays due to interferences and secrecy orders, and 2) delays due to successful appeals to the Board of Appeals and Interferences (the „Board“). Effective May 29, 2000, new 35 U.S.C. § 154(b)(1) will provide applicants three patent term guarantees: 1) the „Prompt Response“ guarantee, 2) the guarantee of no more than a three year pendency of patent applications, and 3) the guarantee of adjustment for delays resulting from interferences, secrecy orders and successful appellate review.

- 1) The „Prompt Response“ provision guarantees the following:
 - a) The USPTO will mail a rejection, objection, restriction or an allowance within **14 month** from the U.S. filing date, i.e. the filing date under 111(a) or the date of entry in the U.S. national stage.
 - b) The USPTO will respond to an applicant's reply to an Office Action withing **4 month**. This presumably includes an Examiner's response to an appeal brief filed at the Board.
 - c) The USPTO will act within **4 month** after a decision from the Board or from a federal court in cases in which allowable claims remain in the application.
 - d) The USPTO will issue a patent within **4 month** of the date on which the issue fee was paid.
- 2) The „three year pendency“ provision guarantees that the issuance of an original patent (i.e., not a reissue patent) will not be delayed more than three years from the „actual“ filing in the United States. However, time consumed by a continued examination of the application, as provided by new 35 U.S.C. § 132(b), will not be included in the three year calculation.³⁹ Furthermore, the three year calculation does not include time occurring during interferences,

35 These estoppel provisions do not apply to ex parte requesters.

36 §4604 of the Act adding 35 USC 315(c) (emphasis added).

37 See §4604 of the Act adding 35 USC 317(b) (emphasis added).

38 §4607 of the Act.

39 We note that Mr. Kunin of the USPTO indicated that the new continued examination of applications will replace the Continued Prosecution Applications (CPA) as of May 29, 2000.

secrecy orders, or time on appeal to the Board. Finally, and most importantly, the three years will not include any delay in the processing of the application requested by the applicant, unless the applicant can show that, in spite of all due care, the applicant was unable to respond within the non-extended period set by the USPTO. For example, the three year calculation will not include extensions of time obtained by the applicant in order to respond to an Office Action, which usually sets a 3-month non-extended period to respond. Any extension beyond the first three months will thus not be included in the three year calculation. Consequently, most extensions of time obtained to respond to an Office Action will result in a non-recoverable loss of extended patent term.⁴⁰ As noted above, this may be remedied with „a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period.“

- 3) The last guarantee, the „Guarantee or Adjustments for Delays Due to Interferences, Secrecy Orders, and Appeals“ is a similar provision to the old 35 U.S.C. § 154(b) extension provision. However, the new provision leaves out the five year limit on the extension.

The above guarantees are restricted by important limitations listed under new 35 U.S.C. § 154(b)(2). First the total number of days extended cannot, due to overlap of the extension provisions, exceed the actual number of days the issuance of the patent was delayed. However, without the USPTO rules in place, it is somewhat speculative to predict how the exact calculations of term extension will be performed. It is however clear that the new statute provides for the USPTO to be in charge of calculating the term extension for each issued patent and of indicating the calculated term extension on the Notice of Allowance. The applicant will then have the opportunity to challenge the calculation to the USPTO or to the district court of the District of Columbia. A third party may not challenge the term extension calculations, except to a court during a patent infringement action. Finally, no patent shall be extended beyond the expiration date specified in a terminal disclaimer.

Recapitulating, the Act now provides for reasonable adjustments of patent terms due to delays created by the USPTO. However, a patent term extension will generally not be granted for delays created by the applicant. Consequently, it is important to avoid, whenever possible, relying on extension of times when responding to Office Actions. Finally, it is important to review Notices of Allowance carefully to ensure that the patent term extension calculated by the USPTO is accurate. If the term extension is significantly less than the extension to which the applicant is entitled, then it may be beneficial to request a reconsideration of the extension calculation, and if necessary to appeal the USPTO calculation to the U.S. District Court for the District of Columbia.

⁴⁰ Extensions of time may be included in the three year calculation by „a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period,“ (see new 35 U.S.C. § 1154(b)(3)(C)).

VI. THE NEW FIRST INVENTOR'S DEFENSE

In 1998, the U.S. Court of Appeals for the Federal Circuit (CAFC) confirmed unequivocally that inventions related to methods of doing business were eligible subject matter for patent protection.⁴¹ Prior to this ruling, companies sometimes kept methods of doing business as trade secrets. In view of the potential liability highlighted by the 1998 CAFC ruling, a number of companies, especially in the financial services industry, lobbied the U.S. Congress to pass legislation protecting them from expected patent infringement law suits brought against these companies on the basis that they infringe a newly patented business method.⁴² In effect, these companies were asking for a prior user right, well known in Europe. Under prior U.S. law, such prior user rights were unavailable based on the public policy that society benefits more from an invention disclosed in a patent, than from an undisclosed trade secret. A first inventor choosing trade secret protection took the risk that a second inventor might independently develop the same invention, patent it, and then sue the first inventor for infringement. In any event, Congress acquiesced and included new 35 USC 273 providing the so-called „First Inventor Defense,“ for infringement of patent claiming methods of doing business.

New 35 USC 273(b)(1) provides:

(1) in General.— It shall be a defense to an action for infringement under 271 of this title with respect to any subject matter that would otherwise infringe one or more claims for a method in the patent being asserted against a person, if such person had, acting in good faith, actually reduced the subject matter to practice at least 1 year before the effective filing date of such patent, and commercially used the subject matter before the effective filing date of such patent.

Although new 35 USC 273(a) defines „method“ as „a method of doing or conducting business,“ it is not clear if this new defense will be available for all methods, e.g., a method of manufacturing a semiconductor device. Furthermore, although 35 USC 273(b)(1) refers to „claims for a method“, it is unclear whether the defense can only be used for a method claim infringement, or can it also be used for a system claim directed to a system for performing a method of doing business. Until judicial decisions clarify this issue, applicants should thus include in their applications for protecting methods of doing business both method claims and system claims. An accused infringer may not be able to successfully assert a 35 USC 273 defense with respect to the system claims.

As another drafting strategy, it is probably wiser to avoid labeling inventions as method of doing business in patent applications. First, such labeling would be evidence that the new prior inventor defense is available to an accused infringer. Second, the application may also disclose a system, which is not a method of doing

⁴¹ *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 851 (1999).

⁴² The companies' fears may have been well founded, to the extent that U.S. patent practitioners have witnessed an explosion in the number of patent applications for inventions related to method of doing business.

business. Third, such labeling might be evidence against the patentability of an invention, or the validity of a patent, in a country where method of doing business are not patentable. Fourth, controversy still exists in the U.S. regarding the patentability of these inventions, so that pressures might lead to another change in the law affecting that patentability.

Several limitations of the defense are listed in new 35 USC 273(b). For example, a successful defense with respect to some claims of the patent does not create a general license under all claims of the patent.⁴³ Furthermore, the defense may not be licensed or assigned or transferred „except as an ancillary and subordinate part of a good faith assignment or transfer for other reasons of the entire enterprise or line of business to which the defense relates.“⁴⁴ In addition, if a court finds that the defense was asserted without „a reasonable basis,“ the infringer may be held liable for attorney's fees under 35 USC 285.

The new „First Inventor Defense“ will be an interesting issue to follow over the next few years. Will the courts construe 35 USC 273 narrowly and view the new defense as an ad hoc solution to a temporary problem, which was politically motivated, and which is inconsistent with the overall U.S. patent system; or will the courts use 35 USC 273 as a seed to expand on prior usage rights?

VII. CONCLUSIONS

The „American Inventor Protection Act of 1999“ is going to substantially change U.S. patent practice. Until the USPTO publishes its new rules and the CAFC provide clarifying decisions, the exact nature and extent of the changes will be somewhat uncertain. However, a number of general strategies are already warranted by the new law:

- Minimize amendments to the claims during prosecution by revising claims prior to filing and by including claims with a broad range of scope, thereby preserving provisional rights and reducing prosecution history estoppels.
- Consider requesting early publication of applications to maximize benefits under the provisional rights provisions.
- Claim priority at the time of filing to avoid waiving the right to priority.
- File PCT applications in the English language to obtain a favorable 102(e) date.
- If filing PCT applications in the English language is not possible, then consider filing „by-pass“ applications instead of entering the U.S. national stage, so as to obtain a 102(e) date as of the filing date of the „by-pass“ application for the application and (possibly) the patent.
- Consider re-filing applications to exclude from the prior art any obvious variations of commonly owned 102(e) prior art.
- Consider inter-partes reexaminations to avoid costly litigation and prevail on highly technical arguments, while considering the estoppel effects of this procedure.
- Avoid obtaining extensions of time and respond to Office Actions within the non-extended period to maximize patent term extensions.
- Verify the USPTO term extension calculation shown on Notices of Allowance, and challenge incorrect calculations.
- Avoid labeling inventions as „methods of doing business.“
- Include method claims and system claims for invention directed to methods so as to potentially preclude a prior user defense to liability.

epoline project

Introduction

D. Speiser (DE)

On 16 July 1999 the EPO had arranged a hearing in Munich on their epoline project. Since it was felt that a substantial part of the hearing was related with matters of relatively little interest for the users President Holzer had arranged with the EPO a joint *epi*/EPO meeting to deal with the epoline project. The meeting took place on 23 November 1999 in Munich. This meeting was constructive and many views could be exchanged between

the *epi* on the one hand and the responsible officials on the other hand.

The EPO distributed at the meeting a number of Mini-CD-ROMS containing an animated on screen presentation of the EPOLINE project. It was proposed by President Holzer that the EPO obtains copies of these Mini-CDs for distribution among all *epi* members and a copy of the latest version is attached to this issue of *epi* Information.

⁴³ §4302 of the Act adding 35 USC 273(b)(3)(C).

⁴⁴ §4302 of the Act adding 35 USC 273(b)(6).

Prior even to the epoline hearing the EASY Committee had suggested to the EPO some twenty names of *epi* members to form a pilot group for testing on-line filing of applications. Following a proposal of the EASY Committee the EPO had subsequently sent out groups of persons of the EPO to the potential members of the pilot group to study their possibilities and their demands. At the joint *epi*/EPO meeting on 23 November 1999 the EPO provided a report on the visits to the potential members of the pilot group and reported in particular that all the *epi* members visited had shown a keen interest in the participation of the project.

The joint *epi*/EPO meeting was closed with the mutual assurance that a follow up meeting would be arranged sometime in mid 2000.

Following the joint meeting the EPO again visited members of the pilot group to install the latest version of the EASY software, now called Set-EASY with the prefix SET meaning „Secure Electronic Transmission“. In some places the installation of the software turned out to be difficult and we learned that a further version of the software would be available in early 2000 which software would then overcome the problem. At the same time the EPO informed their hosts on the possibility of testing the newly opened service of online file inspections. The access was restricted to the public files of those applications which were filed after 1 January 1998.

Tests subsequently made with inspections of relatively small files (approximately 100 pages) revealed that the inspection including downloading of the 100 pages using a fast ISDN-line required about one hour.

Having been asked by the EPO at the joint *epi*/EPO meeting, the EASY Committee provided the EPO with a set of names different from those of the pilot group to form a group of test users for the on-line file inspection. The names were forwarded to the EPO at the end of January and it remains to be seen what the reaction of the test users in general and with respect to user friendliness of the software will be.

Meanwhile the EPO commenced a beta test with their Internet access to the EPO Register of Patents. First inspections of the Register using the Internet access were successful and promising.

Shortly before the spring Council meeting of the *epi* the EPO issued a paper on its epoline project providing interesting information on various details of the project. For the first time the paper mentions the setting up of „epoline Customer Services“, a service of the Office for users of the European patent system having questions about the project or having problems with one or the other of the EPO online services. This recent paper of the EPO will answer many questions of our membership. It is printed hereafter.

epoline® : state of the art communication and transaction for the European intellectual property community

M. Lanier, Head of Communications *epoline* (EPO)
A.J. van Putten, Manager Customer and Technical Support RSS (EPO)

Management summary

The EPO has launched a new strategic initiative, called *epoline*®, which will transform the way the EPO does business. The objective of *epoline*® is to move the EPO away from doing business in paper form towards doing all patent related business via the Internet. As part of this, the EPO is setting up the necessary trusted security environment so that customers can be assured of the confidentiality, the authenticity, the integrity, the non-repudiation and the accountability of any transaction. The priorities for the initial developments under *epoline*® are on-line filing, on-line file inspection, on-line register, on-line search report dispatch and on-line fee payment.

With the launch of *epoline*® Customer Services, the organisation aims to further improve the overall service offered by the EPO and to support the various *epoline*® products and services. This customer contact centre will be your first port of call for all patent-procedure enquiries.

Introduction

The European Patent Office is in the business of establishing state of the art. *epoline*® is the range of products and services of the European Patent Office providing a means of communication and transaction which is itself state of the art, using the latest in Internet technology. The use of Internet-based products paves the way for a faster, more efficient and personalised interaction with the EPO.

Bridging the gap

Traditionally, the interface between the European Patent Office and the intellectual property community has been largely paper-based. Documents are typed on computers at the applicants' or attorneys' offices. These are then printed and submitted. On receipt at the European Patent Office, these are either re-typed or scanned and re-entered into the European Patent Office's computer

system. The use of an Internet interface eliminates the interim paper step, allowing the generating and receiving computer systems to connect directly and thereby reduces the administration that is required to prepare, print and post documentation. In addition there is reduced margin for error as information is only entered once.

Advantages and benefits

The advantages to the intellectual property community in using the *epoline*® products are clear: time and efficiency and the cost reductions associated with improvements in both. In addition all *epoline*® products are free so where an electronic product replaces a fee-paying service there will be direct financial benefits to applicants and attorneys.

Taking the example of a request for a file inspection, in the present paper based system, a request for a file can take 2 weeks, involves administration for making the request and requires additional administration on receipt of the dossier, namely sorting of the relevant documents. On-line file inspection allows you to access the required file directly, then download and print the relevant sections. This means an immediate saving of 2 weeks' waiting time as well as reduced administration. In this example there is an additional saving of the administration fee and fee per page required for paper file requests.

Products and services

The following products and services are currently under development:

1. On-line filing

The full integration of the EASY client software into the *epoline*® server and security environment has now been completed. A key benefit from the user's point of view will be that acknowledgement will be instant with time, date and application number.

Internal testing is currently being carried out and the setting up of the public key environment (PKI) to support the initial external tests is under development. In addition, preparation for the legal framework to allow legally valid on-line filings is well under way. External user tests are expected to run in the second half of 2000.

2. On-line file inspection

This product provides access via the Internet to the public part of the published applications present in the EPO's PHOENIX document management system. Users can view the images of any public document from published applications as well as download documents in PDF format for later viewing or printing. By Q2 2001, when the back-file scanning for PHOENIX is complete, this service will cover all files processed by the EPO. External pilot testing of this service will be starting in the coming weeks.

3. On-line register

The access to the Patent Register, currently only available via our X25 service, will be made available via the Internet. This new service, which will be free of charge, is currently being tested by a limited group of applicants and representatives. Following a positive outcome of this limited test, the service will be gradually rolled out to a larger audience.

4. On-line search report dispatch

Using the public key environment currently being set up for the on-line filing services, it will be possible to create mailboxes which can be accessed by authorised users only. In one instance of this new service, the EPO will dispatch the search report in electronic form to the applicants' or representatives' mailbox, ready for collection by the authorised user. A prototype of this service has been developed.

5. On-line fee payment

A prototype for the replacement of form 1010 has been developed. During 2000, development of further services in this area is planned including credit card payments as well as warnings of outstanding and future payments.

Transaction security

For secure transactions, for example on-line filing, a smart card system is envisaged where authorised users can open up a secure session with the European Patent Office by way of a smart card inserted into a smart card reader. The principle is similar to a bank card with a pin code where the correct pin code in combination with the certificate within the card assures identification of the user. Security of transaction is the primary focus and the encryption and systems put in place will assure customers of confidentiality, authenticity, integrity, non-repudiation and accountability.

Market research

Being fully aware that computer infrastructures already exist at the applicants' end as well as at the EPO, the *epoline*® philosophy is to support platforms and software that are already in use, making access to the *epoline*® range of products as democratic as possible. Supporting this strategy, recent results of a study of 400 applicants and attorneys across Europe showed that the use of Internet was already very much part of the work culture:

- Do you have an Internet connection available at your desk 83%yes
- Do you use the Internet for business? 87%yes
- In what context?
 - Searching 79%yes
 - Communication client & Patent Office 36%yes

This research project is a first step in the implementation of the *epoline*® philosophy, which aims to be a service to the intellectual property community, developing prod-

ucts that are both relevant and desirable to the user community. To do this a clear understanding of the way applicants and attorneys do their business with the European Patent Office is essential. To achieve this more 'customer focussed' objective, the European Patent Office is commissioning further research in all member states to establish which additional *epoline*® products will improve the service of the European Patent Office to its users.

***epoline*® Customer Services**

A continuation of the philosophy of 'customer focus', is the recent launch of *epoline*® Customer Services, providing one single point of contact for users for all *epoline*® queries within the European Patent Office. In addition, extensive training for new users will be coordinated through Customer Services. Such training will

be provided on-line as well as in the form of personal group training.

As with all e-business, the nerve centre will be the web site from where customers will be able to use *epoline*® products and services, find the latest information on patenting and obtain help in using the products and services. The objective for the longer term is to develop the *epoline*® interface so that users can personalise it („my *epoline*®“) to such an extent that they can view their choice of applications on line and be immediately informed of any change in procedural status or communication as it occurs.

For more information contact *epoline*® Customer Services on

E-mail **epoline@epo.org**

Tel. +31 70 340 4500

Fax. +31 70 340 4600

Or visit the web site **www.epoline.org**

Further information on the *epoline*® project can be found on the CD-ROM provided with this issue of *epi* Information.

epi looks for tutors

Der *epi*-Ausschuss für berufliche Qualifikation sucht Tutoren aus Dänemark, Finnland, Schweden und Frankreich für die *epi*-Tutorien zur Vorbereitung auf die Europäische Eignungsprüfung.

Alle *epi*-Mitglieder, die zur Mitarbeit bereit sind, werden gebeten, sich an das *epi*-Sekretariat zu wenden.

The *epi* Professional Qualifications Committee is looking for tutors from Denmark, Finland, Sweden and France for the *epi* tutorials preparing for the European Qualifying Examination.

All *epi* members willing to collaborate are requested to contact the *epi* Secretariat.

La Commission de Qualification Professionnelle de l'*epi* recherche des tuteurs au Danemark, en Finlande, en Suède et en France pour le tutorat de l'*epi* préparant à l'examen de qualification.

Les membres de l'*epi* intéressés sont invités à se mettre en rapport avec le Secrétariat de l'*epi*.

epi-Sekretariat

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e-mail: info@patentepi.com

European Patent Office (EPO) – epi – Deutsche Patentanwaltskammer (PAK)**Symposium**

Topic: „Oral Hearings within the education and training of
European Patent Attorneys“
(How to master Rules of Procedure)

Thursday, October 26, 2000

European Patent Office, Munich

The invitation extends to European Patent Attorneys, Trainees, Students of *epi*

No registration fee, simultaneous translation into the three official languages

Programme

- 14.00 Opening Address
Lise DYBDAHL (EPO) : *The Patent Attorney in Court*
- 14.10 Ingwer KOCH (EPO) : *Oral Proceedings and training therefor at the EPO in practice*
- 14.30 Susanne KAMINSKI (*epi*) : *How to satisfy training demands by the Professional Qualification Committee of epi*
- 14.50 Discussion
- 15.20 Coffee break
- 15.50 Francesco MACCHETTA (*epi*), Patrice VIDON (*epi*) :
Practical experiences of European Patent Attorneys in industry and private practice
- 16.30 Heiner LICHTI (PAK)
The oral hearing within education and professional practice of the German Patent Attorney
- 16.50 Uwe DREISS (PAK)
Further developments toward representation before courts
- 17.20 Discussion
- 17.50 Closing remarks
Walter HOLZER (*epi*)
- 18.00 Reception offered by the *epi*

! Please mark your diary !

Please visit our websites for news !

www.patentepi.com

Das *epi*-Extranet ist einsatzbereit und wartet auf Benutzer

Das *epi*-Extranet ermöglicht es, Nachrichten (News, interessante Informationen, Anfragen) allen anderen Usern des Extranets zugänglich zu machen. In diese Nachrichten können nur registrierte User des *epi*-Extranets Einsicht nehmen.

Die Homepage des *epi*-Extranets (siehe Bild) verfügt über folgende Bereiche:

1. Server statistics for patentepi.com:

Hier können Sie die Abrufzahlen der einzelnen Webseiten unserer Homepage einsehen.

2. Message Board:

Von hier aus können Sie Ihre Nachrichten für die anderen User des *epi*-Extranets hinterlassen.

3. Message Board (Administration):

Die Verwaltung obliegt dem *epi*-Sekretariat, wo auch für ein Entfernen unaktuell gewordener Nachrichten Sorge getragen wird.

4. Mailinglist (Verwaltung):

Hier können Sie sich als Empfänger der *epi*-Mailinglist eintragen, aber auch wieder löschen.

5. Mailing verfassen:

Hier können Sie Ihre Mailings verfassen und versenden. Mailings werden automatisch als E-Mail an sämtliche anderen Teilnehmer in der *epi*-Mailinglist versandt.

Wenn Sie daran interessiert sind, Benutzer des *epi*-Extranets zu werden, schicken Sie bitte eine kurze E-Mail an das *epi*-Sekretariat (info@patentepi.com). Sie erhalten umgehend eine kurze Anweisung und das für die Registrierung erforderliche Kennwort.

The *epi* Extranet has been set up and is waiting for its users

The *epi*-Extranet allows users to share news, interesting information and enquiries with all other users. Access is limited to registered users only.

The homepage of the *epi*-Extranet (see picture) covers the following areas:

1. Server statistics for patentepi.com:

This option allows you to check the number of visitors to the different sections of our website.

2. Message Board:

Use this option to leave messages for the other users of the *epi*-Extranet.

3. Message Board (administration):

The administration responsibility lies with the *epi*-Secretariat, which also takes responsibility for deleting old information.

4. Mailing list (administration):

This option allows you to register as a member of the *epi*-mailing list or delete such registration.

5. Composition of a Mailing:

Here you can write mailings and send them. Mailings will automatically be sent to all other members on the mailing list.

If you are interested in becoming a user of the *epi*-Extranet, please send a short e-mail to the *epi*-Secretariat (info@patentepi.com) You will get brief instructions for the registration procedure as well as the necessary password.

L'Extranet de l'epi est en place et attend ses utilisateurs

L'Extranet de l'epi donne à ses utilisateurs la possibilité d'échanger des informations (actualité, informations intéressantes, demandes). Son accès est limité aux utilisateurs qui se sont préalablement enregistrés.

La page de l'Extranet de l'epi (voir image) couvre les domaines suivants:

1. Statistiques du serveur pour patentepi.com:

Cette option permet de vérifier le nombre des visiteurs sur les différentes sections de notre site.

2. Message Board:

Utilisez cette option pour laisser des messages à l'attention des utilisateurs de l'Extranet de l'epi.

3. Message Board (administration)

Le Secrétariat de l'epi est responsable de l'administration. C'est à lui que revient également la tâche d'éliminer toute information obsolète.

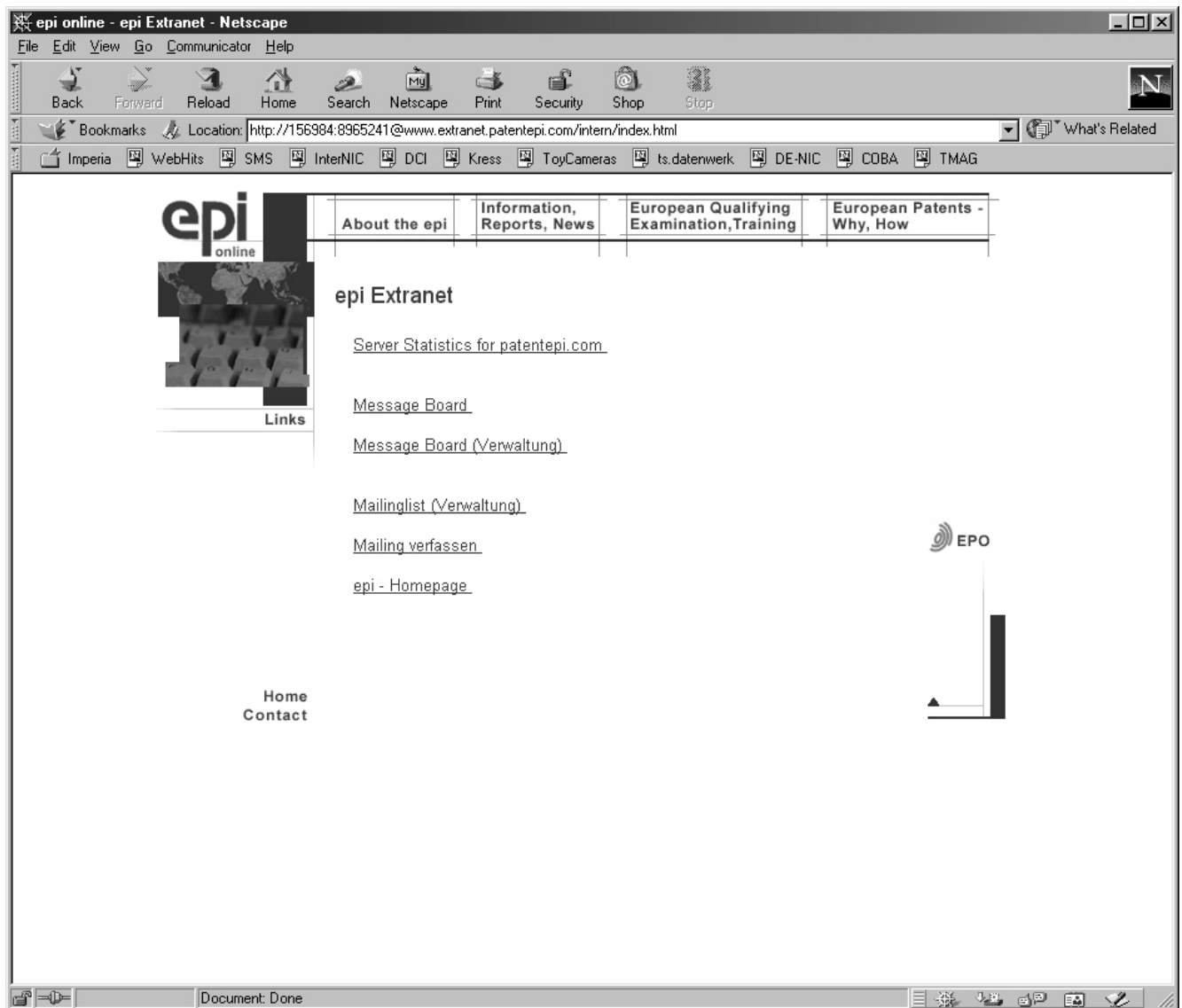
4. Mailing list (administration)

Cette option vous permet de vous inscrire sur la liste des destinataires et également de rayer votre inscription de la liste.

5. Rédaction du courrier:

Vous pouvez ici écrire et envoyer vos messages. Ils seront automatiquement envoyés à tous les membres inscrits sur la liste.

Si vous souhaitez utiliser l'Extranet de l'epi, veuillez envoyer un bref courrier électronique au Secrétariat de l'epi (info@patentepi.com) qui vous indiquera la procédure d'inscription à suivre et vous transmettra le code d'accès nécessaire.



Short Report on the Exhibition of *epi* Artists 2000

The 5th Exhibition of *epi* Artists took place from 13 to 31 March 2000 in the EPO main building, in Munich. The exhibition, opened by Mr. Schatz, acting EPO Vice President, and by the *epi* President, Mr. W. Holzer, was as usual very successful. Mr. Pieter Eveleens Maarse from the Netherlands said a few words on behalf of the participants. A large number of guests and visitors showed considerable interest in the works displayed. We take this opportunity to thank those *epi* members who could not be present on that evening but were kind enough to send their paintings and contributed to the success of the exhibition. We are looking forward to the next exhibition. Any comments and suggestions from our members are welcome!



W. Holzer, *epi* President



P.E. Maarse (NL)

Redaktionsschluss für
epi Information
3/2000

Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **14. August 2000**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zu diesem Datum im Sekretariat eingegangen sein.

Deadline for
epi Information
3/2000

Our deadline for the next issue of *epi* Information is **14 August 2000**. Documents for publication should have reached the Secretariat by this date.

Date limite pour
epi Information
3/2000

La date limite de remise des documents pour le prochain numéro de *epi* Information est le **14 août 2000**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

Special Preparatory Course for the CEIPI Seminar
on European Patent Law for Paper D (legal questions)
Pre-Preparatory Course
Friday, 6 October 2000, Strasbourg

The special preparatory course is intended especially, but not only, to candidates who have attended the CEIPI/EPI basic training course in European patent law and who would like advice on preparing themselves better for paper D. The need for the course is based on the finding that a number of participants at the examination preparation seminar in January (22 to 26 January 2001) do not have sufficient knowledge of European patent law and are not adequately prepared to meet the demands made of them. The general language of the proceedings will be English, but participants may also use French or German. Individual or group discussions will accordingly be held in the requested language – English, French or German.

Programme :

Morning session : Methods and aids for preparing paper D

Afternoon session : Studying of some questions of Paper D I and preparation of paper D II

The venue is : CEIPI, 11, rue du Maréchal Juin, , Strasbourg.

The fee for the course is FF 1 000 for the whole day from 8.30 a.m. to 5.15 p.m. including lunch together with the tutors.

For applications please contact:

Mme Rosemarie Blott
CEIPI
11, rue du Maréchal Juin
F 67000 Strasbourg

Tel. (33) 3 88 14 45 92 ; fax (33) 3 88 14 45 94 ;
e-mail : Rosemarie.Blott@urs.u-strasbg.fr

Freie Stelle · Position vacant · Vacance d'emploi

European Patent Attorney

Manchester, England

A Manchester-based company with 4700 employees world-wide is looking for a **European Patent Attorney** to join its current team of 8 qualified patent attorneys and three trainees.

The successful applicant will be fluent in English and capable of handling a wide variety of chemical inventions. The company has an interest in fields as diverse as pharmaceutical intermediates, colorants and organic light emitting materials.

An excellent remuneration package is on offer, including competitive salary, free life and health insurance, contributory pension scheme, car scheme and relocation expenses, where appropriate. High quality, affordable housing is available throughout Greater Manchester and the City has social and leisure activities to suit all tastes.

The closing date for applications is **15 July 2000**.

Please write in confidence, *c/o epi* Secretariat, Postfach 260112, D-80058 München

VESPA Verband der beim Europäischen Patentamt eingetragenen freiberuflichen schweizerischen Patentanwälte	VIPS Verband der Industriepatentanwälte in der Schweiz
organisieren auch in diesem Jahr wieder ein	

PRÜFUNGSTRAINING FÜR DIE EUROPÄISCHE EIGNUNGSPRÜFUNG 2001

- Der Kurs versteht sich als letzte Etappe vor der Eignungsprüfung und als Ergänzung zu eigentlichen Ausbildungskursen
- Die Lehrfunktion des Kurses beschränkt sich demgemäss auf das Durcharbeiten konkret gestellter Prüfungsaufgaben der Teile A bis D und die Instruktion der Prüfungstechnik durch erfahrene und beim EPA zugelassene Vertreter
- Die Aufgaben werden nach Wunsch auf deutsch, englisch oder französisch gestellt und können auch in der entsprechenden Sprache bearbeitet werden
- Die Bewertung erfolgt anonym anhand der bei der Eignungsprüfung angewandten Kriterien
- Der Kurs ist aus drei zeitlich getrennten Modulen aufgebaut, die auch einzeln belegt werden können und je die Teile A bis D der Europäischen Eignungsprüfung enthalten
- Ferner werden erstmalig an der **Universität Basel** unter der Leitung von **Prof.Dr.Dr.Dolder** an sechs Nachmittagen während des Sommersemesters **Aufgaben zum D-Teil** behandelt (Kosten CHF 100,- **Beginn: 14.04.2000**)

Aufteilung des Kurses

Modul 1

- Die Kandidaten erarbeiten zu Hause schriftlich Lösungen zu Prüfungsaufgaben eines bestimmten Jahrgangs (1999), Versand erfolgt im Juni. Die eingegangenen Arbeiten werden schriftlich korrigiert, bewertet und den Kandidaten wieder zugestellt.
- **Anmeldeschluss:** **31.05.2000**
- **Kosten Modul 1:** **CHF 450.-**

Modul 2 (zusammen mit Modul 3)

- Durchführung einer simulierten, 3-tägigen Prüfung mit den aktuellen Prüfungsaufgaben von 2000 in Basel, im Oktober oder November 2000. Die Lösungen der Kandidaten werden korrigiert und bewertet.
- **Anmeldeschluss:** **31.08.2000**
- **Kosten Modul 2 (inkl. Modul 3 mit Kompendien):** **CHF 600.-**

Modul 3 (auch für Wiederholer und Teilprüfungs-Kandidaten geeignet)

- Eintägige, ausführliche Besprechung der Prüfungsaufgaben in Basel (Februar 2001)
- **Anmeldeschluss (nur für Modul 3):** **15.11.2000**
- **Kosten Modul 3 (inkl. Kompendien):** **CHF 300.-**

Auskunft / Anmeldung beim Kursleiter:

Dr. Wolfgang Bernhardt, Ciba Specialty Chemicals Inc., Klybeckstr. 141, CH-4002 Basel,
Tel.: ++41/61/636 7223, Fax: ++41/61/636 7976, Email: wolfgang.bernhardt@cibasc.com

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Disciplinary bodies and Committees · Organes de discipline et Commissions

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*Chairman/**Secretary

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